

THROUGH THE LOOKING HOLE OF THE MULTI-SENSORY TRADEMARK RAINBOW: TRADEMARK PROTECTION OF COLOR *PER SE* ACROSS JURISDICTIONS: THE UNITED STATES, SPAIN AND THE EUROPEAN UNION

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“There is nothing in the intellect that was not first in the senses.”²

An oft-asserted prediction states that only trademarks that stimulate all five senses with the objective of attracting the consumer’s attention will acquire a firm and durable presence in today’s complex marketplaces.³ This, in turn, has provoked the broadening of the repertoire of signs and symbols potentially eligible to serve as trademarks for products or services. Vivid examples of these are the sounds, scents, flavors, colors and three-dimensional forms, which collectively, are grouped under the generic category of “non-traditional trademarks.”⁴

A recent debate within the field of intellectual property law hinges on whether a color’s inherent qualities prevent it from serving as a trademark. The extent and dimension of the controversy are determined, to a certain degree, by the definition of “color.” One definition of color is, a visual perception phenomenon produced by luminous rays that enables one to differentiate objects even though the objects may appear otherwise identical.⁵

Interpreted in a vacuum, that definition may influence the way in which the inquiry at hand is approached, tempting one to conclude that those who request the trademark registration of one color, to use

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² ARISTOTLE, ON THE SOUL.

³ MARTIN LINDSTROM, BRAND SENSE: BUILD POWERFUL BRANDS THROUGH TOUCH, TASTE, SMELL, SIGHT, AND SOUND 3 (2005).

⁴ See THOMAS P. ARDEN, PROTECTION OF NONTRADITIONAL MARKS: TRADEMARK RIGHTS IN SOUNDS, SCENTS, COLORS, MOTIONS AND PRODUCT DESIGNS IN THE U.S. (2000); Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 773 (2005).

⁵ See Webster’s Third New International Dictionary 447 (2002).

it in relation to products or services want to reserve for themselves a characteristic of the objects which is attributable to the solar rays.⁶

The controversy surrounding granting trademark protection to colors is complicated. The purpose of this article is to serve as a useful platform for the further elaboration, discussion, and assessment of the arguments wielded in the course of the debate over unique color trademark registration.⁷ Additionally, this article traces the legislative and jurisprudential development of the rules pertaining to this topic as it has evolved in the United States, Spain, and the European Union.

I. THE PROTECTION OF COLOR TRADEMARKS IN THE UNITED STATES: LEGISLATION AND CASE LAW

1. Legislation

The protection that the United States legal system confers to trademarks arises primarily out of the Law of Trademarks of 1946, commonly known as the Lanham Act.⁸ The statute does not mention the registration of a single color, nor does it explicitly contemplate the protection of other non-traditional signs or symbols.

The legislative history of the Lanham Act, the principles that informed the enactment of the statute and the overall tenor of its amendments suggest that the Act intended to offer trademark protection to new modes of trade signs.⁹

The Lanham Act adopts an ample and inclusive definition of trademark.¹⁰ The Act defines a trademark as, "a word, symbol, name or a combination of these" that distinguishes a product or a service and identifies its source.¹¹ Moreover, the Act establishes that the nature of the trademark will not constitute a ground for registration refusal, unless the law expressly states the contrary.¹²

The above arguments support the claim that non-traditional signs such as sounds, scent, and three-dimensional forms should have access to the register of the Office of Patents and Trademarks of the

⁶ See Paul Blondeel, *About Color Marks*, THIRD EUROPEAN JUDGES' SYMPOSIUM, OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (OHIM) (2003), available at <http://oami.europa.eu/en/office/ejs/prog2003.htm>.

⁷ The phrases "sole color," "color per se" and "unique color" are used to designate the case in which a trademark consists of one color. Therefore, the trademarks consisting of combinations of colors are excluded from the discussion.

⁸ Lanham Act, 15 U.S.C. §§ 1051-1127 (2006).

⁹ See Juanita J. Webber, *The Green-Eyed Monster Sore or Can Color Really Be Trademarked Under The Lanham Act? Qualitex Co. v. Jacobson Products Co., Inc.*, 21 T. MARSHALL L. REV. 425, 428-432 (1996).

¹⁰ Lanham Act, 15 U.S.C. § 1127 (2006).

¹¹ *Id.*

¹² *Id.*

United States (hereinafter "PTO") and receive federal trademark protection.¹³ Additionally, these arguments are crucial to the issue of the registration of color *per se*.¹⁴

2. Case Law

a) Traditional Rule

Although the issue of trademark protection of a single color, or color *per se*, was not before the Supreme Court in *Leschen & Sons Rope Co. v. Broderick & Bacom Rope Co.*,¹⁵ the opinion stated in dictum: "[y]ou may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you can not register a mark of which the only distinction is the use of a color. . . ."¹⁶

It was not until 1985 that a federal court, in the notorious case of *In re Owens-Corning Fiberglas Corp.*, diverged from *Leschen* because the court did not find any compelling reasons that would preclude the registration and protection of a trademark consisting of a color alone.¹⁷

b) Owens-Corning

In *Owens-Corning*, the federal circuit court analyzed the history of the judicial protection of color *per se* in the United States, and declared that it was inappropriate for the courts to continue to apply judicial precedents decided before the enactment of the Lanham Act, to the extent that they were inconsistent with the principles and objectives espoused in said law.¹⁸

After examining the broad definition of trademark contemplated by the Lanham Act and analyzing various court decisions in which protection was proffered to non-traditional signs, the court concluded that the color of a product could serve as a trademark, so long as it satisfies the applicable statutory requirements.¹⁹

Owens-Corning did not end the divergence of opinions concerning trademark protection color; in fact, division in federal circuits has

¹³ See generally Gilson & LaLonde, *supra* note 4.

