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WHO OWNS BLUE? AN EXAMINATION OF THE FUNCTIONALITY DOCTRINE IN UNIVERSITY SPORTS COLOR

*By Michelle Gallagher**

I. INTRODUCTION

In a university setting, color has a range of meanings. Community. Solidarity. Allegiance. Pride. In the modern era of branding and big-ticket sales to university sporting events, protection of color as an intellectual property right is playing a key role as well. Faculty, students, and alumni alike proudly display their school colors on sweatshirts, caps, banners, tablecloths at tailgate parties, and even golf carts emblazoned with the familiar logos and colors of their university. In the minds of students and alumni, color alone *can* be an identifier of source. When fans are sitting in the stadium on game day, wearing their university colors, there is no doubt which team they are rooting for.

From a trademark protection standpoint, however, it is not so clear that color, or the combination of colors, can be the exclusive property of one school alone. The choices of university colors are limited, and the same colors often are claimed by different schools to be “their colors.” While one university sports fan wearing “maroon and gold” in Boston, Massachusetts, may create an association with the Boston College Eagles,¹ another sports fan wearing “maroon and gold” in Phoenix, Arizona, may suggest an affiliation with the Arizona State University (ASU) Sun Devils.² The color combination of “cardinal red and white” in a university setting in Stanford, California, may bring to mind an association with the Stanford University Cardinals.³ However, in Fayetteville, Arkansas, the “cardinal red and white” color combination in a university setting likely suggests a connection to the University of

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1. See, e.g., Official Site of the Boston College Eagles, <http://www.bceagles.com> (last visited Apr. 5, 2014).

2. See, e.g., Arizona State Sun Devil Athletics, <http://www.thesundevils.com> (last visited Apr. 5, 2014).

3. See, e.g., Stanford University Home of Champions, <http://www.gostanford.com> (last visited Apr. 5, 2014).

Arkansas Razorbacks.⁴ The problem becomes even greater when exclusive rights are claimed, not in a color combination, but simply one color alone.

This article will review the history of color as a trademark and examine the modern rules covering trademark protection of color, with a focus on color in university sports settings. In particular, the Boise State University trademark registration for the color blue on its stadium field will be scrutinized, and two questions will be addressed:

1. Is Boise State's "color blue" trademark on its stadium field merely functional?
2. Can Boise State license its "color blue" trademark to competing universities, high schools, and elementary schools, without destroying the mark?

We will first look at fundamental concepts of trademark law, and how the functionality doctrine in the context of color trademarks has evolved.

II. COLOR AS A TRADEMARK: AN OVERVIEW

A. What is a Trademark?

A trademark is "any word, name, symbol, or device, or any combination thereof" used to identify and distinguish one party's goods from those offered or sold by others, and to indicate the source of those goods.⁵ A service mark bears the same analysis as a trademark, but it identifies services in commerce instead of goods.⁶

In order for a trademark to be capable of protection, it must be (i) distinctive, and (ii) identify a source of goods.⁷ Distinctiveness can be inherent, because the mark itself is strong in the context of the goods it identifies.⁸ However, when a mark is not inherently distinctive because it describes some feature of the goods it identifies, this "merely descriptive" mark needs to build strength by consumer recognition of its trademark use.⁹ Acquired distinctiveness (also

4. See, e.g., Arkansas Athletics, Razorbacks, University of Arkansas, <http://www.arkansasrazorbacks.com> (last visited Apr. 5, 2014).

5. Trademark Act of 1946 (Lanham Act) § 45, 15 U.S.C. § 1127 (2011).

6. See *id.* Trademarks often "carry the torch" for discussion of both categories of marks, and they will do so in this article.

7. See *id.*

8. For example, XEROX is an inherently distinctive and strong trademark because, by its nature of use, it serves no purpose other than to be a trademark. See, e.g., U.S. Registration No. 0,525,717 (issued May 30, 1950).

9. See, e.g., Trademark Manual of Examining Procedure (TMPEP) § 1209.01(b) (Oct. 2013 ed.), available at <http://www.uspto.gov>. (For example, the mark WHOLE FOODS MARKET acquired distinctiveness as a service mark over time, and it is now protected as a registered mark on the Principal Register of the United States Patent and Trademark Office (USPTO)); see, e.g., U.S. Registration No. 1961586 of the mark WHOLE FOODS MARKET

called “secondary meaning”) can be shown by a series of factors, including, (i) substantially exclusive and continuous use of the trademark for a lengthy period of time,¹⁰ (ii) a high volume of product sales associated with the trademark, (iii) significant advertising expenditures related to promotion of the mark in connection with the goods, (iv) examples of advertising specifically highlighting the trademark as an identifier of source, (v) consumer recognition, (vi) media recognition, and other indicia suggesting that considerable goodwill has been established in the trademark as an identifier of a source of goods.¹¹ The end result: when consumers see the trademark, they think of only one source of goods.¹² For color trademarks, “acquired distinctiveness” plays a crucial role.¹³

B. The Functionality Doctrine

Section 2(e)(5) of the Lanham Act expressly forbids registration of a trademark if it “comprises any matter that, as a whole, is functional.”¹⁴ The functionality doctrine provides an absolute bar to trademark protection, and it is customarily triggered in the context of nontraditional marks such as product design, product packaging, sound, flavor, scent, or color.¹⁵ The purpose of the functionality doctrine is to maintain a balance between trademark law and patent law, and to encourage legitimate competition by denying trademark protection for useful

(registered Mar. 12, 1996, under § 2(f) of the Lanham Act, with a disclaimer of FOODS MARKET); *see also* TMEP § 1212 (Oct. 2013 ed.), *available at* <http://www.uspto.gov>.

10. *See, e.g.*, Lanham Act § 2(f), 15 U.S.C. § 1052(f) (2011) (“[P]roof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made” may be accepted as *prima facie* evidence that the mark has acquired distinctiveness.). *But see* TMEP § 1212.05 (Oct. 2013 ed.), *available at* <http://www.uspto.gov>. (“[T]he USPTO may, at its option, require additional evidence of distinctiveness. Whether a claim of five years’ use will be deemed acceptable to establish that the mark has acquired distinctiveness depends largely on the nature of the mark in relation to the specified goods or services.”); *see also* TMEP § 1212.05(a) (Oct. 2013 ed.), *available at* <http://www.uspto.gov>. (“For matter that is not inherently distinctive because of its nature (e.g., nondistinctive product container shapes, overall color of a product, mere ornamentation, and sounds for goods that make the sound in their normal course of operation), evidence of five years’ use is not sufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness.”).

11. *See, e.g.*, TMEP § 1212.06 (Oct. 2013 ed.), *available at* <http://www.uspto.gov>.

12. *See id.* (“In considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive. *In re Redken Labs, Inc.*, 170 U.S.P.Q. 526, 528 (TTAB 1971); *In re Fleet-Wing Corp.*, 122 U.S.P.Q. 335, 335 (TTAB 1959).”).

13. *See, e.g.*, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *see also* *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995); *see also* *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

14. Lanham Act § 2(e)(5), 15 U.S.C. § 1052(e)(5) (2011).

15. *See, e.g.*, TMEP § 1202.02(a)(viii) (Oct. 2013 ed.), *available at* <http://www.uspto.gov>.

features of a product or service.¹⁶ The landmark case, *In re Morton-Norwich Products, Inc.*,¹⁷ sets the framework to assess whether a trademark comprises matter that is merely functional.¹⁸ A functionality determination involves analysis of one or more of the following *Morton-Norwich* factors:

- (i) The existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (ii) Advertising by the applicant that touts the utilitarian advantages of the design;
- (iii) Facts pertaining to the availability of alternative designs; and
- (iv) Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.¹⁹

It is not necessary for all four *Morton-Norwich* factors to be present for a trademark to fail under the functionality doctrine.²⁰ However, since the functionality determination is primarily a question of fact, the *Morton-Norwich* factors serve as a general guide regarding the nature and degree of evidence that may establish that a trademark, as a whole, is merely functional.²¹

The functionality doctrine is divided into two categories: (i) utilitarian (or traditional) functionality, and (ii) aesthetic functionality.²² A product or service feature will fall into the traditional functionality category if evidence shows that the matter sought to be protected as a trademark, “is essential to the use or purpose of the article, or if it affects the cost or quality of the article.”²³ If the claimed feature meets this traditional functionality definition articulated by the Supreme Court in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.* (i.e., the *Inwood* test), then the feature will be deemed merely functional, regardless of the availability to competitors of alternative designs or product features.²⁴

16. *Id.* § 1202(a)(ii); see also *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

17. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982).

18. See, e.g., TMEP § 1202.02(a)(v) (Oct. 2013 ed.), available at <http://www.uspto.gov>.

19. See *id.*; see also *In re Morton-Norwich*, 671 F.2d 1332.

20. TMEP § 1202.02(a)(v), *supra* note 18; see also *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 U.S.P.Q.2d 1422, 1427 (Fed. Cir. 2002).

21. See, e.g., TMEP § 1202.02(a)(v), *supra* note 18.

22. See generally, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

23. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1982).

24. See *id.*; see also *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 U.S.P.Q.2d 1422, 1427 (Fed. Cir. 2002) (“[O]nce a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs”).

The aesthetic functionality doctrine applies in instances in which one party's exclusive right to a claimed feature "would put competitors at a significant non-reputation-related disadvantage" notwithstanding the lack of utilitarian function in the claimed feature.²⁵ The availability of alternate and equally acceptable choices to competitors plays a key role in the analysis of aesthetic functionality.²⁶ As stated in *Morton-Norwich*, "[s]ince the effect upon competition 'is really the crux of the matter,' it is, of course, significant that there are other alternatives available."²⁷

C. The Evolution of Color Trademark Protection

Claiming color as a trademark today could involve an analysis of both traditional and aesthetic functionality, as well as other considerations such as "merely ornamental" use and the failure of the color to function as a trademark,²⁸ coupled with lack of acquired distinctiveness as a trademark.²⁹ However, trademark protection of color alone was, at one time, rejected by courts as a general principle, on the premise that it would be bad public policy for brand owners to lock up colors and deplete them from the reservoir of available resources for all competitors to use.³⁰ Because trademark rights can last in perpetuity, the potential effect of granting trademark rights in a single color would be to take that color off the market for competitors to use in connection with specific goods or services. The "color depletion theory" posited

25. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995).

26. *See id.*; *see also In re Morton Norwich*, 671 F.2d 1332.

27. *In re Morton-Norwich*, 671 F.2d at 1341.

28. TMEP § 1202.02(a)(1) (Oct. 2013 ed.), *available at* <http://www.uspto.gov>. ("Before October 30, 1998, there was no specific statutory reference to functionality as a ground for refusal, and functionality refusals were thus issued as failure-to-function refusals under §§ 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127."); *see also* TMEP § 1202.03(a)(1) (Oct. 2013 ed.), *available at* <http://www.uspto.gov>. ("Subject matter that is merely a decorative feature does not identify and distinguish the applicant's goods and, thus, does not function as a trademark. A decorative feature may include words, designs, slogans, or trade dress. This matter should be refused registration because it is merely ornamentation and, therefore, does not function as a trademark, as required by §§ 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127.")

29. TMEP § 1212.01 (Oct. 2013 ed.), *available at* <http://www.uspto.gov>.

30. *See, e.g., The NutraSweet Co. v. the Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990) (Absolute bar to protection of color as a trademark); *see also Life Savers v. Curtiss Candy Co.*, 182 F.2d 4, 9 (7th Cir. 1950) ("As a rule color cannot be monopolized to distinguish a product."); *see also Campbell Soup Co. et al. v. Armour & Co.*, 175 F.2d 795, 798 (3d Cir. 1949) (Third Circuit held red and white color combination on food packaging cannot be a trademark, stating, "What the plaintiffs are really asking for, then, is a right to the exclusive use of labels which are half red and half white for food products. If they may thus monopolize red in all of its shades the next manufacturer may monopolize orange in all its shades and the next yellow in the same way. Obviously, the list of colors will soon run out. That a man cannot acquire a trade-mark by color alone has been stated a good many times in decisions and textbooks.").

that once key colors were taken by trademark owners, a new participant in the marketplace would be deprived of a necessary tool to compete effectively.³¹

For example, in *First Brands Corp. v. Fred Meyer, Inc.*, the Ninth Circuit rejected trademark protection for use of the color yellow on antifreeze containers, stating, “there are a limited number of colors in the palette which may be depleted if trademark registrants are allowed to prevail.”³² The Ninth Circuit expressed a need for other anti-freeze manufacturers to have the color yellow available for their use in order to compete effectively, stating, “it would in effect be [giving appellant] a trademark on the color yellow as a background color for an ordinary-shaped container . . . [which] would deplete a primary color available to competitors and deprive them of a competitive need.”³³

Similarly, in *The NutraSweet Co. v. the Stadt Corp.*, the Seventh Circuit declared a *per se* prohibition against the protection of color as a trademark when it affirmed the district court’s grant of summary judgment in favor of the defendant on the ground that the color blue used on sugar substitute packets was not capable of protection as a trademark.³⁴ The Seventh Circuit emphasized its concern about competitive need and color depletion, stating “if each of the competitors presently in the tabletop sweetener market were permitted to appropriate a particular color for its product, new entrants would be deterred from entering the market.”³⁵

In contrast, in *In re Owens-Corning Fiberglas Corp.*, the Federal Circuit declined to follow a *per se* rule against protection of color alone, and reversed the USPTO Trademark Trial and Appeal Board (TTAB) in its refusal to allow registration of the color pink in connection with insulation.³⁶ The Federal Circuit noted the difficulty in protecting color, stating: “[b]y their nature, color marks carry a difficult burden in demonstrating distinctiveness and trademark character. Each case must be considered on its merits.”³⁷ The Federal Circuit also noted the color depletion theory in its holding, but indicated its applicability was limited: “[t]his [color depletion] theory is not faulted for appropriate application, but following passage of the Lanham Act, courts have declined to perpetuate its *per se* prohibition which is in conflict with the

31. See, e.g., 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 7:40 (4th ed. 1994).

32. *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378 (9th Cir. 1987).

