

OFFICIAL TRANSCRIPT  
PROCEEDINGS BEFORE  
**THE SUPREME COURT**  
**OF THE**  
**UNITED STATES**

CAPTION: QUALITEX COMPANY, Petitioner v. JACOBSON  
PRODUCTS COMPANY, INC.

CASE NO: No. 93-1577

PLACE: Washington, D.C.

DATE: Monday, January 9, 1995

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IN THE SUPREME COURT OF THE UNITED STATES

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QUALITEX COMPANY, :

Petitioner :

V. : No. 93-1577

JACOBSON PRODUCTS COMPANY, INC.:

- - - - -X

Washington, D.C.

Monday, January 9, 1995

The above-entitled matter came on for oral argument before the Supreme Court of the United States at 10:59 a.m.

APPEARANCES:

DONALD G. MULACK, ESQ., Chicago, Illinois; on behalf of  
the Petitioner.

LAWRENCE G. WALLACE, ESQ., ESQ., Deputy Solicitor General,  
Department of Justice, Washington, D.C.; on behalf of  
the United States, as amicus curiae, supporting the  
Petitioner.

LAWRENCE D. STRICK, ESQ., Beverly Hills, California; on behalf of the Respondent.

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1 P R O C E E D I N G S

2 (10:59 a.m.)

3 CHIEF JUSTICE REHNQUIST: We'll hear argument  
4 next in Number 93-1577, Qualitex Company v. Jacobson  
5 Products Company, Inc.

6 Mr. Mulack.

7 ORAL ARGUMENT OF DONALD G. MULACK

8 ON BEHALF OF THE PETITIONER

9 MR. MULACK: Mr. Chief Justice and may it please  
10 the Court:

11 We'd like to emphasize two points in argument  
12 this morning. The first is that the Lanham Act does not  
13 facially or otherwise prohibit the registration of color  
14 as a trademark. In fact, it permits any symbol or device  
15 which distinguishes goods of one manufacturer from another  
16 to function as a trademark.

17 The second point is that both the Patent &  
18 Trademark Office and the district court found as a factual  
19 matter that Qualitex established a trademark after 30  
20 years of exclusive use of the green-gold color.

21 QUESTION: Mr. Mulack -- Mr. Mulack, the Lanham  
22 Act defines trademark to include any word name, symbol, or  
23 device, or any combination. Where do you think color fits  
24 into that definition?

25 MR. MULACK: Color is a symbol. It is a symbol



1 that has been used universally. Indeed, it's a symbol, in  
2 the sense that people recognize it and have recognized  
3 different colors over the years as representing --

4 QUESTION: What are the requirements, then, to  
5 get a trademark, in your view? It has to be -- color has  
6 to be nonfunctional?

7 MR. MULACK: That is correct. You must show  
8 secondary meaning, that --

9 QUESTION: And you have to show secondary  
10 meaning?

11 MR. MULACK: That is correct.

12 QUESTION: What are the requirements to have  
13 protectable trade dress?

14 MR. MULACK: With respect to a trade dress  
15 claim --

16 QUESTION: Is it the same as to get a trademark,  
17 exactly the same?

18 MR. MULACK: In essence it's very close, as you  
19 must also prove secondary meaning, as we did in the --

20 QUESTION: And it has to be nonfunctional.

21 MR. MULACK: Nonfunctional.

22 QUESTION: So what's the difference in trade  
23 dress and the ability to get it registered for a  
24 trademark?

25 MR. MULACK: Well, a trade -- a trade dress

1 comprises the overall appearance of a product. It  
2 consists of many different items, some of which may or may  
3 not be protectable. For instance, a trade dress is size,  
4 shape, color, the overall look of the product. Any one of  
5 those may not be protectable. However, a trademark is a  
6 symbol which is placed --

7 QUESTION: Well, in these circumstances, with  
8 the ironing pad here, is there any difference in what must  
9 be established to have protectable trade dress and to get  
10 a registered trademark? In each instance, do they not  
11 have to be -- the color has to be nonfunctional, and there  
12 has to be secondary meaning?

13 MR. MULACK: That is correct. In both  
14 instances --

15 QUESTION: It has to be the same.

16 MR. MULACK: It must be the same.

17 QUESTION: And yet the Ninth Circuit appeared to  
18 allow trade dress here but said it couldn't be registered  
19 as a trademark. They kind of split the baby, didn't they?

20 MR. MULACK: Yes, and that is quite baffling and  
21 quite astounding in the sense that the Lanham Act does not  
22 prohibit the registration of color.

23 QUESTION: I thought that in the Two Pesos case  
24 we said that a trade dress could be so inherently  
25 distinctive that no secondary meaning was required.

1 MR. MULACK: That is correct.

2 QUESTION: But I thought you had just -- I  
3 thought you had just answered Justice O'Connor, and these  
4 are background questions, I suppose, that a secondary  
5 meaning is required?

6 MR. MULACK: Well, that's correct.

7 QUESTION: And --

8 MR. MULACK: In the case, though, that you -- if  
9 you have an inherently distinctive product you do not  
10 have -- in terms of a distinctive trademark you do not  
11 have to prove secondary meaning, but the point is that  
12 globally I was responding to Justice O'Connor's question  
13 about the very basic questions of proving that there is a  
14 designation of a source, that one source is particularly  
15 recognized -- is the manufacturer of the product.

16 QUESTION: Well, let me just make sure that I  
17 understand it. For a trade dress, per our decision in Two  
18 Pesos, there can be a trade dress that is so distinctive  
19 that no secondary meaning is required?

20 MR. MULACK: Correct.

21 QUESTION: Can the same thing happen with color?

22 MR. MULACK: Well, I would have to say it's a  
23 facts-and-circumstance test, Your Honor. One would have  
24 to prove that this color is, indeed, acting as an indicia  
25 of source, and if it doesn't so prove through the facts

1 and circumstances of the evidence, then it would act as a  
2 trade --

3 QUESTION: So then color can be so distinctive  
4 you can at least imagine a case in which no secondary  
5 meaning is required?

6 MR. MULACK: Well, Your Honor, that's kind of  
7 close. In our particular case, as you know, we have a  
8 green-gold color, and that is -- it is very distinctive.  
9 It's --

10 QUESTION: I understand that, but as part of  
11 these initial questions, I thought you said to Justice  
12 O'Connor that for all purposes of this case, and for our  
13 consideration, trade dress and color as a trademark are  
14 the same, and you also said that a secondary meaning is  
15 always required, but that is not what we said in Two  
16 Pesos, so I'm still confused.

17 MR. MULACK: Well, I'm sorry if I wasn't clear  
18 in my answers. Clearly, inherently distinctive goods do  
19 not require secondary meaning. I happen to think that  
20 trademarks do not require a secondary meaning. I answered  
21 more globally. But yes, you're absolutely correct,  
22 Justice --

23 QUESTION: Yes, but when you're dealing with  
24 pure color, let me ask you this, isn't color part of the  
25 public domain in a way that distinctive logos and words



1 are not? Is it possible that for pure color to be  
2 protectable either as trade dress or for a registered  
3 mark, that there has to have been secondary meaning  
4 acquired?

5 MR. MULACK: Well, we're --

6 QUESTION: Is that possible because of the  
7 difference?

8 MR. MULACK: Well, because of the difference,  
9 color in our particular case must have acquired secondary  
10 meaning through a long use, so it recognizes and dis --

11 QUESTION: What does that mean in your  
12 particular case? I mean, the question is -- I still don't  
13 understand what your posi -- I had understood from your  
14 brief, I certainly understand from the Government's brief,  
15 that the proposition of law you are urging upon us is that  
16 color can be protectable as a trademark only if it has  
17 acquired a secondary meaning.