¹⁴ See generally Lawrence B. Ebert, *Trademark Protection in Color: Do It by the Numbers!*, 84 TRADEMARK REP. 379 (1994).

¹⁵ *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166 (1906).

¹⁶ *Id.* at 172.

¹⁷ *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985).

¹⁸ *Id.* at 1119.

¹⁹ *Id.* at 1122.

intensified.²⁰ In light of the divergence of opinions, the United States Supreme Court heard the paradigmatic case of *Qualitex Co. v. Jacobson Products Co.*, and issued a unanimous opinion declaring that, under the Lanham Act, a sole color could serve as a trademark for a product or service.²¹

c) *Qualitex v. Jacobson*

i. *Facts*

In the 1950s, Qualitex began to manufacture and sell a green-gold color pad used on dry cleaning presses.²² Several decades later, Jacobsen started to sell a very similar product.²³ As a result, Qualitex registered the green-gold color in the PTO and filed a lawsuit against Jacobsen for trademark infringement.²⁴

ii. *Federal District Court Decision*

The federal district court held that trademark registration of the green-gold color was valid.²⁵ The court reasoned that the color green-gold had acquired a secondary meaning because the consumers associated it with the product manufactured by Qualitex.²⁶ Furthermore, the court found that the fact that Jacobsen copied the color and the general appearance of the product would pose a risk of confusion among consumers.²⁷ Thus, the court prevented Jacobsen from using the green-gold color on its product.²⁸

iii. *Ninth Circuit Decision*

The federal court for the Ninth Circuit reversed the lower court and ordered the cancellation of the trademark.²⁹ It concluded that, although the Lanham Act did not expressly prohibit the registration of a unique color, it was appropriate to preserve the traditional rule. In support of its rationale, the court invoked the theories of "color depletion" and "shade confusion."³⁰

²⁰ See generally *Master Distributors, Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993); *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990).

²¹ *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 166 (1995).

²² *Id.* at 160.

²³ *Id.*

²⁴ *Id.*

²⁵ *Qualitex Co. v. Jacobson Prod. Co.*, 21 U.S.P.Q2d 1457, 1458 (C.D. Cal. 1991).

²⁶ *Id.*

²⁷ *Id.* at 1459.

²⁸ *Id.* at 1462.

²⁹ *Qualitex Co. v. Jacobson Prod. Co.*, 13 F.3d 1297, 1305 (9th Cir. 1994).

³⁰ *Id.* at 1302.

iv. United States Supreme Court Decision

To clarify definitively the controversy of whether a trademark could consist of a sole color and dissipate the difference of criterion prevailing among the various United States Circuit Courts, the Supreme Court of the United States granted certiorari.³¹ Justice Breyer, in a unanimous opinion, reversed the decision of the Ninth Circuit.³² The Court held that there was no legal principle that prohibited extending trademark protection to a sole color; hence, the district court's decision prevailed.³³ In support of its decision recognizing Qualitex's sole-color trademark, the Supreme Court set forth the arguments discussed below.

1) The Legislative History of the Lanham Act

The Supreme Court emphasized that both the language and the spirit of the Lanham Act permit the inclusion of colors in the wide spectrum of signs that could constitute trademarks. Justice Breyer observed that the law defines the concept of a trademark as "any word, name, symbol, or any combination of these," implying that the key element is the capacity of the sign to distinguish the origin of the product, and not its physical state.³⁴ He underscored the fact that the Lanham Act clearly establishes that the nature of the trademark cannot not be a ground for registration refusal, unless expressly forbidden by the Act.³⁵

The Court added that an examination of the legislative history of the Lanham Act and the Congressional purpose behind it, led to the conclusion that color *per se* should be included as a sign that may constitute a trademark. The Court recognized that just a few years prior, the Act was amended; however, this did not modify the relevant disposition.³⁶ In light of the following factors, (i) the federal circuit's *Owens-Corning* decision; (2) the PTO's delineation of a clear policy allowing registration of this type of trademark and, (3) a legislative commission report recommending that the definition of trademark not be restricted,³⁷ the Court concluded that the fact that Congress did not prohibit the registration of color *per se* suggested a tacit legislative ratification of the rule adopted in *Owens-Corning*.³⁸ The Court also referred to a United States Senate report expressly indicating that the

³¹ Qualitex Co. v. Jacobson Prod., 514 U.S. 159 (1995).

³² *Id.* at 160.

³³ *Id.* at 174.

