

# Hardly a Black-and-White Matter: Analyzing the Validity and Protection of Single-Color Trademarks Within the Fashion Industry

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### I. THE FIRST SKETCH

The fashion industry thrives because of the consuming public’s desire to be affiliated with appealing brands. Some of these coveted brands are best identified by particular colors—for example, Tiffany & Co.’s blue, Hermes’s orange, and Christian Louboutin’s red. Others are internationally known for specific designs that incorporate color—such as Missoni’s vibrant patterns. While these colors may be well-recognized symbols of specific brands, and thus deserving of trademark protection, designers rely on a broad and unrestricted array of colors in order to continue conjuring up the latest trends for each new season. Due to these often-competing interests inherent to the industry, fashion designers seeking protection for their single-color trademarks or their identifying use of colors in a design encounter significant challenges.

The Supreme Court, echoing Congress’s intent to define trademark broadly, denied a per se exclusion to the protection of single-color trademarks,<sup>1</sup> but perhaps the fashion industry’s fundamental dependence on color renders the protection of single-color marks particularly problematic. This is the issue at the heart of the recent *Christian Louboutin, S.A. v. Yves Saint Laurent America, Inc.* litigation, in which the Second Circuit held that designer Christian Louboutin’s “Red Sole Mark” constitutes a valid trademark, but only when the red on the sole is in contrast to the remainder of the shoe.<sup>2</sup> This partial victory for the plaintiff-designer leaves in its wake

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1. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995).

2. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012).

unresolved questions about single-color fashion marks and the potential for increased intellectual property protection for the fashion industry in general.

For better or for worse, fashion designers and manufacturers are limited in their menu of intellectual property options. Professor Susan Scafidi, advocating for heightened intellectual property protection for fashion design, highlights the ever-increasing challenges faced by the industry.<sup>3</sup> Advancements in technology and global economic shifts, which facilitate increased production of high-quality counterfeit goods, should be met with increased protection for designers.<sup>4</sup> Permitting protection of fashion marks through a more flexible trademark analysis is a small step toward remedying the dearth of intellectual property protection.

This Note argues that single-color marks and related product designs that identify fashion brands should be granted trademark or trade dress protection, despite serving simultaneous aesthetic and source-identifying functions. Part II outlines the basic requirements of trademark and trade dress law (distinctiveness and nonfunctionality), and details the current protection afforded to color marks and fashion-product features. Part III looks at the recent *Louboutin* decisions from the Southern District of New York and the Second Circuit, and then analyzes the possibility of protecting single-color fashion marks, such as Louboutin's Red Sole Mark. Such analysis involves a review of the arguments and policies supporting such protection, as well as the doctrine of functionality that dangerously cuts against it. Part IV offers a solution that seeks to sufficiently preserve fashion's necessary foundations of creativity and free competition while still incentivizing the creation of successful marks such as Louboutin's Red Sole Mark. Limiting the scope of the trademark is essential to this solution and to the survival of a single-color mark in the face of the functionality doctrine. Lastly, the solution includes a relaxed aesthetic functionality framework, one that properly balances a mark's aesthetic appeal and source-identifying functions.

## II. WHAT'S "IN": A LOOK AT CURRENT TRADEMARK LAW

Fashion is indisputably a "big business";<sup>5</sup> estimated annual revenues for the industry total \$350 billion domestically and \$862

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3. Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH 115, 125 (Peter K. Yu ed., 2007).

4. *Id.* at 125–26.

5. Christopher A. Cotropia & James Gibson, *The Upside of Intellectual Property's Downside*, 57 UCLA L. REV. 921, 954 (2010).

billion worldwide.<sup>6</sup> These numbers reveal that most consumers interact with the industry on an almost daily basis.<sup>7</sup> Despite the jaw-dropping annual revenues and the inarguable impact fashion has on society, the United States offers the industry only limited intellectual property protection.<sup>8</sup> This inconsistency between commercial success and U.S. legal protection is highlighted by the fact that, year after year, sales claimed by the fashion industry surpass sales of books, movies, and music combined—those industries are often compared to the fashion industry, but enjoy far greater intellectual property protection.<sup>9</sup>

Patent and copyright laws protect some components of fashion, but many of the designs and other aesthetic elements are largely unprotected. The fashion industry's inherent preference for aesthetics over pure function, coupled with the constant redefining of what is "in," makes patent law an ill-suited vehicle for design protection. Although design patents<sup>10</sup> may protect innovative shoe and accessory designs,<sup>11</sup> most clothing designs are "re-workings" of past trends and therefore fail the statutory requirement of novelty.<sup>12</sup> Further, the lengthy patent application process and its attendant prohibitive costs do not render this body of intellectual property law a practical option for designers who turn out new products with each new season.<sup>13</sup>

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6. *Id.*

7. C. Scott Hemphill & Jeannie Suk, *The Law, Culture and Economics of Fashion*, 61 STAN. L. REV. 1147, 1148 (2009).

8. See Scafidi, *supra* note 3, at 118–19 (providing an account of the failed legislative attempts throughout the twentieth century to augment intellectual property protection for fashion designs); see also Cotropia & Gibson, *supra* note 5, at 969 (detailing current lack of protection for fashion industry).

9. Hemphill & Suk, *supra* note 7, at 1148 & n.1.

10. Design patents cover "any new, original and ornamental design for an article of manufacture." 35 U.S.C. § 171 (2006).

11. See, e.g., U.S. Patent No. D571,551 (filed June 6, 2006) (DC Shoes, Inc. patent for the ornamental design for an outsole and midsole for a shoe).

12. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1704 (2006); Emma Yao Xia, *The New Trend: Protecting American Fashion Designs Through National Copyright Measures*, 28 CARDOZO ARTS & ENT. L.J. 417, 429 (2010). In addition to the novelty requirement, innovations seeking patent protection must satisfy the difficult statutory requirements of utility and non-obviousness. See 35 U.S.C. § 101 (utility requirement); *id.* § 102 (novelty requirement); *id.* § 103 (non-obviousness requirement).

13. Cotropia & Gibson, *supra* note 5, at 955; see also Raustiala & Sprigman, *supra* note 12, at 1704 (indicating that the application process may take up to eighteen months). According to a 2007 survey, by the time a patent is granted (which itself is extremely uncertain), an applicant could see total costs exceeding twenty thousand dollars. *Preserving Your Patent Rights*, MIT TECH. LICENSING OFFICE, [http://web.mit.edu/tlo/www/community/preserving\\_patent\\_rights.html#controlling\\_costs](http://web.mit.edu/tlo/www/community/preserving_patent_rights.html#controlling_costs) (last visited Jan. 15, 2013).

Copyright law, the realm of intellectual property created primarily to protect original works of art, also fails to provide uniform and adequate protection for fashion designs.<sup>14</sup> The Federal Copyright Act expressly lists “pictorial, graphic, and sculptural works” as eligible for copyright protection.<sup>15</sup> Although fashion designs seem to fit easily within these enumerated categories, courts have classified clothing as a “useful article” having an “intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information,” and therefore have denied copyright protection.<sup>16</sup> Recently, Congress has been open to providing increased, albeit limited, copyright protection to fashion designers: in September of 2012, the Innovative Design Protection Act of 2012 (“IDPA”) passed the Senate Judiciary Committee.<sup>17</sup> The IDPA would provide three years of protection for original fashion designs and would require the design’s owner to provide an alleged infringer with at least twenty-one days’ written notice before instituting an action for infringement.<sup>18</sup> However, previous unsuccessful legislative attempts to increase protection for the industry require one to be wary of the ultimate fate of the IDPA.<sup>19</sup>

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14. Entire museums, the very homes of renowned works of art, are dedicated to fashion. Recently, the late Alexander McQueen’s most ambitious designs were on display at the Metropolitan Museum of Art. See Diane Cardwell, *Waiting Hours to See the McQueen Exhibit, in a Line Not Unlike a Runway*, N.Y. TIMES, Aug. 7, 2011, <http://www.nytimes.com/2011/08/08/nyregion/alexander-mcqueen-exhibition-at-metropolitan-museum-of-art-draws-thousands.html>.

15. Under the statute, copyright protection will be granted to “original works of authorship fixed in any tangible medium of expression,” which includes the following non-exclusive list of eligible works: (1) literary works; (2) musical works, including accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) *pictorial, graphic, and sculptural works*; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. 17 U.S.C. § 102(a) (2006).

16. Works of art in these categories are entitled to protection “only if, and only to the extent that, [their] design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C. § 101. According to the Supreme Court in *Mazer v. Stein*, copyright’s doctrine of separability provides potential copyright protection for those artistic elements that are conceptually or physically independent from the function of the useful article. 347 U.S. 201, 213–14 (1954). For the fashion industry, this could include images or patterns that adorn the clothing.

17. Karen A. Butcher et al., *Design Protection Bill Sent On for Senate Vote*, INTELLECTUAL PROPERTY LAWFLASH (Morgan, Lewis & Bockius LLP, Washington, D.C.), Sept. 28, 2012, at 1, available at [http://www.morganlewis.com/pubs/IP\\_LF\\_FashionDesignProtectionBillVotedOutOfSenate\\_28sep12.pdf](http://www.morganlewis.com/pubs/IP_LF_FashionDesignProtectionBillVotedOutOfSenate_28sep12.pdf).

18. CONG. BUDGET OFFICE, COST ESTIMATE—S. 3523: INNOVATIVE DESIGN PROTECTION ACT OF 2012 (2012), available at <http://www.cbo.gov/sites/default/files/cbofiles/attachments/s3523.pdf>.

19. Congress declined to adopt the proposed Design Piracy Prohibition Act (H.R. 2196) and the Innovative Design Protection and Piracy Prevention Act (S. 3728). LYDIA PALLAS LOREN & JOSEPH SCOTT MILLER, INTELLECTUAL PROPERTY LAW: CASES & MATERIALS 343 (Semaphore Press, version 2.2 2011).

Considering these current shortcomings of U.S. intellectual property law, this Note argues that trademark law is the appropriate vehicle for addressing the fashion industry's need for increased protection.

*A. What Are Trademarks and Trade Dress?*

Trademark law is foremost aimed at protecting the consumer.<sup>20</sup> It both decreases consumer search costs and encourages expenditures in quality, as it is the uniform and dependable quality across products, time, and consumers that allows a trademark to function as a successful source identifier.<sup>21</sup> For example, when a fashion-conscious consumer spots the interlocking “L & V” monogram on a brown leather handbag, she immediately recognizes the symbol as that of Louis Vuitton and can expect a high-quality and expensive product. By granting a source such as Louis Vuitton the exclusive right to use a particular source-identifying symbol within commerce, trademark law protects consumers from confusion and protects brand owners by prohibiting others from exploiting the goodwill of a particular trademark.

