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## **SINGLE COLOUR TRADE MARKS**

### **INTRODUCTION**

As Trade Mark owners increasingly turn to Non-Traditional Marks as a way to increase brand awareness and to find innovative ways to market their products, governments around the world are faced with the challenge of how to reform their national laws to include protection for non-traditional marks, such as colour trade marks. The survey identifies the opportunities and challenges confronted by brandowners and legal practitioners alike whereas the current legal landscape does not adequately address the definition of single colour protection on the whole and where definition of single colour protection exists, the definitions may be inconsistent and oftentimes arising out of case law creating a situation to global IP owners and brands in how to sufficiently protect and defend brands and brand assets at a macro level.

The following paper has been compiled by the International Trade Marks Committee of the IPO to bring the topic of registration of Single Colour Marks to the attention of the IPO's Membership. The paper was prepared following a survey of single colour protection laws and provides an overview of the current legal framework in developed and developing legal markets.

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## **ARGENTINA**

### ***Contribution:***

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The Argentinean Law no. 22.362 (section 2, subsection d) states that single color trademarks cannot be protected, whether the color is the natural (or intrinsic) color of the products or a color arbitrarily applied thereon.

However, when shape and single color are combined with sufficient distinctive capacity, comprising a series of elements that add origin to the sign, these may be registered.

As stated on the first paragraph, it is prohibited the registration of single color marks in Argentina, and since there is a division in case law interpretation (please see the examples inserted below), there have been special cases where, by combining certain elements that gave a distinctive capacity to trademark signs for which protection is sought, single color marks have been registered.

From the analysis of Argentine case law and jurisprudence, it appears that it is necessary to combine three requirements for a single color mark to be considered distinctive for the purpose of its registration, namely: (1) that it is an arbitrary color to distinguish the product; (2) that this color is applied restrictively in a manner such that there is a combination of distinction from the color's originality and the arbitrary character of the shape; and (3) that the color is exactly specified, for instance, through the identification of the pantone codes. In example, there is a mark registered by Benneton under no. 1781925, formed by a green rectangle identified within a pantone line to distinguish products in class 25.

#### **Enforcement Actions:**

Please note that in Argentina, the National Court of Appeals on Civil and Commercial Federal Matters – Courtroom 1, acknowledged Pfizer's exclusive right to the use of the 3D trademark similar to a blue diamond in the case "Pfizer, Inc. vs. Microsules Y Bernabé S.A.", having considered that the trademark was original due to its specific combination of the blue color and its rhomboid shape.

The Court ordered the cease of an authorized use of the trademark and denied the motion for nullity filed by the defendant, reaffirming the originality and distinctive character of the claimant's trademark, for its specific combination of shape and determined color.

Finally, on other recent case (Kraft Jacobs Suchard vs. Chocolates Bariloche S.A.), the National Court of Appeals on Civil and Commercial Federal Matters – Courtroom 3 dismissed the action filed by Claimant (Kraft) seeking a declaration to cease the use of the lilac color on the Defendant's products, for understanding that Kraft cannot pretend any monopoly on the lilac color and has no title on it. The Court emphasized that the law is clear when it comes to single color marks or a plain color.

## AUSTRALIA

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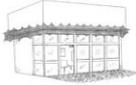
Under Section 6 of the *Australian Trade Marks Act 1995*, a “**sign**” is defined as:

*“includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.”*

All that is required for a colour to be registered as a trade mark is that it be inherently adapted to distinguish the goods or services of the owner.

Therefore, single colours can be registered as trade marks in Australia.

Australian Trade Mark Registration (“ARTM”) No. 585856 – colour PINK GLOW for Class: 42 “The retail of food and beverages; restaurant services including the preparation, supply and sale of foods and beverages” which was filed with the Endorsement: “*The mark consists of a pink glow created by a row of pink coloured lights extending along a fascia of a building or a pink glow created by pink coloured lights mounted on the exterior or interior walls of a building.*”



ARTM No. 633545 – colour SKY BLUE for Class: 9 “Electric soldering apparatus, including soldering stations, soldering irons, desoldering stations and wire-wrapping tools”; and

ARTM No. 704779 – colour ORANGE for Class: 33 “Champagne; sparkling wines”, being for Veuve Cliquot Ponsardin champagne.

However, registrations for single colour marks mostly relate to narrow statements of goods or services. A single colour as opposed to a combination of colours is likely to possess a lower level of distinctiveness and as such a combination of colours is more likely to prima facie registrable.

If the colour, the subject of an application for a trade mark, is deemed to be “functional”, it cannot, as a result, be inherently adapted to distinguish the Applicant’s goods or services. Additionally, colours:

- which are common to the trade;
- which are the natural colour of goods; or
- for which there is a competitive need

are also likely to not be inherently adapted to distinguish the Applicant’s goods or services.

Colours which provide a particular technical result or convey a generally accepted meaning are considered to be “functional”.

### **Enforcement Actions:**

- The colour TERRACOTTA by Philmac P/L for “Irrigation pipe fittings”

In *Philmac P/L v Registrar of Trade Marks*, which Mansfield J held in general that there was a competitive need for colours to remain available. However, given the narrow class of goods, to which the application for the colour Terracotta as a trade mark related, he held that the colour should be treated as being the same as a purely descriptive word. He made it clear though that a single colour can still be inherently adapted to distinguish an Applicant’s goods. If the colour:

- does not serve a utilitarian function (does not physically or chemically produce an effect);
- does not serve an ornamental function (does not convey a recognised meaning); and
- is not sought in relation to a market in which there is a competitive need for use of colour and other properly motivated traders might not think of the colour use in a similar manner in respect of their goods,

then it will be inherently adapted to distinguish the Applicant’s goods or services.

Philmac presented extensive evidence of use and Mansfield J overruled the earlier Registrar’s decision, holding that the colour was capable of distinguishing and did distinguish Philmac’s products.

- The colour GREEN for BP



In *Woolworths v BP (No 2)* BP PLC (UK) sought registration for GREEN as depicted as a trade mark in Class 42 for Wholesale services of a broad range of goods. A significant problem for BP was that its get-up consisted of more than the particular shade of green the subject of the application as it included the badge, the letters “BP” as well as a shade of yellow. Even though green was the predominant colour, it was held to be only one element of BP’s corporate image. The issue therefore was whether trade mark protection was available for only part of an entire corporate image.