³⁴ *Id.* at 162.

³⁵ *Id.* at 171.

³⁶ *Id.* at 172.

³⁷ *Id.*

³⁸ *Id.*

definition of trademark within the existing legal framework did not impede the registration of colors, forms, or sounds.³⁹

2) *Principles that Inspired the Adoption of the Lanham Act*

The Court also relied upon the fundamental principles that inform trademark law to support its decision in *Qualitex*.⁴⁰ The Court declared that since a color *per se* could serve the fundamental objectives of United States Trademark Law — serve as a means to identify products, facilitate consumers' purchase decisions and function as a financial reward for quality-products manufacturers — it should be admitted into the plethora of signs that are eligible for trademark protection.⁴¹

3) *Previous Case Law*

The Court refused to apply previous judicial decisions holding that a sole color could not constitute a trademark.⁴² The Court pointed out that the precedents were no longer persuasive because they interpreted the applicable law before the adoption of the Lanham Act and were therefore contrary to the language and legislative history of the Act.⁴³

4) *Distinctiveness*

The court stated in dicta that in, order for a color to become eligible for trademark protection, it was necessary to demonstrate that the color had acquired secondary meaning.⁴⁴ This rationale is the basis on which various federal courts have held that color alone will never be inherently distinctive.⁴⁵

Attempts to place boundaries on the implications arising from the Supreme Court's opinion suggested that this was an unresolved matter that would persist until the Court made further clarifications.⁴⁶ After five years of persistent debate about *Qualitex*, the Court clarified the state of affairs relating to trademark protection for unique

³⁹ *Id.* at 173.

⁴⁰ *Id.* at 163.

⁴¹ *Id.* at 166.

⁴² *Id.* at 171-172.

⁴³ *Id.*

⁴⁴ *Id.* at 163-164.

⁴⁵ See *Forschener Group Inc. v. Arroz Trading Co.*, 124 F.3d 402, 408 (2d Cir. 1997); *Fabrication Enters v. Hygenic Corp.*, 64 F.3d. 53, 58 n.3 (2d Cir. 1995).

⁴⁶ See Kevin Jordan & Lynn Jordan, *Qualitex Co. v. Jacobson Products Co., The Unanswered Question: Can Color Ever Be Inherently Distinctive?*, 85 TRADEMARK REP. 371, 397 (1995); Jonathan Hudis, *Removing the Boundaries of Color*, 86 TRADEMARK REP. 1, 10 (1996).

colors in *Wal-Mart Stores, Inc. v. Samara Bros.*⁴⁷ In *Wal-Mart* the Court held that color *per se* could never be inherently distinctive; thus, eligibility for trademark protection hinges on whether the color has acquired secondary meaning.⁴⁸

5) Rejection of “The Color Depletion” Theory

The Supreme Court in *Qualitex* grappled with the theory of “color depletion,” as it had been the basis for sustaining the traditional rule holding that color *per se* could not constitute a trademark.⁴⁹ Those who favor the depletion theory argue that the impossibility of registering a trademark consisting exclusively of a unique color is supported by the view that there is a relative dearth of colors.⁵⁰ Therefore, if a seller could appropriate a color, he would gain an immeasurable competitive advantage and restrict competitor’s access to the market.⁵¹

In *Qualitex*, the Court rejected the depletion theory as a basis for the adoption of a categorical rule prohibiting the registration of colors.⁵² The Court indicated that, in the majority of cases, sellers would have alternate colors available to identify their products.⁵³

The Court added that in those cases in which a problem of color depletion exists, the functionality doctrine could prevail over a color trademark claim.⁵⁴ Furthermore, the Court’s holding underscored that it is possible to avoid the exclusive appropriation of a color when confronted with any of the following scenarios: (i) the color serves a functional purpose or, (ii) the color is essential in order to inform certain characteristics of the product, such as purpose, cost or quality.⁵⁵

6) Rejection of the “Shade Confusion” Theory

The theory of “shade confusion” establishes that extending trademark protection to a color could cause uncertainty with respect to what constitutes a concrete protected trademark. It may be unclear what subtle tones and shadings of color can be validly used by competitors. Additionally, application of the classic criteria of probability of

⁴⁷ *Walmart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000).

⁴⁸ *Id.* at 216.

⁴⁹ *Qualitex Co. v. Jacobsen Prod.*, 514 U.S. 159, 167-170 (1995).

⁵⁰ *Id.* at 168.

⁵¹ See Rudolph Callman, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 18.13 (1983).

⁵² *Qualitex*, 514 U.S. at 164-169.

⁵³ *Id.* at 169.

