

ST. THOMAS UNIVERSITY SCHOOL OF LAW
INTRODUCTION TO LEGAL STUDIES (ILS)
CONDITIONAL, SECTION 1

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WEEK OF JUNE 6-10, 2016

ASSIGNMENT FOR THURSDAY, JUNE 9

DAY 4 TOPIC: TRADEMARKS

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DAY 4 ASSIGNMENT

ASSIGNMENT FOR DAY 4 (THURSDAY, JUNE 9)

First, read the study questions. They will help you with the readings.

Second, carefully read the materials in the order shown below. Fully brief any cases and bring your printed briefs to class:

- U.S. CONSTITUTION, Article I, sec. 8, cl. 8
- Statutory selections from the Lanham Trademark Act
- Trademark exercises
- *Qualitex Co. v. Jacobson Prods. Co.*

Finally, after you've read the assigned materials, answer the study questions and do the trademark exercises. Be prepared to discuss all the materials in class. To answer the study questions, you will likely need to go back and reconsider the readings. To do the trademark exercises, you will need to carefully review the statutes.

DAY 4 STUDY QUESTIONS

Constitution and Trademark statutes

1. Look at Article I once again. Which provision(s) of Article I, section 8 might be used to justify the U.S. Congress creating federal trademark laws?
2. Could Congress create federal trademark laws for a trademark that is used only in Akron, OH for Ohio consumers? Why or why not? Consider Article I, section 8, clause 3, as well as 15 U.S.C. §§ 1114(1), 1125(a).
3. Can Professor Nathenson register the following marks? See 15 U.S.C. § 1052.
 - a. ABRAHAM LINCOLN for hats.
 - b. WILLIAM JEFFERSON CLINTON for saxophones.
 - c. DEAN ALFREDO GARCIA for legal education services.
 - d. PROFESSOR NATHENSON for online legal education services.
 - e. LIVING LEATHER for expensive coats made of fake leather.
 - f. REDSKINS for a football team.
 - g. NIKEE for athletic shoes.
 - h. LKDGIEJHLS for computer keyboards.
 - i. CHEESY for pizza.
 - j. CHEESE for cheese.
4. Shelly is an expert in making pork pizzas and decides to open a new restaurant. Shelly plans to call it PORK-U-PIES. Shelly plans to open the restaurant in December but won't be offering any pizzas for sale until then. Shelly is worried that somebody else might steal the idea and start selling PORK-U-PIES pizzas before the restaurant opens. Does 15 U.S.C. § 1127 provide any support for the proposition that a "trademark" can include Shelly's intended mark?
5. Suppose I have been using the trademark SCOOTER for 30 years throughout the United States as a valid common-law unregistered mark in connection with frozen beverages. If somebody else starts selling SCOOTER beverages in competition with me, can I use trademark law to sue them? See 15 U.S.C. §§ 1114(1), 1125(a).

Qualitex

1. Who are the parties?
 - a. Plaintiff? Defendant?
 - b. Petitioner? Respondent?
 - c. Note that the petitioner need not be a plaintiff and is instead the person who is appealing to the Supreme Court.
2. Describe the nature of the trademark at issue in *Qualitex*. Is it a word? A logo? Something else?
3. According to *Qualitex*, where in the *Abercrombie* spectrum does **color** fall as a mark?

4. Can color ever be inherently distinctive? If not, can it ever serve as a trademark?
5. Does the Court's decision make it easier or more difficult to assert trademark rights in a color?
6. Do colors ever have utilitarian purposes? Come up with examples.
7. Could I obtain trademark rights in:
 - a. A unique smartphone ringtone.
 - b. The smell of pizza used in connection with pizza.
 - c. The smell of pizza used for stationery.
 - d. The taste of apples used on the back of stickers.