It may be the case that whilst a particular single colour is deemed to not be inherently adapted to distinguish an Applicant’s goods or services, it may still be registrable as a trade mark if the Applicant can satisfy s 41(6) by establishing that based on the extent of use of the single colour as a trade mark, it does distinguish the Applicant’s goods or services. It is the use of the trade mark, as a trade mark, prior to the date of the application that is crucial and must be assessed (*Woolworths v BP (No.2)* at [79]). This is so because the trade mark applied for must conform with the mark that was used as a trade mark prior the date of application, as it is the extent to which this prior use has

distinguished the designated goods or services as being those of the Applicant that must be assessed (*Woolworths v BP (No. 2)* [79]). Only when the extent of this prior use has the consequence that the trade mark does distinguish the goods or services that the trade is capable of distinguishing the Applicant's goods or services (*Woolworths v BP (No. 2)* [79]).

The use of the colour green (the subject of the application) had to be examined as to whether it was used as claimed in the application as a trade mark and not whether it was used as part of other trade marks or merely as part of packaging or get-up. The court held that BP had used green as a trade mark to a sufficient extent but only in conjunction with yellow and not alone. This issue could not have been resolved simply by finding an advertisement without yellow. The fact that consumers associate green with BP and the evidence of promotion and use of green (without more) were held to be insufficient to establish distinctiveness under s 41(6) (at [117]). The sign must be shown to have been used so as to identify it as a trade mark such that a perception is created that the particular goods or services originate from a particular source (at [117]).

Just for interest sake, BP has however achieved a colour mark registration for the combination of green (Pantone® 348C), yellow (Pantone® 109C) and white (RAL 9016) for Classes 4,35, 37, 38, 39, 40, 42, 43, 44,and 45 with the Endorsement: “*As applied to the exterior surfaces of buildings, canopies, pole signs, shop facias and other component parts of service stations*”, as depicted.



- The colour PURPLE for Cadbury Schweppes

In the reported Judgment, *Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd (No 8)* [2008] FCA 470 (11 April 2008), it was found that Cadbury had not used the colour Purple as an effective indicium of origin of their goods. For example, the colour was not used consistently throughout their product range and was always used in conjunction with the Cadbury device mark. Furthermore, Cadbury had not sought to completely remove competitor's use of purple in respect of confectionery, having allowed Nestlé S.A. to use the colour on its *Violet Crumble* confectionery. If Cadbury had been seen to be consistent and vigilant in using and protecting the trade mark, this may have assisted Cadbury in defending their position.

Cadbury UK Limited has applied for a fresh trade mark application for the colour PURPLE for Class: 30 for “Block chocolate; boxed chocolate” with the Endorsement: “*The trade mark is the colour PURPLE depicted in the representation attached to the application form being approximated by reference PMS 2685C in the Pantone® Colour Formula Guide and used in relation to the designated goods.*”



This pending application has been opposed.

## Conclusions

Trade mark protection is available for a single colour in Australia although it must be established that prior to and at the date of the application, the colour has been used as a trade mark to a sufficient extent that it distinguishes the Applicant's goods or services.

## BRAZIL

***Contribution:***

Mr. Luiz Edgard Montauray Pimenta and Mrs. Joana Siqueira  
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Intellectual Property Protection does not include protection for single color marks in Brazil, as stated on item VIII of section no. 124 of the Brazilian Industrial Property Law, as follows:

*Article 124 - The following are not registrable as marks:*

(...)

*VIII - colors and their names, except when arranged or combined in an unusual and distinctive manner;*

However, it is relevant to clarify the exception contained in this section, which occurs whenever colors are arranged or combined in an unusual and distinctive manner.

In what refers to the absolute prohibition to register a color or its denomination, only under special circumstances this would be possible, specially, if it has obtained a “secondary meaning”, and/or such color has been extensively used in a specific product/service and it is recognized by the consumers as a mark. In this regard, section 6 *quinquies* C-1 of the Paris Convention states:

***Article 6 quinquies***

*C. (1) In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.*

Finally, we did not find any single color mark registration used in an enforcement action in Brazil. However, there are lawsuits related to trade dress and secondary meaning of a trademark, which encompass itself as a whole portion, and not only one aspect of it.

**Enforcement Actions:**

As an example, the 4<sup>th</sup> Civil Court of the city of Nova Iguaçu, in the State of Rio de Janeiro, recognized Skafe’s rights in producing and selling its hair coloring line products named Innovare in Brazil, after Niely Cosméticos argued its Cor & Ton’s trade dress violation. This Civil Court considered that, according to item VIII of section 124 of the Brazilian Industrial Property Law, the registration of colors are not permitted in Brazil, except when arranged or combined in an unusual and distinctive manner.

## CANADA

### ***Contribution:***

Doug Fyfe  
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Canadian intellectual property protection does not extend to single colour marks where the colour is not depicted as part of a two-dimensional or three-dimensional design or shape. An essential element of Canadian trade-mark law is that to be registrable a mark must be capable of graphic representation. An applicant is required to provide a visual representation to the Registrar of Trade-marks of how a mark will appear. Based on this representation, the Registrar will determine whether or not the mark functions as a trade-mark to distinguish the applicants' goods from others.

In short, colour is not registrable per se in Canada, unless it is restricted to a particular shape or design. Applicants may claim colour as an element of a mark. For instance, applicants may register two dimensional marks that are comprised of one or more colours.

Applicants may also register trade-marks consisting of one or more colours applied to three dimensional objects. For instance, if it is shown to be distinctive, a single colour covering the surface of an object such as a pill could serve as a mark. One or more colours applied in specific positions on an object, such as a coloured thread running on the edge of a hose, could also serve as a mark if proven distinctive. In either case, the application must contain a drawing or drawings showing the visible features of the three dimensional object and include a description of how the colours are applied to the object. The drawing and description must sufficiently define the use of the colour on the object so that the Registrar can determine if the colour serves to distinguish the mark or not.

### **Enforcement Actions:**

As single colour marks are unable to satisfy the registration requirement that marks be capable of graphical representation demonstrating use and distinctiveness, there have not been any single colour mark registrations granted and no such marks have been the subject of enforcement proceedings in Canada.

