

## Colours as Trademarks – Clarification and Limitations

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### ABSTRACT

It is possible for a single colour to be registered as a trademark if certain conditions are met. This raises questions about the nature of colour itself and how an individual colour is to be specified. If a colour is understood to be something physical, like paint, it would be possible to patent the process of manufacture. It is more difficult to protect the appearance of something, and the value of a trademark lies in its appearance. An application for registering a colour should be accompanied by a physical sample but the appearance of that sample can vary. Trademark protection needs to extend to the range of appearances that can be expected for the physical sample in different conditions. This range of appearances would occupy a ‘bubble’ in colour space. There is only room for so many such bubbles which means that the number of companies that could trademark a colour for a given class of goods or services is limited. An argument against granting too many applications is that this would lead to ‘colour depletion’, meaning a dwindling supply of colours.

**KEYWORDS:** Colour trademarks, the nature of colour, colour specification

### INTRODUCTION

“What is colour for?” This question is posed by W.D. Wright in his essay *Towards a Philosophy of Colour*, and he suggests an answer: “Surely this is what colour is for – to tell us about objects.” [1]

In the natural world colours convey information about things that may be desirable or dangerous. Where certain colours are experienced in situations that arouse strong feelings those same colours, seen in isolation, can evoke similar feelings. There is what might be called a ‘natural language’ of colour.

With the emergence of human culture people found ways to modify appearances so that a much more complex language of colour has evolved. The yellow petals that identify a sunflower are part of the natural language of colour; the yellow robes that identified the Chinese emperors during the Qing Dynasty are part of the cultural language of colour [2]. There is nothing ‘natural’ in the association between the colour yellow and the rank of emperor. That meaning for yellow was a product of the culture. And the same is true for colours that have come to be identified with different companies.

### COLOURS AS TRADEMARKS

Today colours are key elements in branding strategies and can serve to identify a company’s goods and services and distinguish them from those of competitors. It was long considered impossible that a single colour could meet the criteria for registration as a trademark, but that barrier was broken in 1985 when the U.S. Court of Appeal ruled that Owens-Corning could register the colour pink for its fibreglass insulation [3]. Then in 2004, at a congress of the International Association for the Protection of Intellectual Property, it was resolved that “A colour per se can be capable of registration as a trade mark.” [4].

Having a colour as a registered trademark can give a company a big competitive advantage. Data from my research indicate that colours are a particularly efficient means of differentiation and identification. In many situations colours communicate more quickly and effectively than shapes, letters, or numbers [5].

### FACTORS THAT INFLUENCE DECISIONS ABOUT REGISTRATION

Those who apply to register a colour must show that the colour has acquired distinctiveness and that it is not ‘functional’. In the case of Owens-Corning’s pink insulation it was determined that the colour had acquired a secondary meaning that linked it to the manufacturer. The colour had been used for 29 years, over \$42 million had been spent in advertising, and a survey had demonstrated 50% consumer recognition [6]. The

colour's only role was identification. The meaning of 'pink' to identify the fibreglass insulation is a product of culture. Identification is not a 'function' as that term is understood in this context.

Colours can be termed 'functional' on various grounds [7]. Colours are functional if they are descriptive or symbolic in any way, or if they have a form of aesthetic or decorative value. Fruit flavoured candies are manufactured by Life Savers Corporation as well as by Curtiss Candy Co and both market mixed flavoured candies in packs striped in colours to represent the different flavours. The claim by Life Savers that the use of a striped package by Curtiss amounted to trademark infringement was disallowed. The colours of the stripes were descriptive of the flavours, so the colours were functional. [8]. There were also no winners in another case where the colour black was judged to be functional. Mercury and British Seagull both produce marine outboard motors. The motors are predominantly black which has the effect of reducing the apparent size of the motors. And black can look good with any colour of boat [9].

