

# UIC REVIEW OF INTELLECTUAL PROPERTY LAW



COLORING INSIDE THE LINES: A LOOK AT *QUALITEX V. JACOBSON*

WILLAJEANNE F. MCLEAN

ORCID: 0000-0003-1136-7214



*Cite as* Willajeanne F. McLean, *Coloring Inside the Lines: A Look at Qualitex v. Jacobson*, 21 UIC REV. INTELL. PROP. L. 49 (2022).

## COLORING INSIDE THE LINES: A LOOK AT QUALITEX V. JACOBSON

WILLAJEANNE F. MCLEAN\*

## I. INTRODUCTION

*“Whether mere color can constitute a valid trademark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this.”*<sup>1</sup>

*“We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.”*<sup>2</sup>

With the announcement of Justice Stephen Breyer’s retirement from the bench of the United State Supreme Court, there have been many news articles concerning Justice Breyer’s legacy.<sup>3</sup> This, of course, includes the mark he has made from the Supreme Court bench on intellectual property law<sup>4</sup>, a legacy described as complicated.<sup>5</sup> It is true that Justice Breyer’s writings on aspects of intellectual property have provoked discussion;<sup>6</sup> certainly the decision in *Qualitex*, which involved the question of whether color, alone and apart from any words, devices, or combinations, could serve as a trademark, is one such example.<sup>7</sup>

Until *Qualitex v. Jacobson*, a decision penned by Justice Breyer in 1995, courts “differed as to whether or not the law recognize[d] the use of color alone as a

---

\* © ORCID 0000-0003-1136-7214. Distinguished Professor of Law, University of Connecticut. My thanks to Meghan McDermott, University of Connecticut Law Class of 2023, for her invaluable research assistance. I also thank the editors at the UIC-RIPL for the invitation to think more about Justice Breyer’s *Qualitex* decision. Any and all errors are my own.

<sup>1</sup> A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U.S. 166, 171 (1906).

<sup>2</sup> *Qualitex v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 161 (1995).

<sup>3</sup> See generally Ann E. Marimow, *Breyer’s legacy: A centrist, pragmatic problem-solver and defender of the court’s reputation*, THE WASH. POST (Jan. 26, 2022), <https://www.washingtonpost.com/politics/2022/01/26/justice-breyer-court-legacy/>; Adam Liptak, *Justice Breyer’s Legacy: A Liberal Who Rejected Labels Like ‘Liberal’*, N.Y. TIMES (Jan. 26, 2022), <https://www.nytimes.com/2022/01/26/us/politics/justice-stephen-breyer.html>.

<sup>4</sup> See generally Ruth Silberfarb, *A Look Back: Justice Breyer’s View of and Influence on Intellectual Property Law*, FORDHAM INTELL. PROP., MEDIA, & ENT. L.J. (Mar. 1, 2022), <http://www.fordhamiplj.org/2022/03/01/a-look-back-justice-breyers-view-of-and-influence-on-intellectual-property-law/>.

<sup>5</sup> The author participated in a webinar on February 11, 2022, sponsored by the Center for Intellectual Property Law and Innovation at Indiana University-Robert H. McKinney School of Law, entitled “Justice Breyer and His Complicated Intellectual Property Law Legacy” at which she discussed some of the themes developed here.

<sup>6</sup> See generally Gordon R. Shea, “*Gathering His Beames With a Christall Glass*”: *The Intellectual Property Jurisprudence of Stephen G. Breyer*, 2 MARQ. INTELL. PROP. L. REV. 195 (1998).

<sup>7</sup> *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159 (1995).

trademark.”<sup>8</sup> His opinion, written for a unanimous Court, provoked discussion with many predicting a parade of horrors that would inevitably follow.<sup>9</sup> In reviewing the decision now, at the moment of Justice Breyer’s impending departure from the bench, and more than two decades later, I posit that Justice Breyer was not coloring outside the lines,<sup>10</sup> but acting within the metes and bounds of the Lanham Act.

In this essay, I will review the arguments that the respondent, Jacobson, made against the recognition of color being capable of serving as a trademark and the rebuttals made by Justice Breyer. I will also discuss why some of the critiques that were leveled against the decidedly controversial decision are now shown to have been without merit. Yet, there is at least one way in which the decision had unexpected consequences, and I will note it briefly. It is out of the scope of this essay to do more than just acknowledge some consequences of the Supreme Court’s decision.