33. *Id.* ¶ 11.

34. *The NutraSweet Co. v. the Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990), cert. denied, 499 U.S. 983 (1991) (7th Circuit employed the traditional rule that a single party may not monopolize a single color except when captured in a defined symbol or design).

35. *Id.* ¶ 24.

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

37. *Id.* at 1127.

liberating purposes of the Act.”³⁸ Ultimately, the Federal Circuit held that the Lanham Act did not prevent registration of color alone as a trademark, and that the plaintiff had met its burden of proof to establish that the color pink had acquired secondary meaning as a trademark.³⁹ The Federal Circuit allowed the color pink trademark registration to move forward.

However, in a subsequent case, *Brunswick Corporation v. British Seagull Limited*, the Federal Circuit took an opposite stance and referenced color depletion and competitive need theories in its rejection of federal registration of the color black as a trademark for outboard motors.⁴⁰ Initially the USPTO Examining Attorney had allowed the color black trademark to proceed to registration based upon substantial evidence of acquired distinctiveness, including thirty years of use, over \$100 million in advertising, and \$3 billion in outboard motor sales.⁴¹ Competitors opposed the application, and the TTAB denied registration, finding the color black in connection with outboard motors to be *de jure* functional.⁴² On appeal, the Federal Circuit affirmed the TTAB, indicating that the Board correctly applied both competitive need and color depletion theories in refusing registration.⁴³ As to “competitive need,” the Federal Circuit said, “when we consider whether a color is functional, we must consider whether alternative colors are available in order to avoid the fettering of competition. If competition will be hindered, the color in question will be *de jure* functional.”⁴⁴ As to “color depletion,” the court reiterated its position in *Owens-Corning*, stating that color depletion cannot be used as a *per se* bar to registration, but in certain instances it could apply in the context of the functionality determination, and that the Board did not err in applying the color depletion analysis in this case.⁴⁵ Evidence had been introduced in the TTAB proceedings to show that the color black was a preferred color by boat enthusiasts for outboard motors because (i) it coordinated well with several boat colors, and (ii) the color black

38. *Id.* at 1120.

39. *Id.* at 1128.

40. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994).

41. *Id.*

42. *See id.*

43. *See id.*

44. *Brunswick*, 35 F.3d at 1531.

45. *Id.* at 1532. (“While disavowing in *Owens-Corning* the color depletion theory as a *per se* rule, this court nevertheless recognized its applicability in appropriate circumstances . . . the functionality limitation on trademark protection properly subsumes any lingering policy concerns embodied in the “color depletion theory.” The theory is not a *per se* bar to registration of color marks. Rather, traditional trademark policies, including the functionality limitation, set the boundaries for color mark registration.”).

made the outboard motor appear smaller.⁴⁶ Such evidence of competitor and consumer preference of the color black gave weight to arguments of competitive need and color depletion, and ultimately to the Federal Circuit's refusal of trademark protection on the basis of functionality.⁴⁷

Other instances in which courts weighed competitive need and color depletion theories in decisions to block protection of color as trademarks under the functionality doctrine include: (i) a specific shade of green (commonly called "John Deere" green) in connection with farm equipment,⁴⁸ (ii) the color blue used on audio speakers,⁴⁹ (iii) the color blue used on fertilizer,⁵⁰ (iv) the color royal blue used on ice cream bar packaging,⁵¹ and, (v) the color white used on cutlery.⁵²

Finally, in *Qualitex Co. v. Jacobson Products Co., Inc.*, the Supreme Court addressed trademark protection of color as the central issue and held 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."⁵³ In *Qualitex*, the petitioner had consistently used an obscure green-gold color on its dry cleaning press pads since the 1950s. In 1989, respondent, Jacobson Products (a rival of Qualitex), began selling its own similarly colored press pads to dry cleaning firms. Qualitex applied for and received a trademark registration for the green-gold color of the press pads in the USPTO, and added a count of trademark infringement to the unfair competition lawsuit it had already filed against Jacobson. The district court ruled for Qualitex on the trademark infringement claim, and the case went

46. See *id.* at 1531–32.

47. *Id.*

48. See, e.g., *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85 (S.D. Iowa 1982), citing *Pagliero v. Wallace China*, 198 F.2d 339, 343 (9th Cir. 1952) (The district court weighed evidence that farmers generally preferred to have their farm equipment match, and hence, competitors would be deprived of an "essential ingredient in the commercial success of the product" by being barred from using a particular shade of green for farm equipment.).

49. See, e.g., *Mitek Corp. v. Pyramid Sound Corp.*, 20 U.S.P.Q.2d 1389 (N.D. Ill. 1991) ("If each of the competitors in the speaker industry were permitted to appropriate a particular color for their speaker, new entrants would be deterred from entering the market.").

50. See, e.g., *Nor-Am Chem. Co. v. O.M. Scott & Sons Co.*, 4 U.S.P.Q.2d 1316 (E.D. Pa. 1987) (The court employed traditional color depletion theory to refuse exclusive right to dye nitrogen fertilizer the color blue).

51. See, e.g., *AmBrit, Inc. v. Kraft, Inc.*, 805 F.2d 974, 1 U.S.P.Q.2d 1161 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987) (The court ruled injunction forbidding use of royal blue was too broad, and emphasized general rule that no seller can foreclose competitor use of any particular color).

52. See, e.g., *Russell Harrington Cutlery, Inc. v. Zivi Hercules, Inc.*, 25 U.S.P.Q.2d 1965 (D. Mass. 1992) (The court emphasized color depletion rule was the law in the First Circuit, and denied trademark protection in the color white for professional cutlery).

53. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 161 (1995).

to the Ninth Circuit, which reversed and held that the Trademark Act does not permit Qualitex, or anyone, to register color alone as a mark. The Supreme Court granted certiorari and reversed the Ninth Circuit, stating there was no absolute bar to the use of color alone as a mark. The Supreme Court compared color marks to “descriptive marks” that could gain significance as trademarks over time by developing secondary meaning and posed the question, “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?”⁵⁴ The Court thereby affirmed that color alone could be protected, and registered, as a trademark if it had acquired secondary meaning.

The Supreme Court in *Qualitex* specifically referred to the “color depletion” theory, stating that the theory

... relies on an occasional problem to justify a blanket prohibition. When 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. . . .⁵⁵

The Supreme Court then summarized the functionality doctrine:

The functionality doctrine, as we have said, forbids the use of a product’s feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is “essential to the use or purpose of the article” or “affects [its] cost or quality.” *Inwood Labs*, 456 U.S. at 850, n.10. The functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important non-reputation related product features.⁵⁶

The Court also recognized the “aesthetic functionality” doctrine, and tied this doctrine specifically to anticompetitive consequences, by stating,

The Restatement (Third) of Unfair Competition adds that, if a design’s “aesthetic value” lies in its ability to “confer a significant benefit that cannot practically be duplicated by the use of alternative designs,” then the design is “functional.” Restatement (Third) of Unfair Competition § 17, Comment c,

54. *Id.* at 163.

55. *Id.* at 168–69 (emphasis added).

56. *Id.* at 169.

pp. 175-176 (1993). The ultimate test of “aesthetic functionality” . . . is whether the recognition of trademark rights would significantly hinder competition. . . . [T]he upshot is that, where a color serves a significant non-trademark 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.⁵⁷

Qualitex was important because it directly addressed the color issue, quieted the sparring circuit courts, affirmed the actions the USPTO had already been taking with respect to protection of color marks, and gave some general guidance on how to assess the protection of color as a trademark. *Qualitex* also made clear that a color trademark could be refused protection on the basis of the functionality doctrine if it put competitors at a significant disadvantage because the claimed feature was essential to the use or purpose of the article, or it affected the cost or quality of the article, under the *Inwood*⁵⁸ test (i.e., traditional utilitarian functionality), or it served a significant non-trademark function such as providing aesthetic appeal to the consumer (i.e., aesthetic functionality). The Supreme Court gave courts and the USPTO latitude to assess both traditional functionality and aesthetic functionality, but *Qualitex* emphasized that competitive need, and the anti-competitive consequences of color depletion, may be considered by courts and the USPTO in determining whether color(s) are capable of trademark protection.⁵⁹

In the wake of *Qualitex*, the Supreme Court reiterated the standard for protection of color as a trademark in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, by stating that color can never be inherently distinctive and that secondary meaning as a trademark must always be shown.⁶⁰ Finally, in *TraFFix Devices Inc. v. Marketing Displays, Inc.*, the Supreme Court asserted that the *Qualitex* case stood for “aesthetic functionality” by stating “[i]n *Qualitex* . . . aesthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or

57. *Id.* at 169 (emphasis added).

58. *See Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844 (1982).

59. *Qualitex*, 514 U.S. at 159.

60. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (“Indeed, with respect to at least one category of mark-colors-we have held that no mark can ever be inherently distinctive,” citing *Qualitex*, 514 U.S. at 162–63).

its cost or quality”⁶¹ and reasserted the bounds of the functionality doctrine as a whole.

D. Recent Important Color Cases: Louboutin and In re FTD

Recent important cases involving color trademarks have appeared in the Second Circuit in connection with the red color of shoe outsoles, and in the TTAB in connection with the color black used for floral design packaging. Both cases shed light on the intense factual inquiries and scrutiny of competitive need that take place to assess the determination of functionality in the context of color.

1. Christian Louboutin S.A. v. Yves St. Laurent America Holding, Inc.

In *Christian Louboutin S.A. v. Yves St. Laurent America Holding, Inc.*, the Second Circuit addressed the issue of whether a single color could serve as a legally protected trademark in the fashion industry, and specifically in the context of women’s high fashion design footwear.⁶² As early as 1992, the shoe designer Christian Louboutin used a red lacquered outsole on his footwear and did so consistently.⁶³ As Louboutin’s success in the fashion industry gained momentum, the red sole popping from beneath the shoes of celebrities and movie stars also acquired recognition and goodwill as the identifier of Louboutin footwear.⁶⁴ In 2007, Louboutin applied for federal registration of the red lacquered outsole (the “Red Sole Mark”) on footwear in the USPTO, and received federal registration in 2008 on the basis of “acquired distinctiveness” under Section 2(f) of the Trademark Act.⁶⁵

In 2011, Yves St. Laurent (“YSL”) prepared a line of monochrome shoes in purple, green, yellow, and red.⁶⁶ The YSL monochrome line displayed one color throughout the entire shoe, including its outsole.⁶⁷ When YSL started to market its red monochrome shoe with a matching red outsole, Louboutin objected on the grounds that it infringed Louboutin’s Red Sole Mark.⁶⁸ The parties entered into settlement discussions to avoid litigation, but

61. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

62. *Christian Louboutin S.A. v. Yves St. Laurent America Holding, Inc.*, 696 F.3d 206, 211 (2d Cir. 2012).

63. *Id.* at 213.

64. *Id.*

65. *See* U.S. Registration No. 3,361,597 (issued Jan. 1, 2008).

66. *Louboutin*, 696 F.3d at 213.

67. *Id.*

68. *Id.*

negotiations failed and Louboutin brought a trademark infringement suit and request for preliminary injunction.⁶⁹ In response, YSL asserted two counterclaims: (i) seeking cancellation of the Red Sole Mark on the grounds that it was merely ornamental and not distinctive, and (ii) alleging the Red Sole Mark was merely functional and therefore incapable of protection as a trademark.⁷⁰ The district court denied Louboutin's request for a preliminary injunction, construing the case narrowly as a determination of whether "there is something unique about the fashion world that militates against extending protection to a single color."⁷¹ In its ruling in favor of YSL, the district court created a *per se* rule for the fashion industry, and held that single color marks are inherently functional in the fashion industry, and therefore Louboutin's Red Sole Mark was ineligible for trademark protection.⁷² Louboutin appealed the decision. On appeal, the Second Circuit went through a thorough analysis of the history of protection of color marks and the aesthetic functionality doctrine in the context of color. The court echoed *Qualitex* by stating, "a mark is aesthetically functional, and therefore ineligible for protection under the Lanham Act, where protection of the mark *significantly* undermines competitors' ability to compete in the relevant market."⁷³ The Second Circuit summarized the aesthetic functionality doctrine under the teachings of *Qualitex* and *TrafFix* as a threefold analysis:

The test for aesthetic functionality is threefold: At the start, we address the two prongs of the *Inwood* test, asking whether the design feature is either "essential to the use or purpose" or "affects the cost or quality" of the product at issue. Next, if necessary, we turn to a third prong, which is the competitive inquiry set forth in *Qualitex*. In other words, if a design feature would, from a traditional utilitarian perspective, be considered "essential to the use or purpose" of an article, or it affects its cost or quality, then the design feature is functional under *Inwood* and our inquiry ends. But if the design feature is not "functional" from a traditional perspective, it must still pass the *fact-intensive Qualitex* test and be shown not to have a significant effect on competition in order to receive trademark protection.⁷⁴

The Second Circuit rejected the district court's *per se* rule against protection of single color marks in the fashion industry

69. *Id.*

70. *Id.* at 214.

71. *Id.*

72. *Id.*

73. *Id.* at 222.

74. *Id.* at 220 (emphasis added).

and analyzed the validity of Louboutin's Red Sole Mark in the context of footwear.⁷⁵ In a move that highlights how "fact-intensive" the functionality analysis can be, the Second Circuit declined to find that Louboutin's protectable mark was the Red Sole Mark in the context of *all* shoes, including monochrome shoes. Rather, the court determined the evidence showed that the essence of the Red Sole Mark was a red outsole, which *contrasted* with the color of the upper portion of the shoe, creating a pop of red color from the bottom of the shoe.⁷⁶ Having restricted Louboutin's mark to a *contrasting* Red Sole Mark, the court held this modified mark (and not the original registered Red Sole Mark) was a valid and enforceable trademark that had gained secondary meaning as a "brand with worldwide recognition."⁷⁷ The court then concluded that the red sole on YSL's monochrome red shoe was "neither a use of, nor confusingly similar to, the Red Sole Mark," and affirmed the denial of the preliminary injunction against YSL.⁷⁸ Finally, the court emphasized its position of neutrality on the functionality determination in this case, stating, "having limited the Red Sole Mark as described above, and having established that the red sole used by YSL is not a use of the Red Sole Mark, it is axiomatic that we need not—and should not—address either the likelihood of consumer confusion or whether the modified Mark is functional."⁷⁹ The court then ordered the clerk of the court to notify the director of the USPTO of the modification of the Red Sole Mark as set forth in its federal registration.⁸⁰ The description of the Red Sole Mark in U.S. Registration No. 3,361,597 was amended to conform to the Second Circuit's modification, and now reads as follows:

The color(s) red is/are claimed as a feature of the mark. The mark consists of a red lacquered outsole on footwear that contrasts with the color of the adjoining ("upper") portion of the shoe. The dotted lines are not part of the mark but are intended only to show placement of the mark.⁸¹

75. *Id.* at 223.