John Deere is not able to register green alone for agricultural equipment because green is functional in that it symbolises vegetation, but it was possible to register the combination of green and yellow. Colour combinations came under the protection of trademark law in China in 2001. The first case involving infringement of a trademark in this category was won by John Deere when they sued Jotec International Heavy Industry [10]. In 2014 John Deere won a similar case in India where farm equipment, in the same green and yellow colour scheme, was being marketed under the name *Surindera* [11].

### REQUIREMENTS FOR REGISTRATION

When it was decided that a 'colour per se' could be registered as a trademark no definition of 'colour per se' seems to have been considered necessary. Of more concern for those interested in the registration of colours as trademarks is not the question of *what* it is that is to be registered but *how* it is to be registered.

It is common to conflate two meanings for the word 'colour' – colour as a physical property of an object or substance, and colour as the visual experience of looking at that object or substance. Physical property and visual experience are clearly related, but they are not the same thing. It is much easier to protect a substance than the appearance of that substance. The patent that William Henry Perkin took out in 1856 to protect his invention of a new dye was for the dye itself as a substance and for the process of its manufacture [12]. Then the name 'mauve' came to be used interchangeably for the dye itself and for the appearance of dyed garments. While the patent protected the substance it did not protect the appearance and there was nothing to prevent a rival from achieving the same appearance with another process. And the value lay in the appearance. The same is true in the case of a colour trademark. It is the appearance that matters. The means used to produce the colour is immaterial, it is the appearance that carries the meaning and that is what needs to be protected.

There are guidelines for making an application to register a colour. The colour must be represented graphically in a way that satisfies the 'Sieckmann Criteria': the representation must be 'clear, precise, self-contained, easily accessible, intelligible, durable, and objective.' [13]. These requirements are typically satisfied by attaching a colour sample from the Pantone system.

### COLOUR ELASTICITY

An advantage of the colour sample is that it can be placed against the colour used by a competitor to establish whether or not the trademark has been infringed, but this raises further questions. The appearance of a physical sample will vary, especially under different conditions of illumination. Figure 1 shows a model that was made from a sheet of Letracolor paper designated Pantone 251. It has been photographed in daylight and under tungsten light. Not only do the different planes of the model appear lighter or darker as they reflect more or less light, but a change in the light source has also changed the hue to make the model appear more bluish or more reddish. Monica Billger uses the word 'elasticity' for the way "a specific coloured material can vary in appearance under different specified conditions." [14].

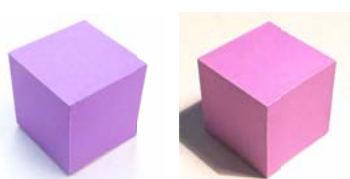


Figure 1: The same model



Figure 2: Samples of Pantone

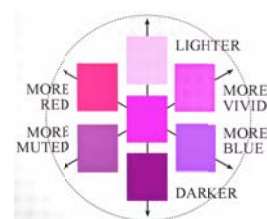


Figure 3: Representation

*photographed in daylight (left)  
and tungsten light.*

*Process Magenta and 676C  
in different orientations*

*of a ‘bubble’ in colour space  
round Process Magenta*

To be successful as a trademark a colour must be recognisable in different situations, so if it is established by a physical sample the trademark protection must cover the range of appearances that can be expected when that sample is seen under different conditions.

### ESTABLISHING THE BOUNDARIES

The ruling in the case of T-Mobile vs Aio Wireless brings this issue into focus [15]. Pantone Process Magenta was claimed as a trademark by T-Mobile and the company objected to the use of Pantone 676C by Aio Wireless. Aio Wireless may have argued that the two colours are sufficiently different that there would be no risk of confusion, but the colours are very similar in hue, and hue is the dimension of colour that plays the most significant role in establishing identity. While Pantone 676C clearly appears darker and less vivid when the two colour chips are placed side by side, this difference all but disappears when the Pantone Process Magenta chip is tilted to be seen in shadow. This can be seen in figure 2. The judge in this case may or may not have considered this, but she was still satisfied that the colours were too similar and she ruled in favour of T-Mobile. If she relied on her subjective assessment of the degree of similarity then that would have been against the spirit of the Sieckmann criteria. Although the Pantone chips themselves satisfy the criterion that a representation should be objective, judgement of their relative appearances is likely to be subjective.

