



UNIO  
EU LAW JOURNAL

## **The possibility of colour registration *per se***

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*ABSTRACT: The admissibility of colour registration per se has been discussed at great length. In opposition to this possibility, the valuation of the general interest in not unduly restricting the availability of colours for other operators in the market («depletion theory»), has been invoked, among other things. Nevertheless, in the current state of Community law the answer to this possibility seems to be affirmative, after the requirements of trade mark registration have been met. In this study we focused briefly on the main issues that arise in this area, in light of the Court of Justice of the European Union case law.*

*KEYWORDS: trade mark– non-traditional trade marks – chromatic trade marks – colour in abstract (per se) – legal concept of trade marks.*

### **I. The practical importance of (in)admissibility of registration of the colour *per se***

Trade marks are signs which allow consumers to distinguish goods and services with reference to their commercial origin.

The economic importance of these signs is undeniable. Without them the consumer's purchasing decision can be extremely difficult, given the huge range of products and

services and their increasing technical complexity.<sup>1</sup> Moreover, the trade mark may be a business asset of great importance,<sup>2</sup> especially in the context of an economic crisis like the one we are currently experiencing.<sup>3</sup>

Since the trade mark is an important instrument of competition, it is not unusual that, from early on, its legal regulation has raised interest in the European Union.<sup>4</sup>

In fact, despite the fact that all the countries which formed the (then) EEC already disposed of trade mark legislation, there were conflicts emerging that had to be addressed.

The concepts of the single market, free competition and the principle of free movement of goods, characterizing the EEC, would be undermined by the application of different rules relating to trade mark law. This was shown in a considerable number of judgments decided by the Court of Justice of the European Union (ECJ), before the EU legislative intervention in this matter.

The crucial role of the ECJ in the affirmation of this right – which is an essential element of the undistorted competition which the Treaty seeks to establish and maintain<sup>5</sup> – persisted after the creation of a European Trade Mark Law by legislation,

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<sup>1</sup> We have already made reference to the socio-economic significance of the trade mark in another work, cf. Maria Miguel Carvalho, *A marca enganosa* (Coimbra, Almedina, 2010), 22 ff.

<sup>2</sup> Cf. Lionel Bently and B. Sherman, *Intellectual Property Law* (2<sup>nd</sup> ed., Oxford University Press, 2004), 694. According to information released by *Interbrand*, in 2013, «Apple» was the most valuable trade mark (98.316 million dollars), followed by «Google» (93.291 million dollars), leaving «Coca-Cola» (which, for over 12 consecutive years, had led this table) in 3<sup>rd</sup> place (79.213 million dollars), information consulted at <http://interbrand.com/en/best-global-brands/2013/Best-Global-Brands-2013-Brand-View.aspx> As regards the Portuguese trade marks, according to information made available at *Controlinveste* website (<http://www.dinheirovivo.pt/Graficos/Detalhe/CIECO047662.html>), in 2012, «EDP» was the most valuable one (EUR 2,480 million), followed by «Galp» (EUR 1,856 million) and «PT» (€ 676 million).

<sup>3</sup> On this topic, cf. Maria Isabel Candelario Macías and Luísa E, Rodríguez Grillo, “Un modo de entender la marca para enfrentar la crisis empresarial”, *ADI* 30 (2009-2010): 141 ff.

<sup>4</sup> We have already made reference to the relevance of the Trade Mark Law within the European Union, cf. Luís Couto Gonçalves, Cláudia Trabuco, Maria Miguel Carvalho, “Propriedade Intelectual”, in *Manual de Direito Material da União Europeia*, ed. Alessandra Silveira and Mariana Canotilho (in edition), which herein we follow closely.

<sup>5</sup> See, for all observations, Judgment *HAG II*, 17 October 1990, Case C-10/89.

This legislative step towards a European Trade Mark Law took place with the approval of the first Council Directive, relating to trade marks, on 21 December 1988 [TMD], and the Regulation on the Community trade mark, on 20 December 1993 [CTMR], meanwhile both have been codified<sup>6</sup>. The interpretation of the rules of these legislative elements, by the ECJ, is binding on their enforcers in Member States, hence its major role.

The concept enshrined in the Trade Mark Directive – and which, by its influence, is set out in the majority of the Member States of the European Union legislation [as is the case of the Portuguese Industrial Property Code (CPI)<sup>7</sup> and the Regulation on the Community Trade Mark] – refers to trade mark as a sign capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of other undertakings.<sup>8</sup>

The adopted legislative-technique also includes an *illustrative* list of signs that might constitute a trade mark, if the premises referred to above are fulfilled. The relevance of this list is evident because it clarifies the existence of signs, whose registration were not always accepted but which constitutes a trade mark (e.g., letters, numbers and the shape of the product). On the other hand the non-exhaustive<sup>9</sup> character of the list of signs carries the possibility, at least theoretically, of *other* signs constituting a trade mark,

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<sup>6</sup> The directive 2008/95/EC of the European Parliament and of the Council, of 22 October 2008, codified the first Council Directive of 21 December 1988 [TDM] and the Regulation (EC) 207/2009, of the Council, of 26 February 2009, on the Community trade mark [CTMR] codified the Regulation 40/94 referred to above.

<sup>7</sup> The Portuguese Industrial Property Code, currently in force, was approved by Decree 36/2003 of 5 March (amended for the last time by Law 46/2011 of 24 June).