76. *Id.* at 227. ("As clearly suggested by the District Court, it is the *contrast* between the sole and the upper that causes the sole to 'pop,' and to distinguish its creator. The evidentiary record further demonstrates that the Louboutin mark is closely associated with contrast.").

77. *Id.* at 227–28.

78. *Id.* at 228.

79. *Id.* at 228.

80. *Id.* at 228–29.

81. See U.S. Registration No. 3,361,597, *Updated Registration Certificate* (May 7, 2013), USPTO Trademark Status and Document Retrieval (TSDR), *available at* <http://tsdr.uspto.gov/documentviewer?caseId=sn77141789&docId=URC20130507000144#docIndex=4&page=1>.

2. *In re Florists' Transworld Delivery, Inc. (FTD)*

In the 2013 precedential TTAB case *In re Florists' Transworld Delivery, Inc. (FTD)* the central question was whether the color black as applied to a substantial portion of the outside surface of a box used as a container or packaging for floral arrangements was merely functional.⁸² The examining attorney issued a final refusal to register the mark on two bases: (i) the mark was merely functional under Section 2(e)(5) of the Trademark Act, and (ii) the mark was merely ornamental and failed to function as a trademark, under Trademark Act Sections 1, 2, and 45 and had not established sufficient acquired distinctiveness under Section 2(f) of the Trademark Act.⁸³ On appeal, the Board affirmed both bases for refusal.⁸⁴

In a series of office actions denying registration, the examining attorney argued the mark was functional under both traditional and aesthetic functionality theories, but conceded in his *ex parte* appeal brief that “[t]he Supreme Court finds appropriate the use of the ‘aesthetic functionality’ doctrine in cases like this one where color, by its nature, makes it difficult to evaluate the functionality issue from a purely utilitarian standpoint”⁸⁵ and therefore dedicated much of his brief to aesthetic functionality. Accordingly, on appeal, the Board focused solely on the aesthetic functionality doctrine and launched into the fact-intensive analysis of whether exclusive registration of the color black for boxes in this instance hinders competition in the floral industry. The Board reviewed the evidence and concluded, “indeed, in the floral industry, color has significance and communicates particular messages.”⁸⁶ The Board noted that evidence demonstrated that “[b]lack communicates elegance or luxury” and that it is a preferred color choice for somber occasions such as bereavement or for holidays such as Halloween.⁸⁷ The Board further stated (quoting the examining attorney’s brief), “competitors will need to use black packaging to convey an appropriate message or sentiment, whether that is elegance, style, festivity, grief, or sympathy,” and “[a]llowing singular entities to control certain colors, in a field where color is both dynamic and has significance, would severely limit the

82. *In re Florists' Transworld Delivery, Inc. (FTD)*, 2013 TTAB LEXIS 115 (TTAB Mar. 28, 2013).

83. *Id.* at 116.

84. *Id.*

85. *Id.* at 124–25.

86. *Id.* at 126. (The Board noted that different colored flowers are given for different occasions; red roses are given on Valentine’s Day, as a message of love, for example. The Board also indicated that the evidence reflects that the packaging of the flowers commonly plays a part in the presentation of the flowers).

87. *Id.* at 128.

availability of appropriate color choices to consumers seeking [particular] floral arrangement gifts.”⁸⁸ The Board also discussed the *Morton-Norwich* factor of the availability of alternatives and concluded that there was indeed an absence of alternative colors for the occasions and messages conveyed by the color black in the floral industry.⁸⁹ Accordingly, the Board held that the color black in the context of floral packaging was incapable of protection as a trademark under the doctrine of aesthetic functionality.⁹⁰

III. COLOR TRADEMARKS IN UNIVERSITY SPORTS

A. Case Review: Protection of Color in University Sports

In the world of university sports, protection of color alone as a trademark has received mixed reviews by the courts and the USPTO. Like color protection as a whole, this specific line of color treatment appears to be evolving as a result of the increased number of entities in sports and university settings seeking trademark protection of color alone in various forms and the highly factual nature of the analysis of color protection. However, common threads throughout case law and USPTO analysis of color protection demonstrate that (i) a color, or combination of colors, claimed narrowly in the context of the goods or services, and/or (ii) the presence of other identifying indicia associated with the claimed color(s), play a role in the determination of whether the claimed color or a combination of colors is eligible for trademark protection.

In *Board of Supervisors of Louisiana State University v. Smack Apparel*, four universities⁹¹ challenged the use of their school colors by an unauthorized apparel company on T-shirts and other merchandise. The defendant, Smack Apparel, used the university colors in connection with university acronyms or slogans that suggested a direct reference to the games of the schools’ football teams on T-shirts and other merchandise.⁹² The universities sued on the basis of trademark infringement and

88. *Id.* at 130–31.

89. *Id.* at 132.

90. *Id.* at 132. (The Board also determined that the color mark (black) in this case was merely ornamental and that the applicant had not satisfied the extensive evidentiary burden required to show that the mark had acquired distinctiveness. Even though a functionality determination renders the trademark incapable of protection regardless of acquired distinctiveness, affirming the examining attorney’s ornamentation refusal served as a supplemental basis for rejection.).

91. *Bd. of Supervisors of La. St. Univ. v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008). (The four universities were Louisiana State University (LSU), Ohio State University (OSU), Oklahoma University (OU), and the University of Southern California (USC)).

92. *See id.* (Smack Apparel T-shirts included the university colors and slogans like “Bourbon Street or Bust” (with the “ou” in a different type style). “OU” refers to University of Oklahoma, and at the time, OU was playing in the 2004 Sugar Bowl in New Orleans, LA).

other claims and won on summary judgment.⁹³ Smack Apparel appealed and the Fifth Circuit affirmed the lower court, stating university colors “with other identifying indicia” could function as trademarks, and Smack Apparel had intentionally infringed the university marks.⁹⁴ The Fifth Circuit disagreed with Smack Apparel’s argument that the claimed marks were too broad, and noted:

Because the Court recognizes that trademarks may include color, we see no reason to exclude color *plus other identifying indicia* from the realm of protectable marks providing the remaining requirements for protection are met.⁹⁵

The Fifth Circuit went on to discuss the considerable secondary meaning in the claimed marks and concluded the “remaining requirements” for trademark protection had been met.⁹⁶ In addressing Smack Apparel’s alleged functionality defense, the court recognized the “competitive need” theory for functionality articulated in *Qualitex* and *TrafFix*, but concluded that the defendant’s competitive disadvantage was related to its inability to reap the benefit of the good will established by the university marks.⁹⁷ The court also rejected Smack Apparel’s “aesthetic functionality” argument on the basis that it was purely dicta in *TrafFix* and not a defense the Fifth Circuit recognized, stating, “[w]e do not believe that the Court’s dictum in *TrafFix* requires us to abandon our long-settled view rejecting recognition of aesthetic functionality.”⁹⁸ At the end of the day, the *Smack Apparel* case does not stand for protection of university colors alone, but rather university colors with “other identifying indicia.” The bad faith of the defendant in intentionally creating an association with the universities also played a significant role in the trademark infringement ruling.

Similarly, in *University of Kansas v. Sinks*, University of Kansas (“KU”) sued Larry Sinks, a former official licensee of KU, his related business venture, Victory Sportswear, LLC (d/b/a Joe-College.com) and other related parties, for trademark infringement and related claims in connection with Sinks’ unauthorized sale of T-shirts and other merchandise bearing the logos and blue and crimson color scheme of KU.⁹⁹ KU moved for summary judgment

93. *Id.*

94. *See id.*

95. *Id.* at 476 (emphasis added).

96. *Bd. Supervisors La. St. Univ.*, 550 F.3d at 486–87.

97. *Id.* at 487.

98. *Id.*

99. *Univ. Kan. v. Sinks*, 565 F. Supp. 2d 1216, 1227 (D. Kan. 2008) KU claimed the infringed logos and trademarks included such word marks as JAYHAWKS, FIGHTING MANGINOS, KIVISTO FIELD, ALLEN FIELDHOUSE, THE PHOG, LATE NIGHT IN

on the issue of infringement with regard to more than 150 T-shirt designs that Sinks sold bearing some form of KU indicia or its color scheme, but the court declined to analyze the entire lot, stating “KU has submitted hundreds of exhibits of officially licensed products that the Court is apparently expected to cull through in order to determine the similarities and differences”¹⁰⁰ and instead focused on just four T-shirts sold by Sinks it considered to have “overwhelming” similarities to officially licensed products.¹⁰¹ Each of the four T-shirts featured a KU word mark, logo, or other school indicia used together with the crimson and blue color scheme, and not simply color alone.¹⁰² The court found no genuine issue of material fact that these four shirts infringed KU’s trademark rights, but determined it was unable to conclude that the multitudes of other shirts were similar or dissimilar as a matter of law.¹⁰³ KU also moved for judgment as a matter of law on the secondary meaning of the crimson and blue color scheme as a trademark, and the court declined to find that KU met the “heightened burden” of proving that the jury could have reached no other conclusion but that the KU color scheme alone had acquired secondary meaning as a trademark.¹⁰⁴ The defendant Sinks raised functionality as a defense, but like the Fifth Circuit in *Smack Apparel*, the district court appeared to focus solely on the *Inwood* test of cost, quality, use, or purpose of the article and devoted no discussion to the aesthetic functionality doctrine, stating, “there is no evidence that KU’s marks are essential to the quality of the T-shirts, or affect how the T-shirts ‘work.’”¹⁰⁵

In contrast, in *Texas Tech University v. Spiegelberg*, the district court recognized trademark protection in the scarlet and black color scheme of Texas Tech (“Tech”) alone, but attributed secondary meaning in the color scheme to the geographic region of Lubbock, Texas, only.¹⁰⁶ Tech sued Spiegelberg for trademark

THE PHOG, BEWARE OF THE PHOG as well as the crimson and blue color scheme, and other indicia, but the court concluded that the plaintiffs did not articulate how these marks should be categorized for purposes of determining protectability, strength, or fame.

100. *Id.* at 1229.

101. *Id.* The four shirts included (i) use of the word KANSAS in white block lettering with one T-shirt in crimson and one T-shirt in blue, (ii) the word mark HAWK KUTIE, (iii) a KU logo, and (iv) the crimson and blue color scheme used in connection with these logos and other indicia.

102. *See id.*

103. *Id.* at 1247. In a subsequent opinion, *Univ. Kansas v. Sinks*, 644 F. Supp. 2d 1287 (D. Kan. 2008), the district court allowed two more shirts to be added to the infringing group for a total of six infringing shirts.

104. *Id.* at 1303.

105. *Id.* at 1252.

106. *Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 527 n.2 (N.D. Tex. 2006) (“Even if it cannot be said that Texas Tech’s scarlet and black color scheme is distinctive

infringement and related unfair competition and dilution claims for Spiegelberg's sale of unlicensed Tech merchandise after his official license from Tech had been terminated in 2003 for failure to provide a proper accounting of royalties.¹⁰⁷ Spiegelberg's two storefronts depicted Tech's scarlet and black color scheme, and a store logo, which comprised a "Red Raider" character.¹⁰⁸ Spiegelberg raised functionality as a defense in his use of the scarlet and black color scheme, and similar to *Sinks* and *Smack Apparel*, the court focused on the *Inwood* test of cost, quality, use, or purpose and did not analyze aesthetic functionality.¹⁰⁹ The court concluded that Spiegelberg produced "no evidence that the use of the Texas Tech color scheme could affect the cost or quality of the products or are the reason the products work."¹¹⁰ The court used as an example that "[t]he fact that a knit cap is scarlet and black or bears a 'Double T' does not affect the quality of the cap or its ability to keep one's head warm."¹¹¹ Rather, the court concluded that "the scarlet and black color scheme of a product can serve the important function of showing that the product is officially licensed by Texas Tech" and that "products which are sold in Lubbock, Texas, that bear the scarlet and black color scheme have become associated with a specific source—Texas Tech."¹¹² In sum, the *Texas Tech* court failed to analyze the applicability of the aesthetic functionality doctrine in the context of color alone, intentionally restricted its determination of secondary meaning in the color scheme to the limited geographic region of Lubbock, Texas (noting the presence of universities in other states that use scarlet and black as a color scheme),¹¹³ considered the "other indicia" Spiegelberg used together with the color scheme, and weighed the "intentional, deliberate, and willful" bad faith of Spiegelberg in

across the nation, it would not affect the analysis. This is so because trademark rights are territorial in nature. See 4 McCarthy, *supra* note 31, § 26.27. Therefore, the relevant territory which the court must consider in determining distinctiveness of the scarlet and black color scheme is not national, but local to Texas Tech. In this university town, a display of the scarlet and black color scheme on a game day (or any other day) is almost certainly a show of support for Texas Tech.").

107. *Id.* at 516.

108. *Id.* (The name "Red Raiders" refers to the Texas Tech football team name.).

109. *Id.* at 520 (The court expressed confusion about how a color scheme could be functional, stating, "[i]ndeed, it is unclear how one could argue that the mere adding of the Texas Tech color scheme could be 'the reason the [product] works.'").

110. *Id.* at 520.