If the judgement in favour of T-Mobile means that Pantone Process Magenta and the darker Pantone 676C are both protected there would be other colours, that are also similar to Pantone Process Magenta, that should be included. There will be colours that are lighter, more or less vivid and of slightly different hue. This range of appearances would occupy a ‘bubble’ in colour space. At the centre of this bubble would be the colour sample. Such a bubble is illustrated in figure 3. So it is not a single colour but the range of colour appearances contained within this bubble that would need protection.

It is difficult to establish the size of such a bubble with the Pantone system – you need a three-dimensional colour order system such as CIELAB which was adopted as an international standard in 1976. The positions of colours in CIELAB are determined by instrumental measurement and measured differences correspond to perceived differences. The unit of measurement for degrees of difference between colours in CIELAB space is known as ‘Delta E’ [16]. Research would determine how many units of Delta E would be needed to establish the size of the bubble that would be covered by the trademark. Then there would need to be additional space around the bubble that would be off-limits to competitors so that there would be no risk of one company’s colour being mistaken for that of another. This would make the bubble even larger and there is only room for so many such bubbles in colour space. The number of these bubbles would determine how many different companies could trademark a colour for a given class of goods or services.

### LIMITED AVAILABILITY OF COLOURS

As part of an investigation into the limits of colour coding I devised a ‘colour alphabet’ that could be used to spell out words as sequences of coloured rectangles [5]. The colour alphabet is shown in figure 4.



Figure 4: Colours assigned to each letter of the alphabet that can replace the letters to spell out words

After learning this ‘alphabet’ I found that I could read a poem – but only just, and I did make mistakes. The first line of Shakespeare’s sonnet 109 is shown in figure 5 with the letters represented by the colours of the colour alphabet.



Figure 5: The first line of Shakespeare’s Sonnet 109 rendered in colours, each colour representing a letter of the alphabet. “O never say that I was false of heart”

The coloured rectangles, that represent the letters in the poem, can be seen as equivalent to packages on the shelves of a supermarket. If I can read the poem, customers should be able to identify the product brands. But the fact that I did make mistakes suggests that customers might still pick up the wrong package. There are 26 letters in the alphabet. The number of different colours that could reliably differentiate product brands is probably less than 26. But, even if that number does represent the largest number of colours that could be registered for a given category of goods or services, there is still not much room for competition. The registration of new colours leads to ‘colour depletion’. This is a strong argument against allowing new colours to be trademarked.

## CONCLUSION

The resolution that it is possible to register a single colour as a trademark has been controversial. The prospect of colour depletion is seen as an impediment to fair competition. But the precedent has been set. To protect the marketplace from all but the most reasonable claims the bar needs to be set very high. There are two main lines of defence: the need to demonstrate that a colour has acquired ‘distinctiveness’ and the ban on colours that are deemed to be ‘functional’. Owens-Corning were able to support their application with solid evidence, and that should be a benchmark, but it is clear from cases that have come before the courts that this is a rich field for legal argument. The effortless nature of everyday visual experience masks the elusive complexity of colour. Legal debate would benefit from more sophisticated concepts. Research is needed to establish the range of colours around a proposed trademark that would need protection. A physical sample, from Pantone or any other recognised system, should still be submitted with an application for registration. That sample should then be measured and located in CIELAB space with the protective bubble around it marked out in units of delta E. This would satisfy the Sieckmann criterion that the application should be objective. Further research, more rigorous and focussed than the colour alphabet project, could then establish how many colours might be available as trademarks. That number, supported by solid evidence, would reinforce the warning about colour depletion.

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