<sup>8</sup> We have already had the chance to make reference to this subject in another study, which we follow closely herein, though with updates, cf. Maria Miguel Carvalho, «“Novas” marcas e marcas não tradicionais: objecto», in AA.VV., *Direito Industrial* (vol.VI, Coimbra: APDI/Almedina, 2009), 217 ff.

<sup>9</sup> As a result from the illustrative list, the range of admissible signs is (increasingly) wide. Cf. David Vaver, “Recent trends in european trademark law: of shapes, senses and sensation”, 95 *TMR*: 897, and, referring, in detail, the legislative developments observed on the this aspect, for the French, German and American laws, cf., among us, M. Nogueira Serens, *A monopolização da concorrência e a (re) emergência da tutela da marca* (Coimbra: Almedina, 2007), 702 ff., 849 ff., 897 ff.

since they allow customers to distinguish the goods or services of one undertaking from those of others and they are also capable of graphical representation.<sup>10</sup>

Being the Man is a multi-sensory animal, the attempt to commercially exploit these other signs is perfectly understandable.<sup>11</sup>

As Perot-Morel<sup>12</sup> refers, «*a priori*, everything that is perceptible by the senses can be an indication to the consumer and can therefore fulfil the function of a trade mark: a sound, a scent, a taste and maybe even a tactile impression can perfectly represent and characterize a product or service» and the same happens with the colour, the subject of this presentation.

Moreover, this has been the trend in recent years, in the marketing field, due to the influence of «colour psychology».<sup>13</sup>

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<sup>10</sup> With the same view, cf., among others, Lutz G. Schmidt, "Definition of a trade mark by the European trade marks regime – a theoretical exercise?", *IIC*, vol.30, 7 (1999): 739.

<sup>11</sup> Marketers have detected new opportunities to develop trade marks and therefore sell more products and services, finding that 83% of commercial communication appeals only to one sense: sight, leaving 17% unexplored. Since 75% of our daily emotions are influenced by what we smell and there is 65% chance of changing one's mood when exposed to a positive sound, one realises the "new" path of marketing (information available at: [www.brandsense.com](http://www.brandsense.com)). For more details, cf., for all, Martin Lindstron, *Brandsense – A marca multissensorial* (Bookman, 2007). It should also be mentioned that, from a different perspective, the most recent trends in marketing changed the approach of consumers by the trade marks, encouraging the creation of *love marks* (trade marks that go beyond reason, appealing to emotions and feelings). For more on *love marks*, cfr. Kevin Roberts, *Love marks – O futuro além das marcas*, trad. Monica Rosemberg (M. Books, 2005). This phenomenon, embedded in the so-called *emotional marketing*, is further exemplified by the creation, by a Portuguese Advertiser – Miguel Durão –, of a «revolutionary» advertising campaign for chocolates, distinguished by «Milka» trade mark, entitled «The last square» («Le dernier carré»). This advertising campaign, whose aim is precisely to promote tenderness and increase connectivity of consumers with the trade mark, is based on the commercialisation, on the French market, of chocolate tablets of the trade mark «Milka» without one of the squares, but with a code that consumers may enter on a website (shown below) to indicate to whom they want the missing square to be sent to, with a personalised message. This campaign is available on the website <http://www.lederniercarre.fr/> For further developments on *emotional marketing*, cf. Marc Gobe, *Emotional branding: the new paradigm for connecting brands to people* (New York: Allworth Press, 2010).

<sup>12</sup> Cf. Marie Angele Perot-Morel, « Les difficultés relatives aux marques de forme et a quelques types particuliers de marques dans le cadre communautaire », *RDI* (1996) Parte I: 257.

<sup>13</sup> The «colour psychology» dedicates itself to the study of how colours determine human behaviour. About this topic, cf, among others, Zena O'Connor, "Colour psychology and colour therapy: Caveat emptor", *Colour Research & Application*, vol. 36, Issue 3, June (2011): 229–234.

According to studies published in this domain,<sup>14</sup> 93% of consumers think that the visual appearance of the products or services that they buy or subscribe determines their decision and 84.7% of those consider that colour is even the most important aspect. Moreover, colour increases a trade marks' recognition by 80%, in addition to attracting consumers with a specific profile, and it also increases a potential change in the consumer's behaviour.

However, the ability of the sign to be perceived by any sense does not mean that this perception is always the same.<sup>15</sup> For instance, considering colour, this may be perceived differently by different people,<sup>16</sup> depending on the light, or the objects in which it appears, etc.

Furthermore, the possible granting of legal protection through registration as a trade mark to such signs needs to take into consideration the interests of other market participants.<sup>17</sup>

Specifically for reasons related either to the registration system for trade mark protection, prevailing in most jurisdictions<sup>18</sup> or the very grounds of the trade mark law,<sup>19</sup> not all the signs that may constitute a trade mark may be registered as such. For European Trade Mark Law, as we mentioned earlier, only signs that, besides being

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<sup>14</sup> Data available at <http://blog.kissmetrics.com/color-psychology/> and <http://viverdeblog.com/psicologia-das-cores/>. Thus, considering, e.g., the trade mark «Starbucks», the choice of the colour green – which, according to colour psychology, is associated with health, peace and nature, stimulating the harmony and balance between body and emotions – seeks to promote a sense of relaxation, attracting consumers to Starbucks with the aim of eliminating stress (data available at <http://viverdeblog.com/psicologia-das-cores/> )

<sup>15</sup> As stated by Advocate General Damaso Ruiz-Jarabo Colomer, in paragraphs 24 ff. of the Opinion presented on 6 November 2001, within the Case C-273/00, concerning *Sieckmann*, which we refer below, this perception differs depending on whether we are talking about «mechanical» (sight, hearing, touch) or «chemical» senses (taste and smell), depending on the perfection of sensory perception and on the greater or less strict interpretation that the receiver makes of what he seizes in the description. These conclusions, as the rulings from ECJ referred to in this study are available at the website <http://curia.europa.eu/juris/recherche.jsf?language=pt>.