111. *Id.*

112. *Id.*

113. *Id.* at 527 n.2; see also San Diego State Univ., <http://www.sdsu.edu/> (last visited Apr. 10, 2014); see also Ark. State Univ., <http://www.astate.edu/> (last visited Apr. 10, 2014); see also Univ. Ga., <http://www.uga.edu/> (last visited Apr. 10, 2014), and others.

marking both licensed and unlicensed products as “officially licensed” to ultimately hold for Tech on its infringement claims.¹¹⁴

As discussed in *In re FTD*, both traditional and aesthetic functionality can apply to color marks used in dynamic settings where color plays an important role, but it is often aesthetic functionality that is the appropriate doctrine to apply in cases in which color, by its nature, makes it difficult to evaluate the issue of functionality from a purely utilitarian standpoint. In *Smack Apparel*, *Sinks*, and *Texas Tech*, the courts never applied an aesthetic functionality analysis to the university color schemes. With the exception of *Texas Tech*, in which the court held a color scheme alone was protectable in Lubbock, Texas, only, the presence of other university indicia played a role in the courts’ determination that the university marks were valid and enforceable. It should also be noted that in *Smack Apparel*, *Sinks*, and *Texas Tech*, the defendants were merchandise vendors who exhibited bad faith behavior and an intent to profit from an association with the universities, which the courts weighed in their findings of infringement. The element of bad faith is removed when the competitor in question is another university or non-university (such as a high school or elementary school) seeking to use its color scheme to communicate school pride, and not to reap any benefit from a false association with a competing school.

In *University of Alabama Board of Trustees v. New Life Art, Inc.*, yet another case wrestling with trademark infringement claims invoking protection of university color, the defendant’s use of university colors in his artistic depictions of famous football scenes involving the University of Alabama was deemed to be non-infringing use of the school colors.¹¹⁵ In *New Life Art*, Daniel Moore, an alumnus of the University of Alabama, painted scenes from his alma mater’s football games and sold the paintings, as well as mugs, calendars, and other products bearing prints from the paintings. The University of Alabama allowed Moore to produce his paintings without any complaint for several years, and, in fact, offered the paintings in the University campus bookstore.¹¹⁶ The University eventually entered into formal licensing agreements with Moore for some products bearing Moore’s works, but these licensed products also included additional University trademarks on the packaging. In 2002, after years of painting images of the University football team, the University suddenly told Moore he would need permission to depict the University’s uniforms in his paintings because they were

114. *Texas Tech*, 461 F. Supp. 2d at 526–27.

115. *Univ. Ala. v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012).

116. *See id.* at 1270.

trademarks.¹¹⁷ Moore contended he did not need permission because the uniforms were being used to realistically portray historical events. The parties could not agree on this issue, and the University sued. There were miscellaneous breach of contract claims to sort through, but the central trademark issue was whether Moore's use of the team uniforms (in University colors) in his paintings constituted trademark infringement, or whether such use was protected as artistic expression under the First Amendment.¹¹⁸ The Eleventh Circuit affirmed the district court's determination that Moore's use of University colors was protected under the First Amendment because the artistic relevance of depicting the uniforms in University colors in Moore's creative works outweighed any source confusion that might arise.¹¹⁹ On the issue of functionality, the Eleventh Circuit concluded it did not need to address whether the University's marks were functional because the First Amendment defense applied. Hence *New Life Art* was neutral on the applicability of the functionality doctrine in the context of university color.

B. USPTO Review: Protection of Color in Sports (Including Universities)

While *New Life Art* was being litigated, in 2010, the University of Alabama (via the Board of Trustees of the University of Alabama as the applicant) attempted to protect its crimson and white color scheme in connection with its football jerseys and its football helmets by filing trademark applications in the USPTO covering these two areas of trade dress.¹²⁰ In its football jersey applications, the University of Alabama claimed in its description of the mark:

The color(s) crimson and white is/are claimed as a feature of the mark. The mark consists of the product configuration of a collegiate football jersey, which includes the color combination of a crimson red jersey with white numbers with no other indicia, with the white numbers appearing on the chest and the crimson red covering the entire outer surface of the jersey. The broken lines of the drawing show the position of the colors

117. *See id.*

118. *See id.* at 1285.

119. *New Life Art*, 683 F.3d at 1290.

120. *See, e.g.*, U.S. Application Serial No. 85/975048 ("App. '048") depicting a crimson and white helmet configuration for registration in Class 16 (filed May 19, 2010); *see also* U.S. Application Serial No. 85/042346 ("App. '346") depicting a crimson and white helmet configuration for registration in Classes 9 and 41 (filed May 19, 2010); *see also* U.S. Application Serial No. 85/042358 ("App. '358") depicting a crimson and white jersey configuration for registration in Classes 25 and 41 (filed May 19, 2010); *see also* U.S. Application Serial No. 85/975049 ("App. '049") depicting a crimson and white jersey configuration for registration in Class 16 (filed May 19, 2010).

and the numbers on the goods and form no part of the mark, serving as a positional reference only.¹²¹

The University of Alabama applied for the crimson and white football jersey trade dress in connection with entertainment and educational services in Class 41, and jerseys in Class 25, as well as paper articles in Class 16 in its second application.¹²² The applications (originally one application but divided into two based upon applicant's request to divide) received numerous objections from the examining attorney, including failure to function as a mark, functionality, depiction of multiple marks, and use of a phantom mark,¹²³ and both applications were eventually abandoned by the applicant in October, 2012.¹²⁴ In the spirit of "try, try again," in November, 2012, the University of Alabama filed new applications for similar crimson and white football jersey trade dress trademarks in the same classes (16, 25, and 41), but it narrowed the scope of the claimed trademarks to include the additional element of a white stylized letter "A" in a circular

121. See *id.*; see App. '358, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4804:nwxpr8.2.4>; see also App. '049, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4804:nwxpr8.2.3>.

122. See *id.*

123. See, e.g., App. '358 Priority Action dated Sept. 14, 2010, <http://tsdr.uspto.gov/documentviewer?caseId=sn85042358&docId=PAT20100914135627#docIndex=17&page=1>.

124. See *id.* The functionality refusal applied to the configuration of the goods and not the color scheme *per se*, yet the examiner issued an "information requirement" in both the '049 and '358 Apps. regarding use of color in the industry and whether competitors use the same color scheme, and it does not appear that the applicant ever addressed these specific inquiries in its responses to the Priority Actions. See, e.g., App. '358 Response dated Nov. 18, 2010, <http://tsdr.uspto.gov/documentviewer?caseId=sn85042358&docId=IPC20101123071705>; see also App. '049 Response dated Nov. 18, 2010, <http://tsdr.uspto.gov/documentviewer?caseId=sn85975049&docId=IPC20101210135258#docIndex=16&page=1>. But the examiner conducted his own third-party search and attached this evidence to his Final Office Actions. Ultimately, the examiner concluded the applicant was unable to provide sufficient evidence of distinctiveness to satisfy registration under § 2(f) for the marks as claimed, notwithstanding significant duration of use. Particularly, the examiner noted in the Final Office Action dated April 23, 2012, "*Because of the large number of other universities that use the dark red and white jerseys, the evidence is insufficient to show acquired distinctiveness of the mark because the claim to the red and white is so common.*" In view of the many highly similar red and white jerseys in football requires substantial proof that the applicant's jersey stands out and is recognized, particularly when applicant alleges the basis for this is the absence of some other source indicator on it. The applicant's argument distills down to whether people will recognize a crimson red and white jersey because it has no source indicator on it which requires a substantial amount of evidence on that very particular point. Hence, in view of the Office's position that the lack of other source indicia does not raise the quality of applicant's evidence nor alter the underlying requirement to show source significance in deep red and white alone, attached examples of other collegiate uniforms bearing the same features of deep red and white for football jerseys." (emphasis added); see, e.g., App. '358 Final Office Action dated Apr. 23, 2012, <http://tsdr.uspto.gov/documentviewer?caseId=sn85975049&docId=OOA20120423151642#docIndex=1&page=1>; see also App. '49 Final Office Action dated Apr. 23, 2012, <http://tsdr.uspto.gov/documentviewer?caseId=sn85975049&docId=OOA20120423151642#docIndex=1&page=1>.

shaped white seal at the center of the jersey's neckline.¹²⁵ These applications are currently in examination. The additional letter and seal element may prove to be sufficient to tip the scales in favor of registration, as both applications were approved for publication, yet at the time of writing, they both were subsequently pulled back by the USPTO for additional review.¹²⁶

In its applications to cover the crimson and white color scheme on a football helmet, the University of Alabama restricted its trade dress claim to the color crimson on a helmet configuration, white numbers,¹²⁷ and a white stripe running from front to back through the center of the helmet.¹²⁸ The identifications cover sports helmets in Class 9, paper articles in Class 16, and entertainment and educational services in Class 41.¹²⁹ With a claimed date of first use in commerce of 1984 for Class 9, and 1961 for Classes 16 and 41, there is extensive duration of use, but the University of Alabama still received numerous objections from the examining attorney, including failure to function as a mark, and functionality.¹³⁰ After a series of office actions, and a 328-page response from the applicant, detailing the acquired distinctiveness of the crimson and white color scheme in the context of a single striped helmet configuration, registrations eventually issued under Section 2(f) of the Lanham Act in 2011.¹³¹ The language carving out the scope of the registered helmet marks is the following:

The color(s) crimson red and white is/are claimed as a feature of the mark. The mark consists of the trade dress comprising the color combination of a crimson red helmet with white numbers, with the white numbers appearing on the sides of the helmet just above the ear holes and the crimson red covering the entire outer surface of the helmet. The white stripe running from front to back along the center of the helmet is also a part of the mark. The broken lines of the

125. See, e.g., U.S. Application Serial No. 85/774310 ("App. '310") (filed Nov. 8, 2012); see also U.S. Application Serial No. 85/774312 ("App. '312") (filed Nov. 8, 2012).

126. See *id.* (The current status for App. '310 is "Application withdrawn by USPTO after publication for further review or action by the Office." Likewise, the current status for App. '312 is "Application withdrawn by USPTO before publication for further review.").

127. In App. '346, the number element was removed in prosecution, whereas in App. '048 the number element remained; see, e.g., App. '346 in Classes 9 and 41, http://tsdr.uspto.gov/#caseNumber=85042346&caseType=SERIAL_NO&searchType=documentSearch; see also, App. '048 in Class 16, http://tsdr.uspto.gov/#caseNumber=85975048&caseType=SERIAL_NO&searchType=document. App. '346 and App. '048 were originally the same application before a request to divide was filed by the applicant on Nov. 17, 2010.

128. See *id.*

129. See *id.*

130. See, e.g., Priority Action dated Sept. 14, 2010, <http://tsdr.uspto.gov/documentviewer?caseId=sn85975048&docId=PAT20101210133905#docIndex=12&page=1>.

131. See, e.g., U.S. Registration No. 3,955,150 in Class 16 (issued May 11, 2011); see also U.S. Registration No. 4,030,682 in Classes 9 and 41 (issued Sept. 27, 2011).

drawing show the position of the colors and the numbers on the goods and form no part of the mark, serving as a positional reference only. The helmet, including the facemask, and the black shading representing the interior of the helmet, form no feature the mark.¹³² (in Class 16);

The color(s) crimson red and white is/are claimed as a feature of the mark. The mark consists of the trade dress comprising the color combination of crimson red and white, the crimson red as applied to the outer surface of the helmet and the white as a stripe running from front to back along the center of the helmet. The broken lines of the drawing form no part of the mark, serving as a positional reference only. The helmet, including the facemask, and the black shading representing the interior of the helmet, form no feature the mark.¹³³ (in Classes 9 and 41).

In the helmet cases, the depiction of the crimson and white university color scheme is narrow in scope with its use of the crimson color limited to a helmet configuration, and the white color element restricted to a single stripe running from front to back down the center of the helmet in Classes 9 and 41, and a white stripe with a white number component in the Class 16 registration. Even if another university claimed use of a crimson and white color scheme, it may be difficult for the university to show it has a competitive need to use its crimson and white color scheme in the same manner. By the same token, the University of Alabama is restricted in its enforcement of its helmet registrations to block third-party use of color trade dress that is confusingly similar to the single striped crimson helmet marks depicted in its registrations. Arguably, even the inclusion of a double white stripe on a crimson colored sports helmet could be enough to distinguish another party's mark from University of Alabama's helmet registrations. It is the limited scope of the color claim in the helmet trade dress that likely contributed to the success of the helmet registrations.

Although not a university trademark, the Dallas Cowboy Cheerleader color trade dress also demonstrates how a sports team color scheme, in a narrowly defined design, has been accepted by the USPTO and survived without subsequent challenge. In U.S. Registration No. 2,906,113, the description of the mark states:

The mark consists of a cheerleader uniform comprising a blue long sleeved, cuffed and colored half blouse which is tied in front, covered by a white-half vest with fringe on the bottom and featuring blue five-point stars outlined in silver, white mini-shorts with a "v" drop front featuring blue five-point

132. *Id.*

133. *Id.*

stars outlined in silver, and white western boots. The drawing is lined for the color blue.¹³⁴

The recitation of services covers entertainment services and fan club services in Class 41.¹³⁵ In its prosecution history, similar to other color trademarks, the cheerleader uniform trade dress received rejections on the basis of failure to function as a mark and lack of acquired distinctiveness, which the applicant was able to overcome.¹³⁶ No functionality refusals issued while the application was pending, but the scope of the claimed color features of the mark always has been restricted to a highly stylized design.

It would be difficult for a competitor to reasonably claim a competitive need to use a blue and white color scheme in a design consisting of a long-sleeved, cuffed half-blouse that is tied in a knot, together with five-point stars depicted on white fringed half vests, and mini-shorts, as worn by cheerleaders. The scope of the claimed color trade dress is simply too limited for any party to reasonably object on the theory that exclusive rights to this particular design inhibits its ability to compete. Accordingly, the Dallas Cowboy Cheerleader trade dress received federal registration based upon evidence of acquired distinctiveness and it remains a valid service mark.