The Lanham Act, passed in 1946, governs federal trademark law.<sup>22</sup> A trademark includes “any word, name, symbol, or device, or any combination thereof used by a person . . . in commerce . . . to identify and distinguish his or her goods . . . and to indicate the source of the goods, even if that source is unknown.”<sup>23</sup> The Supreme Court has interpreted “any” to evidence Congress's intent to define trademark broadly, and courts continue to apply this definition

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20. See Richard J. Berman, *Color Me Bad: A New Solution to the Debate Over Color Trademark Registration*, 63 GEO. WASH. L. REV. 111, 133–34 (1994) (stating that consumer protection is favored over competitors' interest in exclusive use); Cotropia & Gibson, *supra* note 5, at 966 (arguing that trademark law is more about regulating deceptive means of competition than providing incentives for innovation); see also *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (noting the facilitation of commerce and protection of consumers as the principal purposes behind the Lanham Act); Diane E. Moir, *Trademark Protection of Color Alone: How and When Does a Color Develop Secondary Meaning and Why Color Marks Can Never Be Inherently Distinctive*, 27 Touro L. REV. 407, 411 (2011) (“The primary purpose of trademark law is to ‘provide[] national protection of trademarks in order . . . to protect the ability of consumers to distinguish among competing producers.’” (quoting *Park 'N Fly*, 469 U.S. at 198)).

21. William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 270–71 (1988).

22. Pub. L. No. 79-489, 60 Stat. 427 (codified as amended at 15 U.S.C. §§ 1051–1129 (2006)).

23. 15 U.S.C. § 1127.

accordingly when analyzing the validity of a mark.<sup>24</sup> Indeed, both the United States Patent and Trademark Office (“USPTO”) and courts have extended trademark protection to a variety of “symbols” or “devices” including colors, shapes, sounds, and even particular scents.<sup>25</sup>

This broad definition also embraces packaging, dressing, or design. These elements, which contribute to the total image of the product, are referred to as “trade dress,” which can in some instances constitute symbols or devices indicating a source.<sup>26</sup> Trade dress is typically protected as an unregistered mark under a Lanham Act action for false designation of origin.<sup>27</sup> Trade dress can cover features such as “size, shape, color or color combinations, textures, graphics, or even particular sales techniques.”<sup>28</sup> Examples include a toy’s packaging, the design of a restaurant, and even a clothing design. Similar to trademarks, some trade dress elements signal a product’s source. In other words, when the requisite elements are satisfied, trade dress may serve the identical function as a registered trademark and will be protected as such.<sup>29</sup> However, to serve as a valid source identifier, a trademark or trade dress must be both distinctive and nonfunctional.

### *B. Requirements for a Valid Trademark or Trade Dress*

The USPTO makes the initial determination of whether to register a trademark; once registered and if challenged, courts determine whether to uphold protection against an alleged infringement. In fulfilling their respective roles, both institutions must first decide whether the particular “word, name, symbol, or device” is actually a valid mark.<sup>30</sup> A valid trademark must be

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24. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (“Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”).

25. *See id.* (drawing upon examples of nontraditional marks such as the Coca-Cola bottle, NBC’s three chimes, and the scent of plumeria blossoms on sewing thread to indicate the broad definition of “trademark”).

26. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000).

27. 15 U.S.C. § 1125; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764–65 & n.1 (1992).

28. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983).

29. *Publ’ns Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 338 (7th Cir. 1998).

30. *See Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983) (“The threshold issue in any action for trademark infringement is whether the word or phrase is initially registerable or protectable.”), *abrogated by KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

distinctive in the marketplace and nonfunctional.<sup>31</sup> This Section focuses on the requirements as they pertain to single-color marks within the fashion industry.<sup>32</sup>

### 1. Distinctiveness: Inherent or Acquired Secondary Meaning

A trademark will be initially approved by the USPTO, and subsequently upheld by the courts, based in part on its degree of distinctiveness.<sup>33</sup> Courts have relied loosely on the language of the Lanham Act to identify four categories of ascending distinctiveness under which potential trademarks may be characterized: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.<sup>34</sup> Generic marks, those that “connote the ‘basic nature of articles or services’ rather than the more individualized characteristics of a particular product,” never warrant protection.<sup>35</sup> On the other hand, suggestive, arbitrary, and fanciful marks are inherently distinctive and do not require evidence of acquired distinctiveness:<sup>36</sup> “[B]ecause of the nature of the designation and the context in which [they are] used, prospective purchasers are likely to perceive [them] as a designation that, in the case of a trademark, identifies goods or services produced or sponsored by a particular person . . . .”<sup>37</sup>

Courts have held that both single-color marks and clothing designs constituting trade dress are descriptive.<sup>38</sup> A descriptive mark “‘identifies a characteristic or quality of an article or service,’ such as

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31. See, e.g., *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 772–73 (9th Cir. 1981) (“The physical details and designs of a product may be protected under the Lanham Act if these features are ‘non-functional’ and they have acquired a secondary [meaning].”).

32. Due to the fact that a court’s analysis of the validity of a registered mark is for the most part identical to its analysis of trade dress, the following applies to both related bodies of law.

33. *Zatarains*, 698 F.2d at 790.

34. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

35. *Zatarains*, 698 F.2d at 790 (quoting *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 11 (5th Cir. 1974)); see also *Abercrombie & Fitch*, 537 F.2d at 9 (“A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species.”). An example of a generic term would be the word “apple” for the fruit itself.

36. *Zatarains*, 698 F.2d at 791. A suggestive term “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” *Abercrombie & Fitch*, 537 F.2d at 11. An example of a suggestive mark is “Coppertone” for sunscreen. An arbitrary term is one that applies a common word in an unfamiliar way, whereas a fanciful term is a word invented solely for its use as a trademark. *Id.* at 11 n.12. The term “Apple” for computer products is an example of an arbitrary mark. See *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996).

37. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13(a) (1995).

38. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 216 (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

its color, odor, function, dimensions, or ingredients.”<sup>39</sup> While descriptive marks are not inherently distinctive, and therefore do not automatically warrant protection, such marks are valid if they attain secondary meaning in the minds of consumers.<sup>40</sup> A mark or trade dress owner establishes secondary meaning by showing that, “in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”<sup>41</sup>

Direct evidence, such as consumer testimony and surveys, and circumstantial evidence, such as advertising campaigns and expenditures and sales reports, are required in order to establish secondary meaning.<sup>42</sup> The USPTO and various circuits have devised nonexhaustive lists of factors to aid in the determination of secondary meaning.<sup>43</sup> For example, in *Marketing Displays, Inc. v. Traffix Devices, Inc.*, the Sixth Circuit looked to seven factors: (1) direct consumer testimony; (2) consumer surveys; (3) exclusivity, length, and manner of use; (4) amount and manner of advertising; (5) amount of sales and number of customers; (6) established place in market; and (7) proof of intentional copying.<sup>44</sup> The Supreme Court held that single-color marks required a showing of secondary meaning in *Qualitex Co.*

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39. *Zatarains*, 698 F.2d at 790 (internal citation omitted); see also *Abercrombie & Fitch*, 537 F.2d at 11 (“A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”). An example of a descriptive mark would include “Aloe” in reference to products containing gel from the aloe vera plant. See *Aloe Crème Labs, Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir. 1970).

40. 15 U.S.C. § 1052(f) (2006) (“[N]othing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.”); *Zatarains*, 698 F.2d at 790.

41. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938).

42. *Int’l Kennel Club of Chi., Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1085 (7th Cir. 1988).

43. See, e.g., *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 541 (5th Cir. 1998) (utilizing a seven-factor test to determine whether secondary meaning had been achieved). The USPTO uses a similar multi-factor test to determine whether a color mark has acquired the requisite secondary meaning: (1) whether the use of the color is common in the relevant segment of the market in question; (2) the product’s sale volume; (3) whether publicity directly captures the customer’s attention with respect to the color of the product; (4) whether the color is also used in promotional articles; (5) whether consumers associate the color with the nature of the product; and (6) whether the color serves some utilitarian purpose. Glenda Labadie-Jackson, *Through the Looking Hole of the Multi-Sensory Trademark Rainbow: Trademark Protection of Color Per Se Across Jurisdictions: The United States, Spain, and the European Union*, 7 RICH. J. GLOBAL L. & BUS. 91, 99 (2008) (citing Midge M. Hyman & Hannah Y. Cheng, *Registrability and Enforceability of Non-Traditional Trademarks in the United States*, in PRACTISING LAW INST., PATENTS, COPYRIGHTS, TRADEMARKS, AND LITERARY PROPERTY COURSE HANDBOOK SERIES 6–9 (2005)).

44. *Mktg. Displays, Inc. v. Traffix Devices, Inc.*, 200 F.3d 929, 937 (6th Cir. 1999) (citing *Sassafras Enters., Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 7 (N.D. Ill. 1996)), *rev’d on other grounds*, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

*v. Jacobson Products Co.*; it held the same for clothing design in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*

*a. Qualitex: Single-Color Marks*

The Lanham Act does not expressly prohibit the registration of a color as a trademark.<sup>45</sup> The preamble of section two of the Lanham Act states that “[n]o trademark . . . shall be refused registration on the principal register on account of its nature” unless specific enumerated exceptions apply.<sup>46</sup> Early judicial decisions responded to this statutory silence in a variety of ways—ranging from absolutely prohibiting protection,<sup>47</sup> to allowing protection in limited circumstances,<sup>48</sup> and finally to declining to establish per se prohibition against protecting color alone.<sup>49</sup>

The Supreme Court responded to this circuit split in 1995 in *Qualitex Co. v. Jacobson Prods. Co.*, holding that color is *sometimes* capable of satisfying the basic legal requirements for trademark protection and that “no special legal rules prevent color alone from serving as a trademark.”<sup>50</sup> The plaintiff, Qualitex, a manufacturer of green-gold dry-cleaning press pads, sued its competitor, Jacobson, for unfair competition and trademark infringement after discovering Jacobson was selling identically colored press pads to the same distributors.<sup>51</sup>

The Court concluded that a color is not inherently distinctive because it does not automatically signal to consumers a specific brand.<sup>52</sup> Nonetheless, it found that a color could serve as a valid trademark (i.e., it could constitute a “symbol” or “device”) upon a

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45. See 15 U.S.C. § 1052 (explicitly enumerating marks that are not eligible for protection). Even before enactment of the Lanham Act in 1946, when registration of color marks was prohibited, some courts granted owners of color marks protection against unfair competition upon proof of secondary meaning. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1118–19 (Fed. Cir. 1985) (citing *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407 (6th Cir. 1945); *Clifton Mfg. Co. v. Crawford-Austin Mfg. Co.*, 12 S.W.2d 1098 (Tex. Civ. App. 1929)).

46. 15 U.S.C. § 1052; *Owens-Corning*, 774 F.2d at 1119 (stating and arguing that “[c]olor is not such an exception”).

47. See *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1028 (7th Cir. 1990) (holding that the blue color of sugar substitute packets could not be protected as trade dress).

48. See *Owens-Corning*, 774 F.2d at 1128 (finding that the color pink may serve as a trademark for insulation).

49. See *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993) (refusing to establish per se prohibition against standalone color trademarks).

50. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161, 174 (1995); see also *Moir*, *supra* note 20, at 412–13 (describing *Qualitex* as the “emergence of color marks”).

51. *Qualitex*, 514 U.S. at 161.