Property

1. Consider your studies from Day 1 through Day 3. Do any of the earlier cases use trademark-like reasoning? If so, which one(s)?
2. In light of question 1, what social policies should be advanced by trademark rights?
 - a. To protect consumers from confusion in the marketplace.
 - b. To lower consumer search costs in the marketplace.
 - c. To provide incentives to create products of high quality.
 - d. To provide incentives to create new trademarks.
 - e. To reward the creators of distinctive and famous trademarks.
 - f. To prevent unfair competition and free-riding.
3. How broad are trademark rights? Formulate arguments using the skills you have developed so far.
 - a. Could United Airlines sue the United Way?
 - b. Could Best Buy and Apple prevent me from advertising computers at Nathenson's PC Store in an ad where I say "Come to Nathenson's PC Store for a best buy on Macintosh computers!"?
 - c. Could Apple Computer prevent Google from advertising "Buy an Android, they are much more powerful than an Apple iPhone"?
 - d. Could Mercedes prevent a pizza shop from calling its pies "The Mercedes of pizza!"?

TRADEMARK EXERCISES

Question one. Below is a record from the United States Patent and Trademark Office (USPTO) reflecting a real application to register a trademark in international class 025 for the mark OBAMA BIN LADEN. The trademark office rejected the application. Why? See 15 U.S.C. § 1052. Be prepared to explain in class what bases under section 1052 might justify the USPTO's refusal to register the mark.

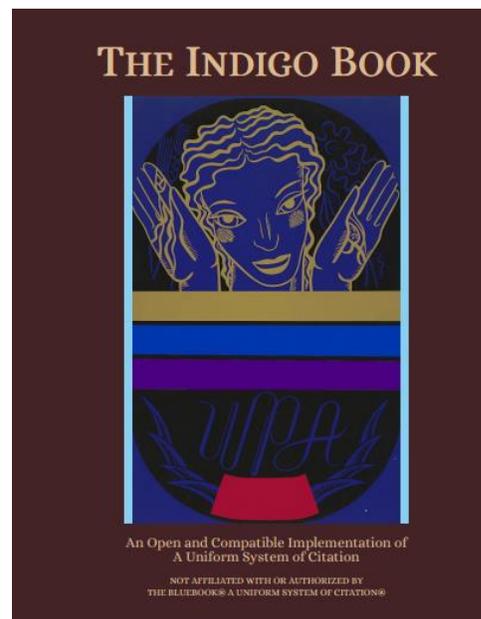
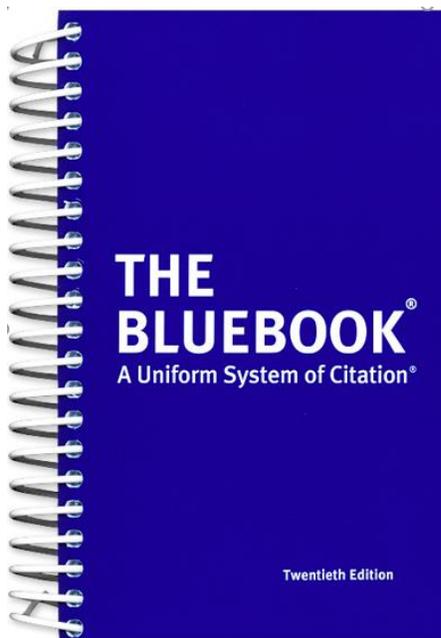
Obama Bin Laden

Word Mark	OBAMA BIN LADEN
Goods and Services	(ABANDONED) IC 025. US 022 039. G & S: Hats, Shirts, Bumper Stickers, Pins
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77086418
Filing Date	January 19, 2007
Current Basis	1B
Original Filing Basis	1B
Owner	(APPLICANT) Alexandre Batlle INDIVIDUAL UNITED STATES 1326 15th St Apt 1 Miami Beach FLORIDA 33139
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Abandonment Date	August 7, 2007

Question two. Your judge has asked for your opinion on a pending trademark dispute that she read about online. The BLUEBOOK is a citation manual used by many law schools, law students, and law reviews. Any lawyer knows about the BLUEBOOK. The BLUEBOOK mark is owned jointly by the law reviews of Harvard, Yale, and several other schools. Recently, a law professor and a well-known attorney felt that they could produce a citation manual that did a better job in a more organized fashion in less space and for less cost. They initially planned to call their book BABY BLUE. After objections from the BLUEBOOK trademark owners, they decided to call their citation manual THE INDIGO BOOK.