<sup>16</sup> There are even studies that show that women distinguish about 5% more colours than men.

<sup>17</sup> See, *infra* I., 1. and 2.

<sup>18</sup> About the (non)essentiality of graphic representation, see *infra* I .4.

<sup>19</sup> We have already referred to trade mark law fundamentals elsewhere, cf. cfr. Maria Miguel Carvalho, *A marca enganosa*, 18 ff.

capable of graphical representation, are able to distinguish the goods or services of one undertaking from those of other companies may be considered trade marks. And even in these situations, we cannot assure their registration, since there may exist other grounds (absolute or relative) for registration refusal.<sup>20</sup>

Given the objective delimitation of our study, we will briefly reflect on the possibility of a single colour *per se*<sup>21</sup> – that is the colour as such, without any form or delineation, colour in abstract<sup>22</sup> – to be registered as a trade mark,<sup>23</sup> taking into account, in particular, the European Law context.

## **II. The admissibility of trade mark registration of the colour *per se* in European Law**

The admissibility of trade mark registration of the colour *per se* usually faces several obstacles<sup>24</sup> with emphasis on matters relating to the valuation of the general interest in not unduly restricting the availability of colours for other traders in the market («depletion theory»).

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<sup>20</sup> These grounds for refusal (or invalidity) cannot be addressed in this study, for an overview, cf., among us, Luís Couto Gonçalves, *Manual de Direito Industrial – Propriedade Industrial e Concorrência Desleal* (4<sup>th</sup> ed., Coimbra: Almedina, 2013), 189 ff.

<sup>21</sup> For reasons related with the limits imposed on the extension of this paper, we cannot focus on the possibility of registration of colour combinations.

<sup>22</sup> As Luís Couto Gonçalves mentions (*Manual*, 209 ff.), «colour, with respect to the trade mark, can emerge in different circumstances:

1<sup>st</sup> As the colour that coats the product or packaging, presented alone, as such;

2<sup>nd</sup> As a distinctive colour composition of the product or packaging;

3<sup>rd</sup> As an array of colours applied on the product or packaging;

4<sup>th</sup> As the colour of the trade mark, i.e., as the colour in which it is reproduced».

As the quoted author states, «of the listed situations, only the first three have relevance to the problem (...) [in question]», i.e., if the colour can play the distinctive function proper of the trade mark. Therefore, we are not referring to the colour of the trade mark which, as we know, can be claimed. Critically about the concept of colour *per se*, cf. Karin S. Schwartz, «It had to be hue: the meaning of color “Pure and Simple”», *Fordham Intellectual Property, Media and Entertainment Law Journal*, vol. 6, Issue 1, (1995), Article 2 (available at <http://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1102&context=iplj>).

<sup>23</sup> Perhaps we can handle matters respecting to the legal protection granted to a colour trade mark some other time.

<sup>24</sup> E.g., the risk of confusion of shades («shade confusion») and the availability of appropriate protection for colour by design.

In the USA, it was mainly the «depletion theory» – the finding that granting exclusive rights over colours, which exist in limited numbers, would lead to the prohibition of other economic agents using them in the market to distinguish their products or services – which led courts to resort to the «mere colour rule» (a sign consisting of a colour *per se* does not constitute a trade mark) to prevent the registration of such trade marks.<sup>25</sup>

However, this position would be changed, and in 1985, the first colour trade mark was registered in the USA.<sup>26</sup> We are referring to the Owen Corning Co.'s pink fiberglass that at first had been refused by the examiner of the Trade mark Trial and Appeal Board (TTAB). Notwithstanding, given the long-time use of the trade mark (29 years), the Court of Appeals for the Federal Circuit, with 2 votes for and 1 against, eventually granted registration by understanding that there is an exception to the 'mere colour rule' when a specific colour is not used, nor is there a need for effective competition.<sup>27</sup> Ten years later, after several contrary judicial decisions,<sup>28</sup> this approach was confirmed in the «Qualitex» case in which green-gold was allowed as a registered trademark.<sup>29</sup>

The affirmative answer to the admissibility of trade mark registration of the colour *per se*, in the current state of EU legislation,<sup>30</sup> beyond the possibility of the sign, requires that the colour has a distinctive character and that it is susceptible of graphic representation. Let us briefly consider some questions that these requirements place regarding the colour in abstract.

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<sup>25</sup> Cf. *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 171 (1906) e *Diamon Match Co. v. Saginaw Match Co.*, do Court of Appeal (6<sup>th</sup> Circuit) – v. 142 F. 727, 6<sup>th</sup> Cir., 1906, 729 ff.

<sup>26</sup> For a short reference relating the evolution in the USA, see, among others, Danielle E. Gorman, “Protecting single color trademarks in fashion after *Louboutin*”, 30 *CARDOZO ARTS & ENT. L. J.*, 108 ff.

<sup>27</sup> Cf. Craig Summerfield, “Color as a trademark and the mere color rule: the circuit split for color alone”, *Chicago-Kent Law Review*, Vol. 68, Issue 2, Article 15, 975 (<http://scholarship.kentlaw.iit.edu/cklawreview/vol68/iss2/15>).