52. *Id.* at 162–63.

showing of secondary meaning.<sup>53</sup> Here, consumers associated the green-gold color of press pads with the Qualitex brand specifically; therefore, the color had acquired secondary meaning.<sup>54</sup>

*b. Wal-Mart: Product Design*

Some forms of trade dress, such as product packaging or the design of a restaurant, may be inherently distinctive.<sup>55</sup> However, the Supreme Court, in *Wal-Mart Stores Inc. v. Samara Brothers*, expressly distinguished clothing design from those categories of trade dress.<sup>56</sup> Refusing to protect the plaintiff's designs as valid trade dress, the Court held that product design is entitled to protection only if it has acquired secondary meaning because, as is the case with color, consumers are not predisposed to equate the feature with the source: "[C]onsumers are aware of the reality that . . . even the most unusual of product designs . . . is intended not to identify the source, but to render the product itself more useful or more appealing."<sup>57</sup> Thus, in order to serve as valid trade dress, a particular fashion design must create an "association in buyers' minds between the alleged mark and a single source."<sup>58</sup> However, no amount of evidence of acquired distinctiveness will succeed in validating a mark or product design if it is merely a functional attribute of the product.<sup>59</sup>

## 2. The Functionality Doctrine

A finding of functionality will trump any evidence of distinctiveness.<sup>60</sup> Thus, many courts will treat this doctrine as a

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53. *Id.* at 163.

54. *Id.* at 174.

55. *See* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 784–85 (1992) (finding that the design of a restaurant could be protected as trade dress and may be inherently distinctive).

56. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213, 216 (2000). Further, "[t]o the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." *Id.* at 215.

57. *Id.* at 213; *see also* *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 637 (6th Cir. 2002) (reiterating that, after *Samara Bros.*, product designs may only meet the Lanham Act's distinctiveness requirement upon a showing of secondary meaning).

58. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed. 1996).

59. *See* *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34–35 (2001) (reasoning that investment made to encourage association with a particular feature is futile if the feature is functional).

60. *See, e.g., In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484–85 (Fed. Cir. 1984) ("Evidence of distinctiveness is of no avail to counter a de jure functionality rejection."); *see also* *Traffix*, 532 U.S. at 34–35 ("The Lanham Act, furthermore, does not protect trade dress in a functional design

threshold issue to secondary meaning, refusing to address the latter altogether upon concluding that a mark is functional.<sup>61</sup> The burden of proof shifts depending on whether a mark is registered with the USPTO. If the mark in question is unregistered—as is the case with most trade dress—the party seeking protection carries the burden of proving nonfunctionality.<sup>62</sup> Alternatively, registration with the USPTO affords mark owners a presumption of validity and shifts the burden of proving functionality to the opponent attempting to invalidate the mark.<sup>63</sup> Due to the fact that valid unregistered trade dress and registered trademarks are treated the same under the Lanham Act,<sup>64</sup> and “because evidence of functionality is equally available to both parties,”<sup>65</sup> this burden shifting has little effect on the analysis in this Note.

So what exactly is the functionality doctrine?<sup>66</sup> In *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, the Supreme Court held that the blue color of plaintiff’s pill was a functional product feature for patients, doctors, and hospitals in that it prevented commingling of medications, assisted drug identification in emergency situations, and signaled a therapeutic effect.<sup>67</sup> Creating what is now referred to as utilitarian functionality, the Court described a functional product feature as that which is “essential to the use or purpose of the article or . . . affects the cost or quality of the article.”<sup>68</sup> In general, there is no great discrepancy in the lower courts’ applications of this doctrine; courts can fairly readily identify a potential trademark or trade dress feature’s necessity or its effect on the product’s cost or quality.<sup>69</sup>

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simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.”).

61. See, e.g., *Pagliari v. Wallace China Co.*, 198 F.2d 339, 344 (9th Cir. 1952) (“[T]he design being a functional feature of the china, we find it unnecessary to inquire into the adequacy of the showing made as to secondary meaning of the designs.”).

62. See *TrafFix*, 532 U.S. at 29 (stating that Congress codified this burden of proving nonfunctionality in 15 U.S.C. § 1125(a)(3)).

63. See *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 774 (9th Cir. 1981) (noting that registration establishes a presumption that the mark serves the nonfunctional purpose of source identification).

64. *Publ’ns Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 338 (7th Cir. 1998).

65. *Id.* at 340.

66. Landes and Posner provide a useful, albeit incomplete, example to aid the understanding of the functionality doctrine: “The maker of a tire could not trademark its circular shape but could trademark an irregularly shaped hubcap.” Landes & Posner, *supra* note 21, at 295.

67. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 853 (1982).

68. *Id.* at 850 n.10.

69. See, e.g., *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938) (finding pillow shape of “Shredded Wheat” to be functional in that “the cost of the biscuit would be increased and its high quality lessened if some other form were substituted”); *Dippin’ Dots, Inc. v. Frosty Bits*

Furthermore, since utility is a fundamental requirement of patent law, it is strong evidence of functionality if a particular product feature was at one time claimed under a utility patent.<sup>70</sup> Though it will be an uphill battle, a mark owner can rebut the presumption of utilitarian functionality by showing that the feature in question is “merely an ornamental, incidental, or arbitrary aspect of the device.”<sup>71</sup>

Thirteen years after *Inwood*, the Supreme Court, in *Qualitex*, supplemented its existing standard by addressing aesthetic functionality.<sup>72</sup> The Court held that the green-gold, single-color mark for laundry press pads could serve as a valid trademark unless “exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”<sup>73</sup> Without further guidance, lower courts have created a variety of inconsistent and inadequate standards for analyzing aesthetic functionality.

In *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, the Court affirmed the coexistence of both subdoctrines of functionality.<sup>74</sup> Declaring plaintiff’s dual-spring design for weather-resistant sign stands to be an attribute of traditional or utilitarian functionality, as evidenced by the product’s expired patent, the Court did not find it necessary to further analyze whether there was a competitive need for the feature.<sup>75</sup>

Despite attempts by the Supreme Court to further clarify the concept of functionality, this doctrine is still fraught with uncertainty and continues to be inconsistently applied throughout the lower courts—especially in cases dealing with color and fashion designs.<sup>76</sup>

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Distribution, LLC, 369 F.3d 1197, 1206 (11th Cir. 2004) (concluding that the size and shape of ice cream beads were functional attributes because they contributed to the product’s taste and consistency, and because this form facilitated quick freezing of the product).

70. See *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29–30 (2001) (finding a dual-spring design to be a functional attribute, as it was the “central advance claimed in the expired utility patents”).

71. *Id.* at 30.

72. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995). The doctrine of aesthetic functionality was first espoused by the Ninth Circuit in *Pagliari v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952).

73. *Qualitex*, 514 U.S. at 165.

74. See 532 U.S. at 33 (applying the “traditional” rule set forth in *Inwood* prior to the “competitive necessity” or aesthetic rule summarized in *Qualitex*).

75. *Id.* at 34 (“The dual-spring design is not an arbitrary flourish in the configuration of MDI’s product; it is the reason the device works. Other designs need not be attempted.”).

76. See Mark P. McKenna, *(Dys)Functionality*, 48 HOUS. L. REV. 823, 824 (2011) (describing the doctrine as “quite inconsistently applied”).

*a. Functionality in Color and Fashion*

While color is not per se functional,<sup>77</sup> the USPTO and various courts have denied trademark protection on the grounds of functionality in several instances, such as when color served to distinguish medications,<sup>78</sup> to indicate flavor,<sup>79</sup> and to blend with the natural color of human skin.<sup>80</sup> Additionally, protection will not be afforded to the natural color of a product, because such a feature is essential to the product's use.<sup>81</sup> Lastly, courts have suggested that color used to avoid stains or to diminish the appearance of "wear and tear" on a product serves a functional purpose.<sup>82</sup> These examples show that single-color marks must overcome various obstacles in order to gain protection; such obstacles may be even greater for industries that fundamentally rely on aesthetic appeal, such as fashion.

Although articles of clothing no doubt serve functional purposes such as protection and warmth, it is aesthetic preferences, dictated by both personal choice and a desire to follow a specific trend, that lead the individual to dress himself or herself in a particular fashion. Color lies at the heart of this aesthetic choice.<sup>83</sup> Furthermore, due to the rapid changes in trends, a particular color can be "in" one season and then "out" mere months later.<sup>84</sup> It is color's central role within the fashion industry that makes protection via trademark law a contentious issue.

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77. See *Qualitex*, 514 U.S. at 165 ("[T]he fact that sometimes color is not essential to the product's use or purpose and does not affect cost or quality—indicates that the doctrine of 'functionality' does not create an absolute bar to the use of color alone as a mark.").

78. See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 853 (1982) (finding color to be functional in that it was used to differentiate medications from one another, provided therapeutic effects to patients, and facilitated quick dispensing in emergency situations).

79. See *Dippin' Dots, Inc. v. Frosty Bits Distribution, LLC*, 369 F.3d 1197, 1203–04 (11th Cir. 2004) (reasoning colors of product were functional because they indicated the different flavors of ice cream).

80. See *In re Ferris Corp.*, 59 U.S.P.Q.2d 1587, 1589 (T.T.A.B. 2001) ("There is no question that 'flesh color' for wound dressings serves the utilitarian purpose of blending well with the natural color of human skin."). The Board also reasoned that certification of the trademark in question would negatively affect competitors. *Id.* at 1591.

81. *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993).

82. See *Qualitex*, 514 U.S. at 166 (arguing that color in general was needed to avoid noticeable stains, but ultimately finding particular green-gold color was not essential, since other colors could be used).

83. See Marilyn Revell DeLong, *Color in Dress*, in 1 ENCYCLOPEDIA OF CLOTHING AND FASHION 280, 282 (Valerie Steele ed., 2005) (stating that color is the "most important aesthetic criterion in consumer preference").

84. Oliver Horton, *Upping the Color Quotient*, N.Y. TIMES, Oct. 1, 2008, <http://www.nytimes.com/2008/10/01/style/01iht-r-color.1.16608890.html> (detailing the trend in the fashion industry of using an increased range of colors).

To date, color used in fashion design has been granted limited trademark protection. In *Keds Corp. v. Renee International Trading Corp.*, the First Circuit found that the blue rectangle placed on plaintiff's shoes was a valid mark because the shape was nonfunctional and the mark had acquired secondary meaning.<sup>85</sup> More recently, in *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, the Second Circuit held that Vuitton's "Multicolore" mark, consisting of its famous monogram design plus thirty-three bright colors, was a valid mark.<sup>86</sup> However, Vuitton did not claim separate protection of the colors alone, and the holding of validity was largely based on the distinctiveness already enjoyed by the widely popular monogram motif design.<sup>87</sup> Other examples from the fashion industry in which color has served as part of a valid trademark include Burberry's "Check" pattern<sup>88</sup> and Prada's red longitudinal heel stripe.<sup>89</sup>

From these few examples, it appears that trademark protection of specific colors has been afforded to fashion brands based on the synergy or arrangement of the color as part of a mark, rather than the use of color independently.<sup>90</sup> Thus, considering color marks within the context of the product's design is similar to trade dress analysis. For the purposes of this Note, analysis of the validity of single-color fashion marks encompasses both registered single-color trademarks and the identifying use of a single color as an element of fashion design or trade dress. The Second Circuit's recent holding in *Christian Louboutin v. Yves Saint Laurent*, which granted Louboutin protection of its Red Sole Mark, simultaneously signals a small victory for the fashion industry and a continued headache for those parsing through the functionality doctrine.

