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## [When the Color Black Functions, But Not as a Trademark](#)

Posted on August 31, 2010 by [Steve Baird](#)



Now that kids are back to school and [summer is coming to a close](#), this billboard advertisement has disappeared from I-94 just outside of downtown Minneapolis. Before it vanished from the roadside, however, I thought to capture it to tell a little trademark tale here, one from years past, but one that remains relevant, important, and applicable to trademark claims involving the color black.

[As we have discussed before](#), a single color can function as a trademark and be the basis of exclusive ownership, so long as it is not [functional](#) and has [acquired distinctiveness](#) for the goods in question. As it turns out, however, and as the billboard reminds me, due to some unique attributes of the color black, it is a tricky one to own as a trademark.



The tale begins back in 1988, after accumulating 25 years of use and allegedly "substantially exclusive" use in commerce, Mercury-Brunswick commenced [efforts to register, own and exclude others from using the color black on the surface of internal combustion engines for boats](#).

As can tend to be the case when claiming exclusive rights in [single colors](#) or other [non-traditional trademark rights](#), others within the industry who are paying close attention to what goes on at the Trademark Office come to life and consider getting in the way of these efforts.

British Seagull Ltd. did just that and filed an opposition lasting six years, ending with and resulting in the final rejection of Mercury-Brunswick's claimed trademark rights in black, based on the functionality doctrine. You might be wondering, how on earth is the color black functional when applied to the entire surface of internal combustion engines for boats?

The longer answer can be found in two decisions: The decision of the Trademark Trial and Appeal Board (TTAB) in *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), and the decision of the Court of Appeals for the Federal Circuit (CAFC), affirming the TTAB's registration refusal, in [Brunswick Corporation v. British Seagull Limited](#), 35 F.3d 1527 (1994).

The shorter answer is "competitive need" as found in this excerpt from the TTAB's decision:

[A]lthough the color black is not functional in the sense that it makes these engines work better, or that it makes them easier or less expensive to manufacture, black is more desirable from the perspective of prospective purchasers because it is color compatible with a wider variety of boat colors and because objects colored black appear smaller than they do when they are painted other lighter or brighter colors. The evidence shows that people who buy outboard motors for boats like the colors of the motors to be harmonious with the colors of their vessels, and that they also find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats.

And the CAFC's affirmance, here:

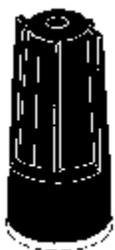
Turning to the present case, the Board determined that "black, when applied to [Mercury's] outboard marine engines, is de jure functional because of competitive need." *British Seagull*, 28 USPQ2d at 1199. The color black, as the Board noted, does not make the engines function better as engines. The paint on the external surface of an engine does not affect its mechanical purpose. Rather, the color black exhibits both color compatibility with a wide variety of boat colors and ability to make objects appear smaller. With these advantages for potential customers, the Board found a competitive need for engine manufacturers to use black on outboard engines. Based on this competitive need, the Board determined that the color was de jure functional. This court discerns no error in the Board's legal reasoning and no clear error in its factual findings

So, it's important to keep in mind this notion of [competitive need](#) when a business desires to own exclusive trademark rights in a color, and it is equally important to keep in mind as a defense when such rights are being asserted against your client's use of a color.



And, when it comes to asserting or refuting a claim of exclusive trademark rights in the color black, it is well worth exploring competitive need by asking whether black's unique attributes of color compatibility and/or visual perception have any application to your facts, since those facts already have been found to support a successful functionality defense.

On a related note, I recently came across [King Innovation's announcement](#) of being "granted" a trademark in black underground waterproof electrical connectors. Of course, I'm left wondering whether color compatibility and/or visual perception might impact this claim of rights. I'm also hoping they aren't referring to this little guy right here, since the application to register this claimed mark was abandoned last year and appears to be deader than a doornail, following a functionality refusal:



Oh, what do you know, [here is another application, filed a year later, that matured to registration and issued just months ago](#). Proof that persistence pays dividends!

Last, as I recall [Dan's](#) post entitled [I See Black Labels](#), I'm left wondering what social science data might exist to support a functionality defense, if one was inclined to require such a defense.

Can you think of other unique attributes to the color black that might establish a successful functionality defense to a trademark claim in black?