<sup>28</sup> Cf. Craig Summerfield, “Color as a trademark and the mere color rule: the circuit split for color alone”; Jerome Gilson e Anne Gilson Lalonde, “Cinnamon buns, marching ducks and cherry-scented racecar exhaust: protecting nontraditional trademarks”, *TMR*, vol. 95, 782.

<sup>29</sup> *Re Owens-Corning Fiberglass Corp.* 774, F 2d, 1128 (Fed.Cir.1985). An excerpt of this important decision can be found in Jerome Gilson e Anne Gilson Lalonde, “Cinnamon buns”, 821 ff.

<sup>30</sup> With this exception we intend to safeguard the possibility of introduction of any amendments in the TDM (and CTMR) that might result in removing the reference to the susceptibility of being represented graphically from the concept of trade mark . See *infra* I. 4.

## 1. *The colour per se as a possible sign*

By contrast with the provisions of some international conventions,<sup>31</sup> colour is not expressly mentioned in Article 2 TDM.<sup>32</sup> However, the list entailed in this legal provision is, as we mentioned above, merely illustrative. Furthermore, notwithstanding the (correct) observations made by the honouree<sup>33</sup> concerning the legal value of the joint statement of the EU Council and Commission (issued when the Directive was adopted and entered in the minutes of the Council), this refers the opinion «that Article 2 shall not exclude the possibility (...) of registering as a trade mark, a combination of colours or a single colour (...) since they are capable of distinguishing the goods or services of one undertaking from those of other undertakings».<sup>34</sup>

Within the Portuguese legal system, the possibility of registration of colours combined with each other (or with graphics, wording or other elements) in a particular and distinctive manner is expressly provided in the Industrial Property Code. However, the prohibition of registration (only) for the single colour remains.<sup>35</sup> In fact, with regard to single colours, national legislation departs from the guidance enshrined in other European Union jurisdictions<sup>36</sup> and it seems to be in contradiction with the binding interpretation of Article 2 TDM repeatedly made by the ECJ.

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<sup>31</sup> See *infra* 4.

<sup>32</sup> However, in the proposed Trade Mark Directive – referred *infra* (see 4.) – it is set out an express reference to «colours».

<sup>33</sup> Precisely in the first ECJ judgment on this issue – Judgment *Libertel Groep BV*, 6 May 2003, Case C-104/01, recital 25 – in which the honouree was rapporteur.

<sup>34</sup> OJ OHIM N.J 5/96, 607.

<sup>35</sup> Briefly, about the status in our legal system on the validity of CPI'40 cf. Luís Couto Gonçalves, *Manual de Direito Industrial*, 210, footnote 516. According to this author, currently, this prohibition «should cover both single colours (the seven colours of the rainbow), where the problems of blocking market access are enormous, but also the intermediate colours due to the insurmountable practical difficulties that the opposite solution would represent».

<sup>36</sup> For an overview of the legal regulation on this matter in European jurisdictions, see INTA's report, from March 2005, entitled «Non-Traditional Trademarks in Europe – Shape and Colour Trademarks – Common Issues with Obtaining, Exploiting and Enforcing Rights», available at [www.inta.org/Advocacy/Documents/INTAShapeColorEurope2005.pdf](http://www.inta.org/Advocacy/Documents/INTAShapeColorEurope2005.pdf) Specifically regarding the Spanish, French, Italian, German, Brazilian, North-American, Japanese and Australian legal system, cf., among others, Eva M. Domínguez Pérez, «Tutela del color como marca: especial referencia al carácter

The ECJ had the opportunity to decide, for the first time, the possibility of a single colour being registered as a trade mark in its judgment in the *Libertel* case. Libertel (a company headquartered in the Netherlands), whose main activity is the provision of mobile telecommunications services, applied to the BBM (the competent authority with regard to trade marks for the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands) for registration of the colour orange for certain telecommunications products and services as trade mark. The application was provisionally refused because it was considered that as the applicant had not proved that the sign filed had acquired a distinctive character through use, the sign was devoid of any distinctive character. Following the appeal filed by *Libertel* first to the *Gerechtshof 's-Gravenhage* (Netherlands) and then to the *Hoge Raad der Nederlanden*, the latter decided to refer some questions to the ECJ for a preliminary ruling.<sup>37</sup>

In this judgment it was argued that one cannot assume that colour *per se* constitutes a sign since colour is usually merely a property of things<sup>38</sup> but *depending on the context in which it is used*, it can be a sign.<sup>39</sup>

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distintivo del color (sentencias del TJCE de 6 de mayo de 2003, asunto “naranja” y del TPI de 9 de julio de 2003, asunto “combinación de naranja y gris”)), *ADI*, 34 (2003), 487 ff.; Maria Cristina Caldarola, “Protection of a color under the law of the United States, Germany and Japan”, *CASRIP Newsletter*, Autumn (1999), Vol.6, Issue 2 (<http://www.law.washington.edu/Casrip/Newsletter/default.aspx?year=1999&article=newsv6i2Caldarola>); Denis Borges Barbosa, “A apropriação de cores em marcas”, novembro de 2011 ([http://grotius.net/arquivos/200/propriedade/apropriacao\\_cores\\_marcas.pdf](http://grotius.net/arquivos/200/propriedade/apropriacao_cores_marcas.pdf)); Jani McCutcheon, “How many colours in the rainbow? The registration of colour per se under Australian trade mark law”, *EIPR* (2004), 26 (1), 27 ff.

