



PROTECTION OF COLOUR/COLOR TRADE MARKS

AN INTERNATIONAL PERSPECTIVE

White Paper
July 2026

Intellectual Property Owners Association (IPO)

International Trademark Law & Practice Committee

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FOREWORD

It is my privilege to present this White Paper on behalf of the Intellectual Property Owners Association (IPO) and the International Trademark Law & Practice Committee. This work reflects the collective expertise, thoughtful deliberation, and sustained commitment of the Committee's members in addressing complex and evolving issues in international trademark law.

The IPO is a premier trade association serving the intellectual property community. As a voice for IP owners, IPO advocates on behalf of its members for effective IP rights. IPO's members include intellectual property owners and private practitioners in all industries and fields of technology, and the Association provides networking, professional development, continuing legal education, and other valuable resources while advocating for reliable IP protection.

Within IPO, the International Trademark Law & Practice Committee plays a valuable role. Comprising trademark professionals from around the world, the Committee supports IPO's mission by examining current issues and policies in trademark law and practice across jurisdictions, developing practical resources for members, and by contributing to continuing legal education of IPO members. The Committee's international membership enables it to produce comparative analyses like this White Paper, building on a tradition of similar resources that assist IP owners in navigating cross-border challenges.

The focus of this report—colour marks as a form of non-traditional trademark—is both timely and consequential. As brand owners increasingly seek to differentiate their goods and services in a crowded global marketplace, the ability of colour to function as a source identifier has taken on heightened importance. At the same time, the legal treatment of colour marks continues to vary across jurisdictions, presenting both opportunities and challenges for practitioners and rights holders operating internationally.

Against this backdrop, this White Paper offers a comprehensive, jurisdiction-by-jurisdiction examination of the current legal landscape. By bringing together insights from practitioners around the world, it provides a practical, comparative resource grounded in experience, research, and professional judgment. In doing so, it aims to promote greater clarity, consistency, and informed decision-making in the protection and enforcement of colour marks globally.

As Chair, I have had the benefit of observing firsthand the depth of engagement and collaboration that shaped this work. I extend my sincere appreciation to the members of the Committee, whose diligence and intellectual rigor made this paper possible, as well as to the many contributors and reviewers who provided invaluable perspective throughout the drafting process.

We anticipate that this White Paper will serve as a valuable resource for practitioners and trademark owners navigating cross-border issues, and that it will contribute meaningfully to ongoing dialogue in this dynamic and developing area of law.

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As Chair of the International Trademark Law and Practice Committee

ACKNOWLEDGEMENTS

The International Trademark Law & Practice Committee of the Intellectual Property Owners Association (IPO) extends its sincere thanks to all the contributors for generously sharing their knowledge and experience. Their collective expertise has made this comprehensive resource possible.

The Committee thanks Dr. Victoria Longshaw of Houlihan Intellectual Property, Vice Chair of the Committee, who served as Editor of this paper. Victoria conceived the project and guided it from inception to completion: drafting the survey questions, liaising with contributors, collating all contributions, and reviewing, editing, formatting and amending the manuscript through drafting rounds.

We also extend our sincere thanks to Ms. Makiko Coffland of Christensen O'Connor Johnson Kindness PLLC, Secretary of the Committee, for her valuable organisational support throughout the project.

Additional appreciation goes to Ms. Angela Pei Heng Li of Counsel at Apple, Inc. and a Committee member, for her helpful line editing contributions on specific sections, which enhanced the clarity of the manuscript. Ms. Nolene Treloar of Adrian M Trioli Intellectual Property is also acknowledged for suggesting Question 8 of the survey.

Artificial intelligence tools were used by some contributors during the research and initial drafting phases of their jurisdiction-specific responses. These tools assisted with gathering background information, summarising legal developments, and generating preliminary text. However, every contribution has been thoroughly reviewed, verified for accuracy against primary legal sources, collated, and edited under the direction of the Editor. All final content reflects the professional judgment, expertise, and approval of the individual contributors and the Editor.

INTRODUCTION

Colour Marks represent a distinct category of non-traditional Trade Marks. In contrast to conventional word, logo, or device Marks, a Colour Mark consists of one or more specific colours, without any accompanying figurative or textual elements. When used in relation to Goods or Services, the colour itself serves as the badge of origin, indicating the commercial source to the relevant public.

The recognition of Colour Marks as registrable non-traditional Trade Marks is a relatively modern development in Trade Mark law. Although colours have long been used in commerce to distinguish products, it was not until the latter part of the twentieth century that Courts and Legislatures in major jurisdictions began to accept colours, standing alone, as capable of functioning as Trade Marks.

Since those early Colour Marks gained formal recognition and protection, a substantial body of jurisprudence has developed across jurisdictions. Issues relating to registrability, graphical representation, acquired distinctiveness, functionality, scope of protection, and enforcement have been examined and refined through landmark decisions, legislative reforms, and evolving administrative practice.

This White Paper is the result of a unique international collaborative effort. Trade Mark professionals practising in jurisdictions around the world have generously volunteered their time and expertise to respond to a detailed series of questions addressing the current legal position on Colour Trade Marks in their respective territories.

The aim of this White Paper is to serve as a practical and up-to-date reference for owners and managers of global Trade Mark portfolios that include Colour Marks. By presenting a comparative overview in a consistent format, it enables brand owners, in-house counsel, and external advisers to evaluate registrability and enforcement prospects efficiently, to identify potential risks, and to develop coherent international protection and enforcement strategies.

It has been a privilege to work on this project in my capacity as Vice Chair of the Committee on International Trade Mark Law and Practice of the Intellectual Property Owners Association (IPO). In that role, I conceived the idea of the project, drafted the survey questions, collated the contributions from participating attorneys into a manuscript, and formatted and edited the final text of the manuscript.

This White Paper will be published by the IPO and will form part of its library as a valuable resource for members of the IPO. Feedback and suggestions for future updates are most welcome as the global landscape of non-traditional Trade Marks continues to evolve.

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As Vice Chair of the International Trade Mark Law and Practice Committee

ARGENTINA

Contributor: Mr. Federico Aulmann of Obligado & Cia

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Single Colour Trademarks: According to Argentine Trademark Law 22362 Article 1, combinations of colours applied to a specific part of the goods or their packaging can be registered as a Trade Mark.

Furthermore, Article 2 establishes that the natural or intrinsic colour of the goods, or a single colour applied thereto, is not registerable as a trademark since it is not considered to be a trademark.

Although the rule that emerges from the above-mentioned regulation of Argentine Trademark Law is that combinations of colours are protected but a single colour is not, Trademark Law implementing decree 242/2019 (enacted after the Argentine Trademark Law amendment by law 27444 of June 2018) established an exception to the exclusion of registrability or article 2, by allowing registration of cases in which the sign—including the shape and colour for which registration is sought—has acquired distinctiveness. Therefore, a new pathway was opened for the registration of a single colour trademark applied to a product, where it can be proven by evidence that the single colour has acquired distinctiveness by intensive and prolonged use, that the relevant public recognizes the single colour as an indication of commercial origin, and where there is evidence of substantial advertising investment and marketing efforts relating to the acquired distinctiveness.

If a trademark application for a single colour applied to a product in a specific part of the product is filed at the Argentine Trademark Office (INPI – Instituto Nacional de Propiedad Industrial), it is highly probable that an office action will issue objecting to the trademark application and requiring further evidence of the acquired distinctiveness of the trademark for which registration is intended.

Combination of Colours: The registrability of a combination of colours as a type of

trademark is specifically considered in Argentine Trade Mark Law (Article 1) which states: *“may be registered as trademarks to distinguish goods and services: ...; combinations of colors applied to a specific part of the goods or their packaging;...”*. This provision was included in the Trademark Law decades ago, and required that the combination of colours must be applied to a specific part of the product, and that the same should have distinctiveness for registration to be granted.

Although the trademark law establishes that the combination of colours should be applied to specific parts of goods or packaging, Argentine Trademark Office practice has allowed combination of colours to be registered in cases where no information on the specific parts of goods or packaging was provided, only the combination of colours. There is also a case of a product with a particular shape that claimed to be blue (a blue pill) that was also registered.

There are several examples of registered trademarks for combinations of colours that were allowed by the Argentine Trademark Office, some as part of a product, some as part of packaging, as well as combinations of colours without specific application to a particular part of a product, which were allowed for several years.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

Application formal requirements for colour trademark applications: When filing a trademark application that contains a combination of colours (or a colour) applied to a product or packaging as part of the trademark, an example of the trademark with its colours applied thereto as claimed should be provided.

The same can be a graphic representation of the location of the combination of colours (or colour) in the product or packaging, either in a black and white representation with the identification of the colours that are applied in each part, or as a colour representation of the trademark in a .jpg file.

The colour/s can be identified using the colour/s names or by its pantone identification, or by submission of a colour graphic representation of the trademark.

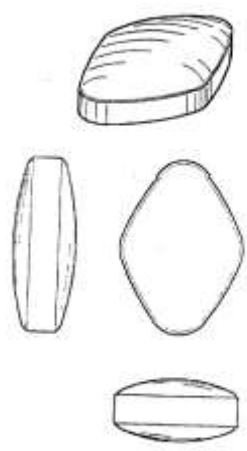
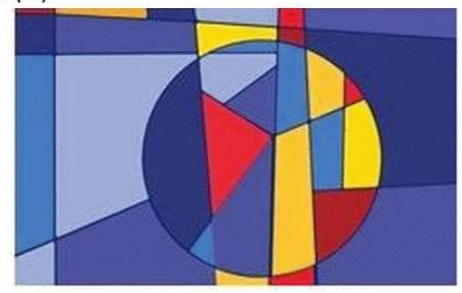
- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

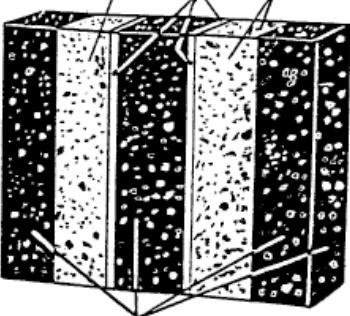
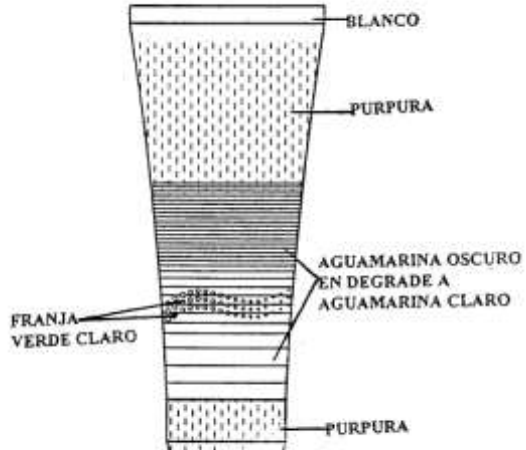
Evidence of acquired distinctiveness: When the Argentine Trademark Office issues an office action objecting to the trademark application due to lack of distinctiveness, whether the trademark is a combination of colours applied to a part of a product or packaging, or a colour applied to a part of a product, evidence of intensive and prolonged use, that the relevant public recognizes the colour combination (or the single colour applied to a part of a product) as an indication of commercial origin, and of substantial advertising investment and marketing efforts relating to the trademark are useful for responding to the office action and supporting an argument of acquired distinctiveness.

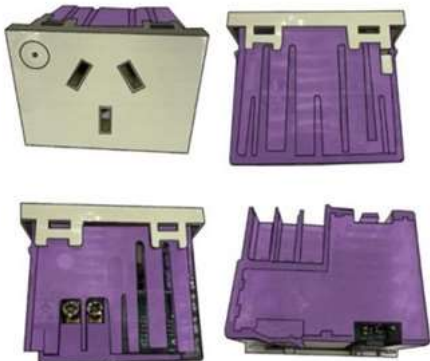
2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

The following list are trademark registrations that have been allowed by the Argentine Trademark Office:

(21) Acta 2.161.787 - (51) Clase 6 (40) F (54)  - DISEÑO EN COLOR AZUL (23) 10/07/1998 - (73) PIZZER INC. - US (57) TODA LA CLASE (74) Ag 195 - (4409/09/1998	(21) Acta 4072208 - (51) Clase 30 (40) M (54)  CONFORME DISPOSICIÓN M NRO. 222/19 LA REPRODUCCIÓN DE LA MARCA EN EL TAMAÑO INGRESADO PARA SU REGISTRO PUEDE SER CONSULTADA EN EL SIGUIENTE ENLACE https://portaltramites.inpi.gob.ar/ (22) 15/11/2021 19:24:05 - (73) KRAFT FOODS SCHWEIZ HOLDING GMBH - CH * (57) SOLAMENTE BIZCOCHO DE CHOCOLATE Y NUECES; CHOCOLATE; GALLETAS; MOUSSES (CONFITERIA); PRODUCTOS DE PASTELERIA; CACAO; TE; CAFE; BEBIDAS DE CACAO; BEBIDAS DE CHOCOLATE; BEBIDAS A BASE DE CHOCOLATE; BEBIDAS A BASE DE TE; BEBIDAS A BASE DE CAFE Y PREPARACIONES PARA HACER ESTAS BEBIDAS; PRODUCTOS DE PANADERIA Y PASTELERIA; AZUCAR Y EDULCORANTES; GALLETTAS; PASTELES DE QUESO; TARTAS; GOFRES; BARQUILLOS; PRODUCTOS DE CONFITERIA, EN PARTICULAR DE CONFITERIA DE AZUCAR Y DE CHOCOLATE; CHOCOLATE PARA UNTAR; SALSAS DE CHOCOLATE; JARABES DE CHOCOLATE; JARABES AROMATIZANTES; PRODUCTOS DE CONFITERIA CONGELADOS Y REFRIGERADOS; HELADOS; POSTRES; POSTRES CONGELADOS; PASTELES CONGELADOS; PASTELERIA CONGELADA; PREPARACIONES CONGELADAS PARA HORNEAR; YOGUR CONGELADO; POSTRES REFRIGERADOS; PRODUCTOS DE PANADERIA; PREPARACIONES A BASE DE CEREALES; PREPARACIONES PARA HORNEAR; CEREALES PARA EL DESAYUNO; HELADOS; SORBETES; CONOS DE HELADO; PUDINES; PRODUCTOS DE APERTIVO EN FORMA DE PALOMITAS DE MAIZ Y PAPAS FRITAS DE MAIZ, CONFORME DISPOSICIÓN M NRO. 222/19 LA LIMITACIÓN DE PRODUCTOS/SERVICIOS COMPLETA PUEDE SER CONSULTADA EN EL SIGUIENTE ENLACE https://portaltramites.inpi.gob.ar/MarcasConsultas/Resultado?acta=4072208 (30) // 105268 - 20/10/21 - KZ (74) 1200 - (44) 12/01/2022
(21) Acta 4393119 - (51) Clase 36 (40) F (54)  CONFORME DISPOSICIÓN M NRO. 222/19 LA REPRODUCCIÓN DE LA MARCA EN EL TAMAÑO INGRESADO PARA SU REGISTRO PUEDE SER CONSULTADA EN EL SIGUIENTE ENLACE https://portaltramites.inpi.gob.ar/ (22) 09/08/2024 16:35:39 - (73) FLONTER S.A. - UY * (57) SOLAMENTE ACOMPAÑAMIENTO DE VIAJEROS;ALMACENAMIENTO DE MERCANCIA;ALQUILER DE AERONAVES;ALQUILER DE MOTORES PARA AERONAVES;FLETAMENTO;ORGANIZACIÓN DE SERVICIOS DE TRANSPORTE DE PASAJEROS PARA TERCEROS MEDIANTE UNA APLICACION EN LINEA;RESERVAS DE PLAZAS DE VIAJE;RESERVAS DE TRANSPORTE;RESERVAS DE VIAJES;SUMINISTRO DE INFORMACIÓN SOBRE ITINERARIOS DE VIAJE;TRANSPORTE AEREO;TRANSPORTE DE PASAJEROS;TRANSPORTE DE VIAJERO;TRANSPORTES AERONAUTICOS; (59) AZUL, CELESTE, AMARILLO, ROJO, VIOLETA Y NEGRO. (74) 204 579 - (44) 14/08/2024	(21) Acta 4393119 - (51) Clase 39 (40) F (54)  (22) 09/08/2024 16:35:39 - (73) FLONTER S.A. - UY * (57) SOLAMENTE ACOMPAÑAMIENTO DE VIAJEROS;ALMACENAMIENTO DE MERCANCIA;ALQUILER DE AERONAVES;ALQUILER DE MOTORES PARA AERONAVES;FLETAMENTO;ORGANIZACIÓN DE SERVICIOS DE TRANSPORTE DE PASAJEROS PARA TERCEROS MEDIANTE UNA APLICACION EN LINEA;RESERVAS DE PLAZAS DE VIAJE;RESERVAS DE TRANSPORTE;RESERVAS DE VIAJES;SUMINISTRO DE INFORMACIÓN SOBRE ITINERARIOS DE VIAJE;TRANSPORTE AEREO;TRANSPORTE DE PASAJEROS;TRANSPORTE DE VIAJERO;TRANSPORTES AERONAUTICOS; (59) AZUL, CELESTE, AMARILLO, ROJO, VIOLETA Y NEGRO. (74) 204 579 - (44) 14/08/2024

(21) Acta 1.688.355 - (51) Clase 3 (54) AMARILLO MARMOLEADO COLOR AMARILLO ORO MARMOLEADO  COLOR NEGRO MARMOLEADO (22) 21/04/1989 - (73) FENDI PROFUMI S.P.A. - ITL (57) JABONES PERFUMERIA ACEITES ESENCIALES COSMETICOS LOCIONES PARA EL CABELLO DENTIFRICOS (30) 1.495.681 - 26/10/1988 - FR (74) Ag 195 - (44) 31/5/89	(21) Acta 2.056.599 - (51) Clase 3 (40) F (54)  (22) 14/11/1994 - (73) FENDI PROFUMI S.P.A. - ITL (57) TODA LA CLASE (74) Ag 195 - (44) 22/12/1997
(21) Acta 3.381.002 - (51) Clase 2 (40) F (54)  (22) 19/01/2015 13:32:09.313 - (73) DONNANTUONI, JUAN CRUZ - AR * (57) TODA LA CLASE (74) Ag 1164 - (44) 05/08/2015	(21) Acta 4398198 - (51) Clase 11 (40) M (54)  (22) 22/08/2024 17:49:01 - (73) DP ARGENTINA S.A. - AR * (57) SOLAMENTE APARATOS DE ILUMINACIÓN; APARATOS DE PRODUCCIÓN DE CALOR; APARATOS PARA CALENTAR COLA (PEGAMENTO); BOMBILLAS DE ILUMINACIÓN; FORJAS PORTÁTILES; HORNOS CONTINUOS PARA SOLDAR; LAMPARAS CON REFLECTOR; LAMPARAS ELÉCTRICAS; LINTERNAS; LINTERNAS DE CABEZA; LINTERNAS ELÉCTRICAS; LINTERNAS RECARGABLES; PISTOLAS DE AIRE CALIENTE; (74) 1200 - (44) 28/08/2024
(21) Acta 3997254 - (51) Clase 11 (40) F (54)  CONFORME DISPOSICIÓN M NRO. 222/19 LA REPRODUCCIÓN DE LA MARCA EN EL TAMAÑO INGRESADO PARA SU REGISTRO PUEDE SER CONSULTADA EN EL SIGUIENTE ENLACE: https://portaltramites.inpi.gub.ar/ (22) 30/03/2021 17:34:38 - (73) DP ARGENTINA S.A. - AR * (57) SOLAMENTE APARATOS PARA CALENTAR COLA (PEGAMENTO); PISTOLAS DE AIRE CALIENTE; (74) 1200 - (44) 28/04/2021	(21) Acta 4537717 - (51) Clase 30 (40) T (54)  (22) 10/07/2025 12:28:00 - (73) GALBUSERA JULIAN JESUS - AR * (57) SOLAMENTE MIEL; MIEL NATURAL; (59) NARANJA Y AMARILLO (74) 1566 - (44) 16/07/2025

(21) Acta 4506710 - (51) Clase 21 (40) T (54)  (22) 13/05/2025 11:05:00 - (73) RACE IN S.R.L. - AR * (57) SOLAMENTE PAJILLAS PARA BEBER;RECIPIENTES ISOTÉRMICOS;RECIPIENTES PARA BEBER;RECIPIENTES TÉRMICOS PARA ALIMENTOS O BEBIDAS;TERMOS;VASOS [RECIPIENTES]; (74) 787 - (44) 28/05/2025	(21) Acta 4565840 - (51) Clase 9 (40) T (54)  (22) 29/08/2025 17:08:00 - (73) CAMBRE I.C.F.S.A. - AR * (57) SOLAMENTE ADAPTADORES PARA EL ACCESO A REDES INALÁMBRICAS;APARATOS ELÉCTRICOS DE CONTROL;ENCHUFES Y CONECTORES ELÉCTRICOS;INTERRUPTORES;REGULADORES [ELECTRÍCOS];SWITCHES (CONMUTADORES) DE ETHERNET;TOMACORRIENTES; (59) BLANCO; VIOLETA (74) 108 - (44) 03/09/2025
(21) Acta 4553434 - (51) Clase 16 (40) T (54)  (22) 07/08/2025 17:16:00 - (73) BANCO DE LA CIUDAD DE BUENOS AIRES - AR * (57) SOLAMENTE FOLLETOS INFORMATIVOS (FLYERS);FOLLETOS PUBLICITARIOS;IMPRESIONES;MATERIAL IMPRESO QUE REPRESENTA VALOR MONETARIO O PARA FINES FINANCIEROS;PAPELERÍA (ARTÍCULOS DE -);PUBLICACIÓN PERIÓDICA, REVISTAS;PUBLICACIONES IMPRESAS;PUBLICACIONES PROMOCIONALES;PUBLICACIONES PUBLICITARIAS;REPRODUCCIONES GRÁFICAS;REVISTAS (PUBLICACIONES); (74) 215 - (44) 13/08/2025	(21) Acta 4534036 - (51) Clase 28 (40) T (54)  (22) 02/07/2025 16:34:00 - (73) MILKY MOO FRANCHISING - SERVICIOS DE GESTAO DE FRANQUIAS LTDA - BR * (57) SOLAMENTE JUGUETES;PELUCHE; (59) NEGRO, BLANCO, ROSA, MARRON (74) 2117 - (44) 10/07/2025

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

In Argentina, the trademarks legal framework which includes colour trademarks, is comprised of the following:

- National Constitution
- TRIPs Agreement
- Trademark Law 22362 (amended by law 27444)
- Implementing Decree 242/2019

There are several Court cases that have helped to establish the interpretation of trademark distinctiveness, and particularly of combinations of colours and colour trademarks. Several years before the amendment of the Argentine Trademark Law in 2018, with the exception of the Implementing Decree of 2019 for Colour trademarks, Argentine Courts softened the strict provisions of Trademark Law Article 2 (d) and allowed combinations of colours to be registered and enforced. Of these cases, we should mention:

- **Club Atlético Boca Juniors Asociacion Civil c/ Superblank srl y otro s/ Cese of use of Trademark. 2010. Appeal Court for Federal Civil and Commercial – I.**

Enforcement of the Combination of Colours was allowed even though the trademark registration did not specify that the colours were applied to a specific part of the product. This was because the defendant's use of the Combination of Colours caused confusion and was considered to be aimed at imitating the plaintiff's registered rights.

- **Mars Incorporated c/ Arcor SA. S/ cese of opposition to trademark registration. 2007 - Appeal Court for Federal Civil and Commercial – I.**

The Court established that the conditions for a combination of colours to be successfully registered as a trademark were met.

- **Industrias Saladillo SA c/ Tigre Argentina SA s/ Cese of use of Trademark. 2019 - Appeal Court for Federal Civil and Commercial – III.**

This is a recent enforcement case regarding a combination of colours trademark in which the plaintiff not only obtained the cease of use of the infringed trademark, even when the name of the infringer was on the product, but was also awarded damages, including the profits obtained by the defendant due to the marketing of infringing products.

- b) *If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?*

The cases mentioned above did not specify a pantone colour, but the name of the colours in the combination. Therefore, the scope of protection of combination colour registrations is not restricted to a specific pantone (unless expressly claimed in application for registration), but encompasses colour variations within the claimed colour combination.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

The Argentine Trademark legal framework has changed significantly in 2018 with the amendment of the Trademark Law 22362 with law 27444 and the implementing Decree 242/2019.

The amendment introduced in 2018, established that oppositions, nullity actions of registrations (due to non-compliance with trademark law provisions), and cancellation actions for lack of use are all prosecuted as administrative proceedings, resolved by the Argentine Trademark Office acting in the first instance, with a right of appeal to the Argentine Appeal Court for Federal Civil and Commercial cases.

One important recent development in trademark procedure is resolution 583/2025, enacted in late December 2025, which modified the examination and opposition procedure of new trademark applications filed from March 1, 2026. The Argentine Trademark Office will now only conduct examination of trademark applications on absolute grounds, and will no longer consider relative grounds (confusingly similar trademark applications with previous registrations or applications). After examination, if the trademark application is approved, it will be published for opposition for one day, and if no opposition is filed within 30 days, the application will automatically be registered.

If a new trademark application is confusingly similar to a previous trademark, it is the duty of the owner of said trademark to oppose the new application to prevent it from being registered. If the trademark application is not opposed during the opposition period, it will automatically proceed to registration.

Opposition proceedings take place during the examination of the trademark application. If no opposition is filed, or if any opposition filed is found to be groundless, the application proceeds to registration. When an opposition is filed within the 30-day period following publication of the trademark application, it prevents the application from proceeding to registration. Once an opposition is filed, the Argentine Trademark Office serves notice on the applicant. Both parties then have a three-month period to negotiate an agreement regarding the goods or services or a coexistence arrangement. If no agreement is reached, the opposition is formally ratified, legal arguments are filed, and an administrative proceeding begins. After the applicant files its response and an evidence stage (if applicable), the Argentine Trademark Office issues a decision. The decision can be appealed to the Federal Court of Appeals in Civil and Commercial Matters.

Nullity actions are divided into those against registrations made by someone who knew or should have known that the trademark belonged to a third party, those registrations

made by someone for the purpose of reselling the mark, and, on the other hand, those registrations that were unlawfully granted in violation of the provisions of the Trademark Law. The nullity actions against registrations that were made by someone who knew or should have known that the trademark belonged to a third party, and those registrations made by someone for the purpose of reselling the mark, are prosecuted before the Argentine Federal Court for Civil and Commercial Matters.

The same legal framework is applied to all trademark applications and registrations, including those that claim combinations of colours.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

The registration and enforcement of colour trademarks in digital or virtual contexts is the same as for physical goods. They are governed by Argentine Trademark Law 22362 (as amended by Law 27444), and there is no provision that establishes any differences, aside from classification, for the registration and enforcement of colour trademarks in digital or virtual contexts, or specifically for colour trademarks.

Enforcement of trademarks is carried out through court proceedings prosecuted before the Argentine Federal Court for Civil and Commercial Matters

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

The enforcement cases below evidence that Argentine Courts enforce combination of colours trademark registrations, and regularly uphold the rights of the trademark owner against infringement by third parties.

Some examples of successful enforcement actions are the following:

- **Club Atlético Boca Juniors Asociacion Civil c/ Superblank srl y otro s/ Cease of use of Trademark. 2010. Appeal Court for Federal Civil and Commercial – I.**

Enforcement of the combination of colours trademark was granted because the defendant's use of the combination of colours caused confusion and was considered as aiming to be close to the plaintiff's registered rights.

- **Industrias Saladillo SA c/ Tigre Argentina SA s/ Cease of use of Trademark. 2019 - Appeal Court for Federal Civil and Commercial – III.**

This case is a recent enforcement case regarding a combination of colours trademark in which the plaintiff not only obtained the cessation of use of the infringing trademark — even when the infringer's own name appeared on the product — but was also awarded damages. These damages included the profits obtained by the defendant from the marketing of the infringing products.

7. Strategies for Managing Colour Trade Mark Applications

- a) [What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?](#)

For colour trademarks it is important to file the application for the combination of colours, if possible applied to a product or packaging. However, combinations of colours are also granted and enforceable without being applied specifically to a part of a product. If the combination is distinctive enough, it is advisable to claim the colours used (no Pantone mention needed), as this provides a wider scope of protection. If further precision is desired, the Pantone codes can also be used to claim the combination of colours.

Combination of colours trademark applications can be filed with a graphic representation of the names of the colours applied or with a colour graphic representation in which the colours are applied.

If the trademark application intends to claim a colour applied to a product in a specific area, it is important to provide a graphic representation of the product showing the colour applied to that particular area. Be prepared to respond to any office action regarding distinctiveness and to submit supporting evidence in order to overcome a possible objection from the Argentine Trademark Office

If possible, conduct a prior search for already registered combination of colours trademarks to avoid eventual oppositions that could delay the registration.

Active watching of new trademark applications of similar combinations of colours should

be in place to be alerted when a new application is published, so that it can be opposed and grant thereof prevented. A later nullity action involves a much lengthier procedure and significantly higher costs. Trademark owners should also remember that the Argentine Trademark Office does not examine relative grounds (similarity to prior marks) during the examination of new applications. It will grant any application that is published after formal examination if no opposition is filed against it.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

For colour trademarks, it should be considered that combinations of colours are allowed, whether applied to a specific part of a product or packaging, or without being applied to any specific part of a product, as the registrations mentioned above show. Therefore, it is also relevant to consider that the principle of speciality provides protection for the trademark registration only for the goods or services covered by the international class in which the mark is protected. The same combination of colours can still be the subject of a trademark application in a different international class for different or related goods or services.

In these cases, it is important to use the opposition system to prevent these new applications from becoming registered, and to negotiate the withdrawal of the opposition through a coexistence agreement.

Lack of opposition in these cases would cause a de-facto coexistence that would dilute the distinctiveness of the protected combination of colours.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

The official filing fees are the same for all trademark applications and renewals, regardless of whether they claim colour or not.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

Argentina does not have any provision regarding the concept of “Colour Depletion”

AUSTRALIA

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1. Legal Recognition and Protection of Colour Trade Marks

a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction?

In Australia, a trade mark is a “sign” used, or intended to be used, to distinguish 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.¹

The term “sign” is defined to include the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.²

Therefore, subject to meeting the other requirements of the Act, a colour by itself or in combination can be protected as a Trade Mark in Australia.

Colour trade marks are unlikely to be considered inherently adapted to distinguish the goods of the applicant where the colour or colour combination is:

- i. Functional. For example, where the colour provides a specific technical result (e.g. light reflection by the colour white) or has a generally accepted meaning (e.g. red for hot); or
- ii. Common. For example, terracotta for terracotta roof tiles or garden pots.

For a colour or combination of colours to be recognised as a trade mark, the colour must be used to distinguish the applicant’s goods and services, and not mere ornamentation or decoration.³

Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

It is possible to register as a Trade Mark a specific colour, a combination of colours, and or a gradient of colour. Specific examples are shown below for Question 2.

b) What specific requirements must accompany an application for a colour Trade Mark

¹ Section 17, Australian *Trade Marks Act 1995* (Cth) (the “Act”).

² Section 6 of the Act.

³ *Woolworths Ltd v BP plc* (No 2) [2006] FCAFC 132.

(e.g., colour codes such as Pantone, graphical representation, or description)?

As set out below, a number of representations and descriptions must accompany an application for a colour Trade Mark in Australia. The intention is that the combination of the description and the pictorial representation clearly define all the details for the Trade Mark.

Specific requirements:

- A clear and concise description of the Trade Mark as an endorsement to the Application. This could include reference to a colour within a recognised colour matching system (e.g. Pantone®). If no colour matching system reference is provided, the applicant will need to provide an example of the colour and ensure that the description refers to the representation as attached to the application form.
- A pictorial representation showing the colour claimed and the manner in which it is to be applied to the goods or packaging.
- An example of the actual colour or colour combination claimed.

c) Is evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of evidence of distinctiveness is typically accepted?

In Australia, a single colour is unlikely to be inherently adapted to distinguish,⁴ whereas a combination of colours may have at least some degree of inherent adaptation to distinguish. IP Australia will also make an assessment as to whether other traders are likely to want to use the colour or colour combination(s).

If evidence of use is required to show distinctiveness as at the filing date, the evidence will need to meet the same basic requirements as evidence for any other kind of trade mark. This includes:⁵

- when the trade mark was first used and the period of use or intended use;
- the goods/services in respect of which the trade mark has been used;
- annual turnover figures (in Australian dollars);
- any advertising or promotional expenditure (in Australian dollars) associated with use of the trade mark, and type of advertising;
- exhibits showing actual use of the trade mark as a badge of origin in the relevant period. These items should be dated, or an estimate of their date of use provided, and may include photographs, publications;
- indication of market share;
- individual item cost;
- indication of customer base and distributors (if any);
- details of online presence such as Internet websites or relevant apps where trade mark is used, third party social media and/or SEO reports;
- declarations from persons of standing within the relevant trade; and
- consumer surveys and/or questionnaires.

⁴ Trade Mark Office Manual of Practice and Procedure Part 21.4.3.1.

⁵ Trade Mark Office Manual of Practice and Procedure Part 23.3.4.

Importantly, IP Australia will scrutinise whether the colour has been used as a trade mark, rather than merely as part of overall get-up or decoration of the product or service.

2. Examples of Registered Colour marks

Refer to Appendix 1.

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Statutes & Legislation

Registration of colour trade marks in Australia is subject to the provisions of:

- i. *Trade Marks Act 1995* (Cth) generally. See, in particular, section 70 (Colours in registered trade marks), section 51 (Application – series of trade marks) and section 6 (Definitions); and
- ii. *Trade Marks Regulations 1995* (Cth) – Regulation 4.3(7) outlines that if a trade mark for which registration is sought contains or consists of a sign that is a colour, the application for registration of the trade mark must include a concise and accurate description of the trade mark.

Case Law

There have been a number of landmark cases that have shaped how Colour Trade Marks are dealt with under Australian law. These include:

Philmac Pty Limited v The Registrar of Trade Marks [2002] FCA 1551 (“Philmac”)

This decision is one of the foundational authorities in Australia on the registrability of single-colour trade marks.

Philmac Pty Limited applied to register the colour terracotta for the connecting insert of polypipe fittings.

Mansfield J outlined that the circumstances in which a colour applied to goods will be inherently adapted to distinguish will be limited to the following:

- the colour does not serve a utilitarian function: that is, it does not physically or chemically produce an effect such as light reflection, heat absorption or the like;
- the colour does not serve an ornamental function: that is, it does not convey a recognised meaning such as the denotation of heat or danger or environmentalism;
- the colour does not serve an economic function: that is, it is not the naturally occurring colour of a product and registration of that colour in respect of that product would not

thereby submit competing traders to extra expense or extraordinary manufacturing processes in order to avoid infringement; and

- the colour mark is not sought to be registered in respect of goods in a market in which there is a proven competitive need for the use of colour, and in which, having regard to the colour chosen and the goods on which it is sought to be applied, other properly motivated traders might naturally think of using the colour in a similar manner in respect of their goods.⁶

His Honour found that the colour trade mark was not inherently adapted to distinguish the designated goods from the goods or services of other persons. However, due to the extent to which Philmac Pty Ltd had used the colour terracotta in relation to certain fittings, the mark was distinctive for those fittings and ultimately registered in relation to those select fittings.

Woolworths Limited v BP plc (No 2) [2006] FCAFC 132 (“BP”)

BP plc filed two trade mark applications, each relating to the use of the colour green in association with service stations. Woolworths Ltd (“**Woolworths**”) opposed the registration of the marks. The delegate of the Registrar of Trade Marks held that the marks were not capable of distinguishing BP plc’s goods or services and the applications for registration were refused. The primary judge allowed the appeal and directed that the applications proceed to registration in the Register. Woolworths appealed the decision of the primary judge.

BP plc had made amendments to the particulars (and not the representations) of the applications after they were filed, moving from a simple reference to a green colour swatch to descriptions stating that green was applied to a “significant proportion” and later as the “predominant colour” of various service-station elements.

The Full Court held that:

- the amendments were not merely changes to particulars, but formed part of the representation and definition of each trade mark;
- the written descriptions accompanying a colour mark are integral to identifying the scope and identity of the trade mark;
- amendments that alter how a colour is applied, or expand the circumstances in which it may be used, can substantially affect the identity of the mark and impermissibly extend the rights claimed;
- colour marks are not inherently adapted to distinguish, and registration could only be achieved (if at all) through proof of acquired distinctiveness. BP plc had failed to establish that the colour green, whether alone or as the predominant colour, had acquired distinctiveness through use prior to the filing dates. The evidence showed that BP had consistently used green in combination with other brand elements, particularly yellow, and not as a standalone badge of origin.

Accordingly, the Full Court held that BP plc’s colour green trade mark registrations should have been refused, and that the Court had power to order rectification of the Register to remove marks that should not have been registered. The marks have subsequently been cancelled.

Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd [2007] FCAFC 70 (“Cadbury”)

⁶ At paragraph [65].

Although this case arose in the context of passing off and misleading or deceptive conduct in Australia, the decision forms part of the array of landmark decisions shaping the limits of colour trade mark protection in Australia.

Cadbury Schweppes Pty Ltd (“**Cadbury Schweppes**”) alleged Darrell Lea Chocolate Shops Pty Ltd’s (“**Darrell Lea’s**”) use of a shade of purple in connection with its chocolate products amounted to passing off and misleading or deceptive conduct under Australian consumer protection and passing off laws.

However, the Courts found that:

- Cadbury Schweppes did not have an exclusive reputation in the use of the relevant colour purple in connection with chocolate. Indeed, other traders had, with Cadbury Schweppes’ knowledge, for many years used a similar shade of the colour purple; and
- Cadbury Schweppes did not need to “own” the colour purple to have a legal claim. What mattered was whether the way Darrell Lea used the colour purple could make customers think the two companies or their products were connected.

In the circumstances of the decision, the Full Court did not make any finding on whether Darrell Lea’s use of the colour purple was misleading. However, the trial judge had found that Darrell Lea’s use of the colour purple was not likely to mislead consumers into thinking there was a connection with Cadbury Schweppes.

The decision reinforces the reluctance of Australian courts to recognise exclusive rights in a colour *per se*, whilst confirming that colour can nevertheless play a role in misleading conduct where its use creates a false impression of association.

b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

In Australia, the scope of protection for a colour trade mark is determined by the precise definition and representation of the colour on the Register, read in conjunction with how the colour is actually used and perceived in practice. Australian authorities are cautious not to allow colour registrations to operate as broad monopolies over colour ranges. Decisions such as *BP* and *Philmac* (see above) illustrate that any protection sought beyond the exact specified shade is limited.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or cancelling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

In Australia, there is a range of procedures and forums before the Registrar and the Court for opposing, invalidating, or cancelling a Registered Colour Trade Mark. These include:

A. Registrar

- (i) Revocation of an Acceptance – those applications accepted after Examination by IP Australia

but then revoked;

- (ii) Cancellation or Revocation of Registration applications to IP Australia – available if the Registrar gives notice of the proposed revocation with 12 months from the date the trade mark’s registration was recorded in the database;
- (iii) Opposition to registration proceedings before IP Australia;
- (iv) Cancellation proceedings before IP Australia such as an Application for Removal for Non-Use;

Any of the above-mentioned proceedings before IP Australia (Delegate of the Registrar of Trade Marks) may then be appealed (*de novo*) to the Federal Court of Australia, or the Federal Circuit and Family Court of Australia, and ultimately the High Court of Australia.

B. Court

- (i) Cancellation on ground of contravention of condition etc. before the Court;⁷
- (ii) Cancellation--loss of exclusive rights to use trade mark before the Court;⁸
- (iii) Cancellation--other specified grounds.⁹

5. Use of Colour Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colours in these emerging spaces or are they treated in the same way as other Trade Marks?

In Australia, colour marks are treated the same in digital environments as in physical ones — but virtual goods and metaverse applications must be precisely classified, clearly represented, and supported with strong evidence of distinctiveness.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party users (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

While a number of Colour Trade Marks have been registered in Australia, there are no reported instances of registered Colour Trade Marks being enforced against third-party users in Australia.

⁷ Section 86 of the Act.

⁸ Section 87 of the Act.

⁹ Section 88 of the Act.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

(i) Filing

Single v Multiple Colours: While colour trade marks are registrable in Australia, a single colour is generally regarded as having little or no inherent adaptation to distinguish goods or services. A combination of colours is more likely to be inherently distinctive than a single colour per se.

Definition of the Colour: Precise definition of the colour is critical. Applications should clearly identify the colour claimed, preferably by reference to an objective colour identification system (for example, Pantone®) and avoid vague or relative descriptors such as ‘significant portion’ or ‘predominant colour’. The written description, visual representation and evidence of use must clearly and consistently define the scope of the colour mark, as these will be closely scrutinised during examination, opposition and enforcement.

Colour used as a Trade Mark: Applicants must demonstrate that the colour is used as a trade mark, rather than merely as a decorative or supporting brand element. Evidence showing use of the colour only in combination with word marks or logos may be insufficient to establish distinctiveness of the colour itself.

Consider the market where the Colour Trade Mark will be used: Colour Trade Marks are unlikely to be inherently distinctive where they perform a functional or trade-common role, rather than acting as a ‘badge of origin’. A colour (or combination) may be functional if it delivers a technical result (such as black for solar collectors or silver/white for reflective insulation) or conveys a generally accepted meaning in the trade or community, including safety, hazard or warning functions. Colours that are commonly used in a particular industry, that arise naturally from the product or standard manufacturing processes, or for which there is a genuine competitive need, will also struggle to act as a ‘badge of origin’.

(ii) Opposition

In Australia, colour trade mark applications are most effectively opposed by showing that the colour lacks inherent adaptation to distinguish because it is functional, common to the trade, or competitively necessary. This includes colours that deliver a technical result, convey an accepted industry meaning, arise naturally from standard manufacturing processes, or are widely used in the relevant market such that other honest traders would reasonably need access to them. Where acquired distinctiveness is claimed, opponents should also challenge whether use has been sufficiently exclusive, consistent and extensive for consumers to perceive the colour alone as a badge of origin rather than as functional or decorative.

(iii) Defending & Enforcing

In Australia, successful defence and enforcement of a colour trade mark depends on demonstrating that the colour functions as a badge of origin rather than a functional or decorative feature. This is best achieved through a clear and precise definition of the colour, consistent

real-world use aligned with that definition, and strong evidence of acquired distinctiveness, showing long-term, exclusive and prominent use of the colour in the relevant market. Enforcement is most effective where the colour is used independently of word marks or logos, does not serve a technical or trade-common purpose, and where the proprietor actively maintains brand discipline and polices third-party use to reinforce consumer recognition of the colour as indicating trade origin.

Overall:

In Australia, the most persuasive evidence of distinctiveness is proof that consumers recognise the colour itself as identifying a single trade source. This is usually shown through long-term, consistent use of the colour in a clear and uniform way, supported by sales figures and advertising that deliberately highlights the colour rather than treating it as decoration or background. Evidence is strongest where the colour is used prominently and consistently with how it is defined on the Register. Consumer evidence can assist, but claims will be weakened if the colour is used inconsistently, serves a functional or industry-standard purpose, or is always overshadowed by word marks or logos.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Coexistence of Colour Trade Marks in Australia is accepted in principle but tightly controlled in practice. It is permitted only where the scope of each colour mark is confined by context, use and consumer perception, and where registration does not impede honest competition.

For example:

(i) *Philmac*

- Co-existence concerns arose because registration of a terracotta colour would prevent other honest traders from using similar shades on comparable goods.
- The decision confirms that colour marks must be narrowly confined, as co-existence becomes untenable where competitors would reasonably wish to use adjacent colours in the ordinary course of trade.

(ii) *BP*

- The case illustrates that co-existence of similar colours is possible unless a colour has been used alone, consistently, and unmistakably as a badge of origin.
- BP plc had always used the colour green with other brand elements, particularly yellow. As a result, the colour green did not function as a standalone badge of origin and other traders were entitled to continue to use green in their own branding. In such circumstances, the shared use of a colour within differentiated get-up is acceptable and expected in Australia. The courts will resist granting exclusive colour rights and will protect the integrity of the marketplace by maintaining coexistence.

(iii) *Cadbury*

- In the context of unregistered colour marks, Australian law permits the co-existence of colour-based branding, provided that the colour is not used in a way that misleads consumers.
- For passing off and misleading or deceptive conduct, exclusive rights in a colour are not required, nor readily recognised, particularly where other traders have used a similar shade of colour.

- Instead, courts will focus on the factual circumstances of whether the overall presentation creates a false impression of commercial connection.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

In Australia, there are no additional official fees for registration and/or renewal of Colour Trade Marks. However, given that an applicant will be required to overcome a likely objection from IP Australia regarding inherent adaptability to distinguish, it is likely that additional fees will be incurred by the applicant in seeking registration of the Colour Trade Mark.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

While Australia does not recognise “colour depletion” as a standalone doctrine, the concern is addressed through strict distinctiveness analysis and a consistent reluctance to grant colour monopolies that would curtail legitimate competitor branding or use (including functional use), or restrict honest trade.