18 Now, I gather you no longer say that, and you  
19 disagree with the Government, and you think color can be  
20 protectable even if it has not acquired a secondary  
21 meaning.

22 MR. MULACK: If color has acquired secondary  
23 meaning, then it can be -- and if the color itself is --

24 QUESTION: That's not the question. The  
25 question is, if it has not acquired a secondary meaning,

1 can it be protected as a trademark?

2 MR. MULACK: If it is not inherently  
3 distinctive, no, it cannot.

4 QUESTION: Perhaps there's --

5 QUESTION: Well, can --

6 QUESTION: -- a middle step there that --

7 QUESTION: No, don't put the "if." I mean, you  
8 think in some situations, however, it can be protected as  
9 a trademark even if it has acquired no secondary meaning.  
10 Is that your position?

11 MR. MULACK: I am -- I would say only if it is  
12 inherently distinctive, and that is a facts-and-  
13 circumstance --

14 QUESTION: But that could exist, so there are  
15 some situations where color can be protected as a  
16 trademark without having acquired a secondary meaning.  
17 That's your position.

18 MR. MULACK: I would say if -- as the  
19 hypothetical that if it was inherently distinctive, as was  
20 earlier --

21 QUESTION: But how can -- you didn't ever answer  
22 my question. How can pure color be inherently  
23 distinctive? It's part of the public domain. Color is  
24 color. How can it be?

25 MR. MULACK: There are numerous colors and

1 shades that have -- we have shown in the trial court the  
2 human eye recognizes tens of thousands of shades and hues,  
3 and as a result --

4 QUESTION: Mr. Mulack, may I just clarify one  
5 thing? You're not suggesting that you could trademark a  
6 color for any and all purposes, you're talking about  
7 trademarking a color for use with a press pad, so it's  
8 color on a particular item, not color in general.

9 MR. MULACK: We are not -- that's correct,  
10 Justice Ginsburg, we are not attempting to appropriate  
11 color generally across the board to apply to every product  
12 that's manufactured in this country. We are seeking, and  
13 we did obtain a registration from the Patent & Trademark  
14 Office for this green-gold color as applied in a limited  
15 area, to press pads only.

16 QUESTION: So isn't that -- it's almost in the  
17 nature of things that you have to establish a secondary  
18 meaning. This color on this product is identified as  
19 coming from this source.

20 MR. MULACK: That's exactly, right, and we did  
21 do that in the trial court.

22 QUESTION: No, but aren't you also saying, or  
23 aren't you at least implying, that with a sufficiently  
24 unusual color, combined with an ironing board pad, it may  
25 not be necessary to establish secondary meaning by usage?

1           Aren't you impliedly saying there's a difference  
2 between -- if I walk into the registration office, there's  
3 a difference between trying to register the sort of bland,  
4 neutral color of some undyed ironing board pad as distinct  
5 from registering the unusual color that you've got, and if  
6 the unusual color that you've got applied to an ironing  
7 board pad is sufficiently distinctive, you don't have to  
8 acquire secondary meaning in order to register it? Is  
9 that what you were implying before?

10           MR. MULACK: Well, Your Honor, I suppose if we  
11 would extend it to that point, yes, but we have not  
12 addressed it in that particular manner in our briefs to  
13 say that it is inherently distinctive per se. We have  
14 established --

15           QUESTION: But you do take the position that  
16 there can be combinations of color and product that may be  
17 registered without acquiring a secondary meaning first?

18           MR. MULACK: Well, now, Your Honor, combinations  
19 of color or product, that's entirely different than a  
20 sole --

21           QUESTION: Well, I thought that's -- I thought  
22 your answer to Justice Ginsburg was that that's what we  
23 were talking about.

24           MR. MULACK: I didn't believe we were talking  
25 about combinations of colors. These are words of art.



1 QUESTION: What you said is that you can't  
2 trademark a color. Green-gold can't belong to Qualitex  
3 for all purposes. It can belong to it, if your position  
4 is right, on these press pads.

5 MR. MULACK: That's correct.

6 QUESTION: And right from the start you can walk  
7 into the register and say -- you know, register -- we  
8 haven't sold any trade pads at all yet, but we're thinking  
9 of selling trade pads, and we want this weird color to be  
10 our trademark --

11 MR. MULACK: We have not --

12 QUESTION: -- and the registrar says, you want  
13 it, you got it.

14 MR. MULACK: We have not suggested --

15 QUESTION: No secondary meaning at all.

16 MR. MULACK: Your Honor, we have not suggested  
17 that.

18 QUESTION: I know you haven't suggested it, but  
19 we're asking you, is it possible? If you wanted it, could  
20 you get it?

21 MR. MULACK: That's a very unique question in  
22 the sense that if it --

23 QUESTION: It's not unique, it's been asked  
24 about 20 times from up here and --

25 QUESTION: We've gotten about five different

1 answers.

2 QUESTION: -- and we still don't have an answer.

3 MR. MULACK: If it is inherently distinctive in  
4 color, which we, of course, would argue that the Qualitex  
5 color is distinctive -- we're not arguing it's inherently  
6 distinctive. We established our trial court record by  
7 proving after 30 years of use that people have recognized  
8 it as a sole source. We're not taking it that far as to  
9 say, this color is inherently distinctive.

10 QUESTION: You don't want us to reach that  
11 issue?

12 MR. MULACK: That's correct. We've not asked  
13 that point.

14 QUESTION: So if I happen to like lime yellow,  
15 for example, which I think is a beautiful color, you all  
16 could go around and get monopolies of it, and henceforth  
17 products wouldn't have lime yellow on them because you and  
18 other people would have tied them all up with trademarks?  
19 At least they wouldn't have lime yellow on them if -- why  
20 do you need to take all the lime yellow, anyway?

21 (Laughter.)

22 QUESTION: I mean, if somebody copies your  
23 appearance they get a trade dress suit.

24 MR. MULACK: Well, the -- in the particular  
25 industry in question, the press pad industry, many

1 different colors have been used over the course of the  
2 years. No one has ever used this unique green-gold color  
3 that Qualitex has used.

4 QUESTION: Would you explain the protection that  
5 you get from having a trademark of this color on this pad  
6 that you don't get from trade dress?

7 MR. MULACK: Yes. With respect to a trademark  
8 registration, certain rights are conferred by the statute,  
9 namely, incontestability of that mark after 5 years. You  
10 have a right to constructive notice that anyone that may  
11 use this product throughout the country is put on  
12 constructive notice that it's being used and you better  
13 not infringe based upon the registration.

14 Thirdly, there's also an importation clause that  
15 allows us to stop at the borders the importation of  
16 counterfeit goods just by showing the registration, which  
17 is quite important to Qualitex today and other  
18 manufacturers because of the importation of knock-off  
19 goods, if you will.

20 So you get those three benefits, in addition to  
21 others, that you don't get in a straight trade dress case,  
22 and you also -- the big benefit is to the public, in the  
23 sense that there's a central registry. There's a registry  
24 as to this particular color or this particular trademark  
25 being used by a particular manufacturer, and the members

1 of the public then know where to check to see if, indeed,  
2 a particular color is being used or has been trademarked.

3 QUESTION: May I ask you --

4 QUESTION: Doesn't trade dress give you enough  
5 protection in case somebody copies your appearance?

6 My real question was the problem of exhausting  
7 colors. There are infinite numbers of beautiful designs.  
8 I take it there are a finite number of attractive colors,  
9 and so what is the reason why it's important to industry  
10 to be able to tie up with a trademark one of what I would  
11 think would be a fairly limited number of attractive  
12 colors?

13 Why doesn't using a symbol, or the trade dress  
14 protection, give adequate protection for any legitimate  
15 purpose that industry might have?

