



***International Trademark Association***

1133 Avenue of the Americas, New York, NY 10036-6710 USA

Telephone: 212-768-9887 Fax: 212-768-7796

## **PROTECTION OF COLOR TRADEMARKS**

**Non-Traditional Trademarks Subcommittee**

**Issues and Policy Committee**

**Trademark Affairs and Policies Group**

**November 1996**

## I. INTRODUCTION

While most countries permit the protection of trademarks which comprise a combination of colors, the extent to which a single color can be protected as a trademark varies considerably from country to country. Some countries specifically prohibit the registration of a single color trademark, while others permit registration, often only upon proof of a very high level of acquired distinctiveness.

Businesses increasingly use color as a means to distinguish their goods or services, whether by use on the product itself, on the packaging or in advertising material. As the international marketing of goods and services continues to grow, color marks assume added importance because they overcome the language or cultural barriers faced by more traditional word or device marks. However, due to the variations in national trademark laws, there is considerable uncertainty in the business community and the courts as to the protectability, registrability and enforceability of single color marks. An effective multi-country marketing strategy based on color may be wasted or stolen in some markets if the goodwill created in the color mark cannot be protected.

As with other marks, there are circumstances in which color should not be registered. Certain colors may have superior utility for certain products or may have become generic (e.g., to designate particular flavors in a sector of the food industry) or inherently unregistrable for certain goods (e.g., a red casing for a red ink pen). However, these issues arise equally with respect to word and other traditional marks. The same point applies with respect to infringement issues. Although a court may be required to decide whether a particular shade is confusing with the registered color, similar difficulties are encountered in assessing likely confusion between two word marks.

This report is timely since the issue of single colors as trademarks is being pressed before the Courts of numerous countries, as illustrated by *Qualitex* (U.S.)<sup>1</sup>, *Re Kraft Jacob Suchard* (Switzerland)<sup>2</sup> and *Glaxo* (Australia)<sup>3</sup>, while many other countries will likely have to face the issue to comply with directives such as NAFTA, the EC Harmonization Directive, and the Community Trade Mark (CTM) Regulation, which support trademark protection for single colors.

---

<sup>1</sup>Qualitex Co. V. Jacobson Products Co., 115 S. Ct. 1300, 34 U.S.P.Q. 1161 (green-gold for an ironing pad)

<sup>2</sup>Re Kraft Jacob Suchard - Reported, Trademark World, December/January 1995-1996 at pg. 6 (violet package for chocolates)

<sup>3</sup>Aktiebolaget Astra v. Glaxo Group Ltd., (1996) 33 IPR 123 (blue or brown for asthma inhalers)

Much would be accomplished in terms of protecting color as the important trade symbol it has become by worldwide recognition that in those specific circumstances in which color operates as a source identifier, it should be protected as a trademark.

## II. RELEVANT LAW

NAFTA expressly includes color within this trademark definition: “ a trademark consists of any sign, or any combination of signs, capable of distinguishing the goods or services of one person from those of another, including personal names, designs, letters, numerals, *colors*, figurative elements, or the shape of goods or of their packaging.” *North American Free Trade Agreement, art. 1708* (emphasis added). The language does not distinguish between a single color or a combination of colors, just as it does not distinguish between a single personal name and a full personal name.

Both the EC Harmonization Directive and the EC Regulation (establishing the Community Trade Mark) provide that a trademark may consist of “any sign” capable of being reproduced graphically if it is capable of distinguishing the source of someone’s goods or services. *EC Harmonization Directive - First Council Directive of December 21, 1988 (89/104/EEC), art. 2; EC Regulation - Council Regulation (EC) No. 40/94 of December 20, 1993, art. 4*. The Council and the Commission of the EC have recently published their joint opinion that Article 2 does not rule out the possibility of registering as a trademark a combination of colors or a single color.<sup>4</sup>