In contrast, and underscoring the point that federal registration does not provide immunity to the functionality analysis later, Sportvision, Inc. secured a federal registration for the color yellow as applied to a line denoting a location of interest (such as a first down) in the broadcast of a football game.¹³⁷ The available prosecution history at the USPTO does not make clear whether a functionality refusal issued in examination, but the registration issued under Section 2(f) of the Lanham Act, implying the registrant properly made a case of “acquired distinctiveness” to support its registration.¹³⁸ In the fall of 2003, Sportvision became aware that another party, Sportsmedia Technology Corporation, was providing a yellow virtual first down line indicator in college

134. U.S. Registration No. 2,906,113 (issued Nov. 30, 2004).

135. *See id.*

136. *See id.*; *see also* prosecution history for U.S. Registration No. 2,906,113, http://tsdr.uspto.gov/#caseNumber=76976635&caseType=SERIAL_NO&searchType=docum.

137. *See, e.g.*, U.S. Registration No. 2,622,916 (issued Sept. 24, 2002; canceled May 16, 2009) (The mark “consists of the color yellow used on a virtual line that appears as an image on a football field during a television or video broadcast of a football game. The portion of the drawing in dotted lines depicts a portion of an image of a football field including line markers, and serves to show positioning of the mark. The drawing is lined for the color yellow.” The recitation of services covers: “[e]nhancing video images for others by adding an electronic visual display or graphic, namely, a line, which denotes a location of interest in an image, a video or a broadcast of a football game” in Class 40).

138. The prosecution history of U.S. Registration No. 2,622,916 is not completely displayed online at <http://www.uspto.gov>.

football broadcasts.¹³⁹ Sportvision demanded that Sportsmedia cease infringement of its intellectual property rights in the yellow line trademark, but the activity continued in other broadcasts, including ABC Monday Night Football broadcasts.¹⁴⁰ In 2004, Sportvision sued in the Northern District of California on the basis of trademark infringement, and Sportsmedia filed a motion for partial summary judgment arguing that Sportvision's infringement claims failed as a matter of law because Sportvision did not have a valid trademark in the yellow line.¹⁴¹ The district court granted the summary judgment motion, stating, "[d]efendant has not only presented evidence of functionality sufficient to overcome the evidence of *prima facie* validity, but Plaintiff has also failed to raise a genuine issue of material fact."¹⁴² The court emphasized the importance of competitive effect and whether "the asserted product feature, which gives a product its distinctiveness, is the best, or at least one, of a few superior designs for its *de facto* purpose, then it follows that competition is hindered."¹⁴³

In its determination of functionality, the court focused on two principal arguments put forth by the defendant: (i) *Quality*: The color yellow is functional "because it affects the quality of the first down indicator. A virtual yellow line is easier for viewers to perceive when used against the colors of a football field."¹⁴⁴ (ii) *Competition*: "[T]o limit competitors' options by allowing Plaintiff exclusive appropriation of one of the most marketable colors would cause 'significant non-reputation related disadvantage' to competitors."¹⁴⁵ In its analysis, the court weighed heavily that the relevant consumers, broadcast networks such as ESPN, preferred the color yellow as a first down line indicator in broadcasts because it was both visible and nondistracting.¹⁴⁶ Evidence showed that ESPN expressly requested yellow over all other available color choices, and that broadcast network, ABC, would choose the vendor who could offer the color yellow as the first down line

139. Sportvision, Inc. v. Sportsmedia Tech. Corp., Case No. C 04-03115 JW (N.D. Cal. 2005), available at <http://www.jurisnotes.com/Cases/sportvision.pdf>.

140. See *id.* at 3.

141. See *id.*

142. *Id.* at 4.

143. *Id.* at 7.

144. *Id.* at 8.

145. *Id.*

146. *Id.* Evidence showed that Sportvision gave ESPN the option to choose the color for the first down line, and ESPN conducted a series of tests to determine which color would transmit the best on television. ESPN ultimately concluded that the color yellow was "the best, or one of the best colors to use against the colors of a football field" in a television broadcast because "it contrasted better with the green playing field and was less obtrusive," and selected yellow based upon its tests. The court concluded that the ESPN tests weighed against Sportvision's arguments that the selection of yellow was arbitrary.

indicator over other vendors.¹⁴⁷ The court concluded Sportvision's federal registration lost its evidentiary significance in the infringement analysis due to the functionality determination and Sportsmedia ultimately prevailed against Sportvision in the infringement claims as well.¹⁴⁸ In a subsequent motion, Sportsmedia requested the court to order the cancellation of Sportvision's federal registration for the yellow line pursuant to 15 U.S.C. Section 1119, and the court complied, stating "[a] trademark registration must be canceled if the mark is functional."¹⁴⁹

C. A Balancing Act

Harkening back to the early trademark cases of *Brunswick* and others, the public policy objective of keeping desirable and useful colors open for all to use to compete effectively appears in most cases involving color even today. While *Qualitex* instructs that color alone can be protected as a trademark, the balance the trademark owner must strike between protecting its interests without treading too far on competitor interests is to claim trademark rights in a manner that does not unreasonably restrict the use of a feature that should be available for all to use. When the color claimed as a trademark is cast too broadly such that it curtails legitimate competition, claims a utilitarian feature, or claims a non-use of a mark, the trademark claim may be required to be restricted along the lines of *Louboutin*, or receive an all-out rejection as shown in *Brunswick*, *In re FTD*, and *Sportvision*. This balance of interests is a highly factual analysis, and it could subject a trademark owner to rejections on multiple bases, including functionality, failure to function as a trademark, failure to establish acquired distinctiveness, failure to use the mark consistently in the specimens of use, and others. However, if the color trademark claim is narrow in scope such that it will not be deemed an unreasonable restriction on competitors, and it will not withdraw a useful feature from the reservoir of available color choices, as we have seen in the case of the Dallas Cowboy Cheerleader uniforms, and the University of Alabama helmet configurations, or it contains other "source identifying indicia" such as the modified University of Alabama jersey applications, then exclusive rights as a trademark may well be justified.

In the examination of university colors as trademarks, competitive need and the availability of alternatives should be

147. *Id.* at 10.

148. *Id.* at 15.

149. *Id.* Order Granting Sportsmedia's Motion to Modify Partial Summary Judgment Order, available at http://scholar.google.com/scholar_case?case=16587591061824875544&hl=en&as_sdt=6&as_vis=1&oi=scholar.

considered carefully because of the simple unavoidable fact: many universities use the exact same color schemes. As anyone can attest when seeing university students painted head to toe in their school colors at university sporting events, the use of color in a university sports setting is dynamic and communicative, like the use of color in the floral industry described in *In re FTD*. When a university wishes to communicate school pride by using its school colors, it will likely use one or both of its colors, and hence the availability of alternatives to coexisting schools with shared colors is really small.

Therefore, if one university claims exclusive rights in one or more of its colors, a determination of trademark rights should turn on how restrictive the trademark claim is in the context of its stated goods or services, to maintain the proper balance between the right of the public to use a useful feature, and the right of a brand owner to an exclusive property claim in its innovative use of color. With this balance of interests in mind, we review Boise State University's "color blue" trademark.

D. Case Study: Boise State University "Color Blue" Registration

On November 10, 2009, Boise State University received a federal registration for use of the single color blue on a football field.



U.S. Registration No. 3,707,623 for the mark "the color blue" used on the artificial turf in the stadium issued in connection with

[e]ntertainment services, namely the presentation of intercollegiate sporting events and sports exhibitions rendered in a stadium, and through the media of radio and television broadcasts and the global communications network.¹⁵⁰

Per the scope of the registration, Boise State has an exclusive right to use the primary color blue as the color of its university stadium field indefinitely. Any other university using the color

150. U.S. Registration No. 3,707,623 (issued Nov. 10, 2009). (The description of the mark reads, "The color(s) blue is/are claimed as a feature of the mark. The mark consists of the color blue used on the artificial turf in the stadium. The matter shown in broken lines on the drawing shows positioning of the mark and is not claimed as a feature of the mark.").

blue on artificial turf in its stadium field can be blocked by Boise State.

For example, University of New Haven (UNH), a school founded in 1920, uses the blue and gold color scheme as its school colors.¹⁵¹ In 2008, UNH received a major donation from its alumnus, Ralph DellaCamera Jr., to restart the football program, and UNH used some of the funding to install blue artificial turf on its stadium field.¹⁵² While UNH admitted to being inspired by Boise State, the choice of the color blue was related to UNH's own school colors, blue and gold.¹⁵³ On September 18, 2008, an article in *Idaho Statesman* discussed the blue field UNH had installed one week earlier, and that Boise State now had some competition.¹⁵⁴ The athletic director, Debbie Chin, said "Absolutely. We're making a statement. We are bringing football back and we are doing it the right way."¹⁵⁵ The article also noted that three high schools (in Barrow, Alaska; Hidalgo, Texas; and Lovington, New Mexico) also play football on blue surfaces.¹⁵⁶ One day after the appearance of the *Idaho Statesman* article—on September 19, 2008—Boise State filed its trademark application in the USPTO for its blue field.¹⁵⁷ Boise then sent UNH a "cease and desist" letter, and a dispute ensued. On June 12, 2009, and again on July 16, 2009, UNH filed extensions of time to oppose the Boise State trademark application for the blue field.¹⁵⁸ The parties eventually settled without litigation, and UNH agreed to license the "color blue" trademark for use on its new DellaCamera field, even though, technically, its field was blue with gold end zones, and technically, Boise State's field was blue with orange end zones.¹⁵⁹ In subsequent media statements, Boise State's athletic director, Debbie Chin, was quick to point out that UNH intended to use blue and gold all along. "We have a blue and gold field,

151. See, e.g., The Official Site of the University of New Haven Chargers, <http://www.newhavenchargers.com/> (last visited Apr. 12, 2014).

152. *University of New Haven: Blue and Yellow Turf Field New Home of Charger Football* (Sept. 30, 2008), <http://www.newhaven.edu/news-events/news-releases/news-archive/24289/> (last visited Apr. 12, 2014).

153. *Id.*

154. *University of New Haven decides to go blue, too*, IdahoStatesman.com (Sept. 18, 2008), <http://www.newhaven.edu/24574.pdf> (last visited Apr. 12, 2014).

155. *Id.*

156. *Id.*

157. See, e.g., prosecution history for U.S. Registration No. 3,707, 623, available at http://tsdr.uspto.gov/#caseNumber=77574724&caseType=SERIAL_NO&searchType=documentSearch.

158. See USPTO TTABVUE History for U.S. Registration No. 3,707, 623, available at <http://ttabvue.uspto.gov/ttabvue/v?pno=77574724&pty=EXT>.

159. Chadd Cripe, "Here's how Boise State protects its trademark on the blue turf," *Idaho Statesman: Bronco Beat* (Sept. 23, 2011, 9:35 AM, updated on Sept. 24, 2011, 5:20 PM), <http://archive.today/Z4yma>.

which was originally our intent. Those are our school colors. We don't have the same colors as Boise State."¹⁶⁰ When Max Corbet, Bronco Director of Sports Information, was asked by a Hawaiian reporter for KGMB9 News why Boise State chose the color blue for its field, Mr. Corbet answered, "We've always been asked, 'why blue?'. . . [a]nd my comment's always been, we didn't want to do orange."¹⁶¹

Like UNH, the three high schools with blue football fields named in the 2011 *Idaho Statesman* article have entered into royalty-free license agreements with Boise State.¹⁶² Rachel Bickerton, Director of Trademark Licensing and Enforcement, indicated that Boise State was not acting "with the intention of stopping other people," but "to protect something that Boise State and the state of Idaho had invested in."¹⁶³ According to the 2011 *Idaho Statesman* article, the Boise State license structure for its color blue trademark includes allowing the alleged infringing school to use the Boise State color blue trademark in connection with its own school football program so long as the alleged infringing school does not imply any association with Boise State, while using Boise State's mark.¹⁶⁴ An excerpt from the 2011 *Idaho Statesman* interview with Director Bickerton is shown below.

Q: What is the policy for other schools using blue turf?

A: When we first went to federally trademark it, it was around the time another school, the University of New Haven, installed their blue field. *We didn't register the trademark with the intention of stopping other people. It was to protect something that Boise State and the state of Idaho had invested in.* We feel, and I think most people agree, that the blue turf has become synonymous with our program like Georgia's "between the hedges," Notre Dame's Touchdown Jesus and Nike's swoosh. We sought to formalize that trademark with a federal trademark registration in 2008. We worked with the University of New Haven and entered into a license, so effectively they could have their blue field and we were able to protect that trademark.

Q: Do you charge other schools for a blue turf license?

A: *We give a license for free. We have agreements that they won't liken themselves to Boise State so there's no confusion.*

160. Graham Watson, "Boise State and New Haven engage in colorful debate," *ESPN.com: College Football Nation Blog* (Sept. 25, 2009, 5:50 PM), http://espn.go.com/blog/ncfnation/post/_id/8185/boise-state-and-new-haven-engage-i.

161. Liz Chun, *Playing on Bronco Blue; Boise's Home Turf*, KGMB9 News Hawaii, lehun@kgmb9.com (Oct. 16, 2008, 5:58 PM), <http://www.newhaven.edu/25549.pdf>.

162. Cripe, *supra* note 159.

163. *Id.*

164. *See id.*

[The University of New Haven] calls theirs a blue and yellow turf to make it clear and distinct. . . . The first high school was Barrow in Alaska and then there's been a whole number since. A lot of them now contact us ahead of time. We just say, "Don't imply that you're related to Boise State, but good luck with your football program and we hope that the kids play well on the blue."

Q: Do you tell them not to call it blue turf?