## CHILE

***Contribution:***

Mr. Christopher Doxrud  
Johansson & Langlois

The Chilean Law no. 19.039 expressly states on section 19 *bis* C that colors cannot be registered as trademark; color combinations are excepted from this prohibition.

In this regard, it is prohibited the registration of single color marks in Chile and since they have never been accepted, no single color trademark should exist in Chile.

**Enforcement Actions:**

Since the Chilean Law no. 19.039 expressly prohibits the protection of a color, it is believed that it has never existed a lawsuit related to this issue.

## CHINA

***Contribution:***

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The provisions of Article 8 of Chinese Trademark Law, provides “any visual sign capable of distinguishing the goods or service of one natural person, legal entity or any other organization from that of others, including any word, design, letters of an alphabet, numerals, three-dimensional symbol, combinations of colors or any combination of the above elements may be applied for the registration of a trademark.”

From the above, it can be seen that combinations of colors as a sign can be registered as a trademark in China, while “a single color” sign is not referred in the above.

In fact, we find if an applicant files an application for single color mark, it will be accepted by the Chinese Trademark Office (CTO). An official filing receipt is usually issued one month from the filing date, on which an application number is allocated.

However, during the substantive examination stage, most of single color mark applications would meet rejection on the grounds that they are short of trademark distinctiveness, unless the applicant can prove the single color mark has become distinctive through extensive use and promotion.

In our knowledge, only one such mark (see below) passed substantive examination and got published. It was filed by CADBURY LIMITED on July 17, 2003 in respect of “*chocolate beverage, chocolate, non-medical sweet, biscuits, confectionary, ice cream, etc.*” in Class 30. Later, it was opposed during the opposition period. No official decision has been made on this case yet.

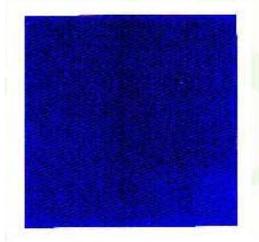
### **The Details of the “Single Color” Mark No. 3636258**

|                   |   |
|-------------------|---|
| Application Date: | July 17, 2003   |
| Application No.:  | 3636258   |
| Applicant:        | CADBURY LIMITED   |
| Address:          | FRANKLIN HOUSE, BOURNVILLE, BIRMINGHAM,<br>E 2NB, ENGLAND |
| Class:            | 30  |
| Goods:            | Chocolate beverage; Chocolate; Non-medical sweet;         |

Biscuits; Waffle; Cake; Pastry; Frozen confectionary, Ice cream, etc.

Legal Status: Pending in opposition

Specimen:



**Enforcement Actions:**

Up to now, no single color mark has been approved for registration in China. Consequently, there have no enforcement actions in China.

## EUROPEAN UNION

### *Contribution:*

[Article 2](#) of [Directive 89/104](#) (and [Article 4](#) of [Council Regulation \(EC\) No 40/94](#)) and its definition of trademarks theoretically does not preclude signs such as a colour (whether single or in combinations) from being registered as a trademark. Therefore, depending on the context, a colour may constitute a sign "*per se*" in relation to a product or service ([Libertel](#), paragraph 27, [Heidelberger Bauchemie](#), paragraphs 23 and 24).

Notwithstanding the above, in practice, applicants wishing to register colour *per se*, not spatially delimited, and a combination of colours must overcome very difficult obstacles to prove that the sign is capable of being a trademark under the above mentioned provisions.

To constitute a trademark under these regulations, the mark must satisfy three conditions. Firstly, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings (see, to that effect, [Libertel](#), paragraph 23, [Heidelberger Bauchemie](#), paragraph 22).

It is usually difficult to demonstrate the second condition, i.e. that a colour can also be represented graphically, particularly by means of images, lines or characters, so that it can be precisely identified (see, to that effect, [Sieckmann](#), paragraph 46; [Libertel](#), paragraph 28; [Heidelberger Bauchemie](#), paragraph 25) and that the representation is "clear, precise, self-contained, easily accessible, intelligible, durable, and objective" (so-called "Sieckmann 7" criteria; see, [Sieckmann](#), paragraphs 52-54). Accordingly, it must be clarified that "precise and durable" in the context of combinations of colours means that those without contours must be "systematically arranged by associating the colours concerned in a predetermined and uniform way" ([Heidelberger Bauchemie](#), paragraph 33). According to the court, a mere sample of a colour would not satisfy the above-mentioned requirements because it might deteriorate with time. In the Court's opinion, an internationally recognised identification code such as Pantone(r) might be considered graphic representation. Therefore, the use of a sample verbal description and such a code might, in combination, satisfy the seven above-mentioned Sieckmann criteria ([Libertel](#), paragraph 38).

As regards the third condition, it must again be remarked that colours are usually features of a product, being part of a product's external appearance, and consumers are not in the habit of making assumptions about the origin of goods merely from their colour or the colour of their packaging. Consequently "a colour *per se* is not normally inherently capable of distinguishing the goods of a particular undertaking" ([Libertel](#), paragraph 65). However, even if a colour *per se* does not initially have any distinctive character, **it may acquire such a character as a result of the use made of it in relation to the goods or services claimed** ([Libertel](#), paragraph 67; [Heidelberger Bauchemie](#), paragraph 39). However, it is almost impossible to conceive colour *per se* to acquire a distinctive character before it has been used. This could only occur "in

exceptional circumstances, and particularly where the number of goods or services for which the **mark** is claimed is very restricted and the relevant market very specific" ([Libertel](#), paragraph 66; [KWS Saat](#), paragraph 79).

### **Enforcement Actions:**

We have now a very recent decision of the Court of First Instance, dated November 12, 2008: **Case T-400/07, GretagMacbeth LLC v OHIM** (the decision is currently available only in French and German).



The Court, upholding the decisions of the Examiner and the Board of Appeal, has decided that the mark lacks distinctive character. Therefore registration is not granted.

CTM No. 3793361, registered on 24/04/2008 in the name of Mars U.K. Limited, for "Foodstuffs for cats; milk for cats".