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85. *Keds Corp. v. Renee Int'l Trading Corp.*, 888 F.2d 215, 221 (1st Cir. 1989). This case serves merely to illustrate an early instance of protection of a mark including a specific color. It should be noted that *Keds Corp.* was decided prior to the Supreme Court's ruling of single-color protection in *Qualitex* and, therefore, its deliberate choice to stay away from the issue of trademarking color alone is no longer relevant. However, the Court did acknowledge that the "color only" issue was previously before the USPTO and that the USPTO decided that there was secondary meaning in and of itself. *Id.*

86. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115–16 (2d Cir. 2006).

87. *Id.* at 115.

88. Registration No. 1,241,222. The Southern District of New York confirmed Burberry's "Check" mark as a valid trademark in *Burberry Ltd. v. Euro Moda, Inc.*, No. 08 Civ. 5781(CM), 2009 WL 1675080, at \*5 (S.D.N.Y. June 10, 2009).

89. Registration No. 2,851,315.

90. *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 451 (S.D.N.Y. 2011), *aff'd in part, rev'd in part sub nom.* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012).

### III. CURRENT ISSUES SURROUNDING THE PROTECTION OF SINGLE-COLOR FASHION TRADEMARKS

The Supreme Court's holdings in *Qualitex* and *Wal-Mart* inform the analysis of the validity of single-color fashion marks; such a trademark or element of trade dress lies at the intersection of color and product design. The fashion industry's unique reliance on creativity and aesthetics may complicate this analysis, but it should not give reason to categorically deny protection to single-color fashion marks. This Part begins with a discussion of contemporary litigation surrounding this issue. It then supports and expands upon the Second Circuit's general holding in *Louboutin* that single-color trademarks within the fashion industry may be protected under certain circumstances.

#### A. *A Battle in Six-Inch Heels*: Christian Louboutin v. Yves Saint Laurent

In 1992, designer Christian Louboutin began coloring the outsoles of his high-fashion women's shoes a glossy, vivid red.<sup>91</sup> In an interview with *USA Today*, the designer explained his decision to use the particular color: “[I]t is the color of love. It's the color of passion.”<sup>92</sup> Elsewhere, Louboutin has described his choice as a way to give the shoes “energy,” because red is “engaging, flirtatious, memorable . . . sexy.”<sup>93</sup> Women lust after the coveted (and pricey) red-soled shoes, making Louboutin a world-renowned name in the high-fashion shoe industry.<sup>94</sup> The brand's fame derives largely from the red outsole itself: interested consumers can instantly recognize the brand when they see a red-soled shoe gracing the red carpet or the pages of fashion publications.<sup>95</sup> The USPTO approved Louboutin's registration of its

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91. *Id.* at 447.

92. Cindy Clark, *Christian Louboutin's Red-Soled Shoes Are Red-Hot*, USA TODAY, Dec. 25, 2007, [http://www.usatoday.com/life/lifestyle/fashion/2007-12-25-louboutin-shoes\\_N.htm](http://www.usatoday.com/life/lifestyle/fashion/2007-12-25-louboutin-shoes_N.htm).

93. *Louboutin*, 778 F. Supp. 2d at 447.

94. Louboutin is estimated to sell approximately 240,000 pairs annually in the United States, with prices ranging from \$395 to as much as \$6,000. The company's revenue for 2011 was forecasted at \$135 million. *Lay Off My Red-Soled Shoes: Can a Colour Be a Trademark?*, THE ECONOMIST, Aug. 20, 2011, <http://www.economist.com/node/21526357>.

95. One journalist writes, “Though many people can't pronounce his name (Lu-bu-TAHn), his signature red sole is instantly recognizable . . . . The red sole ‘has given him an edge, because it's a visible touch that brands him. Women tend to feel others notice, and it's a way of saying you've got the shoe.’” Clark, *supra* note 92 (quoting Filipa Fino). The Lanham Act's broad definition of trademark allows for protection “even if that source is unknown.” 15 U.S.C. § 1127 (2006). The USPTO has reiterated this detail. *In re Paramount Pictures Corp.*, 217 U.S.P.Q. 292, 293 (T.T.A.B. 1983) (“[I]t is immaterial whether the actual identity of the source is known.”).

“Red Sole Mark” in 2008.<sup>96</sup> However, Louboutin’s popularity and commercial success initially failed to convince the Southern District of New York that its Red Sole Mark warranted protection.

### 1. Fashion Faux Pas: Southern District of New York Decides Against Louboutin

In April 2011, Christian Louboutin, S.A. sued competitor Yves Saint Laurent America, Inc., asserting a violation of the Lanham Act and New York law for its use of the color red on the outsoles of its monochromatic Cruise 2011 collection.<sup>97</sup> The district court denied the plaintiff’s motion for a preliminary injunction, holding that Louboutin’s lacquered red color on its products’ outsoles did not warrant trademark protection under the Lanham Act.<sup>98</sup>

While the court acknowledged that Louboutin’s red outsole had acquired secondary meaning due to its public recognition, it denied protection as a trademark on the grounds of functionality: “[I]n the fashion industry, color serves ornamental and aesthetic functions vital to robust competition.”<sup>99</sup> The court began its discussion with a narrow interpretation of *Qualitex*,<sup>100</sup> distinguishing the fashion industry’s use of color as predominantly aesthetic (i.e., serving non-trademark functions), as compared to color marks used to identify industrial products.<sup>101</sup> Additionally, it found that Louboutin’s use of color served a utilitarian function because the red outsole affected the cost of the product—that is, it increased the price of the shoes because a higher manufacturing cost translates into a higher price for consumers, which perpetuates the exclusivity associated with luxury goods.<sup>102</sup>

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96. *Louboutin*, 778 F. Supp. 2d at 448. Its certificate of registration, which included both a verbal description and line drawing to show placement of the mark, stated, “The color(s) red is/are claimed as a feature of the mark. The mark consists of a lacquered red sole on footwear. The dotted lines are not part of the mark but are intended only to show placement of the mark.” Registration No. 3,361,597.

97. *Louboutin*, 778 F. Supp. 2d at 448.

98. *Id.* at 457.

99. *Id.* at 449.

100. *Id.* at 450 (“In short, color can meet the legal requirements for a trademark if it ‘act[s] as a symbol that distinguishes a firm’s goods and identifies their source, *without serving any other significant function.*’ ” (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995)) (emphasis added)).

101. *Id.* at 451. (“The application of color to the product can be isolated to a single purpose: to change the article’s external appearance so as to distinguish one source from another. But, whatever commercial purposes may support extending trademark protection to a single color for industrial goods do not easily fit the unique characteristics and needs—the creativity, aesthetics, taste, and seasonal change—that define production of articles of fashion.”).

102. *Id.* at 454.

Most damning, the court found Louboutin's use of red to be aesthetically functional, because granting exclusive use of the color red would significantly hinder competition due to the foreseeable results of color depletion and shade confusion.<sup>103</sup> Following the district court's decision and Louboutin's subsequent interlocutory appeal to the Second Circuit, support rallied around both parties in the media and through the filing of amicus briefs; many understood that the ultimate outcome in this case would have an impact reaching beyond the fate of one luxury-shoe designer.<sup>104</sup>

## 2. Très Chic?: Second Circuit Holds Louboutin's Red Sole Mark Is a Valid Trademark when Modified

While declaring that there is no per se prohibition of single-color trademarks in the fashion industry (consistent with the seminal holding in *Qualitex*), the Second Circuit held that Louboutin's Red Sole Mark constituted a valid trademark only when used in contrast with the remainder of the shoe; thus, to maintain protection, the court modified the mark pursuant to § 1119 of Title 15 of the U.S. Code.<sup>105</sup> As a result, Yves Saint Laurent's monochromatic shoe, which lacked such a contrast, did not constitute an infringing use of Louboutin's trademark.<sup>106</sup>

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103. *Id.* at 454–57.

104. Tiffany & Co. filed a brief in support of Louboutin, arguing the district court's per se rule is unsubstantiated by both statutory and judicial precedent and that the court incorrectly analyzed the issue under both facets of the functionality defense. Brief of Amicus Curiae Tiffany (NJ) LLC and Tiffany & Co. in Support of Appellants' Appeal Seeking Reversal of the District Court's Decision Denying Appellants' Motion for Preliminary Injunction at 7–8, *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012) (No. 11-3303-cv). The International Trademark Association ("INTA") followed in filing its own brief in support of Louboutin. The INTA argued that the court did not grant Louboutin the presumption of validity warranted by its approved USPTO registration and therefore overbroadly construed the registration as "the color red" rather than as "a lacquered red sole on footwear." Brief of Amicus Curiae International Trademark Ass'n in Support of Vacatur and Remand at 6–15, *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012) (No. 11-3303-cv). It too argued that the court incorrectly applied the doctrine of aesthetic functionality. *Id.* at 16. In support of Yves Saint Laurent, a group of American law professors has argued for the legitimacy of the aesthetic functionality doctrine and the court's proper application of such doctrine. Brief of Amicus Curiae Law Professors in Support of Defendants-Counter-Claimants-Appellees and Urging Affirmance at 2–11, *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012) (No. 11-3303-cv).

105. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012); *see also* 15 U.S.C. § 1119 (2006) ("In any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action." (emphasis added)).

106. *Louboutin*, 696 F.3d at 212.

The court began by stating that in an infringement claim, the mark owner must prove that (1) its mark is distinctive and (2) there is a likelihood of consumer confusion between its mark and that of the alleged infringer.<sup>107</sup> If successfully demonstrated, the opponent may still prevail upon proving the affirmative defense of functionality—in other words, by proving that the mark in question is not a valid source identifier, but rather serves a utilitarian or aesthetic function.<sup>108</sup>

The Second Circuit sought to clarify the district court's incorrect understanding of the doctrine of aesthetic functionality—an understanding that led the lower court to find that a single color could never serve as a trademark within the fashion industry.<sup>109</sup> Keeping in mind the need to balance the competitive benefits of protecting source-identifying aspects of a mark with the costs of precluding competitors from using the feature, the court first formulated a standard for analyzing the aesthetic functionality doctrine: “[A] mark is aesthetically functional, and therefore ineligible for protection . . . where protection of the mark *significantly* undermines competitors' ability to compete in the relevant market.”<sup>110</sup> Second, due to the very fact-specific nature of the inquiry, it cautioned against “jumping to the conclusion” that an aesthetic feature is functional merely because it denotes the product's desirable source.<sup>111</sup> Third, acknowledging the central role of color within fashion, and the resulting difficulty in applying the doctrine to fashion marks, the court reasoned that the functionality defense does not guarantee competitors the greatest range of creative choices, but rather allows them enough ability to fairly compete within a given market.<sup>112</sup>

Despite this comprehensive discussion of the functionality doctrine, the court stopped short of applying its own analysis to the facts at hand.<sup>113</sup> Instead, by framing the “distinctiveness” prong as the central question—the first in its construction of a *prima facie* infringement claim—it avoided the functionality issue all together.<sup>114</sup>

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107. *Id.* at 216–17.

