Shades of Gray: The Functionality Doctrine and Why Trademark Protection Should Not Be Extended to University Color Schemes

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SHADES OF GRAY: THE FUNCTIONALITY DOCTRINE AND WHY TRADEMARK PROTECTION SHOULD NOT BE EXTENDED TO UNIVERSITY COLOR SCHEMES

KRYSTEN E. KNAUF

I. INTRODUCTION

One of the time-honored traditions of the collegiate experience in this country is the dedication to a school's fight colors. During game days on college campuses, it is common to see thousands of students and alumni alike dressed head-to-toe in the two-color scheme of their alma mater. The mere sight of these two colors paired together stirs the emotions of many. Universities, of course, recognize the revenue stream that exists in selling merchandise featuring its color scheme. Usually, merchandising is licensed to third parties who wish to use the color scheme along with a university's registered marks, such as its logos or mascot. Yet, recent events have left many wondering about the extent to which trademark law protects universities' color schemes when they are not accompanied by other marks. There is precedent to suggest that schools have trademark rights to their school colors, but there is usually some other registered symbol or mark that makes trademark infringement easier to find. The question of whether a university color scheme alone can merit trademark protection is quite novel.

This Article asserts that university color schemes, and colors in general, should not be protected under current trademark law. The color scheme, by itself, is functional and thus cannot be trademarked under the Lanham Act. Part II addresses the essential elements of trademark law under the Lanham Act and examines grounds for protection of a mark. Part II also discusses the functionality doctrine as a bar to trademark protection. Part III analyzes the different approaches taken by courts in either granting or denying trademark protection to university color schemes. Part IV looks at recent controversies

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caused by unauthorized uses of university color schemes. Finally, Part V explains why university color schemes are functional and therefore cannot be given trademark protection.

II. THE BASICS OF TRADEMARK LAW

The Lanham Act, the regulatory authority of U.S. trademark law, defines a trademark as:

[A]ny word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.\(^\text{1}\)

"A predominant objective of trademark law is to prevent consumer confusion in the marketplace."\(^\text{2}\) To further this objective and to protect the commercial interests of trademark owners, the Lanham Act provides a cause of action for any trademark holder who believes that the holder's mark has been infringed upon.\(^\text{3}\)

A. Categories of Marks

Courts determine the distinctiveness of a mark by placing it into one of four categories: generic, descriptive, suggestive, or arbitrary or fanciful.\(^\text{4}\) Marks that are "generic with respect to the [associated] product or service can never be protected as trademarks, because this would be unfair to competitors."\(^\text{5}\) "A descriptive [mark] references a quality or characteristic of the associated good or service."\(^\text{6}\) Examples of descriptive marks include

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3. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 767-68 (1992) ("The Lanham Act was intended to make 'actionable the deceptive and misleading use of marks' and 'to protect persons engaged in... commerce against unfair competition.'") (citing 15 U.S.C.S. § 1127 (1992)).
6. Id. at 739.
“Arthriticare” for a topical arthritis relief gel\textsuperscript{7} and “Pet Pals” for a program promoting the well-being of pets.\textsuperscript{8} A suggestive mark is one that suggests a feature of the good or service and requires the consumer to imagine a cognitive link between the mark and the nature of the product.\textsuperscript{9} Terms such as “brown-in-bag” for transparent plastic cooking bags\textsuperscript{10} and “The Money Store” for money lending services\textsuperscript{11} have been held by courts to be suggestive marks.\textsuperscript{12} Arbitrary marks are usually defined as “those that adapt a common word to an unfamiliar circumstance,”\textsuperscript{13} such as “Apple” for a brand of computers.\textsuperscript{14} A mark is fanciful if it consists of a word or symbol that has been “invented solely for [its] use as [a] trademark.”\textsuperscript{15} Fanciful marks include “Xerox” and “Kodak.”\textsuperscript{16}

On one end of the spectrum, generic marks are not entitled to protection because they exhibit few, if any, distinctive qualities.\textsuperscript{17} On the other end, arbitrary or fanciful marks enjoy full trademark protection “without the need of debating whether the term is ‘merely descriptive’ and with ease of establishing infringement.”\textsuperscript{18} In between generic and arbitrary or fanciful marks are descriptive marks and suggestive marks.\textsuperscript{19} These marks acquire distinction, and thus protection, if they “become distinctive of [an] applicant’s goods in commerce.”\textsuperscript{20} The distinctiveness necessary to obtain trademark protection is commonly known as secondary meaning.\textsuperscript{21} Factors used to find secondary meaning include the length and manner of the use of the mark or trade dress, the volume of sales, the amount and methods of advertising,

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\textsuperscript{7} Bernard v. Commerce Drug Co., 964 F.2d 1338, 1339 (2d Cir. 1992).