CTM No. 6358758, registered on 10/07/2008, by TrekStor GmbH & Co. KG, seeking protection for: "MP3 players, computer hard discs, multimedia hard discs for connecting to television sets, set-top boxes, USB memory sticks".



## **FRANCE**

Article L711-1 of the French Trademark Act provides that "*combinations or shades of colour*" among others, may constitute a trademark. Therefore the French Office accepts registration of marks consisting of a shade of colour. Besides, "La Cour de cassation" has established that "the protection of a combination of colours is strictly referred to the registered combination that does not grant any right concerning the colours per se".

Case law requires that the shade of a single colour be precisely identified, for instance by means of an international code such as *Pantone*. A sample of the colour would therefore not be sufficient.

To date, it seems that no trademark consisting of a colour or shade of a colour alone has been registered. Combinations of colours are accepted for registration, with a colour representation of the proposed mark. Case law requires the colours to be arranged in a specific way in the application for registration.

## **Enforcement Actions:**

Since the Trademark Office does not apply strict standards in its registrability examination, the discretion to enforce registered rights remains with the courts.

*The shade chosen by the company Candia SA being precisely described, Pantone 212, the sign is therefore sufficiently determined.* [Paris Court of Appeal, November 25, 1998 – PIBD 1999 672 III 114]

*Although the description of the trademark and of its colours is optional, the company Neymann cannot rely on the absence of such a description to try to prevent its competitors from using brown and yellow colours, whatever their shade and arrangement, as it would result in a monopoly on these colours* [Colmar Court of Appeal, April 5, 2000 – PIBD 2000, 708 III 561]

*When a trademark is composed of a combination of colours arranged in a specific way, the scope of protection cannot extend to the use of other colours.* [Paris Court of Appeal, Burberry, June 10, 1998, PIBD 661 III 468]

*If its registration does not give to Candia a monopoly on the colour pink, the fact remains that the shade of pink is very close to the registered colour, whereas it was possible to choose other shades of pink. So, the visual similarity of the involved colours creates a likelihood of confusion in the public's mind which can be led to attribute them to a common origin* [Paris Court of Appeal, June 9, 2004- PIBD 2004, 796 III 621].

## **GERMANY**

It seems that in principle, combinations of colours as well as a colour *per se* are registrable under German practice, provided that they have distinctive character for the goods or services in question.

Section 8 sec. 2 sub sec. 1 of the Trademark Act excludes the registration of trademarks which are devoid of any distinctive character. The Federal Supreme Court applies the same test which has been developed to determine the distinctiveness of word marks. If the colour is not descriptive for the goods in question and is not perceived by the relevant consumers as a pure decoration it should not be possible to establish that the trademark is devoid of any distinctive character (*cf.* Federal Supreme Court, I ZB 6/99, WRP 2002 p. 452–Processor Cases Coloured in Green; Federal Supreme Court, I ZB 57/98, GRUR 2001, 1154–Colour Violet *per se*).

Federal Patent Court, Decision of February 28, 2007 – 28 W (pat) 223/04  (RAL 3020): Red is used as a signal colour to warn against danger and therefore describes the characteristics of the claimed goods “*hydropneumatic storage and filter cases being integral parts of hydro devices*”. It also lacks the distinctive character (the requirements for acquired distinctiveness were not fulfilled).

Federal Patent Court, Decision of November 14, 2007 – 26 W (pat) 205/01  (RAL 1021, RAL 5010): Applied for services of a gas station, the application was denied. The

colour combination is not considered to be distinctive *per se*. Since distinctiveness without prior use is inconceivable save in exceptional circumstances, it must be shown that the mark is determined to be used for a very restricted and specific market where consumers consider a colour combination as an indication for the source of the origin.

### **Enforcement Actions:**

The Federal Supreme Court has given a ruling on several aspects of infringement of colour marks (Federal Supreme Court, GRUR 2004, p. 151 –Colour mark infringement I; Federal Supreme Court, GRUR 2004, p. 154 –Colour mark infringement II). Deutsche Telekom AG owned trademark registrations for the colour “magenta” and has established trademark rights over such colour by intensive use. Mobilcom had used an almost identical colour in several advertisements, and it was alleged that it did not use the colour magenta in the manner of a trademark. The Federal Supreme Court held that a trademark infringement can only be confirmed if the design of the advertisement and the use of the colour in the advertisement makes the customer perceive the colour as an indication as to the origin of the services offered. The court took the view that colours used in an advertisement are usually not considered as an indication as to the origin of the services offered. However, under particular circumstances, it may be possible that the colour stands out and is perceived as a trademark. In that particular case the court decided that colour “magenta” was unusual for telecommunication services, it was the house colour of Deutsche Telekom AG and had only been used by this company so far. The colour enjoyed a recognition of at least 58 per cent at that time. Under these particular circumstances the use of the almost identical colour by Mobilcom in its advertisements constitutes use in the manner of a trademark, according to the court.

In a similar case the owner of a colour mark for the colour “purple” intensively used for MILKA Chocolate proceeded against the use of a similar colour on the packaging for chocolate cookies. The Higher Regional Court of Bremen confirmed a trademark infringement in view of the intensive use of the colour purple on MILKA Chocolate packagings and its high recognition among consumers (Higher Regional Court of Bremen, WRP 2002, 460–Purple packaging).

## **SPAIN**

Traditionally it has not been possible to register marks consisting of colours alone. The 1988 Trademark Act established the prohibition of the registration of colour *per se*, unless the trademark consisted of a colour limited by a determined shape. Currently, the 2001 Trademark Act, when listing the absolute grounds for refusal (Art. 5), does not expressly refer to the registrability of marks made up of colours.

Nevertheless, the Spanish Trademark Office keeps rejecting registration for marks consisting of a single colour, shade or combinations of colours which are not sufficiently distinctive. In theory, the protection of single colours as trademarks should be possible, as long as it is sufficiently evidenced (a) their inherent distinctiveness, or (b) their acquired distinctiveness.

To date, it seems that no trademark consisting of a colour or shade of a colour alone has been registered. Registration is granted for marks that consist of colours, provided that they have a characteristic shape.



Spanish trademark application No. 2,571,432, filed on December 10, 2003. The Trademark Office refused the application on the grounds of lack of distinctive character, in spite of extensive evidence supplied, thereby acknowledging no distinctiveness acquired through use or “secondary meaning”.