While the possibility of single color registration is not ruled out, each EU member state determines whether color complies with the definition of Article 2. Consistency among member states cannot be assumed. For example, the German Patent Office has issued internal guidelines providing that colors per se are not registrable despite the fact that 1995 amendments to the German Trade Marks Act, prompted by the harmonization initiative, specifically include colors and combinations of colors as registrable marks.<sup>5</sup> On the other hand, the UK recognizes and registers single colors as trademarks, e.g., the color green applied to a building exterior<sup>6</sup>, and the color silver for anthracite briquettes.<sup>7</sup>

Similarly, other treaty arrangements do not guarantee consistent interpretation among members. The Uruguay Round of the General Agreement on Tariffs and Trade Provisions on Trade-Related Aspects of Intellectual Property (TRIPs) states that “[a]ny sign, or any combination of

---

<sup>4</sup>Official Gazette of OHIM, May 1996

<sup>5</sup>See Zendel, Prah, Making Sense of Trademarks, An International Survey of Non-Visual Marks, IP World 1996.

<sup>6</sup>International Trademark Association Bulletin, Oct. 2, 1995 at 13. The initial registration for the color green is dated June 29, 1991, Reg. No. B1,469,513. However, a recently filed application for the color green by the same company is subject to six oppositions.

<sup>7</sup>United Kingdom, Reg. No. B1372291, Feb. 6, 1989.

signs, capable of distinguishing the goods or services of one undertaking from those of another undertaking,” is “capable of constituting a trademark.” The definition of “protectable subject matter” further indicates that “[s]uch signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks.” *TRIPs*, art. 15. The plain language of the treaty contemplates trademark protection for combinations of colors. However, trademark protection for single colors is not excluded from those “signs” eligible for trademark registration.

The registration of single colors as trademarks is accepted in several countries including the U.S.A., the United Kingdom, Canada and Australia. In 1995, the U.S. Supreme Court decided *Qualitex v. Jacobson Prods. Co.*, (infra), unanimously holding that color alone is eligible for federal trademark protection. In reaching this ruling, the Court relied, in significant part, on that portion of the Lanham Act defining a trademark as “any word, name, symbol, or device, or any combination thereof...[used]... to identify and distinguish...goods...from those manufactured or sold by others and to indicate the source of the goods...” 15 U.S.C. §1127. The Court noted that this definition was left unchanged by the 1988 amendments to the Lanham Act and that the INTA (then USTA) report underlying the 1988 amendments specifically recommended that “the terms ‘symbol, or device’... not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound, or configuration which functions as a mark.”: *Qualitex* 34 U.S.P.Q. at 1166, (quoting *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 TMR 375,421 (1987)).

U.S. law, therefore, contemplates that trademark protection is available where color is used to “identify and distinguish...and to indicate the source of goods.” This is consistent with NAFTA, the EC Harmonization Directive, the EC Regulation and the TRIPs Agreement, in that each, whether explicitly or implicitly, supports extending trademark protection to color in circumstances where color performs the traditional trademark function of serving as an indication of the source of particular goods.

In contrast to those authorities that support protection of color as a trademark in appropriate circumstances, there are some that expressly do not. The Andean Pact expressly excludes a single color from the definition of a trademark (which otherwise is “any visible sign” able to distinguish the products or services of a person). *Andean Pact*, arts. 71 and 72. Other individual countries have to date declined to register color alone as a trademark, including Austria, Germany (despite the provisions in its new German Marks Act, effective January 1, 1995 that specifically include colors and combinations of colors as registrable marks), Portugal, South Korea, Spain, Japan, China, Taiwan, Brazil and Mexico.

In yet other countries, the question whether color alone is protectable as a trademark remains subject to controversy. For example, in November 1995, the Swiss trademark authorities (the Federal Intellectual Property Office) in *Re Kraft Jacob Suchard* issued a registration for a violet color to a chocolate manufacturer who had used the color for some time on its chocolate boxes.<sup>8</sup> Swiss law requires that a trademark be suitable for distinguishing the goods of one undertaking

---

<sup>8</sup>Supra, note 2

from those of other undertakings. *Article 1 of the Swiss Trademark Law of August 20, 1992.* Interestingly, the chocolate manufacturer's earlier application for the same color mark had been rejected by the Board of Appeal for Intellectual Property Matters in January 1995, on the grounds that a single color did not meet the requirement of Article 1.<sup>9</sup> Whether the registration will be upheld, either in anticipated opposition proceedings or in future infringement litigation, remains unclear.