\textsuperscript{9} Bartow, supra note 5, at 740.

\textsuperscript{10} Id. at 740-41; In re Application of Reynolds Metals Co., 480 F.2d 902, 904 (C.C.P.A. 1973).

\textsuperscript{11} Bartow, supra note 5, at 741; The Money Store v. Harriscorp Fin., Inc., 689 F.2d 666, 673-74 (7th Cir. 1982).

\textsuperscript{12} Bartow, supra note 5, at 740-41.

\textsuperscript{13} Id. at 741-42.

\textsuperscript{14} Id. at 743.

\textsuperscript{15} Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 11 n.12 (2d Cir. 1976).

\textsuperscript{16} Bartow, supra note 5, at 742.

\textsuperscript{17} See, e.g., Murphy Door Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95, 101 (2d Cir. 1989) (finding that the term “Murphy Bed” had become generic in referring to a bed that folds out of the wall, thus denying trademark protection).

\textsuperscript{18} Abercrombie & Fitch Co., 537 F.2d at 11.

\textsuperscript{19} Id. at 9-11.


\textsuperscript{21} See RESTATEMENT (THIRD) OF UNFAIR COMPETITION §13 cmt. e (1995).
consumer survey evidence, direct consumer testimony, and the defendant’s intent in copying the mark or trade dress. Yet, even with a finding of distinctiveness or secondary meaning, the functionality doctrine can prevent a mark from obtaining trademark protection.

The term “trade dress” refers to a product’s appearance and how it is used as a source identifier or a mark. In order to serve as a source identifier, a product’s appearance must be distinctive because of its color, shape, texture, or “other visible or otherwise palpable feature.” Trade dress, therefore, “serves the same function as trademark and is treated the same way by the Lanham Act” and by the case law interpreting the Lanham Act.

B. Functionality Doctrine

The Lanham Act prohibits trademark registration for any mark that “comprises any matter that, as a whole, is functional.” A valid mark must be nonfunctional, as well as source identifying. “[A] product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” The functionality test articulated by the Supreme Court is whether “exclusive use of the [product] feature would put competitors at a significant non-reputation-related disadvantage.” The idea is to prohibit a trademark owner from “inhibiting legitimate competition by allowing a producer to control a useful product feature.”

A product feature can be functional in three ways: (1) utilitarian, (2) aesthetic, or (3) communicative. In order for a product feature to be functional in the utilitarian sense, it must be “fit... for some purpose [or] something useful or designed for use.” The Supreme Court discussed

25. Id.
30. Qualitex Co., 514 U.S. at 165.
31. Id. at 164.
33. Id. at 1232 (discussing the relationship between functionality and utility) (citing WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 1300 (1987)).
utilitarian functionality at length in the 2001 case *TrafFix Devices, Inc. v. Marketing Displays, Inc.*. The case centered around whether a dual-spring mechanism to permit signs to withstand strong winds was functional and therefore unable to be trademarked. The Court held that for purposes of precluding trade dress protection "a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device."

A product feature is aesthetically functional "if it constitutes 'the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product . . . ." For this reason, the doctrine of "aesthetic functionality" bars protection of an aesthetic feature that forms an "important ingredient in the commercial success of the product . . . ." Aesthetic functionality played a key role in the court's holding in *Wallace International Silversmiths, Inc. v. Godinger Silver Art Co.* In that case, Wallace sued Godinger for trademark and trade dress infringement after Godinger began selling a line of silverware that featured a baroque design very similar to Wallace's popular "Grand Baroque" pattern. The trial court denied the plaintiff's motion, holding that the design was a functional feature of a silverware style and ineligible for protection. On appeal, the Second Circuit affirmed, holding that "where an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the aesthetic functionality doctrine denies such protection."