A: *It just goes back to us saying they can't merchandise themselves as if they're using Boise State's trademarks. With most of them that have contacted us we have talked about compromises. They need to be very clear their merchandise is about their high school and it can't be related or have people associate it with Boise State. It comes down to the design and how it's used.*¹⁶⁵

Back in 1986, when Boise State first chose its blue field, it was the only university with a non-green field. Since 1986, Boise State has pumped a considerable amount of marketing and advertising dollars into building consumer recognition of its blue field. In Boise State's trademark application, the USPTO examining attorney refused the application on the basis that the mark failed to function as a trademark because it was "merely ornamental" and had not acquired sufficient distinctiveness as a trademark.¹⁶⁶ The examining attorney issued neither a refusal on the basis of functionality nor an information request regarding the nature of use of color in the industry, so Boise State never had to address the functionality issue in its application prosecution history.¹⁶⁷ Boise State filed a 513-page response to the Office Action, arguing that Boise State's blue field had acquired secondary meaning as a trademark, with an affidavit from Director Bickerton together with numerous exhibits describing how the color blue on a university football field was uniquely associated with Boise State.¹⁶⁸ The response worked, and Boise State received its federal registration.¹⁶⁹

Since Boise State's trademark registration issued in 2009, other universities have installed football fields displaying their school colors. In 2010, Eastern Washington University installed a

165. *Id.* (emphasis added).

166. *See, e.g.*, U.S. Application Serial No. 77/574724 Color Blue Trademark, Office Action dated Oct. 14, 2008, <http://tsdr.uspto.gov/documentviewer?caseId=sn77574724&docId=OOA20081014075519#docIndex=9&page=1>.

167. *See id.*

168. *See, e.g.*, U.S. Application Serial No. 77/574724 Color Blue Trademark, Response dated Apr. 12, 2009, <http://tsdr.uspto.gov/documentviewer?caseId=sn77574724&docId=ROA20090413173115#docIndex=8&page=1>.

169. U.S. Registration No. 3,707, 623 (issued Nov. 10, 2009).

red field, aligning with its school colors, red and white.¹⁷⁰ In 2011, University of Central Arkansas installed a football field in its Estes Stadium with purple and gray stripes to show allegiance to its school colors, purple and gray.¹⁷¹ In 2012, Lindenwood University–Belleville in Belleville, Illinois, installed a maroon- and gray-striped stadium field to draw attention to its school colors, maroon and gray.¹⁷²

Colored playing surfaces also have appeared in other sports. In the 2012 London Summer Olympics, a blue artificial turf field with pink trim was selected for the field hockey events. According to TEAM USA field hockey forward Michelle Vitesse, “If you look at a bird’s eye view of the Olympic Village, the blue turf stands out and everyone’s drawn to it. And the yellow ball really stands out on the field.”¹⁷³ Vitesse also notes, “Plus our red jerseys on the blue field look awesome.”¹⁷⁴ University of Virginia (UVA), with school colors blue and orange, also installed a blue field hockey field at its school facility.¹⁷⁵ In tennis, both the US Open and the Australian Open selected blue hard courts for “telegenic purposes” in the broadcast of the events.¹⁷⁶ Also in tennis, the Madrid Open installed blue clay courts in 2012, but after complaints by Rafael Nadal and Novak Djokovic that the blue clay was slippery, the red clay was restored.¹⁷⁷ Invariably, the decision to use a different-colored playing surface has been related to the desire to add something special to the event. In response to the London Olympic Committee’s decision to install the blue field hockey field, Vitesse told the *New York Times*, “Green turf, it’s not boring, but it’s old. Why not try something new?”¹⁷⁸

170. Eastern Washington Eagles Football, http://en.wikipedia.org/wiki/Eastern_Washington_Eagles_football (last visited Apr. 12, 2014).

171. http://en.wikipedia.org/wiki/Estes_Stadium (last visited Apr. 12, 2014) *see also* University of Central Arkansas Athletics, <http://uca.edu/athletics/> (last visited Apr. 12, 2014).

172. http://en.wikipedia.org/wiki/Lindenwood_Stadium (last visited Apr. 12, 2014); *see also Lindenwood Stadium Nearing Final Stages of Renovations* (July 11, 2012), <http://belleville.lindenwood.edu/athletics/news/2012/496.html>.

173. Clare Lochary, *For Field Hockey, A New, Blue View*, *NYTimes.com* (July 6, 2012 8:48 AM), <http://london2012.blogs.nytimes.com/2012/07/06/for-field-hockey-a-new-blue-view/>.

174. *Id.*

175. *Id.* It is unknown whether UVA had to seek a license from Boise State to use the color blue on its field hockey field, but per the identification language in Boise’s federal registration “*the presentation of intercollegiate sporting events*,” it seems they would need to, or they are infringing Boise State’s federally registered mark. If UVA did not receive a license from Boise State, the presence of the UVA blue field undermines the validity of the Boise State color blue mark.

176. *Id.*

177. Lochary, *supra* note 173.

178. *Id.*

Boise State's color blue trademark registration and enforcement program raise some real questions: Should all schools that have blue in their school colors be required to seek a license from Boise State to use the color blue on their sports stadium fields? Should Boise State be entitled to a total monopoly in the color blue on a school stadium field forever? Should Boise State's investment in its blue field deplete the color blue as a viable color option for other schools? Should new schools entering football and other sports broadcasts that wish to use the color blue to enhance the telegenic qualities of their playing surfaces be barred from doing so because of Boise State? Is Boise State's color blue trademark merely functional?

IV. IS BOISE STATE'S "COLOR BLUE" TRADEMARK FUNCTIONAL?

A. Functionality Theories and Boise State University

There are reasonable arguments that Boise State's color blue trademark, in its current broad form, is functional. Under *Qualitex* and *TrafFix*, the test for functionality is whether (i) the color affects the cost, quality, use, or purpose of the article (i.e., traditional functionality), or (ii) puts competitors at a significant non-reputation-related disadvantage (i.e., aesthetic functionality).¹⁷⁹ Arguably, Boise State's color blue trademark fails both the traditional and aesthetic functionality tests.

B. Traditional Functionality Discussion

The recitation language of the Boise State trademark registration is relevant to the traditional functionality analysis:

Entertainment services, namely the presentation of intercollegiate sporting events and sports exhibitions rendered in a stadium, and through the media of radio and television broadcasts and the global communications network.¹⁸⁰

The scope of the Boise State trademark registration encompasses entertainment services rendered through the media of radio and television broadcasts.¹⁸¹ According to the *New York Times*, both the US Open and the Australian Open chose blue playing surfaces because these surfaces had telegenic benefits—the color blue was well-suited to television and attractive to the television viewer.¹⁸² Boise State's selection of the color blue

179. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995); *see also* *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

180. U.S. Registration No. 3,707, 623 (issued Nov. 10, 2009).

181. It is unclear how a color mark can be used in a "radio broadcast," but for purposes of this article, the focus will be on television broadcast use.

182. Lochary, *supra* note 173.

(instead of its other school color, orange) may have been influenced by the attractiveness of the color to the television viewer when Boise State games are broadcast. As noted in *Sportvision*, the quality of transmission of color in broadcasts is an important concern of networks. ESPN tested a range of colors before finally deciding on yellow for the first down line offered by Sportvision, and ruled out each and every available color besides yellow for specific reasons associated with broadcast quality.¹⁸³ Boise State's registration restricts the potential for other schools to utilize the important telegenic feature provided by the color blue on their stadium fields. Accordingly, the quality of sports broadcasts rendered by competitors of Boise State is preemptively curtailed by Boise State's color blue trademark.

A second quality issue is linked to the quality of play by the athletes. The home game Boise State uniforms are primarily all blue: blue jerseys, blue pants, and blue helmets (with minor orange trim accents).¹⁸⁴ The blue uniforms are the same shade of blue as the field itself. In certain lighting conditions, it may be difficult to see the Boise State players, clad in all-blue on the blue field. As noted by ESPN photographer, David Wojcik, "[t]he field is blue, the players are blue . . . At night especially, the lights are no good. Even the ball is tough to find, because when the black of the dust pops up from the field, it kind of absorbs the ball, and it becomes a big blue mess."¹⁸⁵ Opposing teams complained.¹⁸⁶ According to ESPN.com, the primary complaint from teams is that Boise State players blend in with the field, providing an unfair advantage over visiting teams.¹⁸⁷ In response to the complaints, the NCAA Football Rules Committee proposed a rule change that would require teams to wear uniforms that contrasted in color to the playing field.¹⁸⁸ Initially, the Mountain West Conference (MWC) banned the blue uniforms when Boise State joined the conference.¹⁸⁹ However, Boise State requested the blue uniforms to be written into its contract with MWC,¹⁹⁰ and then MWC switched

183. *Sportvision, Inc. v. Sportsmedia Tech. Corp.*, Case No. C 04-03115 JW 7-8 (N.D. Cal. 2005), available at <http://www.jurisnotes.com/Cases/sportvision.pdf>.

184. Jerry Hinnen, "NCAA nixes Boise State uniform rule, all-blues OK again," *CBSSports.com: Eye on College Football* (Mar. 7, 2013, 12:11 PM), <http://www.cbssports.com/collegefootball/blog/eye-on-college-football/21826111/ncaa>.

185. Chun, *supra* note 161.

186. Hinnen, *supra* note 184; see also Andrea Adelson, "No All Blue for Boise State home MWC games," *ESPN.com: College Football Nation Blog* (July 26, 2011, 9:39 PM), http://espn.go.com/blog/ncfnation/post/_id/44227/no-all-blue-for-boise-state-

187. Adelson, *supra* note 186.

188. Brian Murphy, "New NCAA rule would outlaw Boise State uniforms at home," *Idaho Statesman: Murph's Turf* (Feb. 13, 2013), <http://blogs.idahostatesman.com/new-ncaa-rule-would-outlaw-boise-states-all-blue-unif>.

189. *Id.*

190. *Id.*

sides and Commissioner Craig Thompson wrote a letter to the NCAA asking for the all-blue uniforms to stay.¹⁹¹ Commissioner Thompson's stated reasons to support the blue uniforms were that it would have a negative marketing impact for the Boise State Broncos and cause undesirable publicity for the NCAA.¹⁹² An excerpt from the Thompson letter is below:

The MW, on behalf of member institution Boise State University, is strongly opposed to the suggested change which states "either the uniform pants or the jersey must clearly contrast with the color of the surface of the field of play". As you know, Boise State Football is known for its signature blue turf. For a majority of their history, they have worn blue pants and blue jerseys when playing at home.

The proposed rule is not related to any student-athlete safety concerns. Furthermore, this regulation could have a significant negative marketing impact for the Broncos. It will also likely result in undesirable publicity for the NCAA, and would most certainly be damaging to the Boise State University brand. Whatever upside might result from this change is not worth the harmful impact it will have on this institution.¹⁹³

The NCAA capitulated and agreed to allow the all-blue uniforms.¹⁹⁴ One notably absent reference in the Thompson letter is the effect on the quality of play by visiting teams against Boise State players. Quality of play is the crux of the complaint by opposing teams. By compelling competing teams to play against its players partially camouflaged by the blue-on-blue, Boise State has a competitive advantage. If the competing teams can't see the Boise State players, they may have trouble performing at an optimal level. How well will opposing teams block, tackle, or intercept passes if they have difficulty differentiating Boise State players from the all-blue field? According to an ESPN.com article published in 2011, "Boise State has won a school-record 32 straight games at home, and never dropped a WAC home game. The last time Boise State lost a conference game at home was in 1998. The Broncos have the nation's No. 1 home winning percentage since 2000, going 69–2. One of those losses came to Boston College in a bowl game."¹⁹⁵ The quality of the recited "entertainment services"

191. Chadd Cripe, "Mountain West writes NCAA to defend Boise State's all-blue uniforms," *Idaho Statesman: Bronco Beat* (Feb. 26, 2013), <http://blogs.idahostatesman.com/mountain-west-writes-ncaa-to-defend-boise-states-all>.

192. *Id.*

193. *Id.* (emphasis added).

194. Chadd Cripe, "NCAA: Boise State football can wear all-blue uniforms on The Blue," *Idaho Statesman: Bronco Beat* (Mar. 7, 2013), <http://blogs.idahostatesman.com/ncaa-boise-state-football-can-wear-all-blue-uniforms>.

195. Adelson, *supra* note 186.

offered in connection with the color blue trademark may be negatively impacted by Boise State's blue field used in combination with its blue uniforms. If Boise State's use of the color blue negatively impacts the quality of entertainment services being rendered by Boise State and competing teams at Boise State home games, then it negatively impacts the quality of the viewing experience for the relevant consumers, the fans.

C. Aesthetic Functionality Discussion

1. Color Depletion

Boise State is one of several universities that (i) use the color blue as part of its university color scheme, and (ii) possess a home stadium field used for "the presentation of intercollege sporting events and sports exhibitions" including through the media of television and a global communications network.¹⁹⁶ University of Virginia, University of Notre Dame, University of Michigan, Syracuse University, Duke University, West Virginia University, Penn State University, and several others, all contain the color blue as part of their school color schemes. These schools also all have home stadiums, and they all have their football games broadcast. If these universities decide to install football field turf in the colors of their school, the color blue is not available for their use. It has been depleted from their available choices by Boise State's federal trademark registration.

The Supreme Court in *Qualitex* said, "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. . . ." ¹⁹⁷ Here, we are presented with a *bona fide* "color depletion or color scarcity" problem. Boise's color blue trademark eliminates the primary color blue as an available choice for schools to use on their fields. While Boise State maintains that the color blue on its field has become synonymous with Boise State, it is probably safe to say that fans of Notre Dame, Penn State, University of Michigan, and other schools that use blue in their color schemes, would disagree that blue belongs solely to Boise State. When these fans see the color blue, they think of their schools. A fundamental problem with Boise State's trademark is that it allows Boise State to control and curtail legitimate competition. Duke, University of Virginia, Penn State, and Notre Dame presumably have no interest in trying to falsely associate their schools with Boise State. There is no bad faith element here, unlike in *Smack Apparel*, *Sinks*, or *Texas Tech*. What the

196. U.S. Registration No. 3,707, 623 (issued Nov. 10, 2009).

197. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 161 (1995).

universities do have is an interest in maximizing their own university visibility in sporting events and broadcasts, and communicating allegiance and university pride among their students, staff, and alumni. School colors play a large part in building that university pride. If schools like Duke and University of Michigan decide to expand the use of their school colors to their football stadium field surfaces, they must ask Boise State's permission to use their own school color on their field to promote allegiance to their own school. Indeed, Boise State expects schools to request permission, as evidenced by Boise State's "cease and desist" letter to UNH in which Boise State expressed hostility toward UNH's decision to proceed "unilaterally" to use the color blue on its field "without contacting or consulting with Boise State" before doing so.¹⁹⁸ Is this reasonable?