### III RELEVANT ISSUES

As is evident from the Swiss registration of violet for chocolates, the U.S. Supreme Court approval of the registration of green-gold for dry cleaning press pads, and other cases protecting color (e.g., pink for insulation<sup>10</sup>, aquamarine for splicing tape<sup>11</sup>), manufacturers/vendors are awakening to the significant advertising potential color presents as a source identifier. As trademark law is premised upon preventing consumer confusion *and* protecting those symbols a trader uses to identify and distinguish its goods from those of others, there is no reason why color as a symbol should be any less entitled to trademark protection than a more traditional symbol such as a word mark, where the color, indeed, performs a traditional trademark function.

The arguments typically invoked against protection of color as trademarks are not persuasive. A summary of those objections, and the response to each, follows.

#### Functionality

*Issue:* Colors which are essential to the use or purpose of the goods or services, or which affect cost or quality, should not be protected because this would have an adverse effect on competition.

There is no dispute that functional colors should not be protected as trademarks, and the proposed resolution does not suggest otherwise. Functional colors, e.g., necessary to the use or affecting the cost of the article, should not be protected, just as functional product configurations or generic word marks are not protected.

Functionality appears, internationally, to be a generally accepted doctrine. See, for example, the Harmonization Directive : "Descriptive or generic marks are not registrable, nor is a functional,

---

<sup>9</sup>Under Swiss law, it is possible to file successive applications for the same mark, as prior decisions do not have preclusive effect.

<sup>10</sup>In re Owens-Corning Fiberglass Corp. 774 F.2d 1116 (CA Fed. 1985)

<sup>11</sup>Marter Distributors, Inc. V Pako Corp., 986 F.2d 219 (8th Cir. 1993)

valuable or natural shape.” *Harmonization Directive*, art. 2; EC Regulation, art 7. See also the Canadian case *Samann v. Canada’s Royal gold Pinetree Mfg. Co. Ltd.*, (1986) 9 C.P.R. (3rd) 223 (Fed. Ct. Appeal).

Application of the functionality doctrine to color was recently illustrated in a case in Australia. Glaxo was refused registration of two shades of blue and two shades of brown for asthma inhalers. The colors were commonly used as informal visual indicators of a particular asthma treatment’s function. Blue indicated reliever therapy and brown preventative therapy. The colors conveyed a direct reference to the character and quality of the goods. Moreover, to require competitors to use a different color code system could have dangerous consequences. *Aktiebolaget Astra v. Glaxo Group Ltd.*, (1996) 33 IPR 123.

### **Competitive Need**

*Issue:* Particular colors may be suited for certain products, or there may be a limited number of “best colors” that appeal to consumers (e.g., in the food industry colors may be used to indicate a particular flavor). Various businesses also argue that they need to have colors free from trademark protection, since the monopolization of a color would unfairly restrict the ability of these companies to meet consumer demand and packaging requirements, or aptly “describe” their products through color (e.g., an orange carton for orange juice, a yellow bottle for lemon juice, etc.). Allowing monopolization of color may unfairly restrict the ability for others to compete.