Similar to aesthetic functionality is communicative functionality. Communicative functionality is the use of a product feature to communicate non-source related meanings. The case of *McNeil Nutritionals, LLC v.*

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35. *Id.* at 33.
36. *Id.* at 33.
37. *In re DC Comics, Inc.*, 689 F.2d 1042, 1049 (C.C.P.A.1982) (quoting Int'l Order of Job's Daughters v. Lindeburg & Co., 633 F.2d 912, 917 (9th Cir. 1980)).
38. *See Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952).
40. *Id.* at 77.
41. *Id.* at 78.
42. *Id.* at 81.
Heartland Sweeteners\textsuperscript{45} provides a great example of communicative functionality as a bar to trademark protection. In that case, the plaintiff argued that the colors of packages of artificial sweeteners effectively communicated the chemical composition of the sweetener to consumers.\textsuperscript{46} Although the Third Circuit did not explicitly use the term “communicative functionality” in its holding,\textsuperscript{47} it is clear that this concept was used as a reason to limit trademark and trade dress rights.\textsuperscript{48}

III. COLORS AS PROTECTED MARKS

A. In General

“Color is essential to the brand-building process because it’s the most visible first point of communication.”\textsuperscript{49} In fact, “[s]everal color marks are registered with the [United States Patent and Trademark Office (USPTO)] . . . for tools and construction materials . . ..”\textsuperscript{50} Consumer products with more commercial exposure also enjoy the protection of color registration.\textsuperscript{51} Perhaps the most well known example is the “eye-catching, [female-sigh-inducing,] robin’s-egg blue color” that is registered for boxes and bags from jeweler Tiffany \& Co.\textsuperscript{52} A service mark can also consist solely of a color when it is used in rendering services or advertising for these services.\textsuperscript{53} United Parcel Service (UPS), for example, has registered “‘the color chocolate brown’ . . . as applied to the entire surface of vehicles and uniforms for the service of transporting and delivering personal property.”\textsuperscript{54} Additionally, the registered slogan “What can brown do for you?” broadcasts UPS’s intentions to use this color brown as a source identifying mark.\textsuperscript{55}

Courts must consider whether a particular color mark is weak or strong and whether a color mark is likely to cause source confusion with similar

\textsuperscript{45} See McNeil Nutritionals, LLC v. Heartland Sweeteners, 511 F.3d 350 (3d Cir. 2007).

\textsuperscript{46} Id. at 363.

\textsuperscript{47} See id.

\textsuperscript{48} Bartow, supra note 43, at 285.


\textsuperscript{50} Id. at 778.

\textsuperscript{51} Id.

\textsuperscript{52} Id.; Principal Register, see Federal TM Reg. No. 2359351 (registered June 10, 2000) (for the boxes); Federal Reg. No. 2416795 (registered Jan. 2, 2001) (for the bags).

\textsuperscript{53} Gilson \& LaLonde, supra note 49, at 778.

\textsuperscript{54} See Federal TM Reg. No. 2901090 (registered Nov. 9, 2004).

\textsuperscript{55} Federal TM Reg. No. 2649286 (registered Nov. 12, 2002).
shades of that color. Will a certain shade of blue be likely to cause source confusion with a shade of blue-green? White might be generic for kitchen appliances like coffee machines or toasters, while unexpected colors like neon green or dark purple could be arbitrary.

B. Colors Obtaining Trademark Protection

Until 1985, no United States court had granted protection to color, in and of itself, as a means of marking goods. This was not based on a theory that color was incapable of functioning as a trademark, for color, just as words, can convey information. Rather, there were considered to be an insufficient number of different colors to be allocated among all possible producers of a given class of product. Moreover, it was said, if protection of color were available, there would be difficulty distinguishing the protected color from similar shades of that color.

In the notorious case of In re Owens-Corning Fiberglass Corp., the Federal Circuit found that Owens-Corning had done everything right. The company made an overwhelming showing of acquired distinctiveness, having advertised its pink color mark for home insulation for over thirty years and having spent over $42 million on consumer advertising. Many of these commercials featured the Pink Panther cartoon character to promote the use of the pink insulation and used the slogan, "Put your house in the pink." The backing of the paper of the insulation bore the trademarked words ‘Owens-Corning,’ but the court was convinced that consumers recognized . . . the pink

57. Id.
58. See id.
59. Lawrence B. Ebert, Trademark Protection in Color: Do It by the Numbers!, 84 TRADEMARK REP. 379, 379 (1994). Although the issue of trademark protection of color per se was not before the Supreme Court in the 1906 case of A. Leschen & Sons Rope Co. v. Broderick & Bacom Rope Co., the opinion stated in dictum, “[y]ou may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color . . . .” A. Leschen & Sons Rope Co. v. Broderick & Bacom Rope Co., 201 U.S. 166, 172 (1906); see also, Glenda Labadie-Jackson, Through the Looking Hole of the Multi-Sensory Trademark Rainbow: Trademark Protection of Color Per Se Across Jurisdictions: The United States, Spain and the European Union, 7 RICH. J. GLOBAL L. & BUS. 91, 93 (2008) (discussing the background leading up to the Owens-Corning decision).
60. In re Owens-Corning Fiberglass Corp., 774 F.2d 1116 (Fed. Cir. 1985).
61. Id. at 1126-127.
62. Id.
color as a signifier of source” independently from any other featured trademarks. Other manufacturers of fiberglass insulation were free to feature “alternative colors into their products, but pink insulation became Owens-Corning’s exclusive prerogative.”