108. *Id.* Had this been an action under § 43(a) for trade dress infringement, the party seeking protection would bear the burden of proving the design was nonfunctional. 15 U.S.C. § 1125(a)(3).

109. *Louboutin*, 696 F.3d at 223.

110. *Id.* at 222.

111. *Id.*

112. *Id.* at 223.

113. *See id.* at 224 (“[W]e need not, and do not, reach the issue[] of . . . functionality at the second stage of trademark infringement analysis described above.”).

114. *See id.* at 217 (stating that confusion and functionality analysis is only carried out if a trademark is first found to be “distinctive” (quoting *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2005))).

Relying on statements from the parties, evidence of Louboutin's advertising expenditures, media coverage, and consumer surveys, the court stated that the red outsole had acquired secondary meaning or distinctiveness as a "symbol" only when contrasted with the upper part of the shoes: "[I]t is the *contrast* between the sole and the upper that causes the sole to 'pop,' and to distinguish its creator."<sup>115</sup> In emphasizing such contrast, and thereby highlighting the Red Sole Mark in the context of the overall shoe design, the court implicitly incorporated the trade dress analysis from *Wal-Mart*. With the issue of the particular mark's functionality still somewhat unresolved, the case was remanded to the district court.<sup>116</sup> The following Section supports and expands upon the Second Circuit's general holding that single-color trademarks within the fashion industry may be protected.

*B. Trend Setting: Clarifying Arguments in Favor of Protection of Single-Color Fashion Trademarks*

*Louboutin* provides a springboard for discussing the possibility of granting the fashion industry increased intellectual property protection through trademark and trade dress laws; this Section offers support for the Second Circuit's holding. First, the broad definition of trademark, as intended by Congress and applied by the Supreme Court in *Qualitex* and *Wal-Mart*, affords protection for valid trademarks within the fashion industry. Second, with respect to the statutory requirement of distinctiveness, the fashion industry's "swift cycle of innovation"<sup>117</sup> highlights those rare instances in which a single color serves to identify a product's source beyond a mere seasonal trend. Third, the often-lethal functionality doctrine should be narrowly applied, to allow for the reality that fashion marks often serve equally significant aesthetic and source-identifying roles.

1. Honoring the Lanham Act's Broad Definition of Trademark

One theme remains constant throughout the evolution of U.S. trademark law: Congress has continually expanded the definition of trademark.<sup>118</sup> Under the Trademark Act of 1905, federal registration

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115. *Id.* at 227.

116. *Id.* at 229.

117. Raustiala & Sprigman, *supra* note 12, at 1691.

118. *See* Moir, *supra* note 20, at 409 (chronicling congressional amendments altering the definition of the term trademark).

was only available to arbitrary or fanciful words or symbols.<sup>119</sup> The Lanham Act eliminated this restrictive definition in 1946 and replaced it with the broad construction of “any word, name, symbol, or device, or any combination thereof.”<sup>120</sup> This expansive definition is repeated in additional sections of the Act: “No trademark . . . shall be refused registration on the principal register on account of its nature” unless specific enumerated exceptions apply.<sup>121</sup> Further, Congress reiterated the all-encompassing definition of trademark in a Senate Judiciary Report regarding the Trademark Law Revision Act of 1988, stating it “intentionally retain[ed] . . . the words ‘symbol or device’ so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks.”<sup>122</sup>

Courts generally adhere to this broad definition.<sup>123</sup> In *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, the Supreme Court stated, “Congress determined that a sound public policy requires that trademarks should receive nationally the *greatest* protection that can be given them.”<sup>124</sup> Specifically regarding single-color marks, courts adopted an expansive definition in multiple cases.<sup>125</sup> In *Qualitex*, for instance, the defendant argued that under pre-1946 precedent, color alone did not warrant trademark protection.<sup>126</sup> In response, the Court insisted that such cases were irreconcilable with Congress’s enactment of the Lanham Act and liberalization of trademark law.<sup>127</sup> With regard to clothing design, the Supreme Court again emphasized the “breadth of the definition of marks” in *Wal-Mart*, stating that unregistered clothing design could constitute valid trade dress upon a showing of secondary meaning.<sup>128</sup>

The above legislative history and judicial opinions do not categorically deny protection to single-color trademarks within any particular industry. Rather, as the Second Circuit found in *Qualitex*, the Supreme Court specifically forbade implementation of a per se

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119. Trademark Act of 1905, Pub. L. No. 58-84, 33 Stat. 724 (repealed 1946); Moir, *supra* note 20, at 409.

120. 15 U.S.C. § 1127 (2006).

121. *Id.* § 1052.

122. *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993) (quoting S. REP. NO. 100-515, at 44 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5607) (alteration in original) (emphasis added).

123. *See supra* Part II.A (describing the Supreme Court’s adoption of a broad definition and describing ways in which this construction has been applied).

124. 469 U.S. 189, 193 (1985) (quoting S. REP. NO. 79-1333, at 6 (1946)) (emphasis added).

125. *See supra* Part II.B.2.

126. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170–71 (1995).

127. *Id.* at 171.

128. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209, 216 (2000).

rule that would deny protection for the use of a single color as a trademark in the context of a particular industry.<sup>129</sup> Assuming a single-color mark identifying a fashion brand is both distinctive (i.e., it has acquired secondary meaning within the marketplace) and nonfunctional, nothing about the fashion industry itself should exclude such a mark from protection under the Lanham Act.

## 2. Color Cutting Across Seasons: Support for Secondary Meaning

Each season, a designer creates a fashion line around a particular color theme.<sup>130</sup> While some designers choose their “color story” based on inspiration,<sup>131</sup> most rely on trend forecasts, which create a somewhat mainstream scheme for a given season.<sup>132</sup> Most colors cycle in and out of fashion; that is, designers rarely use a specific color with such consistency as to make it indicative of the brand. The rarity with which this actually occurs illuminates the need for protection for the instances in which it does.

The Supreme Court reiterated intellectual property law’s default rule in *TrafFix Devices*: “[U]nless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.”<sup>133</sup> Some scholars argue that the fashion industry’s success and constant innovation are based somewhat on this general freedom to copy.<sup>134</sup> The reasoning behind this argument is that heightened intellectual property protection (at least with regard to copyright) would actually retard the production of new trends.<sup>135</sup> Originators

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129. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 218 (2d Cir. 2012).

130. GINI STEPHENS FRINGS, *FASHION: FROM CONCEPT TO CONSUMER* 228 (9th ed. 2007).

131. EVELYN L. BRANNON, *FASHION FORECASTING* 156 (2d ed. 2005).

132. FRINGS, *supra* note 130, at 228; *see also* STEVEN BLEICHER, *CONTEMPORARY COLOR THEORY & USE* 32–33 (2005) (discussing the widespread use of color forecasting within the fashion industry). The Pantone Color Institute, a research group created by Pantone LLC, studies seasonal color trends, providing those in the fashion industry with a summary of colors used by top designers. *See Pantone Fashion Color Report Fall 2012*, PANTONE, <http://www.pantone.com/pages/fcr.aspx?pg=20948&ca=4&from=hpfeatures> (last visited Feb. 21, 2012).

133. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001).

134. *See Raustiala & Sprigman, supra* note 12, at 1689 (“[F]ashion firms continue to innovate at a rapid clip, precisely the opposite behavior of that predicted by the standard theory.”); *see also TrafFix*, 532 U.S. at 29 (reasoning that allowing competitors to copy in some instances will lead to significant advances and innovations); *Cotropia & Gibson, supra* note 5, at 957 (“Fashion’s low-IP status causes trends to cycle in and out more quickly, which increases the demand for new fashions, which means more innovation and a greater supply of fashion goods than would occur in the absence of unregulated copying.”).

135. *See Raustiala & Sprigman, supra* note 12, at 1727–28 (arguing copying promotes innovation and benefits originators). *But see Cotropia & Gibson, supra* note 5, at 958 (“This is not

would have no incentive to create new designs if downstream copying, which makes a particular design widely available, was prohibited.<sup>136</sup>

While these arguments seem logical as they pertain to ephemeral trends, their reasoning is not applicable to instances in which an identifying use of color has acquired distinctiveness in consumers' minds due to its use season after season—like Louboutin's red outsole.<sup>137</sup> Such consistent use across products and throughout seasons does not constitute a trend, and there is therefore no benefit to the fashion industry's "swift cycle of innovation" when trademark protection is denied in these cases.<sup>138</sup> Consistent use across seasons augments the argument that the use of color has obtained secondary meaning—especially when contrasted with the majority of short-lived, single-season color trends.<sup>139</sup> This determination of whether a color has acquired secondary meaning appears relatively straightforward when compared to the analysis required under the doctrine of functionality.

### 3. Fashion and Function

As illustrated by the district court's holding in *Louboutin v. Yves Saint Laurent*, owners of single-color fashion marks face their

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to say that everyone in the industry would be worse off in the presence of strong intellectual property rights. Leading designers in particular might do better if the fashion cycle were slower, as they could increase their share of industry proceeds by licensing a single design . . ."). This difference in reasoning among those presumably arguing for low-IP protection in the fashion industry further augments the lack of concrete bases against heightened protection.

136. Scafidi offers the following analysis:

[T]he cycle begins when high-status individuals or early adopters acquire an item. That item becomes a social signaling device, provoking demand among lower status individuals or outsiders who wish to emulate and perhaps interact with the original purchasers. As more consumers purchase the item, however, it loses its signaling value. This loss of value may be further exacerbated by third-party production of knockoffs, which make a version of the item accessible and affordable to still more aspirational consumers. Thus, the original individuals move on to new expensive or rare objects of desire in order to differentiate themselves, and a fashion cycle is complete.

See Scafidi, *supra* note 3, at 125.

137. Louboutin has been painting the bottom of his soles red since 1992. Such a practice in no way can be considered a mere seasonal trend. See *supra* Part III.A.

138. Raustiala & Sprigman, *supra* note 12, at 1691.

139. In *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, though denying protection due to functionality, the Sixth Circuit acknowledged "the reality of the clothing industry" in finding that seasonal designs were "simply a reaction to seasonal changes." 280 F.3d 619, 633 n.11 (6th Cir. 2002). This willingness to consider seasonal designs eligible for trade dress protection further supports a finding of secondary meaning in cases where such design features (e.g., color) *do not* change with each passing season.

greatest obstacle in overcoming the doctrine of functionality.<sup>140</sup> The Second Circuit's reluctance to apply its own functionality analysis to Louboutin's Red Sole Mark further confirms the complexity of this inquiry. The Supreme Court aptly stated this point in *Qualitex*: "The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature."<sup>141</sup>

In *TrafFix Devices*, the Supreme Court articulated an additional policy reason behind the functionality doctrine: to prevent trademark law from serving as a backdoor method of perpetual protection once the more limited protection of patent law (or similarly, copyright law) expires.<sup>142</sup> While this concern is not unwarranted, as trademarks may be potentially afforded perpetual protection,<sup>143</sup> the Lanham Act's "use in commerce" requirement serves as a safeguard against such an eternal monopoly.<sup>144</sup> The nature of the fashion industry dovetails with this "use in commerce" requirement. Since the fashion industry and consumers rapidly dispose of trends, and sometimes even brands in their entirety, it is unlikely that any brand will remain popular with consumers forever. It is therefore improbable that a single-color trademark will remain "in commerce" eternally.

