

Old colour, new mark

Time is of the essence in formulating a strategy to strengthen the protection of colour marks in Italy. Consistent use of a specific shade over time can prove that the mark has become distinctive on the market

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Colours can frequently establish a strong association with a company and are thus valuable tools with which to establish or enhance the connection between new lines of products or services and the existing goodwill stemming from an established brand value or corporate identity. Section 7 of the Italian IP Code states that “combinations of chromatic shades may be subject to trademark registration”. Further, the European Court of Justice (ECJ) has confirmed that it is possible to register “a colour *per se*” as a Community trademark, provided that it is “clearly and precisely defined” as a particular shade of a given colour, and with regard to a specific group of products (hereinafter the expression “shade of colour” is used to refer collectively to these specifications).

Protecting a shade of colour in Italy: opportunities and threats

However, the available means of protection are not always properly considered and exploited. In the Italian market, a significant number of enterprises have been using shades of colour to distinguish their products or product lines for decades without ever bothering to apply for trademark registration while some may

recently have taken steps in this direction, this is often only out of fear that a competitor will poach their brand identity). Nonetheless, the (often significant) investments that these enterprises have made in consistently using a shade of colour will not go unprotected.

The Italian courts have ruled that a particular shade of colour which distinguishes the products or activities of a company in the relevant market can be protected against imitation, and consequently that a competitor’s imitation of the shade of colour consistently used by the company to distinguish its products or activities may amount to infringement of an unregistered trademark and to an act of unfair competition. A peculiarity of the Italian system is that these two grounds for protection have the same prerequisites, which are examined further below.

Even if a colour is successfully registered, the trademark owner is often caught in the crossfire in the form of invalidity main or cross-claims. Infringers are well aware that the courts are often reluctant to grant broad protection to colours, as they struggle to strike a balance between a request to uphold a monopoly and the general interest not to restrict unduly the availability of limited resources, such as colours.

Applicants and prospective applicants are therefore required to take certain steps in order to ensure that their distinctive (unregistered) colours are suitable for protection and enforceable against infringers. This article considers how the use of a given shade of colour may consolidate distinctiveness for trademark purposes and the steps that a trademark applicant/owner should take in order to strengthen its position against infringers.

Claiming protection on an unregistered shade of colour

The principal hurdle that a company using a particular shade of colour to identify its business must overcome in order to enjoy unregistered trademark protection is to demonstrate that the colour concerned is suitable *per se* for protection against imitation. The Italian courts refer to ECJ case law in order to establish principles to judge whether and in what cases a shade of colour can be protected as a registered and unregistered trademark. Pursuant to the ECJ's *Libertel* ruling (6th May 2003, Case C-104/01, *Libertel Groep BV v Benelux-Merkenbureau*), a colour qualifies as a trademark if it is "clearly and precisely defined" as a particular shade of a particular colour and with regard to a specific group of products. A sample of colour is not, on its own, an acceptable graphic representation (as in certain cases it may deteriorate with time and thus may not have the necessary durability). By contrast, a verbal description of a colour mark or a combination of a verbal description and a colour sample may, depending on the circumstances, constitute an acceptable graphic representation.

Significantly, the ECJ noted that internationally recognised colour identification codes (eg, Pantone) are a precise and stable form of verbal description. The barrier to achieving protection for an unregistered colour sign is therefore high, but not insurmountable. In the vast majority of cases, registration will be achieved only if the evidence of distinctiveness acquired through use is convincing. The burden of proof to substantiate such consistent quality of "use" of a particular and clearly defined shade of colour can be discharged in many ways, such as by demonstrating that the same shade of colour has been consistently used for a long time in connection with the relevant product lines, packaging and/or corporate communications (including the company website and institutional advertising). Any reference to the fact that the shade of colour concerned is protected against passing off by the law or, even better, by cease and desist letters against significant competitors claiming the unauthorised use of that shade of colour will reinforce the ability to prove consistency. Conversely, in connection with this requirement, the applicant must avoid varying the shade of colour for different products or for the same product over time.

Consistency is key is establishing a

colour trademark and implies the use of the same shade of colour for and on every product line and within the same product line. Applicants should also take care to prevent undesired inconsistencies – for example, by testing the shade of colour concerned on different materials or fabrics, because light reflection or the shape, texture, thickness or other features of the products, packaging and display materials may accidentally alter the perception of the colour concerned.

To meet the evidence of distinctiveness, the applicant must persuade the examiner or court that the shade of colour has become distinctive of its business in the relevant market in the minds of the relevant public (ie, it has acquired a secondary meaning). Pursuant to Italian case law, an (unregistered) sign is deemed to have acquired a secondary meaning if it identifies the product or service to which it is applied as originating from a particular company, and distinguishes the products or services concerned from those of competitors. The Italian courts undertake a case-by-case analysis of this phenomenon. However, the elements usually considered in assessing whether a sign has acquired distinctiveness in the relevant market are as follows:

- The length of time for which the shade of colour has been used in connection with the owner's products and activities.
- The use of the same shade of colour for all or certain (bestselling) products or services of the applicant.
- The uniform use of the same shade of colour in advertising campaigns and/or corporate communications (here the size of relevant investments and the applicant's ability to provide evidence thereof will play a significant role).
- The market share held by the product lines or products distinguished by the shade of colour.

Shields against cross-claims

It is difficult for a (registered or unregistered) colour mark owner to seek protection against a well-prepared infringer. The owner should take timely steps to ensure it is in a position to rebut potential cross-claims and minimise the risk that a negative precedent set by the Italian courts may undermine the protection of the colour mark.

The infringer will most likely challenge the distinctiveness of the colour mark by arguing that it is commonly used in the relevant market for the relevant class of products (eg, any shade of white for soaps

or personal care detergents). Alternatively, it may argue that the shade of colour does not identify the business of the owner, and that the way in which it has been used has varied significantly over time. The owner should be able to demonstrate that clear and distinctive reference to the shade of colour has consistently been made over time on products and packaging, and in advertising campaigns and corporate communications, in order to strengthen in the minds of the public the link between the shade of colour concerned and the owner's business.

Further, the owner should be able to persuade the court that the use of a similar colour would likely create confusion in the relevant market. The test for confusion is passed if, as a result of the similarity between the owner's shade of colour and a competing colour, an ordinary consumer would either confuse the two products or be led to believe, in the absence of direct confusion, that both products originated from the same source.

The infringer will likely challenge this by arguing that the similarities between the two colours will not cause confusion

because colour does not predominate in forming the overall impression created by the products concerned, pointing to other distinctive elements such as brand name and logo. The owner's ability to identify the shade of colour as the key element that leads consumers to choose the products concerned will thus be of paramount importance. The results of market research, focus groups and other marketing analysis consistently carried out over time and providing focused qualitative and quantitative feedback will prove valuable in this regard.

The time factor

Overall, a successful strategy to reinforce the protection of colour marks in Italy should consider time as a critical factor. On the one hand, consistent use over time allows the shade of colour to emerge as a strong feature of the owner's identity. On the other, if the owner deliberately monitors the market, time offers the tools with which to counter attempts at infringement of the colour mark, which can be promptly stopped through appropriate legal action. **iam**



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