Five years after the Owens-Corning decision, the Seventh Circuit contrarily refused to give trademark rights in the color blue to a vendor of sugar substitutes. The court held that the blue packaging “used in connection with some symbol or design” could be sufficient for color-linked trademark protection. In 1993, however, the Eighth Circuit rejected the Seventh Circuit’s reasoning and saw no reason that the color blue could not function as a source identifier, subject to full trademark protection, for Blue Max brand splicing tape. This decision widened the circuit split on this hot-button issue and, consequently, attracted the Supreme Court’s certiorari-granting attention.

In Qualitex Co. v. Jacobson Products Co., the Supreme Court resolved the controversy and discrepancies among the circuit courts on the issue of whether a trademark could consist of solely a color. Qualitex, a dry-cleaning business that colored its cleaning pads a particular shade of green-gold, sued Jacobson, a competing business, when Jacobson began using a similar shade of green-gold on its cleaning pads. In reaching its decision, the Court examined the Lanham Act and ultimately determined that there was no “obvious theoretical objection to the use of color alone as a trademark.” The Court stated 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.” Colors, the Court decided, could reasonably serve as marks once they had acquired distinctiveness (secondary meaning), as long as their use was nonfunctional.

64. Id.
65. See NutraSweet Co. v. Stadt Corp., 917 F.2d 1024, 1028 (7th Cir. 1990).
66. Id. at 1027.
69. Id.
70. Id. at 164.
71. Id. at 161.
72. Id. at 163 (emphasis added).
73. Id. at 161.
74. Id. at 163-65.
C. Colors as Functional Marks

Even though the Lanham Act does not inclusively list color alone as a protectable mark, the Supreme Court has decided that color is indeed capable of obtaining protection when its use is not functional. "Colors used in relation to goods or services are used either arbitrarily, functionally, or both. For many consumer goods, color is arbitrary." Everything from computers to garbage cans can be made in a variety of colors to suit a range of tastes. In some situations, the use of color is obviously driven by function. For example, Astroturf "is often green because it replaces and is supposed to look like grass." However, "[c]olor per se is not protectable if it is functional," and "[c]olors that serve some useful purpose on products will be found to be functional and not protectable."

The use of color can communicate a myriad of potential messages. Similar to the McNeil case, the Supreme Court has held that "competitors should be free to copy the color of a medical pill because the color communicated the type of medication it contained, even though it might also serve source identifying functions." This is yet another example of a court giving credence to the idea of communicative functionality. Colors can also communicate messages other than mere ingredient identification. "Colors provide information the consumers want (green candies are unlikely to be orange or cherry flavored) even if it is imperfect or incomplete (green candies may be spearmint flavored, or the color may denote lime)."

IV. TRADEMARK PROTECTION AND UNIVERSITY COLOR SCHEMES

Board of Supervisors of Louisiana State University v. Smack Apparel was a high-profile case that considered the issue of whether university color
schemes are protectable under the Lanham Act. The *Smack Apparel* court ultimately held that university color schemes could obtain secondary meaning, could cause consumer confusion, and are not functional. This issue has yet to be decided by the Supreme Court, but there is case law both following and criticizing *Smack Apparel*.

**A. Board of Supervisors of Louisiana State University v. Smack Apparel**

In *Smack Apparel*, four universities—Louisiana State University (LSU), Ohio State University (OSU), Oklahoma University (OU), and the University of Southern California (USC)—alleged that the defendant, Smack Apparel, "engaged in unfair competition by selling shirts bearing the distinctive two colors used by the universities, along with other symbols which identify the universities." The universities owned trademark registrations for their initials and names but not for their unregistered color schemes. Yet, each school “adopted a particular color combination as its school colors” well over a century ago and had spent “millions of dollars over the years in marketing and promoting items bearing their initials and school colors.” Smack Apparel designed and sold a number of t-shirts “bearing the distinctive two colors used by the universities” that the universities claimed infringed upon their trademarks and their rights.