This argument is adequately addressed by the functionality doctrine as illustrated by the following analysis by the U.S. Supreme Court in *Qualitex*:

The functionality doctrine, as we have said, forbids the use of a product’s feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is “essential to the use of purpose of the article or affects [its] cost or quality.” *Inwood Laboratories, Inc.*, 456 US, at 850, N 10 72 L Ed 2d 606, 102 S Ct 2182. The functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition of reputation) that trademark protection might otherwise impose, namely their inability reasonably to replicate important non-reputation-related product features. For example, this Court has written that competitors might be free to copy the color of a medical pill where that color services to identify the kind of medication (e.g., a type of blood medicine) in addition to its source. *Qualitex*, 34 U.S.P.Q. at 1165

The Subcommittee agrees that application of the functionality doctrine should take care of many concerns regarding the ability of trademark owners to monopolize single colors. To the extent that single colors are needed to compete effectively in the marketplace, they would not be subject to exclusive appropriation if they are functional, i.e., necessary to effective competition.

## **Color Depletion**

*Issue:* The color depletion argument essentially is also a variant of the functionality/competitive need arguments. According to this argument, since there are only a limited number of colors, registration/protection should not be allowed because it will deplete the supply of color available for use by others.

The following passage by the U.S. Supreme court in *Qualitex*, appropriately analyzes, in the Subcommittee's view, that the depletion issue is also adequately handled by the functionality doctrine:

This argument is unpersuasive, however, largely because it relies on an occasional problem to justify a blanket prohibition. When a color serves as a mark, normally alternative colors will likely be available for similar use by others. Moreover, if that is not so -- if a "color depletion" or "color scarcity" problem does arise -- the trademark doctrine of "functionality" normally would seem available to prevent the anti-competitive consequences that [the defendant's] argument posits, thereby minimizing that argument's practical force. *Qualitex*, 34 U.S.P.Q. at 1165

## **Shade Confusion**

*Issue:* Critics of color registration state that deciding likelihood of confusion between shades would be difficult and subtle, and the courts would be ill-equipped to solve such problems.

The Subcommittee considers that determining confusion between different color marks would not present a more difficult question than determining likelihood of confusion in other trademark contexts. The Courts that have considered color, such as the U.S. Supreme Court in *Qualitex*, have not considered this to be a problem.

## **Search Problems**

*Issue:* It would be difficult to search colors to obtain an accurate picture of those colors which conflict with the proposed trademark.

As is the case with other types of design trademarks where descriptions are required, color searches should not pose a major problem. (For example, if a yellow trademark were being searched, all designs, including yellow, could be placed in the search report together with other similar shades of color such as orange and red). The search mechanics could be worked out with the relevant search companies and trademark professionals who use sophisticated techniques for searching design trademarks.

Color marks could be described in trademark applications by reference to an accepted color code such as the Pantone Matching System. Guidelines for UK applicants provide for descriptions of a color or colors defined by a Pantone or some other widely known and easily available standard.

## **Trade Dress Protection**

*Issue:* Some argue that adequate protection already exists for color marks via trade dress-related provisions of the various countries' trademark laws (e.g., § 43 (a) of the Lanham Act in the U.S.), or through laws of unfair competition or passing-off.

The Subcommittee submits that trademark registration provides more protection than is available under a trade dress theory of protection. For example, trademark registrations may be deposited at Customs offices and used to prevent importation of goods bearing confusingly similar marks. Registration also provides evidentiary advantages under various national laws, e.g., constructive notice of ownership, prima facie evidence of validity and ownership, and, in some cases, incontestable status.

It is recognized that in those countries where use is not required to obtain registration, efforts could be made to monopolize a whole range of colors, just as similar efforts might be made to monopolize descriptive or generic word marks. The general language of the resolution proposed for the INTA Board's approval leaves room for individual countries to set appropriate limitations. For example, an applicant may be required to make a prima facie showing that color serves as a trademark, i.e., as an identification of source, e.g., because it is so unique. A showing of distinctiveness through use could also be required. Such individual standards tailored to the specific countries' legal framework would appear to be best evaluated and considered on a country-by-country basis.

In those countries where registrations are granted without examination, opposition and cancellation actions would be available to remove the registration. Provisions could also be adopted placing the burden on the trademark claimant to establish that the claimed color serves as a designation of origin. In any event, the concerns inherent in deposit countries apply also to word marks.