16 MR. MULACK: Well, as I mentioned, trademarking  
17 a particular color helps confusion in the marketplace.  
18 Consumers know when they see this same color, or this  
19 mark, that they're getting the quality goods that they  
20 expected to obtain, and it's no monopoly whatsoever in  
21 that respect. This case --

22 QUESTION: But do they know that if --

23 MR. MULACK: -- held back in 1918 there's no  
24 monopoly to the extent --

25 QUESTION: Do they know that if the color



1 appears on an entirely different product, say, a necktie?  
2 I take it you wouldn't claim using this color for a neck-  
3 tie?

4 MR. MULACK: No, Justice Stevens, we have no  
5 interest in protecting this particular color against any  
6 other product, except on a press pad.

7 QUESTION: So why is the issue phrased as  
8 broadly as it is in the questions presented? You're not  
9 asking for a monopoly on this color. You're asking for a  
10 monopoly on the color used on this particular ironing pad.  
11 Why is that different from a trademark on this color in a  
12 triangle, for example?

13 MR. MULACK: Well, that -- that is a -- that is  
14 a symbol attached to a color which may create a trademark.  
15 It's different because our whole pad is in this one  
16 color --

17 QUESTION: But it's --

18 MR. MULACK: -- and the public recognizes this  
19 color.

20 QUESTION: Which is always in a particular  
21 shape, is it not? It's kind of a long, narrow --

22 MR. MULACK: Yes.

23 QUESTION: But why us that different than if you  
24 just trademarked a triangle of this color? I mean,  
25 neither one would preempt the use of the color on other

1 products that don't have the triangle on them.

2 MR. MULACK: Well, what Qualitex did 30 years  
3 ago, Justice Stevens --

4 QUESTION: That's 30 years before they applied  
5 for the trademark.

6 MR. MULACK: Yes. It --

7 QUESTION: I understand that.

8 MR. MULACK: -- placed on the pad this very  
9 arbitrary color so it would identify itself as a single  
10 source.

11 QUESTION: But why is that different from making  
12 a triangle with an arbitrary color in it, using that for  
13 100 years on some other product, like a bottle of soft  
14 drink, to identify it?

15 MR. MULACK: Well, it may or may not be  
16 different, but in terms of what is done, what the  
17 realities of the marketplace are right now is that we have  
18 sold over a million pads with this one color, so when a  
19 buyer sees that --

20 QUESTION: Yes, but you're not claiming a  
21 monopoly on the color on other products, or on other  
22 shapes, and I don't understand why this case is different  
23 than the ordinary trademark case with the triangle.

24 MR. MULACK: Well, this case is no different in  
25 terms of the perspective of this Court deciding whether or

1 not color alone is a trademark, that's exactly correct.

2 QUESTION: But you're not deciding that color  
3 alone is a trademark. You're deciding that color in this  
4 particular configuration on this particular product is a  
5 trademark.

6 MR. MULACK: No, Your Honor, I don't go so far  
7 as to talk about configuration. Configuration may be  
8 another separate element tied into trademarks, per se,  
9 that are allowed in color right now.

10 For instance, a configuration of the red cross,  
11 that has been trademarked over the years, and that is a  
12 configuration, so when Your Honor puts the word  
13 "configuration" into this trademark, it totally takes me  
14 into a whole different perspective as well as into  
15 different trademark law. We're talking about just color  
16 alone applied to a product, and that product is a press  
17 pad.

18 QUESTION: If you win your case, and I go into  
19 the publishing business and I publish all of my books with  
20 green-gold bindings, do I infringe your trademark?

21 MR. MULACK: Absolutely not. The registration  
22 certificate --

23 QUESTION: Then I don't know why your answer to  
24 Justice Stevens isn't different. I don't understand the  
25 different -- I don't understand how you can answer me as

1     you did, and Justice Stevens as you did.

2             MR. MULACK: One must go to the very basic  
3     trademark registration certificate that says Qualitex was  
4     granted a trademark for the green-gold color as applied to  
5     press pads. Beyond that, we have no rights whatsoever.

6             QUESTION: Then why isn't the press pad like the  
7     triangle.

8             MR. MULACK: I'm sorry, Your Honor?

9             QUESTION: Then why isn't the press pad like the  
10    triangle on Bass Ale?

11            MR. MULACK: The press pad is a whole different  
12    concept, because it is a whole product that has a color.  
13    It's not a consumer looking for a small, little symbol or  
14    mark as a trademark. The trademark in this case is the  
15    entire application of an arbitrary color that was placed  
16    upon the natural white, off-yellow white cloth that comes  
17    from the manufacturer.

18            QUESTION: Well, in any case --

19            MR. MULACK: They put this green color on it,  
20    and that became the trademark.

21            QUESTION: Could you give a general answer to  
22    Justice Stevens and to me that you are not trying to get a  
23    trademark in color per se, but color as applied to  
24    something in particular?

25            MR. MULACK: Yes, we are, and when Your Honor



1 says color per se, I take that to mean, so that the record  
2 is clear, color alone. Yes, we are seeking to establish a  
3 trademark in color alone as applied only to press pads.

4 QUESTION: Now --

5 QUESTION: In which case, Justice Stevens is  
6 correct in suggesting that the question that you present  
7 is somewhat too broad.

8 MR. MULACK: The question I'm -- that we  
9 present --

10 QUESTION: Your question is whether the Lanham  
11 Act prohibits the registration of color as a trademark,  
12 and based on the colloquy we've had, it seems to me the  
13 question should have been whether or not the Lanham Act  
14 protects the registration of color as a trademark on the  
15 ironing pad that's the subject of this suit.

16 QUESTION: And, indeed, that's what's before us,  
17 is it not? I assume that the Patent & Trademark Office  
18 granted a trademark here for a green-gold press pad, isn't  
19 that right? Isn't that what the trademark office gave  
20 you?

21 MR. MULACK: That's exactly right.

22 QUESTION: And that's what the Ninth Circuit  
23 invalidated?

24 MR. MULACK: That is correct.

25 QUESTION: And that's what's before us.

1 MR. MULACK: What's before you --

2 QUESTION: Not green-gold out here as some  
3 separate trademark item, but a green-gold press pad,  
4 right?

5 MR. MULACK: That is the specific issue with  
6 respect to the facts of this case before the Court.  
7 The --

8 QUESTION: So you stated your question too  
9 broadly.

10 MR. MULACK: Well, if the Court please, what we  
11 were certified by this Court on, after petition for cert  
12 was granted, the issue was directed as to whether or not  
13 color is --

14 QUESTION: Why can't you say yes? I mean, all  
15 you're interested in is having a green-gold press pad  
16 trademark upheld.

17 MR. MULACK: That is precisely what we'd like to  
18 do, but to reach that issue, the Court has to construe  
19 that the Lanham Act allows color as a trademark.

20 QUESTION: Well, it's a little too simple. I  
21 mean, really, you are arguing that your trademark is  
22 green-gold, but you are permitted to use that trademark  
23 only for press pads.

24 MR. MULACK: That's right, and only because the  
25 Patent & Trademark Office allowed us to do it.

1 QUESTION: Somebody asks you what's your  
2 trademark, you say, green-gold.

3 QUESTION: No, that's not right. That's not  
4 what the registration says, is it? What does the  
5 registration say?

6 QUESTION: The registration says it can only be  
7 used on press pads.

8 MR. MULACK: Press pads, that's correct, but to  
9 reach that registration, and to have it given to us, the  
10 Patent & Trademark Office must have complied with the law,  
11 and the law was, under the Lanham Act, whether or not you  
12 can trademark a color, whether you can give a registration  
13 for color alone, so -- so the Ninth Circuit says, while we  
14 agree that the Lanham Act does not prohibit the  
15 registration of color, they astoundingly decided that they  
16 wanted to cancel our trademark registration when the PTO  
17 gave it to us based upon that.