## II. COLOR AS A TRADEMARK?

*“If one says ‘Red’ (the name of the color) and there are 50 people listening, it can be expected that there will be 50 reds in their minds. And one can be sure that all these reds will be very different.”*<sup>11</sup>

The case *Qualitex v. Jacobson* concerned whether a green-gold color, used by Qualitex for its dry-cleaning press pads, could, without more, function as a trademark. Qualitex had used the color since the 1950s; therefore, when Jacobson, its competitor, began to use the same color in 1989, consumers had long associated that particular color with Qualitex, and confusion ensued.

Qualitex, which already had a trademark SUN GLOW for its covers and pads,<sup>12</sup> sued Jacobson for unfair competition, based on Jacobson’s use of the same color for its press pads. During the pendency of the lawsuit, Qualitex applied for, and was granted, a federal trademark registration for the green-gold color.<sup>13</sup> Once the trademark issued, Qualitex added to its complaint a count for trademark infringement.

The district court found for Qualitex, finding that Jacobson had engaged in unfair competition through copying the appearance of Qualitex’s press pads and placing inferior products bearing the trade dress on the market, which deceived consumers. It also found that Jacobson had infringed the trademark for the green-gold

---

<sup>8</sup> *Id.* at 161.

<sup>9</sup> See generally Elizabeth A. Overcamp, *The Qualitex Monster: The Color Trademark Disaster*, 2 J. INTELL. PROP. L. 595 (1995); Jean Hayes Kearns, *Qualitex Co. v. Jacobson Products Co.: Orange You Sorry the Supreme Court Protected Color?* 70 ST. JOHN’S L. REV. 337 (1996) (arguing increased litigation as a result of the decision); Christopher C. Larkin, *Qualitex Revisited*, 94 TRADEMARK REP. 1017 (2004) (arguing that critics’ fears were not justified).

<sup>10</sup> See Theodore C. Max, *Coloring Outside the Lines in the Name of Aesthetic Functionality: Qualitex, Louboutin, And How The Second Circuit Saved Color Marks for Fashion*, 102 TRADEMARK REP. 1081 (2012).

<sup>11</sup> JOSEF ALBERS, INTERACTION OF COLOR 3 (1971) (noting that “it is hard, if not impossible, to remember distinct colors.”).

<sup>12</sup> SUN GLOW, Registration No. 674,153 (issued on February 17, 1959).

<sup>13</sup> The mark consists of a particular shade of green-gold applied to the top and side surfaces of the goods, Registration No. 1,633,711 (issued on February 5, 1991).

coloring of the press pads. Important to the court's reasoning was that the Qualitex green-gold press pads had acquired distinctiveness through its long and exclusive use.<sup>14</sup> Although the district court found that there was a competitive need in the dry-cleaning industry for colored press pads, there was not a need for Qualitex's particular color.<sup>15</sup>

On appeal, the Court of Appeals for the Ninth Circuit ("Ninth Circuit") reviewed the District Court's findings of fact regarding the validity of Qualitex's color trademark registration *de novo*.<sup>16</sup> Although the Ninth Circuit acknowledged that the "[r]egistration of mere color is not explicitly barred by the Lanham Act,"<sup>17</sup> it nevertheless reversed the finding of validity and decided to follow the majority of other circuits in "holding that color alone could not form the basis for a trademark."<sup>18</sup> The Ninth Circuit concluded "the better rule is that a trademark should not be registered for color alone," because it wished to avoid "unnecessary problems" that litigation of color would typically involve, such as shade confusion and monopolization.<sup>19</sup> The Ninth Circuit Court determined that the protections afforded by the provisions included in the Lanham Act for unfair competition were sufficient.<sup>20</sup> Given that there was a circuit split as to whether or not the law recognized the use of color alone as a trademark,<sup>21</sup> the United States Supreme Court granted certiorari, and Justice Breyer was assigned the task of writing the opinion.

Justice Breyer, who had just joined the Supreme Court bench, employed in the opinion characteristics for which he would become known – his keen analytical mind and his fanciful, but never generic, hypotheticals.<sup>22</sup> For example, an imaginary jar of orange marmalade branded "Suntost," became his foil for discussion of color as a trademark.<sup>23</sup> He reflected on the term's ability to signal source relative to the inability of the orange color of the contents of the jar to do so – at least until the customers make the association between the content's color and its source.<sup>24</sup> "If," he reasoned, "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?"<sup>25</sup> He could not find, he concluded, "a reason to disqualify absolutely the use of a color as a mark."<sup>26</sup>

---

<sup>14</sup> *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 21 U.S.P.Q.2d 1457, 1458 (C.D. Cal. 1991).