The court recognized that the schools’ color schemes had been used for over one hundred years on different materials, brochures, media guides, and alumni materials. The fact that many people refer to the universities as “purple and gold for LSU, crimson and creme for OU, scarlet and gray for OSU, and cardinal and gold for USC” led the court to believe that the nature of the use of the color schemes created a high probability of secondary

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87. *See, e.g.*, Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225 (5th Cir. Tex. 2010); Xtreme Lashes, LLC v. Xtended Beauty, Inc., 576 F.3d 221 (5th Cir. Tex. 2009).
88. *Smack Apparel*, 438 F. Supp 2d. at 655. “OU . . . ‘Bourbon Street or Bust’ (with the ‘ou’ in ‘Bourbon’ in a different typestyle) (front), ‘Show Us Your Beads!’ (with the ‘ou’ in ‘your’ in a different typestyle) and ‘Sweet as Sugar!’ (back) . . . LSU: ‘Beat Oklahoma’ (front), and ‘And Bring it Back to the Bayou!’ and ‘2003 College Football National Championship’ (back) . . . .” *Id.*
89. *Id.*
90. *Id.* at 655, 658 n.3.
91. *Id.* at 655.
92. *See id.* at 658. Additionally, the universities used their color schemes to advertise to students, faculty, alumni, and the general public. *Id.*
meaning. Most importantly, the court found that Smack Apparel had used the schools' colors with the specific intent of identifying the universities as the subject of the message in the design of the t-shirts.

B. Texas Tech University v. Spiegelberg

The United States District Court for the Northern District of Texas relied on the Smack Apparel holding for its decision in Texas Tech University v. Spiegelberg. In Spiegelberg, the defendant owned two merchandising stores, one across from the Texas Tech campus and the other in a mall in downtown Lubbock, Texas. Spiegelberg decorated the stores with Texas Tech’s [school] colors, scarlet and black, and sold Texas Tech merchandise. Texas Tech sued, alleging trademark infringement. Relying on Smack Apparel, the Spiegelberg court found 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.” The court based its ruling on the fact that the color [scheme] acquired “a secondary meaning which 'identifies and distinguishes' the products,” such that customers associate products marketed and sold in Lubbock adorned with scarlet and black as products licensed by Texas Tech.

C. University of Kansas v. Sinks

The case of University of Kansas v. Sinks has startling factual similarities to Smack Apparel but a very different outcome. The University of Kansas (KU) brought a trademark infringement action against several defendants for the production of red and blue t-shirts bearing university logos. For more than one hundred years, KU has used the colors “crimson and blue” as parts of its Jayhawk mascot and in connection with its educational services, athletics,

93. Id. at 655.
94. Id. at 661.
96. Jeremiah Kline, Black and Blue: An Examination of Trademarking University Color Schemes, 16 SPORTS LAW J. 47, 60-61 (2009).
98. Id.
student life, advertising, events, and website.99 KU does not, however, own a registered trademark for these crimson and blue colors themselves.100 Nevertheless, "KU monitors authorized uses of its color scheme and has set standards to instruct KU representatives and licensees as to how the crimson and blue color scheme is to be presented."101 The District Court of Kansas held that the defendants infringed on KU's trademarks.102 Of the 206 shirts at issue, the court found only a few to be infringing.103 Furthermore, the plaintiff argued that the defendant's use of the crimson and blue color scheme alone was enough to constitute infringement.104

D. University of Alabama v. New Life Art, Inc.

The case of University of Alabama v. New Life Art, Inc. shows one court's stern rejection of a university owning trademark rights in its color scheme.105 More importantly, a reason why the color scheme was not protected was clearly articulated.106 The defendant in this case was a corporation organized by a well-known sports artist, Daniel Moore, who painted artistic renderings of university football events.107 The University of Alabama (Alabama) and the defendant had a licensing agreement from 1991 until 2000, at which time the defendant took the position that the paintings did not need to be licensed.108 Alabama disagreed, arguing that the University's team uniform colors of crimson and white were protectable trade dress and Moore could not sell paintings depicting these uniform colors without a license.109 Alabama subsequently filed a trademark infringement lawsuit, seeking royalties from more than twenty of Moore's paintings and demanding that Moore license any