9. About the Contributor for the Australian section



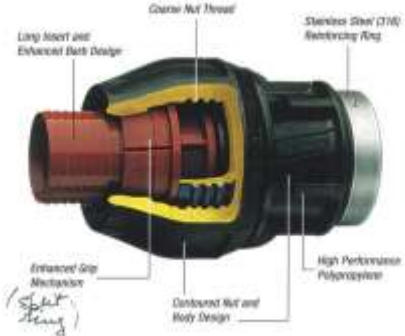
Noelene Treloar is a patent attorney and IP attorney with over 25 years’ experience in the intersection of intellectual property, innovation, technology and commercialisation. She is Of Counsel at Adrian M. Trioli Intellectual Property, a boutique Australian and New Zealand IP practice.

Noelene’s practice covers both contentious and non-contentious matters relating to patents, trade marks, designs, copyright, plant breeder’s rights and confidential information, including patent and trade mark prosecution, opposition and litigation. She has experience across a range of industries including R&D, FMCG, retail, information technology, education, pharmaceuticals, biotechnology and professional services.

Noelene is a member of the IPO International Trademark Law & Practice Committee.

Appendix 1 – Response to Question 2

Trade Mark	Trade Mark No.	Owner	Classes	Status	Endorsement
	728555	BP p.l.c.	4, 35, 37, 42	Registered (Renewal Due)	The mark consists of the colours GREEN and YELLOW applied as the predominant colours to the fascias of buildings, petrol pumps, signage boards - including poster boards, pole signs and price boards - and spreaders, all used in service station complexes for sale of the goods and supply of the services covered by the registration, as exemplified in the representation attached to the application form. Provisions of sub-section 41(6) applied.
	749403	7-Eleven International LLC	35	Registered	The trade mark consists of three horizontal stripes in the colours ORANGE, GREEN and RED on a white or neutral background, as shown in the representation of the trade mark attached to the application form, as applied to the fascia of buildings, shop fronts, shop interiors, and promotional material.
The Trade Mark is as described in the endorsement.	779336	Cadbury Limited UK	30	Registered	The trade mark consists of the colour PURPLE the said trade mark being adopted as the substantial colour of packaging used in relation to the nominated goods. The colour is the shades of PURPLE corresponding to the following references in the 1997-

					1998 PANTONE Colour Formula Guide: 2607c, 2617c, 2627c, 268c, 269c, 2685c, 2695c and 2755c. For the avoidance of doubt, this is a series mark.
	796572	Philmac Pty Ltd	17	Registered	The trade mark consists of the colour TERRACOTTA (PMS 484c + /- 10% Lab, when observed under a controlled D65 illuminant) applied to the connecting inserts of the goods, as shown in the representation attached to the application. Provisions of subsection 41(6) applied.
	1120614 <i>NB: Example only. Cadbury UK Limited has more than one colour trade mark registration for the colour 'purple'</i>	Cadbury UK Limited	30	Registered	The trade mark is the colour PURPLE depicted in the representation attached to the application form being approximated by reference PMS 2685C in the Pantone Colour Formula Guide and used in relation to the designated goods.
	1414010	Tiffany and Company	14, 16, 35	Registered	The mark consists of the colour BLUE with RGB Profile R117 G210 B204, as shown on the form of the application, applied to the whole visible surface, or being the predominant colour applied to the visible surface of the

						packaging of the goods or in relation to the supply of services covered by the registration.
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BENELUX: NETHERLANDS, BELGIUM AND LUXEMBOURG

Contributors: Ms. Ellen Streekstra and Ms. Mayke van Wanroij of Abel+Imray

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Abel+Imray

1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

As concerns the Netherlands, Belgium and Luxembourg, registration of Trade Marks is governed by the [Benelux Convention on Intellectual Property](#) (BCIP).

It is possible to register a colour mark in the Benelux, provided that the colour is capable of:

- Distinguishing the goods or services of one undertaking from those of other undertakings. This is often challenging because a single colour is usually perceived as decorative or functional.
- Being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

No technical or functional role¹⁰: The colour must not be essential for use or serve a technical function.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

In case of a colour mark (a mark that only consists of one colour or of a combination of colours) the colour must be clearly defined, by reference to an internationally recognised colour code (such as Pantone) and a description of the colours.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

¹⁰ CJEU judgment in Case C-104/01 Libertel (colour marks must not be functional and must be distinctive).

In practice, applications for a single colour mark are often refused unless strong evidence of acquired distinctiveness is provided. In many cases, it is needed to demonstrate that the colour has become recognised in the market as an indication of origin through long-term and intensive use (secondary meaning).

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

Single Colour Marks

Trade Mark	Benelux Reg. No.	Owner	Classes
	962326	T-Mobile Netherlands B.V.	Cl. 09 and 38 (telecommunication products and services)
	934863	FrieslandCampina Nederland B.V.	Cl. 30 (chocolate milk)
	610621	Koninklijke Luchtvaart Maatschappij N.V.	Cl. 35, 36, 38 and 39 and 43 (Inter alia: Airline services (transportation); caterings services)

Colour Combinations

Trade Mark	Benelux Reg. No.	Owner	Classes
	832076	Red Bull GmbH	Cl. 32 (Energy drinks to the extent included in this class)
	1385931	JLG Industries, Inc.	Cl. 07 (Elevating work platforms; scissor lifts)
	887568	N.V. Nederlandse Spoorwegen	Cl. 12 and 39 (Trains; transportation of persons by train)

	973519	BROUWERIJ L. HUYGHE N.V.	Cl. 32 (Special beers)

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The protection of Trade Marks, including colour marks, is governed by the [Benelux Convention on Intellectual Property](#) (BCIP). This governs Trade Mark registration and protection in Belgium, the Netherlands, and Luxembourg.

Article 2.1 BCIP: Defines what constitutes a Trade Mark, including colours and colour combinations, provided they can be represented clearly and precisely.

Relevant Case Law for Benelux Trade Marks:

Case	Court / Date	Key Principle
Libertel	CJEU, 2003, Case C-104/01	A single colour can function as a Trade Mark if represented clearly and precisely (e.g., Pantone code) and has acquired distinctiveness.
Heidelberger Bauchemie	CJEU, 2004, Case C-49/02	Colour combinations must be systematically arranged and clearly represented.
CeramTec v. Coorstek	CJEU, 2025, Case C-17/24	Colour marks cannot be used to extend technical monopolies after patent expiry.
T-Mobile Magenta	BOIP, 2024, Cancellation No. 3000494	Magenta colour mark declared invalid due to insufficient proof of acquired distinctiveness across all Benelux countries.

Boundaries of Protection of colour marks

- **High threshold for distinctiveness:**

Colours are generally considered non-distinctive unless proven otherwise through use.

- **Representation requirements:**

BOIP requires that a colour mark be represented clearly and precisely, typically by specifying an internationally recognised colour code (e.g., Pantone, RAL). This ensures legal certainty and defines the scope of protection.

- **Public interest:**

Courts emphasise the need to keep basic colours free for competitors (free availability principle).

- **No technical function:**

Colours cannot serve a technical purpose (e.g., indicating function or quality).

b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

Guidance on the scope of protection:

- In the Benelux protection generally applies to the exact colour as filed, but is not limited to the exact Pantone shade filed.

- Protection does extend to confusingly similar shades, as long as the average consumer would perceive them as the same trade-mark colour. For example, the KÄRCHER case¹¹ in the Benelux confirmed that colour marks (with proper codes) can be enforced successfully against similar uses, even when tone differences exist.

- The Pantone code defines the registration's clarity, but enforcement is governed by likelihood of confusion, overall colour impression, and consumer perception, consistent with Libertel and Heidelberger (mentioned previously) and BOIP practice.

- Courts have emphasised that granting rights over "similar colours" would unduly restrict competitors and conflict with the principle of free availability of colours.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

¹¹ KÄRCHER, District Court of The Hague, ECLI:NL:RBDHA:2021:7222.

Forum:

Benelux Office for Intellectual Property (BOIP)

handles:

- Opposition against Trade Mark applications before registration.
- Cancellation/Invalidation of registered marks.

Benelux Court of Justice

- Hears appeals against BOIP decisions.

National Courts

- May be involved for infringement actions or broader disputes.

Procedures:

Opposition Procedure

Timing:

- An opposition must be filed within two months of publication of the application in the Benelux register.

Grounds:

- Identical mark for identical goods/services.
- Likelihood of confusion with an earlier mark.
- Unfair advantage or harm to reputation of a well-known mark.
- Applications filed by an agent without authorisation.

For colour marks, the most common ground is that a single or similar colour causes confusion, dilution, or takes unfair advantage of the opponent's distinctive colour.

Process:

- Notice of opposition filed with BOIP (paying fees).
- Cooling-off period (initial 2 months, extendable).
- Written exchange of arguments and evidence.
- Decision issued by BOIP, costs may be awarded to the successful party.
- Appeal possible to the Benelux Court of Justice.

Cancellation / Invalidation procedure

Timing:

- There is no time limit.

Grounds:

- Lack of distinctiveness or bad faith at registration.
- Non-use for five consecutive years.
- Becoming generic or misleading.

For colour marks, the most common grounds are:

- Lack of distinctiveness.
- Colour marks that are descriptive or customary.

- Colour marks that lack acquired distinctiveness.
- Marks contrary to public policy.
- Marks not capable of functioning as a Trade Mark.

It is a challenge to prove acquired distinctiveness across the entire Benelux territory. This must be proven across the Netherlands, Belgium and Luxembourg.

Process:

- File a cancellation request at BOIP (paying fees).
- Similar structure to opposition: written arguments, evidence, and possible appeal to the Benelux Court of Justice.

5. Use of Colour Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colours in these emerging spaces or are they treated in the same way as other Trade Marks?

Registration

The Benelux Office for Intellectual Property (BOIP) applies the same fundamental principles for colour marks in digital contexts. The registration procedure for colour mark in digital or virtual contexts is the same as in traditional contexts.

Enforcement in digital or virtual context

Enforcement follows the same principles as traditional contexts:

- Owners can act against unauthorised use of the colour mark in apps, websites, or VR platforms, provided the use relates to goods/services for which the earlier mark is registered.
- Courts consider likelihood of confusion and unfair advantage in virtual environments just as in physical markets.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

Case	Successfully / Unsuccessfully	Key factors
Kärcher v Varo (District Court of The Hague, ECLI:NL:RBDHA:2021:7222)	Successfully	Acquired Distinctiveness: Kärcher proved long-standing, consistent use since 1974, creating strong

Kärcher owned two Benelux registrations for the colour yellow (one with RAL 1018 zinc yellow code) used on cleaning devices. Varo marketed high-pressure cleaners in a similar yellow shade.	The court found infringement and granted an injunction.	consumer association. Precise Representation: Registration with an international colour code (RAL 1018) was decisive; a second registration without the code was invalidated. Likelihood of Confusion: Despite slight tone differences, the court held that consumers rely on overall impression, not direct comparison. Reputation: Kärcher demonstrated its colour mark had a reputation in the Benelux, strengthening its position. This case is widely regarded as a landmark for colour marks in the Benelux.
Friesland Campina, Yellow for chocolate milk (BOIP, 2024) A Benelux colour mark for yellow used on chocolate milk products was successfully enforced when the Trade Mark holder opposed an application for chocolate-related goods under the name <i>Cacaolat</i>.	Successfully BOIP upheld the opposition, confirming that the yellow colour mark had acquired distinctiveness for chocolate milk in the Benelux.	Acquired Distinctiveness: Strong evidence of long-term use and consumer recognition. Specific Market Association: Colour linked to a niche product category (chocolate milk), reducing risk of functionality arguments. Clear Representation: Registration included precise colour identification.
Deutsche Telekom Magenta (BOIP, No. 3000494, 2024)	Unsuccessfully for Trade Mark owner	Insufficient Evidence Across Territory: Surveys showed strong recognition in the Netherlands (60% association) but weak

Deutsche Telekom's magenta colour mark for telecom services was challenged by Lebara. BOIP invalidated the mark.	Registration cancelled for lack of acquired distinctiveness across all Benelux countries.	evidence for Belgium and Luxembourg. High Threshold for Non-Traditional Marks: BOIP reaffirmed that acquired distinctiveness must be proven in all three Benelux countries. Survey Limitations: National surveys were considered supportive, not decisive; BOIP requires consistent use evidence across the region.
Henkel, Blue (BOIP, 2017) Henkel tried to enforce a blue colour mark against a competitor's packaging.	Unsuccessfully The opposition was rejected because Henkel could not demonstrate strong acquired distinctiveness for the blue colour in the relevant market.	Weak Market Recognition: Evidence of acquired distinctiveness was insufficient. Functional Use Argument: Blue was considered common and functional in the cleaning sector. No Clear Consumer Association: Surveys did not show strong linkage to the brand.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

Filing	Precise representation • Use an internationally recognised colour code (Pantone, RAL) in the application. • Include a clear description of how the colour is applied.
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	Evidence of distinctiveness For single colours, prepare strong evidence of acquired distinctiveness: • Long-term, exclusive use in the Benelux. • Market share and duration of use. • Advertising costs and campaigns highlighting the colour. • Surveys showing association of the colour with the brand. Avoid functionality • Demonstrate that the colour is not functional (e.g., not required for technical or aesthetic reasons in the industry).
Opposing	Grounds • Likelihood of confusion with the earlier mark. • Lack of distinctiveness or descriptiveness. • Colour is common or functional in the relevant sector. • Public policy / unfair monopolisation of the colour. Effective opposition strategies • Show functional or aesthetic necessity of the colour in the sector. • Demonstrate third-party use of the colour to argue that registration would limit competition. • Argue lack of acquired distinctiveness: Use surveys showing consumers do not associate the colour with the applicant.
Defending	Acquired distinctiveness across the Benelux • BOIP requires proof for the Netherlands, Belgium, and Luxembourg. • Use territory-specific surveys, sales data, and marketing materials. Strongest defence comes from proving that the colour has become a source identifier: • Consumer recognition surveys. • Evidence of consistent use in advertising, packaging, branding.

	• Media references associating the colour with the brand. • Sales and distribution figures covering the Benelux.
Enforcing	Successful enforcement typically relies on: • Similarity of goods/services. • Similarity of colour and overall visual impression (exact Pantone/RAL match not always required). • Evidence that the public associates the colour with the Trade Mark. Evidence types for enforcement proceedings • Market surveys showing consumer association. • Advertising / social media campaigns linking colour to brand. • Photos of products / packaging in the marketplace. • Examples of actual confusion (if available). • Expert testimony on distinctiveness or branding practices. • Track use in websites, apps, and virtual goods; screenshots and timestamps are key.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Co-existence of colour marks is theoretically possible, but in practice very limited, especially for pure colour marks. It is generally allowed if:

- The colours are sufficiently different in shade or tone.
- They are used for unrelated goods/services.
- There is no likelihood of confusion among consumers.

Case law insights

Courts and BOIP decisions show that co-existence is more likely when:

- The colour is not a dominant branding element for both parties.
- There is clear differentiation in application (e.g., one uses the colour on packaging, the other on logos).

In the Kärcher case, mentioned previously, the court emphasised that even slight tone differences can matter if the colour is central to branding, making co-existence harder for similar shades in the same product category.

Assessment: Coexistence of pure colour marks in the Benelux:

- **In theory:** yes, nothing in BCIP or the relevant EU/Benelux case law absolutely prohibits multiple colour Trade Marks coexisting, especially if scope is limited or the marks cover distinct goods/services.
- **In practice:** very rare, because of the high distinctiveness bar, colour-depletion doctrine, and strong incentives to challenge overlapping marks.
- **Conclusion:** coexistence is better viewed as an exception (or negotiated outcome) than as a viable general model for colour-mark strategy.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

There is no separate surcharge for colour marks. They are treated as non-traditional marks under the same fee schedule. However, costs may increase if the applicant wants to include a detailed description of distinguishing features or require legal representation.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

Yes, the Benelux jurisdiction recognises the concept of “colour depletion”, but it does so indirectly through legal principles and case law rather than as an explicit statutory rule.

1. How colour depletion is addressed

Public interest principle

Courts and BOIP decisions emphasise that granting exclusive rights over basic colours should not unduly restrict competitors.

This principle was highlighted in the Libertel case (mentioned previously), which applies across the EU and Benelux:

- Colours are generally not inherently distinctive.
- Registration is only allowed if the applicant proves acquired distinctiveness.
- The aim is to prevent monopolisation of colours essential for competition.

High threshold for distinctiveness

The strict requirement for clear representation and territorial evidence of acquired distinctiveness acts as a safeguard against colour depletion. Only businesses that can show strong consumer association across all Benelux countries can register a colour mark.

Functionality and availability

BOIP and courts consider whether a colour serves a functional or aesthetic role in the industry. If so, registration is refused to keep that colour available for competitors.

2. Practical effect

- **Single colours:** Rarely registered unless proven distinctive through long-term exclusive use.
- **Common colours:** Harder to monopolise because of the depletion concern.
- **Composite marks:** Easier to register (colour + word/logo), reducing depletion risk.

3. Case law examples

- Libertel (Orange for Telecom)¹²: ECJ stressed avoiding undue restriction of colour availability.
- Deutsche Telekom (Magenta)¹³: BOIP invalidated the mark partly because granting exclusivity without strong evidence would limit colour availability for competitors.

9. About the Contributors for the section for Netherlands, Belgium and Luxembourg

Abel+Imray

Ellen Streekstra - Benelux and EU Trade Mark Attorney based at Abel & Imray's Delft office. She advises national and international clients on trade mark applications worldwide, representing them before the Benelux Office for Intellectual Property (BOIP) and the European Union Intellectual Property Office (EUIPO). Ellen provides guidance on trade mark infringement and manages opposition and revocation actions. Before establishing the Delft office in 2021, Ellen worked at several leading intellectual property firms in the Netherlands, building up over 25 years' experience in the field.

Mayke van Wanroij - Benelux and EU Trade Mark Attorney based at Abel & Imray's Delft office in the Netherlands. With over 20 years' experience in intellectual property, she advises and represents national and international clients before the Benelux Office for Intellectual Property (BOIP) and the European Union Intellectual Property Office (EUIPO). Before joining Abel & Imray, she worked at several mid-sized IP firms. Together with Ellen, she is responsible for the Delft office.

¹² Libertel Groep BV v Benelux-Merkenbureau, Case C-104/01 (ECJ, 6 May 2003).

¹³ [Deutsche Telekom Magenta \(BOIP, No. 3000494, 2024\)](#)

BRAZIL

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Brazilian trademark law adopts a traditionally restrictive approach to the protection of single colours as trademarks. Article 124, VIII of Law No. 9.279/1996 (Industrial Property Law – LPI) expressly provides that “colors and their names” are not registrable as trademarks, except when arranged or combined in a distinctive and peculiar manner. The wording of the statute has historically been interpreted as establishing a categorical prohibition against the registration of colour per se and against the registration of isolated colour denominations. The legislative intent underlying this provision reflects a competition-oriented rationale: colours, as basic elements of visual communication, must remain broadly available to all market participants unless incorporated into a configuration capable of distinguishing goods or services in a concrete and objective manner.

In practical terms, this means that a mark consisting solely of a colour per se, namely, , or of the denomination of such colour — for example, “AZUL” (blue) — is not registrable for any goods or services. The same applies to diminutive or augmentative variations, such as “VERDINHO” (little green), since such variations do not alter the essential character of the sign as a colour name. Brazilian examination practice considers these expressions part of the public linguistic domain and therefore unavailable for exclusive appropriation. The prohibition also extends to denominations that function as colour references even if they originate from objects or natural elements. For instance, the term “ABÓBORA” (pumpkin), when used merely to designate a shade of orange, is treated as a colour denomination and refused under Article 124, VIII. If claimed for pumpkins themselves, refusal would additionally be grounded in Article 124, VI, which bars registration of signs that designate the product or describe its characteristics.

The analysis becomes more nuanced when colour denominations are combined with other elements. The statutory exception in Article 124, VIII allows registration where colours are “arranged or combined in a distinctive and peculiar manner.” This language must be read in conjunction with Article 122 of the LPI, which permits registration of any visually perceptible sign

capable of distinguishing goods or services, provided it is not legally prohibited. Brazilian doctrine therefore recognizes that a sign composed of individually non-distinctive elements may nonetheless be registrable if the overall combination generates sufficient distinctiveness.

This principle explains why expressions such as “PIZZARIA AMARELA” (Yellow Pizzeria) may be registrable for restaurant services. Although “AMARELA” alone is a colour name and “PIZZARIA” is descriptive of the service, the combination does not describe an inherent characteristic of restaurant services. Rather, it forms a business designation whose overall impression is capable of individualization. By contrast, the expression “CAMISA AMARELA” (Yellow Shirt) would be refused for clothing, since it directly describes both the product and one of its potential characteristics. In such a case, refusal is grounded not only in Article 124, VIII but also in Article 124, VI, which prohibits descriptive signs. The combination fails to transcend descriptiveness and does not produce a distinctive whole.

A similar rationale applies where colour denominations describe natural characteristics of goods. The expression “VERDE-E-ROSA” (Green-and-Pink), when applied to guavas, is considered descriptive because those colours correspond to inherent attributes of the fruit. Even though two colours are combined, the sign remains intrinsically linked to the product’s natural appearance and therefore lacks distinctiveness. Conversely, if the same expression were used in relation to musical entertainment services, it could be considered registrable, as the colour combination bears no descriptive relationship to the services and may function as a source identifier.

These examples illustrate that Brazilian practice does not treat colour-related signs as uniformly prohibited; rather, it applies a layered analysis. First, colour per se and isolated colour denominations are barred. Second, combinations that remain descriptive of the goods or their characteristics are also barred. Third, colour names integrated into a distinctive overall expression, unrelated to the nature or characteristics of the goods or services, may be registrable.

Notwithstanding the statutory allowance for colours “arranged or combined in a distinctive and peculiar manner”, examination practice at the Instituto Nacional da Propriedade Industrial - INPI (Brazilian Patent and Trademark Office - BPTO) has demonstrated a degree of inconsistency in relation to simple colour combinations, reflecting the discretionary nature of the assessment of what constitutes a “distinctive and peculiar” arrangement. In particular, figurative marks consisting of two coloured stripes placed side by side have generated inconsistent outcomes.

In certain cases, the Brazilian PTO has accepted registration where the overall chromatic presentation was deemed sufficiently individualized in the relevant commercial context. In other instances, however, the Office has refused registration on the grounds that the mere juxtaposition of two coloured bands — without additional graphic elements, specific proportional configuration, or distinctive stylization — does not satisfy the requirement of a “distinctive and peculiar” arrangement within the meaning of Article 124, VIII of the Industrial Property Law.

For example, Red Bull GmbH was reportedly denied registration in Class 32 for a blue and silver



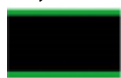
(grey) colour combination, namely, (case nº 926293370) traditionally associated with its beverage cans, on the basis that the arrangement lacked sufficient distinctive peculiarity

beyond decorative presentation. By contrast, Getir Perakende Lojistik A.S., the Turkey-based ultra-fast delivery platform, succeeded in obtaining registration in Class 35 for a purple and



yellow combination, namely (case n° 922885567) as the Office considered that the chromatic configuration, in the specific commercial context, was capable of source identification.

A similar contrast can be observed in other sectors. EUROIMMUN Medizinische Labordiagnostika AG, a German medical diagnostics company, had following colour



combination mark (case n° 915962080) refused in Class 9 under Article 124, VIII, whereas Shell Brands International AG was able to secure registration in Class 4 for its well-



known red and yellow configuration: (case n° 814493734). These examples illustrate that sectoral recognition, market penetration, and contextual distinctiveness may significantly influence the Office's evaluation, even where the structural format of the mark (two primary colour fields) appears similar.

Taken together, such decisions demonstrate that the practical threshold for what constitutes a “distinctive and peculiar” arrangement remains fluid and highly fact-sensitive.

A colour gradient combination, in turn, will in principle be more likely to satisfy the requirement of a “distinctive and peculiar combination of colours” since it does not consist of a mere juxtaposition of solid chromatic bands. Rather, the progressive transition between tones may generate a unique overall visual impression capable of individualizing the sign.

This divergence illustrates an important practical reality: while the law formally permits colour combinations, the threshold for what qualifies as a sufficiently distinctive arrangement remains subject to discretionary evaluation. The assessment often turns on contextual factors, including the degree of stylization, proportional arrangement, market sector practices, and the presence (or absence) of evidence demonstrating that consumers perceive the combination as an indicator of origin rather than mere ornamentation.

Until recently, this framework was applied with considerable rigidity. However, a significant development occurred in 2025, when the Brazilian PTO introduced a formal administrative procedure recognizing acquired distinctiveness (secondary meaning) during trademark examination. Although Article 124, VIII has not been amended, the recognition that a sign may overcome inherent distinctiveness objections through evidence of extensive use introduces interpretative flexibility into the system.

It should be noted that, prior to November 2025, the BPTO did not formally recognize acquired distinctiveness during examination proceedings. Arguments based on secondary meaning were generally disregarded at the administrative level, even though Brazilian courts had long admitted the doctrine in nullity and infringement actions, particularly in cases involving descriptiveness under Article 124, VI. As a result, applicants seeking recognition of acquired distinctiveness frequently needed to resort to judicial proceedings rather than obtaining such recognition

directly before the Trademark Office. The 2025 administrative reform therefore represents not the creation of a new substantive doctrine, but the procedural internalization of a concept that had already been acknowledged by the judiciary.

This reform nevertheless raises an important doctrinal question: whether compelling evidence that an isolated colour has acquired source-identifying character in Brazil could, in exceptional circumstances, mitigate the traditionally categorical interpretation of Article 124, VIII. While Brazilian courts have accepted acquired distinctiveness in relation to descriptive signs, there is no consolidated precedent clearly confirming judicial recognition of secondary meaning in respect of a mark refused solely on the basis of colours *per se*. The absence of settled case law in this specific context reinforces the historically restrictive approach to colour monopolization under Brazilian law.

The existence of a formal administrative mechanism for acquired distinctiveness may, however, signal a gradual shift toward a more distinctiveness-based analytical model, aligning Brazilian practice more closely with jurisdictions that assess colour marks primarily through evidentiary thresholds rather than categorical exclusion. Any such evolution would likely require overwhelming evidence of exclusive, long-standing use, high market penetration, and strong consumer association, given the competitive and public-domain sensitivities inherent in the appropriation of colour.

In sum, Brazilian law reflects a historically cautious equilibrium between trademark protection and the preservation of the public domain. Article 124, VIII embodies a structural concern with preventing undue appropriation of chromatic elements, traditionally treating colours *per se* as unavailable for exclusive rights unless incorporated into a distinctive and peculiar arrangement. Accordingly, the registrability of colour-related signs has depended primarily on objective structural distinctiveness rather than on market perception.

The recent administrative recognition of acquired distinctiveness introduces a new evidentiary dimension to this framework. Although it does not alter the statutory prohibition, it opens the possibility that, in exceptional circumstances, demonstrable and robust consumer association may influence the assessment of registrability. Brazilian practice therefore remains conservative, but it now operates within a more flexible and potentially evolutionary paradigm—one that may gradually recalibrate the balance between competition policy and source-identifying function in the context of colour marks.

b) What specific requirements must accompany an application for a colour Trademark (e.g., colour codes such as Pantone, graphical representation, or description)?

Considering that under the Brazilian Industrial Property Law (Law No. 9.279/96), colour *per se* is not registrable, except when arranged or combined in a distinctive and peculiar manner (Article

124, VIII), the registration of a single colour (e.g. ) — without a claim of acquired distinctiveness — would not be acceptable.

Therefore, the formal requirements for registering a colour combination as a trademark will depend on how the colours are arranged.

In general, such applications are filed as **figurative trademarks**, and at the time of filing, a graphical representation of the sign must be attached to the application.

Where protection is sought specifically for colours, the applicant must expressly indicate the appropriate Vienna Classification codes that best describe the mark, in accordance with the International Classification of the Figurative Elements of Marks under the Vienna Agreement. By

way of practical example, an application for a mark  consisting of two parallel horizontal bands — one in red and the other in blue — could include the following Vienna Codes:

- 29.1.1 (Red, pink, orange)
- 29.1.4 (Blue)
- 26.11.2 (Two lines or bands)
- 26.11.8 (Horizontal lines or bands)
- 29.1.12 (Two predominant colours)

In cases involving colour combinations, particularly minimal configurations such as bands or stripes, a clear description of the arrangement and proportion of the colours is strongly recommended, although not mandatory. The correct selection of Vienna Codes and the precision of the chromatic description are important, as they may influence both substantive examination and third-party clearance searches.

By contrast, where the applicant seeks to register a single colour as a trademark, the procedural approach differs, as the applicant must expressly invoke and substantiate acquired distinctiveness. The specific procedural requirements applicable to such a claim are set out below.

c) Is Evidence of distinctiveness required during prosecution of a colour Trademark Application at the Trademark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

As previously explained, under Brazilian practice, colour per se and some simple colour combinations are generally considered devoid of inherent distinctiveness. However, in exceptional circumstances, a sign that was originally non-distinctive may acquire registrability through use, pursuant to Chapter XVI-A of BPTO Ordinance No. 8/2022.

This phenomenon — referred to as **acquired distinctiveness** (*distintividade adquirida*) — occurs when the use of the sign leads the relevant Brazilian public to associate the colour configuration directly with a single commercial source.

In such cases, the sign gains a secondary meaning, adding a trademark function to its original descriptive or ornamental meaning.

The recognition of acquired distinctiveness is **not automatic** and must be expressly requested by the applicant.

It may only be requested at specific procedural moments:

- At the time of filing;
- Within 60 days from publication of the application;
- Upon filing an appeal against a refusal based on lack of inherent distinctiveness;
- When responding to an opposition grounded on lack of distinctiveness; or
- In counterarguments within administrative nullity proceedings.

If not requested within these procedural windows, the claim will not be examined.

Importantly, once the request is made, the applicant must, within 60 days, file a specific petition for the submission of evidence.

For colour marks, the evidentiary burden is particularly high due to their inherently ornamental nature.

The applicant must demonstrate:

(i) Substantially continuous use

The colour mark must have been used substantially and continuously during the **three years immediately preceding** the request for recognition of acquired distinctiveness.

(ii) Recognition by a significant portion of the national Brazilian public

It must be shown that a relevant segment of the Brazilian consumer public perceives the colour configuration itself — and not other brand elements — as an indicator of origin.

The BPTO requires that the evidence demonstrate that the colour sign has gone beyond its primary meaning (e.g., decoration or aesthetic element) and has acquired a trademark function.

For colour marks, the most relevant types of evidence include:

➤ **Market Research**

Market surveys are considered the most appropriate instrument to demonstrate that consumers associate the colour (or colour combination) with a single commercial source.

The survey must:

- Be methodologically reliable;
- Be nationally representative;
- Focus specifically on the colour configuration as filed.

➤ **Evidence of Use and Market Presence**

- Sales data in Brazil;
- Geographic distribution across all regions of the country;
- Duration and continuity of use;
- Market share within the relevant sector.

Critically, the evidence must demonstrate **national scope**. Regional evidence (e.g., limited to the state of São Paulo) will not be sufficient.

➤ **Advertising and Investment Evidence**

- Advertising expenditures in Brazil;
- Campaigns prominently featuring the colour configuration;
- Media coverage with national reach;
- Identification of the type of media used (TV, radio, internet, influencers, etc.).

Importantly, investment figures alone are insufficient. The applicant must demonstrate how

those investments contributed to consumer recognition of the colour mark.

A particularly important rule for colour marks is that: The evidence must relate to the sign in the exact form in which registration is sought.

If the applicant files a claim for a colour mark in isolation, but the evidence shows use only in combination with strong word or figurative elements, the BPTO may disregard the evidence, since it cannot assess whether recognition derives from the colour itself or from the accompanying elements.

For example:

- If a gradient is filed alone, the evidence must demonstrate recognition of the gradient itself.
- Use of the colour only together with a prominent word mark may be insufficient.

Recognition of acquired distinctiveness will be limited strictly to the goods or services for which evidence is provided.

If the applicant demonstrates acquired distinctiveness only in relation to one product within a broader specification, the recognition will be restricted accordingly.

The BPTO also evaluates whether the colour configuration is used exclusively by the applicant.

If similar colour arrangements are widely used by competitors in the same market segment, this will strongly undermine the claim of acquired distinctiveness.

For colour marks, this is particularly relevant in sectors where certain colours are customary (e.g., green for eco-products, blue for cleaning products, etc.).

The BPTO expressly clarifies that acquired distinctiveness is not equivalent to notoriety.

The objective is not to demonstrate that the brand is famous, but rather that:

The semantic perception of the sign has changed, such that the relevant public understands the colour configuration itself as an indicator of origin.

Given the exceptional nature of acquired distinctiveness and the high evidentiary threshold — including:

- Three years of continuous use,
- National scope,
- Consumer recognition evidence,
- Strict identity between use and filing,

acquired distinctiveness for colour marks in Brazil should be considered a demanding and evidence-intensive route.

For minimalist colour configurations, particularly single colours or simple stripe combinations, robust survey evidence will often be decisive.

It is important to add that under Brazilian practice, the recognition of acquired distinctiveness is not permanent. Where a trademark — including a colour mark — has been registered on the basis of secondary meaning, the distinctiveness must be reaffirmed upon renewal.

Pursuant to Ordinance BPTO/PR No. 15/2025 and the corresponding provisions incorporated into the Trademark Guidelines, the registrant must demonstrate, at the time of renewal (every ten years), that the sign continues to be perceived by the relevant Brazilian public as an indicator of commercial origin.

Although a trademark registered on the basis of acquired distinctiveness enjoys the same ten-year term of protection as any other Brazilian trademark registration — renewable for successive ten-year periods — the recognition of secondary meaning is not indefinite. It must be substantiated periodically.

Considering that the formal recognition of acquired distinctiveness as an express procedural mechanism is a recent development in Brazil, implemented in November 2025, there is still very limited administrative practice under this regime.

There are no publicly documented cases to date on the basis of acquired distinctiveness for a single colour or colour combination alone. As far as publicly accessible information indicates, only one request for recognition of acquired distinctiveness has been filed thus far, and it concerns the design configuration of a bag rather than a single-colour claim.

Accordingly, although the legal framework now allows for the registration of otherwise non-distinctive signs — including, in theory, single colours — the practical viability of such filings remains largely untested in the Brazilian system.

2. Examples of Registered Colour Trademarks

Please provide examples of Colour Trademarks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trademark Registration.

Example 1



Mark: Colour Combination (Green and Red Stripes)

Holder: Guccio Gucci S.p.A.

Nature: Figurative mark consisting exclusively of colour bands

Registration nos: 818461373; 818461381; 818461390; 830742158; 830742166; 830742247; 830742255; 830742263; 840712170; 914237098; 914237179; 914237284; 914237330

Classes: 03, 09, 12, 14, 18, 25, 26, 28 and 35.

Example 2



Mark: Colour combination (Blue, White and Gold stripes)

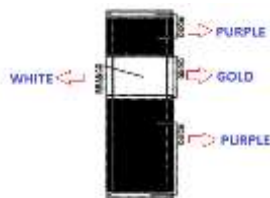
Holder: Visa International Service Association

Nature: Figurative mark consisting exclusively of colour bands

Registration no: 006088244

Class: 36

Example 3



Mark: Colour combination (Composed exclusively of a predominant purple background and a broad white band in the center delineated by a thin gold outline)

Holder: CADBURY UK LIMITED

Nature: Figurative mark consisting exclusively of colour bands

Registration no: 820456764

Class: 30

Example 4



Mark: Colour Combination (Colour Gradient: Purple, Pink, Orange and Yellow)

Holder: Instagram, LLC

Nature: Figurative mark consisting exclusively of gradient of colours

Registration nos: 916503453 and 916503623

Classes: 09 and 42

3. Legal Framework for Colour Trademarks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trademarks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trademarks are dealt with.

a) Relevant statutes, regulations, and case law

The legal framework governing colour trademarks in Brazil is primarily established by **Law No. 9.279/1996 (Industrial Property Law – LPI)**, notably:

- **Article 122**, which provides that any visually perceptible sign capable of distinguishing goods or services may be registered, provided it is not legally prohibited; and
- **Article 124, VIII**, which expressly prohibits the registration of “colors and their names” except when arranged or combined in a **distinctive and peculiar manner**.
- In addition, **Article 124, VI** plays a complementary role, as it bars the registration of signs that are descriptive of the goods or services or their characteristics. This provision is frequently applied in conjunction with Article 124, VIII in cases involving colour-related

signs.

At the administrative level, examination practice is guided by:

- The **Trademark Guidelines (Manual de Marcas)** issued by the Instituto Nacional da Propriedade Industrial; and
- **BPTO Ordinance No. 8/2022**, as amended, which introduced **Chapter XVI-A**, formally regulating the recognition of **acquired distinctiveness (secondary meaning)** during examination.

More recently, **BPTO/PR Ordinance No. 15/2025** clarified that trademarks registered on the basis of acquired distinctiveness remain subject to **reassessment of distinctiveness upon renewal**, reinforcing the non-absolute and evidence-dependent nature of such protection.

From a judicial perspective, Brazilian case law specifically addressing colour marks remains limited and not fully consolidated, particularly in relation to colours per se.

There is no consolidated or binding precedent in which a single colour has been upheld as registrable solely on the basis of acquired distinctiveness.

Nevertheless, the doctrine of acquired distinctiveness is well established in Brazilian jurisprudence. The Superior Tribunal de Justiça has consistently recognized that signs originally lacking inherent distinctiveness may become protectable if it is demonstrated that the relevant public associates the sign with a single commercial source.

A particularly illustrative precedent in the context of colour-related signs is the case involving the protection of the red sole used by Christian Louboutin. After repeated refusals by the Instituto Nacional da Propriedade Industrial, the matter was brought before the judiciary, and a Federal Court decision ultimately recognized the registrability of the sign as a **position mark**, based on evidence of acquired distinctiveness. The court concluded that the red sole had transcended its ornamental function and was perceived by a significant portion of the relevant public as an indicator of origin.

From a doctrinal standpoint, this case has been analyzed as reflecting the interaction between trademark protection and competition policy, highlighting the need to balance exclusivity with the preservation of market access. It also illustrates a degree of divergence between administrative practice—traditionally restrictive—and judicial interpretation, which may adopt a more flexible, evidence-based approach.

Importantly, the protection granted in that case did not extend to the colour in the abstract, but rather to its application in a **specific and consistent position** (the outsole of footwear). As such, the decision does not establish the registrability of colour per se in Brazil, but confirms that colour may be protected when embedded within a distinctive configuration and supported by robust evidence of consumer recognition.

This interpretative flexibility is also reflected in more recent case law from the Tribunal Regional Federal da 2ª Região, which has jurisdiction over appeals involving the Instituto Nacional da Propriedade Industrial. In **Appeal No. 5020331-06.2024.4.02.5101**, the court emphasized that the assessment of distinctiveness should not be purely formalistic, but must take into account the **perception of the relevant public and the factual context of use**. The decision reinforces the principle that even signs traditionally regarded as weak may acquire source-identifying

capacity when supported by sufficient evidence.

Although that case does not concern a colour mark in isolation, but rather a trademark



application for a figurative sign representing a chainsaw in grey and orange (initially rejected by the BPTO on the grounds of lack of inherent distinctiveness—the court ultimately adopted a more flexible approach, reassessing the sign in light of its overall presentation and market context.

While not directly addressing colour marks per se, the decision is relevant in confirming a broader judicial tendency toward a contextual and evidence-based analysis of distinctiveness, which may have direct implications for the assessment of colour-related signs under Brazilian law.

Taken together, these authorities indicate that, while the statutory framework remains formally restrictive—particularly under Article 124, VIII—Brazilian courts have shown openness to a more flexible approach grounded in **market perception and evidentiary substantiation**. This evolving dynamic suggests a gradual, though cautious, shift from categorical exclusion toward a more functional assessment of distinctiveness.

b) If applicable, please outline any guidance provided by the Trademark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trademark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

Brazilian legislation and administrative practice do not establish a fully harmonized or detailed standard regarding the precise scope of protection afforded to colour trademarks.

As a general rule, the protection of such marks is interpreted **narrowly**, reflecting the underlying policy objective of preserving colours as elements of the public domain and avoiding undue restrictions on competition.

Unlike some jurisdictions, Brazilian practice **does not require the mandatory specification of colour codes** (such as Pantone references). Instead, the scope of protection is typically determined by:

- The **graphical representation** of the mark as filed;
- Any **description of the colour arrangement** provided by the applicant; and
- The **Vienna Classification codes** assigned to the mark.

Accordingly, the extent of protection tends to be assessed based on the **overall visual impression** of the sign, rather than strict technical delimitation of a specific shade.

In practice:

- Protection is generally limited to the **specific configuration, proportion, and arrangement** of the colours as represented in the application;
- Broader claims to exclusivity over a colour or shade are viewed with caution; and
- Variations in hue, contrast, or layout may be sufficient to avoid a likelihood of confusion,

particularly where the mark lacks strong inherent distinctiveness.

Where acquired distinctiveness is recognized, the scope of protection may, in principle, be broader, but only to the extent supported by evidence demonstrating that the relevant public associates the colour configuration itself with a single commercial source.

A relevant illustration of the practical scope of protection afforded to colour-related elements can be found in infringement case law involving the red sole used by Christian Louboutin. In a decision rendered by the Tribunal de Justiça de São Paulo, the court recognized that the use of a red outsole in high-heeled shoes constituted a distinctive element associated with a single commercial source and granted injunctive relief against a competitor.

In that case, the court held that the unauthorized reproduction of the red sole amounted to **unfair competition and misappropriation of trade dress**, even in the absence of a formally granted trademark registration. The decision emphasized that the relevant public associates that specific visual feature with the claimant, and that such association is sufficient to justify legal protection.

Notably, the court considered that the distinctiveness of the sign did not depend on high inherent originality, but rather on its **recognition by consumers as a source identifier**. It further acknowledged that the similarity between the products was capable of generating confusion and diverting clientele, thereby justifying injunctive relief.

This line of reasoning demonstrates that, in Brazil, the scope of protection for colour-related elements may extend beyond the strict limits of registration, particularly where strong evidence of market recognition exists. It also confirms that courts may afford protection to colours as part of a broader **trade dress or overall commercial impression**, even in the absence of formal trademark rights.

Overall, the Brazilian approach reflects a **case-by-case and competition-sensitive assessment**, in which the formal scope of registered rights tends to be interpreted narrowly, while judicial protection may, in appropriate circumstances, extend more broadly based on principles of unfair competition and consumer perception.

4. Opposition and Invalidation Procedures for Colour Trademarks

Please describe the forum (e.g., Trademark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trademark in your jurisdiction. Are there any unique considerations for Colour Trademarks compared to other types of Trademarks?

In Brazil, the opposition, cancellation, and invalidation of trademarks—including colour marks—may be pursued through both **administrative and judicial mechanisms**.

Opposition proceedings

Oppositions are filed before the Instituto Nacional da Propriedade Industrial within **60 days from the publication** of the trademark application.

The procedure is administrative and allows third parties to challenge an application based on:

- **Absolute grounds**, such as lack of distinctiveness or violation of Article 124, VIII; and/or
- **Relative grounds**, such as likelihood of confusion with prior rights.

In the context of colour marks, oppositions frequently argue that:

- The colour or colour combination is **non-distinctive or merely ornamental**;
- The arrangement does not meet the threshold of a “distinctive and peculiar” composition; or
- Granting exclusivity would unduly restrict competition in the relevant market.

Where acquired distinctiveness is invoked, opponents typically challenge the **adequacy and scope of the evidence submitted**, particularly in relation to consumer perception and national reach.

Administrative nullity proceedings

Following registration, a trademark may be challenged through an **administrative nullity action** before the Instituto Nacional da Propriedade Industrial within **180 days from the grant date**. The Office may also initiate such proceedings ex officio.

For colour marks, nullity actions commonly focus on:

- The absence of inherent distinctiveness;
- Failure to meet the requirement of a “distinctive and peculiar” arrangement; or
- Insufficient evidence supporting acquired distinctiveness, where applicable.

Judicial nullity and infringement actions

After the 180-day administrative period has elapsed, challenges to a registered mark must be brought before the **Federal Courts**.

Judicial proceedings may seek:

- A declaration of nullity of the registration; and/or
- Enforcement of trademark rights in infringement actions.

Courts generally adopt a broader evidentiary approach, allowing for a more flexible assessment of:

- Consumer perception;
- Market conditions; and
- The existence of acquired distinctiveness.

Non-use cancellation

Registered trademarks may also be subject to cancellation for **non-use** if they have not been used in Brazil for **five consecutive years**.

For colour marks, demonstrating genuine use may present particular challenges, especially where:

- The colour is used only in conjunction with other distinctive elements; or
- The use does not correspond precisely to the registered configuration.

5. Use of Color Trademarks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trademarks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trademarks?

Brazilian trademark law does not currently establish specific rules or a distinct legal regime governing the registration or enforcement of colour trademarks in digital or virtual environments, such as websites, mobile applications, or virtual reality platforms.

Instead, colour marks used in these contexts are assessed under the **general principles of trademark law**, as set out in Law No. 9.279/1996 (Industrial Property Law – LPI), and interpreted by the Instituto Nacional da Propriedade Industrial and the courts.

From a registrability standpoint, the same criteria apply irrespective of the medium in which the mark is used. Accordingly:

- Colours per se remain, in principle, non-registrable under Article 124, VIII, unless arranged in a **distinctive and peculiar manner**;
- Colour combinations or visual interfaces (e.g., app layouts, website colour schemes) may be protected as **figurative marks**, provided they are represented graphically and are capable of distinguishing goods or services; and
- Where inherent distinctiveness is lacking, protection may depend on **acquired distinctiveness**, demonstrated through use and consumer recognition.