<sup>15</sup> *Id.* at 1461.

<sup>16</sup> *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 13 F.3d 1297, 1301 (9th Cir. 1994).

<sup>17</sup> *Id.*

<sup>18</sup> *Id.* at 1302.

<sup>19</sup> *Id.*

<sup>20</sup> *Id.*

<sup>21</sup> See generally *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (where the court held that the color pink could function as a trademark).

<sup>22</sup> See generally Mark Walsh, *Breyer's Befuddling Hypotheticals Reverberate Through the Halls of SCOTUS*, A.B.A. J. (Feb.10, 2022), <https://www.abajournal.com/web/article/breyers-befuddling-hypotheticals-reverberate-through-the-halls-of-scotus>.

<sup>23</sup> *Qualitex*, 514 U.S. at 163.

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 164.

Jacobson, the respondent, made four arguments why a single color should not be protected as a trademark. The first argument was based on the theory of shade confusion; that is, protecting a color alone would produce uncertainty and unresolvable disputes about what shades of a color a competitor may lawfully use and would require an arbitrary and subjective analysis. Justice Breyer dismissed this argument by opining that courts traditionally make quite difficult decisions.<sup>27</sup>

In fact, Justice Breyer's rejection of the theory of shade confusion and the attendant difficulties litigation might pose was not novel. For example, Judge Newman, writing for the Court of Appeals for the Federal Circuit ("CAFC") in the *Owens-Corning* decision, agreed with the Trademark Trial and Appeal Board ("TTAB")'s earlier decision that "[d]eciding likelihood of confusion among color shade . . . is no more difficult or subtle than deciding likelihood of confusion where word marks are involved."<sup>28</sup> In a subsequent case, Judge Gibson, writing for the Court of Appeals for the Eighth Circuit, agreed with the stance taken by the CAFC and noted that "as with any technical issue, expert witnesses are available to testify regarding the similarity of the colors at issue."<sup>29</sup> What may have appeared novel was Justice Breyer's suggestion that courts "replicat[e], if necessary lighting conditions under which a colored product is normally sold."<sup>30</sup> Yet, as noted by Justice Breyer, courts were already deciding shading issues in cases involving the use of color by using color charts or expert testimony.<sup>31</sup>

The second argument advanced by Jacobson concerned color depletion. The color depletion theory, ascribed to the *Campbell Soup Co. v. Armour* court,<sup>32</sup> posits that colors would "soon run out" if manufacturers were allowed to appropriate a color "in all of its shades."<sup>33</sup> Similarly, Jacobson argued that colors would be in short supply because there are only a few viable colors that appeal to customers, thus leaving a competitor unable to find a suitable color.<sup>34</sup>

Justice Breyer also dismissed this argument as unpersuasive because it "relie[d] on an occasional problem to justify a blanket prohibition."<sup>35</sup> According to Justice Breyer, the functionality doctrine, which prohibits the use of a product's feature as a trademark if it affects the cost or quality or if it is essential to the use or purpose of the product, would protect a competitor's need to copy.<sup>36</sup> Here, Justice Breyer amended the Court's formulation of the tests for determining functionality. He added the phrase, "that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage."<sup>37</sup> In doing so, Justice Breyer

---

<sup>27</sup> *Id.* at 167.

<sup>28</sup> *In re Owens-Corning Fiberglass Corp.*, 774 F.2d at 1123.

<sup>29</sup> *Master Distrib., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993).

<sup>30</sup> *Qualitex*, 514 U.S. at 167-68.

<sup>31</sup> *Id.* at 168.

<sup>32</sup> *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 798 (3d Cir. 1949).

<sup>33</sup> *Id.*

<sup>34</sup> *Qualitex*, 514 U.S. at 168.

<sup>35</sup> *Id.*

<sup>36</sup> *Id.* at 169.

