

Can ear plugs tune out colour? Bright green colour for ear plugs not functional
United States - Knobbe Martens

Confusion
Trade dress
Infringement
Enforcement

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- Moldex asserted that McKeon infringed unregistered trade dress consisting of bright green colour for foam ear plugs
- District court found that bright green colour for ear plugs was functional and not protectable as trade dress
- Ninth Circuit held that district court had erred in not considering availability of alternative colours

Background

Moldex-Metric Inc filed a trademark infringement lawsuit against McKeon Products. Moldex asserted that McKeon infringed its unregistered trade dress consisting of a bright green colour for foam ear plugs by using a similar green colour for ear plugs. Below is a side-by-side comparison of the parties' ear plugs:



The district court in the Central District of California granted summary judgment in favour of McKeon after finding that the bright green colour for ear plugs is functional and thus not protectable as trade dress. Moldex appealed to the Ninth Circuit.

Ninth Circuit decision

Trade dress protection under the Lanham Act may be afforded to the total appearance of a product, including features such as size, shape, colour, texture and graphics. However, protection under the Lanham Act is not available if the claimed trade dress is functional.

The test for determining whether a feature is functional is whether the feature is "essential to the use or purpose of a product or it affects the cost or quality of the article" (*Inwood Labs Inc v Ives Labs Inc* (456 US 844, 850 n 10 [1982])). The Supreme Court in a later case added that a functional feature is one where exclusive use would put competitors at a significant non-reputation related disadvantage (*Qualitex Co v Jacobson Prods Co* (514 US 159 [1995])).

Here, the district court found that the green colour used by Moldex played a significant role in allowing the ear plugs to be seen during safety compliance checks and, thus, the bright green colour of the ear plugs was functional. The district court distinguished this case from *Qualitex* where a green-gold colour for dry

cleaning press-pads was found not to be functional. Specifically, the district court stated that, in *Qualitex*, the green-gold colour was not essential to the product because any colour could achieve the function of hiding stains on dry-cleaning press pads. Also, the district court determined that the availability of alternative colours for allowing visibility of ear plugs during safety compliance checks need not be considered since it was already determined that the colour contributes in a significant way to the operation of the product.

The Ninth Circuit found that the district court had erred in not considering the availability of alternative colours in deciding whether the bright green colour for ear plugs was functional. The functionality test of whether a feature is essential to the use or purpose of a product is not always easily applied, especially in cases involving colour. In these cases, the availability of alternative designs becomes more important in assessing functionality. Because a reasonable jury could find that evidence of alternative colours outweighs the evidence of the colour providing some utilitarian advantage, the Ninth Circuit found that there remained a dispute of material fact as to whether Moldex's bright green colour is functional. Therefore, summary judgment on functionality was inappropriate.

Comment

So what does this mean for the fashion industry? It is a reminder that colour may be protectable even if it serves some function, so long as there are other colours that will serve the same function. The owner will need to demonstrate that the colour is not merely decorative, and that consumers recognise the colour as a brand signifying the source of the product, known as 'secondary meaning'. To establish secondary meaning, the owner must provide evidence of extensive sales and advertising of products in which the colour is prominently featured and promoted. 'Look for' advertising can be helpful in educating consumers of the trademark significance of a colour. The owner may also need to provide testimonials or survey evidence demonstrating that consumers associate the colour with the owner. With careful planning, a company may be able to create proprietary rights in a colour identified with its products, and prevent competitors from using the same colour.

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