⁵⁴ *Id.*

⁵⁵ *Id.*

confusion is difficult if the appearance of color depends on various contingent or subjective factors such as illumination.⁵⁶

The Supreme Court rejected the theory of shade confusion indicating that the courts are routinely called to consider the difficult question of whether two words are similar enough as to cause confusion in the public and thus, color should be treated no differently in that respect.⁵⁷ The Court added that judges should be capable of applying the same standards when comparing tones or shades of colors, and, if necessary, they can replicate the illumination under which the product is normally sold.⁵⁸

II. THE POST-QUALITEX STATE OF AFFAIRS

Various commentators predicted that the *Qualitex* decision would lead to a stampede of color trademark applications.⁵⁹ Notwithstanding, although official statistics do not offer a clear picture of what has occurred, the available evidence suggests that *Qualitex* did not result in a significant increase of filings corresponding to this type of application.⁶⁰

An informal study carried out in 2004 revealed that in the nine years following *Qualitex*, the number of registration of color trademarks (around thirty) was similar to the amount of registries accounted for during the ten years which elapsed between *Owens-Corning* and *Qualitex*.⁶¹

Application of the rule announced in the case is limited, and requires that the applicants take significant steps prior to obtaining the inscription of its trademark in the PTO.⁶² Furthermore, *Qualitex* merely validated the practice of the PTO, harking back to the time of *Owens-Corning*, in which the registration of trademarks consisting of only one color was allowed. Consequently, the case did not involve a transcendental shift regarding how the PTO evaluated and considered this type of application.⁶³

The study also revealed that two-thirds of applicants who filed this type of application had used the color in connection with their products for a minimum period of ten years.⁶⁴ Likewise, it is more

⁵⁶ *Id.* at 167.

⁵⁷ *Id.* at 167-168.

⁵⁸ *Id.*

⁵⁹ See Christopher C. Larkin, *Qualitex Revisited*, 94 TRADEMARK REP. 1015, 1017 (2004).

⁶⁰ *Id.* at 1015.

⁶¹ *Id.* at 1025.

⁶² *Id.* at 1026.

⁶³ See Larkin, *supra* note 59, at 1026.

⁶⁴ *Id.*

probable that the application to register the color trademark will be considered favorably when the use of the color concerning the product is unusual, unexpected, or unnecessary.⁶⁵

III. COLOR TRADEMARKS REGISTRATION IN THE PTO

The PTO requires that the inscription of a trademark be accompanied by a depiction “substantially similar” to the one which appears on the actual product.⁶⁶ In addition, it requires that the application for the trademark describe the trademark with “ordinary language,” even if the applicant also describes the color based on a code of a color system such as PANTONE.⁶⁷

The PTO considers the following factors to determine if a color has acquired site secondary meaning: (i) whether the use of the color is common in the relevant segment of the market in question; (ii) the product’s sale volume; (iii) whether publicity directly captures the customer’s attention with respect to the color of the product; (iv) whether the color is also used in promotional articles; (v) whether consumers associate the color with the nature of the product; and (vi) whether the color serves some utilitarian purpose.⁶⁸

IV. COLOR TRADEMARKS IN SPAIN

1. *The Law of Industrial Property of May 16, 1902*

Spain’s Law of Industrial Property of May 16, 1902 defined the concept of trademark as any sign or material medium, whatever its class or form, which serves to identify the products of an industry.⁶⁹

⁶⁵ See *Forschner Group, Inc. v. Arrow Trading Co.*, 124 F.3d 402, 408 (2d. Cir. 1997); *Mana Products, Inc. v. Columbia Cosmetics Mf., Inc.*, 65 F.3d 1063, 1071 (2d Cir. 1995); *Regal Jewelry Co. v. Kingsbridge International Inc.*, 999 F. Supp. 477, 487 (S.D.N.Y. 1998); *In re Denticator Int’l., Inc.*, 38 U.S.P.Q.2d 1218 (T.T.A.B. 1995); *In Re Hudson News Co.*, 39 U.S.P.Q.2d 1915 (T.T.A.B. 1996); *In re Orange Communications, Inc.*, 41 U.S.P.Q.2d 1036 (T.T.A.B. 1996).

⁶⁶ See U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.05 (d) (2007).

⁶⁷ See U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.05 (e) (2007). PANTONE is a color matching system. See www.pantone.com (follow “about us” hyperlink) (last visited Feb. 9, 2007).

⁶⁸ Midge M. Hyman & Hannah Y. Cheng, REGISTRABILITY AND ENFORCEABILITY OF NON-TRADITIONAL TRADEMARKS IN THE UNITED STATES, PRACTICING LAW INSTITUTE, PATENTS, COPYRIGHTS, TRADEMARKS, AND LITERARY PROPERTY COURSE HANDBOOK SERIES 6-9 (2005).

⁶⁹ Law of Industrial Property (May 16, 1902), tit. 2, art. 21 (Sp.), as reprinted in GACETA DE MADRID, May 18, 1902, at 782-783.

The language of the Act was broad enough to infer the protection of color trademarks.⁷⁰ The Regulation of Trademarks of June 12, 1903, however, established that colors could not constitute trademarks.⁷¹

2. *Statute of Industrial Property of 1929*

The Statute on Industrial Property of 1929, enacted by Law of 16 September 1931, defined trademark as any sign or material medium, whatever its class and form, that serves to signal and distinguish similar products.⁷²

The Act directly addressed the registration of a sole color. Specifically, article 126 stated that a trademark could not consist of colors *per se*.⁷³ The prohibition extended to trademarks that were exclusively constituted by a fundamental⁷⁴ or a pure⁷⁵ color.