18 QUESTION: Thank you, Mr. Mulack.

19 MR. MULACK: Thank you, Your Honor.

20 QUESTION: Mr. Wallace.

21 ORAL ARGUMENT OF LAWRENCE G. WALLACE

22 ON BEHALF OF THE UNITED STATES, AS AMICUS CURIAE,

23 SUPPORTING THE PETITIONER

24 MR. WALLACE: Thank you, Mr. Chief Justice, and  
25 may it please the Court:

1           There is a dual nature to the interest of the  
2   United States in this case. On the one hand, we urge the  
3   Court to uphold the interpretation of the Patent &  
4   Trademark Office that the overall color of a particular  
5   product, not the color in the abstract, but the color of a  
6   particular product, or of a container in which the product  
7   is marketed, can qualify under the standards of the Lanham  
8   Act for registration as a trademark, and this case  
9   provides a textbook example of how it can qualify through  
10  the establishment of secondary meaning and  
11  nonfunctionality, a rather strong showing in this case.

12           On the other hand, we urge the Court not to  
13  undermine the rather exacting standards that the Patent &  
14  Trademark Office applies, and that we think are properly  
15  applied under ordinary principles of trademark law when  
16  it, or a reviewing court is considering whether an  
17  applicant has established the right to register a  
18  trademark.

19           In its 1993 second edition Trademark Manual of  
20  Examining Procedure, which we have cited and quoted a bit  
21  of in our brief, there is a whole section devoted to the  
22  question of color as a trademark. It's four paragraphs  
23  long, and I would like to summarize just a few of the high  
24  points at section 1202.04(e), which first cautions the  
25  examiners that color is usually perceived as an ornamental

1 feature of the goods, which is not something that could be  
2 trademarked.

3           However, color can function as a trademark if it  
4 is used in order to identify the source and if it is  
5 perceived by the purchasing public as identifying and  
6 distinguishing the source of the goods, and the applicant  
7 must submit evidence to the examiner that the proposed  
8 color mark has become distinctive of the applicant's goods  
9 in commerce, and --

10           QUESTION: Mr. Wallace, can I interrupt you with  
11 a question? Supposing I was a brand-new manufacturer of a  
12 product and I wanted to register a very distinctive new  
13 design as the trademark before I'd ever sold it, just to  
14 anticipate, I want to identify it. Can that be done?

15           MR. WALLACE: Are you speaking of, not --

16           QUESTION: Not color, just --

17           MR. WALLACE: Your question is not restricted to  
18 a single color? You're talking about --

19           QUESTION: I'm just talking about a typical  
20 trademark with a fancy design --

21           MR. WALLACE: If it is shown to be --

22           QUESTION: -- and a couple of animals in it.

23           MR. WALLACE: -- inherently distinctive --

24           QUESTION: If it's sufficiently distinctive --

25           MR. WALLACE: -- it can qualify.



1 QUESTION: -- it can qualify even though you've  
2 never sold the product, for future use?

3 MR. WALLACE: Under the Lanham Act as it's been  
4 amended, that -- if you have an intention to sell it --

5 QUESTION: Right.

6 MR. WALLACE: -- that will suffice, but then you  
7 have to introduce it in commerce and use it --

8 QUESTION: Could you do that with a color?  
9 Could you do that with a color, say I'm -- say this  
10 product had never been on the market, and they say, we  
11 found this very distinctive color, by which we intend to  
12 market the product. Could they do that?

13 MR. WALLACE: Our brief said that a color of a  
14 product would not ordinarily be registerable as inherently  
15 distinctive. We're not closing our minds to that  
16 possibility, but we have not encountered it in  
17 administering the trademark law.

18 QUESTION: So the statute has two different  
19 meanings, depending on whether one plans to market the  
20 product on the one hand, or has already marketed it on the  
21 other?

22 MR. WALLACE: The statute has the same meaning.  
23 In order for a mark to be registerable without a showing  
24 of secondary meaning, it has to be inherently distinctive,  
25 but mere coloration of a product, every product has some

1 color, and colors are used in all kinds of contexts.

2 Mere coloration is not ordinarily inherently  
3 distinctive, so that in order to use just the overall  
4 color as a trademark, you have to show secondary meaning.  
5 It's the same meaning of the statute.

6 QUESTION: Why isn't every trade dress therefore  
7 trademarkable, or is it?

8 MR. WALLACE: Well, there may be aspects of it  
9 that are trademarkable, but the trade dress --

10 QUESTION: Why not the entire thing?

11 MR. WALLACE: There are similar -- there may be  
12 instances where the trade dress could be put together as a  
13 trademark in its entire thing.

14 QUESTION: Well, how about --

15 MR. WALLACE: If you're talking about the  
16 packaging of a particular product --

17 QUESTION: Right.

18 MR. WALLACE: -- it could happen.

19 QUESTION: A certain shape, and a certain color,  
20 and a certain ribbon on it, that's a trademark. That  
21 becomes a trademark there, just because people get used to  
22 seeing it that way.

23 MR. WALLACE: Well, if you're --

24 QUESTION: It's just a new meaning of trademark  
25 to me.

1 MR. WALLACE: Well, it's not a new meaning, if  
2 you establish secondary -- people don't usually box  
3 themselves into not being able to change any aspect of the  
4 trade dress in order to have a mark. The mark is usually  
5 something more discreet that is then used over the years  
6 in different ways, but there's nothing in the act that  
7 requires that if something qualifies as trade dress it  
8 cannot qualify as a trademark, or vice versa.

9 QUESTION: I suppose a smell, under the  
10 Government's theory, could also be -- could also qualify.

11 MR. WALLACE: Well, I have not explored the  
12 question of fragrances.

13 QUESTION: Well, you sell these ironing covers,  
14 and they always have a lavender smell, you know. You  
15 associate the lavender smell with this company, so you're  
16 going to trademark lavender for ironing board covers.

17 MR. WALLACE: That is a question I have not  
18 explored with the Patent & Trademark Office, or --

19 QUESTION: Mr. Wallace --

20 MR. WALLACE: -- it hasn't come up in the cases.

21 QUESTION: -- you mentioned two interests of the  
22 Government. Is there -- does the Government have any  
23 interest that relates to its position vis-a-vis other  
24 countries? That is, in the NAFTA section, article 1708,  
25 color is specifically mentioned as something that can be

1 the subject of trademark to distinguish goods or services,  
2 so does the United States have any interest vis-a-vis its  
3 partners in the trading world to have the same definition  
4 of what's trademarkable?

5 MR. WALLACE: Well, it's not that the definition  
6 will always be the same. The treaty recognizes that if  
7 the participating country affords trademark protection for  
8 color, then it will be recognized by the other  
9 signatories, and of course --

10 QUESTION: But wouldn't it be odd, then, to  
11 recognize somebody else's color and say, but at home you  
12 couldn't do it?

13 MR. WALLACE: Well, the treaty has not amended  
14 the laws of the participating countries so that everyone  
15 now has an identical trademark law, but it recognizes  
16 aspects of the trademark law that will be mutually  
17 enforced. There are many similarities in the trademark  
18 laws, and we must remember that protection of color under  
19 the trademark laws can often mean something different from  
20 what it means in this case. It can mean the color of a  
21 logo, or a combination of colors on the logo. It doesn't  
22 always mean the color of a product, or the overall color  
23 of a container.

24 In any event, what I was hoping to emphasize is  
25 that both aspects of our dual interest can be illustrated

1 by contrasting the situation in this case with claims that  
2 are suggested to this Court in one or two of the amicus  
3 filings that have been made in support of the petitioner  
4 in this Court, which seem to us to present much closer  
5 cases because they raise concerns that are not involved in  
6 this case about whether -- concerns that would probably be  
7 explored before the -- in the administrative or judicial  
8 proceedings about whether the color would qualify as a  
9 trademark, and I'm not attempting to prejudge those cases  
10 and certainly not asking the Court to prejudge those  
11 cases.