<sup>37</sup> «(1) Is it possible for a single specific colour which is represented as such or is designated by an internationally applied code to acquire a distinctive character for certain goods or services within the meaning of Article 3(1) (b) of the Directive?; (2) If the answer to the first question is in the affirmative: (a) in what circumstances may it be accepted that a single specific colour possesses a distinctive character in the sense used above?, (b) does it make any difference if registration is sought for a large number of goods and/or services, rather than for a specific product or service, or category of goods or services respectively?; (3) In the assessment of the distinctive character of a specific colour as a trade mark, must account be taken of whether, with regard to that colour, there is a general interest in availability, such as can exist in respect of signs which denote a geographical origin?; (4) When considering the question whether a sign, for which registration as a trade mark is sought, possesses the distinctive character referred to in Article 3(1)(b) of the Directive, must the Benelux Trade Mark Office confine itself to an assessment in abstracto of distinctive character or must it take account of all the actual facts of the case, including the use made of the sign and the manner in which the sign is used?»

<sup>38</sup> This is, as we shall see, one of the main obstacles to the admissibility of this type of sign as a trade mark, since, as Craig Summerfield, “Color as a trademark and the mere color rule: the circuit is split color alone,” Jerome Gilson and Anne Gilson Lalonde, “Cinnamon buns”, 777, 791 ff. state, in most cases, consumers will see it as merely decorative or something inherent to the product and not as an indicator of commercial origin.

## 2. *The distinctive ability of the colour per se*

To determine whether a colour *per se* has distinctive ability<sup>40</sup> we must determine if the colour *itself* allows immediate association to the origin of the products or services. In other words, we must establish «if the trade mark is the first association that comes to the minds of reasonably attentive consumers» when they see the colour, and above all, whether this sign has distinctive character *ab initio* or acquires it by the use made of it related to the product or service.

We can try to answer these questions, reflecting briefly on the associations we make (or do not make) to visualize, for example, the following colours:<sup>41</sup>



Eventually, we will experience some difficulty in connecting them to a particular commercial origin of a product/service immediately, either because we usually consider colours as a (ornamental or decorative) characteristic of the goods/services, or because colour is typically used with other indications.<sup>42/43</sup>

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<sup>39</sup> Judgment *Libertel Groep BV*, 6 May 2003, Case C-104/01, recital 27.

<sup>40</sup> On the difference between distinctive ability and distinctive character, cf. Maria Miguel Carvalho, *A marca enganosa*, 43 ff.

<sup>41</sup> In the oral exposition of this paper we used a multimedia presentation containing some colour examples mentioned in the text. By printing in black and white, it must be explained that the colours listed are the lilac/violet and two different shades of yellow which correspond respectively to Pantone codes E 176-4 e E-176-3; 137-C e E trichromatic co-ordinates / colour characteristics: x 0.520, y 0.428 - diffuse reflectance 42.3% - dominant wavelength 586.5 nm - excitation purity 0.860 - colorimetric purity: 0,894. There are several quizzes on the internet which allow testing the recognition solely based on the colour of several trade marks. See, e.g., <http://www.businessinsider.com/can-you-identify-these-12-brands-by-their-trademarked-colors-alone-2012-2#john-deeres-green-painted-machines-are-instantly-recognizable-when-you-see-them-its-full-green-and-yellow-color-scheme-is-also-trademarked-6>; <https://medium.com/design-ux/77eb4f9a439d>.

<sup>42</sup> As Gilson and La Londe state, no company is going to use only a colour to identify its goods or services. UPS, for example, is not going to drop UNITED PARCEL SERVICE and let the colour brown be its exclusive trade mark. Nor would Tiffany & Co. eliminate TIFFANY and use its blue bags and boxes exclusively. Cf. “Cinnamon buns”, 781.



On the other hand, it is undeniable that colour allows some recognition/identification by consumers as a result of its more or less extended use.

Focusing our attention on the European Union case-law again, it should be noted that the Court of Justice, as we have had the opportunity to clarify, ruled in the affirmative regarding the mark's distinctive character consisting of the colour *per se* in the *Libertel* Judgement.

In fact, although considering that «consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour *per se* is not, in current commercial practice, used as a means of identification» so that «a colour *per se* is not normally inherently capable of distinguishing the goods of a particular undertaking», admittedly, in exceptional circumstances, this may succeed. Particularly, in cases, where the number of goods or services for which the mark is claimed is very restricted and the relevant market is very specific.<sup>44</sup>

With these statements, the ECJ ended up taking sides on the question of whether this distinctive character exists (or can exist) *ab initio* or whether, instead, it is (or must be) established by the use of the sign. Taking a different approach from the one enshrined in North American trade mark law, which only allows for the grant legal protection as a trade mark for the colour *per se*, if it has acquired, following the use made of it, a distinctive character<sup>45</sup>, in the aforementioned judgment, the ECJ, admits that the colour

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<sup>43</sup> The 1.<sup>st</sup> and 3.<sup>rd</sup> examples refer to registered Community Trade Marks 31336 and 747 949, respectively. The 2.<sup>nd</sup> example concerns 3M a registered trade mark, in particular, in the USA.

<sup>44</sup> Cf. Judgment *Libertel Groep BV*, 6 May 2003, Case C-104/01, recitals 65 and 66.

