

COLOUR MARKS

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1 INTRODUCTION

This chapter is concerned with the registration of colour and coloured marks and the registrability of such marks.

2 RELEVANT LEGISLATION

Trade Marks Act (Cap. 332, 2005 Rev. Ed.)

Interpretation

2. —(1) In this Act, unless the context otherwise requires —

...

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof;

"trade mark" means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

Absolute grounds for refusal of registration

7. —(1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in section 2(1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

3 CONCEPTS OF COLOUR AND COLOURED TRADE MARKS

There are various ways in which colour(s) may play a role in trade marks.

(a) A colour, by itself or in combination with other colour(s) as a trade mark

This is a case whereby the applicant is claiming rights to the colour(s) per se (that is, colour without limitation as regards shape, extent or presentation) as applied to the goods themselves or as an aspect of packaging which is used as a trade mark, example, a particular coloured wrapper or box used to cover the goods.

(See Chapter on “What is a trade mark?” on how to graphically represent colour(s) as a trade mark.)

(b) Colour limitation

This is a limitation of the right in the trade mark to particular colour i.e. the applicant is claiming rights to a word or device or combination of word and device in particular colour(s) only and no rights are conferred to the applicant of the same word or device or combination of word and device in other colour(s).

A precise and unambiguous representation of the trade mark in the colour(s) used is needed. An acceptable description to accompany the application will be “The trade mark is limited to the colour(s) green and blue as shown in the representation of the application form”. As such, the rights of the owner will be limited. Colour limitation is to be done on a voluntary basis by the applicant.

Where the mark is originally filed without colour limitation, it is not possible for the applicant to subsequently volunteer such a limitation (see UK Court of Appeal in *Société Des Produits Nestlé SA v Mars UK Limited [2004] EWCA Civ 1008 (also known as Polo Mint case)*). (Please refer to the Chapter on “What is a trade mark?”).

(c) Colour(s) in combination with other features

This is essentially a pictorial, figurative or word mark incorporating colour or colours. A claim that colour is a feature of the mark is not necessary. Once a coloured representation is attached to the application form, the Registrar will treat the colour(s) as a feature of the trade mark. No colour limitation is needed. The mark will be examined in the colour(s) as filed without any clause needed.

Should the applicant insert a description or clause that certain colour(s) are claimed as a feature or component or element of the mark in the application form, the Registrar will clarify with the applicant what the applicant intends and may require the applicant to delete the description if it is not the applicant’s intention to limit the mark to the colour(s) as filed. Colour identification codes will **not** be required for these types of marks, because tonal differences are unlikely to have any material bearing on

the identity of the subject matter of these types of trade mark, but will be recorded if filed.

(d) Black-and-white representations

Where the graphical representation of the mark is in black and white, it means that use of the mark in colour(s) is neither claimed nor disclaimed. Therefore, the mark is taken to have been used regardless of whether it appears in colour(s) or it appears in black-and-white as long as the representation conforms to the template or pattern of the mark as registered.

4 A COLOUR, BY ITSELF OR IN COMBINATION WITH OTHER COLOUR(S) AS A TRADE MARK

(a) Graphic representation

(See Chapter on “What is a trade mark?” for how to graphically represent colour(s) per se marks.)

(b) Difficulties in registering colours per se as a trade mark

A colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of a trade mark. However, in assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought (see *Libertel (C-104/01)*).

This is an important public policy reason for not registering colours as a trade mark. This same public policy ground was applied by The Federal Court of Australia in *Philmac Pty Limited v The Registrar of Trade Marks [2002] FCA 1551* (where the colour Terracotta was the subject of the application). Justice Mansfield was of the view that, if an applicant for a trade mark were to monopolise red in all its shades, the next manufacturer may monopolise orange in all its shades, and the next yellow in the same way, the range of colours left would be very limited for the rest of the traders.

In addition, it may be difficult to satisfy the requirement that the colour in question or the combination of colours in question has the necessary distinctive character without prior use in relation to any goods or services. This is because, the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the relevant consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from those of others.