In digital environments, however, certain practical considerations may influence the distinctiveness analysis. For example:

- User interface (UI) design elements, including colour schemes, are often perceived as functional or aesthetic rather than source-identifying;
- The widespread use of similar colour patterns across digital platforms (e.g., blue for technology services, green for sustainability-related applications) may weaken claims to exclusivity; and
- The dynamic or variable nature of digital displays (e.g., responsive design, dark mode adaptations) may complicate the definition of a consistent and protectable colour configuration.

From an enforcement perspective, Brazilian courts generally apply traditional doctrines—particularly **likelihood of confusion** and **unfair competition**—to disputes arising in digital contexts.

In this regard, the judiciary has shown willingness to protect distinctive visual elements, including colour, when they form part of a recognizable **trade dress or overall commercial impression**, even in online environments. The analysis typically focuses on:

- Whether the colour element is perceived by users as an indicator of origin;
- The degree of similarity between competing digital interfaces; and
- The potential for confusion, association, or diversion of clientele.

Although there are no widely recognized precedents specifically addressing colour trademarks in virtual or immersive environments (such as virtual reality or the metaverse), the existing legal framework is considered sufficiently adaptable to address such scenarios.

In practice, therefore, colour marks used in digital and virtual contexts are treated **consistently with traditional trademark principles**, with particular emphasis on **consumer perception, consistency of use, and evidentiary support**.

Overall, while Brazilian law does not yet provide tailored guidance for emerging digital environments, both administrative and judicial practice suggest a **technology-neutral approach**, allowing existing doctrines to be applied flexibly to new forms of commercial interaction.

6. Enforcement of Colour Trademarks

Please provide examples of cases in your jurisdiction where registered Colour Trademarks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

Brazilian case law specifically addressing the enforcement of registered colour trademarks per se remains limited. In practice, disputes involving colour elements are more frequently analyzed under the broader doctrines of trade dress, likelihood of confusion, and unfair competition, rather than as standalone colour mark enforcement.

Nevertheless, existing jurisprudence provides useful guidance on how Brazilian courts approach the protection of colour-related signs.

a) Successful enforcement: recognition of distinctiveness and risk of confusion

Brazilian courts have shown willingness to protect colour-related elements where there is clear evidence that the sign:

- functions as an **indicator of origin**, and
- its unauthorized use is likely to **cause confusion or divert clientele**

For example, the Tribunal de Justiça de São Paulo has repeatedly recognized **unfair competition** in cases involving the misuse of distinctive brand elements.

In one line of cases involving online advertising and brand misuse, the court found that the use of a competitor's distinctive sign in sponsored links constituted **unlawful diversion of clientele**, emphasizing that consumer confusion and association were sufficient to justify protection.

Similarly, in cases involving misuse of marks in commercial contexts, the court has granted:

- **injunctive relief**, and
- **damages**,

based on the finding that the defendant sought to benefit from the **reputation and**

distinctiveness of the claimant's sign.

Although these cases do not always involve colour marks in isolation, they are highly relevant because they confirm that **distinctive visual elements (including colour)** are protectable where:

- they are recognized by consumers, and
- their use creates **association or confusion**.

This reasoning is directly applicable to colour trademarks, particularly those supported by evidence of acquired distinctiveness.

b) Unsuccessful enforcement: lack of exclusivity over colours and weak distinctiveness

Conversely, Brazilian courts have also made clear that **colours alone—especially when common in the sector—do not confer broad exclusivity**.

A particularly illustrative decision from the Tribunal de Justiça de São Paulo involved allegations of trade dress imitation based largely on **similar colour schemes in product packaging**.

The court rejected the claim, holding that:

- **“there is no exclusivity in the use of colours”**, and
- the presence of similar colours, even combined with other elements, was insufficient to establish unfair competition in the absence of clear evidence of confusion or distinctiveness.

The decision also emphasized that:

- similar colour patterns were **widely used in the market**, and
- this weakened any claim to exclusivity.

This case illustrates a key limitation in Brazilian practice: **colour, as an isolated element, is generally considered weak unless strongly associated with a single source**.

c) Cases where enforcement failed due to evidentiary shortcomings

Brazilian courts also place significant weight on the quality of evidence, particularly in digital contexts.

In another decision involving alleged misuse of a mark in online advertising, the Tribunal de Justiça de São Paulo denied compensation despite acknowledging that the practice could, in theory, constitute unfair competition.

The claim failed because:

- the **evidence was insufficient**, and
- the submitted materials (e.g., search result screenshots) did not conclusively demonstrate misuse or consumer confusion.

This reinforces an important practical point: Even where legal grounds exist, **weak or inconclusive evidence can be decisive against enforcement**.

d) Key factors influencing the outcome of colour-related disputes

Across Brazilian case law, the outcome of disputes involving colour elements is primarily determined by the following factors:

1. Distinctiveness (central factor)

- Whether the colour (or colour combination) is perceived as a **source identifier**
- Strongly linked to **acquired distinctiveness**

2. Evidence of consumer perception

Courts consistently emphasize the need to show that consumers:

- associate the colour with a single undertaking, and
- may be confused by similar uses

3. Market context and sector practices

- If similar colours are commonly used in the industry, protection is significantly weakened

4. Overall impression (trade dress analysis)

- Courts rarely assess colour in isolation
- Instead, they evaluate the overall visual identity

5. Likelihood of confusion or association

Central to findings of infringement and unfair competition

Includes:

- confusion as to origin
- false association
- diversion of clientele

6. Quality and robustness of evidence

Particularly important in:

- digital environments
- advertising disputes
- Weak evidence can defeat otherwise valid claims

e) General conclusion

Brazilian enforcement practice confirms a consistent pattern:

Successful cases:

→ strong evidence of **distinctiveness + consumer association + confusion**

Unsuccessful cases:

→ colour treated as **ornamental, common, or insufficiently distinctive, or**
 → **lack of robust evidence**

Overall, while colour marks face significant hurdles at the registration stage, their **enforcement in practice is largely aligned with broader unfair competition and trade dress principles**, with courts adopting a **fact-intensive and evidence-driven approach**.

7. Strategies for Managing Colour Trademark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trademark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trademark Office or in the Courts?

Given the traditionally restrictive approach of Brazilian law—particularly under Article 124, VIII of the Industrial Property Law—successful management of colour trademarks requires a **highly strategic and evidence-driven approach** from the outset.

Filing strategies

Applicants should prioritize structuring the mark in a way that maximizes its chances of overcoming the prohibition on colours per se. In practice, this includes:

- **Avoiding claims to colour in isolation**, unless there is a well-supported argument for acquired distinctiveness;
- Presenting the colour as part of a **distinctive configuration**, such as a figurative mark, position mark, or stylized composition;
- Providing a **clear and precise graphical representation**, including proportions and spatial arrangement of the colours; and
- Including a **description of the colour arrangement**, even if not mandatory, to reinforce the distinctiveness of the configuration.
- Where possible, applicants should consider filing **parallel applications**, combining:
 - a broader figurative mark (with colour), and
 - a version including additional distinctive elements (e.g., word or logo),
 - to ensure layered protection.
- In sectors where colour plays a functional or customary role, it is advisable to **narrow the specification of goods/services** to those where the colour is less likely to be perceived as descriptive or ornamental.

Use of acquired distinctiveness

Where inherent distinctiveness is weak or absent, the most effective strategy is to rely on **acquired distinctiveness (secondary meaning)** before the Instituto Nacional da Propriedade Industrial.

In such cases, the evidentiary strategy is critical. The most persuasive types of evidence include:

- **Market surveys**, demonstrating that consumers associate the colour (or colour configuration) with a single source;
- **Evidence of long-standing and consistent use**, particularly over at least three years in

Brazil;

- **Nationwide sales and market share data**, showing significant commercial presence;
- **Advertising materials and investment figures**, especially where the colour is prominently featured; and
- **Media coverage and brand recognition indicators.**
- A key practical point is that the evidence must demonstrate recognition of the **colour itself**, rather than recognition derived from accompanying word or figurative elements.

Opposition and defense strategies

In opposition or defence proceedings, the strategy typically turns on how the colour element is framed:

To oppose:

- Argue that the sign is **merely ornamental or decorative**, lacking source-identifying function;
- Demonstrate that the colour or combination is **common in the relevant sector**;
- Emphasize the absence of a “**distinctive and peculiar arrangement**”; and
- Challenge any claim of acquired distinctiveness by attacking the **methodology, scope, or relevance of the evidence.**

To defend:

- Focus on the **overall commercial impression** of the mark;
- Demonstrate **consistent and exclusive use** of the colour configuration;
- Highlight **consumer recognition**, preferably through survey evidence; and
- Argue that the sign has transcended its ornamental function and now performs a **source-identifying role.**

Enforcement strategies:

In enforcement, colour marks are most effectively protected not in isolation, but as part of a broader **trade dress or visual identity.**

Successful enforcement strategies typically include:

- Framing the infringement as **unfair competition**, rather than relying solely on formal trademark rights;
- Demonstrating **likelihood of confusion, association, or diversion of clientele**;
- Providing **visual comparisons** highlighting similarity in overall impression; and
- Submitting robust evidence of **market recognition and reputation.**
- Courts tend to be more receptive where the colour is shown to be a **central and recognizable feature** of the brand’s identity.

b) Can you provide any insights as to the co-existence of Colour Trademarks in your jurisdiction.

Coexistence of colour trademarks is relatively common in Brazil, largely due to the **narrow scope of protection** afforded to such signs.

Because protection is typically limited to the **specific configuration, arrangement, and context**

of use, multiple parties may use similar or even identical colours, provided that:

- The **overall presentation** of the marks differs sufficiently; and
- There is no **likelihood of confusion or undue association**.

In practice:

- Identical colours may coexist across **different sectors**, where consumer confusion is unlikely;
- Even within the same sector, coexistence may be accepted where colours are applied in **distinct layouts, proportions, or combinations**; and
- Coexistence is particularly common in industries where certain colours are **customary or functional** (e.g., green for environmental products, blue for cleaning or technology services).

From a strategic perspective, this means that applicants should not rely on colour alone, but should seek to build protection around a **distinctive overall visual identity**.

c) [Are there additional fees for Registration and Renewal of Colour Trademarks in your jurisdiction?](#)

Under Brazilian practice, there are **no additional official fees specifically associated with colour trademarks as a category**.

Applications for colour marks—typically filed as figurative marks—are subject to the **same official filing, registration, and renewal fees** applicable to other types of trademarks before the Instituto Nacional da Propriedade Industrial.

However, where the applicant seeks to rely on **acquired distinctiveness (secondary meaning)**, additional official fees may apply. This is because the recognition of acquired distinctiveness requires the filing of **specific petitions within the applicable procedural windows**, including:

- a formal request for recognition of acquired distinctiveness; and
- a subsequent petition for the submission of supporting evidence.

These procedural steps are subject to **separate official fees**, which increase the overall cost of prosecution.

In addition, colour trademark applications—particularly those relying on acquired distinctiveness—often involve **higher overall costs in practice**, due to:

- the need for **robust evidentiary submissions**, such as market surveys and expert reports;
- the preparation of detailed documentation demonstrating use and consumer recognition; and
- a higher likelihood of **oppositions, office actions, or appeals**, given the restrictive approach to colour marks.

Accordingly, while official fees for registration and renewal are formally equivalent to those of other trademarks, the **total cost of obtaining and maintaining protection for colour marks may be significantly higher in practice**, especially where acquired distinctiveness is invoked.

8. Colour Depletion

Due to the Registration of Colour Trademarks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

Brazilian trademark law does not expressly recognize the concept of “colour depletion” as a formal legal doctrine. However, the underlying concern—namely, the risk that granting exclusive rights over colours may unduly restrict competition—is **clearly embedded in the statutory framework and administrative practice**.

This concern is most directly reflected in **Article 124, VIII of the Industrial Property Law (Law No. 9.279/1996)**, which prohibits the registration of “colors and their names,” except when arranged or combined in a **distinctive and peculiar manner**. The provision is widely understood as embodying a **competition-oriented policy**, aimed at preserving colours as elements of the public domain and ensuring their continued availability to market participants.

In practice, the Instituto Nacional da Propriedade Industrial applies this principle by:

- Adopting a **restrictive approach to colour per se**, which are generally deemed non-registrable;
- Requiring that colour combinations demonstrate a **specific and non-ornamental configuration**; and
- Closely scrutinizing whether the claimed colour arrangement is **customary or functional within the relevant sector**.

These practices effectively mitigate the risk of colour depletion by limiting the circumstances under which exclusive rights may be granted.

Judicial decisions also reflect sensitivity to this issue. Brazilian courts frequently emphasize that **colours, in isolation, do not confer exclusivity**, particularly where they are commonly used in the relevant market. In disputes involving trade dress or visual similarity, courts have often rejected claims based solely on colour, noting that broad monopolization of colours would be incompatible with the principles of **free competition**.

At the same time, Brazilian law allows for a degree of flexibility through the recognition of **acquired distinctiveness**. In exceptional cases where a colour or colour configuration has become strongly associated with a single commercial source, protection may be granted.

However, the evidentiary threshold for such recognition is intentionally high, requiring robust proof of **consumer perception, long-standing use, and market exclusivity**.

This high threshold serves as an additional safeguard against colour depletion, ensuring that exclusivity is granted only where it is clearly justified and does not unduly hinder competitors.

Overall, while the concept of “colour depletion” is not explicitly articulated in Brazilian law, it is **implicitly addressed through a combination of statutory restrictions, administrative scrutiny, and judicial interpretation**. The Brazilian system therefore reflects a cautious balance between protecting distinctive signs and preserving the availability of colours for general commercial use.

9. About the Contributor for the Brazilian section



Juliana Hoffmann is a Partner at Daniel Law, a Brazil-based full-service Technology and Intellectual Property firm operating across Latin America. She has been active in the IP field since 2014, specializing in trademark strategy, brand protection, and enforcement. Juliana advises national and international clients on complex legal challenges related to the protection and commercialization of IP assets in dynamic and globalized markets. She is also an active contributor to industry discussions and collaborative initiatives on the evolving landscape of intellectual property and technology

CANADA

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Yes, a single colour or combination of colours may be registered as a trademark in Canada.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

If a trademark consists of a single colour or combination of colours without delineated contours, a statement to that effect must be included in the application. For a trademark consisting of colour per se to be clearly defined, the application must include a description that provides the common name of the colour. A visual representation consisting of a square swatch in each colour is also required. The application must not include a statement that colour is claimed as a feature of the trademark. An example of an acceptable description of a colour per se trademark would be: “The trademark consists exclusively of the colour red without delineated contours, as shown in the visual representation”. An applicant may reference a colour identification system provided that they also name the colour. The following is an acceptable example of such a reference: “Colour is claimed as a feature of the trademark. The letter “A” in the trademark is the colour light blue (PANTONE* 317C). *PANTONE is a registered trademark.” Applications which claim colour(s) as a feature of the trademark must provide an indication, by way of written description, of the principal parts of the trademark that are in each colour. What constitutes the “principal parts” of a particular trademark will depend on the complexity of the trademark. However, in general, the application need only describe the readily-identifiable elements of a trademark that appear in each colour. For example, if a trademark contained a forest scene, an acceptable colour claim might be: “Colour is claimed as a feature of the trademark. The sky is blue, the grass is green, the tree trunks are brown and the leaves are red, orange, and yellow.” If a trademark contains a colour claim and a colour appears in gradations, the application should describe the transition. For example, acceptable colour claims for trademarks that contain a gradation of colour(s) could read: “Colour is claimed as a feature of the trademark. The spheroid design transitions from dark red in the upper-left portion to light red in the lower-right portion.” or “Colour is claimed as a feature of the trademark. The swirl design transitions left to right from purple to red to blue.”

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

Paragraph 32(1)(c) of the *Trademarks Act* provides that if a trademark consists exclusively of a single colour or of a combination of colours without delineated contours, the Registrar of Trademarks may require an applicant to file evidence establishing that the trademark is distinctive at the filing date (not taking into account any priority filing date). When submitting evidence of distinctiveness, the applicant must file a master affidavit. If the affidavit is filed on behalf of a company, it must be sworn by a knowledgeable officer. The affidavit should be accompanied by specimens of the trademark as used in relation to the goods or services in the application and describe how the mark is used in Canada. Subsection 32(2) of the *Trademarks Act* provides that if the evidence only shows acquired distinctiveness in certain territorial areas of the country, the Registrar may limit the registration to such areas. Trademarks that consist of colour(s) applied to the surface of a three-dimensional object will generally not be considered inherently distinctive if research shows that they are commonly or generically used by a number of traders in the related marketplace. The Canadian Intellectual Property Office has cited as an example of this principle that the colour red applied to the surface of a fire hydrant lacks any inherent distinctiveness in association with the goods “hydrants” or the services “delivery of water for fire suppression purposes” but would be considered to have some inherent distinctiveness in association with “retail sale of hot peppers”.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

A Canadian company successfully registered the colour yellow, as shown in the visual representation below, in association with debris chutes in class 19:



Deere & Company has registered the combination of the colours yellow and green without delineated contours in classes 7, 8 and 12 for various agricultural machines and lawn mowers:



3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Section 2 of the *Trademarks Act* provides the following definitions that collectively protect colour as a trademark: (a) “trademark” means a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others; and (b) “sign” includes a ... colour. Paragraph 31(f) of the *Trademarks Regulations* provides that if colour is claimed as a feature of a trademark, a statement to that effect, along with the name of each colour claimed and an indication of the principal parts of the trademark that are in that colour, must be included. Paragraph 31(g) of the Regulations provides that if a trademark consists exclusively of a single colour or a combination of colours without delineated contours, a statement to that effect, along with the name of each colour, must be included in the application.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

The Canadian Intellectual Property Office has not provided any guidance when it comes to the scope of protection provided by a colour trademark registration.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

If a third party wishes to oppose a trademark application that has been approved by the Registrar for advertisement, it must file a statement of opposition with the Trademarks Opposition Board. A third party wishing to invalidate a registration for a colour mark would need to file an application with the Federal Court.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

In a trademark application for a hologram, colour can be claimed as a feature of the trademark, such as “The trademark consists of a hologram of a map of the world as depicted in the visual representation. The trademark has a holographic rainbow colour effect and the applicant claims

the colours red, orange, yellow, green, blue, indigo, violet as a feature of the trademark.” Also, in a trademark application for a moving image, colour can be claimed as a feature of the animation provided that the application contains a statement to that effect and the visual representation(s) is in colour.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

In *Rothmans Benson & Hedges Inc v Imperial Tobacco Products Limited* 2015 FCA 111, the Federal Court of Appeal considered two trademark applications that had been filed by Imperial Tobacco for the colour orange as applied to cigarette packages in two-dimensional and three-dimensional forms. On appeal, the Court held that Imperial Tobacco’s evidence showed that it had adopted the colour orange as a trademark by itself and had used the colour as a trademark.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

A trademark owner who wishes to register a colour per se trademark in Canada should, before filing a trademark application, carefully review their use to date and confirm that they can provide adequate evidence of acquired distinctiveness as of the filing date of their application. The trademark owner should then gather its evidence of acquired distinctiveness (see section 1(c) above) so that they can meet CIPO’s strict criteria for establishing acquired distinctiveness. A party who wishes to oppose an application for a colour mark should consider whether it can be shown that third parties have used the same or a similar colour in Canada for similar goods and should consider whether the colour in question has functional attributes that would make it non-registrable.

- b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

The same principles would apply regarding the co-existence of colour trademarks as would apply to other categories of trademarks. For example, if a defendant wishes to show that Canadian consumers will be able to distinguish between their colour trademark and the plaintiff’s colour trademark, they could adduce evidence regarding the common use by third parties of similar colour marks in Canada and/or the co-existence of its mark with the plaintiff’s mark without actual confusion.

- c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No, the same fees that are applicable to other trademarks are also applicable to colour

trademarks.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

An application for registration of a colour will be rejected if the trademark is not inherently distinctive (see the example of red for fire hydrants discussed above) or if the colour is already being used by third parties for the same or similar goods/services. Aside from those scenarios, however, the Canadian Intellectual Property Office will not refuse registration of a colour trademark simply because it will reduce the range of colours that are available to other traders.

CHILE

Contributor: Mr. Matias Valenzuela of Covarrubias

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

In Chile, a single colour cannot be registered by itself as a trade mark. Article 20(i) of Law 19.039 expressly prohibits registering “the colour of products or packaging, as well as colour in itself.” However, colours can be protected when used within a specific and distinctive configuration, such as:

- Combinations of colours arranged in a defined layout,
- Position marks where the colour appears on a specific part of a product, or
- Trade dress incorporating colours in a distinctive overall presentation.

In these cases, the colour use must be precisely represented, clearly delimited, and distinctive (inherently or through acquired distinctiveness).

Thus, Chile does not allow protection of a colour *per se*, but does allow protection of colours within a defined, non-functional configuration capable of identifying origin.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

A colour trademark application must include:

1. A precise graphical representation showing the exact use of the colour.
2. Exact colour identification using recognised codes (Pantone, CMYK, RGB, HEX) or clear descriptive references.
3. A detailed verbal description specifying the colour(s) claimed and indicating where and how the colour appears, consistent with the representation and colour codes.

These elements ensure a clear and unambiguous definition of the scope of protection.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

In Chile, evidence of acquired distinctiveness may be required for colours trademark applications. In such cases, applicants must show that the colours—as *specifically applied*—

function as an indicator of commercial origin.

Accepted evidence includes:

- Long and continuous use in Chile,
- Sales figures and market share,
- Advertising materials and investment,
- Media recognition,
- Consumer surveys,
- Prior enforcement actions.

This evidence must show that consumers associate the specific colours configuration with a single commercial source.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

Representative examples include:

Registration No. 1452543 — Colour Combination (Green and Yellow)

Colours:

- Green (Munsell 9.47 GY3.57/7.45)
- Yellow (Munsell 5.06 Y7.63/10.66)



Description:

The visible parts of the machinery or vehicles are mainly green, with yellow parts, symbols, or details, as shown in the accompanying representation. Green elements predominate over yellow ones.

Classes:

- **Class 7:** Agricultural, forestry, and garden machinery and implements, including lawnmowers and equipment for soil, plant, and landscape maintenance.

- **Class 12:** Self-propelled agricultural and forestry machinery, including tractors, riding mowers, and trailers.

Owner: Deere & Company.

Registration No. 1455095 — Colour Combination (Various Pantone Shades)

Colours:



Pantone 2945 C (blue), Cool Gray 7C, Pantone 420 C (gray), Pantone Black 6C, and White (all specified with CMYK, RGB, and HEX codes).

Class: Training services; training workshops; education and teaching.

Owner: Celeris Servicios de Capacitación Limitada.

3. Legal Framework for Colour Trade Marks

- Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Relevant Statutes, Regulations, and Case Law in Chile

Colour Trade Marks in Chile are governed by the general trademark framework, mainly:

- **Industrial Property Law (Law No. 19.039)**

Article 20(i): the key rule. It prohibits protection of a *colour “in itself”* or colours applied in an undefined or functional manner.

Articles 19, 20(e) and 20(f): require distinctiveness and prohibit descriptive or non-distinctive signs.

- **Industrial Property Regulations**

Require clear graphic representation and precise descriptions for all non-traditional marks, including colours.

INAPI Practice and Case Law

Decision No. 180882 (Application No. 1.205.993, Class 30 – chocolates):

INAPI upheld an opposition and confirmed an absolute refusal under Article 20(e), (i) and (f) of the Industrial Property Law (LPI). The sign reproduced both the *shape* and *typical colour* of a chocolate bar widely used in the market, leaving no room for distinctiveness.



- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

In Chile, the scope of protection for colour trademarks is very narrow. INAPI and the Courts generally limit protection to the exact shade and specific configuration described in the application (e.g., Pantone code and precise placement). Protection does not extend to similar shades or broader colour families.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

In Chile, disputes over colour trade marks follow the same procedural structure as any other trademark:

INAPI (Trade Mark Office)

Handles oppositions to pending applications and invalidity actions (absolute and relative) against registered marks.

Industrial Property Court (TDPI)

Hears appeals against INAPI decisions.

Supreme Court

Reviews only legal issues through annulment actions.

Unique considerations for colour marks:

Colour marks face stricter scrutiny, mainly because Article 20(i) prohibits protection of a colour “in itself.”

5. Use of Color Trademarks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

In our jurisdiction, colour trademarks used in digital or virtual environments are treated the same as any other trademark. There are no specific guidelines or precedents tailored to online, app-based, or virtual-reality uses. Enforcement therefore follows the general principles of likelihood of confusion and proper representation of the colour as registered.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

In Chile, there are no widely reported or iconic cases specifically addressing the enforcement of *colour-only* trade marks, largely because Chilean practice restricts the registration of a colour *per se* unless it has acquired sufficient distinctiveness. However, Chilean authorities (INAPI and the Industrial Property Tribunal) have examined colour as part of the overall visual presentation of trademarks in several disputes involving graphic similarities.

A relevant example is the dispute between the Chilean paint company Tricolor and Target, where INAPI held that the visual similarity between the parties' circular colour designs could lead to consumer confusion, despite certain differences. The decision favoured the Chilean company.

7. Strategies for Managing Colour Trade Mark Applications

a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

To successfully file, oppose, defend, or enforce a colour trademark in our jurisdiction, the most effective strategies include:

- Providing strong evidence of acquired distinctiveness, such as long-standing use, market surveys, advertising investment, and consumer recognition.
- Submitting precise colour specifications (e.g., Pantone or equivalent codes) and clear representations showing how the colour is applied.
- Demonstrating consistent and exclusive use of the colour in commerce.
- In opposition or enforcement scenarios, focusing on the likelihood of confusion created by similar colour use, and addressing any functionality arguments raised by the other

party.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Colour trade marks often coexist in Chile because protection is very narrow and limited strictly to the exact shade and specific configuration described in the application. INAPI generally allows coexistence when:

- The colours are applied in different positions or layouts,
- The overall trade dress differs, or
- The colour is not claimed in the abstract (prohibited under Art. 20(i)).

Because the scope of protection is so restricted, multiple businesses can use similar or even identical colours as long as their applications are distinct, reducing the risk of conflict.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

In Chile, there are no additional or special fees for colour trademarks. Registration and renewal fees are the same as those applicable to any other trademark.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

Chile does not formally recognise the doctrine of “colour depletion.” There is no statutory or judicial reference to it. However, the Chilean trade mark system prevents colour depletion in practice through several mechanisms:

- Article 20(i) of Law 19.039, which prohibits registering a colour *per se*; protection is only allowed when the colour is precisely delimited, non-functional, and applied in a specific configuration.
- Very narrow protection for any accepted colour marks, limited strictly to the exact shade and the exact manner of application.
- Functionality and industry-need rejections, ensuring essential or commonly used colours remain available.
- Coexistence policies, which allow similar colours to exist when used in different contexts.

Although not formally recognised, Chile structurally avoids colour depletion by preventing overly broad monopolisation of colours.

CHINA

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?
- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?
- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

a) Color Combination Marks Are Accepted in China

Since the revision of the *Trademark Law of the PRC* in 2001, color combination has been an expressly accepted form of trademark for registration in China. As to single color marks, although they are not prohibited by law in theory, at the current stage, they are still not a registrable category.

Current Statute	Relevant Provisions
Trademark Law of the PRC (2019)	<u>Article 8</u> : Any mark which can differentiate the commodities of a natural person, legal person or any other organization with the commodities of others, including text, graphics, alphabets, numbers, three-dimensional mark, color combination and sound, etc. , and a combination of the aforesaid elements, may be registered as a trademark.

A color combination mark currently acceptable by the PRC Trademark Office (**TMO**) refers to a trademark formed by combining two or more colors in a specific way. A specific way can be used on a specific part or position of the designated goods, or colors in certain order and proportion. Different from ordinary trademarks, color combination marks protect the color combination itself and the specific way of use, but do not include any texts or graphics, and they are not limited to specific shapes as seen in normal device marks.

According to the TMO’s *Examination Guidance*, when a color combination trademark is used on

goods, it can be used for all or part of the goods, as well as for all or part of the packaging of the goods. When a color combination trademark is used on services, it can be used for the carriers of the services, such as packaging boxes, transportation vehicles, or couriers' clothing during express delivery services, or external and internal decorations of service venues.

b) How to File Applications for Color Combination Marks in China?

When filling out the application form of a color combination mark in China, the applicant should check "Apply for trademark registration in the form of color combination" in the "Trademark Application Declaration" section. Then, in the "Trademark Description" section, the applicant should list the color name and color code, such as the Pantone code, the RGB code, and also indicate the way the mark is used.

The applicant must also provide a clear trademark specimen. In a typical application for a color combination mark, the trademark specimen can be either a color block representing the colors and their combination method, or a graphic outline representing the specific positions of colors in use. The outline of the graphic, however, is not deemed a protected part of the trademark and must be represented by dashed/dotted lines, instead of solid lines.

Here are some examples of trademark specimen and descriptions that are accepted by the TMO.

Trademark Specimen	Trademark Description
	Color combination trademark, where green is Pantone code 2290CP; cool gray is Pantone code COOL GRAY11C; and warm gray is the PANTONE code WARM GRAY4C. Usage: Three colors are used for appearance on mechanical equipment.
	This color combination trademark consists of three colors: green, anthracite, and orange. Among them, green (Pantone 368C) accounts for 60%, anthracite (Pantone 425C) accounts for 30%, and orange (Pantone 021C) accounts for 10% of the mark, as illustrated in the specimen. The color combination mark is used for the appearance of gas stations. Green is used for the ceiling of gas stations, anthracite is used for gas station columns, and orange is used for the overall exterior of refueling machines.
	This color combination trademark consists of two colors, green and yellow. Among them, green is Pantone364C, and yellow is Pantone109C. Green is used for the body, and yellow is used for the wheels. The dash line is used to indicate the position of the color on the product, and the vehicle outline and appearance are not elements of the trademark.
■ Note that, in some early applications, the way of use in the application form may not be very clear.	

Current Regulations	Relevant Provisions
Implementation Regulations for the	<u>Article 13</u> : ... To apply for registration of a trademark using a color combination or color pattern, a color specimen shall be submitted

Trademark Law of the PRC (2014)	together with a black and white draft; ...In the case of an application for registration of a color combination as a trademark, it shall be stated in the application form, and the method of use of the trademark shall be stated.
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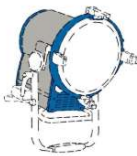
c) Acquired Distinctiveness

In China, color combination trademarks are often treated as lacking inherent distinctiveness by default at the application stage. In the initial filing stage, the applicant is not required to provide any evidence of use. However, the examiner is likely to issue an Examination Opinion or provisionally refuse the application during the substantive examination. Then, the applicant is entitled to respond to the Opinion with the PRC Trademark office (“TMO”) or to file a review of refusal with the Trademark Review and Adjudication Department (“TRAD”) to submit evidence of use to prove the acquired distinctiveness of the mark. Relevant evidence should demonstrate long-term or extensive use to establish a stable association with the applicant, thereby the mark acquires the ability to distinguish the source of goods or services and achieve distinctive characteristics.

Generally speaking, the requirement for distinctiveness of a color combination mark is strict. The color combination must achieve a very high degree of fame through use, to the extent that the primary characteristics of the color combination in this class of goods/services have changed, in the way that the relevant public can immediately recognize the source of the goods/services through the color combination.

In practice, the evidential materials used to prove distinctiveness are similar to those used to prove extensive use, high fame and well-known status of a mark. Please see the below table for a few examples of evidential materials submitted by applicants to demonstrate acquired distinctiveness of their color combination marks through use.

No.	Trademark	Applicant	At Which Stage the Mark Was Granted Registration:	Evidence Provided Include:
1.	 App. No. 69194028 in Class 12	Zoomlion Heavy Industry Science & Technology Co., Ltd. (中联重科股份有限公司)	Review of Refusal Registered on December 14, 2024	1. Evidence of the applicant's business scale and reputation; 2. Trademark design and statement of use; 3. Product sales scale and tax evidence; 4. Advertising and media coverage evidence; 5. Previous cases and related rulings.
2.	 App. No. 55721255 in Class 11  App. No. 55722717 in Class 11  App. No. 55724817 in Class 11	Arnold & Richter Cine Technik Gmbh & Co. Betriebs Kg	Review of Refusal Registered on October 21, 2022	1. 100-year chronicle; 2. Affidavit and work certificates issued by managers; 3. Product images of other brands of lighting fixtures; 4. Registration information of the applicant's blue and silver color combination trademark in the European Union; 5. Relevant design patent certificates; 6. Relevant copyright registration certificates; 7. Interior design images in China; 8. The applicant's distribution contracts, exhibition catalogues, product contracts, customs declarations, order forms, sales documents, evidence of filming for movies and TV dramas, sales records of lighting fixtures, maintenance service contracts, advertising contracts, media reports, and a large amount of promotional evidence; 9. Audit reports, consumer survey reports; 10. Honors in China and internationally; 11. Relevant judgments, mediation agreements, penalty decisions, commitment letters, domain name arbitration rulings, etc.; 12. Other evidence.

	 App. No. 55718105 in Class 11			
3.	 App. No. 17165071 in Class 7	Andreas Stihl Ag & Co. Kg	1st Instance of Administrative Lawsuit Registered on January 14, 2019	<u>At the review of refusal stage (unsuccessful), but the TRAD's decision was overturned by BIPC.</u> 1. Copy of registration certificate of trademark No. 9137205. 2. Product manuals and photos of major domestic chain saw manufacturers. 3. Copy of registration certificates of the trademark in other countries. 4. A statement from a company in the same industry regarding the distinctiveness of the applicant's color combination trademark. 5. Administrative penalty decision letters and civil judgments between 2013 and 2016. 6. Thank-you letter from the National Bureau of Standards to the representative of the applicant in July 1985 reported by Heilongjiang Television Station. 7. Product catalogs, advertising brochures, and official Chinese website pages. 8. Photos of the applicant's dealers in China's Mainland. 9. Advertisements published in newspapers and magazines. 10. Advertisement statistics table published by China Green Times Daily from 2007 to 2011. 11. Advertisement contracts and invoices. 12. Review of various media reports in 2010. 13. Business license, product sales invoices from 2006 to 2013, audit reports from 2004 to 2012, statements from the general manager, and product images of related Chinese companies.

				14. Partial list of distributors in China. 15. Copy of the "2010-2012 China chainsaw market research and investment prospect analysis report" issued by Beijing Zhongzhilin Information Technology Co., Ltd. 16. Relevant certificates issued by the China Forestry Machinery Association. 17. Evidence such as the market research reports on the orange grey color combination of chain saw products in China issued by market consulting company. <u>At the administrative lawsuit stage (successful):</u> 1. Product manuals for major domestic chain saw manufacturers. 2. Websites of several major chainsaw manufacturers in China. 3. 2013-2016 Canton Fair Garden Tools Enterprise Chain Saw Product Manual. 4. China Customs Magazine October 2010 issue. 5. Notarization Certificates. 6. Introduction of Plaintiff's Products in Domestic Magazines in 2016. 7. Statistical table of advertising expenses for Taicang Steele from 1995 to 2010. 8. Copies of National Library searches. 9. Reports on the national map searches. 10. Reports on the "Top Ten Intellectual Property Cases in Guangdong Province in 2013". 11. Compilation of civil infringement and industrial and commercial penalties regarding the orange grey color combination. 12. Civil judgments and administrative penalty decisions between 2014-2016. 13. Search results of color trademark files related to previous cases.
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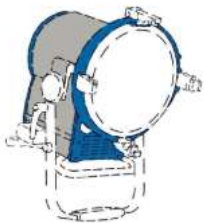
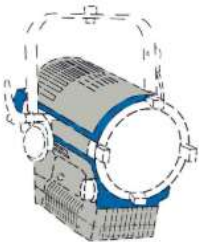
2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

We have collected some examples of registered color trademarks in China as listed in the following table:

	Trademark	Class	App. No.	Owner	App. Date	Reg. Date	Goods/Services	Note
1		12	69194 028	Zoomlion Heavy Industry Science & Technology Co., Ltd.	2023-01-11	2024-12-14	Forklift trucks.	Successful on review of refusal
2		7	24542 227	Shang Yin Technology LLC	2017-06-08	2023-08-21	Robots [machines]; guides for machines; transmissions for machines; reeling apparatus, mechanical; bearings [parts of machines]	Successful on appeal (2 nd Instance)
3		7	19118 878	JLG INDUSTRIES, INC	2016-02-19	2023-06-07	Lifting apparatus; elevating apparatus; handling apparatus for loading and unloading; hoists; high altitude work lifting platform.	Successful on appeal (1 st Instance)
4		9	30379 73	DURACELL U.S.OPERATION, INC.	2001-12-12	2006-03-07	Batteries.	
5		12	18338 886	Zoomlion Heavy Industry Science & Technology Co., Ltd.	2015-11-16	2016-12-21	Vehicles for locomotion by land, air, water or rail; tipping bodies for trucks; automobile chassis; trucks; motor coaches; sprinkling trucks; forklift	Registration sustained in

	Trademark	Class	App. No.	Owner	App. Date	Reg. Date	Goods/Services	Note
							trucks; lifting cars [lift cars]; bodies for vehicles; concrete mixing vehicles; automobiles; tilting-carts; motors, electric, for land vehicles; tractors; trailers [vehicles].	invalidation action based on lacking distinctiveness.
6		11	55721255	ARNOLD&RICHTER CINE TECHNIK GMBH & CO. BETRIEBS KG	2021-04-29	2022-10-21	Indoor strong light; led underwater light; photographic backlight; beam projector for photography; lighting apparatus and installations; limelight; lighting fixtures; stage lamps; lamps; lamp reflectors; light-emitting diodes [led] lighting apparatus	Successful on review of refusal
7		11	55722717		2021-04-29	2022-10-21	Lamp reflectors; lamps; stage lamps; lighting fixtures; limelight; lighting apparatus and installations; photographic backlight; beam projector for photography; led underwater light; indoor strong light; light-emitting diodes [led] lighting apparatus	Successful on review of refusal
8		11	55724817		2021-04-29	2022-10-21	Indoor strong light; led underwater light; photographic backlight; beam projector for photography; lighting apparatus and installations; limelight; lighting fixtures; stage lamps; lamps; lamp reflectors; light-emitting diodes [led] lighting apparatus	Successful on review of refusal

	Trademark	Class	App. No.	Owner	App. Date	Reg. Date	Goods/Services	Note
9		11	55702767		2021-04-29	2022-10-21	Indoor strong light; led underwater light; photographic backlight; beam projector for photography; lighting apparatus and installations; limelight; lighting fixtures; stage lamps; lamps; lamp reflectors; light-emitting diodes [led] lighting apparatus	Successful on review of refusal
10		11	55718105		2021-04-29	2022-10-21	Lamp reflectors; lamps; stage lamps; lighting fixtures; limelight; lighting apparatus and installations; photographic backlight; beam projector for photography; led underwater light; indoor strong light; light-emitting diodes [led] lighting apparatus	Successful on review of refusal
11		7	17165071	ANDREAS STIHL AG & CO.KG	2015-06-10	2019-01-14	Chain saw	Successful on appeal (1 st Instance)
12		7	33461463	HONDA MOTOR CO., LTD.	2018-09-12	2020-08-21	Non land vehicle engines; motors, other than for land vehicles / engines, other than for land vehicles; dynamos; outboard engines for non-land vehicles	Registered (no rejection)
13		35	31141706	SHELL BRANDS INTERNATIONAL AG	2018-05-24	2019-10-21	Demonstration of goods; commercial administration of the licensing of the goods and services of others; providing business information via a website; sales promotion for others;	Registered (no rejection)

	Trademark	Class	App. No.	Owner	App. Date	Reg. Date	Goods/Services	Note
							administrative processing of purchase orders; rental of vending machines	
14		37	31135 693		2018-05-24	2019-10-21	Vehicle service stations [refueling and maintenance]; Vehicles fueling station.	Registered (no rejection)
15		12	28022 588	DEERE COMPANY &	2017-12-12	2019-01-14	Ground maintenance tractor; Tractors; lawn tractor.	Registered (no rejection)
16		7	28022 589		2017-12-12	2019-01-14	Agricultural machines; Reapers.	Registered (no rejection)
17		12	28022 590		2017-12-12	2019-01-14	Lawn tractor ; Tractors; Ground maintenance tractor	Registered (no rejection)
18		12	28022 591		2017-12-12	2019-01-14	Multi purpose vehicle; Tractors; lawn tractor; Garden Tractor; Golf course trimmer	Registered (no rejection)

	Trademark	Class	App. No.	Owner	App. Date	Reg. Date	Goods/Services	Note
19		7	28022 587		2017-12-12	2019-01-14	Agricultural machines; Reapers	Registered (no rejection)
20		7	13517 704		2013-11-11	2015-03-21	Agricultural implements, other than hand-operated; tea-leaf picker; rice transplanter; Sowers [machines];	Registered (no rejection)
21		7	13517 702		2013-11-11	2015-03-21	pulverizes [machines] / atomizers [machines] / spraying machines; harrows; straw [chaff] cutters / chaff cutters; lawnmowers [machines]; grain separators; cultivators [machines]; grain sheller; binding apparatus for hay / trussing apparatus for hay; harvesting machines / mowing and reaping machines; agricultural elevators; agricultural machines; weeding machines; combine-harvester; reapers; succulence cutting equipment; woodworking machines.	Registered (no rejection)
22		12	13517 703		2013-11-11	2015-03-21	Tractors; Tipper truck; wagons; golf Carts.	Registered (no rejection)
23		7	91372 05	ANDREAS STIHL AG & CO. KG	2011-02-22	2015-08-14	Forestry and gardening with chain saws	Registered (previously rejected, reason unknown)

	Trademark	Class	App. No.	Owner	App. Date	Reg. Date	Goods/Services	Note
24		7	18961 114	Shang Yin Technology LLC	2016-01-22	2018-01-14	Robots [Machines]; reeling apparatus, mechanical; transmissions for machines; machine drive; guides for machines; linear bearing; bearings [parts of machines].	Registered (previously rejected, reason unknown)
25		7	18961 113		2016-01-22	2018-01-14	Robots [Machines]; Linear bearing; bearings [parts of machines]; Machine drive; Transmissions for machines; Guides for machines; Reeling apparatus, mechanical.	Registered (previously rejected, reason unknown)
26		7	18961 112		2016-01-22	2017-02-28	Robots [Machines]; Linear bearing; Machine drive; Transmissions for machines; Guides for machines; Reeling apparatus, mechanical; bearings [parts of machines].	Registered (no rejection)
27		43	19254 578	KABUSHIKI KAISHA LAWSON	2016-03-09	2017-10-21	Teahouse; Itinerant catering service; Bar services; snack-bar services; restaurant services; cafeteria services; café services/cafe services	Registered (no rejection)
28		35	19254 577		2016-03-09	2017-10-21	Procurement Services for others [Purchasing Goods and Services for other Businesses]; Sales Promotion for others.	Registered (no rejection)
29		17	11915 216	ROXTEC AB	2012-12-19	2015-08-28	Sealed ball; lute; pipe muffs, not of metal; sealant compounds for joints; rubber or hard fiber gasket; pipe	Registration sustained

	Trademark	Class	App. No.	Owner	App. Date	Reg. Date	Goods/Services	Note
							gaskets; gaskets; junctions, not of metal, for pipes.	in invalidation action based on lacking distinctiveness.

3. Legal Framework for Colour Trade Marks

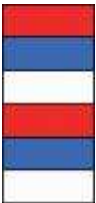
- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.
- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

Although written law in China allows registration of color combination marks and the TMO's guidance has outlined certain rules and boundaries of protection, development of laws in this aspect is still at a relatively rudimentary stage.