<sup>45</sup> Cf., among others, Jekaterina Kudrjavceva, "Issues surrounding registration of colour trade marks", *RGSL Research papers*, 9, 2012, 23 ([http://www.rgsl.edu.lv/uploads/files/RP\\_9\\_Kudrjavceva\\_final.pdf](http://www.rgsl.edu.lv/uploads/files/RP_9_Kudrjavceva_final.pdf)).

in abstract can acquire a distinctive character following the use made of it<sup>46</sup> and considers that, *in exceptional circumstances*, it may have distinctive character *ab initio*, that is to say, even prior to any use.<sup>47</sup>

However, this admissibility turns out to be more theoretical than practical, since a large part of the applications as colour (*per se*) trade mark eventually succumb to the requirement of distinctive character, precisely due to the «nature of colour and its peculiarities».<sup>48</sup> This does not happen, however, in cases where the applicant provides evidence of the acquisition of a distinctive character following the use made of it. This is what seems to follow, first and foremost, from the practice of OHIM,<sup>49</sup> e.g., once the colour «lilac/violet» to identify chocolates, entitled by *Kraft Foods Schweiz Holding Gmb*, have been accepted for registration as a Community trade mark (31336).

Regarding the assessment of the distinctive character of a specific colour as a trade mark, the ECJ also said that it is necessary to take into account – given the limited number of colours available – the public interest in not unduly restricting the availability of colours for the other operators who also offer products or services of the type for which registration is sought.<sup>50</sup> Thus, «the greater the number of goods or services for which the trade mark is sought to be registered, the more excessive the exclusive right which it may confer is likely to be, and, for that very reason, the more likely is that right to come into conflict with the maintenance of a system of undistorted competition, and with the public interest in not unduly restricting the availability of

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<sup>46</sup> Showing that a significant part of the relevant public associates the products/services to a particular commercial origin because of the colour as a registered trade mark. That is what happened, e.g., in the 2<sup>nd</sup> Decision of the Second Board of Appeal of OHIM, from 4 May 2007, on the *Whiskas* case (available at: [http://oami.europa.eu/LegalDocs/BoA/2006/en/R1620\\_2006-2.pdf](http://oami.europa.eu/LegalDocs/BoA/2006/en/R1620_2006-2.pdf)). In this case, the application for registration colour (purple/Pantone 248C) for goods in Class 31 (food and milk for cats) as trade mark was refused. On appeal, it was held that, based on general consideration of the evidence presented, there is a very high trade mark recognition by the relevant public in the Community (in all Member States and between 53% -75% in eight of these), which results from many years of presence in the market, a significant market share and a considerable investment on advertising and marketing (see recitals 26 ff. from the decision).

<sup>47</sup> Cf. Judgment *Libertel Groep BV*, 6 May 2003, Case C-104/01, recitals 66 and 67.

<sup>48</sup> Cf. Jekaterina Kudrjavceva, “Issues surrounding registration of colour trade marks”, 23.

<sup>49</sup> The consultation of registration applications for Community trade marks may be made at <http://oami.europa.eu/ows/rw/pages/CTM/caseLaw/decisionsOffice.en.do>

<sup>50</sup> Cf. Judgment *Libertel Groep BV*, 6 May 2003, Case C-104/01, recitals 54-60.

colours for the other traders who market goods or services of the same type as those in respect of which registration is sought». <sup>51</sup>

### ***3. The prohibition of trade mark registration of descriptive, usual, generic and functional chromatic signs***

Once these barriers are overtaken the competent authority for trade mark registration must determine whether the chromatic sign for which registration is sought as a trade mark fulfils the other requirements laid down in Article 3 TDM, in particular. <sup>52</sup>

Within this context, it may be of relevance to prevent the registration, in principle, in cases where a colour can be considered to be, e.g., descriptive<sup>53</sup> (e.g., to use the colour orange to distinguish orange juices), usual<sup>54</sup> (e.g., blue and red taps for cold and hot water), generic<sup>55</sup> (e.g., red for fire equipment) or even functional<sup>56/57</sup> if the colour

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<sup>51</sup> Cf. Judgment *Libertel Groep BV*, 6 May 2003, Case C-104/01, recital 56.

<sup>52</sup> Cf. Judgment *Heidelberg*, 24 June 2004, Case C-49/02, recital 41, in which it was discussed the registration of the colours blue and yellow as trade mark to distinguish certain products used in building and construction.

<sup>53</sup> For reasons related with the economy of the present study, we cannot herein dwell upon the prohibition of registration of descriptive signs On this subject, cf. Maria Miguel Carvalho, “A marca descritiva apreciada pelo Tribunal de Justiça no Acórdão Postkantoor”, *SI*, LIII, 300, setembro-dezembro 2004, 509 ff. (“La marca descriptiva apreciada por el Tribunal de Justicia en la Sentencia «Postkantoor», *ADI*, XXV, 2005, 695 ff.).

<sup>54</sup> For reasons related with the economy of the present study, we cannot herein dwell upon the prohibition of registration of descriptive signs On this subject, cf. Luís Couto Gonçalves, *Manual de Direito Industrial*, 207 ff.

<sup>55</sup> For reasons related with the economy of the present study, we cannot herein dwell upon the prohibition of registration of generic signs On this subject, cf. Luís Couto Gonçalves, *Manual de Direito Industrial*, 199 ff.

<sup>56</sup> It seems to result implicitly from the CJEU case law, as the Court does not assume it expressly, the acceptance of the «functionality doctrine [of North American origin] and competitive colour need». In this sense, cf. Eva M. Domínguez Pérez, “Tutela del color como marca: especial referencia al carácter distintivo del color”, 496, which states that, in paragraph 71 from the Judgment *Libertel*, ECJ takes as its starting point «the “public interest” in not unduly restricting the availability of colours for other traders offering products/ services from the same type as those for which registration is sought», underlying this statement the need to «prevent registration as a trade mark of signs when it fulfils a technical function (...) or (...) when the colour is the only possibility that other agents have to distinguish its products or services in the market».

