

How Might Shoe Soles Impact Mobile Iconography

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Recently, the Second Circuit Court of Appeals heard arguments in *Louboutin v. Yves Saint Laurent* – an appeal that considers (or some might say re-considers) the protectability of a single color as a trademark to identify the source of a product or service. Among other arguments, the case considers whether granting a monopoly on a specific color might have an anticompetitive impact on the ability of a competitor to use the same or similar color. Specifically, some have argued that because color is an exhaustible resource, it ought not be the subject of trademark protection at all.

The outcome of Louboutin's appeal (and a decision on the protectability of color) could impact other industries, including the mobile application industry, which is becoming larger and more crowded every day as more and more applications are developed and launched. Specifically, if the law were to embrace a theory that limited databases – like color – can never (or only under limited circumstances) be the subject of trademark protection, it would not be long before some competitors might argue that letters of the English alphabet, or certain arguably functional combinations of color are similarly limited and therefore equally ineligible for protection. Such an outcome could have a negative impact on application developers, whose ability to squeeze trademarks into application icons is becoming increasingly reliant on more limited symbology and iconography.

Depending on whose statistics you believe, there are around one million mobile applications available for download – about evenly split between Apple's App Store™ and Google Play™. The steep rise in the popularity and use of mobile applications has an impact on branding and trademark design. Whereas earlier producers of computer applications focused on the canvas provided by a computer display and trademarks applied within a screen size user interface, mobile application producers now must squeeze branding into the graphic representation of the mobile icon—meaning the relatively miniscule landscape of the square shapes that inhabit our tablets and hand-held devices (1/2" square space for tablet applications and a 9mm square area for smaller iPhone® and Android® icons).

Companies have responded to this shrinking canvas in one of three ways. First, by reducing their traditional word marks to initialism, such as "h" for Hulu, and "f" for Facebook, for example.



Alternatively, developers have removed all the traditional branding and instead have created unique designs or symbols meant to capture or convey the application's functions or features (e.g, the eighth notes used on the iTunes® icon and the Twitter® bird design icon).



A third option pursued by some is simply to shorten their traditional branding, such as use of the suffix "in" to indicate LinkedIn®.



In short, the smaller space has caused marketers and developers to migrate to a truncated or alternate form of messaging – using symbols and a reduced number of letters as trademarks.

This contraction in space and the concomitant reduction in communicative symbols begs the question of whether, in time, the database of available imagery, symbols and formatives of letters which might be useful in this small icon will be exhausted. For example, how many mobile icons can use just the letter “g” before we would consider the “g” icon to be “taken” and no longer available to a potential developer? Even if multiple users can use a “g,” but avoid confusion by using different fonts and color combinations, how many commercially useful combinations of color with “g” might be available? Surely it is a finite number—and a more limited number than a trademark that might consist of a full word or combination of words.

If exhaustion of available combinations is a foreseeable outcome, how will competitors for those symbols (now already over one million) be able to assert exclusive rights in their icon trademarks? Should the law grant any kind of proprietary interest in the designs of icons, or limit available protection in any way so as to limit the potential anti-competitive effect of granting a monopoly on a (potentially) limited resource of available symbols?

The most obvious place to seek protection for a mobile icon is trademark law, which, with some caveats, protects any word, term, name, symbol or device (or combination of the foregoing) that is used in commerce to identify the source of a particular good or service (15 U.S.C. § 1127). (Of course, a mobile icon might also qualify for copyright and design patent protection. This article focuses on trademark protection, however.) As a general proposition, mobile application icons should be protectable as trademarks provided they perform a “source identifying” function. Icons that are merely functional, because the symbols used are merely communicative of the application’s functionality, probably would not be protectable. For example, an icon depicting a snippet of a map to identify a mapping application, or an icon using a calendar page to identify a calendar application likely would not be protectable unless there was something distinctive about either of those designs. Aside from this type of functionality argument, however, a mobile icon should be apt subject matter for trademark protection.