Your judge is curious as to whether the publishers of THE INDIGO BOOK could withstand a trademark infringement lawsuit by the owners of THE BLUEBOOK. Although trademark infringement analysis looks to a long list of non-exclusive factors such as mark strength, similarity of goods, similarity of consumers, and more, the only factor she wants you to consider is the degree of similarity of marks. To analyze similarity of marks, consider the overall commercial impression of the marks as well as the context in which they will appear to consumers. You should also consider the similarities of the marks in terms of sight, sound, and meaning. Be prepared to explain your conclusions and the reasons for your conclusions.

Hint: Go to <http://www.nathenson.org/courses/ils/assignments/trademark-exercises/> for full-color versions of these images. That may help with your analysis.



CONSTITUTION & STATUTES

U.S. Constitution, Article I, Section 8, clauses 3, 8, and 18

The Congress shall have power . . .

. . . .

[3] To regulate commerce with foreign nations, and among the several states, and with the Indian tribes;

. . . .

[8] To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;

. . . .

[18] To make all laws which shall be necessary and proper for carrying into execution the foregoing powers, and all other powers vested by this Constitution in the government of the United States, or in any department or officer thereof.

15 U.S.C. § 1052. Trademarks Registrable on the Principal Register; Concurrent Registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after [the effective date of the WTO agreement].

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them [subsections (e)(2) through (e)(5) omitted].

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce [i.e., attained "secondary meaning" as described in the note preceding the *Qualitex* case]. . . .

15 U.S.C. § 1114. Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. . . .

15 U.S.C. § 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1127. Construction and definitions; intent of chapter [selections]

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

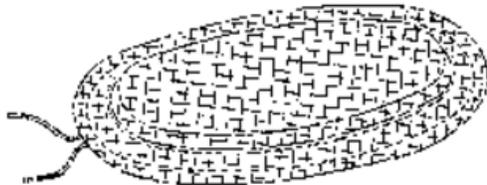
QUALITEX CO. V. JACOBSON PRODS. CO.

Note from Professor about trademark distinctiveness: To understand the issue in *Qualitex*, you will need a little background. Paragraph 6 of *Qualitex* refers to the *Abercrombie* spectrum of marks. Some marks are “inherently distinctive,” and are immediately protectable once the owner uses the mark in commerce in connection with the goods. Some marks, however, are “merely descriptive,” and require proof that consumers view the descriptive terms as having trademark significance or “secondary meaning,” i.e., that consumers understand the term to serve as a mark. Secondary meaning can be proven through circumstances such as length of use, extent of sales, advertising, surveys, and more. Finally, generic terms get no protection at all. Below are definitions of the types of marks with examples.

<i>Type of mark</i>	<i>Definition</i>	<i>Example</i>	<i>Inherently distinctive?</i>
Fanciful	Coined words	VERIZON for communication services	Yes
Arbitrary	Dictionary words used in non-dictionary ways	APPLE for computers	Yes
Suggestive	Requires a leap of imagination from the mark to the goods	COPPERTONE for suntan lotion	Yes
Merely descriptive	Describes the goods, their characteristics, their use, or their quality	BEST BUY for retail services	No. Requires secondary meaning
Generic	Genus of goods, or a trademark that has become genus of goods	BEER for beer ELEVATOR for elevators	Not protectable at all, regardless of secondary meaning

In *Qualitex*, what kind of mark is at issue? Does it fall neatly into any of the above categories? How does the court categorize the mark at issue in the case?

The current registration for the Qualitex mark is shown below. The Court's opinion follows.



Goods and Services	IC 007. US 023. G & S: machine parts; namely, press pads and covers for press pads for commercial and industrial presses. FIRST USE: 19571121. FIRST USE IN COMMERCE: 19571121
Mark Drawing Code	(2) DESIGN ONLY
Design Search Code	09.01.07 - Afghan; Bags, sleeping; Bed comforters; Bed pillows; Bed quilts; Bedding, bedspreads; Bedding, pillows, comforters, blankets; Blankets; Bolsters (cushions); Comforters, bed; Cushions; Mattress pads; Pillows; Quilts, bed; Sleeping bags 26.03.21 - Ovals that are completely or partially shaded
Serial Number	74013732
Filing Date	December 26, 1989
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	August 14, 1990
Registration Number	1633711
Registration Date	February 5, 1991
Owner	(REGISTRANT) Qualitex Company CORPORATION ILLINOIS 4248 North Elston Avenue Chicago ILLINOIS 60618
Attorney of Record	Sean C. Fifield
Description of Mark	The mark consists of a particular shade of green-gold applied to the top and side surfaces of the goods. The representation of the goods shown in phantom lining not a part of the mark and serves only to indicate position. The drawing is lined for the color gold.
Type of Mark	TRADEMARK
Register	PRINCIPAL-2(F)
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20100211.
Renewal	2ND RENEWAL 20100211
Live/Dead Indicator	LIVE

QUALITEX CO. V. JACOBSON PRODS. CO.