<sup>57</sup> In the USA, even if we can prove that the non-traditional trade mark has acquired distinctive character from the use made of it (e.g., the colour in abstract), this will not be registered due to the doctrine of functionality, cf. Anne Gilson Lalonde and Jerome Gilson, “Getting real with nontraditional trademarks:

complies a certain utility function or is used to achieve a particular technical result concerning a product (e.g., the silver colour, known for reflecting heat and light, therefore the favourite colour of the manufacturers of insulating coatings for buildings<sup>58</sup>).

#### **4. The susceptibility of graphical representation of colour per se**

The susceptibility of a trade mark being represented graphically for registration purposes, required by the Community legislator, has been justified primarily on grounds of technical and legal certainty.

On the one hand, it is said that the graphical representation facilitates the assessment of the application for registration as a trade mark by the competent authority<sup>59</sup> and of the official publication of the application and its eventual concession. On the other hand, it alludes to the need to accurately determine the scope of protection afforded to the trade mark.<sup>60</sup>

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what's next after red oven knobs, the sound of burning methamphetamine, and goats on a grass roof?", *TMR*, vol.101, 189 ff. It should also be noted that, apart from the utilitarian functionality, some authors advocate the aesthetic functionality doctrine. For an overview of this topic, cf. Mark Alan Thurmon, "The rise and fall of trademark law's functionality doctrine", *Florida Law Review*, vol. 56 (2004): 253 ff. and Sunila Sreepada, "The new black: trademark protection for color marks in the fashion industry", *Fordham Intellectual Property, Media and Entertainment Law Journal*, Vol. 19, Issue 4 (2009), Article 6: 110 ff. (<http://iplj.net/blog/archives> for access to the IPLJ archive>1149).

<sup>58</sup> Cf. paragraph 33 of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) document: "Relation between the existing principles relating to trade marks and new types of trade marks", from March 30, 2007, available at [www.wipo.int/meetings/es/topic.jsp?group\\_id=63](http://www.wipo.int/meetings/es/topic.jsp?group_id=63)

<sup>59</sup> In the same sense, cf. Carlos Fernández-Nóvoa, *Tratado sobre Derecho de Marcas* (2 ed., Madrid/Barcelona: Marcial Pons, 2004), 43. Marco Arcalá refers to this requirement as having «objective, formal and functional characteristics», showing a legislative choice in favour of registration as the fundamental path to the acquisition of the trade mark in most of the compared jurisdictions and in the EU law. Cf. Rodríguez-Cano e García-Cruces González, "Prohibiciones absolutas", in *Comentarios a la Ley de Marcas* (Navarra: Editorial Aranzadi, Cizur Menor, 2003), 138 ff.

<sup>60</sup> In this sense, cf., among us, Luís Couto Gonçalves, "Marca olfativa e o requisito da suscetibilidade de representação gráfica – Acórdão do Tribunal de Justiça, de 12.12.2002, P. C-273/00", *Cadernos de Direito Privado*, 1, janeiro/março (2003), 26. See also Francisco J. Alonso Espinosa, "Las prohibiciones de registro en la Ley 17/2001, de 7 de diciembre, de Marcas", *RDM*, 245 (2002): 1203; Lutz G. Schmidt, "Definition of a trade mark by the European trade marks regime – a theoretical exercise?", 740. Discussing the correctness of the requirement of being represented graphically, cf., for all, José Manuel Otero Lastres, "La definición legal de marca en la nueva Ley Española de Marcas", *ADI*, xxii (2001): 200 ff.

However, the fact that this requirement arises from the constitutive system of registration and not exactly from the trade mark concept,<sup>61</sup> leads some legal doctrine to criticize the inclusion of this requirement in the context of a rule with regard to the concept of trade mark, raising difficulties for the registration of some signs (which in some cases even results in the impossibility of registration - e.g., tactile, taste, olfactory signs ...) This position can also be explained by the fact that this requirement was established at a time when there were no technological means available to allow the disclosure of registration of different signs (which is today already a reality and will increasingly be in the future...<sup>62</sup>).

Furthermore, at an international level, there has been an evolution in this area. Consequently, despite Article 15 (1) of the TRIPS which enables WTO members to require that the signs be visually perceptible in order to be registered as trade marks, in more recent treaties there are no limitations of this kind (let us consider the provisions of Article 2 of the Singapore Treaty on the Law of Trade Marks<sup>63</sup> and Rule 3 of the Regulations under the Singapore Treaty on the Law of Trade marks<sup>64</sup>).

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<sup>61</sup> Blanca Torrubia Chalmeta, "El requisito de la representación gráfica: un límite de acceso al registro para las marcas no visuales", *ADI* 32 (2011-2012), 394 ff., refers in regards to this respect that «it is the consumer who identify and distinguish in the market the perceptions of the trade mark (...) [and] consumers, who do not consult records or the official bulletins through which the offices publish registration relating to trade marks, know the trade marks in its real dimension, as such, identifying a product or service in the market. This is the size at which the registration should adapt its bureaucratic structure so that the non-visual trade marks can be examined and compared with each other».