Interestingly, even before the *Louboutin* case mentioned above, trademark law met and apparently answered the question of whether exhaustible resources for trademark protection (such as color) could be protectable as trademarks when the U.S. District Courts, and finally the U.S. Supreme Court, examined whether a color could be protected as a trademark. In those cases, one compelling argument against granting a trademark monopoly on color was the limited number of colors available to competitors.

The “color depletion” argument was first fully explicated in a 1985 ruling from the Court of Appeals for the Federal Circuit in *In re Owens-Corning Fiberglas Corp.* 774 F.2d 1116, 227 U.S.P.Q. 417 (Fed. Cir. 1985). In that case, Owens-Corning was attempting to protect the color pink as a trademark for its insulation products. The Federal Circuit rejected color depletion as a rationale to deny trademark protection, stating that a single color could be registered as a mark even though it would effectively reduce the available palette of colors for competitors. The Court emphasized “pink has no utilitarian purpose and does not deprive competitors of any reasonable right or competitive need.”

The Owens-Corning decision, predictably, was not followed by all of the U.S. Circuit Courts of Appeal – with a handful of courts sticking to the theory that granting a monopoly on color was anti-competitive. *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378 (9th Cir. 1987); *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 29 U.S.P.Q.2d 1277, 1280 (9th Cir. 1994), *rev’d* 514 U.S. 159 (1995). Then, in 1995 the U.S. Supreme Court appeared to resolve the conflict relating to color depletion in its seminal *Qualitex Co. v. Jacobson Products Co.* decision. 514 U.S. 159 (U.S. 1995). In *Jacobson* the Court rejected the color depletion theory and instead opined that the potential for colors to be or become

merely functional (and therefore unprotectable per se) would act as a more natural barrier to the possibility of an anti-competitive effect in granting a monopoly on color. Rather than formulate a per se rule against protection of colors, the Court held that color could be protected as long as it was not functional as applied to the relevant goods and services. Competitors who needed colors would need them only if they were themselves functional as applied to the relevant goods – and so allowing non-functional colors to be protected as trademarks would not have an anticompetitive impact.

One could reason, based upon the Supreme Court's ruling in *Qualitex*, that even though there may be a more limited database of imagery useable to identify mobile applications within the square icon frame, a court is unlikely to reject protection of, for example, the letter "g" to identify a mobile application merely because there are only so many versions of "g" available to competitors. Rather, only if "g" could be shown to be utterly functional as applied to mobile applications, would the law reject protection.

Of course, this year's appeal of *Louboutin v. Yves Saint Laurent Am., Inc.* could change that analysis, depending on how the Second Circuit rules and the outcome of any appeal. In *Louboutin*, famed shoe designer Christian Louboutin claimed exclusive rights in the red outer sole of his unique shoe designs, arguing that the red outer sole was not functional but instead a signal to consumers that those shoes were his design. The District Court for the Southern District of New York disagreed and re-conjured the color depletion theory, stating that colors were "per se aesthetically functional" and that allowing a monopoly over color, at least within the fashion industry, would be anti-competitive. 778 F. Supp.2d 445 (S.D.N.Y. 2011). *Louboutin* appealed the District Court's decision and that appeal is currently pending.

The outcome of the *Louboutin* case could confirm that re-emergence of the color depletion theory as applied to trademarks. While some have argued that the District Court's ruling (if it stands) should be read narrowly and to apply only in the fashion industry, others have raised significant concerns that the alleged anticompetitive effect of removing non-functional colors from trademark protection will impact all industries and their ability to protect trademarks from encroachment by competitors.

Considered in the context of protection of the iconography of mobile application trademarks, the re-emergence of color depletion as a rationale for denial of protection certainly could be used as a basis to deny protection for other common (and limited) symbols such as letters, or even combinations of colors and letters. In particular, there is research that suggests that certain colors and certain combinations of color are more legible on computer displays than others. (See, for example Gradisar, Mirko et al, *The Legibility of Colored Web Page Texts*, ITI 2007 29th Int. Conf. on Information Technology Interfaces). If certain colors or combinations are more suited to computer displays, this would create an argument that colors (or some colors) are functional as applied to computer applications. This functionality argument could further weaken an application developer's ability to rely on trademark protection for his mobile application icon design.

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