Supreme Court of the United States

514 U.S. 159

Argued Jan. 9, 1995

Decided Mar. 28, 1995

Justice BREYER delivered the opinion of the Court.

[1] The question in this case is whether the Trademark Act of 1946 (Lanham Act), 15 U.S.C. §§ 1051-1127, permits the registration of a trademark that consists, purely and simply, of a color. We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.

I

[2] The case before us grows out of petitioner Qualitex Company's use (since the 1950's) of a special shade of green-gold color on the pads that it makes and sells to dry cleaning firms for use on dry cleaning presses. In 1989, respondent Jacobson Products (a Qualitex rival) began to sell its own press pads to dry cleaning firms; and it colored those pads a similar green-gold. In 1991, Qualitex registered the special green-gold color on press pads with the Patent and Trademark Office as a trademark. Registration No. 1,633,711 (Feb. 5, 1991). Qualitex subsequently added a trademark infringement count, 15 U.S.C. § 1114(1), to an unfair competition claim, § 1125(a), in a lawsuit it had already filed challenging Jacobson's use of the green-gold color.

[3] Qualitex won the lawsuit in the District Court. But, the Court of Appeals for the Ninth Circuit set aside the judgment in Qualitex's favor on the trademark infringement claim because, in that Circuit's view, the Lanham Act does not permit Qualitex, or anyone else, to register "color alone" as a trademark. . . . The Courts of Appeals have differed as to whether or not the law recognizes the use of color alone as a trademark. . . . Therefore, this Court granted certiorari. We now hold that there is no rule absolutely barring the use of color alone, and we reverse the judgment of the Ninth Circuit.

II

[4] The Lanham Act gives a seller or producer the exclusive right to "register" a trademark, 15 U.S.C. § 1052, and to prevent his or her competitors from using that trademark, § 1114(1). Both the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark. The language of the Lanham Act describes that universe in the broadest of terms. It says that trademarks "include any word, name, symbol, or device, or any combination thereof." § 1127. 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. The courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC's three chimes), and even a particular scent (of plumeria blossoms on sewing thread). If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?

- [5] A color is also capable of satisfying the more important part of the statutory definition of a trademark, which requires that a person “use” or “intend to use” the mark

“to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127.

- [6] True, a product's color is unlike “fanciful,” “arbitrary,” or “suggestive” words or designs, which almost *automatically* tell a customer that they refer to a brand. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (CA2 1976) (Friendly, J.). The imaginary word “Suntost,” or the words “Suntost Marmalade,” on a jar of orange jam immediately would signal a brand or a product “source”; the jam's orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods—*i.e.*, “to indicate” their “source”—much in the way that descriptive words on a product (say, “Trim” on nail clippers or “Car-Freshner” on deodorizer) can come to indicate a product's origin. . . . In this circumstance, trademark law says that the word (*e. g.*, “Trim”), although not inherently distinctive, has developed “secondary meaning.” See *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851, n. 11, 72 L. Ed. 2d 606, 102 S. Ct. 2182 (1982) (“Secondary meaning” is acquired when “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself”). Again, one might ask, if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit a color, under similar circumstances, to do the same?

- [7] We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained “secondary meaning” and therefore identifies and distinguishes a particular brand (and thus indicates its “source”). In principle, trademark law, by preventing others from copying a source-identifying mark, “reduce[s] the customer's costs of shopping and making purchasing decisions,” 1 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 2.01[2], p. 2-3 (3d ed. 1994) (hereinafter *McCarthy*), for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby “encourage[s] the production of quality products,” *ibid.*, and simultaneously discourages those who hope to sell inferior products by capitalizing on a

consumer's inability quickly to evaluate the quality of an item offered for sale. . . . It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes. And, for that reason, it is difficult to find, in basic trademark objectives, a reason to disqualify absolutely the use of a color as a mark. . . .