12 QUESTION: What I'm trying to work out, the  
13 reason I raised this before, was why -- what is the  
14 difference between a triangle and a color? A triangle  
15 obviously could be used as a trademark, assuming all  
16 conditions. Historically, I take it, many courts have  
17 said that colors cannot.

18 Now, the differences that I was -- assumed had  
19 been in the briefs, that I wanted your reaction to, was  
20 that there are a limited number of, let's say, attractive  
21 colors. They're prevalent everywhere.

22 So that if you allow in each field one person to  
23 get a trademarkable monopoly of color, you might have less  
24 attractive products, you might have trade advantages, et  
25 cetera. That's what I wanted a reaction to.



1 MR. WALLACE: There are specific findings in  
2 this case that answer that question, that there are many  
3 other attractive colors available for press pads, and  
4 there's nothing in the act that precludes this basis for  
5 granting -- as a per se matter, for granting a trademark.  
6 Even though courts, mostly looking toward pre-Lanham Act  
7 law, some courts have adopted that view, it is not based  
8 on the statute.

9 QUESTION: Thank you, Mr. Wallace.

10 Mr. Strick, we'll hear from you.

11 ORAL ARGUMENT OF LAURENCE D. STRICK

12 ON BEHALF OF THE RESPONDENT

13 MR. STRICK: May it please the Court, Mr. Chief  
14 Justice:

15 I'd like to pick up on a comment that Justice  
16 Scalia just made, because I think it goes to the essence  
17 of the respondent's case. Under the view asserted by  
18 Qualitex in this case, whatever distinctions might have  
19 existed in the law between registered trademarks and trade  
20 dress, two completely different concepts heretofore, would  
21 be eliminated. The differences would go away.

22 In Qualitex's view, there is no difference  
23 between trade dress, the overall look and image of a  
24 product, and a registered trademark, which has generally  
25 and historically been limited to devices, symbols, and

1 designs under the Lanham Act.

2 I don't think -- in any way in which you torture  
3 the language of the Lanham Act, mere colors used on these  
4 press pads, unconfined to a symbol or a design, cannot be  
5 designed as a symbol or a design. It is trade dress,  
6 which adequate protection already exists for, and which  
7 Qualitex was given in the case at bar, the same protection  
8 it would have been entitled to had it had a registered  
9 trademark.

10 No, petitioner would not answer, the 20-or-so  
11 times it was asked by the Court. I will. That is exactly  
12 what the petitioner is asserting. The petitioner is  
13 asserting that I can walk into the Patent & Trademark  
14 Office with a color that is inherently -- not inherently  
15 distinctive, that has never been used on a product, that  
16 the public has never even seen --

17 QUESTION: Well, now, wait a minute.

18 MR. STRICK: -- and say, register it.

19 QUESTION: Wait a minute. I'm not sure that's  
20 what petitioner said. We tried to pin petitioner down and  
21 were unable to do it, but we do have a case here where the  
22 findings show there was secondary meaning acquired.

23 It's not a first-time registration before any  
24 production of the press pad. This is a press pad that has  
25 been in use and been sold for a long time with the green-

1 gold color, and where the Patent & Trademark Office, after  
2 some time of experience, did issue a trademark, and you  
3 say that that is improper?

4 MR. STRICK: Yes, I do, Justice O'Connor, and I  
5 say it for this reason. Under section 2 of the Lanham  
6 Act, the only type of trademark that requires a showing of  
7 secondary meaning in order to earn registrability is a  
8 descriptive mark, as this Court pointed out in the Two  
9 Pesos case.

10 Now, the fact that Qualitex went ahead in this  
11 case and spent an awful lot of money to prove secondary  
12 meaning I think is itself a concession that its color is  
13 not inherently distinctive, otherwise it would have so  
14 asserted, and it didn't in this case. Now --

15 QUESTION: What do you mean by the term -- and  
16 you've used it, and your opponent, to say that a color is  
17 inherently distinctive? What precisely does that mean?

18 MR. STRICK: It's a difficult question,  
19 Mr. Chief Justice.

20 QUESTION: Well, it's apparently a difficult  
21 answer, too.

22 MR. STRICK: I think that there are certain  
23 colors that if you compare, for example, hot neon pink,  
24 that color, one might say that there are certain colors  
25 that might in fact be inherently distinctive, because --

1 QUESTION: Well, is it a totally --  
2 MR. STRICK: -- just the spectrography of it.  
3 QUESTION: Is it a totally subjective thing?  
4 MR. STRICK: I think it is a totally subjective  
5 thing.  
6 QUESTION: Then how is it usable in deciding  
7 whether or not something can be trademarked?  
8 MR. STRICK: It is the essence of one of the  
9 difficulties we've pointed out in our brief. It is  
10 precisely because it is so difficult to tell colors apart,  
11 and to make fine distinctions between color.  
12 I can't help but resort to props in this case,  
13 when I use --  
14 QUESTION: Well, I thought --  
15 MR. STRICK: Here are three shades of green --  
16 QUESTION: Yes, but the Solicitor General says  
17 you can't have color as inherently distinctive, that only  
18 if secondary meaning has been acquired can the trademark  
19 issue. That's the S.G.'s position.  
20 QUESTION: Or at least it used to be. It was in  
21 his brief, I think.  
22 QUESTION: It was in the brief, anyway, and  
23 apparently that kind of fits the facts of this case, and  
24 why, on the facts of this case, is the trademark invalid,  
25 where we are not dealing with inherently distinctive

1 color, we are dealing with something that has acquired  
2 secondary meaning and was found to be nonfunctional?

3 MR. STRICK: Yes, justice O'Connor, I say that  
4 it's not registrable because it's not being used as a  
5 trademark as you defined it at the beginning of  
6 petitioner's argument. The use of color in this case is  
7 not a symbol, it is not a device, it is not a design.

8 Justice Thomas, in his concurring opinion in the  
9 Two Pesos case --

10 QUESTION: Well, the petitioner says --

11 MR. STRICK: -- generally recognized --

12 QUESTION: The petitioner says color on a press  
13 pad is a symbol, in effect.

14 MR. STRICK: I simply disagree with that  
15 proposition. In my --

16 QUESTION: The Patent & Trademark Office takes  
17 the position that it is.

18 MR. STRICK: The Patent & Trademark Office, if  
19 you look back to the Owens-Corning case, was sort of --  
20 sort of led kicking and screaming into registering trade  
21 colors. They had denied Owens-Corning a trademark in that  
22 case. The case arose from an appeal of the Trademark  
23 Trial & Appeals Board. It's not some --

24 QUESTION: That's pink fiberglass insulation?

25 MR. STRICK: That's the famous Owens-Corning 1-



1 800-PINK color.

2 QUESTION: Insulation.

3 MR. STRICK: Yes.

4 QUESTION: Yes.

5 MR. STRICK: Behind-the-wall insulation.

6 QUESTION: But did the -- does the office take  
7 the position that color is a symbol, or simply that color  
8 as applied to a product is registrable under a definition  
9 which does not confine itself to symbols or words or what-  
10 not, but refers to a mark as including these things?

11 MR. STRICK: I think that the way they write the  
12 precise rule in question sort of begs the question. Rule  
13 1202.04(e) says the color can function as a trademark if  
14 it is used on the goods in the manner of a trademark.  
15 What I am arguing is that mere color unconfined by a  
16 symbol or a design is not a trademark.