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99. Id. at 1297; see also University of Kansas, http://www.ku.edu (last visited May 2, 2010).
100. Sinks, 565 F. Supp. 2d. at 1235.
101. Id.
102. See id. at 1254-55.
103. See id.
104. Id. at 1302-303. On April 12, 2010, the defendants agreed to a Consent Injunction and Settlement Agreement in exchange for KU's full release of the judgment. Among other things, the Agreement stipulates that the defendants are permanently enjoined from ordering, producing, manufacturing, distributing, selling, advertising, promoting, or marketing "any product that is red or blue (or red and blue) or that makes prominent use of the colors red or blue when combined with any of the words or symbols listed below which Defendants are prohibited from using, except as otherwise specifically permitted." See Kansas Athletics Resolves Lawsuit with Local Apparel Manufacturer, WIBW.COM, Apr. 12, 2010, http://www.wibw.com/sports/headlines/90696844.html.
106. See generally id.
107. Id. at 1240.
108. Id. at 1244.
109. Id.
future paintings.\textsuperscript{110}

The District Court for the Northern District of Alabama issued a memorandum opinion holding that Alabama did not have trademark rights in the football team colors and, thus, the defendant did not need a license to use the colors in his paintings.\textsuperscript{111}

The marks here concerned are the uniforms and their colors. These "marks" do not lend themselves to [trademark] type designations; nor would the general public usually consider them to be "marks." They are descriptive at best and are not inherently distinctive. The following Division 1-A football teams have crimson as part of their colors: Indiana, Kansas, New Mexico State, Oklahoma, Southern Methodist, Utah, Washington State... and Harvard... New Mexico State, Utah and Harvard all have crimson and white colors.\textsuperscript{112}

The court clarified that its holding only extended to the use of the uniform colors in artistic paintings and prints; such works would not be allowed to use the University's logos, symbols, or seals without potentially infringing on the University of Alabama's trademark rights.\textsuperscript{113}

V. COLOR ME BAD? RECENT COLOR SCHEME CONTROVERSY

Although the courts are split as to whether to extend trademark protection to a university's color scheme per se, one company decided to take a risk and use the color schemes of not just one, but several, prominent universities in a nationwide marketing campaign.\textsuperscript{114} Another company went one step further and is now looking for a court to declare that universities do not own trademark rights to their own color schemes.\textsuperscript{115}

\begin{footnotesize}
\begin{enumerate}
\item[110.] Id. at 1243.
\item[111.] Id. at 1246-48.
\item[112.] Id. at 1249. The court even went on to list "other teams with variations of red[,]" including "Arizona, Arkansas, Arkansas State, Ball State, Fresno State, Georgia, Houston, Iowa State, Miami of Ohio, Mississippi, Nebraska, North Carolina State, Northern Illinois, Ohio State, Rutgers, San Diego State, Stanford and Wisconsin." Id.
\end{enumerate}
\end{footnotesize}
A. The Bud Light Fan Can

In August 2009, right before the start of college football season, Anheuser-Busch began its “Team Pride” marketing campaign. This campaign was primarily directed toward college football tailgaters; in its lighthearted television commercials for Bud Light beer, many popular tailgate items were reworked to create functional, yet absurd, “tailgate approved” products. However, the centerpieces of the Team Pride program were the “Fan Cans:” Bud Light cans adorned in twenty-seven different color schemes designed to represent colleges across the country. Advertisements for the Fan Cans announced that they “were made for game day” and suggested that college football fans should “show [their] true colors with Bud Light . . . .”

The Fan Can promotion sparked a firestorm of controversy. Concerned with protecting their trademarks and avoiding consumer confusion, more than twenty-five universities formally asked Anheuser-Busch to cease its Fan Can promotion. Additionally, the Collegiate Licensing Company, which represents about 200 colleges, the National Collegiate Athletic Association, and other school sports organizations complained to Anheuser-Busch about potential trademark law violations. In response, Anheuser-Busch pointed out that the cans did not bear the logos or names of any one school. Because the cans featured only the schemes, it was ultimately up to the consumer to associate the colors with a particular alma mater or sports team. Nevertheless, Anheuser-Busch pulled the Fan Cans from the communities where affected universities had complained.