Current Statutes, Regulations and Guidance	Relevant Provisions
Trademark Law of the PRC (2019)	<u>Article 8</u> : Any mark which can differentiate the commodities of a natural person, legal person or any other organization with the commodities of others, including text, graphics, alphabets, numbers, three-dimensional mark, color combination and sound, etc., and a combination of the aforesaid elements, may be registered as a trademark.
Implementation Regulations for the Trademark Law of the PRC (2014)	<u>Article 13</u> : ... To apply for registration of a trademark using a color combination or color pattern, a color specimen shall be submitted together with a black and white draft; ...In the case of an application for registration of a color combination as a trademark, it shall be stated in the application form, and the method of use of the trademark shall be stated.
Trademark Examination Guidance of the TMO (2021)	<u>Part II, Article 7</u>: A color combination trademark refers to a trademark composed of two or more colors combined in a specific way. ... Due to the extremely limited variety of single colors in nature, accepting a single color as a trademark application may monopolize the use of a certain color and hinder the normal use of other production and operation entities. Therefore, currently in China, only color combinations are accepted for trademark registration, and a single color is not accepted for trademark registration. ... In general, color combination trademarks lack inherent distinctiveness and require long-term or extensive use to establish a stable connection with the applicant and function to distinguish the source of goods or services, in order to obtain distinctive features. ... The substantive examination of color combination trademark

	registration applications include examination of prohibited clauses, examination of distinctive features, and examination of similarity. ... In addition to the factors considered in examination the distinctiveness of ordinary trademarks, the examiners, in examining applications for color combination trademarks, should also take into account factors such as the trademark's own attributes, composing elements, usage methods, duration of use, intensity of use, use of similar colors by operators in the same industry, trademark usage practices by relevant industries, advertising and promotion of color combination trademarks and their effects, and the level of awareness of the relevant public.
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The *Examination Guidance* gives some examples of trademarks that are considered to lack distinctiveness because they are natural or commonly used color combinations of the products:

Unregistrable for lacking distinctiveness		
		
Used on toothpastes	Used on hair salon services	Used on electric grinders

Further, according to the *Examination Guidance*, the following trademarks are considered similar marks:

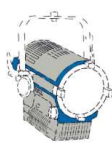
Similar Marks	Trademark 1	Trademark 2
Trademark Specimen		
Designated Goods	Chainsaws	Chain saws for forestry and horticulture
Trademark Description	This color combination trademark consists of two colors: orange red and gray. The orange red color is PantoneP0-17-1464TCx, and the gray color is PantoneP179-15C. Grey is used for the lawn mower body, orange is used for the air filter cover and handle, and the dotted line is used to indicate the position of the	This trademark is a color combination trademark, and the graphic outline of the trademark is only used to display the position of the color. The graphic outline itself is not part of the trademark to apply for protection. The colors included in this trademark are orange (RAL color chart reference number 2010) and gray (RAL color

	color on the product. The serrated outline and shape are not trademark elements.	chart reference number 7035), which are consistent with the colors of the goods designated for use under this trademark. Among them, orange is located at the upper part of the designated product cover, and gray is located at the lower part of the designated product cover.
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Among the registered color combination marks, Arnold & Richter's registrations for



and



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and Deere & Company's registrations for



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and



are probably the best-known cases to the Chinese

practitioners. However, due to the limited number of registered color combination marks in the registry, it is difficult to generalize a consistent standard as to what constitutes sufficient evidence to prove acquired distinctiveness.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

a) Invalidating a Color Combination Mark on Absolute Grounds

Any party can file an opposition or an invalidation action against a color combination mark based on the grounds of lacking distinctiveness. However, since the history of color combination marks in China is not long and the examination criteria set for registration is quite high, for a trademark that has typically gone through the review of procedure and even subsequent appeals to prove its acquired distinctiveness in recent years, the chances of invalidating it on the grounds of lacking distinctiveness would actually be quite low.



In 2020, Reg. No. 18338886  in class 7, in the name of Zoomlion Heavy Industry, survived three straight invalidation actions filed by different parties (Shangpingzi (2020) Nos.154358, 264478 and 232627). The key issue in dispute was whether the color combination had been the standard color or had already become a commonly used color combination in the

industry before the application date of the mark. The examiners found that the applicants of the invalidations did not submit evidence to prove that the color combination of the disputed trademark had been included and published in relevant professional reference books or dictionaries (or the colors are different), and the product images submitted by the petitioners could not prove that the color combination of the disputed trademark had become a commonly used sign for goods such as cranes in the general public's understanding. One of the cases went up to Beijing Higher People's Court, and the trademark registration was maintained by court.



Similarly, Reg. No. 11915216  in class 17, in the name of Roxtec AB, survived invalidation actions in 2019 and 2021, respectively (Shangpingzi (2019) No. 188625 (Shangpingzi (2021) No. 032760). In the former decision, the TRAD examiner held that the evidence submitted by the petitioner of the invalidation action is insufficient to prove that the color combination of the disputed trademark had become a commonly used color combination on the approved goods or had a functional way of use.

To take a step further, whether a registered color combination mark may lose its distinctiveness because it is too commonly used by relevant public to the extent that the color combination has become a generally used pattern in the same trade and industry? It remains to be seen as the practices in China have not reached that stage.

b) Invalidating a Device Mark Based on Color Combination Marks

Interestingly, color combination marks can also serve as prior trademark rights to invalidate a normal device mark on the grounds of trademark similarity. In such cases, the actual way of use will be taken into consideration.

For example, Shang Yin Technology LLC filed an invalidation action against Leqing City Hailuo

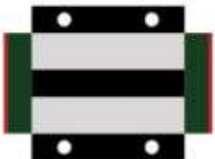
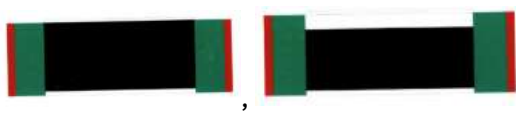


Automated Equipment Co., Ltd.'s device mark Reg. No. 24915204  in class 7. In the subsequent administrative lawsuit ((2020) Jing 73 Xingchu 1108), Beijing IP Court found the disputed mark similar to Shang Yin's color combination marks, namely, Reg. No. 18961112



(the cited mark 1) and Reg. No. 18961115  (the cited mark 4) in class 7.

According to the judgment, "The disputed trademark design is identical or highly similar to the top view of the plaintiff's goods bearing the color combination trademarks. The side view of the plaintiff's goods bearing the color combination trademarks, the cited marks 1 and 4, is actually a different perspective of the same product, the complete guide rail, just with a top view and a side view. The relevant public will simultaneously observe the patterns on both sides. Therefore, based on the usage of the cited marks 1 and 4, the disputed mark and the cited marks 1 and 4 are similar in terms of overall appearance, visual effects, etc. The disputed mark and the cited marks are used simultaneously on products such as machine guide rails. Consumers in isolation cannot easily distinguish the source of the products identified above with a general level of attention." In effect, the judge considered the two parties' trademarks similar because they point to goods with the same design and thus are likely to cause confusion among the relevant public.

Product Top View	Product Side View
	
Disputed Trademark	Cited Trademarks
	

5. Use of Color Trademarks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

In the “Trademark Description” section of an application for a color combination mark, the applicant must include the specific way of use on the designated goods/services. However, it is still uncommon for a trademark applicant to describe the specific way of use in a digital and virtual environment.

Under the current practice, without a recognized trademark right, use of certain color combination in the digital environment is more likely to fall into the scope of protection of trade dress. Trade dress is generally a combination of shape and color combination, unique elements, design layout, etc. To obtain protection, it also requires extensive use and high fame to the extent that the trade dress has gained distinctiveness to distinguish the source.

In the “first case” of trade dress of “application icons” in China between two providers of cosmetic and microplastic surgery, Beijing IP Court, in 2nd instance, held that the combination of colors, layout and design elements of the Plaintiff’s application icon, after removing the text part, constitutes trade dress. However, it overruled the 1st instance court’s holding by pointing out that the trade dress lacks distinctiveness or specificity and cannot distinguish the source of goods/services. Therefore, it does not constitute trade dress that has gained certain impact.

App. Icon of the Plaintiff	App. Icon of the Defendant
 新氧 APP 完整装潢	 更美 APP 完整装潢

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

a) Similarity of Goods

Because of the special nature of color combination marks, they are typically registered on specific, defined goods and closely associated with specific, defined goods. Otherwise, it would be difficult to describe the position and location of colors. Absent a close connection to the goods, it would also be difficult to accumulate distinctiveness. As a result, enforcement of such trademark rights is usually on identical goods, instead of similar goods.

b) Assessing Trademark Similarity

The commonly used standard in assessing trademark similarity in enforcing color combination trademark rights is similar to that of any other forms of trademarks, which is a “likely-to-cause-confusion” standard, and the courts’ assessment is based on “the general attention of consumers”.

Current Judicial Explanation	Relevant Provisions
Interpretation of the Supreme People's Court on Several Issues Concerning the Application of Law in the Trial of Trademark Civil Dispute Cases, 2002	Article 9: The similarity of trademarks as stipulated in Article 57 (2) of the <i>Trademark Law</i> refers to the similarity in the shape, pronunciation, meaning, composition and color of the characters, or the overall structure of the combination of its various elements, or the similarity in its three-dimensional shape and color combination between the accused infringing trademark and the registered trademark of the plaintiff, which may cause the relevant public to misidentify the source of the goods or believe that their source is specifically related to the goods of the registered trademark of the plaintiff.

In practice, various factors, such as the position, the way of use and the overall appearance,

would be taken into consideration.

In ROXTEC AB's civil lawsuit against certain Shanghai Boyi Shipping Company based on trademark Reg. No. 11915216  in class 17 ((2020)Hu 0110 Minchu 1151, (2021) Hu 73 Minzhong 228), court held that, "When determining whether a color combination trademark and the accused infringing mark constitute similar marks, the general attention of consumers should be taken as the standard, and the focus should be on observing **the usage position, arrangement and combination method, color difference, overall visual effect, etc. of the color combination. If it is used on the same goods and easily causes confusion and misidentification of the source of the goods by the relevant public, it should be recognized as constituting similarity.**"

Moreover, finding trademark similarity does not require the color combination to be identical. In the same case, court found that the accused sealed module products are in the form of concentric circles in blue and black, with only slight difference in respect of the specific color codes of the blue color from the plaintiff's trademark, and that their overall composition is similar.

Plaintiff's trademark right	Plaintiff's use	Defendant's use
 Trademark Description: The trademark is a color combination trademark, composed of blue (International Standard Color Card Color Code: 2925) and black (International Standard Color Card Color Code: Black). Trademarks have certain graphic limitations in actual use: blue and black are used in concentric circles on designated goods, with the black circle located in the center and surrounded by a blue box.	 	 

On the other hand, because a color combination is not naturally distinctive, the scope of protection in respect of the differences in color should be narrow to prevent monopoly of a broad range of colors. In 1st instance of the administrative lawsuit regarding the invalidation action

against Reg. No. 11915216  ((2021) Jing 73 Xingchu 5816), Beijing IP Court expressed its view that, "In determining the distinctiveness of colors or color combinations, there should be a balance between leniency and strictness. That is to say, while the standard of distinctiveness of colors or color combinations is lenient, then the standard of similarity of colors or color combinations should be strict. Only in this way can a balance between law and reason be achieved to prevent individuals from monopolizing color trademarks."

c) Comparison Beyond the Trademark Itself

Different from ordinary trademarks, in assessing trademark infringement, the actual way of use plays a more important role. Sometimes, the trademark registration records may not be very clear, but the Court is allowed to compare the infringing products with the trademark owner's actual products. This is recognized by the Supreme Court's decision in 2021 in the case between Deere & Company and Shandong Sading Heavy Industry Co., regarding the latter's infringing use



of Reg. No. 4496718 in class 12. In 2017, Deere filed a complaint with the Market Supervision & Administrative Bureau of Dangyang City, Hubei Province against Shangdong Sading's production and sales without authorization of tractors with "green body, silver front wheels, and yellow rear wheel hub". The local MSB found trademark infringement and fined Shadong Sading in the amount of CNY 600K (around USD 84K). In subsequent administrative lawsuit, Yichang Intermediate People's Court recognized that Reg. No. 4496718 is a color combination mark and held that "The infringement comparison of color combination trademarks has certain peculiar features. When the MSB of Dangyang City determined infringement, it compared the accused infringing product with the involved trademark, and also compared the accused infringing product with the trademark owner's product, which did not violate legal provisions." The Supreme Court upheld the judgment and the amount of penalty.

Deere's Trademark Right	Deere's Actual Use	Shandong Sading's Use
 Reg. No. 4496718 in Class 12		

As can be seen from the above cases, comparison of the prior trademark right and the use on the infringing product is not a mechanical application of the exact indexes of the mark to an actual product. The color combination itself does not possess distinctiveness. The distinctiveness of the mark is acquired through use. Thus, comparing the way of use is an essential part in assessing infringement. It is how one can more comprehensively evaluate the likelihood of causing confusion.

d) Quasi Single-Color Mark Protection

Although single color mark is not an expressly acceptable form of trademark registration in China, a well-known and iconic color may achieve similar effect of protection with registration of standard device marks in certain shape or with certain indication of position. The best-known example is Christian Louboutin's red sole. In the administrative lawsuit regarding IR No. 1031242



, the Supreme Court did not deny the possibility of protection of a single-color mark at a specific position by granting registration of this device mark (2019) Zuigaofaxingsheng 5416). But later, the TRAD re-issued a decision rejecting the protection of the IR No.1031242 based on the grounds of non-distinctiveness.



But Christian Louboutin's IR No. 902955 is successfully granted for protection as a device mark in China. In a trademark infringement case, the Chengdu Intermediate People's Court awarded punitive damage of CNY 10m (around USD 1.4m) to the French brand (2023) Chuan 01 Minchu 815).

The above cases show that it may still be very difficult for the Tiffany Blue or the Cadbury Purple to obtain trademark registration in China. The underlying rationale is still a balance between different features that contribute to the distinctiveness of the mark. By default, single color is even less distinctive than combination of colors. Thus, it sets even higher requirements in other aspects in order to prove acquired distinctiveness. A specific position or location of use could be one of such features. A strong connection with very specific goods would also help develop distinctiveness.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?
- b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.
- c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

a) Narrowing the Goods and Defining the Way of Use More Specifically in Trademark Applications

To overcome the first hurdle in seeking trademark registration, which is distinctiveness, the colors and the way of use must be well defined and the designated goods are better to be narrow in trademark applications. If the trademark applicant has several ways of use of the color combination in actual business, it is recommended to start the application with the most iconic one.

b) Preserving Evidence of Prior and Specific Way of Use

The types of evidence to prove distinctiveness of a color combination mark are similar to those

used to prove fame and well-known status of a traditional mark. Moreover, the evidence of use for a color combination mark must include sufficient visual evidence, such as images, showing the specific way of use.

By the way, in some of the civil infringement cases, the court considered the prior use defense. Same as the situation of other categories of marks, the prior use defense requires not only use prior to the registration of the trademark right, but also use prior to the earliest use of the Plaintiff. In this view, evidence of use, as early as possible, would be helpful to both parties.

c) Seeking Registration for Traditional Device Marks

If the applicant fails to register color combination marks, it may resort to an alternative of traditional device marks with specific colors and shapes. They might have a similar effect in enforcement.

d) Collaboration Between Administrative and Civil Cases

Seeking registration of a color combination mark may help claims in another civil lawsuit because of the enhanced weight of evidence. In 1st instance of Shang Yin Technology LLC's trademark infringement and unfair competition lawsuit against Xianyang Fengning Machinery Co., Ltd. ((2023)Zhe0108Minchu1033), the judge held that the side of the products of Fengning features a color combination pattern of red plastic oil scraper, green plastic end cap, and black iron block from the outside to the inside. This arrangement is consistent with the trademark usage claimed by Shang Yin, and their color distribution and combination are extremely similar. Therefore, the overall structure of the two marks is similar. Moreover, the "red green black" color combination trademark of Shang Yin has obtained a high level of popularity, and Fengning's actions can easily lead to confusion among the relevant public about the source of its goods or recognition of a specific connection between the parties in this case.

Therefore, 1st instance court found Fengning's behaviors constituted trademark infringement of Shangyin's color combination marks  (Reg. No. 18961112),  (Reg. No. 18961115),  (Reg. No. 14387012) and  (Reg. No. 14387013). However, 1st instance court did not recognize unfair competition in this case. During 2nd instance of the lawsuit ((2024)

Zhe01Minzhong1838), Shang Yin's  (Reg. No. 24542227) was granted registration after two stages of administrative lawsuit. Based on the usage evidence provided by Shang Yin and the updated registration status of the color combination mark, court re-evaluated the distinctiveness of the "red green gray" color combination and overruled the first instance court's holding in respect of unfair competition.

8. Colour Depletion

[Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.](#)

Color depletion is not yet a heavily discussed topic in China, but the trademark examination authorities expressed some concern. It is the main reason why China still does not allow registration of single color marks. As stated in the TMO's Examination Guidance, due to the extremely limited variety of single colors in nature, accepting a single color as a trademark

application may monopolize the use of a certain color and hinder the normal use of other production and operation entities. Therefore, currently in China, only color combinations are accepted.

COLOMBIA

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

In Colombia, the protection of colour marks is governed by the Andean Community’s Decision 486, which adopts a cautious and highly structured approach to the registrability of these signs. Although the legislation expressly acknowledges that colours may constitute trademarks, this possibility is subject to strict representational and distinctiveness requirements designed to prevent the monopolization of colours in the abstract. Article 134 establishes that a colour may serve as a trademark only when it is delimited by a specific shape, or when it forms part of a combination of colours. Conversely, Article 135(h) expressly prohibits the registration of a colour “considered in isolation,” without any delimiting shape, reflecting a clear legislative intent to preserve the general interest in ensuring that colours remain freely available to market participants. However, the final paragraph of Article 135 includes an exceptional derogation from the absolute bar in Article 135(h). Under this exception, a colour “considered in isolation” may be registered only if the applicant proves acquired distinctiveness (secondary meaning) through continuous, substantial, and effective use in the Member Country. This requires compelling evidence that consumers have come to perceive the colour, without any accompanying verbal or figurative elements, as an indicator of commercial origin.

The requirement that all colour marks be delimited by a specific shape does not imply that the shape itself must be distinctive. Rather, the delimitation operates as a representational mechanism that provides concreteness, objectivity, and graphic reproducibility to the colour claimed. Colombian administrative practice has consistently emphasized that the distinctive element in these cases is the colour (not the outline) which must not be monopolized beyond what is necessary to fulfill the source-identifying function of the mark.

In some cases the CTO has reiterated that applicants must show that consumers have come to associate the colour, as delimited on the product or container, with a specific commercial origin. Such proof may include surveys, advertising expenditures, sales data, and long-standing use. This evidentiary burden reflects the inherent difficulty in evaluating the distinctiveness of colour, which often performs ornamental, functional, or customary roles in the marketplace.

Through Resolution 36246 of 2022, the CTO denied the registration of the Tiffany Blue color trademark application¹⁴, as it considered that although the evidence showed extensive advertising and commercial use of Pantone 1837 (“Tiffany Blue”) by Tiffany & Co. (including promotional materials, packaging, and certain products consistently presented in this colour) the Colombian Trademark Office concluded that the colour had not acquired distinctiveness on its own. Consumer studies demonstrated an association between the colour and the brand *when used together with the word marks TIFFANY or TIFFANY & CO.*, but the record did not show that Pantone 1837 was used *independently* as a trademark. The Office emphasized that high-intensity use of a colour as part of a composite brand does not, by itself, prove that the colour alone functions as a source identifier. Moreover, the applicant’s argument that Pantone 1837 was specially created for Tiffany & Co. was deemed insufficient to establish distinctiveness, as similar shades of blue remain freely available and would not necessarily be perceived by consumers as indicating commercial origin in the absence of accompanying verbal elements. Subsequently, Tiffany filed 3 more colour trademark applications which are pending a decision.

Conversely, in other cases the CTO has granted the registration of trademarks that have a similar case but were deemed to be sufficiently distinctive¹⁵. In this case, the CTO considered that evidence submitted in the proceeding demonstrated a remarkably high level of spontaneous consumer association between the specific orange colour (Pantone C021), delimited in a rectangular shape, and the products of Productos *Ramo*, particularly *Chocorramo*. Hence the CTO established that Pantone C021 had acquired distinctiveness in the relevant market. Accordingly, the Office concluded that the colour had come to function as a trademark, creating a strong and immediate link between the goods and their commercial origin, and that the applicant had provided sufficient evidence to demonstrate acquired distinctiveness under the Andean regime. Finally, the CTO clarified that the examination must focus on the distinctiveness of the colour, not the distinctiveness of the shape that merely delimits it. A usual shape, such as the rectangular outline used to frame the colour Pantone C021 in a case concerning Class 30 goods, does not convert the application into a three-dimensional or figurative mark, nor does it fall under the prohibition on usual shapes, because the applicant does not seek exclusive rights over the shape. The delimiting shape functions only as a representational requirement under Article 134(e), and a colour mark may still be distinctive when the colour is arbitrary for the goods concerned. In this sense, usual shapes in colour marks operate much like explanatory elements in word marks: they may be part of the sign but are not appropriable.

b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

In Colombia, applications for colour trademarks are subject to strict formal and substantive requirements derived from Article 134 of Decision 486 and the national administrative guidelines



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issued by the Colombian Trademark Office (SIC).

First, the graphical representation must be “clear and precise,” as expressly required by Colombia’s competition and consumer-protection authority, the Superintendence of Industry and Commerce (SIC). Applicants must include the exact colour being claimed, along with an internationally recognized colour code, such as Pantone, Focoltone, RGB, or another standardized system that allows for objective verification. When the application concerns a single colour, the representation must show the colour delimited by a shape depicted in dotted lines. The dotted outline functions only as an illustrative boundary showing how the colour is applied; it does not confer exclusivity over the shape, nor does the applicant claim rights over the container or form used to frame the colour.

If the application concerns a combination of colours, the representation must still be precise and must: (i) specify each colour and its corresponding international code, and (ii) include a graphical depiction showing the arrangement, proportion, and manner in which the colours will be used. In both cases, the colour(s) depicted (single and combinations) must match the referenced colour codes exactly.

Additionally, the application must be accompanied by a high-resolution reproduction of the colour or colour combination, submitted in JPG, DOC, DOCX or PDF format, with a maximum size of 450 × 450 pixels and up to 50 MB. This reproduction must not include references, labels, or written indications of the colour name or code, as the graphic itself must serve as the definitive representation of the sign.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

Evidence of acquired distinctiveness is not automatically required when filing a colour trademark application in Colombia. The SIC has granted several colour marks without requiring the applicant to demonstrate secondary meaning, particularly when the colour is arbitrary for the relevant goods and is properly delimited by a shape. However, evidence becomes crucial if the Office issues a refusal for lack of distinctiveness or if third parties oppose the application on this ground.

When needed, the SIC accepts a broad range of evidence to demonstrate that the colour has acquired distinctiveness, including consumer surveys, market studies, longstanding and consistent use, advertising materials, sales and distribution figures, media references, and examples of packaging. In past cases, such as the pink colour used for Manzana Postobón, consumer surveys played a decisive role in proving secondary meaning. Thus, while not mandatory at the outset, proof of acquired distinctiveness is often key to overcoming objections and securing registration.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

The Annexure hereto sets out a list of colour trademarks currently registered in Colombia.

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The protection of colour trademarks in Colombia is primarily governed by the Andean Community's Decision 486, a supranational statute binding on all Member States. Article 134 expressly recognises that a trademark may consist of "a colour delimited by a specific shape, or a combination of colours," while Article 135(h) prohibits the registration of "a colour considered in isolation, without being delimited by a specific shape." The final paragraph of Article 135 introduces an exception, allowing the registration of signs, including isolated colours, that have acquired distinctiveness through continuous use.

These provisions are implemented nationally through Title X, Section 1.2.5.14 of the SIC's Unified Circular, which requires clear and precise representations, internationally recognised colour codes (Pantone, Focoltone, RGB), and the use of dotted lines to delimit single colours without claiming the underlying shape. Additionally, prejudicial interpretations of the Andean Court of Justice (TJCA) which are binding, have clarified that primary colours are not appropriable as abstract concepts; that delimitation is a representational, not a distinctiveness, requirement; and that colours natural or usual for the goods cannot be monopolised unless secondary meaning is proven.

Although SIC decisions are not binding precedent, several cases have shaped national practice. The Resolution 1075 of 2015 granted protection for Postobón's pink colour (Pantone 183C) based on strong evidence of acquired distinctiveness and remains the most influential colour-mark decision. Subsequent cases (such as Resolution 14792 of 2020 and Resolution 62154 of 2024) have reaffirmed these principles, emphasizing the need for precise representation and, where inherent distinctiveness is questioned, robust evidence of consumer recognition. These decisions illustrate a consistent approach: colour marks may be protected when arbitrary for the goods or when they have acquired distinctiveness, while avoiding undue monopolization of elements necessary for fair competition.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

In Colombia, the scope of protection afforded to a colour trade mark is construed restrictively, in accordance with the principles set out in Decision 486 and the interpretative criteria developed by the SIC. Although Article 134 permits the registration of a "colour delimited by a specific shape," the protection granted does not extend to an entire colour family, nor to tonal variations derived from the primary colour from which the registered shade originates. Rather, exclusive rights are confined to the precise chromatic specification claimed in the application, as identified by its Pantone or equivalent international code, and to the overall composite sign as registered.

This restrictive reading has been consistently reaffirmed in administrative practice. In Resolution

79964, the SIC held that registration of a specific pink shade associated with apple-flavoured soft drinks did not confer exclusivity over the broader range of hues derived from the primary colour red. The Office emphasised that the registrant's rights were limited to the exact tonal value claimed and to the particular configuration of graphic and verbal elements present in the registered labels when assessed as a whole. Similarly, Resolution 647 underscored that broad descriptions such as "pink," without a precise colour code, risk encompassing the distinctive Pantone 183C shade recognised as a well-known mark, thereby creating a likelihood of association. The SIC concluded that the absence of a specific code rendered the claimed shade potentially coterminous with the protected one, and therefore unacceptable.

By contrast, when Pantone codes correspond to perceptibly distinct hues, the Office has declined to find conflict. In Resolution 4695, involving two greens, the SIC determined that although both signs were generically described as "green," the Pantone codes reflected significantly different values in hue, saturation and brightness. Supported by market evidence demonstrating strong consumer recognition of Pantone 382C as identifying Argos's products in the construction materials sector, the Office concluded that the competing shade did not fall within the registrant's sphere of protection.

These decisions illustrate a clear and coherent doctrine: the scope of protection of a colour mark extends only to the specific shade claimed and to visually similar tonalities that, from the perspective of the relevant consumer, fall within the same perceptual range. Protection does not extend to broader chromatic spectrums. Generic or overly broad colour descriptions are analysed with particular scrutiny to avoid granting exclusivity beyond what is justified by the distinctiveness of the claimed shade.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

In Colombia, colour trademarks are challenged through the same administrative mechanisms as any other trademark, without a specialised forum. The procedures are governed by Decision 486 of the Andean Community and national administrative law.

- Oppositions are filed before the Colombian Trademark Office (SIC) during the publication stage. Oppositions may rely on any absolute or relative ground under Articles 134–136 of Decision 486.
- Cancellation actions—including actions for non-use and for loss of distinctiveness—are also filed before the SIC.
- Nullity actions against final decisions of the SIC must be filed before the Administrative Court of Cundinamarca (Tribunal Administrativo de Cundinamarca). These actions may invoke violations of Articles 134–135 of Decision 486 (for example, failure to meet distinctiveness requirements or an improper attempt to monopolise colours necessary for competition), or likelihood of confusion with earlier rights.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade

Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

Colombian law does not provide a separate legal regime or specific guidelines for the registration or enforcement of colour trademarks in digital or virtual contexts, such as websites, mobile applications, metaverse environments or virtual reality platforms. Under the Andean Community's Decision 486, colour marks are assessed under the same substantive and procedural rules, regardless of whether their use occurs in physical or digital spaces. The core requirements (graphic representation, delimitation by a shape, distinctiveness, and scope of protection limited to the specific claimed shade) apply uniformly.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

In Colombia, one of the most significant references regarding the enforcement of a registered colour trademark is the Andean Court of Justice's Prejudicial Interpretation 01-AI-2017, issued in the context of an *acción de incumplimiento* filed by ACAVA against the Colombian Trademark Office (SIC) for granting colour marks to Postobón. The Court upheld the legality of such registrations, reaffirming that a colour delimited by a specific shape may be enforceable when the applicant demonstrates strong distinctive character (particularly through acquired distinctiveness arising from long-standing and consistent use) while emphasizing that protection does not extend to colours "considered in isolation" or to broad colour families. This interpretation consolidated the principle that colour marks can be valid under Decision 486 when they meet strict representational and distinctiveness requirements.

Another administrative decision illustrates how these principles operate in practice: in Resolution No. 82146 (2020), the CTO confirmed the refusal to register the word and design mark BIG COLA MANZANA (claiming protection over the Pantone 7420C) for Class 32 goods, following an opposition by Gaseosas Posada Tobón S.A. based on its well-known colour mark Pantone 183C associated with Manzana Postobón. The Office concluded that the reproduction of a pink hue (arbitrary for carbonated beverages) combined with the depiction of a bottle created a high risk of confusion and association with the earlier colour mark. Key factors included the notoriety of Pantone 183C, competitive proximity of the goods, and the potential dilution of the distinctive character and advertising value of the well-known colour mark. This case confirms that enforcement of colour marks in Colombia hinges on precise chromatic similarity, market context, and evidence of acquired distinctiveness or notoriety.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or

in the Courts?

To file a Colour Trademark:

- Comply with all formal requirements of the SIC, including:
 - clear and precise graphic representation;
 - Pantone/Focoltone/RGB or equivalent colour codes;
 - delimitation of the colour with dotted lines;
 - high-resolution reproduction in accepted formats.
- Ensure the claimed colour matches exactly the colour code submitted.
- Avoid broad or generic colour descriptions.

To oppose or defend a Colour Mark Application:

- Provide evidence of acquired distinctiveness, especially when distinctiveness is challenged.
- Include a consumer survey demonstrating association between the colour and a single commercial origin.
- Submit additional evidence such as the following, it is important this evidence allows the demonstration of the recognition of the color by the consumer without additional elements:
 - certifications from the statutory auditor regarding advertising investment;
 - certifications from the statutory auditor on the accounting value of the sign;
 - client declarations confirming recognition of the colour;
 - supplier declarations confirming recognition of the colour;
 - market studies;
 - digital or printed publications;
 - advertising and promotional materials;
 - sales invoices showing use of the mark;
 - records showing continuous and consistent use;
 - prior trade mark registrations incorporating the claimed colour.

To enforce:

- Compare the allegedly infringing sign against the exact claimed shade and its perceptual range.
- Demonstrate that the competitor's use creates likelihood of association with the specific Pantone-based shade registered.
- Document continuous use of the colour as applied in the market.
- Preserve updated evidence of consumer perception and use patterns.

Post-registration strategy:

- Seek the well-known mark declaration when possible to strengthen protection.
- Maintain updated evidence of advertising, market presence and consumer recognition for future enforcement.
- Proactive defense of the trademark.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

In Colombia, the coexistence of colour trade marks is assessed under the general principles applicable to all trademarks, and coexistence agreements are not automatically accepted by the SIC. They are only admitted when the Office considers that the coexistence will not create a likelihood of confusion or association in the relevant consumer group. In practice, this requires

a clear differentiation of the goods or services, market segments and economic sectors in which each sign will be used, as well as evidence that the colours, their application, and their overall commercial presentation are sufficiently distinct. The Andean case law on well-known marks also guides this assessment: coexistence may be permissible when the marks belong to unrelated economic sectors, when both parties comply with fair competition principles, and when there is no risk that one party will take advantage of the reputation or image associated with the other's mark.¹⁶

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No, there are no additional fees.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

In Colombia, the concept commonly described as “colour depletion” is expressly recognised through the interpretation of Article 135(h) of Andean Decision 486 by the Andean Court of Justice. The Court has held that the prohibition against registering “a colour considered in isolation” is grounded in the need to prevent the monopolisation of the seven fundamental colours of the spectrum, as these are limited in number and essential for fair competition. Allowing a trader to appropriate a fundamental or pure colour would confer a disproportionate competitive advantage and restrict market access for others, particularly where the colour is customary for a category of goods or their packaging. The Court has clarified that this prohibition also extends to pure colours that are easily identifiable by their chromatic properties and, to some extent, to secondary colours—unless the claimed colour is delimited by a specific shape, forming part of a composite sign that may access registration if it does not fall under another ground for refusal. Thus, the Andean system addresses colour depletion by denying exclusivity over colours per se, while permitting protection for specific tonalities that are (i) precisely delimited, (ii) not functional or common for the goods, and (iii) capable of distinguishing commercial origin. This framework preserves the availability of colours for competitors while allowing trademark protection only for objectively defined, non-obstructive uses.

¹⁶ <https://www.sic.gov.co/ruta-pi/noviembre-2022/jurisprudencia/coexistencia-entre-marcas-notorias-en-el-registro-y-en-el-mercado-parte-2>

9. About the Contributor for the Colombian section



Luciana Moreno is a lawyer from Universidad EAFIT (Medellín, Colombia) and holds an LLM in Intellectual Property Law from Queen Mary University of London. She is a member of OlarteMoure's Business Law team, where she focuses on national and international trademark prosecution and litigation, including under the Madrid Protocol, and on the strategic management of global trademark portfolios. Her practice includes advising on complex trademark matters across various areas of intellectual property. Luciana has held leadership roles within the firm, serving as Trademark Team Leader since 2022 and Coordinator since 2024. She is an active member of the Newsletter Committee of the International Trademark Association (INTA) and the International Trademark Law and Practice Committee of the Intellectual Property Owners Association (IPO).

Superintendencia de Industria y Comercio de Colombia (SIC) - Reporte detallado de solicitudes
 Fecha y hora: 19 nov. 2025 08:07:54 p. m.

Criterio de búsqueda: Los criterios de búsqueda seleccionados coinciden con los criterios de búsqueda que el usuario entra en el campo de búsqueda en la pantalla de búsqueda, por ejemplo.

Estado: Registrada; Registrada; Registrada;
Tipo: Color

Número de caso	Caso Título	Imagen	Fecha de radicación	Vigencia	Estado del Caso	Referencia del solicitante	Titular	Descripción de Productos y Servicios	Calendario Clasificación de Niza	Productos y Servicios Descripción	Bajo Oposición	Apoderado	Fecha de Registro	Fecha de la publicación	Fecha de prioridad	Otra información
09090473	ROSADO PANTONE (183C) DELIMITADO POR LA FORMA BIDIMENSIONAL DE UNA BOTELLA. LA LÍNEA PUNTEADA TIENE COMO OBJETO DELIMITAR LA MARCA. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA.		27 ago. 2009	27 may. 2034	Registrada		POSTOBÓN S.A., CALLE 52 No 47 - 42 PISO 25, MEDELLÍN, ANTIOQUIA, CO	32	9	32. AGUAS MINERALES Y GASEOSAS Y OTRAS BEBIDAS NO ALCOHÓLICAS; SABOR A MANZANA.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	27 may. 2014	19 ago. 2010		
10101477	REIVINDICACION DEL COLOR : ROSADO (PANTENE 197 C) DELIMITADO POR UNA FORMA TRIDIMENSIONAL. LA LÍNEA PUNTEADA TIENE COMO OBJETO DELIMITAR LA MARCA. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA.		18 ago. 2010	30 mar. 2032	Registrada		OWENS CORNING INTELLECTUAL CAPITAL, LLC, ONE OWENS CORNING PARKWAY, TOLEDO, OHIO 43659, US	17	9	17. CAUCHO, GUTAPERCHA, GOMA, AMIANTO, MICA Y PRODUCTOS DE ESTAS MATERIAS NO COMPRENDIDOS EN OTRAS CLASES; PRODUCTOS DE MATERIAS PLÁSTICAS SEMIELABORADOS; MATERIALES PARA CALAFATEAR, ESTOPAR Y AISLAR; TUBOS FLEXIBLES NO METÁLICOS, ESPECIALMENTE MATERIALES AISLANTES	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	30 mar. 2012	20 oct. 2010		
10101479	REIVINDICACION DEL COLOR : ROSADO (PANTENE 197 C) DELIMITADO POR UNA FORMA TRIDIMENSIONAL. LA LÍNEA PUNTEADA TIENE COMO OBJETO DELIMITAR LA MARCA. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA.		18 ago. 2010	30 mar. 2032	Registrada		OWENS CORNING INTELLECTUAL CAPITAL, LLC, ONE OWENS CORNING PARKWAY, TOLEDO, OHIO 43659, US	17	9	17. CAUCHO, GUTAPERCHA, GOMA, AMIANTO, MICA Y PRODUCTOS DE ESTAS MATERIAS NO COMPRENDIDOS EN OTRAS CLASES; PRODUCTOS DE MATERIAS PLÁSTICAS SEMIELABORADOS; MATERIALES PARA CALAFATEAR, ESTOPAR Y AISLAR; TUBOS FLEXIBLES NO METÁLICOS, ESPECIALMENTE MATERIALES AISLANTES	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	30 mar. 2012	20 oct. 2010		
10101482	ROSADO (PANTONE 197 C), DELIMITADO POR UNA FORMA IRREGULAR ONDULADA. LA LÍNEA PUNTEADA TIENE COMO OBJETO DELIMITAR LA MARCA. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA		18 ago. 2010	31 jul. 2032	Registrada		OWENS CORNING INTELLECTUAL CAPITAL, LLC, ONE OWENS CORNING PARKWAY, TOLEDO, OHIO 43659, US	17	9	17. CAUCHO, GUTAPERCHA, GOMA, AMIANTO, MICA Y PRODUCTOS DE ESTAS MATERIAS NO COMPRENDIDOS EN OTRAS CLASES; PRODUCTOS DE MATERIAS PLÁSTICAS SEMIELABORADOS; MATERIALES PARA CALAFATEAR, ESTOPAR Y AISLAR; TUBOS FLEXIBLES NO METÁLICOS, ESPECIALMENTE MATERIALES AISLANTES	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	31 jul. 2012	20 oct. 2010		
12096858			08 jun. 2012	12 dic. 2032	Registrada		FIBERGLASS COLOMBIA S.A., CALLE 3 NO 3-49 ESTE., MOSQUERA, CUNDINAMARCA, CO	17	9	17. MATERIALES AISLANTES Y/O AISLAMIENTOS TALES COMO: AISLAMIENTOS TERMOACÚSTICOS, AISLAMIENTOS ACÚSTICOS, AISLAMIENTOS TÉRMICOS, EN FIBRA DE VIDRIO Y/O LANA MINERAL DE VIDRIO.	No	JUAN CARLOS CUESTA QUINTERO, CLL 72 # 10 - 07 OFC 603, BOGOTÁ, D.C., CO	12 dic. 2012	16 oct. 2012		
12096864			08 jun. 2012	12 dic. 2032	Registrada		FIBERGLASS COLOMBIA S.A., CALLE 3 NO 3-49 ESTE., MOSQUERA, CUNDINAMARCA, CO	19	9	19. MATERIALES PARA LA CONSTRUCCIÓN NO METÁLICOS, TALES COMO MATERIALES AISLANTES.	No	JUAN CARLOS CUESTA QUINTERO, CLL 72 # 10 - 07 OFC 603, BOGOTÁ, D.C., CO	12 dic. 2012	16 oct. 2012		
12096872			08 jun. 2012	12 dic. 2032	Registrada		FIBERGLASS COLOMBIA S.A., CALLE 3 NO 3-49 ESTE., MOSQUERA, CUNDINAMARCA, CO	17	9	17. MATERIALES AISLANTES Y/O AISLAMIENTOS TALES COMO: AISLAMIENTOS TERMOACÚSTICOS, AISLAMIENTOS ACÚSTICOS, AISLAMIENTOS TÉRMICOS, EN FIBRA DE VIDRIO Y/O LANA MINERAL DE VIDRIO.	No	JUAN CARLOS CUESTA QUINTERO, CLL 72 # 10 - 07 OFC 603, BOGOTÁ, D.C., CO	12 dic. 2012	16 oct. 2012		
12096878			08 jun. 2012	26 abr. 2033	Registrada		FIBERGLASS COLOMBIA S.A., CALLE 3 NO 3-49 ESTE., MOSQUERA, CUNDINAMARCA, CO	19	9	19. MATERIALES PARA LA CONSTRUCCIÓN NO METÁLICOS, TALES COMO MATERIALES AISLANTES.	No	JUAN CARLOS CUESTA QUINTERO, CLL 72 # 10 - 07 OFC 603, BOGOTÁ, D.C., CO	26 abr. 2013	18 ene. 2013		
12096885			08 jun. 2012	12 dic. 2032	Registrada		FIBERGLASS COLOMBIA S.A., CALLE 3 NO 3-49 ESTE., MOSQUERA, CUNDINAMARCA, CO	17	9	17. MATERIALES AISLANTES Y/O AISLAMIENTOS TALES COMO: AISLAMIENTOS TERMOACÚSTICOS, AISLAMIENTOS ACÚSTICOS, AISLAMIENTOS TÉRMICOS, EN FIBRA DE VIDRIO Y/O LANA MINERAL DE VIDRIO.	No	JUAN CARLOS CUESTA QUINTERO, CLL 72 # 10 - 07 OFC 603, BOGOTÁ, D.C., CO	12 dic. 2012	16 oct. 2012		

12096888			08 jun. 2012	12 dic. 2032	Registrada		FIBERGLASS COLOMBIA S.A., CALLE 3 NO 3-49 ESTE., MOSQUERA, CUNDINAMARCA, CO	19	9	19. MATERIALES PARA LA CONSTRUCCIÓN NO METÁLICOS, TALES COMO MATERIALES AISLANTES.	No	JUAN CARLOS CUESTA QUINTERO, CLL 72 # 10 - 07 OFC 603, BOGOTÁ, D.C., CO	12 dic. 2012	16 oct. 2012		
13015116			28 ene. 2013	19 may. 2034	Registrada		Société des Produits Nestlé S.A., AVENUE NESTLÉ 55, VEVEY, VAUD CH-1800, CH	30	10	30. CEREALES Y PREPARACIONES HECHAS CON CEREALES, COCOA Y PREPARACIONES HECHAS A BASE DE COCOA, BEBIDAS HECHAS A BASE DE COCOA, CHOCOLATE Y PREPARACIONES A BASE DE CHOCOLATE, BEBIDAS A BASE DE CHOCOLATE, CONFITERIA, GALLETERIA, PASTELERIA Y HELADOS.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	19 may. 2014	01 feb. 2013		
15041108	COMBINACION ROJO PANTONE 485C Y AMARILLO PANTONE PROCESS YELLOW C		24 feb. 2015	18 oct. 2026	Registrada		PRODUCCIONES GENERALES S.A. - PROGEN S.A., Carrera 3 No. 56 - 07, Centro Industrial Cazucá, Entrada 2 Soacha, SOACHA, CUNDINAMARCA, CO	9, 37	10	9. CAMISAS, DELANTALES, OVEROLES, CHAQUETAS, GUANTES Y GORRAS CON PROTECTOR DE CARA Y CUELLO, A SABER TRAJES PARA FUMIGACIÓN. 37. SERVICIOS DE FUMIGACIÓN.	No	ALICIA LLOREDA RICALARTE, CALLE 72A No. 5-83, PISO 3, BOGOTÁ, D.C., CO	18 oct. 2016	29 may. 2015		
15055343	COLOR VERDE (PANTONE 382C) DELIMITADO POR LA FORMA DE UN SACO DE CEMENTO		11 mar. 2015	09 may. 2029	Registrada		CEMENTOS ARGOS S.A., Carrera 53 No. 106-280, Centro Empresarial Buenavista, Piso 17, BARRANQUILLA, ATLÁNTICO, CO	19	10	19. CEMENTO, CONCRETO, CAL, CALIZA, GRAVILLA Y DEMÁS MATERIALES DE CONSTRUCCIÓN METÁLICOS, CONSTRUCCIONES TRANSPORTABLES NO METÁLICAS, ASFALTO.	No	JUAN GUILLERMO MOURE PEREZ, CARRERA 5 No. 34-03, BOGOTÁ, D.C., CO	09 may. 2019	29 may. 2015		
15055364	COLOR VERDE (PANTONE 382C) DELIMITADO POR LA FORMA DE UN SACO DE CEMENTO		11 mar. 2015	09 may. 2029	Registrada		CEMENTOS ARGOS S.A., Carrera 53 No. 106-280, Centro Empresarial Buenavista, Piso 17, BARRANQUILLA, ATLÁNTICO, CO	19	10	19. CEMENTO, CONCRETO, CAL, CALIZA, GRAVILLA Y DEMÁS MATERIALES DE CONSTRUCCIÓN NO METÁLICOS, CONSTRUCCIONES TRANSPORTABLES NO METÁLICAS, ASFALTO.	No	JUAN GUILLERMO MOURE PEREZ, CARRERA 5 No. 34-03, BOGOTÁ, D.C., CO	09 may. 2019	29 may. 2015		
15113874	Pantone 2747C(azul), Pantone 877C(plata)		20 may. 2015	29 sept. 2026	Registrada		RED BULL GMBH, Am Brunnen 1, FUSCHL AM SEE, SALZBURG 5330, AT	32	10	32. BEBIDAS ENERGÉTICAS.	No	EDUARDO VARELA PEZZANO, CARRERA 4 NO. 72 - 35, BOGOTÁ, D.C., CO	29 sept. 2016	10 jun. 2015		
15117118	COLOR AMARILLO CON PANTONE PMS 100 DELIMITADO POR UNA FORMA IRREGULAR ONDULADA. LA LÍNEA PUNTEADA TIENE COMO OBJETO DELIMITAR LA MARCA. NO SE REIVINDICA PRIORIDAD SOBRE LA FORMA.		22 may. 2015	14 mar. 2026	Registrada		GEORGIA-PACIFIC GYPSUM LLC, 133 PEACHTREE STREET, N.E., ATLANTA, GEORGIA 30303, ESTADOS UNIDOS DE AMERICA, ATLANTA, GEORGIA, US	19	10	19. REVESTIMIENTO DE YESO UTILIZADO PARA LA CONSTRUCCIÓN DE PAREDES EXTERIORES.	No	JUAN PABLO CONCHA DELGADO, AVENIDA 82 No. 10-62 PISO 5, BOGOTÁ, D.C., CO	14 mar. 2016	19 jun. 2015		
15161937	TRATÁNDOSE DE UNA MARCA DE COLOR, SE SOLICITA DEJAR EN BLANCO EL APARTADO DENOMINACIÓN, COINCIDENTE CON LA DESCRIPCIÓN DE LA MARCA		13 jul. 2015	27 feb. 2027	Registrada		NATALIA GIRALDO NARVÁEZ, CRA 1 No 15-10, VILLAMARIA, CALDAS, CO	1	10	1. PRODUCTOS DE CARBÓN Y SUS DERIVADOS INCLUYENDO NUEVAS TECNOLOGÍAS, GRAFITOS, GRAFENO Y GRAFANO, BLOQUES DE GRAFITOS, ELECTROGRAFITO PARA USO INDUSTRIAL, ADEMÁS DE PRODUCTOS QUÍMICOS UTILIZADOS PARA MANTENIMIENTO DE MÁQUINAS ELÉCTRICAS, RESORTES, TALADROS, PULIDORAS, MOTORES, RUTADORAS, LICUADORAS, ASPIRADORAS, SECADORES DE CABELLO ENTRE OTROS ELECTRODOMÉSTICOS. TAMBIÉN PRODUCTOS QUÍMICOS PARA EL MANTENIMIENTO DE REPUESTOS, INTERRUPTORES, ESCOBILLAS, BUJES SELLO	No	ADRIANA RAVE VALENCIA, CALLE 65A No. 23A-04, MANIZALES, CALDAS, CO	27 feb. 2017	16 dic. 2015		
15188105			12 ago. 2015	18 oct. 2026	Registrada		COMPAÑIA LECHERA DEL MORTIÑO S.A.S COMLEMO S.A.S, KM 7 VIA ZIPAQUIRA - NEMOCÓN VEREDA EL MORTIÑO, COGUA, CUNDINAMARCA, CO	29	10	29. PRODUCTO LÁCTEO: BEBIDA LÁCTEA, ALIMENTO LÁCTEO, PREPARACIÓN LÁCTEA.	No	JOSE DEL CARMEN BUSTOS CORTES, CRA. 9 NO. 10 - 06, ZIPAQUIRA, CUNDINAMARCA, CO	18 oct. 2016	20 ago. 2015		