“The perception of the relevant public is not necessarily the same in the case of a sign consisting of a colour per se as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods it denotes. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the look of the goods in respect of which registration of the sign as a trade mark is sought. 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. A colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking.” (see *Libertel, paragraph 65*)

Thus, given that colours are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message as to origin, and given that consumers are not in the habit of making assumptions about the origin of goods and services based solely on their colours or the colours of their packaging, it is at first glance difficult to register colours per se as trade marks. Thus, registering colours per se as a trade mark is more an exception rather than the rule. One category of exception is where the colour/colour combination is exceptionally unique or unusual (eg the colour is not a basic or primary colour) for goods/services which are very restricted and the relevant market is very specific).

*“The fact that registration as a trade mark of a colour per se is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of a particular case, to assessing both the distinctive character of the colour in respect of which registration is sought, and whether its registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.” (see **Libertel, paragraph 71**)*

Colour per se marks may also be objectionable for one of the following reasons:

(i) Colours which serve a function

Where the colour or colour combination may be seen by the average consumer as serving a function, it will not be capable of serving as an indication of origin. Colours will be functional where:

- **They provide a particular technical result**

Some colours produce (either physically or chemically) an effect and thereby improve the functionality or durability of the product. For example, the colour black for solar power collectors and associated piping (because of heat absorption) or the colour silver or white in situations where heat or light reflection is required such as building insulation sheeting for roofing tiles.

- **They convey a generally accepted meaning**

Some colours may convey a recognised meaning. For example, red for heat or danger and green for environmentalism. Another example would be goods such as paints. For such goods, a single colour or even a colour combination is unlikely to be accepted as paints are naturally denoted by their colours.

(ii) Colours which are common to the trade

Colours which are commonly used in the industry or trade are not distinctive. Colours will be common to the trade where:

- **They are the natural colour of goods**

Some colours are the naturally occurring colour of the product or the result of the manufacturing process. For example, the colour terracotta for roof tiles or pots or the natural colour of hemp rope or seagrass matting. If so, they are not registrable because consumers would not be able to distinguish the goods of the trade mark owner from those of other producers whose goods are of the same colour.

- **Goods in a market in which there is a proven competitive need for the use of colours**

If there is a competitive need for the use of colour in the market concerned, and having regard to the colour chosen and the goods on which it is sought to be registered, other traders may naturally think of the colour and use it in a similar manner in respect of their goods, the colour is also not registrable as a trade mark. For example, registration of two or more colours for goods such as clothing or cars, which normally come in colours, is unlikely to be accepted on a prima facie basis as colours for such goods are not usually regarded as indications of source.

(c) Acquired distinctiveness

Even if the colours per se is not prima facie distinctive, it may acquire distinctiveness in relation to the goods or services claimed following the use made of it. “That distinctive character may be acquired, inter alia, after the normal process of familiarizing the relevant public has taken place. In such cases, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.” (see *Windsurfing Chiemsee v Boots (Case 108/97)*, paragraph 49). It is to be noted that the evidence must show use of the mark as a trade mark.

In assessing the “use” of a colour or combination of colours as a trade mark, the Registrar will look for evidence whether the applicant has been promoting the colour(s) as something apart from the goods or their packaging. Mere entries in catalogues or brochures showing pictures of the goods in the colour(s) claimed may not be sufficient, even if the applicant is able to show many years of such material.

(See Chapter on “Evidence of distinctiveness acquired through use” for more on acquiring distinctiveness for colour marks.)

Further guidance can be found from UK Opposition Case O-148-03, concerning an application by *Alexander Duckham & Co* to register the mark “*The mark consists of the colour green as added to and integrated with the goods covered by the*

registration, which as a result are wholly and inseparably coloured green as defined by Pantone No 3435.”. The hearing officer in rejecting the case of acquired distinctiveness said as follows:

“A mark that is said to have acquired a distinctive character must be shown to have come to operate as a guarantee of origin. For that to be so, consumers must rely upon it as a means of returning to the same undertaking if their experience of its products is positive, or to avoid that undertaking if their experience is negative.