Spanish designation of International registration No. 925,565, filed on April 6, 2007. The Trademark Office considered this mark to be sufficiently distinctive, as a result of the specific shapes the different colours are contained in.

#### **Enforcement Actions:**

Since up until now apparently no Spanish trademark or International Registration designating Spain consisting of a colour *per se* has been registered, there is no case law concerning use and enforcement of colour trademarks.

### UNITED KINGDOM

It seems that colour marks are registrable in the UK. Section 1 of the Trade Mark Act, 1994 established that a trademark means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another, and that a trademark may consist of words, designs, letters, numerals or the shape of goods or their packaging. The definition does not expressly mention colours, but those are not excluded either. However, registrants may be required to prove that the colours had acquired distinctiveness through prior use or, if the color to be registered is the colour of the goods themselves, proof or assurance that the colour serves no function other than as a trademark may be requested. Colours may be designated using an internationally recognised colour identification system code such as Pantone, RAL or Focoltone.

Where a mark consists of a single colour, it may in theory be possible to demonstrate inherent distinctiveness. However, in practice it is extremely difficult to imagine such a situation and evidence will nearly always be required to demonstrate factual distinctiveness and overcome an objection under Section 3(1)(b) of the Act (devoid of distinctive character). A combination of colours may be registrable without evidence of acquired distinctiveness, but this will depend on individual factors, for example how the colours are applied and to what goods (or services) they are to be applied. To register

colour(s) in the abstract it will be necessary to establish that the colour(s) is distinctive irrespective of the medium on which it appears. In practice this could be quite difficult to establish. The UK follows the ECJ guidance (*Libertel, Heidelberger*) in relation to colour marks. Assuming them to be properly graphically represented, the UK will assess the mark against all the established criteria of distinctiveness/descriptiveness. It is unlikely we would accept such a mark prima facie, so the applicant would be faced with showing acquired distinctiveness through use.

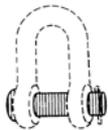
Colours have been granted trademark protection when used in specific, limited contexts such as packaging or marketing.

As an example, BP was granted the exclusive right to use green on signs for petrol stations: Registration No. B1469513, registered on June 29, 1991:



**Mark claim/limit:** *The mark, here depicted in heraldic shading, consists of the colour green as applied to the exterior surface of the premises used for the provision of the services.*

Also, The Crosby Group registered on February 10, 1993 colour red for shackles included in Class 6: registration No. 1526441:



*The mark consists of the colour red applied to the pin of a shackle.*

### **Enforcement Actions:**

Unregistered color marks have been protected in the United Kingdom under the “passing off” theory. Green and black pharmaceutical tablets were considered sufficiently distinctive of a manufacturer so as to prevent use of the same color scheme by another trader.

**Hoffman-La Roche & Co AG v. DDSA Pharmaceuticals Ltd.**, 1972 R.P.C. 1.

However, a pharmaceutical manufacturer was unable to prevent use of its yellow and white color coding system for tablets of different dosages.

**Roche Products Ltd. v. Berk Pharmaceuticals**, 1973 R.P.C. 461 and 473.

Even though it seems to be inconsistent, success in passing off actions will depend on the specific facts and the extent to which the colours at issue have become distinctive of a particular party. See also, **Boots Co. Ltd. v. Approved Prescription Services Ltd.**, 1988 F.S.R. 44 (C.A.) and **Wyeth (John) & Brother Ltd. v. M. & A. Pharmachem Ltd.**, 1988 F.S.R. 26 (each denying protection in the context of single colors).

## INDIA

### *Contribution:*

The Indian Trademarks Law (as per its statutory text) does not expressly provide for protection of single colour trademarks. However, the practice guidelines drafted by the Trade Mark Office (which are still being enforced) suggest that single colours will be protected on strict evidence of acquired distinctiveness and that registration of single colour will be allowed strictly to the extent of colour shade – however, when it comes to enforcement, in theory, the similar shades can be actioned against. In order to secure a single color trademark registration, one must furnish to the Registrar the evidence of acquired distinctiveness in India, prior to the date of filing of the single colour trademark.

### **Enforcement Actions:**

So far, no single colour trademarks have been registered in India, therefore, also no enforcement actions relating to single color trademarks have been carried out through courts, thus, no factors have been laid down by Indian courts in respect of single colour trademarks. However, there have been enforcement actions on colour combinations (such as red and white) in the past.

## ISRAEL

### *Contribution:*

Israeli Trademark law acknowledges single color protection. However, colors are considered inherently indistinctive. Thus, in order to register a color as a Trademark, one must prove that it has acquired secondary meaning in Israel. A color mark that has been registered as a trademark would be protected against any mark which is confusingly similar, including similar (but not identical) shades. However, a color would generally be considered as a "weak" mark, which deserves narrower protection.

The Trademark Office will accept the registration of a color per se only if the applicant proves that:

- The mark has acquired secondary meaning through extensive use or advertising;
- The mark is identified with the applicant by consumers in Israel; and
- The mark is used as a trademark i.e. indicates the applicant as the source of the goods covered by the mark.

There are very few color marks registered in Israel. Here are some samples:



Israeli trademarks Nos. 125,724 (class 9) and 125,725 (class 38) -- the color Pantone 151 Orange, in the name of Orange Personal Communications Services Ltd., November 7, 2000.



Israeli trademark No. 159,999 (class 3) -- the color Pantone Rhodamine Red C, in the name of Reckitt Benckiser N.V., January 4, 2004.

### **Enforcement Actions:**

There is very little case law on single color protection in Israel. There were few cases in which an unregistered colored mark has been enforced successfully, based on the ground of passing off. In CF 225/96 **Eastman Kodak Company v. Chonco Inc.** (2003) the District court held that Kodak's unregistered yellow color has acquired considerable goodwill amongst consumers in Israel, by extensive use. The court ruled that the defendants' use of a confusingly similar color for similar goods constitutes passing off, and an attempt to benefit from Kodak's goodwill.