17 QUESTION: Yes, but they --

18 MR. STRICK: It is protectable trade dress.

19 QUESTION: Wasn't -- isn't it -- that may not be  
20 a championship definition, but isn't it clear that they  
21 were not assuming that there was the little symbol or  
22 device involved, so they must have been assuming that it  
23 was color as applied to some kind of an object.

24 MR. STRICK: I don't get that meaning from the  
25 regulation, Mr. -- Justice --

1 QUESTION: Why couldn't color be -- fit with the  
2 definition of a device used to distinguish goods? The  
3 color here is a device, is a means to distinguish these  
4 press pads from other press pads.

5 MR. STRICK: I am simply asserting as a matter  
6 of policy that color of a product itself, while it may be  
7 protectable as trade dress under appropriate  
8 circumstances, the overall product, color of a product,  
9 that which has always been traditionally referred to and  
10 regarded as trade dress, is simply not a device within the  
11 meaning --

12 QUESTION: Well, I'm not sure that that's --

13 QUESTION: The Patent & Trademark Office now  
14 thinks it is.

15 MR. STRICK: I understand the Trademark  
16 Office --

17 QUESTION: And wisdom may come late, but --

18 MR. STRICK: And it may not be correct wisdom,  
19 for the host of reasons we set forth in our brief.

20 QUESTION: But everyone agrees, I take it, that  
21 color can be part of a registrable device or symbol.  
22 Everyone agrees with that, don't they?

23 MR. STRICK: Everyone -- even I agree with that.

24 QUESTION: All right.

25 (Laughter.)

1 QUESTION: Why isn't color, in the context of a  
2 press pad, something that has all of the impact and the  
3 force and the meaning of a symbol, or a device?

4 MR. STRICK: I simply disagree with that  
5 assertion, Justice Kennedy. What -- the law has always  
6 distinguished between trade dress and trademarks. There  
7 is tremendous cross-over, and this Court has held numerous  
8 times that the same requirements for trademarkability are  
9 used to apply to trade dress to determine whether trade  
10 dress is protectable.

11 But again, to pick up on something Justice  
12 Scalia mentioned, why couldn't we trademark, for example,  
13 smells? If I come up with an alleged unique chocolate  
14 smell for a candy bar and assert that it, too,  
15 functions -- has all the functionality and all the  
16 attributes of a trade --

17 QUESTION: You were saying that a design or a  
18 symbol need not be registrable with reference to its use  
19 on a particular product --

20 MR. STRICK: I'm --

21 QUESTION: -- or it becomes trade dress --

22 MR. STRICK: What I am saying --

23 QUESTION: -- and I don't think that's the law.

24 MR. STRICK: Well, what I am saying is that the  
25 law has always separated the issue of registrability of a

1 trademark from concepts of trade dress.

2 It's an issue in my mind between registrability  
3 and protectability. The mere fact that trade dress may be  
4 protectable because it has the attributes of a trademark  
5 doesn't necessarily mean it ought to be granted  
6 registrability, because I think it puts it somewhat in  
7 tension with the Two Pesos case. Two --

8 QUESTION: Is there any other instance in which  
9 the registry has, before issuing a trademark, has  
10 requested -- gone to the trouble of ascertaining whether  
11 that mark has already acquired a secondary meaning? Are  
12 there any other areas where the registry does this?

13 MR. STRICK: My understanding is that's exactly  
14 what happened in this case.

15 QUESTION: In this case, I know.

16 MR. STRICK: The trademark office did require  
17 further declarations and affidavits regarding secondary  
18 meaning.

19 QUESTION: Is that, as far as you know, unique?

20 MR. STRICK: As far as I know, it's unique. I  
21 am not aware of every single instance of registration of  
22 color in the trademark office or what was filed.

23 QUESTION: I had always assumed that you can get  
24 a trademark ex ante. The whole purpose of it is to brand  
25 the stuff before you've ever sold anything.

1 MR. STRICK: That's correct. I think that's why  
2 the holding in Two Pesos was that inherently distinctive  
3 trade dress is entitled to protection without secondary  
4 meaning, because it's the right to identify your goods  
5 even if it hasn't yet bestowed secondary meaning that's  
6 being protected.

7 What I'm simply suggesting is that the product  
8 feature in this case --

9 QUESTION: You keep looking back there. I can't  
10 see what --

11 MR. STRICK: There's a press pad --

12 QUESTION: You're doing something.

13 MR. STRICK: We have -- we've brought the actual  
14 press pad.

15 QUESTION: Ah, I see.

16 QUESTION: All right.

17 (Laughter.)

18 MR. STRICK: The product feature in this case is  
19 something which has traditionally been regarded as trade  
20 dress subject to virtually the same protection as a  
21 trademark. The difference is this. Again referring back  
22 to Justice Scalia's question to Mr. Mulack, could they  
23 just walk into the office and say, register this, without  
24 a showing of secondary meaning, even if the color is not  
25 inherently distinctive?



1           Putting aside whether I concede that certain  
2 colors may be inherently distinctive, could they go in and  
3 simply say, register this color, without any showing of  
4 secondary meaning, when, under the Two Pesos holding, it's  
5 only inherently distinctive --

6           QUESTION: Well, what if --

7           MR. STRICK: -- trade dress that's entitled to  
8 proof without secondary meaning.

9           QUESTION: What if the effort was to register a  
10 small circle of the same color to simply be put on each of  
11 the pads and the rest of the pad stay in its natural  
12 color?

13          MR. STRICK: I think that's probably  
14 registrable. It's a device, it's a design, or it's a logo,  
15 but that's not what they did in this case. They sought to  
16 register the entire -- in other words, there's no  
17 difference between the product and its trademark.

18          QUESTION: I take it the word "device" in this  
19 list of things doesn't mean a gimmick, it means -- it  
20 means like a heraldic device, that is, a symbol or sign.  
21 It's another word for a sign.

22          MR. STRICK: Some element of design, that's  
23 correct, Justice Scalia.

24          QUESTION: Where has it ever been defined that  
25 way by Congress or by the PTO?

1 MR. STRICK: I don't think it has.

2 QUESTION: Hasn't it generally been given a very  
3 broad meaning, symbol and device?

4 MR. STRICK: Generally so. Again, quoting from  
5 Justice Thomas' concurring opinion in the Two Pesos case  
6 at page 2766 of the Supreme Court Reporter version of the  
7 case, trade dress -- "trade dress, which consists not of  
8 words or symbols but of a product's packaging or image,  
9 seeks at common law to have been thought incapable ever of  
10 being inherently -- "

11 QUESTION: That's not the question I'm asking  
12 about. Trade dress -- correct me if I'm wrong. I  
13 associate it more with a total packaging, as distinguished  
14 from the goods themselves, and I thought that the words  
15 "symbol" and "device," as used by Congress in the law,  
16 were given a broad meaning, not a narrow meaning, to mean  
17 a heraldic device. I thought that those terms were given  
18 a broad meaning. Am I wrong?

19 MR. STRICK: No, I don't think you are wrong,  
20 Justice Ginsburg. I'm only suggesting that the word  
21 "device," "symbol" or "design" in my view requires some  
22 element of design or art to be a symbol or a logo,  
23 otherwise it qualifies as trade dress. Now --

24 QUESTION: So you disagree with the insulation  
25 case as well, the pink --

1 MR. STRICK: That's correct. We agree with  
2 Judge Bissell's dissent in the Owens-Corning case, not  
3 with the majority opinion. We think that that was an  
4 unusual case based on the facts. It ought to be limited  
5 to its facts, because you might recall that Owens-  
6 Corning -- Owens-Corning was the only manufacturer that  
7 put color on its insulation that went behind walls. No  
8 one cared what color it was, but Owens-Corning used --

9 QUESTION: They advertised it that way, too, the  
10 famous pink panther, right?

11 MR. STRICK: And the 1-800-PINK telephone  
12 number, and on and on, so the Court in that case said, we  
13 don't think in this particular case it's anticompetitive  
14 to grant a trademark because no one else is using color.