- [8] It would seem, then, that color alone, at least sometimes, can meet the basic legal requirements for use as a trademark. It can act as a symbol that distinguishes a firm's goods and identifies their source, without serving any other significant function. . . . Indeed, the District Court, in this case, entered findings (accepted by the Ninth Circuit) that show Qualitex's green-gold press pad color has met these requirements. The green-gold color acts as a symbol. Having developed secondary meaning (for customers identified the green-gold color as Qualitex's), it identifies the press pads' source. And, the green-gold color serves no other function. (Although it is important to use *some* color on press pads to avoid noticeable stains, the court found “no competitive need in the press pad industry for the green-gold color, since other colors are equally usable.” 21 U.S.P.Q.2D (BNA) at 1460.) Accordingly, unless there is some special reason that convincingly militates against the use of color alone as a trademark, trademark law would protect Qualitex's use of the green-gold color on its press pads.

III

- [9] Respondent Jacobson Products says that there are four special reasons why the law should forbid the use of color alone as a trademark. We shall explain, in turn, why we, ultimately, find them unpersuasive.
- [10] *First*, Jacobson says that, if the law permits the use of color as a trademark, it will produce uncertainty and unresolvable court disputes about what shades of a color a competitor may lawfully use. Because lighting (morning sun, twilight mist) will affect perceptions of protected color, competitors and courts will suffer from “shade confusion” as they try to decide whether use of a similar color on a similar product does, or does not, confuse customers and thereby infringe a trademark. Jacobson adds that the “shade confusion” problem is “more difficult” and “far different from” the “determination of the similarity of words or symbols.” Brief for Respondent 22.
- [11] We do not believe, however, that color, in this respect, is special. Courts traditionally decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context, to confuse buyers. They have had to compare, for example, such words as “Bonamine” and “Dramamine” (motion-sickness remedies); “Huggies” and “Dougies” (diapers); “Cheracol” and “Syrocol” (cough syrup); “Cyclone” and “Tornado” (wire fences); and “Mattres” and “1-800-Mattres” (mattress franchisor telephone numbers). . . . Legal standards exist to guide courts in making such comparisons. See, *e. g.*, 2 McCarthy § 15.08; 1 McCarthy §§ 11.24-11.25 (“Strong” marks, with greater secondary meaning, receive broader protection than “weak” marks). We do not see why courts could not apply those standards to a color, replicating, if necessary, lighting conditions under which a colored product is normally sold. Indeed, courts already have done so in cases where a trademark consists of a color plus a design, *i.e.*, a colored

symbol such as a gold stripe (around a sewer pipe), a yellow strand of wire rope, or a “brilliant yellow” band (on ampules).

- [12] *Second*, Jacobson argues, as have others, that colors are in limited supply. Jacobson claims that, if one of many competitors can appropriate a particular color for use as a trademark, and each competitor then tries to do the same, the supply of colors will soon be depleted. Put in its strongest form, this argument would concede that “hundreds of color pigments are manufactured and thousands of colors can be obtained by mixing.” But, it would add that, in 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, and adds the shades that competitors cannot use lest they risk infringing a similar, registered shade, then one is left with only a handful of possible colors. And, under these circumstances, to permit one, or a few, producers to use colors as trademarks will “deplete” the supply of usable colors to the point where a competitor’s inability to find a suitable color will put that competitor at a significant disadvantage.
- [13] This argument is unpersuasive, however, largely because it relies on an occasional problem to justify a blanket prohibition. When a color serves as a mark, normally alternative colors will likely be available for similar use by others. Moreover, if that is not so—if a “color depletion” or “color scarcity” problem does arise—the trademark doctrine of “functionality” normally would seem available to prevent the anticompetitive consequences that Jacobson’s argument posits, thereby minimizing that argument’s practical force. . . .
- [14] The upshot is that, where a color serves a significant nontrademark function—whether to distinguish a heart pill from a digestive medicine or to satisfy the “noble instinct for giving the right touch of beauty to common and necessary things,” G. Chesterton, *Simplicity and Tolstoy* 61 (1912)—courts will examine whether its use as a mark would permit one competitor (or a group) to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient. That examination should not discourage firms from creating esthetically pleasing mark designs, for it is open to their competitors to do the same. But, ordinarily, it should prevent the anticompetitive consequences of Jacobson’s hypothetical “color depletion” argument, when, and if, the circumstances of a particular case threaten “color depletion.”
- [15] *Third*, Jacobson points to many older cases—including Supreme Court cases—in support of its position. . . . These Supreme Court cases, however, interpreted trademark law as it existed *before* 1946, when Congress enacted the Lanham Act. The Lanham Act significantly changed and liberalized the common law to “dispense with mere technical prohibitions,” S. Rep. No. 1333, 79th Cong., 2d Sess., 3 (1946), most notably, by permitting trademark registration of descriptive words (say, “U-Build-It” model airplanes) where they had acquired “secondary meaning.” See *Abercrombie & Fitch Co.*, 537 F.2d at 9 (Friendly, J.). The Lanham Act extended protection to descriptive marks by making clear that (with certain explicit exceptions not relevant here)