As discussed above in Section II.B.2, the functionality doctrine is commonly subdivided into utilitarian functionality and aesthetic functionality.<sup>145</sup> This Section begins by analyzing the more uniformly applied doctrine of utilitarian functionality. The rest of the Section is devoted to the courts' divergent treatment of the doctrine of aesthetic functionality, focusing on its application to color and fashion design.

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140. See *supra* Part II.B.2 for a discussion of the burden of proof with regard to functionality.

141. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995); see also *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1339 (Fed. Cir. 1982) (arguing that an owner's right to protect a product feature is limited by "the need to copy . . . [articles which are not protected by patent or copyright], which is more properly termed the right to compete *effectively*" (emphasis added)); Mitchell M. Wong, Note, *The Aesthetic Functionality Doctrine and the Law of Trade-Dress Protection*, 83 CORNELL L. REV. 1116, 1131-32 (1998) ("The rationale behind the functionality doctrine is that the public interest in certain inventions or designs outweighs an individual's right to use those inventions or designs as indicators of a product's source.").

142. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001) ("The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.").

143. See 15 U.S.C. §§ 1058-59 (2006) (stating that registration remains in force for ten years and may be renewed for successive ten-year terms upon showing of continued use in commerce).

144. See *id.* § 1127 (stating that the source of trademark protection lies in the use or intent to use in commerce).

145. See *TrafFix*, 532 U.S. at 33 (outlining the standards under both subdoctrines).

*a. Utilitarian Functionality*

Single-color fashion marks and their incorporation into a product's design do not likely face invalidation due to utilitarian functionality. A mark owner's successful demonstration that the feature in question is "merely an ornamental, incidental, or arbitrary aspect of the device" will overcome this facet of the functionality doctrine.<sup>146</sup> Colors are primarily used in the fashion industry as arbitrary embellishments.<sup>147</sup> However, there are some examples in which fashion marks would be denied protection under the doctrine of utilitarian functionality. One of these rare instances would occur when an individual seeks to register a trademark or attain trade dress protection for the natural color of leather.<sup>148</sup> The natural color of leather (or any other material, for that matter) is a functional attribute of the product. Thus, color in this instance may not serve as a trademark or trade dress element because allowing such would grant exclusive use of that leather in its natural color to the mark owner and would render it inaccessible to the rest of the market. An individual would be equally unsuccessful in an attempt to monopolize black or dark colored outsoles on footwear; such colors provide the utilitarian function of diminishing the shoes' "wear and tear" and therefore affect the product's quality.<sup>149</sup>

The Southern District of New York initially stated that Louboutin's use of red on the shoe's outsole constituted an instance of utilitarian functionality in that it "affects the cost of the shoe."<sup>150</sup> While consumers are no doubt willing to pay a higher price for items bearing luxury brand insignia, this interpretation of the functionality doctrine appears to be inconsistent with the doctrine envisioned by judicial precedent.<sup>151</sup> In *LeSportSac, Inc. v. K Mart Corp.*, the Second

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146. *Id.* at 30.

147. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1124 (Fed. Cir. 1985).

148. *See Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993) ("[I]f color is essential to the utility of a product or is the natural color of the product, then no party may acquire exclusive trademark rights in that feature or color.").

149. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995) (stating that trademark registration of color alone requires that the color not be functional); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1982) ("[A] product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.").

150. *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 454 (S.D.N.Y. 2011), *aff'd in part, rev'd in part sub nom.* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012); *see also supra* Part III.A (providing a more detailed explanation of the court's reasoning).

151. *See, e.g., TrafFix*, 532 U.S. at 33–34 (reiterating the functionality doctrine). In its analysis of utilitarian functionality, the Southern District of New York explicitly notes its departure from precedent. *Louboutin*, 778 F. Supp. 2d at 454.

Circuit interpreted the “effect on cost” element of utilitarian functionality to refer to a design feature that permits the product to be manufactured at a *lower* cost.<sup>152</sup> Applying a foreign color (such as a specific shade of red) to a piece of clothing or accessory (such as the outsole of a shoe) makes a product *more* costly to produce. Despite the district court’s argument that this “effect on cost” benefits luxury fashion designers,<sup>153</sup> the ability to charge higher prices does not derive primarily from the increase in manufacturing costs. Rather, the ability to charge such a premium stems predominantly from the notions of luxury and exclusivity created by high-fashion brands such as Louboutin. This consumer desire to be associated with single-color marks such as Louboutin’s Red Sole Mark augments the distinctiveness fashion marks can acquire and, therefore, reiterates their function as valid source identifiers.

On appeal, the Second Circuit paid little attention to the doctrine of utilitarian functionality.<sup>154</sup> It did not address the district court’s arguments that the Red Sole Mark was functional because it “affected the cost” of the product or, more specifically, that it allowed Louboutin to charge a premium.<sup>155</sup> However, in its brief treatment of the subdoctrine, it directly quoted the language from *LeSportSac*: a feature “affects the cost or quality of the article ‘where it permits the article to be manufactured at a lower cost.’”<sup>156</sup> By including such language, the Second Circuit implicitly rejected the district court’s earlier interpretation.

While utilitarian functionality may pose a surmountable threat to a designer seeking trademark or trade dress protection for a single-color design, the fashion industry’s dedication to and reliance on aesthetic appeal presents an additional, and even more challenging, obstacle.

### *b. Aesthetic Functionality*

With minimal guidance from the Supreme Court, lower courts continue to grapple with the doctrine of aesthetic functionality and

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152. *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 76 (2d Cir. 1985) (quoting *Warner Bros. v. Gay Toys, Inc.*, 724 F.2d 327, 331 (2d Cir. 1983)).

153. *Louboutin*, 778 F. Supp. 2d at 454.

154. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 219 (2d Cir. 2012).

155. *Louboutin*, 778 F. Supp. 2d at 454.

156. *Louboutin*, 696 F.3d at 219 (citing *LeSportsac*, 754 F.2d at 76).

have created divergent and inadequate tests.<sup>157</sup> While it is unlikely that a standardized approach will ultimately emerge, as the analysis varies depending on the specific facts of each case and the competitive needs of each consumer market, a more uniform understanding of the doctrine is crucial. This is especially true for the issue at hand because single-color marks are frequently denied protection due to their aesthetic functions. Additionally, the fashion industry's focus on aesthetic appeal presents a further obstacle with regard to this subdoctrine: fashion marks more often than not attract consumers both because of their pleasing looks and their identifications of a coveted brand or source.

This Section begins with an analysis of the theory of color depletion, the argument most commonly asserted against protection of single-color marks. Next, it surveys the various approaches courts have taken in evaluating the non-reputation-related purposes of color marks, taking into account the need to incentivize and protect the creation of aesthetically pleasing marks. While innovation in the fashion industry is dependent on a designer's access to a sufficient color palette with which to "paint," such creative need must be balanced with the underlying policies of trademark law.

#### i. Color Depletion: Not a *Significant* Hindrance to Competition

Using the Second Circuit's formulation of the aesthetic functionality doctrine, protection of one particular color on one part of a product does not " 'significantly undermine competitors' ability to compete in the relevant market."<sup>158</sup> While color depletion is not a per se claim of functionality,<sup>159</sup> the theory nonetheless remains relevant within the functionality framework, particularly for industries such as fashion, which rely so heavily on color.

The color depletion theory cautiously posits, "[I]f one of many competitors can appropriate a particular color for use as a trademark,

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157. See McKenna, *supra* note 76, at 824 ("Some courts refuse to recognize the aesthetic functionality doctrine at all, and some courts that do recognize it are often reluctant to actually find the features at issue functional, even when exclusive use of those features seems very likely to put competitors at a significant, non-reputation-related disadvantage."); see also *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1068 (9th Cir. 2006) ("The results reached in these various aesthetic functionality cases do not easily weave together to produce a coherent jurisprudence, although as a general matter courts have been loathe to declare unique, identifying logos and names as functional."); Moir, *supra* note 20, at 430 (stating that many federal courts and the TTAB seem to reject, or at least question, the doctrine on the grounds that it disincentivizes the creation of visually pleasing marks).

158. *Louboutin*, 696 F.3d at 222.

159. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 168–69 (1995) (noting that, if color depletion were to arise, the functionality doctrine would *seem* to be available).

and each competitor then tries to do the same, the supply of colors will soon be depleted.”<sup>160</sup> Complicating this matter, “[t]he effect on competition is not a function of the range of designs that are physically or conceptually possible; it is instead determined by the number of alternative designs that would be accepted by consumers as reasonable substitutes.”<sup>161</sup> However, these legitimate worries are alleviated when one considers the almost infinite choice of colors available and the accepted practice of claiming only one specific shade when creating source-identifying symbols. Considering the seasonal use of most colors within the fashion industry, it is difficult to foresee a time when designers will have claimed trademark or trade dress rights to every imaginable color.

Anyone who has ever painted a room can attest to the infinite and overwhelming range of paint-chip colors. The same holds for the fashion industry—where new technologies in color dyeing lead to an ever-increasing number of colors available for use.<sup>162</sup> Although it is true that not every hue will appeal to consumers, demand is largely dictated by what popular brands (not customers) designate to be “in” for a given season. Therefore, the range of colors at a designer’s disposal is not limited in this way. Additionally, registration of a mark only minimally decreases access to color, as typically an applicant applies for protection of a specific shade.<sup>163</sup> The Pantone Color System, a commercial system that designates shades numerically and assists a variety of creative and technological industries, is particularly useful for those wishing to trademark a single color.<sup>164</sup>

In *Louboutin*, the district court worried that protecting Louboutin’s Red Sole Mark would usher in a “specter of fashion wars” in which designers would stake claim to colors, ultimately resulting in

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160. *Id.* at 168.

161. McKenna, *supra* note 76, at 846–47; *see also Qualitex*, 514 U.S. at 168 (“[I]n the context of a particular product, only some colors are usable. By the time one discards colors that, say, for reasons of customer appeal, are not usable . . . then one is left with only a handful of possible colors.”).

162. In *DAP Products, Inc. v. Color Tile Manufacturing, Inc.*, 821 F. Supp. 488, 495 (S.D. Ohio 1993), the court rejected the theory of color depletion due to the fact that modern technology has exponentially increased the number of different colors available. *See also Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 225 (8th Cir. 1993) (“It is highly improbable that every distinguishable color shade has already been selected and would be subject to trademark protection.”).

163. *See* Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 776 (2005) (noting that descriptive imprecision tends to create enforcement difficulties).