2. Competitive Need: Arguments in Favor . . .

There is a competitive need for the color blue to be available for use by other schools on their stadium fields because it is a preferred color by universities and fans to communicate school pride when one of the university colors is blue. In *Brunswick*, compelling factors in the functionality holding were that (i) consumers preferred the color black on outboard motors because it made the motors appear smaller, and (ii) the color black complemented a wide range of boat colors. In *In re FTD*, the TTAB emphasized the competitive need of other florists to use the color black "to convey an appropriate message or sentiment, whether that is elegance, style, festivity, grief, or sympathy" and the preference in the floral industry to use the color black in holiday theme packaging.¹⁹⁹ In *Sportvision*, the court weighed the competitive need of other vendors to use the color yellow in the broadcast enhancement tools they provided to consumers such as ESPN and ABC and that these consumers preferred the color yellow to other available choices.²⁰⁰

198. See, e.g., U.S. Application Serial No. 77/574724 Color Blue Trademark, Response dated Apr. 12, 2009 at 226, citing Oct. 27, 2008, "cease and desist" letter from Rachael Bickerton to outside counsel for UNH ("It is regrettable that UNH elected to proceed unilaterally to install its blue astroturf without contacting or consulting with Boise State in any way . . ."); at 227 ("Again, it is most unfortunate that this situation arose without benefit of prior communication between our schools such that this episode, and its concomitant burden on school fiscal and human resources, could have been avoided."); and at 227 ("UNH shall agree to replace its turf with green or any other colored turf other than one with blue as the predominant color by August 2016."); available at <http://tsdr.uspto.gov/documentviewer?caseId=sn77574724&docId=ROA20090413173115#docIndex=8&page=1>.

199. *In re Florists' Transworld Delivery, Inc. (FTD)*, 2013 TTAB (LEXIS 115, 130–31 (TTAB Mar. 28, 2013).

200. *Sportvision, Inc. v. Sportsmedia Tech. Corp.*, Case No. CV-04-3115 JW (N.D. Cal. 2005).

In the case of Boise State's color blue mark, even Director Corbet of Boise State admitted Boise State was motivated to choose the color blue for its field because it was preferred over Boise State's other school color, orange.²⁰¹ The color blue is a preferred color for the playing surfaces of other sports because its telegenic qualities serve well in the broadcast of sporting events.²⁰² The color blue was selected by the London Olympics to give the presentation of the field hockey games aesthetic appeal to viewers and fans.²⁰³ USA Team member Michelle Vitesse noted how the yellow ball popped against the blue field, and that their uniforms looked "awesome" against the blue field.²⁰⁴ In *Qualitex*, the Supreme Court referenced the "noble instinct for giving the right touch of beauty to common and necessary things," as a basis for aesthetic functionality.²⁰⁵ Boise State's use of the color blue on a playing field may have been motivated by the desire to give an ordinary thing like a football field beauty. However, being the first does not allow a brand owner to carve out an exclusive right to a broad claim to color which should be available for all to use, particularly when the color is a scarce feature shared by many in the communication of school camaraderie, teamwork, and pride in sports settings. Here, there is a competitive need to leave the option of the color blue open for all universities to use on their playing surfaces, regardless of whether Boise State was the first.

3. Competitive Need: Arguments Against . . .

The counterpoint to the "competitive need" argument is: universities do not *need* to color their stadium fields blue to compete in university sports. However, as explained in *In re FTD, Brunswick*, and other cases, competitive need is driven by consumer expectation and reasonable alternatives. Professor Mark McKenna, a leading scholar in the trademark functionality analysis, states: "[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."²⁰⁶ In *Brunswick*, there was a competitive need for the color black to be available for all outboard motor producers to use because the consumers (i.e., boat owners) liked the appearance of the color black on their boat motors. The color black did not make the motor function better. The color black was hardly the only color choice;

201. Chun, *supra* note 161.

202. Lochary, *supra* note 173.

203. *Id.*

204. *Id.*

205. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 169 (1995).

206. Mark P. McKenna, *(Dys)functionality*, 48 Hous. L. Rev. 823, 846-47 (2011).

there were many substitutes available. Yet there were very few, if any, color choices that would be accepted by consumers as reasonable substitutes based upon their preferences. Similarly, in *In re FTD*, if floral designers wished to evoke luxury in the packaging, or align the packaging with a holiday theme such as Halloween, there were few color choices they would accept as substitutes for the color black.

The problem in casting artificial turf in a school color, and then claiming exclusive rights to that color in the context of a football field is that the “reasonable substitutes” accepted by the relevant consumer base are slim. Green, the natural color of grass, is an option. But if schools wish to use the color of the stadium turf as a way to communicate school pride, or to enhance the telegenic qualities of their football field for the medium of television, their choices are limited. They must now work around the basic primary color blue claimed exclusively by Boise State and use another color, which may not be a reasonable substitute. Boise State had the option to say “we didn’t want to do orange” (its other school color), but every other school with blue in its color scheme must avoid use of the color blue on its stadium field to preclude infringement of Boise State’s mark—an unreasonable result, and one that was not intended by trademark law.

D. Can Boise State License Its “Color Blue” Trademark to Competing Universities, High Schools, and Elementary Schools Without Destroying the Mark?

One could argue that Boise State University understands the fundamental problem in capturing a color that should be available to all by reviewing its licensing activities for the blue field. Illustrated by the 2011 interview Rachael Bickerton gave to the *Idaho Statesman* on the subject of licensing, Boise State decided to deal with any infringement problems created by other schools using the color blue on their playing fields by giving them a license. While licensing alleged infringers works well in patent law because no quality control is generally required by the licensor, it is much more problematic in trademark law. The *sine qua non* of a trademark license is quality control. As stated by the International Trademark Association (INTA), “control is needed because a trademark represents the trademark owner’s reputation for goods and services of a certain quality If a licensor does not exercise sufficient control over the quality of goods and services offered by the licensee, the trademark may, in some countries . . . become vulnerable to attack by the licensee or a third party. In other countries, such as the United States, the trademark may be

deemed abandoned.”²⁰⁷ The rationale for requiring quality control is that consumers tend to rely on the trademark owner’s reputation, and accordingly, consumers could be deceived if there is no quality control over the licensee’s use of the licensor’s mark.²⁰⁸

Implied elements of quality control are that the licensees’ use of the defined mark inures to the benefit of the trademark owner and the trademark owner actively polices the licensees’ use.²⁰⁹ If anyone can use the trademark under the guise of a license with no structure defining that use to make sure the use consistently inures to the benefit of the trademark owner, or the trademark owner does not actively monitor its licensees’ use of its mark to make sure such use is in conformance with quality control requirements, then there may very well be uncontrolled (“naked”) licenses in play.²¹⁰ An uncontrolled license destroys the value of the brand, and it will ultimately destroy trademark rights.

In this case, it is a conundrum when Boise State licensees are instructed that they can use the Boise State color blue mark only if they do not suggest any affiliation whatsoever with Boise State.²¹¹ As Director Bickerton told the *Idaho Statesman*, “We just say, ‘Don’t imply that you’re related to Boise State, but good luck with your football program’”²¹² This unusual policy for the “color blue” mark also appears to violate Boise State’s standard licensing policy, which requires the following:

All licensed vendors are required to identify their product with the “Officially Licensed Collegiate Products” label. With this label, alumni, students, fans and supporters know they are buying a product of quality and authenticity that has been manufactured in accordance with University set standards.²¹³

The manifestation of the “color blue” licensing policy is that Boise State’s color blue trademark is being used on UNH’s field

207. *Fact Sheets: Assignments, Licenses and Valuation*, Trademark Basics: Global Trademark Research International Trademark Association (INTA), <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkLicensing.aspx>.

208. *Id.*

209. *See, e.g.*, TMEP § 1201.03(f) (Oct. 2013 ed.), available at <http://www.uspto.gov>. (“In all franchise and license situations, the key to ownership is the nature and extent of the control by the applicant over the goods or services to which the mark is applied. A trademark owner who fails to exercise sufficient control over licensees or franchisees may be found to have abandoned its rights in the mark. *See Hurricane Fence Co. v. A-1 Hurricane Fence Co.*, 468 F. Supp. 975, 986; 208 U.S.P.Q. 314, 325 (S.D. Ala. 1979).”).

210. Jeffrey Pietsch, “Naked Licensing: Trademark Owners Beware,” *Weintraub Tobin: The IP Law Blog*, (Dec. 29, 2010), <http://www.theiplawblog.com/archives/-trademark-law-naked-licensing-trademark-owners-beware.html>.

211. Cripe, *supra* note 159.

212. *Id.*

213. State University Trademark Licensing Policy, <https://licensing.boisestate.edu/licensing-enforcement/> (last visited April 9, 2014).

with a large UNH “Chargers” logo in the middle of Boise State’s trademark.²¹⁴ In Barrow, Alaska, there is a large yellow circular logo in the middle of Boise State’s mark.²¹⁵ In Hidalgo, Texas, there is a substantially sized “H” logo in the center of Boise State’s trademark, and the shade of blue of the field is navy.²¹⁶ In Lovington, New Mexico, there is a prominent “Wildcat” logo in the center of Boise State’s trademark.²¹⁷

Boise State’s federally registered trademark simply covers “the color blue used on the artificial turf in the stadium,” and therefore, technically, it could encompass navy, royal blue, or any shade of blue.²¹⁸ The depiction of the mark in the registration drawing does not include any logo in the center of the drawing, notwithstanding the fact that Boise State uses a BOISE STATE (and “Bronco” design) logo in the middle of its own blue turf.²¹⁹ One may be tempted to argue that even Boise State is not using its current color blue mark as registered, and perhaps may never have used its color blue mark as registered if its field always included a BOISE STATE (and “Bronco” design) logo, because the

214. *See, e.g.*, The Official Site of University of New Haven Chargers, <http://www.newhavenchargers.com/sports/2010/2/11/dellacamerastadium.aspx?path=football> (last visited Apr. 17, 2014).

215. *See, e.g.*, Google Images of Barrow, Alaska high school football stadium field (home of the Barrow Whalers), <http://www.google.com/search?q=football+field+barrow+alaska&tbm=isch&tbo=u&source=univ&sa=X&ei=h9pPU6j0NISTyAS16IHgCA&ved=0CDEQ7Ak&biw=1024&bih=643> (last visited Apr. 17, 2014).

216. *See, e.g.*, Texas Football Stadiums, Bill Pate Stadium (home of the Hidalgo Pirates), <http://www.texasbob.com/stadium/stadium.php?id=896> (last visited Apr. 17, 2014).

217. *See, e.g.*, Google Images of Lovington, New Mexico high school football stadium field (home of the Lovington Wildcats), <http://www.google.com/search?q=lovington+new+mexico+football+stadium&biw=1024&bih=643> (last visited Apr. 17, 2014); *see also* MaxPreps, a CBSSports.com site, [http://www.maxpreps.com/high-schools/lovington-wildcats-\(lovington,nm\)/football/home](http://www.maxpreps.com/high-schools/lovington-wildcats-(lovington,nm)/football/home) (last visited Apr. 17, 2014).

218. *See, e.g.*, U.S. Registration No. 3,707,623 (issued Nov. 10, 2009). However, the color blue licensing policy may be the only instance when the exact shade of blue is not clearly defined by Boise State. According to the Boise State University “Official Colors/Brand Standards” webpage (<http://brandstandards.boisestate.edu/official-colors/> (last visited May 12, 2014)):

The official colors of Boise State University are blue and orange, more specifically Pantone 286 and Pantone 172, respectively. These colors are as important as the university name or logo in identifying the university. All printed materials, whether produced on coated or uncoated stock, should match color to the coated Pantone chips. The Pantone Matching System (PMS) is the universal reference for selecting and specifying matching and controlling ink colors. It is recommended that samples be requested for every print job to ensure that the PMS colors are accurate. Slight adjustments may be required depending upon the material being produced.

219. *See, e.g.*, Google Images of Boise State University blue field (home of the Boise State Broncos), http://www.google.com/search?q=boise+state+university+blue+field&tbm=isch&tbo=u&source=univ&sa=X&ei=v9RbU_78KfDksATU1IHwDA&ved=0CEMQsAQ&biw=1024&bih=643 (last visited Apr. 26, 2014); *see also* U.S. Registration No. 3,707,623 (issued Nov. 10, 2009); *see also* TMEP.

mark as registered is simply a blue field.²²⁰ However, under USPTO rules, it is not technically wrong to register a background color of a design so long as the applicant can provide sufficient evidence to convince the USPTO that the color alone in its defined design has acquired distinctiveness as a trademark.²²¹ Nonetheless, the overriding concern about Boise State's color blue licensing program is that its licensed mark is not used consistently by Boise State's licensees, and licensees are being instructed to conceal any association with Boise State. If the guiding principle of quality control required by genuine trademark license relationships is to avoid consumer deception, then one can only question whether the interests of consumers are well-served by Boise State's color blue licensing policy.

Another troubling fact is that Boise State's color blue trademark registration covers only "entertainment services, namely, the presentation of *intercollegiate* sporting events and sports exhibitions. . . ."²²² Boise State even admitted in its dispute with UNH that the use of the color blue by the high schools is different.²²³ While the scope of the color claim in Boise State's registration is broad enough to include a variety of shades of blue, its recitation of services in the registration does not mention school use other than intercollegiate use. Naturally, Boise State is a university and not a high school, and therefore its services are rendered in connection with intercollegiate activities. Accordingly, the claimed "acquired distinctiveness" of the color blue mark (a mandatory prerequisite for trademark protection under *Qualitex*) is built upon university use. But this begs the question: can Boise State even license its color blue trademark to high schools and other non-universities if its registration is limited to intercollegiate activities? In other words, following the rationale of *Louboutin*, if

220. See, e.g., Specimen of Use filed Sept. 19, 2008 in connection with U.S. Application Serial No. 77/574,724 for Color Blue Trademark, <http://tsdr.uspto.gov/documentviewer?caseId=sn77574724&docId=SPE20080923075218#docIndex=14&page=1>.