<sup>62</sup> In this sense, cf. Sergio Balaña, "El entorno digital, segunda oportunidad para la marca olfativa? Estudio acerca de la capacidad del signo olfativo para funcionar como marca en el mercado", *ADI*, 26 (2005-2006): 25 ff., as regards, in particular, telematics networks. Cf. also the study on «virtual reality environment» by Caroline Wilson, "Trade mark law in an online future – coming to its senses?", 19 September 2007 (<http://www2.law.ed.ac.uk/ahrc/gikii/docs2/wilson.pdf>).

<sup>63</sup> This Treaty was signed on 27 March 2006, under the auspices of WIPO. Portugal signed it on 28 March 2006, but it has not been ratified yet.

<sup>64</sup> In regards to the subject of this study, the latter refers expressly to the registration as a trade mark of the colour *per se*, without imposing its admissibility, but establishing that, for members who admit it, it is required that the trade mark reproduction consists of sample(s) colour(s) and that may be required that its designation(s) uses its common name. Furthermore, it is also contemplated that a description may be required regarding the colour application on products/services as well as a code chosen by the applicant and accepted by the authority responsible for registration (Rule 3 paragraph 7). This rule resulted from the work of the SCT, since November 2006. The documents prepared by this Committee are available at [http://www.wipo.int/meetings/en/topic.jsp?group\\_id=63](http://www.wipo.int/meetings/en/topic.jsp?group_id=63)

Therefore, we see an amendment of the Directive (and the Regulation on the Community Trade Mark) in the wake of the proposal submitted by the European Commission on March 27, 2013, as very natural. The proposal is based on the study of the overall functioning of the European trade mark system, prepared by the Max Planck Institute for Intellectual Property and Competition Law.<sup>65/66</sup>

This proposal specifies that the requirement of the susceptibility of the sign to be represented graphically has become obsolete, creating great uncertainty to the registration of non-traditional trade marks and therefore it should be excluded from the definition of trade mark.<sup>67</sup> This does not mean, however, an «extension without limits of permissible ways of representing a sign».

While such an amendment is not implemented, we must consider the existing regime which is determined by a more or less strict interpretation of the requirement of the capacity of the sign to be represented graphically.

In fact, as it is pointed out by Fernández-Nóvoa, if the signs' susceptibility of graphic representation is to be interpreted strictly, it shall be required that this provides, by itself and directly, accurate information about the sign that you want to register as a

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<sup>65</sup> See Proposal for a Directive of the European Parliament and of the Council of 27 March 2013 to approximate the laws of Member States relating to trade marks (Reformulation [SWD (2013 96 final), COM (2013 162 final (available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=COM:2013:0162:FIN:PT:PDF>)). The proposed wording for article 3 is as follows: A trade mark may consist of any signs capable of being represented graphically, in particular, words, including personal names, designs, letters, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that such signs are capable of: (a) distinguishing the goods or services of one undertaking from those of other undertakings; (b) being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor. See also in an equivalent sense, the proposal for a Regulation of the European Parliament and of the Council of 27 March 2013, amending CTMR [SWD (2013 95 final), COM (2013 161 final). The proposed wording for Article 4 is as follows: A European trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that such signs are capable of (a) distinguishing the goods or services of one undertaking from those of other undertakings; (b) being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.

<sup>66</sup> On this study, cf. Maria Miguel Carvalho, "O estudo sobre o funcionamento geral do sistema europeu de marcas", *ADI* 31 (2010-2011), 509-526.

<sup>67</sup> The reference to «colours» will be part of the illustrative list contained in the trade mark definition.

trademark. On the other hand, if this requirement is interpreted broadly it will suffice that the indirect graphical representation of the sign, is completed by other means.<sup>68</sup>

This obstacle to the registration of non-traditional trade marks has been the subject of attention by the Court on the interpretation of Article 2 TMD. We refer, in particular, the Sieckmann Judgement,<sup>69</sup> where the possibility of registering an olfactory trade mark was considered for the first time.

According to the precedent established there, and that has been restated in subsequent cases, «Article 2 of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [...] must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters».

However, the ECJ, at the same time, held the enunciation of the so-called «*Sieckmann* criteria», i.e., the seven characteristics that the graphical representation must observe in order to satisfy the requirement at issue (clarity, accuracy, completeness, easy accessibility, intelligibility, durability, objectivity), seeming to adopt a stricter interpretation, that may impede the registration of such signs, in practice.

With specific regard to chromatic signs, the ECJ also ruled on this point in the *Libertel* judgement, by referring specifically to representation through a colour sample, a verbal description and/or an internationally recognised code identifying the colour.

Thus, considering the possibility of graphic representation through a sample colour on paper, the ECJ, emphasised that it cannot be admitted by itself, as a graphical representation of such sign, since it does not entail a durable nature, insofar as it is liable to change with time. However, it has been admitted that there are alternatives to the representation of the sample on paper that do not encounter this obstacle (e.g., the sample in electronic format).

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<sup>68</sup> Carlos Fernández-Nóvoa, *Tratado sobre Derecho de Marcas*, 43.

<sup>69</sup> Cf. Judgment *Sieckmann*, 12 December 2002, Case C-273/00.

When the Court addressed the verbal colour description, it also held that all the requirements of graphic representation may not be fulfilled so its admissibility must be determined casuistically. Moreover, with regard to this form of representation, some authors point out the subjectivity of this description as an evident obstacle.

The indication of an internationally recognised identification code of the colour was determined to be viable by the ECJ – which considers, as an alternative to this form of representation, the combination of a colour sample complemented with its verbal description.