## MALAYSIA

***Contribution:***

Ms. Tricia Dang

Nanyang-H<sup>2</sup> Patent & Trade Mark Attorneys

Although Malaysia, unlike some other jurisdictions, does not specifically include colour among the examples of a mark, colour is one of the things that must be taken into account in considering whether a mark qualifies for registration - **section 13(1)** of the *Malaysian Trade Marks Act 1976*.

The questions of whether such colour marks are used as trade marks, and whether they are distinctive are additional matters to be considered before registration can be allowed. However, there is a general difficulty in registering single colour marks as it would limit the availability of that colour for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought. Therefore, registration of colour trade marks is more of an exception than the rule.

No colour registrations have yet been reported. Consequently, there have been no enforcement actions in Malaysia.

## NEW ZEALAND

### *Contribution:*

Dr. Elizabeth Houlihan

Houlihan<sup>2</sup> Patent & Trade Mark Attorneys

The New Zealand *Trade Marks Act 2002* defines a “trade mark” as any **sign** capable of being represented graphically and distinguishing the goods or services of one person from those of another person. The definition of a “**sign**” is:

- a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket, or word; and
- any combination of signs

As “colour” is included in the definition of “sign”, a colour is therefore registrable as a Trade Mark.

Applicants who wish to register a single colour mark in New Zealand are required to supply the exact details of the colour. A description of the colour using the widely known colour standard known as the Pantone® colour system must be provided.

The description of the trade mark should include how the colour is being used, or is to be used in relation to the goods or services. The greater the specificity of the mark’s description, the more distinctive character the mark is likely to have. For example, whether the colour used is used in a particular pattern or arrangement, and/or whether the application is for the colour as applied to a particular surface.

A colour mark is registrable in New Zealand unless:

- it is a sign, not a trade mark.
- its use as a trade mark has no distinctive character.
- the mark consists only of signs or indications that have become customary in the current trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of product of goods or of rendering of service, or other characteristics of goods or services.

As a trade mark’s function is to serve as a badge of origin for a consumer to identify a product or service, it is essential for a trade mark to be distinctive. The New Zealand Trade Marks Office works on the basis that a colour *per se* normally lacks these properties. Consumers do not assume that the colour/s of the packaging relates to the origin of goods/services.

An application for a single colour mark can be considered *prima facie* to lack distinctive character. An Applicant will be required to provide extensive evidence of use which will need to indicate that their mark is exclusively associated with their goods or services; to show that their mark has acquired distinctive character.

Some colours may also be associated with certain industries and may have become customary to that trade and therefore these colours may lack sufficient distinctive character within those industries.

There are single colour marks registered in New Zealand. Examples include:

New Zealand Registered Trade Mark (“NZRTM”) No. 312997 for PURPLE (Pantone® No. 2685C) in Class: 30 for “Block chocolate; chocolate in bar or tablet form” to Cadbury Limited (UK);



NZRTM No. 300375 for the colour BROWN (Pantone® No. 462C) to United Parcel Service of America, Inc., in Class: 39 for “Motor vehicle transportation and delivery of personal property, in this class”;

NZRTM No. 211575 (among others) for the colour GREEN to BP PLC in Class: 1 for “Anti-freeze and de-icing preparations; hydraulic fluids; transmission fluids, not in the nature of oils; chemical additives for fuels and lubricants”;



NZRTM No. 291668 for the colour SILVER (Pantone® 877U to 877C) in Class: 5 for “Pharmaceutical preparations and substances being analgesics” to Reckitt & Colman (Overseas) Limited;



NZRTM No. 718005 for the colour PINK (Pantone® 1767) in Class: 17 for “Insulation materials” to Owens Corning Intellectual Capital, LLC;



NZRTM No. 294930 for the colour GREEN (PMS 361C) in Class: 30 for “Cocoa based beverages” to Societe des Produits Nestle S.A.; and



NZRTM No. 706440 for the colour PURPLE (CMYK: cyan 40%, magenta 100%) in Class: 31 for “Foodstuffs for cats and kittens, and additives for such foodstuffs” to Mars New Zealand Limited.



**Enforcement Actions:**

There have not been any enforcement actions in New Zealand for single colour registrations. The only cases involving colour trade marks were in relation to removal and opposition matters.

**Conclusion**

New Zealand does offer protection for Single colour marks; however, the Applicant will be required to provide extensive evidence of use, which will need to indicate that the mark is exclusively associated with their goods or services.

## RUSSIA

### *Contribution:*

Doug Fyfe  
Gowling Lafleur Henderson LLP

Single color marks are considered as not distinctive and as such they can not be protected under the Russian Law.

However, upon reviewing the Russian State register of trademarks we have found a



single color mark registration #310048 for  (declared as pink) in the name of Reckitt Benckiser H.B. (NL), application filing date – 2004.09.30, registration date – 2006.07.06, in respect of class 03 goods – Bleaching preparations, preparations for cleaning carpets, spot cleaning preparations either with or without disinfectants.

In our opinion this registration is a nonsense and the exception to the rule and in case of necessity can be easily cancelled.

Nevertheless it is quite possible to register a color indirectly by applying for a word mark indicating the color in the languages other than Russian. There is quite a number



of the registrations of such kind protecting words  (national registration #

**BROWN**

356319 in the name of OAO “MobileTeleSystems”),  
(national registration # 247071 in the name of United Parcel Service of America Inc.

**VIOLET**

(US)), (national registration # 350336 in the name of Gallaher Limited (GB)) and others.

In order to register a color name in Cyrillic the mark should be at least binominal (having two color names indication). The examples of such registrations can be

**ЧЕРНОЕ**

**И**

**БЕЛОЕ**

Russian trademark registration #263586 for **БЕЛОЕ** (black& white) in the name of OOO “confectionary factory “POBEDA””(RU), registration # 203868 for



(red & black) in the name of OOO “Buki International”(RU),

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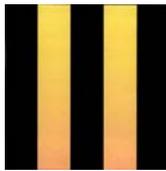
(White & Black) in the name of a physical person (RU) and others.