164. *Id.* at 778–79; *see also* PANTONE, <http://www.pantone.com/pages/pantone/index.aspx> (last visited Jan. 16, 2013) (advertising color-precision services).

depletion.<sup>165</sup> While the above arguments indicate that this outcome is unlikely, merely taking into account the fashion industry's ordinary use of color as specific to one season or one ephemeral trend makes it outright unfathomable.

The Eighth Circuit addressed color depletion in *Master Distributors, Inc. v. Pako Corp.* Refusing to adopt a per se rule against trademarking color, the court cabined the reach of the color depletion theory: "Until secondary meaning has been established in every distinguishable shade of color and in no color at all, a highly improbable situation, there will always be an option available to a new market entrant."<sup>166</sup> Color depletion in the fashion industry seems unlikely due to the fact that acquiring secondary meaning for a particular color is extremely difficult.<sup>167</sup> Because most colors are associated with seasonal trends, rather than consistently utilized to indicate a particular source, this negative effect on competition does not seem like a legitimate threat.<sup>168</sup>

The Second Circuit did not explicitly comment on the color depletion argument in *Louboutin*. However, the court's formulation of an aesthetic functionality doctrine that allows competitors sufficient options to compete within a given market, rather than allowing them the greatest range of choices,<sup>169</sup> evidences its lack of reliance on this argument. The court understood that the protection of one particular color on one part of a product does not "significantly undermine[] competitors' ability to compete in the relevant market."<sup>170</sup>

With respect to the related issue of shade confusion, courts generally disregard this argument on the grounds that the issue is no more burdensome on courts than the likelihood-of-confusion analysis required for more traditional word marks.<sup>171</sup> Further, expert witnesses are available to testify regarding similarity of colors.<sup>172</sup>

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165. *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 457 (S.D.N.Y. 2011), *aff'd in part, rev'd in part sub nom.* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012).

166. *Master Distribs.*, 986 F.2d at 223.

167. *See supra* Part III.B.2 (noting that the acquisition of secondary meaning in the fashion industry requires the color to be used for much longer than the typical period of one season or fashion cycle).

168. *See supra* Part III.B.2 (highlighting the dual role of colors both as components of seasonal designs and as source identifiers).

169. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 223–24 (2d Cir. 2012).

170. *Id.* at 222.

171. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 167 (1995).

172. *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 223–24 (8th Cir. 1993).

In conclusion, while color is in many respects the “lifeblood” of the fashion industry, a “specter of fashion wars” is an unlikely consequence of granting protection to deserving brands.

ii. Marks that Are Equally Aesthetically Pleasing and Source Identifying

A product attribute is not aesthetically functional simply because it serves both ornamental and source-identifying purposes.<sup>173</sup> While courts generally agree on this, the degree to which a particular mark or product design may serve an aesthetic purpose is a point of contention among the circuits.<sup>174</sup> Fortunately, the evolution of the doctrine exhibits a gradual relaxation—an understanding that consumer appeal and commercial success do not automatically render a mark or design feature aesthetically functional. As initially formulated, the doctrine of aesthetic functionality invalidated a mark or design that was an “important ingredient” to the commercial success of the product.<sup>175</sup> This formulation permitted use of the feature in the interest of free competition.<sup>176</sup> Under this original standard, fashion marks and designs would face an almost invariable fate of invalidation since consumers at least in part choose a particular article of clothing because of “the look.” Today, such a fate has been somewhat alleviated by the modern necessary-for-effective-competition test, which the Supreme Court applied in *Qualitex*: a mark is functional if “exclusive use of the feature would put competitors at a *significant* non-reputation-related disadvantage.”<sup>177</sup>

Notwithstanding this trend of relaxation, single-color marks within the fashion industry still face heightened scrutiny due to their aesthetic appeal and the fact that color largely serves an ornamental purpose within the industry. In order to constitute a valid trademark

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173. See *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 76–78 (9th Cir. 1985) (noting that source-identifying features on a bag may be nonfunctional even if the bag is purchased because of its aesthetic features and its aesthetic features contribute to its commercial success); *In re Paramount Pictures Corp.*, 217 U.S.P.Q. 292, 293 (T.T.A.B. 1983) (“[T]he Lanham Act does not exclude registration of a mark simply because it has an ornamental as well as a source-indicating purpose.”).

174. *Compare SK&F, Co. v. Premo Pharm. Labs., Inc.*, 625 F.2d 1055, 1063 (3d Cir. 1980) (“Proof of nonfunctionality generally requires a showing that the element of the product serves no purpose other than identification.”), *with Publ’ns Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 339 (7th Cir. 1998) (“[I]f consumers derive a value from the fact that a product looks a certain way that is distinct from the value of knowing at a glance who made it, then it is a nonappropriable feature of the product.”).

175. *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952).

176. *Id.*

177. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (emphasis added).

or trade dress, a single color's value to consumers must derive sufficiently from its ability to identify a particular source.<sup>178</sup>

Courts have long acknowledged the difficulty in applying this doctrine and the inability to create a bright-line rule due to its context-specific nature:

Since the line distinguishing between mere ornamentation and ornamentation which is merely an incidental quality of a trade-mark is not always clearly ascertainable, the application of legal principles to fit one situation or the other requires proper reflection upon the impression likely to govern the ordinary purchaser in the market place. For that reason, the merits of each case of the character here presented must be individually and accordingly adjudged.<sup>179</sup>

In *Automotive Gold, Inc. v. Volkswagen of America, Inc.*, the Ninth Circuit acknowledged the “somewhat checkered history” of the doctrine of aesthetic functionality.<sup>180</sup> Refusing to uphold declaratory relief for a maker of car accessories bearing exact replicas of Volkswagen and Audi marks, the court warned that if left unfettered, the aesthetic functionality doctrine could serve as a defense to infringement when a mark constitutes the actual benefit the consumer desires.<sup>181</sup> Additionally, the court distinguished between logos or insignia, which generally have no function apart from their association with a trademark owner (e.g., extrinsic aesthetic appeal), and certain shapes or “uses of color,” which have intrinsic appeal independent of an ability to identify a source.<sup>182</sup>

Within the fashion industry, color holds a great deal of intrinsic aesthetic value. For example, if demand exists for red-soled shoes

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178. See, e.g., *LeSportsac*, 754 F.2d at 78 (reasoning that a mark is nonfunctional even if its aesthetic features are also an important ingredient in the product's commercial success). In other words, the consumer demand for the product must derive from the secondary meaning the mark owner has cultivated through the consumer's use of the mark as a source identifier. Landes and Posner provide a detailed explanation of the theory behind aesthetic functionality:

A more attractive mark is equivalent to a higher-quality good. So while a strong trademark increases the price that consumers are willing to pay for the good by lowering search costs, an attractive trademark raises price by increasing the utility that consumers get from the good once they have bought it. Because a more attractive mark will usually be more expensive to produce, the firm will invest in such a mark only if it is rewarded by obtaining a higher price for each unit of the trademarked good that it sells. And the higher the price, the more units the firm will produce. Thus, the effect of giving the attractive trademark legal protection is to increase both the quality and quantity of output, thereby benefiting consumers, rather than to reduce output by raising rivals' costs, as in the case of utilitarian functionality.

Landes & Posner, *supra* note 21, at 296.

179. *In re Swift & Co.*, 223 F.2d 950, 954 (C.C.P.A. 1955).

180. *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1064 (9th Cir. 2006).

181. *Id.* The Ninth Circuit referred to this reading of the aesthetic functionality doctrine as the “death knell for trademark protection,” as it would mean that just because a consumer likes a mark or finds it attractive, competitors could freely adopt it. *Id.*

182. *Id.* at 1073.

unrelated to the reputation developed by Louboutin, the product feature would be deemed functional.<sup>183</sup> However, if the desire to own such shoes is “tied to the reputation and association” with the brand, signifying luxury and a chic lifestyle, the color serves a source-identifying purpose.<sup>184</sup> Here lies the issue: some consumers covet a product because the color mark is aesthetically appealing, others desire the same product because the color mark represents a particular source, and still others purchase such a product because the color mark is aesthetically appealing and simultaneously indicates a specific source. Under a strict interpretation of the functionality doctrine, a court would invalidate the Red Sole Mark because it serves an aesthetic purpose, regardless of its source-identifying functions.

In *Vuitton et Fils S.A. v. J. Young Enterprises, Inc.*, the Ninth Circuit held that Louis Vuitton’s trademark was nonfunctional, despite the mark’s contribution to the commercial success of the product.<sup>185</sup> It reasoned that a trademark that contributes to the commercial success of a product is not aesthetically functional if such success derives from the mark’s ability to indicate the product’s source.<sup>186</sup> Under this construction, the aesthetic appeal the mark confers is merely incidental to its source-identifying function.<sup>187</sup> In analyzing functionality, the court offered a helpful formulation:

If a group of consumers who had never heard of Louis Vuitton were choosing between Vuitton goods and similar goods . . . would the consumers tend to choose the Vuitton good or would they have any utilitarian reason for doing so? If the Vuitton mark increases consumer appeal only because of the quality associated with Vuitton goods, or because of the prestige associated with owning a genuine Vuitton product, then the design is serving the legitimate function of a trademark.<sup>188</sup>

Thus, according to *Automotive Gold* and *Vuitton*, as a matter of law, a product feature is not functional merely because it contributes to consumer appeal and saleability. This formulation of the doctrine is crucial for the survival of single-color marks within the fashion industry.

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183. Using the words iterated by the Supreme Court in *Qualitex*, there would have to be a “significant non-reputation-related advantage.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

184. *Au-Tomotive Gold*, 457 F.3d at 1074.

185. *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 773 (9th Cir. 1981).

186. *Id.* at 776.

187. *Id.* at 775; see also *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 643–44 & n.18 (6th Cir. 2002) (quoting *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 346 (7th Cir. 1985)) (reasoning that a trade dress attribute is nonfunctional if it is “the kind of merely incidental feature which gives the brand some individual distinction” (emphasis added)).

188. *Vuitton et Fils S.A.*, 644 F.2d at 776.

Further supporting a narrow reading of the doctrine of aesthetic functionality is the fact that most trademarks are initially chosen for the very reason that they are pleasing to consumers.<sup>189</sup> A strict application of this subdoctrine cuts against the broad definition of a trademark articulated in the Lanham Act. It would disincentivize the creation of attractive marks and could work to punish those who create attractive and commercially successful marks, such as Louboutin.<sup>190</sup>

Various circuits have argued for a narrower application of the aesthetic functionality doctrine. For example, in *Keene Corp. v. Paraflex Industries, Inc.*, the Third Circuit held that the design of a wall luminaire was functional due to limited alternatives.<sup>191</sup> Nonetheless, the court called for protection of “imaginative and attractive design” as to continue to encourage the “spark of originality which could transform an ordinary product into one of grace.”<sup>192</sup>

This need to protect “imaginative design” carries heightened significance for trademarks within the fashion industry due to the fact that aesthetics are fundamental to a consumer’s choice of what to wear.<sup>193</sup> Therefore, a balance must be reached between requiring that marks sufficiently identify source, so as to not disadvantage competition, and continuing to encourage the creation of appealing marks by offering protection against infringement.<sup>194</sup> The following Part will focus predominantly on formulating the inquiry of aesthetic functionality to adequately serve the unique demands of the fashion industry, because that doctrine is the greatest obstacle to protection under the Lanham Act.