15201590			27 ago. 2015	08 feb. 2028	Registrada		RED BULL GMBH, Am Brunnen 1, FUSCHL AM SEE, SALZBURG 5330, AT	32	10	32. BEBIDAS NO ALCOHÓLICAS; REFRESCOS; BEBIDAS ENERGÉTICAS; BEBIDAS DE SUERO; BEBIDAS REFRESCANTES; BEBIDAS HIPERTÓNICAS E HIPOTÓNICAS (PARA USO POR PARTE DE ATLETAS Y/O DEMANDADAS POR ATLETAS); BEBIDAS ISOTÓNICAS; CERVEZAS; CERVEZA DE MALTA; CERVEZA DE TRIGO; PORTER; ALE; STOUT Y LAGER; AGUAS MINERALES [BEBIDAS]; AGUAS DE MESA Y AGUAS GASEOSAS; JUGOS Y ZUMO DE FRUTAS; BEBIDAS DE ZUMO DE VERDURAS O FRUTA NO ALCOHÓLICAS Y EXTRACTOS DE FRUTA NO ALCOHÓLICOS; SIROPE Y OTRAS PREPARACIONES PARA HACER BEBIDAS Y SIROPE PARA LIMONADA; PASTILLAS Y POLVOS PARA BEBIDAS EFERVESCENTES; APERITIVOS Y CÓCTELES NO ALCOHÓLICOS; SORBETES [BEBIDAS]; BATIDOS.	No	EDUARDO VARELA PEZZANO, CARRERA 4 NO. 72 - 35, BOGOTÁ, D.C., CO	08 feb. 2018	10 oct. 2017		
13263153	PANTONE 136C LA LINEA PUNTEADA TIENE COMO OBJETO DELIMITAR EL COLOR. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA EN QUE APARECE EL COLOR, EL CUAL PODRÁ SER APLICADO A OTRAS FORMAS.		07 nov. 2013	27 jun. 2034	Registrada		Société des Produits Nestlé S.A., AVENUE NESTLÉ 55, VEVEY, VAUD CH-1800, CH	5, 29	10	5. ALIMENTOS DIETÉTICOS Y SUBSTANCIAS PARA USO MÉDICO Y CLÍNICO; ALIMENTOS Y SUBSTANCIAS ALIMENTICIAS PARA BEBÉS, NIÑOS Y ENFERMOS; ALIMENTOS Y SUBSTANCIAS ALIMENTICIAS PARA MUJERES QUE AMAMANTAN; SUPLEMENTOS DIETÉTICOS Y NUTRICIONALES; PREPARACIONES VITAMÍNICAS, SUPLEMENTOS MINERALES; FIBRAS ALIMENTARIAS. 29. LECHE Y OTRAS PREPARACIONES HECHAS A PARTIR DE LECHE, SUBSTITUTOS DE LECHE; BEBIDAS A BASE DE LECHE; LECHE DE SOYA (SUCEDÁNEOS DE LA LECHE), LECHE FORTIFICADA CON PROTEÍNAS; SUBSTITUTOS DE CREMA PARA EL CAFÉ Y/O EL TÉ; LECHE, PRODUCTOS LÁCTEOS, SUBSTITUTOS DE LECHE Y PRODUCTOS LÁCTEOS, Y BEBIDAS HECHAS A BASE DE LECHE, DIETÉTICA Y/O NUTRICIONALMENTE FORTIFICADOS.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	27 jun. 2014	20 feb. 2014		
13263229	PANTONE 115C. LA LINEA PUNTEADA TIENE COMO OBJETO DELIMITAR EL COLOR. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA EN QUE APARECE EL COLOR, EL CUAL PODRÁ SER APLICADO A OTRAS FORMAS.		07 nov. 2013	22 sept. 2034	Registrada		Société des Produits Nestlé S.A., AVENUE NESTLÉ 55, VEVEY, VAUD CH-1800, CH	5, 29	10	5. ALIMENTOS DIETÉTICOS Y SUBSTANCIAS PARA USO MÉDICO Y CLÍNICO; ALIMENTOS Y SUBSTANCIAS ALIMENTICIAS PARA BEBÉS, NIÑOS Y ENFERMOS; ALIMENTOS Y SUBSTANCIAS ALIMENTICIAS PARA MUJERES QUE AMAMANTAN; SUPLEMENTOS DIETÉTICOS Y NUTRICIONALES; PREPARACIONES VITAMÍNICAS, SUPLEMENTOS MINERALES; FIBRAS ALIMENTARIAS. 29. LECHE Y OTRAS PREPARACIONES HECHAS A PARTIR DE LECHE, SUBSTITUTOS DE LECHE; BEBIDAS A BASE DE LECHE; LECHE DE SOYA (SUCEDÁNEOS DE LA LECHE), PREPARACIONES PROTEÍNICAS PARA LA ALIMENTACIÓN; SUBSTITUTOS DE CREMA PARA EL CAFÉ Y/O EL TÉ; LECHE, PRODUCTOS LÁCTEOS, SUBSTITUTOS DE LECHE Y PRODUCTOS LÁCTEOS, Y BEBIDAS HECHAS A BASE DE LECHE, DIETÉTICA Y/O NUTRICIONALMENTE FORTIFICADOS.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	22 sept. 2014	14 nov. 2013		
15208111			04 sept. 2015	20 ene. 2027	Registrada		PRODUCTOS RAMO S.A.S., Avenida Calle 116 # 7-15 Interior 2, Oficina 1502, BOGOTÁ, D.C., CO	30	10	30. PASTELES, BIZCOCHOS, TORTAS Y PONQUÉS.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	20 ene. 2017	20 abr. 2016		
15221542	COLOR ROJO PANTONE 485C DELIMITADO POR LA FORMA BIDIMENSIONAL DE UNA BOLSA DE LECHE. LA LINEA PUNTEADA TIENE COMO OBJETO DELIMITAR LA MARCA. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA.		18 sept. 2015	04 jul. 2027	Registrada		PRODUCTOS NATURALES DE LA SABANA S.A.S. BIC, KILÓMETRO 5 VÍA A TABIO, BOGOTÁ, D.C., CO	29	10	29. LECHE Y PRODUCTOS LÁCTEOS	Si	MANUEL ANTONIO GUERRERO GAITAN, TRANSVERSA L 2 67 - 15, BOGOTÁ, D.C., CO	04 jul. 2017	09 oct. 2015		
15233524	COLOR VERDE PANTONE 348 LIMITADO POR LA FORMA DE UNA CUBETA DE HUEVOS		01 oct. 2015	24 jun. 2026	Registrada		INCUBADORA SANTANDER S.A., Cra 15 # 3AN- 50 Acceso 3, piso 10, Torre Empresarial Delacuesta, PIEDECUESTA, SANTANDER, CO	29	10	29. HUEVOS	No	MARIO ANDRES ORTEGA MENDOZA, CL 44 C 45 28 TO 5 AP 801, BOGOTÁ, D.C., CO	24 jun. 2016	20 oct. 2015		
15233614	MARCA COLOR PANTONE 354 APLICADO A LA FORMA DE UNA CUBETA DE HUEVOS		01 oct. 2015	24 jun. 2026	Registrada		INCUBADORA SANTANDER S.A., Cra 15 # 3AN- 50 Acceso 3, piso 10, Torre Empresarial Delacuesta, PIEDECUESTA, SANTANDER, CO	29	10	29. HUEVOS	No	MARIO ANDRES ORTEGA MENDOZA, CL 44 C 45 28 TO 5 AP 801, BOGOTÁ, D.C., CO	24 jun. 2016	20 oct. 2015		

15265801	LA MARCA CONSISTE EN LA COMBINACIÓN DE COLORES VERDE (PANTONE 364 C) Y AMARILLO (PANTONE 109C) PARA SER APLICADOS EN LAS FORMAS DE LOS PRODUCTOS DE LAS CLASES 7, 12 Y 28 ASÍ COMO EN SUS EMPAQUES. NO SE REIVINDICAN DERECHOS DE EXCLUSIVA SOBRE LAS FORMAS. ES IMPORTANTE ACLARAR QUE EL TIPO DE SIGNO DE ESTA SOLICITUD NO ES UNA MARCA DE COLOR SINO UNA MARCA DE COMBINACIÓN DE COLORES DE CONFORMIDAD CON EL ARTÍCULO 134 LITERAL C) DE LA DECISIÓN ANDINA 486. - LOS COLORES REIVINDICADOS SON COMBINACIÓN VERDE...		06 nov. 2015	03 may. 2026	Registrada		DEERE & COMPANY., ONE JOHN DEERE PLACE, MOLINE, ILLINOIS, US	7, 12, 28	10	7. MÁQUINAS E IMPLEMENTOS PARA USO EN LA AGRICULTURA, LA HORTICULTURA, EL PAISAJISMO Y LA SILVICULTURA. 12. VEHÍCULOS PARA USO EN LA AGRICULTURA, LA SILVICULTURA, LA HORTICULTURA Y EL PAISAJISMO. 28. JUEGOS; PEQUEÑAS RÉPLICAS A ESCALA DE JUGUETES QUE REPRESENTAN MÁQUINAS Y VEHÍCULOS DESTINADOS A LA AGRICULTURA, HORTICULTURA, PAISAJISMO Y SILVICULTURA.	No	Manuel Chavarriaga Pérez, Carrera 7 #71-21 - Edificio Avenida Chile, Torre B - Piso 13, BOGOTÁ, D.C., CO	03 may. 2016	20 nov. 2015		
15265805	LA MARCA CONSISTE EN LA COMBINACIÓN DE COLORES VERDE (PANTONE 364 C) Y AMARILLO (PANTONE 109C) DELIMITADOS POR LA FORMA DE UNA MÁQUINA, EN LA QUE EL VERDE ES APLICADO A LA SUPERFICIE EXTERIOR DE LA MÁQUINA Y EL AMARILLO ES APLICADO EN FORMA DE LÍNEA EN ESA MISMA SUPERFICIE Y EN LAS LLANTAS DE LA MÁQUINA TAL Y COMO SE APRECIA EN LA REPRESENTACIÓN GRÁFICA DE LA MARCA. LA FORMA PUNTEADA TIENE LA INTENCIÓN DE ESPECIFICAR LA POSICIÓN DE LA MARCA EN LOS PRODUCTOS (LA CUAL SE REIVINDICA COMO PARTE DE L...		06 nov. 2015	11 nov. 2026	Registrada		DEERE & COMPANY., ONE JOHN DEERE PLACE, MOLINE, ILLINOIS, US	7	10	7. MÁQUINAS E IMPLEMENTOS PARA USO EN LA AGRICULTURA, LA HORTICULTURA, EL PAISAJISMO Y LA SILVICULTURA.	No	Manuel Chavarriaga Pérez, Carrera 7 #71-21 - Edificio Avenida Chile, Torre B - Piso 13, BOGOTÁ, D.C., CO	11 nov. 2016	10 feb. 2016		
16009741	COLOR PANTONE 127U DELIMITADO POR UNA FORMA RECTANGULAR SOBRE LA CUAL NO SE REIVINDICA PROTECCIÓN.		18 ene. 2016	25 ago. 2030	Registrada		ETEX COLOMBIA S.A., PARQUE INDUSTRIAL JUANCHITO KM 14 VIA AL MAGDALENA, MANIZALES, CALDAS, CO	19	10	19. PLACAS DE YESO.	No	INES CONSUELO BENJUMEA RENDON, Carrera 42 No. 3 Sur 81 Oficina 1013, Torre 2 Edificio Milla de Oro, Distrito de Negocios., MEDELLIN, ANTIOQUIA, CO	25 ago. 2020	29 abr. 2016		
SD2016/0034456	LA MARCA CONSISTE EN LA COMBINACIÓN DE COLORES VERDE (PANTONE 364C) Y AMARILLO (PANTONE 109C) DELIMITADOS POR LA FORMA DE UN VEHÍCULO. EN LA QUE EL VERDE ES APLICADO A LA SUPERFICIE EXTERIOR DEL VEHÍCULO Y EL AMARILLO ES APLICADO EN FORMA DE LÍNEA EN ESA MISMA SUPERFICIE Y EN LAS LLANTAS DEL VEHÍCULO TAL Y COMO SE APRECIA EN LA REPRESENTACIÓN GRÁFICA DE LA MARCA. LA FORMA PUNTEADA TIENE LA INTENCIÓN DE ESPECIFICAR LA POSICIÓN DE LA MARCA EN LOS PRODUCTOS (LA CUAL SE REIVINDICA COMO PARTE DE ...		05 oct. 2016	18 feb. 2030	Registrada	88681/1	DEERE & COMPANY., ONE JOHN DEERE PLACE, MOLINE, ILLINOIS, US	12, 28	10	12. Vehículos y partes de vehículos para uso en el campo relacionados con la agricultura, la silvicultura, la horticultura y el paisajismo. 28. Juegos; vehículos, máquinas y aparatos de juguete y sus partes, pequeñas réplicas a escala de juguetes que representan máquinas y vehículos destinados a la agricultura, horticultura, paisajismo y silvicultura.	No	Manuel Chavarriaga Pérez, Carrera 7 #71-21 - Edificio Avenida Chile, Torre B - Piso 13, BOGOTÁ, D.C., CO	18 feb. 2020	10 mar. 2017		
SD2016/0034460	LA MARCA CONSISTE EN LA COMBINACIÓN DE COLORES VERDE (PANTONE 364 C) Y AMARILLO (PANTONE 109C) DELIMITADOS POR LA FORMA DE UNA MÁQUINA, EN LA QUE EL VERDE ES APLICADO A LA SUPERFICIE EXTERIOR DE LA MÁQUINA Y EL AMARILLO ES APLICADO EN FORMA DE LÍNEA EN ESA MISMA SUPERFICIE Y EN LAS LLANTAS DE LA MÁQUINA TAL Y COMO SE APRECIA EN LA REPRESENTACIÓN GRÁFICA DE LA MARCA.		05 oct. 2016	19 oct. 2028	Registrada	88680/1	DEERE & COMPANY., ONE JOHN DEERE PLACE, MOLINE, ILLINOIS, US	7	10	7. Máquinas, partes de máquinas, aparatos e implementos para uso en el campo relacionados con la agricultura, la horticultura, el paisajismo y la silvicultura.	No	Manuel Chavarriaga Pérez, Carrera 7 #71-21 - Edificio Avenida Chile, Torre B - Piso 13, BOGOTÁ, D.C., CO	19 oct. 2018	28 jul. 2017		
SD2016/0059428	Color Verde (Pantone 7481C) delimitado por la forma de un tanque de agua, sin reivindicar exclusividad sobre la forma.		30 dic. 2016	08 may. 2030	Registrada	PA-PO-IT164 Marca de color Tanque	ANDRES JULIAN ZAMBRANO GIRALDO, carrera 4 A No. 21 B 06, CHINCHINA, CALDAS, CO	40	10	40. Tratamiento del agua; tratamiento de subproductos del beneficio del café; tratamiento de materiales, de residuos y de aguas residuales; información sobre tratamiento de materiales; tratamiento de residuos en el ámbito del control de la contaminación medioambiental; servicios de recuperación medioambiental; tratamiento de agua potable, agua para servicios y aguas residuales. Consultoría en tratamiento de aguas, en tratamiento de subproductos del beneficio del café y en servicios ambientales.	No	NATALI RAMIREZ GARCIA, CALLE 69A No.24-37, MANIZALES, CALDAS, CO	08 may. 2020	09 feb. 2017		

SD2017/0004064	Color verde arrecife utilizado como signo distintivo de los vehículos de la empresa de transporte especial COOPSANTALUISA		24 ene. 2017	24 jul. 2027	Registrada		COOPSANTALUISA, calle 52# 27a-44, BOGOTÁ, D.C., CO	39		11	39. Organización de servicios de transporte; organización de transportes; reserva de transportes; servicios de asesoramiento en transporte; servicios logísticos de transporte; servicios de transporte relacionados con la celebración de acontecimientos; servicios de transporte para visitas turísticas; suministro de información sobre servicios de transporte; suministro de información sobre transporte; transporte; transporte en autocar; transporte en automóvil; transporte de pasajeros; transporte de pasajeros en autobús; transporte de pasajeros por carretera.	No	LORENA RINCON PATIÑO, CALLE 134 A # 124 B -02, BOGOTÁ, D.C., CO	24 jul. 2017	28 abr. 2017		
SD2017/0018730	La marca de Color que consiste en la combinación de colores: azul alborada Pantone 2145C, Color Azul nube Pantone 2173C y Color Blanco Occidente Pantone 11-0601 delimitados por la forma de un bus de servicio público, como se aprecia en la representación gráfica de la marca, sin que se reivindique la forma del bus.		15 mar. 2017	11 may. 2030	Registrada	MARCA DE COLOR SOCOBUSES	SOCIEDAD COORDINADORA DE BUSES URBANOS DE MANIZALES SOCOBUSES S.A., CALLE 20 NO. 12-34, MANIZALES, CALDAS, CO	39		11	39. Servicio de transporte público de pasajeros.	No	ADRIANA RAVE VALENCIA, CALLE 65A No 23A-04, MANIZALES, CALDAS, CO	11 may. 2020	21 ago. 2018		
SD2017/0020503	No se reivindica exclusividad sobre la forma como aparece el color.		22 mar. 2017	16 sept. 2030	Registrada	COLO-00612-701-106-9	PRODUCTOS RAMO S.A.S., Avenida Calle 116 # 7-15 Interior 2, Oficina 1502, BOGOTÁ, D.C., CO	30		11	30. Pasteles, bizcochos, tortas, ponqués y productos de pastelería y confitería a base de chocolate o que contienen chocolate.	Si	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	16 sept. 2020	10 abr. 2017		
SD2017/0025362	Marca de Color Pantone 382C delimitada por la forma de una cubeta para 12 huevos.		06 abr. 2017	25 ago. 2030	Registrada		INCUBADORA SANTANDER S.A., Cra 15 # 3AN- 50 Acceso 3, piso 10, Torre Empresarial Delacuesta, SANTANDER, CO	29		11	29. Huevos.	No	MARIO ANDRES ORTEGA MENDOZA, CL 44 C 45 28 TO 5 AP 801, BOGOTÁ, D.C., CO	25 ago. 2020	10 may. 2017		
SD2017/0027722	LA MARCA ES UNA COMBINACIÓN DEL COLOR VERDE Y AMARILLO (PANTONE 356 C Y YELLOW PROCESS) DELIMITADOS POR UNA FORMA PUNTEADA DE UN CUADRADO. LA FORMA PUNTEADA TIENE LA INTENCIÓN DE DELIMITAR LOS COLORES. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA SINO SOBRE LA COMBINACIÓN DE LOS COLORES.		18 abr. 2017	05 ene. 2031	Registrada	90046/1	BORGNET INTERNATIONAL HOLDINGS CORPORATION, PLAZA 2000, CALLE 50, PISO 16, CIUDAD DE PANAMA, PANAMA, PA	29		11	29. Coco deshidratado, snacks a base de coco, frutos secos, mezclas de mani con coco deshidratado.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	05 ene. 2021	31 oct. 2017		
SD2017/0027723	La marca es una combinación del color verde y amarillo (Pantone 356 c y yellow process) delimitados por una forma punteada de un bombón, en la que el verde es aplicado a todo el bombón y el amarillo consiste en una franja levemente arqueada que sin tocar los extremos atraviesa por el centro la parte superior del bombón de lado a lado. No se reivindica exclusividad sobre la forma del bombón sino sobre la combinación y disposición de los colores.		18 abr. 2017	13 ene. 2031	Registrada	90047/1	BORGNET INTERNATIONAL HOLDINGS CORPORATION, PLAZA 2000, CALLE 50, PISO 16, CIUDAD DE PANAMA, PANAMA, PA	30		11	30. Productos de pastelería, galletería y confitería con sabor a coco, cocadas y dulces típicos con sabor a coco.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	13 ene. 2021	31 oct. 2017		
SD2017/0027725	LA MARCA ES UNA COMBINACIÓN DEL COLOR VERDE Y AMARILLO (PANTONE 356 C Y YELLOW PROCESS) DELIMITADOS POR UNA FORMA PUNTEADA DE UN CUADRADO. LA FORMA PUNTEADA TIENE LA INTENCIÓN DE DELIMITAR LOS COLORES. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA SINO SOBRE LA COMBINACIÓN DE LOS COLORES.		18 abr. 2017	05 ene. 2031	Registrada	90048/1	BORGNET INTERNATIONAL HOLDINGS CORPORATION, PLAZA 2000, CALLE 50, PISO 16, CIUDAD DE PANAMA, PANAMA, PA	30		11	30. Productos de pastelería, galletería y confitería con sabor a coco, cocadas y dulces típicos con sabor a coco.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	05 ene. 2021	31 oct. 2017		
SD2017/0027729	LA MARCA ES UNA COMBINACIÓN DEL COLOR VERDE Y AMARILLO (PANTONE 356 C Y YELLOW PROCESS) DELIMITADOS POR UNA FORMA PUNTEADA DE UN TURRÓN, EN LA QUE EL VERDE ES APLICADO A TODO EL TURRÓN Y EL AMARILLO CONSISTE EN UNA FRANJA LEVEMENTE ARQUEADA QUE SIN TOCAR LOS EXTREMOS ATRAVIESA POR EL CENTRO EL TURRÓN DE LADO A LADO. LA FORMA PUNTEADA TIENE LA INTENCIÓN DE DELIMITAR LOS COLORES. NO SE REIVINDICA EXCLUSIVIDAD SOBRE LA FORMA DEL TURRÓN SINO SOBRE LA COMBINACIÓN Y DISPOSICIÓN DE LOS COLORES.		18 abr. 2017	05 ene. 2031	Registrada	89818/1	BORGNET INTERNATIONAL HOLDINGS CORPORATION, PLAZA 2000, CALLE 50, PISO 16, CIUDAD DE PANAMA, PANAMA, PA	30		11	30. Productos de pastelería, galletería y confitería con sabor a coco, cocadas y dulces típicos con sabor a coco.	No	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	05 ene. 2021	31 oct. 2017		

SD2017/0036724	Marca de color (Pantone 348) delimitado por una cubeta de 12 huevos.		18 may. 2017	22 feb. 2030	Registrada	Marca color Pantone 348 (x12)	INCUBADORA SANTANDER S.A., Cra 15 # 3AN- 50 Acceso 3, piso 10, Torre Empresarial Delacuesta, PIEDECUESTA, SANTANDER, CO	29	11	29. Huevos*.	No	MARIO ANDRES ORTEGA MENDOZA, CL 44 C 45 28 TO 5 AP 801, BOGOTÁ, D.C., CO	22 feb. 2020	20 jun. 2017		
SD2017/0036716	Marca de Color Pantone 354 delimitado por la forma de una cubeta de huevos x 12		18 may. 2017	25 feb. 2030	Registrada	Marca color Pantone 354 (x12)	INCUBADORA SANTANDER S.A., Cra 15 # 3AN- 50 Acceso 3, piso 10, Torre Empresarial Delacuesta, PIEDECUESTA, SANTANDER, CO	29	11	29. Huevos*.	No	MARIO ANDRES ORTEGA MENDOZA, CL 44 C 45 28 TO 5 AP 801, BOGOTÁ, D.C., CO	25 feb. 2020	20 jun. 2017		
SD2017/0066913			30 ago. 2017	11 ago. 2030	Registrada	COLO-17873-701-012-8	DD IP HOLDER LLC, P. O. Box 9141, CANTON, MASSACHUSETTS 02021, US	30, 43	11	30. Donas; productos de panadería; galletas; Pasteles; tartas; Magdalenas (muffins americanos); pasteles fritos, simples, glaseados, recubiertos y rellenos; Bagels; sándwiches; pizza; Azúcar, harina, extractos saborizantes; Dulces en forma de pepitas para productos de horno; miel; levadura, polvo para hornear; rellenos a base de crema inglesa para pasteles; rellenos a base de chocolate para pasteles; coberturas de chocolate; café y bebidas a base de café; té y bebidas a base de té; cocoa y bebidas a base de cocoa; bebidas granizadas de café saborizado. 43. Servicios de restauración; servicios de cafetería; servicios de bares de comida rápida; servicios de restaurantes de comida rápida.	No	EDUARDO VARELA PEZZANO, CARRERA 4 NO. 72 - 35, BOGOTÁ, D.C., CO	11 ago. 2020	11 sept. 2017		
SD2017/0080270	La marca de color consiste en Naranja Pantone (805c) y negro delimitado por la figura bidimensional de una cinta métrica. la línea punteada tiene por objeto delimitar el signo. no se reivindica exclusividad sobre la forma.		17 oct. 2017	03 dic. 2031	Registrada		APEX BRANDS, INC., 1000 LUFKIN ROAD APEX, NORTH CAROLINA 27539 USA, APEX, NORTH CAROLINA, US	9	11	9. Cintas Métricas.	Si	JUAN PABLO CONCHA DELGADO, AVENIDA 82 No. 10-62 PISO 5, BOGOTÁ, D.C., CO	03 dic. 2021	30 sept. 2019		
SD2017/0085170	La marca consiste en la combinación de los colores NARANJA RAL 2010 y GRIS RAL 7035, delimitados por la forma de una motosierra, en la que el color NARANJA RAL 2010 se aplica a la parte superior de la cubierta y el color GRIS RAL 7035 es aplicado a la parte inferior de la cubierta, como se evidencia en la representación gráfica adjunta a la solicitud de registro. La línea punteada tiene la intención de especificar la forma cómo se va a aplicar la combinación de colores en los productos (la cual se...		31 oct. 2017	19 ene. 2032	Registrada	188-IPEJ17 Marca Color STIHL	ANDREAS STIHL AG [8] CO KG., BADSTRASSE 115 71336 WAIBLINGEN ALEMANIA, WAIBLINGEN, NOT DEFINED, DE	7	11	7. Motosierras.	No	CLAUDETTE VERNOT HERNÁNDEZ, Cra 13 # 90 - 17 (110221), BOGOTÁ, D.C. 110221, CO	19 ene. 2022	31 ene. 2018		
SD2018/0106070	La marca consiste en el degradado y la combinación de los colores reivindicados en la solicitud, delimitado por la forma de un cuadrado que tiene sus bordes curvos. No se reivindica exclusividad sobre dicha forma.		28 dic. 2018	24 sept. 2031	Registrada		INSTAGRAM, LLC, 1601 WILLOW ROAD, MENLO PARK, CALIFORNIA 94025, ESTADOS UNIDOS DE AMERICA, MENLO PARK, CALIFORNIA, US	9, 42	11	9. Software para crear y gestionar perfiles de redes sociales y cuentas de usuario; Software informático para redes sociales e interacción con comunidades en línea; Software de computadora para modificar fotografías, imágenes y audio, video y contenido audiovisual con filtros fotográficos y efectos de realidad aumentada (AR), a saber, gráficos, animaciones, textos, dibujos; Software informático para modificar y habilitar la transmisión de imágenes, audio, audiovisuales y contenido y datos de video; software de mensajería; Software de computadora descargable para ver e interactuar con contenidos de noticias en imágenes, audio, audiovisuales y video con texto y datos asociados. 42. Servicios informáticos de la naturaleza de perfiles o páginas web personalizadas electrónicas; y grupales con información definida por el usuario o especificada, incluyendo audio, video, imágenes, texto, contenido y datos; servicios informáticos, en concreto, curación de contenidos y anuncios en línea definidos por el usuario y creación de feeds de redes sociales; suministro de uso temporal de software no descargable para redes sociales y creación de una comunidad virtual, y transmisión de audio, video, imágenes, texto, contenido y datos; suministro de uso temporal de software no descargable para cargar, descargar, archivar, habilitar la transmisión y compartir imágenes, contenido audiovisual, de video y texto y datos asociados; suministro temporal de software no descargable para mensajes electrónicos; suministrar el uso temporal de software no descargable para ver a interacción con una fuente de medios electrónicos a	No	LUZ HELENA ADARVE GOMEZ, CRA 7 No. 71-52 Torre B Piso 9, BOGOTÁ, D.C., CO	24 sept. 2021	12 abr. 2019		

SD2019/0000290	La marca consiste únicamente en el degradado de color en la cual la esquina inferior izquierda es amarilla, se atenúa a naranja y la esquina inferior derecha es roja y rosa. La parte superior del degradado es azul y púrpura, desvaneciéndose a rosa. Los elementos representados en las líneas punteadas, a saber, un cuadrado con bordes curvos, superpuesto sobre un cuadrado más grande, que contiene dos círculos uno en el centro y otro círculo más pequeño ubicado arriba y a la derecha del círculo		03 ene. 2019	21 oct. 2031	Registrada	6-2384	INSTAGRAM, LLC, 1601 WILLOW ROAD, MENLO PARK, CALIFORNIA 94025, ESTADOS UNIDOS DE AMERICA, MENLO PARK, CALIFORNIA, US	9, 42	11	9. Software para crear y gestionar perfiles de redes sociales y cuentas de usuario; Software informático para redes sociales e interacción con comunidades en línea; Software de computadora para modificar fotografías, imágenes y audio, video y contenido audiovisual con filtros fotográficos y efectos de realidad aumentada (AR), a saber, gráficos, animaciones, textos, dibujos; Software informático para modificar y habilitar la transmisión de imágenes, audio, audiovisuales y contenido y datos de video; software de mensajería; Software de computadora descargable para ver e interactuar con contenidos de noticias en imágenes, audio, audiovisuales y video con texto y datos asociados. 42. Servicios informáticos de la naturaleza de perfiles o páginas web electrónicas personalizadas o grupales con información definida por el usuario o especificada, incluyendo audio, video, imágenes, texto, contenido y datos; servicios informáticos, en concreto, curaduría de contenidos y anuncios en línea definidos por el usuario y creación de feeds de redes sociales; suministro de uso temporal de software no descargable para redes sociales y creación de una comunidad virtual, y transmisión de audio, video, imágenes, texto, contenido y datos; suministro de uso temporal de software no descargable para cargar, descargar, archivar, habilitar la transmisión y compartir imágenes, contenido audiovisual y de video y el texto y datos asociados; suministro temporal de software no descargable para mensajes electrónicos; suministrar el uso temporal de software no descargable para ver e interactuar con una fuente de medios electrónicos.	No	LUZ HELENA ADARVE GOMEZ, CRA 7 No. 71-52 Torre 8 Piso 9, BOGOTÁ, D.C., CO	21 oct. 2021	19 feb. 2019	17 jul. 2018
SD2019/0066589			05 ago. 2019	16 abr. 2030	Registrada	COLOR POP UP BURO	POP UP BURO S.A.S., CL 95 NO. 13 55 OF 215, BOGOTÁ, D.C. 110111, CO	35	11	35. Organización de ferias con fines comerciales o publicitarios.	No	FELIPE ABELLO MONSALVO, Carrera 10 No. 97A - 13, Torre A, Oficina 506, BOGOTÁ, D.C., CO	16 abr. 2020	21 oct. 2019	
SD2021/0074195	Color verde Pantone PMS 7739 C delimitado por la forma de una bolsa; La línea punteada tiene por objeto delimitar la marca, no se reivindica exclusividad sobre la forma.		05 ago. 2021	19 nov. 2034	Registrada	102844/1	Société des Produits Nestlé S.A., AVENUE NESTLÉ 55, VEVEY, VAUD CH-1800, CH	30	11	30. Modificador de leche en polvo a base de malta y cocoa.	Sí	MAURICIO PATIÑO BONNET, CARRERA 9 No. 74-08 OFICINA 305, BOGOTÁ, D.C., CO	19 nov. 2024	20 dic. 2021	
SD2022/0058625	El signo consiste en una combinación de dos colores delimitada por un cuadrado dividido en dos sectores donde uno de los sectores va en color naranja (Pantone 172C) y el segundo sector en un color café (Pantone 4695C). Adicionalmente, la línea o frontera de unión de los dos colores consiste en una honda curva donde el primer sector de color naranja es proporcionalmente más grande al segundo sector de color café. No se reivindica exclusividad sobre dicha forma.		10 jun. 2022	23 dic. 2034	Registrada	M2022/000504	COMPAÑIA NACIONAL DE CHOCOLATES S.A.S., CARRERA 43A NO. 1A SUR 143 EDIFICIO SANTILLANA, MEDELLIN, ANTIOQUIA, CO	30	11	30. Cereales listos para comer; cereales procesados; cereales para el desayuno; alimentos procesados a base de cereales que se utilizarán como alimentos para el desayuno; barras de cereales; cereales preparados para la alimentación humana; mezclas de cereales para el desayuno; preparaciones a base de cereales; snacks a base de cereales; productos alimenticios en los que predominan los cereales.	Sí	MAURICIO JARAMILLO CAMPUZAN O, Calle 67 No. 7-35 Of 1204, BOGOTÁ, D.C., CO	23 dic. 2024	11 oct. 2022	
SD2023/0016190	La marca consiste en la combinación de los colores: azul (Pantone 3272 C C:100 M:0 Y:44 K:0 R:0 G:170 B:166), negro (Pantone Black C C:0 M:0 Y:0 K:100 R:29 G:29 B:7), blanco (Pantone Blanco C:0 M:0 Y:0 K:0 R:255 G:255 B:255, gris, rojo y naranja, delimitados por la forma de un vehículo de servicio público, como se aprecia en la representación gráfica de la marca. En la parte frontal y posterior del vehículo, el color negro es aplicado en la parte del techo del vehículo y el color azul es aplicado...		01 mar. 2023	05 ago. 2035	Registrada	COLO-14588-701-066-1	EMPRESA DE TRANSPORTE DEL TERCER MILENIO TRANSMILENIO S.A., Avenida Dorado No. 69-76 Torre 1, Piso 5, Edificio Elemento,, BOGOTÁ, D.C., CO	39	11	39. Transporte; transporte público; todos los servicios relacionados con el transporte de personas y cosas de un lugar a otro y en general todos los servicios relacionados con esta actividad.	No	EDUARDO VARELA PEZZANO, CARRERA 4 NO. 72 - 35, BOGOTÁ, D.C., CO	05 ago. 2025	17 mar. 2025	
SD2024/0066004			26 jun. 2024	15 sept. 2035	Registrada	M2024/000506	EMPRESAS PUBLICAS DE MEDELLIN E.S.P, CARRERA 58 NO 42 - 125 EDIFICIO INTELIGENTE SOTANO 2, MEDELLIN, ANTIOQUIA, CO	39	12	39. Distribución de energía eléctrica, gas y agua; suministro de energía eléctrica, gas y agua; servicios públicos, a saber, suministro y distribución de agua; servicios públicos, a saber, distribución de energía eléctrica; suministro de energía eléctrica como servicio de utilidad pública; servicios públicos, a saber, distribución de gas natural; servicios de suministro de gas.	No	JUAN GUILLERMO MOURE PEREZ, CARRERA 5 No. 34-03, BOGOTÁ, D.C., CO	15 sept. 2025	09 sept. 2024	

SD2025/0044422	La marca consiste en el color Pantone 1375U delimitado por la forma del signo aritmético más (+). La línea punteada tiene por objeto delimitar la marca, no se reivindica exclusividad sobre la forma.		13 may. 2025	29 oct. 2035	Registrada	C - 651 Color +	G.U.C. S.A.S., CALLE 14 N° 52 A 370 LOCAL 201, MEDELLIN., ANTIOQUIA, CO	35, 36, 42	12	35. Administración comercial; administración de asuntos comerciales; administración de empresas de compañías inmobiliarias; administración de empresas de las agencias inmobiliarias; administración de negocios; administración de negocios comerciales. 36. Servicios financieros. 42. Servicios informáticos y tecnológicos para la protección de información personal y financiera; suministro de uso temporal de programas informáticos no descargables para la planificación financiera de empresas; supervisión electrónica de las transacciones y actividades financieras para detectar transacciones y actividades sospechosas, fraudulentas o ilícitas; servicios de utilización temporal de software no descargable para analizar datos financieros y generar informes; servicios de detección de fraudes en la utilización de tarjetas de crédito para comprar en línea; vigilancia electrónica de operaciones por tarjeta de crédito para la detección de fraudes por internet; investigación en el ámbito de la tecnología informática realizada a través de bases de datos e internet; investigación en el ámbito de la construcción inmobiliaria; servicios de análisis en el ámbito de la economía circular.	No	NORMA JULIANA ORDUZ BELTRAN, Calle 65A, 7 - 18, Piso 8., BOGOTÁ, D.C., CO	29 oct. 2025	06 jun. 2025		
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EUROPE

Contributor: Mr. Josh Little of Bird & Bird LLP

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

In the EU, colours can be protected in the form of registered trade marks. It is not possible to register broad or vague references to colours (such as red or blue) or colours that are commonly associated with the relevant goods and services, such as brown for chocolate. However, single colours and colour combinations can, in principle, be registered if the applicant can show that they are distinctive.

In the EU, a single colour must be precisely identified. This can be achieved quite easily by adopting an international colour code such as those under the Pantone colour scheme. Further, the colour must be distinctive in relation to the applied for goods and services, meaning consumers will associate it with a particular brand (such as Tiffany Blue or Louboutin Red).

The same principles apply for colour combinations. Each colour must be clearly represented with specific colour codes, and the proportion, layout, and placement of each colour must be fixed and used consistently in that arrangement. However, as a general principle, the higher the number of colours featured in a colour combination mark, the less distinctiveness it is likely to be, due to the difficulties associated with memorising a large number of different colours and their relevant sequence.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

Unlike traditional trade marks, such as words or logos, colour marks are generally more difficult to register in the EU. This is primarily due to their inherently non-distinctive nature and broader concerns surrounding the monopoly and potentially anti-competitive behaviour that a colour trade mark registration may encourage.

The EUIPO assesses colour marks in the same way as any other trade mark application. A trade mark may be represented in any appropriate form using generally available technologies, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner, so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor. For colours per se, it is mandatory to file a reference to a generally recognised colour code, such as Pantone, Hex, RAL, RGB or CMYK. Where the colour code(s) clearly do(es) not

correspond to the representation, the Office will issue a deficiency notice.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

EU trade mark applications for colour marks will almost always receive an absolute grounds refusal on the basis of non-distinctiveness. Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging. There are also competition principles at play. A small number of trade mark registrations for certain goods or services could exhaust the entire range of colours available. Such an extensive monopoly would be incompatible with a system of undistorted competition, in particular because it could have the effect of creating an unjustified competitive advantage for a single trader.

A colour is not normally inherently capable of distinguishing the goods of a particular undertaking. Therefore, single colours are not distinctive for any goods and services except under exceptional circumstances. Such exceptional circumstances require the applicant to demonstrate that the mark is unusual or striking in relation to these specific goods or services. These cases will be very rare.

Inherently non-distinctive colour marks may nonetheless be registrable if the applicant can provide evidence that the mark has obtained distinctive character. The acquisition of distinctive character through use must be proven for the part of the EU in which the trade mark concerned did not initially have this character. It is normally the case that a non-distinctiveness objection for a colour per se will exist throughout the EU, as it may be assumed that the assessment of distinctiveness will be the same throughout the EU, unless there is concrete evidence to the contrary. The threshold for acquired distinctiveness is very high, and the onus is on the applicant to overcome this hurdle.

Examples of evidence that can be put forward to the EUIPO to establish acquired distinctiveness include, but are not limited to, sales brochures, catalogues, invoices, annual reports, turnover figures, advertising investment (including figures, reports, press cuttings, billboard posters, television adverts), consumer or market surveys, and affidavits. The EUIPO will then make an overall assessment, based on all the evidence, to determine whether the mark has come to identify the applied-for goods or services concerned as originating from a particular undertaking.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

There are a number of colour marks registered at the EUIPO. A non-exhaustive list of examples is displayed below:

- EUTM Reg. No. 000655019 for  in Class 16 (Post It Note (3M))

- EUTM Reg. No. 000031336 for  in Class 30 (Milka (Kraft))
- EUTM Reg. No. 008148934 for  in Class 9 (Duracell)
- EUTM Reg. No. 1526441 for  in Classes 16, 24, 25, 28 (F.C. Barcelona)

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017, otherwise known as the EUTMR. The **EUTMR** is the primary piece of legislation that sets out the rules for registering and protecting trade marks (including colour marks) across the European Union.

Article 4 of the EUTMR is the key starting point, as it confirms that a colour can be registered as a trade mark provided that it is capable of being represented and capable of distinguishing the goods or services of one undertaking from another.

Article 7 of the EUTMR sets out the distinctiveness requirement that many colour trade marks struggle to overcome. For this reason, applicants wishing to register a colour trade mark must provide evidence of acquired distinctiveness illustrating extensive use in the market in order to prove that the mark has gained a “secondary meaning” and that consumers associate the colour with the specific brand.

Finally, the EUTMR governs the legal framework for enforcing a colour trade mark once it is registered. It recognises the exclusive rights that a colour trade mark registration offers in relation to the goods and/or services that protection has been obtained for.

While the EUTMR remains the key statutory framework governing the registration and protection of colour trade marks, a number of important cases have also shaped the key principles relating to colour marks that still apply to date. In *Libertel Groep BV v Benelux-Merkenbureau*, the CJEU recognised that although a single colour could, in principle, be registered as a trade mark, it must be capable of distinguishing the relevant goods or services and be represented with sufficient precision. A colour is often recognised as a characteristic rather than a badge of origin, so it must go beyond being merely decorative or functional in nature (such as the colour brown for chocolate). The public interest argument was emphasised in *Libertel*, with the fundamental idea being that colours should be freely available to the public given their limited number.

The next development in the law of colour trade marks came in *Heidelberger Bauchemie GmbH*, where the CJEU confirmed that combinations of colours could be registered if represented (such as by reference to an internationally recognised colour code as previously mentioned).

The reins on colour combination trade marks were slightly tightened in *Société des Produits Nestlé SA v Cadbury UK Ltd*, as the decision reinforced the principle that, in order for a colour combination to be registrable, applicants must show how the colours are combined, rather than merely listing them with their relevant colour codes. *Cadbury* also reiterated the importance of acquired distinctiveness and how it must be demonstrated across the entirety of the EU, and not just in a select jurisdiction.

Although a number of decisions relating to colour trade marks have been issued since, *Libertel*, *Heidelberger*, and *Cadbury* form the holy trinity of colour trade mark case law in the EU.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

When an assessment for likelihood of confusion of two colour marks is made, a phonetic or conceptual comparison of the signs is clearly not possible. The similarities must therefore be assessed on the basis of a visual comparison of the signs. Recognising the concept of colour depletion (namely the concept of restricting the availability of colours available for registration) and the fact that the inherent distinctiveness of colour marks per se is limited, the EUIPO states that the scope of protection of colour trade marks should be limited to identical or almost identical colour combinations. An example of the Board applying this reasoning can be found in *EU Case R 755/2009-4* (an analysis of which can be found at Question 6 to this paper), whereby the Board found that the colour combinations in that case, identified by different colour codes, were not sufficiently close to lead to a likelihood of confusion.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

The forum and procedures for opposing, invalidating, or cancelling a registered colour trade mark in the EU are set out below. There are no unique considerations in the forum and procedure for colour trade marks compared to other types of trade marks.

Trade Mark Opposition Proceedings

Opposition proceedings take place before the EUIPO (the “Office”) when a third party requests that the Office reject an EUTM application, or an international registration designating the EU, on the basis of earlier rights of the third party. An opposition must be based on rights held by the opponent in an earlier trade mark, or other form of trade sign. Therefore, the opposition can only be based on ‘relative grounds’. These are found in Article 8 EUTMR and involve inter partes proceedings based on likely conflict with earlier rights and which are not raised *ex officio* by the Office.