B. Madison County Winery, LLC v. State of Iowa

During the heyday of the Fan Cans controversy, a small Iowa winery

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116. Hechinger, supra note 114.
117. Steve Wood, Are You Ready for Some Tailgating?, COURIER-POST, Oct. 1, 2009, at NaN. Some of these “tailgate approved” products included a “Grooler” (a hybrid between a grill and a cooler) and a “Tailgate Companion” (a vest outfitted with pockets for condiments and grilling tools to be worn by a large breed of dog, such as a Labrador Retriever). Id.
118. Hechinger, supra note 114.
119. Id.
120. See id.
121. Id. These universities included the University of Michigan, the University of Colorado, Oklahoma State University, Texas A&M University, and Boston College. Id.
122. Id.
123. Id.
introduced what soon proved to be very controversial bottles of wine. Madison County Winery, located just outside of St. Charles, Iowa, began selling bottles of "Iowa Gold" and "State Red" wines. "Iowa Gold, a blend of Iowa-grown vignoles and chardonnay grapes, was sold in a bottle with a black and gold label. State Red is a dry red blend of cabernet sauvignon and marechal foch, which was sold in a bottle with a red and yellow label." Naturally, both the University of Iowa and Iowa State University sent cease-and-desist letters to Madison County Winery. Winery owner Doug Bakker tried to comply with the Universities' requests and stopped using the words "Iowa" and "State." However, he continued to use the color schemes of black and gold and red and yellow on labels that simply said "Gold" and "Red." When the universities insisted that the winery could not use these colors either, Bakker decided to sue. "The lawsuit says the state schools' [sic] overstepped their trademark authority, and in doing so owe Madison County Winery an unspecified amount of damages, as well as legal fees in the case." "If the winery does win... the decision could have widespread impact on the ability of Iowa and Iowa State 'to dissuade others' from using the colors and words in commercial applications."

VI. UNIVERSITY COLOR SCHEMES AS UNPROTECTABLE UNDER THE LANHAM ACT

Although the Supreme Court has yet to determine whether the protection of color as a trademark can extend to university color schemes, there are many reasons why university color schemes should not be protected as trademarks under the Lanham Act. The Sinks case reasoned that the color scheme alone

125. See Elbert, supra note 115.
126. Id.
127. Id.
128. Id. An August 18, 2009 letter to the winery from Dale Arens, the University of Iowa trademark licensing director, promised legal action "if [the winery does] not immediately cease the unlawful use of [the universities'] logos." Id. Additionally, "a [September] 22, 2009, letter from Licensing Resource Group, which [Iowa State University] uses to police brand licensing, was more specific. It said that State Red labels would 'confuse the public into believing that Iowa State University sponsors or approves of [the winery's] products.'" Id.
129. Id.
130. Id.
131. Id.
132. Id. The lawsuit indicates that the legal situations of the two schools are not identical. For example, it notes that Iowa State University's registration of the word mark "I State" specifically states "color is not claimed as a feature of the mark." Id.
133. Id.
did not merit trademark protection.\textsuperscript{134} \textit{New Life Art} states that university color schemes are functional and therefore barred from gaining trademark protection.\textsuperscript{135} The \textit{Smack Apparel} decision examined the strength of university marks, the use of the marks in advertising, and the volume of sales to determine that use of a university’s color scheme can cause consumer confusion, and thus, the Lanham Act affords protection to the universities’ color schemes. University color schemes may acquire secondary meaning through affiliation and advertising, but this secondary meaning may vary depending on what part of the country is being examined.\textsuperscript{136} Even with secondary meaning, university color schemes are functional and not protectable under the Lanham Act.\textsuperscript{137}

To gain registration in the Principal Register or common law protection under the Lanham Act, a trade dress must not be “functional.”\textsuperscript{138} That is, the configuration of shapes, designs, colors, or materials that make up the trade dress in question must not serve a utility or function outside of creating recognition in the consumer’s mind.\textsuperscript{139} Yet, the \textit{New Life Art} court explicitly stated that university color schemes perform a function: “They help avoid confusion as to team members for the benefit of officials, opposing team members and spectators.”\textsuperscript{140} Interestingly enough, the University of Alabama’s own words in its complaint against New Life Art acknowledged that “the first use of [the color] crimson by Harvard was ‘so that spectators could differentiate Harvard’s crew team from other teams during a regatta in 1858’.”\textsuperscript{141}