I am not suggesting that the applicant must necessarily have used the mark as the only means of identifying the trade origin of the product. There is no rule that two or more trade marks cannot operate alongside each other....A trade mark should not therefore be regarded as having acquired a distinctive character in circumstances where (after discounting the distinguishing effect of other marks) it could not be presumed that confusion would occur even if a third party used an identical sign for the same goods. And this cannot be presumed if, in practice, the public place no reliance on the mark.

The requirements for securing protection under the proviso to section 3(1) therefore appear to me to be that:

- a) the mark must have been used by an undertaking as a means of identifying the trade origin of the goods;*
- b) the effect of this use is that the relevant public (or a significant proportion thereof) have come to rely upon the mark, in the course of trade, as a means of identifying the trade origin of the goods*
- c) if the mark is but one of a number used by the undertaking to identify the trade origin of the goods, the competent authority must be satisfied that the mark applied for has, by itself, come to foster a concrete expectation amongst the relevant public that goods bearing that mark originate from, or under the control of, a single undertaking.”*

Example

Singapore Registration No. : T99/04253H
Applicant : BP P.L.C.
Date of application : 27 April 1999



The mark was applied for in relation to business services relating to aviation and automotive fuel and related services.

The mark was described as consisting of the colour green as applied to the exterior surface of the premises used for the provision of the services.

The mark was found to be acceptable as the Registrar was satisfied that, through substantial use as a trade mark and the effort of the applicant in promoting the colour green as a badge of origin, consumers have come to rely on the colour as a means of identifying the source of the services sought for registration.

(d) Two or more colours

A combination of two or more colours may be registrable *prima facie* depending on how unusual the colour combination is in relation to the goods and whether, *prima facie*, the combination is likely to strike the relevant consumer as an indication of trade source. This would also involve a consideration of whether the colours serve a function or is common in the market place or relevant trade.

(i) For goods

Registration of two or more colours for goods such as clothing or cars, which normally come in colours on a *prima facie* basis, is unlikely as colours for such goods are not regarded as indications of source. Where colour is the nature of the products (such as paints), two colour combinations will also not be registrable on a *prima facie* basis.

As with single colours, additional objections under Section 7(1)(c) and (d) may apply.

Example

Singapore Application No. : T00/10524I (abandoned)
Applicant : Koninklijke Philips Electronics N.V.
Date of application : 16 June 2000



The mark was applied for in relation to electrical appliances.

The mark was described as: The mark is a colour mark. The rectangular and square shapes of the representation are not part of the distinctive elements of the mark. The mark consists of a combination of the following colours: Ivory:RAL 1015; Pearlblue: Pantone 5435 and Zinc Brown: Pantone 409.

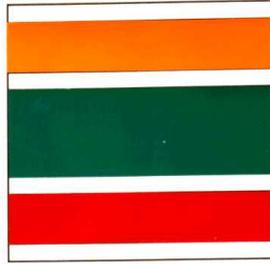
As consumers will not immediately identify the combination of colours as an identifier of source, the mark would not have been acceptable prima facie. However, if the applicant can show that through substantial use as a trade mark and the effort of the applicant in promoting the colour combination as a badge of origin, consumers have come to identify the colour combination itself as an identifier of the source of the products, the mark may be accepted on the basis of acquired distinctiveness through use. There would also be the issue of whether the mark has been represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

(ii) For services

Colour marks for services are treated in the same way as colour marks for goods.

Example

Singapore Registration No. : T99/06795F
Applicant : 7-Eleven, INC.
Date of application : 1 July 1999



The mark was applied for in relation to retail services of a convenience store.

The mark was described as: The trade mark consists of three horizontal stripes in the colours orange, green and red on a white or neutral backdrop, as shown in the representation of the trade mark on the form of application.

The Registrar was satisfied, after reviewing the evidence of use, that the said unique colour combination, has acquired distinctiveness of the applicant's convenience store services. That is, through substantial use, consumers have come to identify the said colour combination as identifying that the services originate from the said applicant/proprietor and no other.

5 RESEARCHING COLOUR TRADE MARKS

Research will have to be done by the examiner to determine if the colour is common to the trade or is used in a functional manner within the particular industry.