Notice of opposition and cooling off period

Opposition proceedings start upon receipt of the notice of opposition. The notice of opposition has to be received by the Office in written form within the opposition period (namely three months from publication of the contested EUTM application). Once received, the Office checks that the corresponding opposition fee has been paid and assess the admissibility of the opposition. After this examination, a notification is sent to both parties to set the time limits for the proceedings (“notification of admissibility”). These start with a period during which the parties are encouraged to negotiate an agreement (“cooling off” period). This is an automatic process in the EUIPO and serves as a period in which the parties are encouraged to negotiate an agreement amicably. The cooling off period expires 2 months from the notification of admissibility. It can be extended once by a period of 22 months. This request for an extension is agreed between the parties and the 22-month period which might be granted is irrespective of any specific length of time requested. The cooling off period can therefore last up to a total of 24 months.

Adversarial stage

Once the cooling off period has expired, the adversarial part of the proceedings begins. The opponent is then allowed a further two months in which to submit all evidence and observations it considers necessary (if any) to make its case. Once this period is over, the applicant has two months to reply to the opposition. At this point, the applicant can file a request for proof of use requiring the opponent to prove that any earlier marks registered for more than five years have been used. The opponent is then given the opportunity to comment on the applicant’s observations.

If proof of use is not requested, but the applicant still submits evidence and observations, then the opponent is given two months to comment on these. The Office may give the applicant a further two-month period to respond if the case is, for example, complex or a new point is raised by the opponent.

Once the parties have submitted their observations, the proceedings are closed, and the file is ready for a decision on substance. The parties will then be informed of the decision. There is option to appeal the decision to the Board of Appeal within two months of the date of notification of the decision.

Trade Mark Cancellation Proceedings

Both the revocation or invalidity of a registered EUTM are grouped under the general heading of ‘cancellation proceedings’ and are managed by the Cancellation Division. The rules covering these proceedings are predominantly contained in Articles 58-60 and Articles 62 and 64 EUTMR, and in Articles 12-20 EUTMDR.

Grounds for cancellation

The grounds for revocation are established in Article 58 EUTMR. In summary, an EU trade mark shall be declared to be revoked if:

- The EUTM has not been put to genuine use during a continuous period of 5 years.
- The EUTM has become generic due to acts/inactivity of its proprietor.
- The EUTM has become misleading due to the use made by its proprietor or with its consent.

The grounds for invalidity are the absolute grounds (established in Article 59 EUTMR) based on the inherent nature of the mark itself and the relative grounds (established in Article 60 EUTMR) based on conflicts with other existing rights.

Application for cancellation

Cancellation proceedings are initiated with the submission of an application for revocation or for a declaration of invalidity against a registered EUTM. Cancellation proceedings can never be initiated *ex officio* by the Office, but only upon receipt of an application from a third party.

The applicant bringing an application for revocation or for invalidity based on absolute grounds does not need to demonstrate an interest in bringing the proceedings. Conversely, for applications for invalidity based on relative grounds, these may only be filed by those persons mentioned in Article 46(1) EUTMR (in the case of applications based on Article 60(1) EUTMR), or by those entitled under European Union legislation or under the law of the Member State concerned to exercise the right in question (in the case of applications based on Article 60(2) EUTMR).

Unlike in the case of oppositions, there is no time limit for submitting a request for cancellation. Therefore, cancellation applicants should submit all the facts, evidence and arguments in support, together with the application.

Once received, the Office checks that the corresponding opposition fee has been paid and assess the admissibility of the opposition.

Adversarial stage

Once the application for cancellation has been found admissible, the adversarial part of the proceedings is opened and the application for cancellation and other documents received are sent to the EUTM proprietor. The Office may invite the parties to submit observations as often as it considers necessary. In practice, the Office will usually grant two rounds of observations, usually ending with those of the EUTM proprietor (i.e. application for cancellation, EUTM proprietor's observations, applicant's observations, EUTM proprietor's observations). The EUTM proprietor may also file a request for proof of use of the earlier trade marks in regard to applications for invalidity based on relative grounds.

Once the rounds of observations are over, the adversarial part is closed and the file is ready for a decision. Once the decision becomes final (i.e. if no appeal has been filed within the prescribed time limit, or when the appeal proceedings are closed), the Office will make the corresponding entry in the Register, in accordance with Article 64(6) EUTMR.

The legal effect of revocation

In the event of revocation, and to the extent that the rights of the proprietor have been revoked, the EUTM will be deemed not to have the effects specified in the EUTMR as from the date of the application for revocation.

The legal effect of invalidity

In the event of a declaration of invalidity, the EUTM will be deemed not to have had, as from the

outset, the effects specified in the EUTMR.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

The registration and enforcement of colour trade marks in digital or virtual contexts are treated by the EUIPO in the same way as other trade marks. The EUIPO provides specific guidance in its Guidelines for classifying both virtual goods and services in virtual environments. This would be applicable when registering or enforcing a colour trade mark in digital or virtual contexts.

The EUIPO address three instances of virtual goods:

1. those depicting real-world goods (e.g. a digital image of a piece of fruit to make a supermarket in an online game appear more realistic);
2. those depicting and emulating the function of real-world goods (e.g. a digital image of a piece of fruit that is somehow 'eaten' by an avatar); and
3. those representing objects with no equivalent in the real world (e.g. virtual time machines).

When drafting a specification for a trade mark, the EUIPO recommends indicating the type of goods, e.g. "virtual cosmetics", rather than a long list of the individual goods e.g. "virtual lipstick", "virtual mascara" etc. The term "virtual goods" by itself will not be accepted for lack of clarity and precision, however specifying the digital form in which the goods appear (e.g. digital files) is not required. Care must also be taken when choosing the relevant class of goods. For instance, "virtual clothing" would belong to Class 9 and not Class 25, since the term does not have the same purpose as real-life clothing in Class 25 (i.e. garments normally used by people to cover their bodies as opposed to applying a digital image of clothing to an avatar).

The EUIPO also address three categories of services in virtual environments:

1. real-world services that are provided via online or virtual environments;
2. services specifically developed for a virtual environment that emulate a real-world service online or in a virtual environment; and
3. services specifically developed for a virtual environment without counterparts in the real world.

The mere fact that real-world services are provided through a virtual environment does not affect how they are classified. This is because it is an established principle that the means by which a service is rendered does not impact its classification, provided that the means of provision does not change the purpose or result of the underlying service.

This principle applies to real-world services developed for a virtual environment, however this does not mean the virtual service would belong to the same type of activity as the real-world service. For example, "provision of virtual food and drink" would belong to Class 41, and not Class 43, since the services do not nourish people as they do in real-world situations.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

Examples of successful enforcement

EU Opposition No B3194629

Red Bull GmbH (“Opponent”) v. Gorbatschow Wodka KG (“Applicant”)

The Opponent filed an opposition against all the goods of European Union trade mark application



No 18 808 190 (figurative mark). The opposition was based on the following earlier colour combination trade marks owned by the Opponent:

- a) European Union Trade Mark Registration No 4 381 471: ;
 - b) International Trade Mark Registration No 857 309:  designating the European Union; and
 - c) European Union Trade Mark Registration No 18 028 411: ,
- each an “earlier mark”, and together, the “earlier marks”.

The Opponent argued that the Applicant’s mark is identical or similar to the Opponent’s earlier marks, that Opponent’s earlier marks have a reputation, and that use of the Applicant’s mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade marks.

In assessing the evidence, the Opposition Division placed particular weight on the following evidence provided by the Opponent:

- an affidavit including the figures related to unit sales of the opponent’s goods from 2013 to 2023, market share figures for 2022, media and marketing expenses from 2013 to 2023 in Austria and Germany and statistics to support the brand’s social media presence;
- an independent certified auditor’s report;
- market studies conducted by independent agencies in Germany and France demonstrating significant consumer association with Red Bull’s earlier mark;
- independent brand rankings and recognition evidence; and
- evidence of commercials, events and merchandising showing Red Bull’s colour marks as forming a prominent feature of the energy drink cans.



The Opposition Division found that Registration No 4 381 471:  obtained reputation among

the relevant public at the very least in Germany. As Germany is one of the largest countries in the European Union, it was considered a substantial part of the European Union such that reputation was proved in the relevant territory for energy drinks in Class 32.

The Opposition Division found that the signs are visually similar to a very low degree. Both marks contained the same colour combination arranged in geometrically divided fields. Furthermore, in both marks, the Opposition Division found the colour division to be symmetrical, sharp and evenly distributed. Conceptually, the semantic content conveyed by the Opponent's mark is that of the colours it reproduced and this was found to be conceptually similar to a very low degree to that of the Applicant's mark.

Taking into account all the relevant factors, the relevant consumers in Germany are likely to associate the Applicant's mark with Red Bull's mark so as to establish a mental 'link' between the signs.

Finally, there was long-established use and recognition of the Opponent's mark which makes it likely that the behaviour of consumers would be swayed in favour of the contested goods only because they are commercialised under the Applicant's sign. This would transfer the goodwill and exploit the Opponent's efforts in establishing reputation and the image of its mark, without payment in exchange.

German Case 33 Ø 14937/23

Paulaner Brauerei Gruppe ("Plaintiff") v. Kalrsberg Brauerei ("Defendant")

This was a trademark infringement case decided by the Regional Court of Munich I (Landgericht) ("Court"). The Plaintiff is the proprietor of European Trade Mark No 018282231 in class 32 for the

colour mark:  ("the contested mark"). The Plaintiff is a brewery that produces and

distributes beverages in the following packaging:  . The Defendant is also a brewery selling

beverages in the following packaging:  . The Plaintiff sued the Defendant for trade mark infringement.

The Court found the action to be well-founded. The contested mark was found to possess at least average distinctive character. The Court placed emphasis on the specific colour combination, in conjunction with the wave design. The goods were also found to be identical. There was also an average degree of similarity between the signs. Despite not featuring the same shade of magenta, the overall colour impression between the signs was similar, and both included a colour progression characterised by a sequence from lighter to darker colours. Likewise, the Court recognised that the colours magenta and violet are nuances between red and blue. As such, there is a high degree of similarity between the colour shades and sequence, as well as the graphic arrangement.

In reaching this decision, the Court found that the public perceives the colour scheme in the Defendant's packaging in isolation. The other signs that were applied to the Defendant's packaging were found to be used sparingly, and the public will rely on the eye-catching colour

scheme to determine the origin of the goods. This is supported by the fact that the average consumer in supermarkets and beverage stores would often be guided by large-scale colour designs and would recognise the colour scheme in its entirety.

The Court therefore found that there is a likelihood of confusion by consumers due to the least average distinctiveness of the contested mark and the moderate similarity between the signs.

Examples of unsuccessful enforcement

EU Case R 1860/2012-2

Red Bull GmbH (“Opponent”) v. X. B. M [a person] (“Applicant”)

The applicant sought to register the following figurative mark in classes 5, 30, and 32:  (the “application”). The Opponent opposed the application, relying on the following earlier rights, in particular:

a) Austrian Trade Mark Registration No 241 108 in classes 5 and 30:  (“earlier mark a”);

b) Austrian Trade Mark Registration No 246 684 in class 32:  (“earlier mark b”);

c) Austrian Trade Mark Registration No 253 550 in classes 5 and 30:  (“earlier mark c”); and

d) Community Trade Mark No 2 534 774 in class 32:  (“earlier mark d”),

each an “earlier mark”, and together, the “earlier marks”.

The Second Board of Appeal (“Board”) found that the contested goods in classes 5, 30, and 32 were identical and highly similar to the goods covered by the earlier marks.

However, the Board found that earlier mark a) was visually dissimilar to the application. There was no common verbal element or graphic between the signs. The background shades of blue and silver were different. Furthermore, there was no possible phonetic or conceptual comparison, since the earlier mark a) has no verbal element nor graphic element.

Similarly, the main background of earlier mark b) is identical to the one depicted in earlier mark a) (which was found dissimilar to the application). The additional verbal and graphic elements are also profoundly different, notwithstanding the fact they share the generic word ‘DRINK’. The main word elements, being “Red Bull” and “cool down”, have no aural similarity. These verbal expressions also relate to different concepts and that the Austrian general public who do not understand the English word elements will focus on their different depictions, namely the owl in the application and the two red bulls in the earlier mark b). The same reasoning was applied to earlier mark c), whilst earlier mark d) was held to have different shades of blue and silver depicted

in different proportions.

Therefore, since the signs were found to be dissimilar, a likelihood of confusion between the competing signs cannot exist. The Opponent also put forward the argument of unfair advantage. Given the dissimilarity of the application and the earlier marks, the application does not call to mind the earlier marks. As such, no link with the earlier marks exists. In doing so, there will be no damage from use of the application, and the Applicant will not take unfair advantage of the distinctive character or repute of the earlier marks.

EU Case R 755/2009-4

Proxxon S.A. (“Opponent”) v. Franz Jost AG (“Applicant”)

The Applicant sought to register the following mark in the colours “Yellow Pantone MS 142, Green RAL 6001” in class 8:  (the “application”). The Opponent opposed relying on the following marks:

- a) Community Trademark No 3 396 801 in classes 7, 8, and 9:  (“earlier mark a”);
- b) Benelux Trademark No 654 610 in classes 7, 8 and 9:  (“earlier mark b”); and
- c) International Registration No 748 039 in classes 7,8 and 9 designating France:  (“earlier mark c”),

each an “earlier mark”, and together, the “earlier marks”.

The marks had overlapping goods in the field of hand tools and instruments, and the Fourth Chamber of Appeal noted that green is a common colour in agriculture, due to its connotations to the natural colour of plants and the environment. Notwithstanding this, there was no likelihood of confusion with any of the three earlier marks. Earlier marks b) and c) had an inconsistent arrangement of the colours; with the lighter colour being positioned on the opposite side to the earlier marks. The colours themselves for all three earlier marks are also different; contrasting a clear yellow with a dirty ochre, and a normal green with a darker olive green. As such, the colours convey different overall impressions for consumers, especially at a more cursory glance. The Court therefore dismissed the opposition.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

Strategies for successfully filing a Colour Trade Mark Application in the EU

When filing a colour trade mark, it is important to be aware of the general conditions for registering a trade mark. These conditions are set out in Article 4 of the EU Trade Mark Regulations 2017 (“EUTMR”). In summary, in order to register an EU trade mark:

1. there must be a sign;
2. the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings; and
3. the sign must be capable of being represented on the Register in a manner that determines the clear and precise subject matter of the protection afforded.

The EUIPO Guidelines set out that a trade mark must be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor. The description, when given, must accord with the representation. As discussed previously, it is mandatory to file a reference to a generally recognised colour code, such as Pantone, Hex, RAL, RGB or CMYK.

Care must be taken when filing a colour trade mark consisting of two or more colours if they are presented in an abstract way and omitting the use of contours. The colours should be arranged both systematically and in a consistent and predetermined way and attempts to widen the scope of the mark by specifying that the colour combination could be arranged “in every conceivable form” would be unacceptable.

Furthermore, the EUIPO provides the following situations where a combination of two colours should be refused:

- where the colour would merely be a decorative element of the goods or comply with the consumer’s request (e.g. colours of cars or T-shirts), irrespective of the number of colours concerned);
- where the colour can be the nature of the goods (e.g. for tints);
- where a colour can be technically functional (e.g. colour red for fire extinguishers);
- where a colour may be usual (e.g. yellow for postal services in many countries);
- where a colour may indicate a particular characteristic of the goods such as flavour (pink for strawberry flavour) or the colour green as the colour of nature and thereby leading the public to understand it as referring to the ecological nature of the goods (e.g. wind energy converters); and
- where the colour combination can already be found of the market, in particular if used by different competitors (e.g. red and yellow in the context of beer and soft drink cans).

Evidential threshold in proving acquired distinctiveness through use

EU Case R 200/2017-4 (Giro Travel Company v. Andres Stihl AG & Co. KG) provides a good example of the evidential threshold for proving acquired distinctiveness through use. The case involved an invalidity action brought by Giro Travel Company against the registered colour mark

7472723 for the mark  for class 7: chain saws.

In this case, the Fourth Board of Appeal (the “Board”) recognised that neither relevant EUTM legislation, nor case law of the General Court or Court of Justice, has specified a mandatory form for the evidence that must be adduced to prove acquired distinctiveness. Instead, the distinctive character of a sign must be assessed in relation to the goods and services concerned and to the presumed perception of the relevant average consumer. The EUTM proprietor must submit evidence that enables the Office to conclude that, because of that trade mark, at least a significant proportion of the relevant section of the public identifies the products as originating

from a specific undertaking.

With this in mind, the Board stated that the evidence must be examined as a whole, taking into account such measures as:

- the market position held by the contested EUTM;
- the amount invested in promoting the mark;
- the proportion of the relevant class of persons who, as a result of the mark, identify the product as originating from a particular undertaking;
- how intensive, geographically widespread and long-standing the use of the mark has been;
- statements from chambers of commerce and industry or other trade associations; and
- opinion polls.

In this case, and on the topic of proving the long-standing, geographically widespread and intensive use of the contested EUTM as mentioned above, the Board placed particular weight on the following evidence provided by the EUTM proprietor:

- copies of internal instructions concerning the use of the colours for the visible parts of the product;
- catalogues displaying different models of the product in the protected colours;
- press releases, and article and website extracts, concerning sponsorship agreements, and advertising and TV commercials;
- extracts showing the EUTM proprietor's website in different languages;
- various statements provided by the Trade and Professional Associations from different Member States regarding their familiarity with the colour combination for orange/grey for gasoline chainsaws (in detail, orange for the upper part of the casing and light grey for the lower part);
- marketing and advertising materials and annual reports being designed in the protected colour trade marks;
- company structure of the EUTM proprietor as a company and its distribution chain through its EU subsidiaries and licenced dealers for demonstrating visibility and spread of the goods;
- data concerning the sales numbers and market share figures, turnover figures, the market position and advertising expenses; and
- list of TV-commercials for the product broadcasted across numerous member states.

On the topic of the proportion of the relevant public that identify chainsaws as originating from the EUTM proprietor, the Board assessed the relative probative value of evidence submitted in this area. It stated that advertising material and sales figures can only be regarded as secondary evidence in support of direct evidence of acquired distinctiveness through use. This might include survey evidence or market studies, or statements by professional bodies or the professional public. Furthermore, the Board acknowledged that previous case law recognises that a sign is not prevented from being shown to have acquired distinctiveness through use from a failure to provide opinion poll evidence. Similarly, no fixed percentages of market penetration or of recognition by the relevant public have been found in previous case law. Instead, and as addressed previously in this paper, the evidence should demonstrate that a significant proportion of the public perceives the mark as identifying the specific goods or services as originating from a particular undertaking, as recognised in previous case law.

In this case specifically, the EUTM proprietor provided a number of statements from entities in a range of market segments. The value that the Board placed on these was founded in the independence of the entities, the preparation of the statements in the language of origin of the

entity, and the precise and individual reference to the specific mark.

In the context of market surveys, the Board recognised that the probative value of such surveys depends on:

1. the type of survey method used;
2. whether the survey is carried out in the objective circumstances; and
3. the principles of demoscropy and the manner in which the survey questions were formulated.

In this regard, the Board noted that the survey questions were formulated in a neutral way. In particular, they did not mention or indicate the EUTM proprietor. Likewise, the surveys outlined the questions, their sequence and interviewer instructions correctly. Furthermore, the interviewees were representatively chosen.

Practical tips

Given the high evidential threshold in proving acquired distinctiveness through use of a colour trade mark, businesses looking to register such marks need to ensure that they possess the necessary evidence to demonstrate such use. Maintaining an up-to-date internal document filing system that collates all evidence of use of the colour trade mark is important. Furthermore, maintaining use of the same colour trade mark in the same style and shade is equally important, and businesses should record evidential documentation that proves such consistency of use.

When applying to register the colour trade mark, it is important that the application makes reference to a generally recognised colour code, such as Pantone, Hex, RAL, RGB or CMYK. Ensuring the specification for the relevant goods and services is very specific and very limited is also key to improving the chances of a successful registration.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

There is little in the way of co-existence of colour trade marks within Europe. Since very few applications for colour trade marks make it to registration, there exists relatively few registered colour trade marks on the European register. Of those colour trade marks that ultimately do make it to registration, there are few instances where there are two marks consisting of the same colour shade and gradient. Instead, there are some instances, albeit relatively few, where there exists two or more colour trade marks consisting of the same colour and a similar shade and tone. In these instances, there can sometimes be overlap in the classes for which the colour trade marks are protected. However, there exist differences in the precise goods and services so as to negate any overlap.

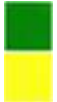
For example, in the context of single colours, there exists EUTM 000747949 by MHCS (the company behind Moët & Chandon) for the mark:  in class 33. There also exists EUTM

001292705 by B&H Holding GmbH (the company behind Stroh Rum) for the mark:  also in class 33. However, the specification for the former mark lists *champagne wines* within its specification, whereas the specification for the latter mark is protected for *Rum and beverages containing rum*.

The same can be said for the following registrations:

- EUTM 000396176 by Northern Technologies International Corporation for the mark:  in classes 2, 16 (*Anti corrosive plastic, paper, card and chipboard packaging*) and 17.
- EUTM 000655019 by 3M Company for the mark:  in class 16 (*Self-stick notes; stationery notes containing adhesive on one side for attachment to surfaces*).
- EUTM 010194835 by Grundfos Holding A/S for the mark:  in class 7 (*circulator pumps*).
- EUTM 003425311 by Hilti Aktiengesellschaft for the mark:  in class 7 (*Drill hammers for construction industry professionals; cases, in particular of metal or plastic, for transporting and storing drill hammers for construction industry professionals*).

The situation is similar for colour combinations, as demonstrated in the below registrations:

- EUTM 002925099 by MANN+HUMMEL GMBH for the mark:  in classes 7 (*Filters for motors and engines or machines for gaseous and liquid substances, in particular for air, gases, motor fuel and oil*), 11, 35 and 37.
- EUTM 006258131 by Deere & Company for the mark:  in classes 7 (*Self-propelled, pushed, drawn, towed, mounted, built-on or semi-mounted agricultural and forestry machines and implements; self-propelled, pushed, drawn, towed, mounted, built-on, hand-held or semi-mounted machines and implements for the maintenance, cleaning and conditioning of soils, gardens, property, lawns, golf courses and sports grounds, parks and public areas, and for treating and handling plants*), 8 and 12.
- EUTM 003151008 by ARAG SE for the mark:  in classes 9 (*Data processing programs, data processing devices; optical and magnetic storage media; electrotechnical equipment (included in class 9)*), 16, 35, 36 and 42.
- EUTM 002716843 by THE BLACK & DECKER CORPORATION for the mark:  in classes 7, 9 (*Batteries, battery chargers, battery packs*) and 20.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

There are no additional fees that exist for the registration and renewal of colour trade marks at the EUIPO. The basic fee for an application for an individual EU trade mark is €1000 (€850 if the

application is made electronically). These prices are the same for a renewal of an individual EU trade mark.

The basic fee for filing an international trade mark via WIPO is different depending on whether the representation of the mark is in colour or not. Where no representation of the mark is made in colour, the basic fee for an international application is CHF 653 (Swiss francs). Conversely, the basic fee where the representation of the mark *is* in colour is CHF 903 (Swiss francs).

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

The concept of “colour depletion” has been considered within EU case law. For example, the concept was addressed in the leading case of *Libertel*. In this case, the court acknowledged that in assessing the potential distinctiveness of a given colour as a trade mark, one must consider the general interest in not unduly restricting the availability of colours for those other traders offering for sale the same type of goods or services as those in respect of an applied for mark. Here, the court acknowledged that the number of different colours that are in fact available as potential trade marks to distinguish goods or services must be regarded as limited. Considering this, the court set out as follows:

“...a small number of trade mark registrations for certain services or goods could exhaust the entire range of the colours available. Such an extensive monopoly would be incompatible with a system of undistorted competition, in particular because it could have the effect of creating an unjustified competitive advantage for a single trader. Nor would it be conducive to economic development or the fostering of the spirit of enterprise for established traders to be able to register the entire range of colours that is in fact available for their own benefit, to the detriment of new traders.”

The court went on to recognise that the greater the number of the goods or services for which a trade mark is seeking to be registered, then the more excessive the exclusive right is likely to be. This makes it more likely for that right to come into conflict with a system of undistorted competition, and the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type.

This was recognised again in *Proxxon S.A. v Franz Jost AG* (an analysis of which can be found at Question 6 to this paper) which reiterated the comments from the ECJ in *Libertel*; namely emphasising the public interest in ensuring that colours remain available to others, and that overly generous registration of colour marks could exhaust the range of available colours, which in turn could be contrary to the maintenance of an undistorted system of competition.

FRANCE

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Yes, France recognises colour marks.

According to the guidelines of the French Office (INPI), a colour mark consists of:

- Exclusively a single colour without contours; or
- Exclusively a combination of colours without contours.

However, registering a single colour has become increasingly complex, as it may be difficult for the public to distinguish between similar shades. It is therefore generally easier to obtain registration where the mark consists of a combination of colours rather than a single colour alone.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

The requirement of clear and precise representation entails that the description be accompanied by an internationally recognised colour code identifying the exact shade claimed. In practice, the filing of a colour trademark is conditional upon specifying the reference of the chosen colour within an internationally recognised system, such as the Pantone code.

From the perspective of both European and French courts, it is also essential to define with sufficient precision how, and in what proportions, the colours are used. In the case of a combination of colours, this may require specifying the respective proportion of each colour claimed.

A colour mark is represented by:

- A reproduction of the colour together with an indication of that colour by reference to a generally recognised colour code; or
- A reproduction showing the systematic arrangement of the combination of colours in a uniform and predetermined manner, together with an indication of those colours by reference to a generally recognised colour code.

A description of the sign constituting the mark is mandatory in the case of a colour mark where the mark consists exclusively of a single shade of colour or a combination of colours.

The applicant must also specify precisely the shade claimed by means of an internationally recognised identification code for that colour (Article 4, 3°(f) of Decision No. 2023-51 of the Director General of the INPI). This may include, for example, RAL or Pantone codifications.

Finally, such signs consisting of a shade or a combination of colours must, like all types of trademarks, be distinctive. It should be noted that this requirement is sometimes difficult to satisfy given the non-traditional nature of this type of sign, which is generally less capable of conveying precise information.

c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

Regarding signs consisting solely of a single shade of colour, generally acquired distinctiveness can only be shown in exceptional circumstances, particularly where the number of goods or services for which the mark is applied is very limited and the relevant market is very specific (ECJ, 21 October 2004, KWS Saat/OHMI, C-447/02 P, para. 79).

In practice, the INPI will very often be led to refuse this type of mark consisting of a single colour, unless the applicant can demonstrate that the association of this colour with the claimed goods and services is extremely unusual, or that the sign has acquired distinctiveness through use.

In this regard, the INPI considers that consumers are not in the habit of identifying the origin of goods or services on the basis of a colour *per se*, in the absence of any graphic or textual element.

For the acquisition of distinctiveness through use, proof of use of a mark must relate to the place, duration, extent, and nature of the use that has been made of the mark.

Furthermore, in order to assess whether a mark has acquired distinctiveness through use, the courts consider that it is necessary to take into account all the circumstances in which the relevant public is confronted with the mark (ECJ, 22 June 2006, August Storck, C-25/05 P).

In this regard, certain factors have been recognized in case law, in particular:

- ✓ the market share held by the mark
- ✓ the intensity of use
- ✓ the geographical extent
- ✓ the duration of use of the mark
- ✓ the significance of investments made by the company to promote it
- ✓ the proportion of the relevant public who identify the product as originating from a specific company through the mark
- ✓ statements from chambers of commerce and industry or other professional associations

However, this list is not exhaustive and only constitutes a bundle of evidential elements that may be used to establish the facts of use.

The use of the sign as a mark must be based on objective factual elements demonstrating effective and sufficient use of the mark on the relevant market, and not on probabilities or mere assumptions.

It should be noted that there is a certain interdependence among the factors considered, and “a low volume of products marketed under the said mark may be compensated by a strong intensity or long-term consistency in the use of the mark, and vice versa” (GC, 30 January 2015, *Now Wireless Ltd*, T-278/13, para. 15).

The types of compelling evidence are similar to those that may be provided before the EUIPO for European Union trademarks and include, in particular:

- Catalogues, magazines, and sales brochures
- Invoices
- Annual reports
- Turnover figures
- Advertising expenditure and reports
- Advertisements (press articles, posters, TV spots, etc.)
- Customer surveys or market research studies
- Affidavits

Opinion polls may also, to some extent, help demonstrate acquired distinctiveness through use. In this regard, the sample of respondents must be sufficiently large, and the public surveyed must be relevant with respect to the goods and/or services in question (Paris Court of Appeal, Division 5, Chamber 2, 6 April 2018, RG 2017/01742, M20180144).

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

Some examples of colours or colour combinations protected as trademarks in France:



French trademark No. 11 3869370

in the name of PALOÏSE SAS in class 25;



French trademark No. 15 5163021 in the name of NESTLE WATERS No. in class 32;

French trademark
in class 30;



No. 23 4928819 in the name of ALSA FRANCE

French trademark



No. 25 5169006 in the name of SNCF VOYAGEURS in classes 12 and 39;

French trademark



No. 98759688 in the name of DECATHLON in classes 9, 10, 11, 12, 13, 14, 16, 18, 20, 21, 22, 24, 25, 28, 29, 30, 31, 32, 41.

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Under French domestic law, colour trademarks are governed by Articles L.711-1 and L.711-2 of the French Intellectual Property Code, relating to the definition of trademarks and distinctive character, as well as by Article R.711-1, which imposes the requirement of clear, precise, distinct and objective representation.

Under French law, the registration and protection of colour trademarks are governed by:

1. The Intellectual Property Code

Article L. 711-1

Article L. 711-2

Articles L. 711-3 et seq.

2. Decision No. 2023-51 of the Director General of the INPI concerning filing requirements, which specifies the representation requirements for colour trademarks (mandatory reference to a recognised colour code).

3. Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trade marks.

In terms of case law, the leading principle derives from the CJEC judgment of 6 May 2003, *Libertel*. That decision established that a colour *per se*, without spatial delimitation, can constitute a trademark, provided that it is distinctive (often through acquired distinctiveness) and precisely identified, in particular through a recognised colour code.

In French law, this approach can be found in several decisions, including:

- **CA Paris, 4 February 1988 (“pale blue”)**: the court refused registration of a colour described too imprecisely, holding that a mere verbal description does not enable the exact shade claimed to be determined with certainty.
- **CA Versailles, 15 March 2001 (Lancôme)**: the court denied protection for a colour used for cosmetic products, considering that in a sector where colours play a significant aesthetic role, the shade in question was perceived as decorative rather than as an indication of origin.
- **Cass. com., 10 May 2006 (Décathlon)**: the French Supreme Court upheld the registration of a colour identified by a Pantone code, expressly aligning itself with the *Libertel* judgment. It confirmed that a colour in itself may constitute a trademark, provided it is designated by an internationally recognised colour code and meets the requirements of distinctiveness. The case concerned Décathlon’s blue (Pantone



Process Blue Quadri Cyan 100%):

- **CA Paris, 16 September 2009**: the court invalidated a colour combination mark due to inconsistency between the written description (four colours claimed) and the graphical representation (only two visible), emphasising that the filing must allow the exact subject matter of protection to be determined.
- **CA Paris, 30 October 2013 (Luxury Gold Group)**: this decision reaffirmed more generally that the scope of protection is determined solely by the representation as filed.

Overall, this reveals a demanding French approach, focused on the formal precision of the application and rigorous demonstration of distinctiveness.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

According to INPI practice, a colour mark without outlines must be represented clearly, precisely, and objectively, most often through the designation of an internationally recognised colour code (such as a Pantone reference), in accordance with Article R.711-1 of the French Intellectual Property Code.

In practice, the scope of protection is determined by the sign as filed, namely the specific shade of colour identified in the registration. However, since infringement analysis is based on the overall impression and the likelihood of confusion, a very similar shade may still be caught if it only slightly alters the perception of the relevant public.

The INPI also emphasises that protection granted to a single colour must remain strictly limited

in order to avoid the undue appropriation of an element that should remain available for competition.

In principle, colour marks must be used in the colours that have been registered.

However, insignificant variations in the shade or intensity of the colours will not alter their distinctive character.

Where a combination of colours is registered without specifying the respective proportions of each colour, use in different proportions will not alter its distinctive character, unless specific proportions have been indicated and these are significantly modified in the version used.

The use of a colour mark together with a distinctive or descriptive word generally does not alter the distinctive character of the sign.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

In France, colour trademarks are subject to the same procedures as other types of trademarks. The INPI is responsible for opposition (which must be filed within two months following publication), as well as administrative actions for invalidity and revocation (Articles L.712-4 and L.716-2 et seq. of the French Intellectual Property Code).

In practice, what differs for colour marks is the nature of the challenges raised, which frequently concern lack of distinctiveness (Article L.711-2 IPC) or insufficiently clear and precise representation (Article R.711-1 IPC). Proof of genuine use consistent with the registered shade is also a decisive element and is often required in practice.

5. Use of Color Trademarks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

There is no specific legal regime in France governing colour trademarks in digital or virtual environments.

The French Office (INPI) has not issued any specific guidelines for digital interfaces, mobile applications, or immersive environments. It should therefore be noted that color must always be precisely identified (i.e., by a color code) and perceived as an indicator of origin.

In practice, it will therefore be necessary to demonstrate that, beyond its purely aesthetic function, the relevant public associates the colour trademark with a specific commercial origin.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

The judgment delivered by the French Supreme Court on 10 May 2006 in “Décathlon vs Mov’in” may be cited as one of the rare (if not the only) large-scale cases in France in which a registered colour trademark was relied upon in litigation.

In that case, Décathlon was the proprietor of a trademark consisting of the colour “*Pantone process blue quadri cyan 100%*”, filed at the end of 1998 for services including, *inter alia*, sports clubs (Class 41). Mov’in, which operated fitness centres, used a similar shade of blue, leading to a seizure of evidence followed by infringement and unfair competition proceedings initiated by Décathlon.

Mov’in sought to have Décathlon’s mark declared invalid for lack of distinctiveness, arguing in particular that a primary colour could not, in the absence of a specific arrangement or combination, fulfil the origin-indicating function required under Article L.711-1 of the French Intellectual Property Code.

However, the Supreme Court dismissed this argument and, relying on the CJEC judgment of 6 May 2003, *Libertel*, held that a colour in itself, without spatial delimitation, may be distinctive and registrable provided that its representation is clear, precise, self-contained, intelligible and objective. This requirement is now primarily satisfied through the use of an internationally recognised colour code, such as Pantone.

This decision confirms, first, that a colour may constitute a distinctive sign in its own right if it is sufficiently defined and not merely perceived as a generic or decorative shade, and second, that courts take into account the public interest by applying a strict standard when assessing the distinctiveness of a colour, in order to avoid granting an undue monopoly over a colour.

7. Strategies for Managing Colour Trade Mark Applications

a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

1. Strategies at the filing stage

1.1. Ensuring proper representation of the mark

- Indicate a recognised colour code (such as Pantone, RAL, etc.).
- For a combination of colours without contours, specify the systematic arrangement of the colours (by providing a clear description in the application form).

1.2. Anticipating an objection based on lack of distinctiveness

- Limit the specification to goods/services for which use can be demonstrated.
- From the time of filing, prepare a body of evidence in anticipation of a possible substantive objection, in order to prove the acquisition of distinctiveness through use.

2. Regarding the evidence required to demonstrate acquisition of distinctiveness through use: please refer to question 1.c).

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

There does not appear to be any specific legal regime governing the coexistence of colour trademarks in France. However, in practice, coexistence may be more readily accepted given the inherently limited distinctiveness of single colours.

Like any trademark, a colour mark is protected not only against identical reproduction but also against the use of a closely similar shade capable of constituting an imitation. In *Cass. com.*, 30 January 2001, No. 99-10.399 (*Candia/Besnier*), the Court held that although each party had selected a precise shade, the colours were sufficiently close to be confused by an average consumer who did not have both marks simultaneously before them.

In principle, the choice of a colour or combination of colours is primarily aesthetic rather than origin-indicating. Granting a monopoly over a colour may therefore undermine the public interest by restricting competition. For this reason, colours are generally presumed to lack inherent distinctiveness. Consequently, the registration of a single colour as a trademark remains complex, and multiple non-registered colours may coexist freely. However, once a colour has acquired sufficient distinctiveness through intensive use, it benefits from protection against infringement and imitation.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

In France, there are no specific additional official fees for filing or renewing colour trademarks. They are subject to the same fee structure as any other trademark, with costs depending solely on the number of classes designated. The nature of the sign (including a colour mark) does not affect the applicable filing or renewal fees.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

French law does not formally recognise the theory of colour depletion, according to which the limited number of available colours would prevent a single colour from being monopolised. However, this concern implicitly permeates French case law. In line with the *Libertel* judgment (CJEC, 6 May 2003), French courts take into account the public interest in avoiding undue restrictions on the availability of colours for economic operators. This approach results in a strict

assessment of the distinctiveness of colour trademarks.

Accordingly, the French Supreme Court (Cass. com., 10 May 2006, Décathlon v. Mov'in) acknowledged that a colour may constitute a distinctive sign, without drawing any distinction between a primary colour and a particular shade, but subject to rigorous requirements regarding its representation and distinctiveness.

In practice, although the limited number of colours does not prevent their registration, it leads courts to narrowly circumscribe their protection in order to avoid granting an excessive monopoly. Nevertheless, no legal text or decision strictly adheres to the theory of colour depletion.

GERMANY

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

According to German trademark law, there are two different types of trademarks: 1) Registered trademarks, created by registration in a trademark register, and 2) Trademarks acquired through use (“Benutzungsmarken”), which arise automatically without registration when a supplier uses a sign to identify their products in the course of trade, if and insofar as it has acquired distinctiveness as a trademark among at least a significant portion of consumers in a sufficiently large geographical area within Germany (= a fairly high level of recognition in the market of at least 25% - which may have to be proven by the trademark owner).

A color or color combination may be registered as an abstract color trademark if it is not defined by contours and is detached from concrete representations and figurative boundaries. Color combinations can only be defined in the required abstract form if the combination of colors is specified in a clearly defined appearance. (If a figurative boundary is added, the color(s) are no longer applied for abstractly, but rather a structure is established, including the type of boundary for the color(s) – then a different trademark type may be suitable.)

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

Abstract color or color combination trademarks are subject to the following formal requirements:

- A two-dimensional graphic representation on paper or as a JPEG file on a data carrier readable by the GPTO. A single-color mark requires a color sample with the color named according to an internationally recognized color classification system¹⁷ such as RAL, Pantone, HKS, or CIELAB¹⁸. For mixed colors beyond these, the GPTO’s practice¹⁹ allows a color sample and the indication of the closest number in a classification system to suffice.
- In the case of combinations of two or more colors, the systematic arrangement in which the colors are combined in a fixed and permanent manner must also be specified²⁰ in

¹⁷ § 8 I MarkenG

¹⁸ BGH GRUR 2016, 1167 - Sparkassen-Rot

¹⁹ No established case law.

²⁰ § 10 II MarkenV

order to anticipate the later actual appearance of the color combination on the product²¹²². The systematic arrangement can be specified by a graphic representation of the arrangement of the colors relative to each other, which reveals the area ratio and the spatial arrangement of the colors, or by a trademark description²³. A statement in percent or in the manner of 1:1, a verbal description, or a rectangular color sample with two equally wide, directly adjacent color stripes to represent the distribution of a two-color combination in a 1:1 ratio is sufficient²⁴.

c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

In (color) trademark registration proceedings before the GPTO, **inherent distinctiveness** will always be examined. Since an ECJ landmark ruling²⁵, abstract colors and color combinations are generally not considered to be inherently distinctive, especially since they must remain freely available to the general public, but only exceptionally so under extraordinary circumstances in specific markets:

- A very specific, self-contained market segment independent of the labeling practices of other industries, in which a customary use of (house) colors as an indicator of origin exists as a result of established practice.
- Colors must actually be conceivable as an indicator of origin within this market segment. (Not the case for goods where colors merely convey objective information by representing the goods themselves (paints, colored pencils, decorative cosmetics) or their properties (clothing, furniture), nor for colors with symbolic meaning for the products (e.g. red for danger, green for ecological, and gold for valuable).)
- In this market segment, there must be an actual familiarity with colors as an indicator of origin among consumers (mostly only if consumers are accustomed to such a perception through company colors).
- The color must have an origin-indicating effect (the public must not perceive the product/its packaging in a product-related, functional way, whether necessarily, descriptively, symbolically, or merely decoratively).

If all requirements are met, distinctiveness is exceptionally conceivable in special cases involving colorless goods such as electricity and intangible services. The applicant must, in the application procedure, demonstrate and substantiate all the requirements for the inherent distinctiveness of their color as specifically as possible and provide sound justification.

²¹ ECJ GRUR 2004, 858 ff. - Heidelberger Bauchemie GmbH Blue/Yellow

²² Example: Because the pure combination of red/blue for garden tools and machinery would leave open whether it would later be used in the form of large stripes, checks, dots, or with such fine stripes or a grid pattern that both colors appear as a mixed color, the ratio of the colors must be specified.

²³ § 6 b) MarkenV

²⁴ E.g. ECJ GRUR INT. 2012, 333 - Color mark light gray/traffic red: with color sample and corresponding description "The color light gray (RAL 7035) is arranged above the color traffic red (RAL 3020), which in turn is arranged above the color light gray (RAL 7035); the ratio of the colors from top to bottom is light gray; traffic red; light gray = 7:1:2."; BGH GRUR 2007, 55 - Color mark Yellow/green: "The colors green and yellow are to be registered side by side in a lateral arrangement" or BPatG 26 W (pat) 568/12 of April 24, 2013 = BeckRS 2013, 8278 - Blue/silver color mark: "The colors blue and silver have a ratio of 50:50."

²⁵ ECJ GRUR 2003, 814 ff - Libertel and most recently ECJ GRUR 2014, 776 - Sparkassen-ROT; as well as regarding abstract multi-color marks ECJ GRUR 2004, 858 ff - Heidelberger Bauchemie.

Lack of inherent distinctiveness may be overcome if the indication for the contested products has become established in the market as an indication of a supplier (**acquired distinctiveness**). This is only assumed, depending on the degree to which the obstacle to registration is fulfilled, if at least 50% (or more) of the relevant public perceives the indication as an indication of origin for a specific supplier²⁶. The procedure for proving this before the GPTO involves establishing credibility of acquired distinctiveness in a first step before providing proof in a second step. This proof regularly requires a demographic report from a recognized opinion research institute. In practice, the requirement of such report is very rarely waived under special circumstances if the opposing obstacle to protection is weak and the required high level of public awareness is sufficiently demonstrated by a high market share or otherwise by indirectly proven public awareness in light of all the circumstances^{27, 28}. Aspects such as market share, intensity, geographical distribution, and duration of use must be considered here, as well as the company's advertising expenditure for the trademark and statements from chambers of industry and commerce and professional associations²⁹.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

-  for class 30: Chocolate products.
-  for class 36: Financial affairs, namely retail banking (banking services for private customers), in particular account management, processing of payments (current account transactions), issuing of debit and credit cards, handling of financial transactions with debit and credit cards, investment and wealth management advice, advice on and brokerage of investments, securities trading, custody business, general financial advice, brokerage of insurance, advice on and brokerage of building society savings contracts, credit advice, credit business, credit brokerage
-  for class 7: Tattle liners for milking systems
-  for class 16: Writing implements, namely pencils, colored and copying pencils, mechanical pencils, ballpoint pens, felt-tip and fiber-tip pens, fountain pens, mechanical pens, highlighters and markers
-  for class 07: Dishwashers, including dishwashers

²⁶ BGH GRUR 2016, 1167 – Sparkassen-Rot

²⁷ ECJ GRUR 1999, 723 – Chiemsee

²⁸ Example of affirmed acquired distinctiveness in specialist circles without a public opinion report: BPatG 27 W (pat) 47/12 of January 27, 2015 = BeckRS 2015, 2952

²⁹ Note: Acquired distinctiveness cannot be successfully based on the fact that the mark in a particular town or city indicates a specific provider, but (for a national German trademark) only on the fact that it does so throughout the entire Federal Republic of Germany.

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

German Trademark Act ([MarkenG](#))

German Trademark Ordinance ([MarkenV](#))

Most important case law:

- BGH GRUR 2016, 1167 – Sparkassen-Rot: Specific requirements for application; Requirements of inherent and acquired distinctiveness – both for single color marks
- ECJ GRUR 2004, 858 ff - Heidelberger Bauchemie: similarly for color combination trademarks

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

There is no concrete guidance by the GPTO or courts. However, some corresponding case law cases are discussed under question 6.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

Note: There are no specifics for color trademarks. Please check the respective sections of the law for more details. All §-references refer to the MarkenG.

Opposition to a newly registered trademark:

After the publication of a newly registered trademark, owners of earlier trademarks (including EU or IR trademarks) can file an opposition against the registration if the trademarks are too similar. An opposition can also be based on other earlier rights such as unregistered trademarks, trade names, protected geographical indications or protected designations of origin. The opposition is to be filed in writing within 3M of the publication of the registration together with fee of €250 per opponent. Extra fee per additional earlier mark if opposition is based on several marks.

Cancellation and invalidity proceedings before the German Patent and Trademark Office (§ 53)

An application for a declaration of revocation (§ 49) and invalidity due to absolute grounds for refusal (§ 50) and prior rights (§ 51) can be filed in writing with the GPTO. The facts and evidence supporting the application must be stated. A fee of €400 is payable within 3M of filing the application. The GPTO informs the trademark owner of the invalidity application. If the owner does not object within 2M, the trademark is cancelled. If an objection is filed, invalidity

proceedings are conducted before the GPTO. If the application is successful, the trademark registration is removed from the register.