It is also possible to register bicolour and multicolour marks if they have acquired strong distinctiveness through the use. Below are the examples of the bicolour mark registrations which have been granted in Russia.in the name of OOO Vympel-Communications (RU)

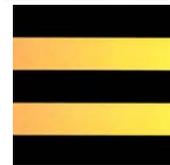
1. Registration # 359441



2. Registration # 300967



3. Registration # 300966



Summarizing the above we can say that in accordance to the Russian Law it is impossible to register a single color mark in the Russian Federation because it has no distinctiveness. It is known that people have different chromatic sensitivity and their ability to sense colors is not constant. Consequently, color is considered as a subjective sensation of a light depending on the person’s consciousness that is why it is rather hard to determine the particular name of a color or a color shade for some of the potential customers. Due to their subjective perception single colors or their shades are not likely to obtain the protection as trademarks.

Besides, if it is a word mark in Russian, indicating singular color, it can be considered as indicating the quality of goods.

## SINGAPORE

### ***Contribution:***

Ms. Tricia Dang  
Nanyang-H<sup>2</sup> Patent & Trade Mark Attorneys

The Singapore Trade Marks Act (“TMA”) defines “trade mark” as any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person and “sign” includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, **colour**, aspect of packaging or any combination thereof. Therefore, from the above, the TMA expressly recognises a colour or a combination of colours as a sign which can be registered as a trade mark.

In practice, a precise and unambiguous representation of the trade mark in the colour(s) used is needed. A sample of the colour(s) is required to be lodged with the application. The Registrar of Trade Marks also recommends that the applicant includes a designation from an internationally recognised identification code where the colour or shade exists in the coding system. Hence, the protection is only extended to the shade(s) presented on the application form.

The effect of acceptance of colour marks would mean restricting others from using those colours in the same industry or trade. Further, given that consumers are not in the habit of making assumptions about the origin of goods and services based solely on their colours or the colours of their packaging and the palette of colours available to traders is limited. For these reasons, registration of colour mark is unlikely to be accepted on a *prima facie* basis. There must be very strong evidence of its acquired distinctiveness in order to get registration. The distinctive character may be acquired, *inter alia*, after the normal process of familiarizing the relevant public has taken place. In such cases, the Examiner must make an overall assessment of the evidence that the colour mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings. There must be evidence to show the use of the colour mark as a trade mark.

In general, colour *per se* marks may also be objectionable for one of the following reasons:

- Colours which serve as a function – where the colour or colour combination may be seen by the average consumer as serving a function, it will not be capable of serving as an indication of origin.
- Colours which are common to the trade – colours which are commonly used in the industry or trade are not distinctive.

### The colour GREEN for BP

The Singapore Trade Marks Registry has allowed the registrations of the “Green” colour mark in Class 4, 6 and 39 by BP PLC. Details of the registrations are attached for your reference.

**Enforcement Actions:**

So far, there has not been any enforcement action in Singapore on the single colour registrations.

## SOUTH AFRICA

### ***Contribution:***

The South African trademarks law does protect single colour trade marks. A single colour trademark registration for a very unusual colour in respect of specialized goods would extend to shades of the colour in question. However, on the other hand, registration of a common colour for common goods would limit the protection to the identical or near identical shade of what is registered. In order to secure a single color trademark registration one must satisfy the Registrar either that the single colour mark is inherently capable of distinguishing or that it has acquired distinctiveness through use. The recommended approach is to file a trade mark application not merely for the single colour *per se* but illustrating how the colour is applied to the goods in question. An example of a registered single colour trademark is Registration No. 2000/04522 in class 31 for whiskas colour purple (see Figure 2 below). No enforcement actions against infringement of a single color registration have been reported as yet, however, there have been enforcement actions on colour combinations (such as green and yellow) in the past. The representation of a color mark filed should consist of a sample color(s) either on paper or in an electronic format. Additionally, the application should contain an indication of the internationally recognized color codes and must be accompanied by a written description detailing how the color is applied to the goods or used in relation to the services.



South Africa  
Registration No. 2000/04522  
(Class 31)

## TAIWAN

### *Contribution by:*

Wu Shung Houng

Louis International Patent Office

Single color marks may be protected in Taiwan and the scope of protection extends to all shades of a particular color.

The requirements which may need to be overcome to secure protection include:

- Specifying a particular color in the application form, the applicant may choose to employ color identification coding systems to define a particular color;
- Mandatory use of dotted lines in designated goods or services, its positions or content in preferred embodiments;
- Providing evidence of its acquired distinctness in use and in trade.

Certain limited Universal colors, including colors which are common to the trade, which are the natural color of goods, or for which there is a competitive need are unregistrable. For examples, the yellow color commonly used in taxis cannot be registered for commodities of vehicles, and the red color commonly used in warning signs cannot be registered for medical services.

An example of a colour mark which has been registered to the US Corporation, LRG Fastener Corporation is the colour "Purple" for a washer inside a nut depicted as follows:



The Class 6 Goods were described as: "A screw nut having a nonmetal washer embedded therein."

### **Enforcement Actions:**

So far, there have been no enforcement actions involving single color registrations.

## THAILAND

**Contribution by:**

Kowit Somwaiya / Prasantaya Bantadtan  
LawPlus Ltd.

Section 4 of the Trademark Act B.E. 2534 as amended by the Trademark Act No. 2 B.E. 2543 (the “Act”) provides that:

*“mark” means “a photograph, drawing, photograph, drawing, device, brand, name, word, letter, manual, signature, **combinations of colours**, shape or configuration of an object or any one or combination thereof”.*

Section 7 of the Act provides that:

*“a distinctive trademark is one which enables the public or users to distinguish the goods with which the trademark is used from other goods.*

*A trademark having or consisting of any one of the following essential characteristic shall be deemed distinctive:-*

- (1) a personal name, surname not being such according to its ordinary signification, a name of juristic person or tradename represented in a special manner;*
- (2) a word or words having no direct reference to the character or quality of the goods and not being a geographical name prescribed by the Ministry in the Ministerial Notifications;*
- (3) a **combination of colour** represented in a special manner, stylized letters, numerals or invented word;*
- (4) the signature of the applicant for registration or some predecessor in his business or the signature of another person with his or her permission;*
- (5) a representation of the applicant or of another person with his or her permission or of a dead person with the permission of his or her ascendants, descendants and spouse, if any;*
- (6) an invented device.*

*Names and words not having the characteristic under (1) and (2) if used as trademarks with goods which have been widely sold or advertised in accordance with the rules prescribed by the Minister by notification and if it is provided that the rules have been duly met shall be deemed distinctive”.*

A single colour mark is not deemed as a mark under Section 4 and it is not deemed distinctive under Section 7. Therefore, a single colour mark is not registrable in Thailand.