Additionally, the Spanish doctrine posed the question of whether the prohibition also encompassed shades or tones of a fundamental color. Some commentators argued that the shades of a color were unlimited; therefore, if one were to protect one of them, there would always be other available shades of the same fundamental color.⁷⁶ However, most Spanish legal commentators rejected this argument and pointed out that in many occasions, it was extremely difficult to discern between shades of the same color. Therefore, awarding protection to one color shade would cause untenable confusion.⁷⁷

3. *Law 32/1988 of November 10, 1988*

Spain's Law 32/1988 of November 10, 1988⁷⁸ reiterated the basic principle that article 126 of the Statute of Industrial Property ini-

⁷⁰ Jaime Pellisé Capell & María Teresa Solanelles Battle, *Hacia la Protección del Color Único*, REVISTA DE DERECHO MERCANTIL 1563, 1565 (1998).

⁷¹ *Id.*

⁷² Royal Order of April 30, 1930, published in the *Gaceta de Madrid* on May 21, 1930, no. 127.

⁷³ See Carlos Fernández-Novoa, *El Color y las Formas Tridimensionales en la Nueva Ley Española de Marcas*, ACTAS DE DERECHO INDUSTRIAL Y DERECHO DE AUTOR 41 (1989-1990).

⁷⁴ The seven colors of the rainbow are considered "fundamental colors." See Capell & Solallanes, *supra* note 70, at 1568.

⁷⁵ "Pure colors" are those that are easily identifiable such as black and white. See Capell & Solallanes, *supra* note 70, at 1568; see also Fernández-Novoa, *supra* note 73, at 48.

⁷⁶ See Capell & Solanelles, *supra* note 70, at 1569.

⁷⁷ *Id.*

⁷⁸ Ley 32/1988 [Trademark Law] (Nov. 10, 1988) (Sp.), BOLETÍN OFICIAL DEL ESTADO, Dec. 11, 1988, at 32238, available at http://www.wipo.int/clea/docs_new/pdf/en/es/es010en.pdf.

tially introduced. It defined a trademark as any sign or medium that served to distinguish identical or similar products or services.⁷⁹ Just like its predecessors, the Law of 1988 configured a trademark definition sufficiently broad as to allow trademarks constituted of only one color;⁸⁰ however, it expressly prohibited trademark protection of a single color.⁸¹ Article 11.1 (g) of the Law of 1988 established the general rule that a single color could not be registered as a trademark.⁸²

The Law of 1988 excluded the possibility of obtaining protection of color *per se*, even in the event that the color had acquired a secondary meaning.⁸³ The law was interpreted as creating a presumption that color *per se* lacked distinctiveness. Furthermore, the law did not recognize a color *per se* as a means of resolving the tension between protecting commercial identity in the market vis-à-vis sustaining free market competition.⁸⁴

4. Law 17/2001 of December 7

Title II, article 4 of Spain's Law 17/2001 of December 7 defines trademark as any sign susceptible to graphic representation that serves to distinguish products and services.⁸⁵ In addition, it recognizes a *numerus apertus* catalogue of signs that could constitute trademarks such as words, figures, three-dimensional forms, sounds, symbols, drawings, letters, and numbers.⁸⁶ It is important to stress that the list includes three-dimensional forms and sounds, two typical examples of non-traditional signs.⁸⁷ Nevertheless, any reference to colors as a trademark was excluded.⁸⁸

The language and the principles that informed the enactment of the Law of 2001 justify the conclusion that, in light of the open-ended character of the list of signs that constitute trademark, denial of registration of non-traditional signs or symbols, is near impossible. Thus, the list of signs afforded trademark protection is not exclusive and signs not listed may be entitled to trademark protection.⁸⁹ This

⁷⁹ *Id.* at tit. 1, art. 1.

⁸⁰ See Capell & Solanelles, *supra* note 70, at 1572.

⁸¹ *Id.* at 1573-1574.

⁸² *Id.* at 1576-1578. See also Manuel Martínez Miguez, *La Protección del Color Único como Marca en el Derecho Español*, ACTAS DE DERECHO INDUSTRIAL Y DERECHO DE AUTOR 117 (1982).

⁸³ See Capell & Solanelles, *supra* note 70, at 1578-1579.

⁸⁴ *Id.* at 1579.

⁸⁵ Law 17/2001 [Trademark Act], Dec. 7, 2001, art. 4 (Sp.), available at http://www.wipo.int/clea/docs_new/pdf/en/es/es080en.pdf.

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ See SALVADOR FERRANDIS GONZÁLEZ, COMENTARIOS A LEY DE MARCAS 46 (2002).

argument is strengthened by the fact that the express prohibition stated in article 126 of the Statute of Industrial Property of 1929, as well as in article 11.1 (g) of the Law 32 of November 10, 1988, does not appear in the Law of 2001.