The application is inadmissible if the same subject matter has already been decided between the parties by a final and unappealable decision or a legally binding judgment. This also applies if an action under § 55 (court proceedings) is pending between the parties concerning the same subject matter.

1. Revocation (§ 49)

The registration shall be declared invalid and cancelled upon application if, after the date on which opposition against it ceases to be possible, the trademark has not been used in accordance with § 26 for a continuous period of five years. However, the invalidity of a trademark may not be claimed if, after the end of this period and before the application for a declaration of invalidity is filed, use of the trademark in accordance with § 26 has commenced or resumed.

The registration shall also be declared revoked and cancelled upon application, if, as a result of the conduct or inaction of its proprietor, the trademark has become the common designation in the course of trade for the goods or services for which it is registered; if, as a result of its use by the proprietor or with the proprietor's consent, the trademark is capable of deceiving the public, in particular as to the nature, quality, or geographical origin of the goods or services for which it is registered; or if the proprietor of the trademark is no longer the rightful owner acc. to § 7.

2. Absolute grounds for refusal (§ 50)

The registration of a trademark will be declared invalid and cancelled upon application due to absolute grounds for refusal (§ 50 I) if it was registered contrary to §§ 3, 7, or 8, that is, if it lacks the capacity to be a trademark (§ 3), the applicant could not be the owner of a trademark (§ 7), or absolute grounds for refusal existed (§ 8).

3. Prior rights (§ 51)

The registration of a trademark can also be declared invalid and cancelled upon application to the GPTO based on existing prior rights (§ 51 I). Entitled are holders of the rights specified in §§ 9 – 13, as well as persons entitled to assert rights arising from a protected geographical indication or protected designation of origin (§ 53 III). Excluded are cases of acquiescence to the later trademark or non-use of the earlier trademark.

If the application for a declaration of invalidity on the grounds of prior rights has been filed by the proprietor of a registered trademark with an earlier priority date, the proprietor must, upon objection by the respondent, prove that the trademark has been used within the last five years before the application was filed pursuant to § 26, provided that no opposition against it had been possible for at least five years at that time. If an opposition has been filed, the five years are calculated from the date on which the decision terminating the opposition proceedings became final or the opposition was withdrawn. If the five-year period of non-use ends after the application was filed, the applicant must, upon objection by the respondent, prove that the trademark has been used within the last five years before the decision pursuant to § 26. If the earlier mark had been registered for at least five years on the filing or priority date of the later mark, the applicant must, upon objection by the respondent, further prove that the registration of the earlier mark could not have been declared invalid on that date pursuant to § 49 I. Only those goods or services for which use has been demonstrated will be considered in the decision. Such

demonstration may also be provided by a sworn affidavit.

Cancellation and invalidity proceedings before the ordinary courts (§ 55 MarkenG)

An action for a declaration of invalidity (§ 49) or for invalidity due to the existence of prior rights (§ 51) can be brought against the person registered as the proprietor of the trademark or their successor in title. The action is inadmissible if the same subject matter has already been decided between the parties before proceedings before the GPTO have started/been decided. The court notifies the GPTO which shall enter record the date of filing the action and the outcomes in the register.

Further requirements for § 49 and § 51 as stated above.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

The GPTO treats color trademarks in the above-mentioned context largely in the same way as traditional trademarks. The key requirement is that the trademark, including color marks, must be graphically represented clearly and have distinctiveness. This applies regardless of whether the color is used in physical goods or digital services.

(Also, note the recent “Glashütte original” ECJ decision stating that virtual goods and services are legally treated the same as their physical counterparts when it comes to trademark distinctiveness and likelihood of confusion.)

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

1. Deutsche Telekom Magenta vs Lemonade

Deutsche Telekom’s abstract magenta mark has been enforced broadly, including against the insurance start up Lemonade after its 2019 launch in Germany, leading to a preliminary injunction forcing Lemonade to remove pink/magenta from its German assets. Courts accepted that magenta had strong acquired distinctiveness for Telekom beyond telecoms, supported by long term, intensive use and survey evidence; the use of a similar shade as a dominant corporate colour in the same country was seen as trade mark use capable of causing confusion or association. (note that e.g. in France, Lemonade succeeded)

Key factors: Very high recognition of Telekom’s magenta as a sign of origin, evidenced by market surveys and long-standing, consistent use. Use by the defendant as a key corporate/brand colour, not merely decorative, and in overlapping or adjacent service fields, supporting confusion/association. No credible functionality argument (the colour

does not make telecom or insurance services technically better), so the dispute centred on distinctiveness and confusion.

2. **Lindt-Sprüngli vs Heilemann**

Lindt claimed unregistered trademark rights (Benutzungsmarke) in the specific golden shade of the “Lindt Goldhase” foil for chocolate bunnies, based on many decades of intensive use and very high market recognition in Germany. Heilemann marketed similarly seated chocolate bunnies wrapped in gold-coloured foil, and Lindt sued for injunctive relief, information and damages before the Munich courts. At first instance, Lindt partly succeeded, but on appeal the Higher Regional Court of Munich denied that the gold colour itself functioned as an independent indication of origin and dismissed the action. The Federal Court of Justice (BGH, I ZR 139/20, decision of 29 July 2021) overturned this and held that the golden shade of the Lindt bunny had acquired trade mark recognition as a use mark for chocolate bunnies, relying in particular on a consumer survey showing about 70% recognition and on sales of hundreds of millions of gold bunnies over decades.

Key factors: Very strong evidence of acquired distinctiveness of the gold tone for chocolate bunnies, methodological survey evidence clearly above the usual 50% threshold, and long, consistent use; the open question on remand is how similar Heilemann’s overall presentation is and whether consumers would confuse or associate the origin despite other design differences.

7. **Strategies for Managing Colour Trade Mark Applications**

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

The critical point with respect to color trademarks is definitely distinctiveness. Arguments for proving inherent/acquired distinctiveness are described under question 1. Evidence for acquired distinctiveness will mostly be in the form of demographic reports.

- b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Generally, co-existence should be possible if color shades and/or market areas differ distinctly (e.g. next to Sparkasse – red (finance sector), there are several other registered trademarks in a more or less similar shade of red, however, for very different products. At the same time, Spanish Santander banks’ red trademark application was rejected due to likelihood of confusion, (Decision I ZB 52/15 – Sparkassen-Rot).

In any case, outcomes of disputes will depend on the individual characteristics of the case...

- c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

Not different for color trademarks than for traditional trademarks.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

No such formal legal doctrine or barrier. Rather individual assessment of each color mark’s graphical representation, distinctiveness (inherent/acquired), and non-functionality rather than a presumption of limited color availability.³⁰

List of sources:

- German Trademark Act ([MarkenG](#))
- German Trademark Ordinance ([MarkenV](#))
- [GPTO web page](#)
- [Guidelines for the examination of trademark applications and for the maintenance of the register](#)
- Bingener, S. (2022). Markenrecht - Strategie, Anmeldung, Schutz und Verteidigung von Marken (4th Edition), C.H. Beck

³⁰ See e.g. ECJ GRUR 2003, 814 ff – *Libertel (orange)*, where registrability hinges on clear definition and public perception as a source identifier, not exhaustion of the palette.

ITALY

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

In Italy, single colours and colour combinations can be protected as trade mark. So, indeed, it is possible to successfully register a colour trade mark under Italian Law, pursuant to Article 7 of the Italian Industrial Property Code (“IPC”), which includes among protectable trade marks also “*combinations or shades of colours*”. This provision therefore includes both the possibility to register as trade marks single colours, as well as their combinations.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

In Italy, the registration of a colour trade mark is subject to the condition that such colour must be precisely identified by an international colour code (such as the Pantone code) and that, in the overall assessment made by the Italian Patent and Trade Mark Office (“IPTO”), consideration is given to the general interest in not restricting the availability of colours for other operators offering goods or services of the same kind. According to consistent case law, other specific requirements for the valid registration of a colour mark include that it must serve to identify the commercial origin of the goods and services, and that it enables consumers to distinguish the products of the proprietor from those of others.

In general, under Italian and EU case law a colour mark must fulfill the same requirements as any other trade mark, with the note that it is subject to a strict examination regarding the existence of distinctive character.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

It is possible to register a colour trade mark provided that the sign fulfils the essential function of a trade mark, namely that it possesses distinctive character so that the chosen colour or the combination of colours can distinguish the goods and services of the applicant from those of others. Acquired distinctiveness through use is of particular importance and relevance for colour marks. According to consistent case law, a colour rarely possesses inherent distinctiveness, as colours are common elements in business and communication sectors, and are often perceived

by the public merely as aesthetic choices rather than as indicators of commercial origin. For this reason, the registration of a colour trade mark is possible only when the applicant can demonstrate that, through long-term use, the colour has acquired distinctiveness in the relevant sectors, thus enabling consumers to recognize the goods or services as originating from the applicant.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

There are various cases of colour trade marks registered in Italy. Below are some examples:

- Italian mark no. 301999900733086 “” filed by United Parcel Service of America Inc. (UPS) on 27 January 1999, granted on 4 July 2002 and claiming the colour brown for services in class 39;
- Italian mark no. 302023000104244 “” filed by Ferrari S.p.A. on 6 July 2023, granted on 11 January 2024, claiming the colour “Rosso Corsa Ferrari” (Pantone 200 C) for products in classes 12 and 28;
- Italian mark no. 302023000153153 “” filed by Davide Campari – Milano N.V. on 20 October 2023, granted on 22 April 2024, claiming the colour Red (Pantone 186 C) for products in class 33;
- Italian mark no. 302023000024639 “” filed by Davide Campari – Milano N.V. on 16 February 2023, granted on 12 September 2023, claiming the colour orange (Pantone 021 C) for products in class 33;
- Italian mark no. 302022000172614 “” filed by Gradi Gualtiero S.r.l. on 7 December 2022, granted on 22 May 2023, claiming a combination of colours such as dusty blue (Pantone 645), orange (Pantone 165) and black (Pantone 9011, gloss 25), for services in class 37;
- Italian mark no. 302022000161640 “” filed by Bper Banca S.p.A. on 17 November 2022, granted on 16 June 2023, claiming a combination of colours such as Dark Green (Pantone 7476) and Light Green (Pantone 7480) for products and services in classes 9, 35, 36 and 38.

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The colour trade mark falls within the general provision set out in Article 7 of the IPC, which, in outlining what may be validly registered as a trade mark, includes “*combinations or shades of colour*”. The practice of the IPTO also states that a colour mark must be clearly identified by an international colour code (e.g. Pantone code) and is subject to a stringent assessment of

distinctiveness.

In Italy, EU trade mark law and the case law of the Court of Justice of the European Union, the European General Court and the EUIPO play a pivotal role in guiding both administrative and judicial practice. In fact, Italian Courts and the IPTO constantly align themselves with the European principles, so that national decisions remain coherent with the broader EU framework.

Some of the cases that have most contributed to defining the limits and requirements of colour marks in Italy are:

- UPS brown colour mark: one of the first “pure” colour to be registered in Italy was the brown colour of UPS (*United Parcel Service*) “” (application no. 301999900733086) filed in 1999 and granted in 2002, for services in class 39. UPS submitted evidence of the extensive use of the colour brown and successfully demonstrated that the colour had acquired secondary meaning. This case shows that a pure colour can be granted protection under Italian law, if distinctiveness is proven;
- the provision above is further reaffirmed in the CJEU *Libertel* case (C-104/01, judgment of 6 May 2003) which established the principle that even a single colour may be registered as a trade mark, provided it is represented with sufficient precision;
- to prevent monopolies, the Italian Supreme Court (in judgements no. 7254 of 18 March 2008 and no. 3478 of 12 February 2009) has limited the registrability of monochromatic colour marks to only those featuring very particular or unusual shades in relation to the product to which they are applied, to avoid unduly restricting the general interest in keeping colours available for other operators offering similar products or services. In doing so, for example, the colour orange applied to orange-based soft drinks could not be registered because it is a standard and descriptive colour for that type of product, and would excessively restrict competitors marketing similar products;
- following the Supreme Court decision, the Milan Court (with judgement no. 3005 of 6 March 2015) stated that it is possible to successfully register a colour trade mark provided that the public interest not to unduly restrict the availability of colours for other operators is taken into consideration. The Court also stated that it is necessary, for registrability purposes, to verify whether the colour was distinctive at the time of the registration or had acquired it over time for the average consumer;
- In addition, the Bologna Court (with judgement no. 733 of 24 April 2017) confirmed that a pure colour cannot be protected as a trade mark without reference to the shade of that colour specified through an international colour coding.

b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

In Italy the scope of protection of a Colour Trade Mark extends primarily to the exact colour shade claimed by the applicant, this in line with the IPTO requirement to detail the colour code. That said, if the colour is part of a broader distinctive sign and the overall impression is imitated, imitation of a similar shade may contribute to a finding of infringement of that trade mark, as well

as of unfair competition.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

The procedures for opposing, invalidating, or cancelling a Registered Colour Trade Mark in Italy are aligned with those applicable to all types of trade marks.

Administrative Opposition Procedure: Following the filing and publication of the trade mark application in the Official Bulletin, a three-month opposition period is available. During this time, interested parties may submit a formal opposition before the IPTO. Once an opposition is filed, a two-month cooling-off period begins, during which the parties may attempt an amicable settlement. Failing settlement, each side must submit its respective statement of grounds. The IPTO then evaluates the case and issues a decision.

Administrative Invalidation Procedure: Beyond the opposition phase, a registered trade mark may also be challenged ex post before the IPTO through an administrative invalidity action. This includes grounds such as absolute impediments (e.g., lack of distinctive character, descriptiveness, genericness) or relative grounds (e.g., conflict with prior rights). In the case of colour marks, challenges for lack of inherent distinctiveness or insufficient proof of acquired distinctiveness are particularly common.

Appeal Process: Decisions of the IPTO may be appealed to its Board of Appeal. The Board can issue various types of rulings, including orders, decrees, and judgments. Judgments are final and may be challenged only before the Italian Supreme Court (Corte di Cassazione).

Judicial Invalidation ("Invalidazione Diretta"): In addition to administrative proceedings, a trade mark may be invalidated through direct judicial action before the competent courts. This route is particularly relevant in cases involving colour marks. Courts in such cases typically assess whether the mark lacks inherent distinctiveness or whether the evidence of acquired distinctiveness is insufficient. The judiciary also considers the public interest in preserving the availability of colours for all market players, applying a stricter threshold in assessing the validity of such marks.

Unique Considerations for Colour Trade Marks: Although the procedural framework is the same, colour marks face heightened scrutiny during both examination and litigation. Due to their typically non-distinctive nature and the need to avoid monopolisation of fundamental visual elements, colour marks must satisfy a more demanding standard of proof. Applicants are expected to provide substantial evidence of either inherent distinctiveness or a strong secondary meaning acquired through extensive use in the marketplace.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting

colors in these emerging spaces or are they treated in the same way as other Trade Marks?

IPTO currently does not have an established practice or guideline expressly addressing the registration of colour trade mark in the digital or virtual environment. Colour applied to virtual spaces can be successfully registered if they meet the requirements applicable to any other type of trade mark, together with the specific requirements for the colour trade marks mentioned above (see question no. 1, b).

Virtual use can contribute to acquired distinctiveness, provided it is targeted at the Italian/EU public.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

Here some examples of relevant case law:

- **Hop On Hop Off case** (Court of Milan, order of 9 March 2021): Hop on Hop Off is a well-known bus service within the tourist sector, particularly recognized for its red-yellow colour scheme (registered as both an EU trade mark and an Italian trade mark). While the Milan Court denied trade mark infringement as the defendant, a competing bus service, used the same name along with a differently structured red-yellow colour scheme, it was found that the competitor's conduct anyhow fell under unfair competition law, due to the close overall similarity between the competitors' bus appearance;
- **K-Way case** (Supreme Court, judgement no. 5491 of 18 February 2022): Basic Net S.p.A. is the owner of K-Way, a well-known brand for windbreakers and raincoats. It holds an EU trade mark consisting of five coloured stripes (navy blue / orange / yellow / orange / navy blue). The Italian Supreme Court ruled in favour of K-Way against a competitor that used three vertical bands (yellow / orange / navy blue) on its products. The Court, by confirming lower courts' decisions, found that there was a risk of confusion and association for the consumers as the colour combination was very similar and appeared on similar products. Moreover, the Court highlighted the consistent use over time by K-Way, which made the stripes recognizable by the public as an indication of the brand's origin.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

A coherent filing and protection strategy for a colour trade mark depends above all on demonstrating that the chosen colour has acquired distinctive character within the relevant market sector. This requires selecting a colour that is not standard, generic or commonly used in

the industry, to avoid objections based on lack of distinctiveness.

Once the colour has been adopted, the proprietor should systematically collect all relevant evidence over a sufficiently long period to show that consumers have come to recognise that colour as identifying the commercial origin of the goods or services. This may include advertising materials, sales data, market presence, press coverage and – ideally – an independent consumer survey demonstrating brand recognition and awareness of the colour. Where possible, this preparatory phase should begin before filing, so the application is supported by solid proof of acquired distinctiveness.

After gathering the necessary evidence, the mark should be filed with a precise indication of the colour using an international coding system (e.g., Pantone or RAL), ensuring a clear and unambiguous definition of the colour claimed.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

In Italy, the coexistence of colour trade marks follows the same principles that apply to any other trade mark. Identical or similar colour marks create the same risks: when several identical or highly similar colours coexist in the same market sector, this typically indicates that the colour has low / no distinctive character, which may adversely affect both its registrability and its enforceability. The weaker the distinctiveness, the narrower the scope of protection the mark will enjoy.

By contrast, coexistence issues are less problematic when colour marks are used for unrelated goods or services, or when the colour is applied in clearly different ways (e.g., different positions, shapes or trade dress).

A separate scenario arises where two proprietors of similar or identical colour marks enter into a coexistence agreement. In such cases, the agreement must follow the standard contractual principles applicable to trade mark coexistence: it should prevent mutual conflict, clearly regulate each party's use of the colour, and ensure that the respective products remain distinguishable on the market, thereby avoiding consumer confusion and preserving consistent quality standards.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No, there are no additional fees for the Registration and Renewal of Colour Trade Marks before the IPTO.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of "colour depletion"? If so, how.

In Italy there is no explicit recognition of the colour depletion theory. However, the concern about the exhaustion of available colours is implicitly reflected in the strict requirement of distinctiveness and in the obligation to indicate an international colour code, which serves to clearly define the specific colour claimed for protection.

JAPAN

Contributor: **Ms. Takako Okada of Abe, Ikubo & Katayama**

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction?

In principle, it is possible to register colour marks under the category of “marks consisting solely of colour,” which includes three types: Single Colour Marks, Combination of Colours, and Colour Marks with a Specified Position. However, colours are not considered inherently distinctive on their own. The Japan Patent Office (JPO) generally regards colours as incapable of inherently distinguishing one’s goods or services from those of others, unless distinctiveness has been acquired through use.

Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

While colour combinations have been successfully registered as trademarks in Japan, there have been no cases to date where a single colour alone has obtained trademark registration. Under the JPO’s examination practice, it is essentially required that a single colour must have acquired a high degree of distinctiveness through long-term, extensive, and exclusive use in the marketplace, to the extent that consumers directly associate the colour with a specific source. Moreover, both the JPO and the Courts take into account whether or not granting a monopoly over a particular colour would be appropriate in view of avoiding the risk of unduly restricting competitors from selecting colours for their products. In practice, these requirements have made it extremely difficult to register single-colour marks. Although single-colour marks are theoretically registrable, the current administrative and judicial stance makes the registration of such marks very unlikely.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

- **Single Colour Marks**

Representation: The colour should ideally be displayed across the entire trademark representation field in the form of a solid colour drawing or photo. Partial display within the representation field is accepted but not preferred.

Description: The application must include a detailed explanation in the Description of the Trade Mark specifying the colour name, RGB breakdown, colour chart code (e.g., Pantone).

- **Combination of Colours**

Representation: Similar to single colour marks, the application should depict multiple colours across the entire mark representation area. The colours should be clearly distinguishable (though color gradient is permitted as an exception) to demonstrate how they are combined.

Description: The applicant must explain how the colours are arranged, their proportions, and the spatial relationship (e.g., side-by-side, gradient). The application must include a detailed explanation in the Description of the Trade Mark specifying the colour name, RGB breakdown, colour chart code (e.g., Pantone) on each color.

- **Colour Marks with Specified Position**

Representation: The colour must be shown as applied to a specific location on a product. This is typically done by using a solid colour on the relevant portion of the product, while the rest of the product is usually outlined by dotted lines to indicate that it is not part of the mark. The coloured area must not depict a specific shape (e.g., hearts, flowers, letters, or numerals), with the exception of a square, rectangle or circle if necessary to indicate a portion that is not delineated by lines showing the shape of the product.

Description: The position of the product where the colour is applied must be described clearly in the “Description of the Trade Mark” section. Even if the rest of the product is not shown in dotted lines, the explanation must make the claimed position unambiguously clear. The application must include a detailed explanation in the Description of the Trade Mark specifying the colour name, RGB breakdown, colour chart code (e.g., Pantone) on each color.

In all cases, it is necessary to indicate in the application that the applied-for trademark is a “mark consisting solely of color”.

c) *Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?*

Evidence of acquired distinctiveness is almost always required during prosecution of colour marks. Under Article 3(1) of the Trademark Act, marks consisting solely of colour are viewed as lacking inherent distinctiveness. Thus, the JPO will refuse a colour mark application unless the applicant can prove that the colour has acquired distinctiveness through use. In practice, applicants should submit substantial evidence that the relevant consumers have come to recognize the colour(s) in question as a badge of origin for the applicant’s goods or services. The type of evidence typically accepted includes:

- Long-term, extensive and exclusive use of the colour on the product or its packaging, or in connection with the services. It may also be useful to provide explanatory materials showing how the product’s variations have evolved since its initial launch, and whether a consistent colour tone identifiable as the same colour has been used throughout those changes.
- Advertising and promotional materials highlighting the colour, along with advertising expenditure figures to show extensive promotion.
- Consumer surveys and market research demonstrating that a significant percentage of target consumers associate the colour with the applicant’s brand. Survey results should indicate the level of awareness in the form of percentage, preferably exceeding 60%, that the colour is perceived as originating from the applicant, particularly when the goods are directed to the general public.

- Any awards, media coverage, or publications referring to the colour as associated with the brand can further support distinctiveness.

The JPO Examination Guidelines emphasize that colours are fundamental design elements of goods and services, and it is generally difficult for consumers (including traders) to perceive a colour alone as an indication of source. Registration may be granted only when the colour has become recognizable as an indication of source of the goods or services of a particular business through use. In a notable case discussed later, Christian Louboutin's application for the red shoe sole was rejected by the JPO, and the IP High Court upheld the refusal despite evidence of consumer recognition. The court found that the level of recognition (around 50% in a certain survey) was insufficient, and that red soles had been used by many other producers.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

Trademark owner: Tombow Pencil Co., Ltd.

A combination of **blue, white, and black** horizontal stripes as used on the MONO eraser wrapper. Registered for "erasers" in Class 16 with a recognition of Article 3(2) of the Trademark Act, i.e., acquired distinctiveness through use.

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015-029914/40/en>



Trademark owner: SEVEN-ELEVEN JAPAN CO., LTD.

A pattern of orange, green and red horizontal stripes on white background as used on convenience store signage.

Registered for various retail services in Class 35

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015-030037/40/en>



Trademark owner: Sumitomo Mitsui Financial Group, Inc.

Two combinations of dark green and light green as used in banking and financial service branding. Registered for various services in Classes 35, 36, 41 and 45

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015-030413/40/en>



And

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015030414/40/ja>



Trademark owner: MITSUBISHI PENCIL COMPANY, LIMITED

Two color combinations primarily consisting of black and dark red colour as used on the bodies of high-end pencils

Registered for “pencils” in Class 16 with a recognition of Article 3(2) of the Trademark Act, i.e., acquired distinctiveness through use.

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015-029865/40/en>



and

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015-029867/40/en>



Trademark owner: FamilyMart Co.,Ltd.

A combination of green and light blue horizontal stripes on white background, as used on convenience store signage.

Registered for various retail services in Classes 35, 36, 39 and 43

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015054537/40/en>



Trademark owner: Ueshima Coffee Co.,Ltd

A combination of brown, white and red as used on canned milk drinks containing coffee.

Registered for “canned milk drinks containing coffee” in Class 29 and “canned milk coffee drinks” in Class 30.

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2015047686/40/ja>



Trademark owner: NISSIN FOOD PRODUCTS CO., LTD .

A combination of sepia, white, and orange as used on the packaging of instant noodles.

Registered for “instant noodle” in Class 30 with a recognition of Article 3(2) of the Trademark Act,

i.e., acquired distinctiveness through use.

<https://www.j-platpat.inpit.go.jp/c1801/TR/JP-2018090378/40/en>



3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The primary legal basis for colour trade marks in Japan is the Trademark Act. Key provisions include:

Definition of Trademark: Article 2(1) of the Trademark Act states that a “trademark” may consist of “characters, figures, symbols or three-dimensional shapes or colors, or any combination thereof; sounds, or anything else specified by Cabinet Order” used in connection with goods or services. This is the legal basis that states that colours (by themselves or in combination) are eligible subject matter for trademarks.

Registrability and Distinctiveness: Under the Japanese Trademark Act, colour marks may encounter three principal absolute grounds for refusal: Article 3(1)(ii), Article 3(1)(iii), and Article 3(1)(vi).

(1) Article 3(1)(ii): Commonly Used Marks.

A mark consisting solely of a colour (or combination of colours) that is customarily used in connection with particular goods or services falls under Article 3(1)(ii) as a mark “customarily used in connection with the relevant goods or services.” For example, in Japan, the combination of red and white is traditionally regarded as auspicious, while black and white is associated with mourning. Accordingly, using red and white for bridal services or black and white for funeral services will likely be deemed customary and therefore unregistrable under this provision.

(2) Article 3(1)(iii): Marks Merely Indicating Quality or Function

Marks consisting solely of colours ordinarily used for goods or services are generally considered to fall under Article 3(1)(iii) as marks that merely indicate a feature of the goods or services and therefore lack inherent distinctiveness. The JPO Examination Guidelines provide illustrative examples:

- Colours naturally resulting from the product's nature, such as black for charcoal;
- Colours functionally required or commonly used to ensure product performance, such as black for automobile tyres;
- Colours customarily used in the relevant market to enhance product appeal, such as silver for mobile phones;
- Colours not commonly used for the product in the market but possible to be used, such as yellow for refrigerators; and
- Colours that may appear as patterns or background designs, such as vertical stripes in yellow, green, and red on cups.

For trademarks refused under Article 3(1)(ii) or (iii), registration may still be granted if the applicant can demonstrate that the colour has become recognizable as identifying the goods or services of a particular business through use, pursuant to Article 3(2) (acquired distinctiveness).

(3) Article 3(1)(vi): Other Non-distinctive Marks

Even where a colour mark does not fall under Article 3(1)(ii) or (iii), a mark consisting solely of colour is, in principle, regarded as lacking distinctiveness under Article 3(1)(vi) ("other marks devoid of distinctiveness"). To overcome refusal on this ground, the applicant may argue that, as a result of use, relevant consumers have come to recognize the colour as indicating the applicant's goods or services. Although the legal basis differs from Article 3(2), the practical argument to demonstrate the acquired distinctiveness through use is essentially the same.

Hitachi Construction Machinery's single colour mark case (2020):

https://www.courts.go.jp/ip/eng/assets/ip/eng/chizai_en/chizai_en-pdf-2765.pdf

Hitachi Construction Machinery Co., Ltd. sought to register a single colour mark (orange) for construction machinery, eventually limited to "Hydraulic excavators", but was unsuccessful as they lost in an IP High Court appeal case in June 2020 (Case No. 2019 (Gyo-Ke) 10147, Decision date June 23, 2020).

The IP High Court upheld the JPO's refusal decision and specifically referred to color trademarks as follows: When determining whether a single color without an outline has acquired distinctiveness through use, it is also necessary to consider the public interest in avoiding a situation where business operators, providing the designated goods, are unduly restricted from freely using colors.

Christian Louboutin "Red Sole" Case (2023):

https://www.courts.go.jp/ip/eng/assets/ip/eng/chizai_en/chizai_en-pdf-3275.pdf

Christian Louboutin, the French luxury shoe brand known for its shoes with red-colored soles, had been trying to seek trademark registration for its red sole in Japan, but was unsuccessful as they lost in an IP High Court appeal case in January 2023 (Case No. 2022 (Gyo-ke) 10089, Decision date 2023.1.31).

The IP High Court ruled that, in principle, color lacks distinctiveness and granting exclusive use thereof to a specific person would limit people's freedom of selecting the color and be against public interests. An exception would be where the color has acquired distinctiveness through actual use, but the IP High Court held that especially when it comes to a trademark consisting of a "single color," a high level of acquired distinctiveness, enough to be acknowledgeable as an exception against public interests, would be necessary. The IP High Court referred to the survey results, noting that the level of recognition of the Applied Trademark among consumers was

limited, as only around 51.6% of all respondents recognized it.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

In principle, the scope of protection is determined by the representation and description of the mark as registered. A trademark owner has the exclusive right to use the registered mark as-is in connection with the designated goods or services, and to prevent third parties from using, without authorization, identical or similar marks in connection with identical or similar goods or services. In this respect, colour marks are treated in the same manner as other types of trademarks.

According to the JPO Examination Guidelines, basic rules of similarity assessment that are conducted by the JPO Examiners for colour marks are prescribed as follows:

(1) Single-colour marks

When determining similarity between marks consisting solely of colour, the assessment must be made based on the overall impression created by the mark as a whole, taking into account the combination of the hue (tone), saturation (vividness), and brightness (lightness) of the colour.

(2) Marks consisting of combinations of colours

For marks composed of multiple colours, the determination must consider not only the individual characteristics of each colour (as in (1)) but also the overall appearance created by the combination, including the colour arrangement and balance.

(3) Combination of colours vs. single-colour marks

As a general rule, a mark consisting of a combination of colours is not considered similar to a single-colour mark, even if one of the colours in the combination is identical to the single colour.

(4) Single-colour marks vs. marks combining colour and letters

A single-colour mark and a mark consisting of letters combined with colour are generally not considered similar.

(5) Single-colour marks vs. word marks

Even if a word mark (for example, the word “red”) and a colour mark (for example, the colour red itself) share identical or similar pronunciation or concept, they are generally not considered similar. For colour marks, the visual impression plays a decisive role in the similarity assessment.

(6) Marks combining figures and colours vs. registered colour combinations

When comparing a mark that combines figures and colours with a registered mark consisting of a combination of colours, if the arrangement, proportion, or balance of the colours is identical or similar, the marks are generally considered similar.

To date, there has been no court case in Japan in which infringement of a colour mark has been at issue. Therefore, how courts will assess the similarity of colour marks in future cases remains to be seen.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

Opposition and Invalidation Procedures

The procedures for opposing or invalidating a registered colour trademark in Japan are essentially the same as those for any other trademark, as governed by the Trademark Act.

Opposition:

Once a trademark is registered and published, any third party may file an opposition within two months from the date of publication of the registration before the JPO Trial Board. To date, there have been no opposition cases involving colour marks; however, if such an opposition were to be filed, the likely grounds of challenge would include lack of distinctiveness under Article 3(1)(ii), Article 3(1)(iii), or Article 3(1)(vi), or alleged misapplication of Article 3(2) of the Trademark Act.

After a Notice of Opposition with detailed arguments is filed, the JPO Trial Board (“the Board”) examines the case and will either (i) render a decision upholding the registration or (ii) issue a Notice of Reason for Revocation to the trademark owner, indicating the Board’s preliminary view that the registration may be revoked. When such a Notice is issued, the trademark owner is given an opportunity to submit arguments or evidence within a prescribed period (basically 40 days for Japanese residents and three months for foreign residents).

The opposition procedure generally takes about six months to over one year from the filing of the opposition until a final decision is issued. If the Board decides to revoke the registration, the trademark owner may file an appeal. Conversely, if the registration is upheld, the opponent cannot appeal that decision but may instead file an invalidation action before the Board within five years from the registration date of the challenged mark.

Invalidation:

An invalidation trial may be filed against a registered trademark, including a registered colour mark, before the Board. To date, there have been no invalidation cases involving colour marks; however, if such a case were to arise, the likely grounds of challenge would include lack of distinctiveness under Article 3(1)(ii), Article 3(1)(iii), or Article 3(1)(vi), or alleged misapplication of Article 3(2) of the Trademark Act. An invalidation trial based on these provisions must be filed within five years from the date of registration of the challenged mark. If the Board renders a decision invalidating the registration, the trademark owner may appeal to the IP High Court.

Summary:

In summary, oppositions and invalidations concerning colour marks are conducted under the same procedural framework as for other trademarks. However, in practice, disputes involving colour marks are expected to focus primarily on issues of distinctiveness.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or

virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

As of now, Japanese trademark law does not draw a distinction between traditional and non-traditional trademarks with respect to their use and protection in digital or virtual contexts. To ensure proper protection of a mark in digital or virtual environments, the list of goods and services should be carefully and appropriately prepared.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

To date, there have been no court decisions in Japan enforcing a registered colour trademark. In addition to the arguments concerning similarity, important issues in colour trademark disputes would likely include challenges to the validity of the registration on the grounds of lack of distinctiveness.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

Develop Secondary Meaning First: Before filing a colour trade mark application, ensure that the colour (or colour combination) has been used extensively, exclusively and consistently in the marketplace so that consumers have begun to associate it with your product or service. A colour mark should ideally only be filed after significant use.

Evidence Gathering: Ideally, a comprehensive evidence dossier should be prepared before filing a colour trademark application, or at the latest, upon receiving an office action citing lack of distinctiveness. Applicants should collect supporting materials such as sales data, advertising materials and expenditure records, and any industry awards, media coverage, or publications that associate the colour with their brand. Applicants may also consider planning and conducting a consumer survey, well-designed to ensure that the colour is presented and the questions are framed in an objective and non-leading manner.

Combination vs Single Colour: If possible, avoid a single colour application and instead consider a specific combination of colours. The bar for registering a single colour is extraordinarily high (thus far unattainable in Japan).

Narrow Goods/Services Specification: Tailor the list of goods or services to those for which the colour has acquired distinctiveness. For example, if a company uses a colour combination on “erasers”, it is recommendable to limit the list of goods only to “erasers”, rather than “stationery” to increase the likelihood of success.

Precise Definition of the Applied-for Mark: When preparing the application, be precise in the description of the mark. Specify the exact shades by internationally recognized codes (like Pantone, CMYK or RGB) and describe any layout of the colours.

- b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Given the limited number of registered colour marks in Japan, co-existence issues have not been prominent. In principle, colour marks follow the same rules as ordinary trademarks: if two marks are similar and applied for overlapping goods/services, they cannot coexist on the register. One practical insight is that the JPO requires evidence of acquired distinctiveness, and that inherently limits a mark to the field where the distinctiveness was gained, so registrations tend to be scoped narrowly. This naturally prevents overlap because a colour famous in one field may not be famous in another, and an applicant would not even pursue those other fields without evidence.

- c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

JPO does not impose additional fees specifically for registering or renewing colour marks.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

The concept of “colour depletion” is that if companies are allowed to monopolize colours as trademarks, the range of colours available for others to use in branding would gradually diminish, potentially placing competitors at a disadvantage and hindering fair competition. Although the term “colour depletion” itself is not used in Japan, Japanese trademark practice recognizes this concern and takes necessary measures to prevent such a situation. The common understanding shared by the JPO and the Courts is that colours in general should remain free for all to use, absent a truly compelling reason to restrict one for a single source. Likewise, the JPO Examination Guidelines stipulate that colours are fundamental design elements of goods and services, and it is generally difficult to consider that traders or consumers would perceive a colour alone as an indication of source. Only when the colour has become recognizable as an identification of source of the goods or services of a particular business through use, registration may be granted.

KOREA

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FIRSTLAW P.C.

1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Yes. In Korea, single colours and combinations of colours can be protected as trademarks. Since January 3, 2007, marks composed solely of colours—whether a single shade (e.g., Tiffany Blue, Cadbury’s Purple, Louboutin Red) or a combination of colours—have been eligible for registration as a category under non-traditional trademarks.

Under the Korean Trademark Act (“KTA”), a “Colour Trademark” is defined as a mark consisting exclusively of colours, and this category is expressly distinguished from conventional marks in which colour is used merely as a design attribute applied to other elements. In the latter scenario, the mark is examined and protected as a standard (traditional) trademark, not as a Colour Trademark.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

A trademark application for a Colour Trademark must include a mandatory description of the claimed colour(s). Such descriptions typically rely on globally recognized colour specifications, such as Pantone, RGB, Hex, or RAL codes.

In addition to the colour description, the application must provide a graphical representation of the colour(s) as filed. If a combination of colours is claimed, the application typically describes the arrangement and distribution of each colour as part of the representation, so that the claimed colour(s) can be precisely identified by both the examiner and third parties.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

Yes. In Korea, Colour Trademarks are presumed to be inherently non-distinctive, as colours are

ordinarily perceived by consumers as decorative or functional design features rather than indicators of commercial origin. Under the Korean Trademark Examination Guidelines, a Colour Trademark may therefore be registered only upon proof of acquired distinctiveness through use.

To establish acquired distinctiveness, applicants typically submit a comprehensive body of evidence demonstrating that the relevant public recognizes the colour(s) as a source identifier. Common forms of evidence include:

- photographs showing actual use of the colour(s) on goods, packaging, or trade dress;
- sales data, such as revenue, volume, and market share;
- advertising evidence, including duration, frequency, geographic scope, content, and expenditure;
- industry recognition, such as awards or certifications;
- press and media coverage;
- results of consumer surveys demonstrating source-identifying perception; and
- judicial or administrative decisions acknowledging the mark's distinctiveness.

The Guidelines note that at least five years of continuous and substantially exclusive use is generally expected to support a claim of acquired distinctiveness, though the ultimate assessment depends on the totality of the evidence submitted.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

Since the 2007 amendment to the KTA, recognizing trademarks consisting solely of colour(s), only three Colour Trademarks have been successfully registered to date.

No.	Mark	Classes / Goods	Registration No.	Registrant
1	 (Single Colour)	Class 30 Confectionery	40-1183777	RiGO Trading S.A.
2	 (Colour combination)	Class 5 Health functional food made primarily from red ginseng; Health functional beverage in red ginseng drink form	40-1917854	KOREA CORP. GINSENG

3	 (Colour combination)	Class 29 Processed red ginseng products; Red ginseng concentrate; Dietary supplement made primarily from red ginseng	40-1917855	KOREA CORP. GINSENG
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3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The registration and protection of Colour Trademarks in Korea are primarily governed by the KTA. Under the KTA, a trademark consisting solely of a single colour or a combination of colours may be registered and protected if it functions as a source identifier and satisfies the requirement of distinctiveness, typically through proof of acquired distinctiveness.

In addition to the KTA, aspects of colour use may also be regulated under the Unfair Competition Prevention and Trade Secret Protection Act (“UCPA”). If a colour (or colour scheme) used on goods, packaging, or business materials creates a likelihood of confusion, or constitutes an imitation of another’s product configuration or trade dress, such conduct may be actionable under the UCPA—even if the colour itself is not registered as a Colour Trademark.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

If a Colour Trademark is successfully registered in Korea, its scope of protection is assessed in the same manner as for any other trademark—that is, protection extends not only to identical uses of the registered colour(s), but also to uses that are deemed similar from the perspective of the relevant public and likely to cause confusion.

There are no specific statutory provisions, administrative guidelines, or published court precedents in Korea that precisely define the threshold for colour similarity (e.g., whether similarity is assessed strictly by Pantone/RGB code proximity or by broader perceptual criteria). However, based on general trademark principles applied by the MOIP (formerly KIPO), the IPTAB, and the courts, it is reasonable to infer the following:

- The scope of a registered Colour Trademark is not limited solely to the exact numerical colour code (e.g., Pantone).
- Protection likely extends to reasonably similar shades or hues, particularly where the overall commercial impression created by the colour is close enough to generate

consumer confusion as to source.

- The assessment would focus on visual similarity, context of use, degree of distinctiveness acquired, and consumer perception, consistent with standard Korean confusion analysis.

Given the exceptionally small number of registered Colour Trademarks in Korea, judicial interpretation remains limited, and the scope of similarity will likely continue to take shape on a case-by-case basis as more disputes arise.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

In Korea, opposition, invalidation, and cancellation actions involving Colour Trademarks proceed in the same forums and under the same procedures as those applicable to all other trademark types.

1. Opposition

Oppositions to published trademark applications—whether for standard marks or Colour Trademarks—are filed before the MOIP. Oppositions must be filed within the statutory opposition period of thirty days following publication. Decisions in opposition proceedings are not appealable; dissatisfied parties must wait for registration and then pursue an invalidation action.

2. Invalidation/Cancellation

Post-registration challenges to the validity of a Colour Trademark (e.g., on grounds of non-distinctiveness, likelihood of confusion, bad faith) or actions to cancel a registration must be brought before the IPTAB, which operates independently but administratively under the MOIP. IPTAB decisions may be appealed to the IP High Court, and thereafter to the Supreme Court.

There are no separate procedural rules for Colour Trademarks. They are subject to the same statutory framework and evidentiary burdens as other trademarks throughout opposition, invalidation, and cancellation proceedings.

One notable consideration is that, because Colour Trademarks face an exceptionally high threshold for registration—typically requiring substantial proof of acquired distinctiveness—any subsequent dispute (opposition, invalidation, or cancellation) tends to focus heavily on whether the colour (or colour combination) actually possessed distinctiveness at the time of filing or registration.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

Korea currently has no specific statutory provisions, examination guidelines, or case law that address the protection of Colour Trademarks in digital or virtual environments. As such, Colour Trademarks used in these emerging contexts are treated in the same manner as all other trademarks.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

To date, there have been no reported enforcement actions or judicial/administrative disputes in Korea involving registered Colour Trademarks, whether successful or unsuccessful. This is largely attributable to the extremely small number of Colour Trademarks that have been registered since the system was introduced in 2007, and the high evidentiary threshold required for establishing acquired distinctiveness.

7. Strategies for Managing Colour Trade Mark Applications

a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

Given the exceptionally high threshold for registering and enforcing Colour Trademarks in Korea, a long-term and evidence-driven strategy is essential.

As the first step, we recommend building distinctiveness over time by way of obtaining related registrations. Because pure Colour Trademarks are presumed non-distinctive, it is advisable to file and maintain multiple “regular” trademarks (word marks, device marks, composite marks) that prominently incorporate the same colour(s).

Second, it is necessary to ensure that these marks are used consistently across product packaging, advertising, promotional materials, retail environments, and digital assets so that these uses, together with the registrations, establish a history of stable commercial association between the colour(s) and the trademark.

Finally, it should be noted that acquired distinctiveness is the central—and often determinative—issue. Therefore, the body of evidence to support acquired distinctiveness listed above in our answer to question 1(c) needs to be well documented and cataloged for submission to the MOIP and potentially to the IPTAB, IP High Court and Supreme Court.

The MOIP and the courts largely prefer objective records demonstrating extensive and consistent use of the Colour Trademark. That said, consumer recognition surveys are generally regarded as particularly effective because they directly measure consumer perception and provide independent, third-party validation.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your

jurisdiction.

Korea introduced a trademark co-existence system, effective from May 1, 2024. Accordingly, if a Colour Trademark application is refused solely due to a conflict with prior registered marks, it may still proceed to registration by submitting a Letter of Consent (LoC) from the prior rights holder. It should be noted that, if the mark and the goods are completely identical, registration cannot be obtained even with the submission of a LoC. In addition, where a mark is registered on the basis of a LoC, this fact is explicitly recorded in the trademark registry.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No. In Korea, the registration and renewal of Colour Trademarks are treated identically to standard trademarks, and no additional fees are imposed for applications, registrations, or renewals involving Colour Trademarks.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

The concept of “colour depletion” is not yet the subject of active discussion in Korea. As previously noted, the threshold for registering Colour Trademarks is extremely high, and single colours are, in practice, almost never registrable. Moreover, any acquired distinctiveness is recognised only for the specific goods on which the colour has been used, resulting in a very narrow scope of protection. Because Colour Trademark registrations remain rare and limited in effect, the risk of colour depletion is acknowledged largely in theory rather than debated in practice.

MEXICO

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

According to applicable Mexican Law, combination of colours could be protected, being important to determine which kind of protection is sought for. If we only intend to protect a colour combination that will always be used in the way it is presented in the application, then we would be aiming to obtain registration of a design mark.

If on the contrary, what we want to claim is protection of a colour combination as applied to different presentation of goods or location where services are rendered, then you may want to protect it as a trade dress, which according to our Law is also subject of registrations.

As for isolated colours, we must say that initially they may not be registered as a mark in light of article 173 of Mexican Federal Law for the Protection of Industrial Property, which expressly provides:

Article 173.- The following shall not be registrable as a trademark:

...