<sup>37</sup> *Id.* at 165.

introduced a competitive need test for functionality, setting the stage for the Court, in another trade dress case, to opine that competitive need was only an adjunct to the question of functionality, used when determining aesthetic functionality.<sup>38</sup>

The third argument – that precedent precluded a color from serving as a mark – was equally unconvincing to Justice Breyer.<sup>39</sup> Here Jacobson cited cases, including those from the Supreme Court, which suggested that “mere color” could not function as a trademark.<sup>40</sup> However, Justice Breyer found that these cases were decided before the enactment of the Lanham Act, and furthermore the Act had been liberalized to “dispense with mere technical prohibitions.”<sup>41</sup> Justice Breyer contended that when Congress amended the Lanham Act, it did so against the backdrop of the *Owens-Corning* decision and a Trademark Revision Commission report which suggested that the language found in the Act defining a trademark as “any word, name symbol or device,”<sup>42</sup> meant exactly that. Thus, for Justice Breyer, writing for the Court, “almost anything that is capable of carrying meaning” should be able to function as a trademark.<sup>43</sup>

The last argument proffered by Jacobson was that there was no need to permit color alone to function as a trademark because a manufacturer could rely upon the Lanham Act’s Section 43(a). Section 43(a) protects unregistered trademarks by, *inter alia*, prohibiting consumer confusion regarding the overall appearance of the competing products.<sup>44</sup> Jacobson argued that this was sufficient to protect a manufacturer’s trade dress against any alleged infringement. Justice Breyer, in dismissing this argument, correctly noted that there are valid reasons for wanting the protections granted by federal registration, such as constructive notice of ownership, and *prima facie* evidence of validity, for example.<sup>45</sup>

Breyer concluded that the arguments proffered by Jacobson did not “justify a special legal rule preventing color alone from serving as a trademark,” and that the findings were undisputed that Qualitex’s use of the green-gold color conformed to all the required elements necessary for a trademark.<sup>46</sup> That is, Qualitex proved that its trademark was distinctive – it had acquired consumer association- and it was non-functional- the green-gold color did not affect the cost or quality of the product and was neither essential to the use or purpose of the product nor needed in order for other manufacturers within the industry to compete. Based on these findings, Justice Breyer

---

<sup>38</sup> See *Traffix Devices, Inc. v. Mktg. Displays, Inc.* 532 U.S. 23 (2001). While beyond the scope of this essay to discuss, note that this decision has also been roundly criticized. See generally, Amy B. Cohen, *Following the Direction of Traffix: Trade Dress Law and Functionality Revisited*, 50 IDEA 593 (2010) (noting the difficulties that the *Traffix* decision engendered).

<sup>39</sup> *Qualitex*, 514 U.S. at 170–73 (discussing reasons the argument was not persuasive).

<sup>40</sup> *Id.* at 170–71.

<sup>41</sup> *Id.* at 172.

<sup>42</sup> The Lanham Act, 15 U.S.C. § 1127 (2022) (emphasis added).

<sup>43</sup> *Qualitex*, 514 U.S. at 162.

<sup>44</sup> 15 U.S.C. § 1125 (2022).

<sup>45</sup> *Qualitex*, 514 U.S. at 174.

<sup>46</sup> *Id.*

concluded for the unanimous court that “Qualitex’s use of the green-gold color on its press pads meets the basic trademark requirements.”<sup>47</sup>

### III. DISCUSSION

*“I found I could say things with color and shapes that I couldn’t say any other way-things I had no words for.”*<sup>48</sup>

The *Qualitex* decision was widely decried. There were those who claimed that there would be a torrent of non-traditional marks registered, given Justice Breyer’s (too) wide reading of the statutory definition of trademarks.<sup>49</sup> The decision, some commentators warned, would upend competition,<sup>50</sup> and most certainly reduce judicial efficiency by opening the floodgates of litigation as to what shade of red was too close.<sup>51</sup>

Fortunately, none of these jeremiads have happened. For example, according to a recent study of USPTO registrations post- *Qualitex*, “only .06% of the universe of applications” for trademark registrations claimed color and, of those, only about 27% received a registration on the Principal Register.<sup>52</sup> These findings suggest that colors are not in any danger, at least not yet, of depletion.<sup>53</sup> As for upending competition, the same study also suggests that there are no color monopolies.<sup>54</sup>

There were others who seemingly thought, despite Breyer’s constant affirmation that there were no special rules forbidding color from performing the work of a trademark, that the *Qualitex* decision itself *was* the creation of a “special legal rule,”<sup>55</sup> and that it was most certainly coloring outside the lines to extend the bounds of trademark law.<sup>56</sup>

Based on the text of the opinion alone, I would posit that Justice Breyer was actually coloring inside the lines. For example, Justice Breyer, who is regarded by some as an intellectual property skeptic – at least where it concerns extending intellectual property protections<sup>57</sup> – assiduously parsed the Lanham Act, as if searching for reasons

---

<sup>47</sup> *Id.*

<sup>48</sup> 2 NANCY HOPKINS REILY, GEORGIA O’KEEFFE, A PRIVATE FRIENDSHIP 379 (2009).