Another argument supporting the assertion that the Spanish legal system now admits the trademark registration of a unique color is that this constitutes a prescription of European Union Trademark Law, to which Spain's legislative branch should adapt. In fact, the Declaration of Purposes of the Law of 2001 establishes that one of its objectives is to incorporate international and European Union legal norms.⁹⁰

In sum, there are strong arguments supporting the conclusion that the Spanish legal system admits the registry of a trademark consisting in unique color.⁹¹ Nevertheless, some commentators state that registration of a single color is still not possible, since it contravenes the general principle that a sign that lacks distinctiveness cannot constitute a trademark.⁹²

V. THE PROTECTION OF COLOR TRADEMARKS IN THE EUROPEAN UNION

1. *Comparative Law Assessment: National Legal Regimes of European Union Member States*

The majority of the member states of the European Union allow the registration of color trademarks.⁹³ Most countries require that the applicant shows that the color has acquired secondary meaning, that is, that the public harbors the expectation that the goods sold with this certain color are those of a specific seller.⁹⁴

With respect to the registration procedure, the majority of the national trademark offices have established a requirement that the color be adequately identified, by way of a sample or by reference to an internationally-recognized color-code, such as PANTONE.⁹⁵ In some countries, a narrative description of the color is also required as part of the application process.⁹⁶

⁹⁰ Trademark Act, Explanatory Memorandum § 4.

⁹¹ See Europe Legislation Analysis Subcomm., Int'l Trademark Ass'n, Non-Traditional Marks in Europe: Shape and Colour Trademarks, Common Issues with Obtaining, Exploiting and Enforcing (2005), available at https://www.inta.org/downloads/tap_nontradEU.pdf.

⁹² *Id.*

⁹³ See *id.*

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ See *id.* See generally Pantone Home Page, <http://www.pantone.com/pages/pantone/index.aspx>.

2. Directive and Regulation Regarding the Community Trademark

The adoption, interpretation, and application of the national laws of the member states of the European Union should be in accordance with the principles of the European Union Law.⁹⁷

With regard to European Community Law, the regulation of trademarks is principally governed by “First Directive 89/104/EEC of the Council, to Approximate the Laws of the Member States Relating to Trade Marks”⁹⁸ and “Council Regulation (EC) No 40/94 on the Community Trademark.”⁹⁹ Both are fundamental sources of law that apply to European Union trademarks. Additionally, national trademarks are regulated primarily by these supranational rulings and secondarily by national legislation.¹⁰⁰

Article 2 of the Directive defines trademark as those signs that can be an object of a graphic representation, such as words, phrases, drawings, letters, or numbers, as long as such signs meet the condition that they distinguish the product or services of a seller from those of other sellers.¹⁰¹ Article 4 of the Council Regulation contains a similar provision.¹⁰²

The definition of trademark provided in the Directive and in the Council Regulation is substantially broad.¹⁰³ It merely offers an open-ended list of signs that serve as examples of what may be construed as a trademark. This leaves the door open to non-traditional signs, as long as they fulfill the function of identifying and distinguishing products or services. Therefore, as a general rule, as is the case with other signs, a single color can constitute a European Union trademark, so long as it is distinctive and meets other pertinent requirements and criteria.¹⁰⁴

3. European Court of Justice (ECJ)

The controversy regarding the protection of color *per se* has been the subject of intense debates in the European Court of Justice. In the renowned case of *Libertex Group vs. Benelux Merkenbureau* of

⁹⁷ Jaume Pellisé Capell & María Teresa Solanelles Battle, *La Protección del Color Único como Marca en el Derecho Comunitario*, REVISTA DE DERECHO MERCANTIL 1101,1123-1124 (1998).

⁹⁸ See Council Directive 89/104, 1989 O.J. (L 40) (EC), available at <http://oami.europa.eu/ES/mark/aspects/direc/direc.htm>

⁹⁹ See Council Regulation (EC) No. 40/94 of 20 December 1993, The Community Trade Mark (2003).

¹⁰⁰ See Capell & Solanelles, *supra* note 97, at 1104.

¹⁰¹ See Council Directive, *supra* note 98.

¹⁰² See Council Regulation, *supra* note 99.

¹⁰³ See Capell & Solanelles, *supra* note 97, at 1109.

¹⁰⁴ *Id.*

2003, the European Court of Justice declared the applicable standard in these cases.¹⁰⁵

The Court reasoned that colors do not have the inherent capacity to communicate specific information, such as the origin or the source of the product or service.¹⁰⁶ Nevertheless, it found that color *per se* could constitute a trademark if the applicant demonstrates that the mark acquired a secondary meaning.¹⁰⁷ The Court established that, in determining if a color is distinctive, it is necessary to take into account all the intervening circumstances, including the time during which the company has made use of the color, and the public's perception with regard to the link between the unique color and the corresponding product or service.¹⁰⁸

The Court invoked the "Council Regulation (EC) No. 40/94 on the Community Trademark"¹⁰⁹ to support the decision, which, as mentioned previously, defines trademark in broad terms.¹¹⁰

4. *Reports of the World Intellectual Property Organization*

The World Intellectual Property Organization ("WIPO") has declared that a single color can constitute a trademark. The following are some of the arguments outlined in its most recent reports.¹¹¹

In one report, WIPO recognized that sellers make deliberate and systematic use of unique colors and combinations of colors in their

¹⁰⁵ Case C-104/01, *Libertel Groep BV v. Benelux – Merkenbureau* 2003 ECJ (May 6, 2003), available at http://www.copat.de/markenformen/c-104_01en.pdf.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ See Council Regulation, *supra* note 99.