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189. See Landes & Posner, *supra* note 21, at 295 (noting that the producer of a consumer product will never deliberately “uglify” the product).

190. See 1 MCCARTHY, *supra* note 58, § 7:80 (citing *In re DC Comics, Inc.*, 689 F.2d 1042, 1053 (C.C.P.A. 1982) (Nies, J., concurring)) (“No principle of trademark law required the imposition of penalties for originality, creativeness, attractiveness, or uniqueness of one’s product.”).

191. *Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 827–28 (3d Cir. 1981).

192. *Id.* at 825.

193. See *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 340 (7th Cir. 1985) (“In an age when fashion-conscious consumers wear t-shirts emblazoned with the trademarks of consumer products . . .”).

194. The Second Circuit pays lip service to this crucial balance: “[I]n determining whether a mark has an aesthetic function so as to preclude trademark protection, we take care to ensure that the mark’s very success in denoting (and promoting) its source does not itself defeat the markholder’s right to protect that mark.” *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012) (citing *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 80 (2d Cir. 1990)).

## IV. A TAILORED LOOK

Although the definition of a trademark encompasses a wide variety of source-identifying symbols and devices, designers face various obstacles in their attempts to attain and later maintain protection of their single-color marks. The fashion industry's fundamental reliance on color and aesthetically appealing designs complicates the analysis of a trademark's or trade dress's distinctiveness and nonfunctionality.<sup>195</sup> While the preservation of creative options is crucial to free competition and to the future of the fashion industry in general, such a concern should not overshadow those instances in which single-color fashion marks have genuinely acquired secondary meaning and are nonfunctional.

This Part proposes a flexible inquiry into the validity of a fashion mark. Because consumers more often than not select a fashion product based *equally* on aesthetic appeal and association with a particular brand, the crux of this solution lies with a relaxation of the aesthetic functionality doctrine. This Part begins by suggesting that mark owners limit the scope of their single-color marks to avoid a court's modification similar to that in *Louboutin*. It then offers a form of functionality analysis that better balances the competing interests of mark owners and competitors.

*A. Limiting the Scope of the Mark*

Since designers usually use a particular color or design for only a given season, most uses of color within the fashion industry would fail to acquire secondary meaning in the minds of consumers.<sup>196</sup> Such ephemeral glimpses of a given color or design do not rise to the level of the consistent use needed to establish secondary meaning.<sup>197</sup> Affording trademark protection in the rare occasion in which a designer has maintained the use of a specific color across seasons does not significantly affect creative liberty or competition.

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195. In regard to clothing designs seeking trade dress validity, the Supreme Court had "little confidence that a reasonably clear test can be devised." *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213 (2000).

196. *Cf. Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938) (noting that a long period of time was required in order for consumers to attribute a secondary meaning to "Shredded Wheat").

197. *See, e.g., Mktg. Displays, Inc. v. Traffix Devices, Inc.*, 200 F.3d 929, 937 (6th Cir. 1999) (arguing that "exclusivity, length, and manner of use" must be considered in determining whether secondary meaning has been achieved), *rev'd on other grounds*, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

Turning to the requirement of nonfunctionality, limiting the scope of a single-color mark is essential to a trademark owner's ability to gain and maintain protection.<sup>198</sup> In other words, sustained trademark protection for single-color marks relies on limiting the trademark's scope to that which is completely necessary to cover a designer's intended uses on products. The broader and less defined the mark, the more likely a particular mark will be held to be functional and therefore "unprotectable" under trademark law.<sup>199</sup> For example, in *Jay Franco & Sons, Inc. v. Franek*, a trademark for a circular beach towel—a basic shape and thus a very broad claim—significantly hindered competition and was therefore found to be functional.<sup>200</sup> It follows that a fashion brand seeking to trademark a single color must limit the scope of the mark by limiting it to a specific color, a specific medium, and a specific market.

Because the threat of color depletion is commonly asserted against protection of single-color marks, a mark owner must claim ownership of a particular shade.<sup>201</sup> This can be achieved by claiming a recognized numerically identified color from the Pantone Color System. Doing so "depletes" the available colors by only one shade of a particular color. Claiming use of the color on a particular medium, such as the outsole of a high-heeled shoe, further diminishes the threat of color depletion (and thereby decreases the chances of a finding of invalidity) due to the fact that competitors are free to use that particular shade on all parts of their products other than that protected by the trademark.<sup>202</sup> Lastly, the market in which the single-color trademark exists should be narrowly defined (for example, as women's high-fashion, high-heeled shoes) as the fashion industry is highly segregated into submarkets by price points, product types, and target consumers.<sup>203</sup>

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198. See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997) (reversing preliminary injunction because plaintiff had not articulated and supported its claimed inherently distinctive trade dress with sufficient particularity).

199. See *id.* ("[A] plaintiff's inability to explain to a court exactly which aspects of its product design(s) merit protection may indicate that its claim is pitched at an improper level of generality, i.e., the claimant seeks protection for an unprotectable style, theme or idea.").

200. *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 860 (7th Cir. 2010).

201. See *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 454 (S.D.N.Y. 2011) ("Louboutin's claim to 'the color red' is, without some limitation, overly broad and inconsistent with the scheme of trademark registration established by the Lanham Act.").

202. Courts have previously upheld such positional uses of color. See, e.g., *Keds Corp. v. Renee Int'l Trading Corp.*, 888 F.2d 215, 221 (1st Cir. 1989) (upholding protection of blue rectangle placed on canvas shoes); Registration No. 2,851,315 (red longitudinal heel stripe of Prada S.A.).

203. 3 LOUIS ALTMAN & MALLA POLLACK, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 19:79 (4th ed. 2003) ("[F]unctionality . . . is not to be determined within the

*B. Balancing “Buying the Brand” and “Buying the Look”*

As evidenced by Christian Louboutin’s initial decision to add the color red to the outsoles of his shoes, a given color can say a lot. In addition to signifying its source, a specific color can give a product energy, while another may make a product more refined, and yet another may suggest a look of understatedness or neutrality.<sup>204</sup> Analysis of a fashion mark’s aesthetic functionality begins with the acknowledgement that the fashion industry presents a unique conundrum: with any given article of clothing, pair of shoes, or accessory, some consumers decide to buy the item because the color mark makes the product aesthetically appealing, while other consumers decide to buy the item because the color mark identifies a particular brand with which such consumers desire to be associated. These non-reputation-related and source-identifying purposes are equally significant and thus suggest that the fashion industry needs its own version of the aesthetic functionality doctrine. Under the traditional aesthetic functionality analysis, a court concludes that a mark is functional, and therefore invalid, if these consumer preferences are in equipoise; policy dictates that competition is hindered by a monopoly over aesthetically pleasing features, and therefore trademark law denies protection to such features. However, an optimal solution would not automatically invalidate such marks due to their simultaneous roles, but rather would implement a more industry-specific balancing of consumer decisions and competitive costs.

The easy cases would benefit from a more lenient functionality standard similar to that utilized by the Ninth Circuit in *Vuitton et Fils*.<sup>205</sup> For example, the standard could be presented as the following test: “If Fashion Brand X’s single-color mark or identifying use of color increases consumer appeal only because of the quality associated with Brand X’s goods, or because of the prestige associated with owning a genuine Brand X product, then the single-color mark or identifying use of color is serving a legitimate function of a trademark.”<sup>206</sup> This strikes a balance by affording protection to those rare marks that satisfy this high bar (thereby incentivizing future creation of highly

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broad compass of different but interchangeable products; the doctrine of functionality is intended to preserve competition within the narrow bounds of each individual product market.”).

204. See *supra* Part III.A (detailing what Louboutin thought the color red added to his shoes).

205. *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 776 (9th Cir. 1981).

206. *Id.*

successful and aesthetically pleasing marks), while simultaneously preserving creative sources and ongoing competition.

The more difficult cases, in which a mark's value is equally attributable to its aesthetic appeal and association with a specific source, would require the court to balance the needs of competitors with those of the mark owner. This balancing test would take into account what drives consumers to purchase a particular product. Salience of a given color mark—in essence, the degree of acquired distinctiveness—can be gleaned from evidence already provided to the court for the purposes of proving secondary meaning.<sup>207</sup> For those marks that have successfully attained secondary meaning, such evidence would also show the relative aesthetic or source-identifying impact a mark has on a consumer's purchase.

As stated by the Second Circuit, determining a mark's functionality or lack thereof is a very fact-specific inquiry; this is especially true for fashion marks.<sup>208</sup> With this in mind, a court charged with such a task must inquire into the particularized interests of the parties involved. In analyzing a fashion mark's validity, a court should ask two questions:

- (1) Why does a mark owner seek exclusive use of a color mark?
- (2) Why do competitors seek free use and access to that same color mark?

If the answers to these questions reveal that both interests are largely grounded in the acquired meaning the mark owner has created, this weighs against a finding of functionality. Alternatively, if such source-identifying purposes are secondary to aesthetic or other non-reputation-related advantages, a mark is likely functional. In summary, a relaxed inquiry into a mark's aesthetic functionality can account for the unique features of a single-color fashion mark, which often cause consumers to seek out “the look” and “the brand” in equal measure.

## V. TREND FORECASTING

Despite the Second Circuit's holding allowing Louboutin's modified Red Sole Mark to serve as a valid trademark, many questions still remain with respect to the fashion industry's potential for increased intellectual property protection. Fortunately, it is safe to

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207. *See supra* Part II.B.1 (detailing the direct and circumstantial evidence necessary to prove a given mark has acquired secondary meaning).

208. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012).

say that single-color fashion marks may warrant protection and are not categorically invalid. But the certainty of the industry's intellectual property status stops here, as the Second Circuit sidestepped the more challenging issue of functionality by deciding the case on the mark's lack of distinctiveness when used on a monochromatic shoe. Furthermore, a footnote within the opinion once again illustrates the puzzling position the fashion industry inhabits within the realm of intellectual property: "It is arguable that, in the particular circumstances of this case, the more appropriate vehicle for the protection of the Red Sole Mark would have been copyright rather than trademark."<sup>209</sup> Such an afterthought seems for the most part irreconcilable with copyright law's denial of protection to "useful articles" such as clothing.<sup>210</sup> Until legislation such as the IDPA successfully modifies U.S. copyright law, the uncertainty will remain.

In the meantime, formulating a relaxed and more accommodating inquiry into the aesthetic functionality of single-color fashion marks provides mark owners some repose from the "death knell for trademark protection."<sup>211</sup> Allowing trademark protection for those features that both aesthetically appeal to consumers and signify a specific source incentivizes the continued creation of attractive fashion products.

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209. *Id.* at 223 n.19.

210. *See supra* Part II (explaining the meager copyright protection afforded to the fashion industry).

211. *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1064 (9th Cir. 2006).

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