15 I'm suggesting that's an unusual situation. The  
16 facts in the case at bar are that every press pad  
17 manufacturer uses one color or another.

18 QUESTION: May I ask you a question that really,  
19 I'm wondering how much emphasis we should properly put on  
20 the showing of secondary meaning in a case.

21 As I understand what you're telling us, the  
22 statute doesn't require it, but the trademark office does,  
23 is that right?

24 MR. STRICK: That's what it seems to require.

25 QUESTION: But if that's true and the statute

1 does not require it, would it not follow that if you came  
2 in tomorrow with a yellow pad, not even a distinct --  
3 you'd be entitled to a trademark?

4 MR. STRICK: Yes. That's what that would mean.

5 QUESTION: That's your position, that if they're  
6 right, that you don't really need all the secondary  
7 meanings.

8 MR. STRICK: That's correct. They just walk in  
9 and get a trademark, even if what they're really talking  
10 about is trade dress, and even if it's not inherently  
11 distinctive trade dress, which would require an  
12 affirmative showing of secondary meaning under the Two  
13 Pesos case.

14 QUESTION: Well, so then you're saying that no  
15 trademark requires secondary meaning as a condition of  
16 registration.

17 MR. STRICK: Section 2 requires a showing of  
18 secondary meaning only with respect to descriptive marks,  
19 as the Two Pesos case pointed out, and the reason why they  
20 did not graft on to section 43(a) requirement for  
21 secondary meaning for inherently distinctive trade dress  
22 is because section 2 doesn't require it except for  
23 descriptive marks, if it's arbitrary, fanciful,  
24 suggestive, et cetera, that section 2 does not require a  
25 showing of secondary meaning for registrability, only if

1 it's the weakest form of mark, in essence, a descriptive  
2 mark.

3 The position adopted by petitioner in this case  
4 would turn that, I think, on its head, because they would  
5 be able -- and be at tension with Two Pesos, because they  
6 would in essence be able to register that which might not  
7 have been protectable as trade dress absent a showing of  
8 secondary meaning, and we've pointed out that --

9 QUESTION: Well, if you say that color can't be  
10 inherently distinctive, so that what we have here is  
11 something descriptive in the minds of the buyers? Then  
12 under our Two Pesos case, and other authorities as well,  
13 there would have to be secondary meaning to make it  
14 protectable.

15 MR. STRICK: That's correct.

16 QUESTION: So I think maybe that's the rationale  
17 of the Patent & Trademark Office, to say color isn't  
18 inherently distinctive, it's part of the public domain,  
19 but if it's descriptive as applied to a product, it can be  
20 registered provided secondary meaning is established and  
21 provided it's nonfunctional, and isn't it true that very  
22 few items will be found where color is nonfunctional? I  
23 guess an aesthetic use or purpose of color makes it  
24 functional.

25 MR. STRICK: I think color is generally used for



1 aesthetic purposes, and since the so-called aesthetic  
2 functionality test really seems to have lost its way in  
3 the law, and it really isn't used -- it isn't used in the  
4 Ninth Circuit any more, for example -- we did show out  
5 there was a nonaesthetic function, in essence, for the use  
6 of color on press pads, a finding that was not persuasive  
7 either to the district court or to the Ninth Circuit.

8 QUESTION: But color, not a particular color, as  
9 distinguished from the boat motor case, where the  
10 particular color, black, that color was functional because  
11 it made it look smaller, because it was compatible with  
12 different boats --

13 MR. STRICK: Exactly.

14 QUESTION: -- but here it's arbitrary. Color is  
15 functional on a press pad, but not any particular color.

16 MR. STRICK: True.

17 QUESTION: There, the color black was  
18 functional.

19 MR. STRICK: That's true. I -- both the  
20 district court and the Ninth Circuit held that color, the  
21 use of color may be functional, but not the particular  
22 shade of color employed in this case. We argued, because  
23 there was substantial evidence, that you can't sell a  
24 light press pad. They get dirty fast, they look untidy --  
25 that was generally uncontested.

1 But the point that both courts made, however,  
2 was it was this particular -- there was no need shown for  
3 this particular shade of green, and therefore it was  
4 serving a source-identifying feature, not a functional  
5 feature of making the pad look neat.

6 But there -- most, I think, examples of the use  
7 of color will be found functional. As some of the courts  
8 have pointed out, ice creams tend to be packaged in blue  
9 or silver packages because it connotes coldness or  
10 iciness. Vegetable cans are packaged in green, for  
11 example, because green connotes vegetables. Lemonade is  
12 made yellow, because it connotes lemons.

13 I think one of the examples I've always used in  
14 this case, not -- going back to 1920, to the Court's  
15 decision in the Coca-Cola versus Koke, K-o-k-e Koke, if  
16 you were to take a glass of Pepsi and a glass of Coke, a  
17 can of Pepsi and a can of Coke, say Coca-Cola, probably  
18 the most famous logo every invented, and a can of Pepsi,  
19 which basically is also a very well-known logo after all  
20 these years, no one would confuse them, because the logos  
21 are so well-known, so well done.

22 Now, if I took that beverage and poured them  
23 both into clear glass, I would hold up two glasses of  
24 brown-flavored liquid that you couldn't tell apart.

25 Now, this Court held in the Coca-Cola case that

1 you couldn't get trademark rights in the brown color of  
2 that fluid because this Court held that coloring matter is  
3 free to all, and it's an example, I think, that goes to  
4 the --

5 QUESTION: Well, but wasn't part of the reason  
6 that that, as a functional matter that was necessary for  
7 the manufacture of the product?

8 A different case, something which we might all  
9 need after the arguments, are Pepto-Bismol --

10 (Laughter.)

11 QUESTION: -- which is pink.

12 MR. STRICK: And it's packaged in a clear  
13 bottle, so what you're seeing is really the product, not  
14 some image or design pressed onto the bottle. If you  
15 empty a bottle of Pepto-Bismol it's a clear bottle.  
16 That's another example.

17 They would be arguing, and it's one of the more  
18 difficult, I think, examples, because pink is a much more  
19 distinctive color than -- than green.

20 QUESTION: Well, but pink medication you  
21 associate with being soothing, so I assume that that's  
22 functional.

23 MR. STRICK: But -- that may be true. It's a  
24 soothing color, it's --

25 QUESTION: Sure.

1           QUESTION: Also, it has kind of a candy  
2 connotation, so it's not really medicine, but that's a  
3 question I think that goes to the private -- private, so-  
4 called private label manufacturers question, where this  
5 Court -- courts are now holding that you can mimic  
6 packaging. The issue is likelihood of confusion, not  
7 whether you're mimicking packaging.

8           If you're putting a sufficient descriptive  
9 label -- this is Ralph's Market stuff, not Procter Gamble  
10 stuff -- you're not infringing trademark rights, because  
11 the essence of trademark law is to prevent deception and  
12 confusion, not simply to protect property rights, but if  
13 you adopt Qualitex's position in this case, you are saying  
14 that all trade dress is now registrable. Two Pesos can  
15 now take their trade dress one further and register a  
16 distinctive Mexican-looking motif for fast food,  
17 Mexican --

18           QUESTION: I thought Mr. Wallace said no, you  
19 were buying into all this stuff that's in the manual, too,  
20 so that the trademark office had to be very careful about  
21 what colors on products it accepts for registration.

22           MR. STRICK: And whether the color is truly  
23 being used, as I quoted from the regulation, in a  
24 trademark sense of the word.