¹¹⁰ *Id.*

¹¹¹ See *Non-Traditional Marks Non-Traditional Marks – Key Learnings– Key Learnings*, STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS (Nov. 12-16, 2007), available at http://www.wipo.int/edocs/mdocs/sct/en/sct_18/sct_18_2.pdf; see also *New Types of Trademarks*, STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS (Nov. 13-17, 2006), available at http://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf. See World Intellectual Property Org. [WIPO], Standing Comm. on the Law of Trademarks, Industrial Designs and Geographical Indications, *Non-Traditional Marks- Key Learnings* (Nov. 12-16, 2007) (prepared by the Secretariat), available at http://www.wipo.int/edocs/mdocs/sct/en/sct_18/sct_18_2.pdf; World Intellectual Property Org. [WIPO], Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *New Types of Trademarks* (Nov. 13-17, 2006) (prepared by the Secretariat), available at http://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf.

products, in their promotional memorabilia, and in their points of sale, as an important instrument of commercial identification.¹¹²

The reports states that, of the seventy-five offices of registry of trademarks questioned on the topic, (i) seventy-one permit the registration of combinations of colors and, (ii) seventy-two accepted the registry of individual/unique colors or combinations of colors associated with other signs.¹¹³

WIPO requires that the color trademark application include a description of the colors in words.¹¹⁴ The graphical representation of the trademarks of color can be effectuated by means of a pictorial representation of the goods that possess the color claimed.¹¹⁵ WIPO may also require that the applicant present a chromatogram or refer to a code of an internationally recognized color system, such as Focoltone, PANTONE, RAL or RGB.¹¹⁶

On the other hand, it is a necessary condition that the unique color must have acquired distinctiveness as a condition for registry eligibility. The color will not be susceptible to protection if it constitutes a functional element of the product. It is understood that a color trademark is functional if it accomplishes a utilitarian objective, if it is used to obtain a determined technical result in relation to the product, is fundamental to the use or end to which the product is destined, or affects its cost or quality.¹¹⁷ However, said reports affirm that it may be convenient to deny registration of some colors based on criteria that go beyond those outlined above, such as when the conferral of trademark registration would contravene principles of public policy or provide an unfair competitive advantage.¹¹⁸

5. Madrid Protocol

The Rules of Practice for Trademark-Related Filings under the Madrid Protocol Implementation Act, which entered into force on April 1, 2007, also contemplate the registry of a unique color.¹¹⁹ As per the European Union's adhesion to the Madrid Protocol, upon October 1, 2004, trademark title-holders may file an international application as a member state of the European Union.¹²⁰

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ See http://www.wipo.int/madrid/es/legal_texts/pdf/common_regulations.pdf.

¹²⁰ *Id.*

VI. SOME OBJECTIONS TO THE PROTECTION OF COLOR *PER SE*

Although the rule established by the United States Supreme Court and ECJ's cases of *Qualitex* and *Libertex* —respectively— to confer protection to color trademarks invested with secondary meaning, has been adopted by many other jurisdictions, it has not been exempt from critics. It is worth underscoring that some of the principal arguments that have been wielded against the rule adopted in both cases are precisely those that various jurisdictions have invoked to deny trademark-registry protection to color *per se*.

1. *Theory of Color's Inherent Inability to Operate as Trademark*

The first obstacle with which the admission of unique-color trademark has to deal with is the generalized idea that a color *per se* is not, on its own, an adequate vehicle to distinguish the products or services of a seller from others that operate in similar circumstances. That line of thought argues that the public tends to see a color as a mere accessory or ornamentation of the product as opposed to an integral-identifying characteristic.¹²¹

Nevertheless, “the experience of countries whose legal system offers a trademark definition outlined in broad terms and eschews an outright prohibition of [*per se*] color registry, has demonstrated that color can acquire distinctive force with use, and that, on occasion, it may even become the only medium with which a producer may identify and distinguish his products in the market.”¹²²

2. *Theory of “Shade Confusion”*

Both *Qualitex* and *Libertex* ruled out adopting the “shade confusion” theory. Some interpreted that as an attempt to avoid the particular-idiosyncratic controversies that stem from the different ways color may be perceived. As such, the absence of an overarching criterion that may guide the courts while considering these types of controversies remains problematic.¹²³

The perception of colors depends on a multiplicity of factors that are often intrinsically variable and exert reciprocal influence as they interact. Among the examples of these variable factors are surface of the product, illumination, as well as questions hinging on

¹²¹ See Callmann, *supra* note 51, at 137.

¹²² See Capell & Solanelles, *supra* note 70, at 1584.