“nothing . . . shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f) (1988 ed., Supp. V).

[16] This language permits an ordinary word, normally used for a nontrademark purpose (*e. g.*, description), to act as a trademark where it has gained “secondary meaning.” Its logic would appear to apply to color as well. Indeed, in 1985, the Federal Circuit considered the significance of the Lanham Act’s changes as they related to color and held that trademark protection for color was consistent with the

“jurisprudence under the Lanham Act developed in accordance with the statutory principle that if a mark is capable of being or becoming distinctive of [the] applicant’s goods in commerce, then it is capable of serving as a trademark.” *Owens-Corning*, 774 F.2d at 1120.

[17] In 1988, Congress amended the Lanham Act, revising portions of the definitional language, but left unchanged the language here relevant. It enacted these amendments against the following background: (1) the Federal Circuit had decided *Owens-Corning*; (2) the Patent and Trademark Office had adopted a clear policy (which it still maintains) permitting registration of color as a trademark; and (3) the Trademark Commission had written a report, which recommended that “the terms ‘symbol, or device’ . . . not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound, or configuration which functions as a mark[.]” This background strongly suggests that the language “any word, name, symbol, or device,” 15 U.S.C. § 1127, had come to include color. And, when it amended the statute, Congress retained these terms. Indeed, the Senate Report accompanying the Lanham Act revision explicitly referred to this background understanding, in saying that the “revised definition intentionally retains . . . the words ‘symbol or device’ so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks.” S. Rep. No. 100-515, at 44. . . .

[18] *Fourth*, Jacobson argues that there is no need to permit color alone to function as a trademark because a firm already may use color as part of a trademark, say, as a colored circle or colored letter or colored word, and may rely upon “trade dress” protection [i.e., the look and feel of a product’s packaging, advertising, or the product itself], under § 43(a) of the Lanham Act, if a competitor copies its color and thereby causes consumer confusion regarding the overall appearance of the competing products or their packaging. The first part of this argument begs the question. One can understand why a firm might find it difficult to place a usable symbol or word on a product (say, a large industrial bolt that customers normally see from a distance); and, in such instances, a firm might want to use color, pure and simple, instead of color as part of a design. Neither is the second portion of the argument convincing. Trademark law helps the holder of a mark in many ways that “trade dress” protection does not. See 15 U.S.C. § 1124 (ability to prevent importation of confusingly similar goods); § 1072 (constructive notice of ownership); § 1065 (incontestible status); § 1057(b) (*prima facie* evidence of validity and ownership). Thus, one can easily find reasons why the law might provide trademark protection in addition to trade dress protection.

IV

[19] Having determined that a color may sometimes meet the basic legal requirements for use as a trademark and that respondent Jacobson’s arguments do not justify a special legal rule

preventing color alone from serving as a trademark (and, in light of the District Court's here undisputed findings that Qualitex's use of the green-gold color on its press pads meets the basic trademark requirements), we conclude that the Ninth Circuit erred in barring Qualitex's use of color as a trademark. For these reasons, the judgment of the Ninth Circuit is

Reversed.