<sup>49</sup> See Overcamp, *supra* note 9, at 613.

<sup>50</sup> See generally Kearns, *supra* note 9, at 337–38.

<sup>51</sup> See generally Lauren Traina, *Seeing Red, Spending Green: The Costly Process of Registering and Defending Color Trademarks*, 87 S. CAL. L. REV. 1319 (2014) (arguing that the cost of litigating color is expensive and extremely challenging).

<sup>52</sup> Deborah R. Gerhardt & Jon McClanahan Lee, *Owning Colors*, 40 CARDOZO L. REV. 2483, 2532–34 (2019).

<sup>53</sup> *Id.* at 2547.

<sup>54</sup> *Id.* at 2546.

<sup>55</sup> Shea, *supra* note 6, at 200, fn 18 (characterizing some negative commentary as implicitly implying that Justice Breyer was creating rules).

<sup>56</sup> See generally Kenneth L. Port, *Revisiting Park ‘N Fly: In Pursuit of Constraints On Trademark Bullies*, 16 WAKE FOREST J. BUS. & INTELL. PROP. L. 135, 149 (2015) (decrying the expansion of trademark law that the *Qualitex* decision represents to the author).

<sup>57</sup> See Shea, *supra* note 6, at 199; Ryan Davis, *Breyer’s Rulings Shaped By Wariness Of Intellectual Property*, LAW 360 (Jan. 27, 2022), <https://www.law360.com/articles/1458997/breyer-s-rulings-shaped-by-wariness-of-intellectual-property>.



to affirm the Circuit Court's holding.<sup>58</sup> In doing so, he noted: “[b]oth the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark.”<sup>59</sup> From the Lanham Act's definition of trademarks, he concluded that “the language, read literally, is not restrictive.”<sup>60</sup>

Justice Breyer did not base his decision solely on analysis of the Lanham Act. He also turned to the U.S. Patent and Trademark Office's Trademark Manual of Examining Procedure, which approved the registration of color alone, provided it was non-functional and had acquired distinctiveness.<sup>61</sup> Justice Breyer also consulted, *inter alia*, various scholars' writings on the subject of trademark law,<sup>62</sup> the Senate report accompanying the Lanham Act revision, the Congressional Record of the bill and the report from the Trademark Commission.<sup>63</sup> All of these supported his ultimate conclusion: “A color is also capable of satisfying the more important part of the statutory definition of a trademark”; that is, “to identify and distinguish . . . goods . . . and to indicate the source of goods.”<sup>64</sup>

Other critiques focused on a lack of clarity in the *Qualitex* decision and argued that it created more confusion rather than lessened it.<sup>65</sup> For example, Justice Breyer wrote that *sometimes* a color could serve as a trademark. This, of course, begs the question whether color could ever be inherently distinctive or whether it would *always* require a showing of consumer association, also known as secondary meaning.<sup>66</sup> After all, the holding explicitly states, “there is no rule absolutely barring the use of color alone.”<sup>67</sup> This suggests that there may be instances where a particular color is so distinctive when associated with a product or service that it needs no further evidence of its source-signaling ability. Yet, Justice Breyer limited the expansive nature of this holding by likening color to a descriptive word which requires a showing of consumer association before protection as a trademark.<sup>68</sup> Furthermore, the case *Wal-Mart v. Samara Brothers* in which the Court stated that color may “be protected as a trademark, but only upon a showing of secondary meaning,” confirmed the limitations placed on color by the *Qualitex* decision.<sup>69</sup>

Another area of concern was Justice Breyer's amendment of the Court's classic functionality tests. In an earlier portion of the opinion, Justice Breyer explained the

---

<sup>58</sup> See Shea, *supra* note 6, at 218 (suggesting Justice Breyer struggled with resolving *Qualitex*).