¹²³ See Jean Hayes Kearns, Comment, *Qualitex Co. v. Jacobson Products Co.: Orange You Sorry the Supreme Court Protected Color?*, 70 ST. JOHN'S L. REV. 337 (1996).

whether the color is juxtaposed with another of various other colors.¹²⁴ Nevertheless, among the many important *shifting-contingent variables* that one must grapple with, the most important is the perception and assimilation of color as essentially a subjective, hinging on the mind of the observer, which in itself is subject to shifts or accommodations, according to the age and memory of the observer in question.¹²⁵

Even if a seller achieves trademark inscription of a color, the nature of this type of sign creates obstacles that impede or curtail the enforcement of the resulting rights that stem from Trademark Law. The problems stemming from the particular variables affecting the perception of color create considerable difficulties when attempting to apply the “probability of confusion” test. It may also be extremely complicated to determine what is the threshold that validates that a competitor used a color substantially similar to the protected trademark.¹²⁶

On the other hand, the problem of the perception of shades of color can also signify a competitive disadvantage for the competitors, who may feel compelled not to use any similar shades of a protected color in order to prevent a possible claim regarding a violation of protected trademark.¹²⁷

In *Qualitex*, the Supreme Court of the United States rejected this line of argument and stated that the courts are routinely obliged to make comparatively complicated assessments on which their decisions will hinge. As such, the Court held that other controversies faced by the courts are not essentially different from cases in which it is alleged that two competitors use similar colors to identify their products. Nevertheless, the Supreme Court conveniently glossed over two fundamental problems which lower courts would eventually have to deal with.

First, the environment under which the colors are to be compared as shades of colors can substantially differ with respect to the various circumstances in which the consumer observes the color associated with the product.¹²⁸ Consumers are not necessarily in the habit of undergoing an exhaustive analysis of the appearance of the product to determine its source, origin, or the brand with which it is associated. In fact, the modern-day proliferation of trademarks has created an atmosphere in which many consumers accustom themselves to a

¹²⁴ See George A. Agoston, *COLOR THEORY AND ITS APPLICATION IN ART AND DESIGN* 7 (1979); Anni Berger-Schunn, *PRACTICAL COLOR MEASUREMENT* 1-2 (1994).

¹²⁵ See RALPH M. EVANS, *AN INTRODUCTION TO COLOR* 223 (1948).

¹²⁶ See Gilson & LaLonde, *supra* note 4.

¹²⁷ See *G.D. Searle & Co. v. Chas. Pfizer & Co.*, 265 F.2d 385 (7th Cir. 1959).

¹²⁸ See Kearns, *supra* note 123.

rapid, often *nonchalant*, identification of the origin associated with the product or advertisement under observation.¹²⁹

Second, the rejection of the “shade confusion” theory raises a significant problem. Regardless of the supposed human capacity to distinguish millions of colors, the intuitive reality is that common experience may lead people to conclude that the subtle differences in shades of a color can be practically imperceptible and impossible to determine.¹³⁰

3. “Color Depletion Theory”

In *Qualitex*, the court discarded the notion that a relative dearth of perceptible colors could justify a prohibition to the registration of a single color. It indicated that hundreds of shades of colors are manufactured and that thousands of additional colors can be obtained by mixing existing colors.¹³¹

The experts deem that, under an optimal visual environment, a normal eye can distinguish and discern about ten million different colors. Nevertheless, this analysis is not helpful in the context of trademarks given that ordinarily the consumer does not have the opportunity to compare the shades of two similar products.¹³²

Moreover, consumers often depend on their memories to buy products. Thus, they will often be compelled to reach decisions under less than optimal circumstances regarding the scope of available reference points. In fact, albeit in theory, hundreds of names for colors exist, the majority of the people use as little as twelve.¹³³

In order to avoid consumer confusion — or to prevent the violation of a protected trademark — competitors may eliminate from their catalogue of options a relatively wide segment of the alternative broad bands of available colors. That, in turn, depletes the offer of available colors for commercial use and therefore, makes it difficult for the competitors to choose an appropriate identifiable color, which also tends to prevent them from competing effectively.¹³⁴

An additional problem that stems from the rejection of the “color depletion” doctrine is that it is often the case that there are a limited number of desirable colors within any given industry. If all attractive colors for a specific category of products are not available because they are protected, a new competitor will be at a disadvantage

¹²⁹ *Id.*

¹³⁰ See Stephen J. Newman, *Kill The ‘Mere Color’ Rule: Equal Protection for Color Under the Lanham Act*, 61 U. CHI. L. REV. 1595 (1994).

¹³¹ *Qualitex Co. v. Jacobson Prod.*, 514 U.S. 159, 166.

¹³² EVANS, *supra* note 125, at 230.

¹³³ *Id.*

¹³⁴ See Kearns, *supra* note 123.

because probably it will be obliged to use a less attractive color that is not yet protected.¹³⁵

VII. CONCLUSION

The world markets are currently experiencing an ever-increasing proliferation of multi-sensory stimulants — including those catalogued as “nontraditional”— used with the objective of capturing the attention of potential consumers and to serve the basic goal of identifying products or services.

Undoubtedly, one of the challenges that the field of trademark law will inevitably face and grapple with during the course of the impending decades is the adoption of principles that apply to the peculiar problems posed by the grant of exclusive property rights over trademarks consisting of non-traditional signs, such as scents, sounds, flavors, and colors.

¹³⁵ *Id.*