Under the Department of Intellectual Property Regulation on Rules and Procedures for Registering Combinations of Colours as Trademarks dated 13<sup>th</sup> May 2002, a combination of colors must consist of at least two colours, no matter they are light or strong colours. A combination of colours must not be colours of a photograph, drawing, device, brand, name, word, letter, manual, signature, shape or configuration of an object or any one or combination.

A combination of colours which is distinctive and registrable must be represented in a special manner, i.e. a group of at least two colours combined or assembled together, whether they are joining each other or not, and each colour must be clearly differentiated from another colour.

An example of a distinctive combination of colours registered in Thailand is shown below:-



**Trademark:**

**App. Nos.:** 369641, 369642, 369643

**Reg. Nos.:** TM81737, TM81741, TM81879

**Applicant:** Konica Minolta Holdings, Inc.

**Classes:** 1, 9 and 10

#### **Enforcement Actions:**

No single color mark application has been filed and registered in Thailand and therefore, there have been no enforcement actions.

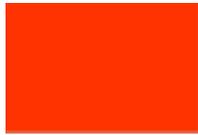
#### Conclusion

Thailand does not offer protection for a single colour mark. In other words, a single colour mark is not registrable, but a combination of colour that is represented in a special manner is registrable in Thailand.

## UNITED ARAB EMIRATES

### ***Contribution:***

The Trademarks Law of UAE does allow registration of a single colour as a trademark. Recent experience with the UAE's Trademark Office confirms that existence of earlier trademark registrations (of single colour) in other countries is accepted by the UAE's Trademarks Office as sufficient evidence of distinctiveness based on which the UAE's Trademarks Office has allowed registration to a single colour as trademark. UAE's Trademarks Office in 2007 allowed trademark registration (under No. 81124) for colour orange used by Mars Incorporated in connection with its UNCLE BEN'S range of rice products (see Figure 1 below).



UAE  
Registration No. 81124  
(Class 30)

### **Enforcement Actions:**

So far, there have not been any contentious actions (civil or criminal) for enforcement of single colour trademarks in the UAE. However, the UAE authorities have enforced other kinds of non-traditional trademarks.

## UNITED STATES OF AMERICA

### ***Contribution:***

U.S. trademark law protects single color marks provided they meet all the other criteria for a valid trademark. This protection does not extend to colors *per se*, that is, protection is afforded only to the coloration of a specific shape, design, or product. The extent of protection to varying shades of a protected color depends on the likelihood of consumer confusion as to source, sponsorship, affiliation, or approval, and most likely would not extend to *all* shades of a particular color. The U.S. Patent and Trademark Office requires that applicants claiming color as a feature of a mark include the generic name of the color (*e.g.* “navy blue” or “baby blue”); applicants also may refer to a commercial color identification system. Some U.S. courts have used the Pantone Matching System to define the limits of trademark protection of a color so the defendant has an objective benchmark for complying with an injunction.

A color is registrable as a mark in the U.S. only if 1) it is not functional, and 2) it has acquired secondary meaning in connection with the applicant’s goods or services. A color is functional for a particular good if it yields a utilitarian or functional (*i.e.*, non-reputation related) advantage, or if it is more economical to manufacture or use than other colors. In such a case, protecting a color as a trademark would unfairly limit competitors’ ability to compete in the relevant industry, and thus a color would not be registrable as a trademark.

Color marks are never inherently distinctive, hence the requirement for secondary meaning. The burden of proving that a color mark has acquired secondary meaning is substantial. The applicant must show the color has come to identify not only the goods but the source of the goods; in other words, the *primary* significance of the mark in the mind of the consuming public is not the product but the producer.

Examples include:

BROWN applied to vehicles, identifying the delivery services of the United Parcel Service – U.S. Reg. No. 2,131,693.

CANARY YELLOW applied to adhesive notes, identifying the goods as those of 3M Company – U.S. Reg. No. 2,390,667.

ROBIN’S EGG BLUE applied to catalog covers, identifying the catalog services of Tiffany and Company – U.S. Reg. No. 2,416,794.

### **Enforcement Actions:**

Enforcement actions involving color marks in the U.S. typically turn on whether the color is functional or has acquired secondary meaning. If the mark satisfies those two requirements, then likelihood of confusion or dilution come into play. A color mark

registered with the U.S. Patent and Trademark Office is presumed valid. The defendant in an enforcement action can rebut the presumption with evidence that the color is functional or that the mark did not acquire secondary meaning before the defendant's first use of its allegedly infringing product. For example, in *Baughman Tile Co. v. Plastic Tubing, Inc.*, the plaintiff owned a registration for yellow corrugated plastic tubing for underground drainage and sued the defendant for using the color yellow in manufacturing its tubing. The defendant successfully argued that the plaintiff's trademark was functional, and therefore invalid, because the yellow tubing did not soften in the sun like dark colored tubing, and the bright color made it easier to identify in the ground during excavation.

If the defendant fails to rebut the presumption that a registered color mark is valid, then courts in infringement actions apply the standard likelihood of confusion test. In *Binney & Smith v. Rose Art Industries*, the plaintiff's registered trademark for a yellow and green crayon design on its CRAYOLA crayon boxes was valid. However, the court found no likelihood of confusion between plaintiff's trade dress and the defendant's, which included a bright yellow oval over a neon green background on its crayon boxes. Because the two marks featured different shades of yellow and green as well as different shapes, the court found they did not create the same overall impression and were not confusingly similar.

## **VIETNAM**

***Contribution:***  
INVESTIP  
Hanoi, Vietnam

In accordance with Article 72 of the IP Law No. 50/2005/QH11, a mark shall be eligible for protection if it meets the following conditions:

- To be a visible sign in the form of letters, words, pictures, figures, including three-dimensional figures or a combination thereof, represented in one or more colors;
- To be capable of distinguishing goods or services of the mark owner from those of others.

Therefore, no single colours can be registered as trademarks in Vietnam

### **Enforcement Actions:**

As a result, there have not been any enforcement actions in Vietnam on single colour registrations.