The Subcommittee understands that other INTA committees are considering specific examination guidelines with respect to color marks and the proposed resolution does not undertake to set forth specific guidelines. The examples given are meant to illustrate how different concerns could be addressed in a framework where each country has the flexibility to establish the specific requirements for according trademark status to color marks.

## **IV. INTA POSITION**

INTA already has gone on the record at least twice (once expressly and once implicitly) in support of the availability of protection of color as a trademark under the U.S. Trademark Act. In 1994 INTA submitted an amicus brief on behalf of the party claiming trademark rights in a single color in *Qualitex*. That brief argued that the Lanham Act did not preclude the registration of single colors. Years earlier, *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, 77 TMR 375 (1987)*, on which the U.S. Congress relied in passing the 1988 amendments to the Lanham Act, specifically recommended that Congress not narrow or delete that portion of the statutory

definition of trademark referring to “symbol or device,” because such amendment might “preclude registration of such things as color, shape, smell, sound , or configuration which functions as a mark.” *id.*, at 421. (See above discussion re relevant law).

Thus, adoption of the proposed resolution would be an affirmative confirmation of, not a departure from, what essentially is implicit INTA policy on this issue. INTA’s focus in the past, as confirmed in the resolution, is not blanket protection of color per se, but protection only where color serves the trademark function of identifying source of origin.

## V. IMPLEMENTATION STANDARDS

In November 1995, the Board recommitted an earlier Action Request (proposed by the then International Committee) for reassessment on several issues, including the potential for proposing a defined implementation standard of international scope.<sup>12</sup>

The Subcommittee believes that it is necessary for the Board to formalize INTA’s position on the fundamental question of protectability of color marks, without including related implementation issues, such as whether a showing of acquired distinctiveness should be required or whether incontestable status would be made available.<sup>13</sup> The Subcommittee believes that these issues exceed the scope of the Subcommittee’s charter of assisting the Board in formulating general INTA policy,

---

<sup>12</sup>The Board also identified several inconsistencies between the Committee’s Report and the Proposed Resolution. Both of these documents have been substantially rewritten and the identified inconsistencies have been eliminated.

<sup>13</sup>After the Board recommitted the initial action on this subject, the Non-Traditional Trademarks Subcommittee again considered the issue of whether acquired distinctiveness should be a threshold requirement for protection of single color trademarks. The Subcommittee concluded that, albeit rare, there might be some situations where single color trademarks would be so unusual and unrelated to the product that it would be appropriate to protect such marks as inherently distinctive without a requirement of establishing acquired distinctiveness. Accordingly, the Subcommittee again concluded that acquired distinctiveness should not be stated as a requirement set forth in the resolution. Rather, the resolution should use more general terminology, including that protection should be extended “in appropriate circumstances” to encourage the individual countries or jurisdictions to establish appropriate implementation standards.

and are under consideration by other committees, such as the Legislation Analysis Committee (Model Law Subcommittee) and the Trademark Office Practices Committee (Examination Guidelines Subcommittee).

## **VI CONCLUSION**

Commercial realities confirm that color, alone, is capable of performing a trademark role of indicating the source or origin of goods or services. Color, therefore, may well be used as, and, in appropriate circumstances, should be viewed as a “sign” used to identify the goods/services of one undertaking and distinguish those goods/services from those of another undertaking -- performing the same role as more traditional word or design marks.

The definitions of trademark contained in NAFTA, the EC Harmonization Directive, the EC Regulation and TRIPs, and many national laws, are focused not on technical requirements that to be protected a mark must satisfy traditional notions of what a mark must look like, but on the traditional role of a trademark to serve as a source identifier. To the extent that a single color performs that purpose, there is no principled reason why it should categorically be denied trademark protection.

The proposed resolution simply confirms, as appears already is INTA informal policy, that in appropriate circumstances, color performing a trademark purpose should be entitled to protection, and leaves collateral issues regarding such protection to the discretion of the individual countries.

We stand on the brink of much international debate on color trademarks and we urge INTA to lead the way.