In addition to having a useful function, university color schemes are communicatively functional. As previously discussed, communicative functionality is the use of a mark to communicate a non-source related meaning, including social meanings. Loyal alumni often wear their school colors while attending collegiate athletic events to communicate their affinity for a particular team. Colloquially, one might accurately say that blue and gold are the trademark colors of Marquette University,\textsuperscript{142} but wearing these

\begin{itemize}
\item \textsuperscript{135} See generally Univ. of Ala. v. New Life Art, Inc., 677 F. Supp. 2d 1238 (N.D. Ala. 2009).
\item \textsuperscript{136} See Bd. of Supervisors of La. State Univ. v. Smack Apparel Co., 550 F.3d. 465, 477-78 (5th Cir. 2008).
\item \textsuperscript{137} McCARTHY, supra note 22, at § 15.3; see also New Life Art, 677 Fed. Supp. at 1249.
\item \textsuperscript{139} Id.
\item \textsuperscript{140} New Life Art, 677 F. Supp. 2d. at 1249.
\item \textsuperscript{141} Id. at 1247. Alabama used this evidence to support their incorrect argument that “nothing about the color scheme serves a functional purpose.” Id.
\item \textsuperscript{142} See Marquette University, http://www.marquette.edu (last visited May 2, 2010).
\end{itemize}
colors to university sports events communicates support for the Marquette University Golden Eagles outside of the linear realm of commercial trademark use. Moreover, the Sinks case held that several of the t-shirts that KU thought to be “infringing” were not “infringing” if they only featured the university’s color scheme.143 Again, this is because the use of the colors here was not to identify the source of the product, but to communicate an allegiance to the University of Kansas.144

In addition to their utilitarian and communicative functionalities, university color schemes are also aesthetically functional.145 The Restatement (Third) of Unfair Competition provides 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,” the design is “functional.”146 “The ultimate test of aesthetic functionality, as with utilitarian functionality, is whether the recognition of trademark rights would significantly hinder competition.”147 Courts have historically placed the importance of allowing consumers the ability to obtain products in the colors they prefer above an entity’s desire to make exclusive use of a color.148 Because farmers had an aesthetic preference for green farm equipment, one district court refused to allow the John Deere Company a trademark for the color green with respect to farm machinery.149 Because boat owners prefer outboard motors to be black for aesthetic reasons, the Federal Circuit held that a single outboard motor company could not use trademark law to make itself the exclusive manufacturer of black outboard motors.150 If courts continue to follow this precedent, they will likely deny university color schemes trademark protection for the same reason: to protect the consumer’s ability to obtain products in the colors they prefer. Clothing, furniture, office supplies, and other consumer goods are manufactured in every color imaginable because consumers find these colors to be appealing and desirable.151 Marquette’s interest in its blue and gold color scheme should not prevent consumers from buying mittens,
sweaters, notebooks, or any other product that happens to be blue and gold in color.152

True, with enough exposure “via relentless advertising and expansive market permeation,” the color scheme of blue and gold could be conceivably linked with Marquette University in consumers’ minds.153 This is not, however, an adequate justification for overcoming the functionality doctrine and allowing universities to monopolize particular color combinations through trademark law.154 “Mere association does not mean that a color [scheme] is functioning as a trademark.”155

VII. CONCLUSION

Colors alone can make words or symbols more distinctive marks, but they signify too many things to function as effective stand-alone trademarks. No company is going to use only a color to identify its goods and services. UPS is not going to stop using the mark “United Parcel Service” and let the color brown be its sole identifier. Nor would Tiffany & Co. eliminate “Tiffany” and use its blue bags and boxes exclusively. Similarly, no university is going to abandon its use of its logos and mascots and rely only on its two-color scheme. Colors are almost always functional from a utilitarian, aesthetic, or communicative perspective. The fact that they may also have a secondary meaning does not automatically overcome the barrier of the functionality doctrine.

Universities may enthusiastically register their color schemes, but they would never actually use the color scheme by itself. This is because the color scheme is not perceived by consumers as a trademark but rather as aesthetically pleasing, emotionally appealing, or even functional from a utilitarian perspective. The issue of whether a university can trademark its color scheme will come before the courts again. Recent controversy over the use of university color schemes has illustrated how eager universities are to protect their interests in color schemes. However, the most recent case law has denied protection to university color schemes per se, and courts should

152. See generally id.
153. Id. at 268.
154. Id.
155. Id. For a more detailed discussion on the geographical limitations for universities with similar color schemes, see generally Kline, supra note 96, at 73-78. Moreover, the associations attached to particular color schemes vary dramatically based on geographical location. Many universities share similar, if not identical, color schemes. In Wisconsin, blue and gold can signify an allegiance with Marquette University. However, in Michigan and many other parts of the county, these same shades of blue and gold (also known as “maize”) show a connection to the University of Michigan. See University of Michigan, http://www.umich.edu (last visited May 2, 2010).
continue to follow this precedent.