221. See, e.g., TMEP § 1202.05(c) (Oct. 2013 ed.), available at <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml#/manual/TMEP/current/TMEP-1200d1e2146.xml> ("As with all trademarks and service marks, a color mark may contain only those elements that make a separable commercial impression. See TMEP § 807.12(d). Accordingly, an applicant may not seek to register the color of the wording or design apart from the words or designs themselves if the color does not create a separate commercial impression. However, the applicant may register the color of the background material on which the words or design appear apart from the words or design. See TMEP § 1202.11 regarding background designs and shapes.").

222. *Id.*

223. See, e.g., U.S. Application Serial No. 77/574724 Color Blue Trademark, Response dated Apr. 12, 2009, at 226, citing October 27, 2008 "cease and desist" letter ("While we are aware of the three high schools that also subsequently began using blue turf, UHN's [sic] use is very different, as both UHN [sic] and Boise State are NCAA schools, (see Exhibit Seven) and as such, UNH stands well-positioned to generate significant merchandising licensing and attendance revenue from its new blue turf and the NCAA-sanctioned athletic events performed thereon.").

the acquired distinctiveness of the color blue mark relates solely to university use, then schools that are not universities are not engaged in use of the Boise State trademark (similar to YSL and other shoe manufacturers that use the color red on the outsoles of monochrome shoes). These non-universities are simply using their school color on their field. Of course, this logic leads back to the functionality analysis because a compelling motivation for competing university use of the color blue on a stadium field is to highlight a school color. Hence, the anti-competitive effect of claiming exclusive rights to a single color on a sports field cannot be ignored.

And finally, in very recent news, it appears both the number of licenses and the scope of Boise State's claimed trademark rights are growing. In March 2014, it was reported that Brevard High School in North Carolina raised \$19,000 to install a new blue football field because blue is one of its school colors.²²⁴ Boise State University turned down Brevard's request for a license because a local college also uses the high school field.²²⁵ In reaction to the Brevard rejection, in late March 2014, *Idaho Statesman* published another interview with Boise State Licensing Director Rachel Bickerton, again discussing Boise State's licensing structure.²²⁶ According to the 2014 *Idaho Statesman* article, Boise State now enforces trademark rights, not only in the color blue on a football field, but in the use of any *non-green color* on a field.²²⁷ Director Bickerton explains, "[i]n general, when it's another color, we do approve it," adding, however, "[i]f a big school wants to put an orange field in, because it's one of our colors, I can't necessarily say we'd say yes."²²⁸ The article notes that blue became popular after the 2012 London Olympics, and Boise State has issued licenses to seventeen high schools and elementary schools with blue or navy fields, as well as Yale University, University of Massachusetts at Lowell, and the University of New England for blue hockey fields.²²⁹ The 2014 *Idaho Statesman* article further observes that Eastern Washington University's *red* field is under license by

224. Kevin McGuire, *Boise State denies high school a blue football field*, CollegeFootballTalk (March 28, 2014, 1:58 PM EDT), <http://collegefootballtalk.nbcsports.com/2014/03/28/boise-state-denies-high-school-a-blue-football-field/>

225. *Id.*

226. Chadd Cripe, "Here's how and why Boise State controls who installs non-green playing fields," *Idaho Statesman: Bronco Beat* (Mar. 28, 2014), http://blogs.idahostatesman.com/heres-how-and-why-boise-state-controls-who-install-non-green-playing-fields/?utm_source=feedly&utm_reader=feedly&utm_medium=rss&utm_campaign=heres-how-and-why-boise-state-controls-who-installs-non-green-playing-fields.

227. *Id.*

228. *Id.*

229. *Id.* This article does not mention UVA's blue field hockey field, but its field is also blue, implying it is either under license from Boise State as well, or simply running the risk of infringement; see, e.g., Lochary, *supra* note 173.

Boise State, as well as thirty non-green field licenses in total.²³⁰ Boise State's rationale for its enlargement of rights beyond the scope of its color blue trademark registration is that federal registration is not required to hold trademark rights, but "the formality makes the trademark better known and increases the potential damages for violators."²³¹ To aid enforcement efforts, the *Idaho Statesman* article also notes, "Boise State controls the flow of non-green turf by working with the turf manufacturers. They have been informed of Boise State's trademark rights and tell clients that they need to check with the school before proceeding with a non-green field."²³²

While Boise State has stated its goal is not to make money from issuing color licenses to schools (i.e., competing universities, high schools, and elementary schools) because all licenses of the color blue trademark (a/k/a the "non-green" trademark) are free,²³³ one can only question under what authority Boise State is entitled to control *all* color (besides green) used on sports playing surfaces by *all* schools. The Supreme Court in *Qualitex* was careful to note, "courts will examine whether [a color's] use as a mark would permit one competitor (or a group) to interfere with legitimate (non-trademark-related) competition through actual or potential exclusive use of an important product ingredient."²³⁴ Boise State's motives appear to be rooted in protecting its novel use of color because it was the first and not in inhibiting competition or controlling a feature all should be entitled to use. However, asserting rights in a *non-color* is so ambiguous that if such a trademark were claimed within the bounds of a trademark application before the USPTO, it may not even receive the benefit of a filing date because a specific mark has not yet been provided.²³⁵ From this author's viewpoint, imbuing an exclusive proprietary interest in *all* color (besides green) on school playing fields, and denying other schools the right to use *any* color (besides

230. Cripe, *supra* note 226.

231. *Id.* (*Idaho Statesman's* Chadd Cripe summarizing Director Bickerton's response).

232. *Id.*

233. *Id.* (quoting Director Bickerton: "We didn't do this to make money. . . [w]e did it to protect our uniqueness"); see also Cripe, *supra* note 159 (quoting Director Bickerton: "We didn't register the trademark with the intention of stopping other people. It was to protect something that Boise State and the state of Idaho had invested in.").

234. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 169 (1995).

235. See, e.g., TMEP § 807.01 (Oct. 2013 ed.), available at <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/dle2.xml#/manual/TMEP/current/TMEP-800dle1.xml> ("An application must be limited to only one mark. 15 U.S.C. § 1051(a)(1); 37 C.F.R. § 2.52. See *In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366, 51 U.S.P.Q.2d 1513, 1516 (Fed. Cir. 1999). Under 37 C.F.R. § 2.21(a)(3), an applicant must submit 'a clear drawing of the mark' to receive a filing date. . . . Accordingly, if an applicant submits two or more drawing pages, the application is denied a filing date, because the applicant has not met the requirement for a clear drawing of the mark.").

green) on their sports fields without a license from Boise State is an inappropriate extension of trademark law.

In trademark licensing, as in life, you can't have your cake and eat it too. Either the licenses are channeling goodwill for the trademark owner by allowing the licensees to offer comparable goods or services under a specifically defined licensed mark, within a scope of rights a licensor reasonably possesses, and the licensor monitors the quality of the specifically defined trademark used by licensees, as well as the quality of the specifically defined licensed goods and/or services, or the licenses may not be valid licenses.²³⁶

V. PROPER BALANCE: *LOUBOUTIN* AS A GUIDE

No one can dispute that Boise State University was a trailblazer in its innovative concept of installing blue turf on its football field instead of the traditional color green. Striking the proper balance between protecting the interests of the public in its right to a useful color feature and the interests of Boise State in its novel use of color may work if the scope of the Boise State trademark claim is defined more narrowly.

In *Louboutin*, the Second Circuit directed the USPTO to restrict the scope of Louboutin's federal registration in its Red Sole Mark to include a contrasting sole.²³⁷

A modification to the Boise State trademark registration is unlikely to be as simple as the modification in *Louboutin*, particularly because the modified Red Sole Mark was considered still valid and, hence, no cancellation of the registration was required. Moreover, even if modification of the color blue registration were possible, the addition of any new element (such as the color orange to the end zones) likely would be construed as a material alteration to the color blue mark.²³⁸ It is unclear whether

236. See, e.g., Trademark Basics, *supra* note 207; see also William E. Ridgway, *Revitalizing the Doctrine of Trademark Misuse*, 21 Berkeley Tech. L.J. 1547 (2006), available at <http://scholarship.law.berkeley.edu/btlj/vol21/iss4/7> (discussing an equitable public policy-based approach to the trademark misuse doctrine).

237. *Christian Louboutin S.A. v. Yves St. Laurent America Holding, Inc.*, 696 F.3d 206, 228, 229 (2d Cir. 2012).

238. See, e.g., TMEP § 807.14(e)(ii) (Oct. 2013 ed.), available at <http://www.uspto.gov>. ("Exception—Color is the Dominant Portion of the Mark. Generally, if the color portion to be amended constitutes the dominant or most significant part of the entire mark, it becomes more likely that the proposed color amendment is a material alteration. For example, if the design mark consists solely of a common geometric shape, the color element is likely to be the dominant element of the mark. As a result, amending the color of a common geometric shape is likely to be a material alteration. Another factor to consider in assessing the dominance of the color element of the mark is the size or prominence of the color design or graphic element to be amended in proportion to the rest of the mark. For example, if it is clear that the mark consists of the overall color scheme of a product's trade dress, such as the product package or container, an amendment to a particular color element that is small or insignificant in proportion to the entire mark is unlikely to be a material alteration. Conversely, an amendment to a color element that is large in proportion to the

adding orange end zones alone would even resolve all potential issues associated with claiming trademark rights solely in school color on a football field, because other schools with blue and orange as their school colors may be unfairly impacted by the modified trademark claim. A new application would likely have to be filed if the Boise State color blue trademark registration were cancelled under Section 2(e)(5) of the Lanham Act.²³⁹

Nonetheless, *Louboutin*, and other successful sports trade dress trademarks claiming color (such as the University of Alabama helmet registrations) can serve as a general guide. Restricting the claimed trade dress may assist in resolving issues of competitive need. If Boise State files a new application and restricts its claim to the color blue in the configuration of a field together with its BOISE STATE (and “Bronco” design) logo set forth in the middle of its field, such a design may be sufficiently narrow to cure any issue of competitive need. Another possible solution is a claim to the blue field with the orange end zones, and the depiction of the BRONCOS word mark in the end zones. A third option is the combination of both the orange end zones and the blue field together with the accompanying trademark indicia in the middle of the field and the end zones.²⁴⁰ The *quid pro quo* of any limitation is that Boise State’s enforcement of trademark rights could not apply to third party use of blue (or other non-green) fields. Boise State’s enforcement policy necessarily would be cabined by the scope of its restricted trademark claims. However, this is the proper balance in this case. Universities, high schools, and elementary schools that decide to install a blue, or other non-

entire mark, or is a dominant element of the overall color scheme, is more likely to be a material alteration. For example, if a mark consists solely of the color scheme or pattern of a package or container that is equally divided into two colors, amending one or both colors is more likely to be a material alteration.”).

239. The USPTO will not *sua sponte* cancel a registration. A third party allegedly harmed by the registration either must petition to cancel Boise State’s registration in the TTAB under Lanham Act § 14, 15 U.S.C. § 1064(3), or file an action for declaratory judgment in federal court asserting the trademark is invalid. So far, this has not happened. A third option is for a party to raise functionality as a defense in an infringement action brought by Boise State (like the *Sportvision* case), but Boise State continues to issue royalty-free licenses in lieu of suing. Similar to *In re FTD*, another basis for challenge may be to assert that the Boise State service mark is merely ornamental and fails to function as a mark under §§ 1, 2, 3, and 45 of the Lanham Act because the registration is not yet incontestable pursuant to 15 U.S.C. § 1065. However, this issue already was raised in prosecution. Boise State also may voluntarily surrender its registration for cancellation pursuant to § 7(e) of the Lanham Act, 15 U.S.C. § 1057(e). There is no fee to do so. See, e.g., TMEP § 1608 (Oct. 2013 ed.), available at <http://www.uspto.gov>.

240. It is noted that any of these proposed changes renders the resulting trademark claim to be not simply color alone, but rather, a color claim in connection with additional word and/or design elements. However, in this case, this restriction seems appropriate. In other cases, a restriction in scope may allow the nature of the mark to remain a pure color mark, as in the *Louboutin* case. Consideration also must be given to the scope of the recitation of services.

green, field to align with their school colors will not have to seek a license from Boise State University. By the same token, Boise State can continue to build good will in its use of the color blue on a football field, but its scope of rights will be restricted to the color blue together with other university indicia that create an association with Boise State University.²⁴¹

In the end, a useful feature will be available to all schools to use in their stadiums: to build school pride, to communicate school allegiance, to enhance the broadcast features of the school stadium on television, or to simply give the stadium playing surface a touch of beauty, and Boise State's trademark rights will be properly restricted.

VI. CONCLUSION

Color as a trademark can be a powerful branding tool. Courts and the USPTO have recognized the power of color and grappled for years with how such a powerful yet amorphous subject should fit into the realm of trademark law. Since trademark law permits exclusive ownership of a trademark indefinitely, the right of exclusive ownership bestowed by courts and the USPTO must be weighed carefully. Balancing the interests of universities that innovated uses of color with the interests of competing universities (and other schools) that should be entitled to use their school colors as they so choose, we are presented with a challenging analysis. Ultimately, university colors should be recognized as conduits of school spirit shared by many, and the standards for protection of such colors as intellectual property must be viewed in such context. In other words, limits should be in place to prevent one school from monopolizing a broad feature that should be shared by all. The functionality doctrine provides the framework for such limits, and its analysis should apply in the context of unduly broad claims to school color, and specifically in the case of the Boise State University "color blue" trademark.

241. Boise State's modified trademark claim may not cure the "quality" issues created by its players dressed in home game blue uniforms on a blue field, but the NCAA's regulation of uniforms is beyond the scope of this article. Moreover, if the NCAA decided to ban all non-green football fields (like the NFL), the trademark analysis for university fields would be moot, and high schools and elementary schools could do as they wish without worrying about objections from Boise State. However, NCAA regulation of football field colors also is beyond the scope of this article.