<sup>59</sup> *Qualitex*, 514 U.S. at 162.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at 172.

<sup>62</sup> *Id.* at 164.

<sup>63</sup> *Id.* at 172–73.

<sup>64</sup> *Id.* at 162.

<sup>65</sup> See generally Daniel C. Hudock, *Color Receives Trademark Protection And The Courts Receive Confusion*, 16 J.L. & COM. 139 (1996); James L. Vana, *Color Trademarks*, 7 TEX. INTELL. PROP. L.J. 387, 393 (1999).

<sup>66</sup> See Jonathan Hudis, *Removing the Boundaries of Color*, 86 TRADEMARK REP. 1 (1996); Kevin M. Jordan & Lynn M. Jordan, *Qualitex Co. v. Jacobson Products Co., The Unanswered Question — Can Color Ever Be Inherently Distinctive?*, 85 TRADEMARK REP. 371, 396–97 (1995).

<sup>67</sup> *Qualitex*, 514 U.S. at 162.

<sup>68</sup> *Id.* at 163.

<sup>69</sup> See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000).



role of the functionality doctrine in trademark law. He wrote that the doctrine “prevents trademark law . . . from . . . inhibiting legitimate competition.”<sup>70</sup> To illustrate the doctrine, Justice Breyer used an imaginary example of a new patented light bulb with a special illumination enhanced shape.<sup>71</sup> He underscored the necessity of leaving its shape unprotected by trademark – even though consumers associated the shape with the source – so that competitors’ legitimate efforts to produce an equivalent bulb would not be frustrated- or “put competitors at a significant non-reputation-related disadvantage.”<sup>72</sup>

To some within the intellectual property community, this explanation of functionality signaled a revitalization of the (then) moribund doctrine of aesthetic functionality.<sup>73</sup> This is the case, particularly since the Court in *TrafFix* opined that “[i]t is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of esthetic functionality, the question involved in *Qualitex*.”<sup>74</sup> It is doubtful that Justice Breyer foresaw the consequences of his textual addition. Nevertheless, the expansion of the *Inwood* test was left open to interpretation and as might be expected, courts vary in their application of the test.<sup>75</sup> The exact role a “significant non-reputation-related disadvantage” might play in determining whether or not a trade dress is functional is still very much up for discussion.

#### IV. CONCLUSION

*Color . . . thinks by itself, independently of the object it clothes.*<sup>76</sup>

The use of color *per se* to indicate the source of goods or services was, for almost ninety years, largely unthinkable – even after the Lanham Act’s liberalized definition of the term “trademark.” That color, independent of designs, was incapable of such use, was an article of faith, in some circuits. However, Justice Breyer, who carefully and methodically engaged in close statutory reading, found that nowhere in the Lanham Act is there a proscription against color as a mark, and settled the issue. He concluded that “almost anything at all that is capable of carrying meaning” could serve as a trademark.<sup>77</sup>

Justice Breyer was equally careful to limit the reach of the holding, restricting the use of color as a trademark to situations where the color had acquired secondary meaning and did not present a competitive impediment to others. Unfortunately, in

---

<sup>70</sup> *Qualitex*, 514 U.S. at 164.

<sup>71</sup> *Id.* at 165.

<sup>72</sup> *Id.*

<sup>73</sup> Hudis, *supra* note 66, at 8 (“the *Qualitex* decision . . . appears to have resurrected the concept of “aesthetic functionality”); Hudock, *supra* note 65, at 152 (arguing that the *Qualitex* court breathed new life into a once dying doctrine).

<sup>74</sup> *TrafFix Devices*, 532 U.S. at 1262.

<sup>75</sup> See generally Vincent N. Palladino, *Trade Dress Functionality After Traffix: The Lower Courts Divide Again*, 93 TRADEMARK REP. 1219 (2003).

<sup>76</sup> CHARLES BAUDELAIRE, *Exposition Universelle de 1855*, in OEUVRES COMPLÈTES DE CHARLES BAUDELAIRE (1868).

<sup>77</sup> *Qualitex*, 514 U.S. at 162–63.

forestalling the possibility of anti-competitive effects of the decision, he introduced language that resulted in subsequent judicial interpretations and muddied the waters. Regardless of the unforeseen consequences, the *Qualitex* decision has withstood the test of time; the parade of horrors failed to materialize, and Justice Breyer has forever colored the world of trademarks.