25           We've also pointed out the practical problems

1 that registering colors will present. For example, the  
2 trademark office used the same lining codes for pink and  
3 red, so if I'm going to search the principal register to  
4 see if a client of mine's color is going to infringe a  
5 registered color, and I see a lining for red, I don't know  
6 what shade that is. How do I know whether my client's  
7 color is going to infringe that color when it doesn't give  
8 me sufficient notice of what color we're talking about?

9 Second, how close do the colors have to be  
10 before they're found to be infringing?

11 I couldn't help notice at counsel table I've got  
12 a handful of amicus briefs in light green, I've got  
13 another shade of green here -- these are pretty clearly  
14 different, but the pen blotter that counsel are provided  
15 at table is pretty close to this green, and as you get  
16 into those kinds of issues, I think you're dealing in an  
17 area where both the trademark office and perhaps even the  
18 law is not really prepared to exist.

19 QUESTION: Your argument interests me that you  
20 would not know if you saw that a color was registered  
21 whether you were a possible infringer. Is that unique to  
22 the color problem? Don't you have to really examine the  
23 exact replication of each symbol or device before you can  
24 give an opinion as to whether or not it infringes?

25 You're not saying that every symbol must have a



1 verbal description that is sufficient in and of itself to  
2 determine infringement, are you?

3 MR. STRICK: No, I'm not, Justice Kennedy. What  
4 I'm saying is, you've got a traditional situation where  
5 I'm going to search the principal register and compare my  
6 client's proposed mark with a registered mark, I'm going  
7 to see words, I'm going to see a symbol or a design, and  
8 that symbol or design may or may not have lining codes  
9 which the trademark office uses to connote different  
10 colors.

11 Now, I can look at the symbol or the words and  
12 say, whoops, my client's mark is going to infringe that,  
13 irrespective of the color, or irrespective of whether  
14 we've changed the color.

15 What I'm saying is, when you have a registration  
16 that says green-gold for press pads, I don't know what the  
17 registration is talking about, and the lining codes may  
18 not help because it doesn't tell me what shade of green,  
19 what shade of red, what shade of blue.

20 QUESTION: Well, before you yield some opinions  
21 as to some devices, I assume you would have to identify  
22 the precise color on the registered device by looking at  
23 the mark itself, not just some verbal description of it.

24 MR. STRICK: That's correct. In this case it  
25 would force me to go out and buy a press pad, because

1     that's the mark. There's not a symbol. It's not a  
2     design. It's not a device.

3             I would have to go out and buy a press pad and  
4     then say, okay, this color does or does not -- my  
5     appliance color does or does not infringe, and I think  
6     that's the essence of what I'm saying, and I think it's  
7     the essence of the question that Justice Scalia posed:  
8     why doesn't trade dress, then, therefore become  
9     registrable?

10            Under the view adopted by Qualitex, there's  
11    going to be no difference between trademarks as I've  
12    traditionally understood it in 18 years of practice and  
13    trade dress, which encompasses a whole host of features  
14    separate and apart from the logo, symbol, device, or  
15    design a manufacturer may use to differentiate his goods  
16    from the goods of a competitor, and I think that opens a  
17    host of problems that are unnecessary, particularly when  
18    color is already protectable either as part of a logo or  
19    as trade dress under section 43(a) of the Lanham Act.

20            QUESTION: I'm trying to think of what authority  
21    the register has to insist that before he approve a  
22    particular trademark it have acquired recognition as the  
23    symbol of a particular --

24            MR. STRICK: Well, if you say -- if I ask, what  
25    is the trademark in this case, I'm going to say green-

1 gold. I think that's inherently descriptive, almost per  
2 se. Therefore, I suppose the trademark office could say,  
3 because just in --

4 QUESTION: I think --

5 MR. STRICK: -- the color is descriptive we're  
6 going to --

7 QUESTION: I think -- yes, I think the trademark  
8 office probably says it doesn't become distinctive until  
9 it has acquired distinctiveness from the public  
10 associating it with the particular product, but that's a  
11 strange, strange meaning of distinctive, it seems to me.

12 MR. STRICK: I agree.

13 QUESTION: But if you take that -- if you  
14 construe their work that way, then you would not be able  
15 to get a trademark on your yellow pad that we discussed  
16 earlier without proving secondary meaning.

17 MR. STRICK: That's correct. That is exactly  
18 our position.

19 QUESTION: It seems to me it either is or isn't  
20 distinctive. It doesn't acquire distinctiveness. It  
21 acquires recognition, perhaps.

22 MR. STRICK: I --

23 QUESTION: It's either distinctive or not  
24 distinctive.

25 MR. STRICK: Again, I think in Two Pesos the

1 Court said the issue is not public recognition of the  
2 distinctiveness. It's either inherently distinctive, or  
3 it's not. If it's inherently distinctive, it's entitled  
4 to be protected irrespective of whether that inherent  
5 distinction has bestowed some other benefit. It adopted  
6 the Fifth Circuit's position in that case.

7 If there are no --

8 QUESTION: Do you agree with the view that this  
9 color is descriptive?

10 MR. STRICK: I agree with the view that the  
11 color -- I think that any color mark is inherently  
12 descriptive, because you have to describe it to describe  
13 it. What is it? It's yellow-green. That's descriptive.

14 QUESTION: But the word "descriptive" means  
15 descriptive of the product, doesn't it, not descriptive of  
16 the color?

17 MR. STRICK: I suppose you could -- yes.  
18 Normally, descriptive --

19 QUESTION: And you agree that this is  
20 descriptive of the product?

21 MR. STRICK: I think it's a descriptive use of  
22 the product, but it's not the same as a can of meat --

23 QUESTION: Well, don't you say the color --

24 MR. STRICK: -- that says, "good meat."

25 QUESTION: Don't you say the color is

1 descriptive, not that this particular color is descriptive  
2 of this product?

3 MR. STRICK: Color is descriptive.

4 QUESTION: Yes.

5 MR. STRICK: That's what I'm saying, but I'm  
6 also saying it's not the same as a can of chili that does  
7 says, "Good-eating chili," or something like that, which  
8 would clearly be a descriptive -- a descriptive mark.

9 QUESTION: I'm not sure I understand what you  
10 mean when you say color is descriptive. What do you mean  
11 by, color is descriptive?

12 MR. STRICK: It's not something I planned to get  
13 into on the argument, but if you were to ask me, what is  
14 the trademark whose protection is sought in this case, I'm  
15 going to say the color, a green-gold color. That sounds  
16 like I'm describing the mark.

17 QUESTION: Not any mark. I mean, you can  
18 describe a red cross mark as a, you know --

19 QUESTION: The red cross --

20 MR. STRICK: The red cross would be a red cross  
21 colored red. That's a slightly different example.

22 I am not asserting, by the way, in this case,  
23 and I did not in my brief, that registration should be  
24 denied in this case because it's purely descriptive, so I  
25 don't want any misunderstanding on that. I did not assert



1 it in the brief, and I am not asserting it, except as part  
2 of this --

3 QUESTION: I withdraw my question, then. You  
4 have enough problems, without asking.

5 MR. STRICK: If there are no more questions,  
6 I've pretty much had my argument.

7 CHIEF JUSTICE REHNQUIST: Thank you, Mr. Strick.  
8 The case is submitted.

9 (Whereupon, at 11:58 a.m., the case in the  
10 above-entitled matter was submitted.)  
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## CERTIFICATION

*Alderson Reporting Company, Inc., hereby certifies that the attached pages represents an accurate transcription of electronic sound recording of the oral argument before the Supreme Court of The United States in the Matter of:*

*QUALITEX COMPANY, Petitioner v. JACOBSON PRODUCTS COMPANY, INC.*

*CASE NO.:93-1577*

*and that these attached pages constitutes the original transcript of the proceedings for the records of the court.*

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