V. - Letters, digits, or their name, as well as **isolated colours**, unless they are combined or accompanied by other signs that give them a distinctive character;

However, the same article provides that the prohibitions contained in section V may be overcome if proposed mark has acquired a distinctive character deriving from its use in the Mexican territory within the trade in the products or services for which the trademark is being requested.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

In light of the recently enacted Administrative Regulation of the Mexican Law which was published on April 28, 2026 and came into effect on July 23, 2026, the following circumstances must be demonstrated to argue that a colour shade has acquired distinctiveness based upon the aforementioned exception:

- the prolonged and exclusive use of the distinctive sign in question, in accordance with the commercial practices of the sector to which the products or services belong; and
- the identification of the product or service with the distinctive sign and its association

with the person manufacturing or providing the product or service.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

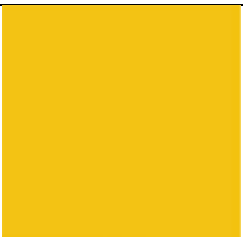
According to the applicable provision of said Regulation, an applicant must submit the following pieces of evidence:

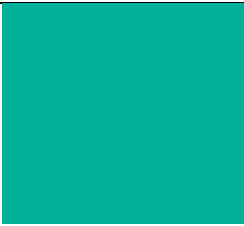
- Advertising of the products or services within the national territory during the last three years;
- Evidence of surveys, market research, or consumer reaction studies;
- Means of dissemination of the mark in Mexico, including positioning on electronic platforms of indexed results, as applicable; and
- Any other evidence deemed pertinent in order to demonstrate the alleged acquired distinctiveness.

If the examiner considers that additional evidence is required, the applicant may be required to provide additional information or evidence.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

Registration	Registered Colour	Products	Owner
2741515		Class 09. Butter	CREMERIA AMERICANA, S.A.P.I DE C.V.
2412700		Class 05. Bandages	LABORATORIOS LE ROY, S.A. DE C.V.
2706601		Class 03. Bleaches and bleaching preparations	INDUSTRIAS ALEN, S.A. DE C.V.

2706602		Class 5. Disinfectants	INDUSTRIAS ALEN, S.A. DE C.V.
2586465		Class 3. Bleaching preparations, bleaching preparations for laundry use;	INDUSTRIAS ALEN, S.A. DE C.V.

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Mexico's trademark regime is governed by the Federal Law for the Protection of Industrial Property, which recognizes trademarks as any sign perceptible by the senses capable of distinguishing goods or services, expressly including some non-traditional marks such as smell and sound marks. Within this context, colour marks, which are perceivable through the sight are registrable provided they have a distinctive character and not otherwise prohibited.

These prohibitions, taken together with the public-interest need to keep basic design features and colour palettes available, operate as practical constraints on colour marks. Relative grounds of refusal protect earlier rights, including earlier trademarks, well-known marks, trade dress, and other priority claims.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

Nowadays we do not have guidelines specifically applicable to colour marks. Still, the prohibition provided in our law, which has been addressed, taken together with the public-interest need to keep basic design features and colour palettes available, operate as practical constraints on colour marks.

Now, given that our current Law forbids registration of marks that are confusingly similar to priority registered or applied for marks, and sanction unauthorized use of confusingly similar marks it may be concluded that the protection of a colour mark could extend to similar shades.

Thus, the importance of having a rigorous analysis from IMPI to make sure they do not register colours that are being used by different entities within the industry as such a registration could

result in an apparent right by which its owner could try to get its competitors out of the market or to restrain their lawful activities.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

Opposition procedures are prosecuted before IMPI.

All applications, including colour marks, are published for opposition. Mexico's opposition system allows third parties to oppose within a non-extendible one-month term. IMPI considers oppositions as part of its examination but issues an independent decision, which may be challenged before the Specialized IP Chamber of the Federal Court of Administrative Justice, and thereafter by means of a judicial appeal known as *amparo*.

The tricky part when dealing with colour marks is to ensure you have a suitable monitoring service in place which is capable of detecting this type of applications.

As for cancellation actions, these are also pursued before IMPI through an administrative procedure, where the main issues when it comes to colour mark disputes should focus on whether IMPI correctly assessed distinctiveness, properly weighed acquired distinctiveness evidence, and accurately framed the comparison of signs in their overall commercial context, i.e. that no competitors have used the same color shade before.

Appeals against IMPI's decisions can be brought before the Federal Administrative Justice Court and subsequently via constitutional review (*amparo*) before the federal judiciary.

5. Use of Color Trademarks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

There are no specific guidelines. However, once a colour mark is registered it has the same effects and its owner the same rights to use and enforce the mark as when dealing with any traditional mark.

Thus, access to notice and take down mechanisms is also available, as well as infringement actions provided that we are dealing with the same or similar goods or services.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

Nowadays there are no final and conclusive decisions regarding the enforcement of colour mark

registrations.

Still, enforcement against infringing colour use proceeds primarily through the Mexican Institute of Industrial Property (IMPI) through an administrative infringement procedure. The rights holder may seek:

- A determination of infringement based on confusing similarity.
- Precautionary measures, including the immediate cessation of infringing acts, seizure of infringing goods, embargo of assets related to the infringement, and suspension of services used to carry out the infringement, subject to guarantees.
- Administrative fines and orders to withdraw infringing goods from commerce.
- The possibility of having damages and lost profits awarded, which our law estimates in at least 40% of the sales price of the involved good/service

Appeals against IMPI's decisions can be brought before the Specialized IP Chamber of the Federal Administrative Justice Court and subsequently via constitutional review (amparo) before the federal judiciary.

Border enforcement is available through customs authorities, allowing recordation of trademark rights and the interception of suspected infringing goods at points of entry. Rights holders can request the suspension of customs clearance and follow up with IMPI proceedings.

Criminal actions may lie in cases of counterfeiting or recidivist conduct involving deliberate reproduction of identical marks at a commercial scale; however, these are reserved for egregious scenarios and typically involve traditional marks.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

The most effective evidence for filing and successfully registering colour marks is a market survey since it serves two purposes: first to demonstrate that the colour has acquired a distinctive character linked to the involved products/service and second to demonstrate that the granting of the proposed colour would not harm competitors within the market as ideally the survey should show only applicant's goods/services are distinguished with the involved shade.

Regarding their further maintenance and enforcement, the key element should be adopting an effective monitoring system of what is filed before the Mexican trademarks office, as to avoid dilution, and of the market in order to prevent the mark from becoming generic.

- b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

While no specific guidelines exist, as a general rule the Mexican Law allows coexistence of confusingly similar marks and even identical marks, applied to similar products or services, when express and written consent of the senior registrant is exhibited.

Since as explained, once you secure registration for a colour mark, same has the same effects as a traditional mark, we consider the aforementioned provision would also be applicable.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No, although additional government fees will have to be taken into account deriving from the response to the relevant official actions. Other costs as the suggested/required market survey would need to be taken into account.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

No, there has not been a final and conclusive decision from an authority sustaining that in light of the limited number of colours that exist, granting colour shades as registered marks, that could derive in the exhaustion of all usable options for other businesses.

To this end, we think it is important to consider that when filing for a colour application you must also constrain its use and protection to determined goods/and services.

In any event, the most important thing is that the authority, before granting a registration for a colour mark, is sure that the same or a similar color is not being used by other businesses within the same market in connection with the same or similar goods, as otherwise the granting of a registration would in fact constitute an unlawful tool for registrant to try to expel its competitors from the relevant market.

NEW ZEALAND

Contributor: Dr. Victoria Longshaw of Houlihan Intellectual Property

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

The New Zealand *Trade Marks Act 2002* defines a “sign” in section 5 to include “colour”, making colours (single or combinations) eligible for registration as Trade Marks. This provision aligns with New Zealand’s international obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) Article 15(1), which includes combinations of colours as eligible signs.

Colour Trade Marks must have distinctive character (Section 18(1)(b) of the *Trade Marks Act 2002*) and thus be capable of distinguishing the Goods/Services of one trader from those of others. Registration of a clearly represented and described Colour Trade Mark, whether as a specific shade like a Pantone-referenced colour, a combination of colours, or a gradient, is therefore possible in New Zealand.

Where colours do not function as a Trade Mark (Section 18(1)(a) of the *Trade Marks Act 2002*) have no distinctive character (Section 18(1)(b) of the *Trade Marks Act 2002*); consist only of signs or indications that serve in trade to designate characteristics of the Goods or Services (section 18(1)(c) of the *Trade Marks Act 2002*); or consist only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade (section 18(1)(d) of the *Trade Marks Act 2002*); then such colours would not be registrable as a Trade Mark in New Zealand.

Since Colour Trade Marks are typically considered to have low inherent distinctiveness, registration often requires evidence of acquired distinctiveness.

- b) What specific requirements must accompany an Application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

The following filing requirements must be met for a Trade Mark Application for a Colour Mark according to Regulations 42(1)(b) and 44(g) of the *Trade Marks Regulations 2003*:

1. A clear representation of the colour or combination of colours (e.g., a sample or swatch);
2. A clear description using a widely recognised colour standard, such as Pantone® codes (preferred and commonly accepted by IPONZ).

If the written description of the Colour Mark provided by the Applicant is considered by the Commissioner to be not sufficiently clear and precise, and/or does not reflect the actual use of the Mark as shown in the exhibits provided, the Applicant will be directed to provide a more precise description of the Trade Mark that reflects its actual use.

c) *Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?*

IPONZ assesses the registrability of a Mark that is a colour, or a combination of colours, on the merits on a case-by-case basis. Evidence of distinctiveness (acquired distinctiveness through use) is typically required during prosecution, especially for single colours or combinations lacking inherent distinctiveness (under section 18(1)(b) of the *Trade Marks Act 2002*).

- A Mark that consists only of a single colour is considered to have no distinctive character. Extensive evidence of use will need to be submitted to IPONZ to show that the Mark has acquired a distinctive character in New Zealand in respect of the relevant Goods/Services.
- A Mark that consists only of two or more colours is considered to have insufficient inherent distinctiveness for registration. Extensive evidence of use will need to be submitted to IPONZ to show that the Mark has acquired a distinctive character in New Zealand in respect of the relevant Goods/Services.
- A Mark consisting of a single colour, or a combination of colours, that is associated with or common to certain trades, is considered to have no distinctive character with respect to Goods/Services used in those trades. For example, bands of colour are commonly used as product reference codes in some trades.

Evidence must be submitted to IPONZ in the form of a Statutory Declaration, an Affidavit or an Affirmation, with exhibits. The evidence should include:

1. the date the Colour Trade Mark was first used on the relevant Goods/Services in New Zealand;
2. how widely used the Colour Trade Mark has been in New Zealand (geographically);
3. annual sales/turnover figures of the Goods/Services traded under the Colour Trade Mark in New Zealand;
4. annual advertising or promotional expenses for the Goods/Services provided under the Colour Trade Mark in New Zealand; and
5. examples showing how the Colour Trade Mark has been used in New Zealand (e.g., copies of sales brochures, copies of advertisements, samples of packaging for the Applicant's Goods or letterhead).

Additional evidence may include:

6. supporting Declarations from persons in the relevant trade attesting to the distinctiveness of the Colour Trade Mark and the length of time that the Colour Trade Mark has been known in the trade;
7. Consumer surveys or Declarations showing consumer association of the colour with the Applicant's Goods/Services;
8. any other information that may assist in establishing that the Colour Trade Mark has

become distinctive as a result of its use in New Zealand.

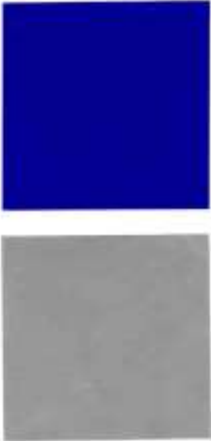
2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

At the time of writing, there are 135 live cases of Colour Trade Mark Applications or Registrations on the IPONZ Register. Some examples of successfully registered Colour Trade Marks are shown below:

New Zealand Trade Mark Registration No. 211576 In the name of BP P.L.C. Filed on 19 July 1991 <u>Class 4:</u> Industrial oils and greases; transmission oils; lubricants; products for absorbing, spraying and binding dust; fuels (including petrol) and lighting substances. <u>Mark Description:</u> The Mark consists of the colour green, applied to the exterior surfaces of service stations used for the supply of the said Goods as depicted in the representation attached to the Application form. <u>Limitations:</u> Registration of this Mark shall give no right to the exclusive use of the colour green as applied to pumps, nozzles and hoses for delivery of unleaded petrol. <u>Explanations:</u> This Mark was advertised before acceptance under section 27(1) of the <i>Trade Marks Act 1953</i>. <u>Statement of Use:</u> Use Claimed	
New Zealand Trade Mark Registration No. 220103 In the name of DEERE & COMPANY Filed on 24 July 1992 <u>Class 12:</u> Tractors. <u>Mark Description:</u> The Trade Mark consists of a green colour applied to the body of the tractor, a yellow colour applied to the wheels of the tractor and a yellow colour applied in horizontal stripes to the sides of a tractor, as shown in the representation attached to the Application form. <u>Explanations:</u> This Mark was advertised before acceptance under section 27(1) of the <i>Trade Marks Act 1953</i>. <u>Statement of Use:</u> Use Claimed	

New Zealand Trade Mark Registration No. 245954 In the name of GLAXO GROUP LIMITED Filed on 20 February 1995 <u>Class 10:</u> An inhaler device for use in conjunction with an aerosol can containing beclomethasone dipropionate or a solvent thereof, the inhaler being adapted to deliver 100 (50) micrograms of active ingredient per actuation; all included in this Class. <u>Mark Description:</u> The Mark consists of the colours maroon and pink, applied to the visible surface of inhalers, as shown in the representation attached to the Application. <u>Statement of Use:</u> Proposed to be used by the proprietor(s), (being the Applicant) [only valid for filings prior to 2002 Act]	
New Zealand Trade Mark Registration No. 285611 In the name of CADBURY UK LIMITED Filed on 4 December 1997 <u>Class 30:</u> Block chocolate; chocolate in bar or tablet form. <u>Mark Description:</u> The Mark consists of the colour purple (Pantone 2685C), as shown in the representation attached to the Application, as applied predominantly to the packaging of the Goods. <u>Explanations:</u> Section 18(2) of the <i>Trade Marks Act 2002</i> applies. <u>Statement of Use:</u> Use Claimed	
New Zealand Trade Mark Registration No. 602096 In the name of DURACELL U.S. OPERATIONS, INC. Filed on 1 November 1999 <u>Class 9:</u> Batteries. <u>Mark Description:</u> The Trade Mark consists of the colouring of the side walls of a battery container, as shown in the representation attached to the Application, namely, a copper coloured upper portion and a black coloured portion, said portions together constituting the whole of the container side walls. <u>Explanations:</u> This Mark was advertised before acceptance under section 27(1) of the Trade Marks Act 1953. <u>Statement of Use:</u> Use Claimed	

New Zealand Trade Mark Registration No. 1194609 In the name of SKELLERUP INDUSTRIES LIMITED Filed on 9 November 2021 <u>Class 25:</u> Gumboots. <u>Mark Description:</u> The Trade Mark consists of two red stripes (Pantone 7600C) applied to Goods of a contrasting colour, as shown in the representation attached to the Application. The first red stripe is applied around the top of the boot. The second red stripe is applied around the base of the boot and includes additional coverage over the toe cap. <u>Explanations:</u> Section 18(2) of the <i>Trade Marks Act 2002</i> applies. <u>Statement of Use:</u> Use Claimed	
New Zealand Trade Mark Registration No. 644331 In the name of RED BULL GMBH Filed on 27 August 2001 <u>Class 32:</u> Energy drinks, namely non-alcoholic caffeinated beverages. <u>Mark Description:</u> The Mark consists of the colours blue (Pantone Reflex Blue C) and silver (Pantone 877C), as shown in the representation attached to the Application, and as applied in combination and in relative proportions of 50% blue and 50% silver in diagonally or transversally extending stripes or lines, applied to the external surface of a drink container. <u>Statement of Use:</u> Use Claimed	
New Zealand Trade Mark Registration No. 1133434 In the name of P&F GLOBAL LIMITED Filed on 29 October 2019 <u>Class 19:</u> Culvert pipes, not of metal. <u>Mark Description:</u> The Trade Mark is the colour black (Pantone Black) as applied to the exterior of a pipe, and the colour green (identified as RAL6016) as applied to the interior of a pipe, as shown in the representation attached to this Application. <u>Explanations:</u> Section 18(2) of the <i>Trade Marks Act 2002</i> applies. <u>Statement of Use:</u> Use Claimed	

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The primary statute is the *Trade Marks Act 2002* (as amended), and associated *Trade Marks Regulations 2003*.

Notable cases include:

Energy Beverages LLC V Frucor Suntory NZ Limited [2020] NZHC 3296

Background:

- Frucor (owner of the V energy drink brand) had used a specific shade of green (Pantone 376C, a bright lime green) as the predominant colour on its cans, bottles, and packaging for many years.

Pantone 376C



- On 29 August 2008, Frucor filed a paper Trade Mark Application (No. 795206) with IPONZ. It included a physical colour swatch of Pantone 376C and the written description: “*The Mark consists of the colour green (Pantone 376c), as shown in the representation attached to the Application, applied as the predominant colour to the Goods, their packaging or labels.*” (Class 32 – energy drinks.)
- IPONZ approved the wording. The Mark was registered on 23 June 2012 (deemed registration date: 29 August 2008).
- During IPONZ’s later digitisation of paper records, the physical swatch was scanned and uploaded incorrectly, resulting in a darker “emerald” green appearing on the electronic register. The original swatch was destroyed. This technical error became central to the dispute.

Trade Mark Application No. 795206:



- Energy Beverages LLC (hereafter “EBL”, part of the Monster Energy group and maker of MOTHER energy drinks) began using a very similar shade of green on its “Kicked Apple” variant packaging.
- Frucor considered this use an infringement of its registered Colour Mark and sent a cease-and-desist letter threatening legal action.

Proceedings:

- Instead of waiting to be sued, EBL launched two pre-emptive proceedings at IPONZ in 2017 (nine years after the deemed registration date):
 - On 20 June 2017, an Application for revocation for non-use was filed (under Section 66): EBL argued Frucor was not using the exact colour shown on the register (the darker emerald shade).
 - On 8 August 2017, an Application for declaration of invalidity was filed wherein EBL claimed the Mark was not a “sign” capable of graphic representation, was ambiguous (the written description included the words “predominant colour” which were allegedly to cover multiple signs), and lacked distinctiveness.

Decisions by IPONZ:

- In Decisions issued on 11 May 2020 by IPONZ ([2020] NZIPOTM 5 and 6), both Applications by EBL were dismissed. The registered Colour Mark was upheld as valid.

Appeal to the High Court of New Zealand:

- EBL appealed both IPONZ decisions to the High Court of New Zealand.
- On 14 December 2020, the High Court dismissed both appeals ([2020] NZHC 3296) based on the following reasoning:
 - The 7-year statutory bar (s 75) prevented most invalidity challenges after seven years from registration.
 - The written description (Pantone 376C + “predominant colour”) prevails over the incorrect uploaded swatch on the register.
 - Frucor had made genuine use of the exact colour described, so non-use revocation failed.
 - The word “predominant” in the written description was not considered to be too vague in this context.

Appeal to the Court of Appeal of New Zealand:

- EBL appealed to the Court of Appeal of New Zealand.
- On 30 November and 1 December 2021, the Court of Appeal dismissed both appeals ([2022] NZCA 536) based on the following reasoning:
 - The written Pantone description defined the Mark and prevailed over the erroneous graphical representation.
 - The registration was not ambiguous and did not cover multiple signs.
 - The 7-year bar applied.
 - IPONZ’s upload error of the graphical representation did not invalidate the Colour Mark or support any non-use revocation.

Rectification of the Register:

- After the Court of Appeal win, Frucor applied to the High Court under section 76 of the *Trade Marks Act 2002*, to rectify the Register by replacing the wrong (darker) colour swatch with the correct Pantone 376C shade.
- EBL intervened to oppose.
- On 1 August 2023, the Court granted rectification ([2023] NZHC 2032) and the Register was corrected to match the written description

Key takeaway for Applicants: When filing colour Trade Marks in New Zealand, prioritise precise written descriptions (e.g., exact Pantone codes) over visual representations, as the former governs interpretation in disputes, and retain copies of Applications to address potential administrative errors.

Effem Foods Ltd V Cadbury Ltd HC WN CIV-2004-485-2127 [2005] NZHC 376 (12 December 2005)

This is not a colour-Mark case in the modern sense (it does not involve a Pantone swatch or “the colour purple applied to packaging”). Instead, it concerns Cadbury’s attempt to register the ordinary English word “PURPLE” itself as a word Trade Mark for confectionery and the possibility of registering a Word Mark to cover a Colour Mark.

Background:

- Cadbury Ltd applied to register the word “PURPLE” (in plain block capitals) as a Trade Mark under the old Trade Marks Act 1953.
- The Goods claimed were in Class 30: chocolate, chocolates, non-medicated confectionery, biscuits, wafers, cakes, snack food, cereal preparations, ice cream, ices, and frozen confections.
- Important limitation in the Application: Cadbury added the exclusion “none of the foregoing Goods being coloured purple”.
- Cadbury’s stated intention was to use the word “PURPLE” on its packaging/labels for its ordinary (non-purple) chocolate products, while accepting that it could not stop competitors from using the word on Goods that actually were purple-coloured.

Proceedings:

- Effem Foods Ltd (the New Zealand arm of the Mars group, a direct competitor in confectionery) filed a formal Opposition to the Application at IPONZ under earlier legislation, the *Trade Marks Act 1953*.
- The main grounds of Opposition were:
 - “PURPLE” is not a Trade Mark within the definition in Section 2 (it does not function as a badge of origin).
 - It is not registrable under sections 14 or 15 of the *Trade Marks Act 1953* because:
 - The Mark has a direct reference to the character or quality of the Goods (s 14(1)(d)) in that the word simply describes a colour that could be used on or in the Goods.
 - The Mark was not inherently adapted to distinguish Cadbury’s Goods from those of other traders.
- Evidence suggested that Cadbury’s primary purpose for the registration was defensive rather than a genuine intention to use the mark, which can be a ground for opposition.

Decision by IPONZ:

- On 7 September 2004, IPONZ upheld Cadbury’s Application and allowed registration (T19/2004).

Appeal to the High Court of New Zealand:

- Effem appealed the IPONZ decision to the High Court of New Zealand.
- On 12 December 2005, the High Court allowed the appeal and refused registration of “PURPLE” based on the following reasoning:
 - The word “PURPLE” was considered to directly describe a possible colour of the Goods or their packaging. Even with the exclusion for “Goods being coloured purple”, the Mark still had a direct reference because the exclusion did not remove the descriptive character of the word.

Appeal to the Court of Appeal of New Zealand:

- Cadbury appealed to the Court of Appeal ([2007] NZCA 303).
- On 20 July 2007, the Court of Appeal dismissed the appeal and upheld the High Court’s decision that “PURPLE” was descriptive and not inherently distinctive, even with the exclusion.

Key takeaway for Applicants: In New Zealand (under the 1953 Act, influencing later practice), word Marks describing colours face high hurdles for inherent distinctiveness in relevant Classes like confectionery, where colour terms are commonly descriptive. Including a negative exclusion in the Specification of a Trade Mark Registration may address direct descriptiveness but may not overcome the risk that others could legitimately use the term descriptively. The case highlighted that while filing an Application creates an inference of intent to use, this can be displaced by evidence showing the purpose is purely defensive.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

IPONZ practice guidelines

- The Intellectual Property Office of New Zealand (IPONZ) provides detailed practice guidelines (in sections on filing, examination, absolute grounds for distinctiveness, and colour limitations) emphasising that colour Trade Marks must be described with precision to satisfy the graphic representability requirement under section 5 of the *Trade Marks Act 2002*.
- Applicants are required to use standardised colour systems such as Pantone® codes, together with a clear written description (e.g., “the colour green (Pantone 376C) as shown in the representation attached to the Application, applied as the predominant colour to the Goods, their packaging or labels”) and a representative sample.
- IPONZ discourages the use of subjective or imprecise terms such as “predominant” or “predominantly” in the description, as these can introduce uncertainty about the scope and boundaries of the Mark.
- Where colour is central to distinctiveness, IPONZ may require a colour limitation and evidence of acquired distinctiveness to overcome inherent objections. Marks filed without an explicit colour limitation (e.g., in black and white or without restriction) are not limited as to colour under section 19(2), providing broader protection across shades.
- At the time of writing, general guidelines may be found at <https://www.iponz.govt.nz/get-ip/trade-Marks/practice-guidelines/#group-current-practice-guidelines>

Scope of Protection — Exact vs Similar Shades

- IPONZ guidelines stress precision in the registered description, particularly Pantone codes, to clearly define the Mark’s boundaries and facilitate graphic representation.
- While registration is tied closely to the exact nominated colour, protection is not strictly limited to identical reproductions.
- Infringement under sections 89 and related provisions occurs if the allegedly infringing sign is identical or similar to the registered Mark and its use is likely to deceive or confuse consumers in the relevant Market context. For Colour Marks, this means protection can extend to confusingly similar shades where the overall impression (considering Goods/Services, get-up, and consumer perception) creates a real likelihood of deception or confusion.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or cancelling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

Opposition Proceedings

Opposition proceedings provide the primary mechanism to challenge a Trade Mark Application before registration in New Zealand. They are conducted exclusively before the Intellectual Property Office of New Zealand (IPONZ).

Any person may file a Notice of Opposition within three (3) months of the advertisement of acceptance of the Trade Mark Application in the IPONZ Journal. The Applicant then has two (2) months to file a Counter-Statement and failure to do so results in the Application being deemed abandoned.

Following the Counter-Statement, the Opponent must file its Evidence-in-Support within two (2) months. The Applicant has a further two (2) months to file its Evidence-in-Support, after which the Opponent has one (1) month to file Evidence-in-Reply. Once the evidential stages are complete, the parties are invited to elect how they wish to be heard: on the papers (no fee), by written submissions (with payment of a fee), or at an in-person or video hearing (with payment of a fee, typically in Wellington, with options for Auckland, Christchurch, or video). After the Hearing, the Assistant Commissioner issues a written decision, usually within 30 working days of the hearing, which may include an award of costs. This Decision may be appealed to the High Court of New Zealand within 20 working days. A successful Opposition results in refusal of the Application, which may be total or partial in respect of specific Goods/Services or Classes.

Oppositions against Colour Marks follow the same procedure but frequently focus on absolute grounds under sections 17 and 18 of the *Trade Marks Act 2002*, particularly lack of distinctiveness (including inherent distinctiveness of colours per se), graphic representability under section 5, and descriptiveness. Precise specification of the colour (e.g., Pantone reference) and evidence of acquired distinctiveness through use are often central to the outcome.

Invalidity Proceedings

Invalidity proceedings allow an “aggrieved person” to challenge the validity of a Registered Trade Mark. Applications are filed at IPONZ (or, in certain circumstances such as in linked court proceedings, directly in the High Court). The Applicant must demonstrate that the Mark was not eligible for registration under Part 2 of the *Trade Marks Act 2002* at its deemed registration date. Grounds upon which Invalidity Proceedings may be filed include both absolute grounds (sections 17–18) and relative grounds (section 25).

If the Invalidity Proceedings are filed at IPONZ, the Registered Trade Mark owner has two (2) months to file a Counter-Statement. If no Counter-Statement is filed, the Applicant must establish a *prima facie* case. If a Counter-Statement is filed, the Applicant has two (2) months to file Evidence-in-Support and thereafter the owner has two (2) months for its Evidence-in-Support. The Applicant then has one (1) month to file Evidence-in-Reply. The hearing election and decision process is the same as that for Opposition Proceedings, with an appeal available to the High

Court.

A significant limitation affecting Invalidity Proceedings is the seven-year statutory bar under section 75 of the *Trade Marks Act 2002*. After seven (7) years from the deemed registration date, invalidity is generally unavailable except in cases of fraud or grounds under section 17(1) or 17(2). It is possible to file Invalidity Proceedings for partial invalidity of a Trade Mark Registration.

If the Invalidity Proceedings are filed in the High Court, the proceedings follow standard civil procedure, including the filing of pleadings, discovery, affidavit evidence (with potential cross-examination), and a full hearing before a judge. The registration of the Trade Mark is *prima facie* evidence of validity, placing the onus of proving invalidity on the Applicant. A Decision issued Invalidity Proceedings in the High Court may be appealed to the Court of Appeal and potentially the Supreme Court of New Zealand.

For Colour Marks, invalidity challenges commonly target lack of distinctiveness or graphic representability. However, the seven-year bar often shifts focus to other remedies once a Colour Mark has been registered for an extended period. Evidence of acquired distinctiveness through use remains highly relevant.

Revocation Proceedings

Revocation allows an “aggrieved person” to seek removal of a Registered Trade Mark from the register under sections 65–68 of the *Trade Marks Act 2002*, primarily on grounds of non-use, genericity, misleading use due to the owner’s conduct, or other public policy grounds.

Revocation Proceedings are filed at IPONZ (or the High Court if linked to other litigation). There is no general time bar, although non-use revocation requires a continuous period of at least three (3) years of non-genuine use after the actual registration date.

The procedure at IPONZ is similar to that outlined above for Invalidity Proceedings: two (2) months for the owner’s Counter-Statement, followed by two months for the Applicant’s Evidence-in-Support, two (2) months for the owner’s Evidence-in-Support, and one (1) month for the Applicant’s Evidence-in-Reply. The hearing election and decision process is the same as that for Opposition Proceedings, with an appeal of the Decision available to the High Court.

It is possible to file Revocation Proceedings for partial revocation of a Trade Mark Registration. The Applicant bears the onus of proving the grounds of revocation, although in non-use cases once a *prima facie* case is made the onus shifts to the owner to demonstrate genuine use.

For Colour Marks, revocation is particularly relevant where the owner is not using the precise registered colour specification (e.g., a different shade from the stated Pantone reference). The written description of the colour in the registration prevails over visual representations of the colour.

Cancellation Proceedings

Voluntary Cancellation

An owner of a Trade Mark Registration may voluntarily apply to cancel the Registration (in full or partially) under section 61 of the *Trade Marks Act 2002* by written Application to IPONZ. Other grounds of voluntary cancellation by an owner of a Trade Mark Registration, under sections 62–

64 and 87 of the *Trade Marks Act 2002*, include breach of conditions or disclaimers entered on the register, correction of obvious errors, or issues relating to registered licensees (e.g., misuse or termination of the licence relationship).

The procedure of voluntary cancellation is as follows: owner files a simple request, which is processed by IPONZ if no issues arise.

Opposed Cancellation

A Cancellation Application may be opposed by any person. If a cancellation Application is opposed then the proceedings follow a procedure similar to those of revocation proceedings. That is, the Cancellation Proceedings will involve the filing of a Counter-Statement, evidence stages, hearing election, and a written decision by the Commissioner (or Assistant Commissioner), with appeal to the High Court available, as outlined above for Revocation Proceedings.

Cancellation generally takes effect prospectively from the date of the decision or as ordered. Partial cancellation of a Trade Mark Registration is common, particularly in cases of voluntary cancellation.

5. Use of Colour Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile Applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colours in these emerging spaces or are they treated in the same way as other Trade Marks?

In New Zealand, Colour Trade Marks in digital/virtual contexts (websites, apps, VR) are treated similarly to traditional Marks under the *Trade Marks Act 2002*. There are no specific guidelines or precedents exclusively for digital/virtual spaces. If the colour functions as a Trade Mark and is used in commerce (including online), then the colour may be registered as a Trade Mark. Enforcement of Registered Trade Marks for colours relies on standard infringement tests under section 89 of the *Trade Marks Act 2002*.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

New Zealand case law on Colour Mark infringement actions (i.e., owner suing to judgment) remains limited, probably due to Colour Marks being relatively rare and many disputes being resolved by settlement. There are currently no reported cases identified where a registered Colour Mark owner failed in enforcement against a third-party use.

Energy Beverages LLC V Frucor Suntory NZ Limited [2020] NZHC 3296 upheld on appeal [2022] NZCA 536, with related rectification in 2023

This is the leading (and most prominent) New Zealand case involving enforcement of a registered colour Trade Mark, although a final decision on infringement was not made. This dispute arose from Frucor’s threatened infringement proceedings against a third-party competitor.

As discussed above, Frucor owned a registered Colour Mark for its V energy drink packaging: the colour green (Pantone 376C), described as “applied as the predominant colour to the Goods, their packaging or labels.” Energy Beverages (owner of Mother energy drinks) used a closely similar shade of green on its “Kicked Apple” cans and get-up. Frucor warned Energy Beverages that this constituted infringement and indicated that it would sue for infringement. In response, Energy Beverages pre-emptively challenged the Mark’s validity and sought revocation for non-use at IPONZ (and on appeal to the High Court and Court of Appeal).

Frucor successfully defended its colour Trade Mark registration. The registration was upheld as valid, and the revocation Application was dismissed. No infringement proceedings were ultimately filed to final judgment (the validity battle resolved the commercial dispute), but Frucor’s ability to enforce was confirmed. In 2023, the Court of Appeal further allowed Frucor to rectify the register by correcting an erroneous colour swatch that had been uploaded (the written Pantone description prevailed).

This case illustrates that once registered and protected beyond seven (7) years, a precisely described Colour Mark (especially with Pantone referencing and evidence of use) provides strong enforcement leverage in New Zealand, even against close third-party uses on similar Goods.

A key factor influencing the successful outcome of this case for the colour Trade Mark owner was the fact that the owner included a precise written description of the colour Mark when filing the Trade Mark Application.

Key factors influencing the outcome:

- ***7-year statutory bar under section 75 of the Trade Marks Act 2002:*** The invalidity challenge (brought almost nine years after registration) was largely time-barred. After seven (7) years, a registration is presumed valid unless obtained by fraud or falling under narrow Section 17(1) or (2) grounds. This provided significant protection against attacks on registrability, distinctiveness, or whether the colour qualified as a “sign”.
- ***Interpretation of the registered Mark:*** The written description prevails over any graphical representation of the Colour Mark. The registration specified “the colour green (Pantone 376C) ... applied as the predominant colour”. The Court held that the precise written Pantone reference takes precedence over any graphical swatch or uploaded image on the register (even if the swatch showed a slightly different shade due to an IPONZ error). This gave certainty to the scope of the Mark and defeated arguments of ambiguity or imprecision.
- ***Genuine use matching the Registration:*** Frucor demonstrated continuous use of the exact Pantone 376C shade on its V energy drink packaging. The non-use revocation failed because use aligned with the written description. Minor discrepancies in the register’s visual representation did not undermine this position.
- ***Distinctiveness (inherent and acquired):*** Evidence of long-standing, substantial, and conspicuous use since the late 1990s supported acquired distinctiveness in this case. The specific shade was not merely descriptive or functional in the energy drink category. Arguments that “predominant” made the Mark too subjective or covered multiple signs were rejected.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

Recommended prosecution strategies include:

At filing of a Trade Mark Application for a Colour Mark:

- File the Application with both a colour representation and an explicit written description using a recognised standard such as Pantone, together with the precise manner of Application (for example, “the colour green (Pantone 376C) applied as the predominant colour to the Goods, their packaging or labels”).
- To overcome distinctiveness objections, effective evidence includes sales volumes, Market share data, advertising expenditure, examples of promotional materials, and consumer or trader declarations demonstrating that the colour functions as a badge of origin.
- If use of the Colour Mark in New Zealand is limited, consider filing a composite Mark initially to build reputation before pursuing a pure Colour Mark.

When defending a Colour Trade Mark Application or Registration:

- Emphasise the written Pantone description as definitive and invoke the seven-year statutory bar under Section 75 where applicable, which limits invalidity challenges after seven years from the deemed registration date.
- Key defensive evidence includes proof of genuine use matching the registered specification, long and substantial use demonstrating acquired distinctiveness, and declarations from traders or consumers confirming the colour’s source-identifying function. Defend proceedings at IPONZ where possible for efficiency, reserving High Court proceedings for cases involving linked infringement actions or the need for cross-examination.

When enforcing a Registered Colour Trade Mark:

- Consider filing a Customs Notice with New Zealand Customs under the *Trade Marks Act 2002* in respect of Goods for which the Trade Mark is registered in New Zealand.
- Consider keeping a watch for any new Trade Mark Applications for similar Colour Marks by competitors, in order to monitor for opportunities to initiate Opposition Proceedings and prevent competitors from gaining registered rights for similar Colour Marks.
- Consider combining causes of action when enforcing registered Colour Marks. Enforcement of Colour Marks is strongest when combined with other elements such as logos and get-up. Pure single colour enforcement is rare but is viable in light of the *Frucor* case, as long as the written description of the Pantone colour is exact and there is strong evidence of use of the Colour Mark by the owner.

- b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Co-existence of Colour Trade Marks in New Zealand is possible if the Marks are not confusingly similar or if agreement between the owners is reached (e.g., via Opposition settlements). Multiple similar Colours Marks can co-exist if they are distinct in Application or the Goods/Services for which the Trade Mark Applications are filed are different.

- c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No additional fees are payable for Applications for Colour Trade Marks and standard fees apply.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

New Zealand does not explicitly recognise or apply a “colour depletion” doctrine (unlike some jurisdictions where limited colours in commerce restrict registrations to prevent monopolisation). The *Trade Marks Act 2002* and IPONZ guidelines focus on distinctiveness and graphical representation rather than depletion concerns. Each Application is assessed on merits, with no statutory bar based on colour scarcity. Courts/IPONZ consider availability indirectly via distinctiveness and public interest in non-monopolisation of functional/descriptive elements, but depletion is not a formal concept.

9. About the Contributor for the section for New Zealand



Dr. Victoria Longshaw currently serves as Vice-Chair of the International Trade Marks Law and Practice Committee of the IPO Association. She is a Principal of Houlihan Intellectual Property, a patent and trade mark attorney firm headquartered in Melbourne, Australia and assisting clients in Australia, New Zealand, Singapore and Malaysia.

Victoria drafts, files and prosecutes Patent, Trade Mark and Design Applications and she has had over twenty years of experience in the IP Field. She provides innovative expertise in IP prosecution and in dispute resolution, specialising in Patent and Trade Mark Opposition Proceedings and in Intellectual Property Litigation. Her advanced degrees in Biochemistry, Psychology and Law, together with her scientific research and legal experience, assist Clients of Houlihan IP in navigating through otherwise complex matters. Victoria previously worked as a Post-Doctoral Research Scientist in the Life Sciences area, an IP consultant, and a Principal of another IP Firm. She is the author of several peer-reviewed research articles and a named inventor on several Patents.

PERU

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Andean Decision 486 provides the legal framework for trademark protection in Peru.

Article 134 of Decision 486 of the Andean Community defines what a trademark is, establishing that any sign capable of distinguishing products or services in the market can be registered, provided that it is capable of graphic representation. The article lists examples of these signs, such as words, images, sounds and shapes.

Article 134 (e) establishes that a color delimited by a shape, or a combination of colors may constitute a trademark.

To be noted is that a specific category for color trademarks is already included in the online trademark application system.

The Peruvian Trademark Office recently incorporated a new platform (SEL) for trademark applications (which also includes other services such as trademark renewals and an official notification/action system, etc.), wherein the following trademark categories/types (traditional and non-traditional) can be applied for:

- Mixed marks
- Word marks
- Figurative marks
- Mixed marks
- 3D marks
- Sound marks
- Scent marks

- Position marks
- **Color marks**
- Tactile marks

Source: SEL Platform for trademark applications in Perú (<https://servicio.indecopi.gob.pe/sel>)

The platform states that a color by itself cannot be registered unless it is demonstrated beyond doubt that it has acquired distinctiveness as a consequence of its constant use in the market.

b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

A color by itself cannot be registered unless it is demonstrated beyond doubt that it has acquired distinctiveness as a consequence of its constant use in the market. It must also present a specific configuration or shape.

Process 23-IP-98 - The Andean Court of Justice (regarding Decision 344, the predecessor of the current Decision 486) stated that "the seven fundamental colors of the rainbow and secondary colors resulting from their combinations" are not eligible for trademark registration. This prohibition applies only to individual colors and if the color is not "delimited by a specific shape. (...) If two or more colors are arranged together, but not mixed, they can access registration. (...) A mark composed of several colors should be treated in the same way as generic or descriptive signs, and therefore, if analyzed together they provide distinctiveness, they can be registered as a trademark."

Case No. 137-IP-2004 - Pre judicial interpretation issued by the Andean Court of Justice on the grounds for non-registrability contained in Article 82, paragraph f) of Decision 344 (predecessor to Decision 486), state that signs that "consist of a color considered in isolation without being

delimited by a specific shape" are not eligible for trademark registration. The prohibition established in the rule refers to both primary and secondary colors resulting from the combination of primary and secondary colors. The impediment contained in this article prevents a businessperson from appropriating one or more colors through registration, thus preventing others from using them in their trademarks, which would create an unfair competitive advantage. CONCLUSION: A color considered in isolation and without a specific configuration cannot be registered as a trademark. However, signs composed of two or more colors, or those made up of a single color but delimited by a specific two-dimensional or three-dimensional shape, can be registered, provided that this does not incur any cause of non-registrability.

c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

Yes, see our reply above and the following examples:

Resolution No. 151-2002/TPI-INDECOPI of February 18, 2002, regarding the registration of a trademark consisting of the steel blue color defined by the three-dimensional shape of a pill, where the three-dimensional shape of the pill is not claimed, according to the facsimile, to distinguish pharmaceutical products of Class 5 of the Official Nomenclature. The registration was denied due to the existence of other rhomboid-shaped, steel blue pills on the market.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

By Resolution No. 987-2006/TPI-INDECOPI, the Intellectual Property Chamber of Indecopi revoked 2435-2006/OSD-INDECOPI and granted the registration of the mixed trademark consisting of two rectangles with white borders and a magenta background 241C, in Class 5 of the international classification.



Tommy Hilfiger held trademark registrations in class 25 for color schemes it typically uses in its products, i.e. registrations 23558 (first registered in 1997) and 32918.

RESOLUTION No. 0632-2024/TPI-INDECOPI: The opposition filed by Tommy Hilfiger Licensing LLC against the SUALIK PERÚ trademark was declared unfounded, and the trademark registration was granted. The opposition alleged the use of the colors red, white, and blue, but Indecopi ruled that these colors were not exclusive to the foreign brand and did not generate confusion. This case underscores that the use of common colors cannot be monopolized unless a strong and distinctive association is demonstrated.



3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Andean Decision 486 provides the legal framework for trademark protection in Peru.

Article 134 of Decision 486 of the Andean Community defines what a trademark is, establishing that any sign capable of distinguishing products or services in the market can be registered, provided that it is capable of graphic representation. The article lists examples of these signs, such as words, images, sounds and shapes.

Article 134 (e) establishes that a color delimited by a shape, or a combination of colors may constitute a trademark.

Landmark cases:

- Article 134 (e) of Andean Decision 486 has been interpreted by the Andean Tribunal of Justice in Prejudicial Process 619-IP-2019, concerning alleged Infringement of industrial property rights of the green color trademark (green) VERDE PANTONE 361C where it stated the following:



“1.5. It is possible to register an isolated color as a trademark if it is delimited by a specific shape and, when viewed as a whole, and without incurring any other grounds for unregistrability, possesses distinctiveness. Therefore, the color must not be common to a type or line of products or to their packaging, nor should it be characteristic of a particular product. For example, fire extinguishers are characteristically red. To be distinctive, the color must not be linked to the nature of the product in question, nor must its use be mandated, for example, by a technical safety standard. The use of the color must be arbitrary, so as to allow for the identification of the business origin.” This interpretation was issued in relation to Colombian file N° 2018-308488.

In Peru, the same trademark was prosecuted under file No. 259965-2005, wherein the Trademark Office denied the registration of the trademark consisting of the color (green) VERDE PANTONE 361C (without claiming a shape), distinguishing products in class 30, because it is an isolated color not delimited by a specific shape and lacks additional elements that would grant it distinctiveness. Although the applicant claimed acquired distinctiveness of the color, the Specialized Intellectual Property Chamber (SPI) of the National Institute for the Defense of Competition and the Protection of Intellectual Property (INDECOPI) Tribunal considered that the applicant did not present sufficient evidence to prove acquired distinctiveness, particularly because it did not prove the use of the isolated color, as the evidence contained denominative and graphic elements.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

Guidance has been provided in Prejudicial interpretations issued by the Andean Court of Justice, the SPI of the INDECOPI Tribunal and the Peruvian online trademark application system as mentioned above.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

Colour trade marks are filed before the Directorate of Distinctive Signs (DSD) of the **INDECOPI** and follow the same procedure as regular trade marks.

Upon publication of the colour trademark application, any person with a legitimate interest can file a reasoned opposition within thirty business days. After this period, the authority conducts a substantial examination.

The Commission of Distinctive Signs (CSD) is the specialized administrative body that handles contentious matters in the first instance, including all trademark oppositions, nullity actions, and cancellation actions.

The CSD evaluates the grounds for opposition (e.g., risk of confusion) and the evidence presented by both the opponent and the applicant, and issues the Resolution in the first instance.

If either the applicant or the opponent is dissatisfied with the Commission's decision, they can file an appeal:

The appeal is filed with the CSD who raises it to the SPI of the INDECOPI Tribunal.

The SPI acts as the second and final administrative instance in all trademark disputes. It reviews the CSD's decision and issues a final administrative ruling.

Thereafter it is possible to file a Contentious-Administrative Claim with the Peruvian Judiciary.

This action is filed with the Subspecialized Commercial Courts of the Superior Court of Justice of Lima, which have national jurisdiction to review INDECOPI's IP decisions.

The deadline for filing this claim is three months from the date the party was notified of the final administrative decision by the SPI.

The court issues a ruling that can either uphold the INDECOPI decision or overturn it.

The ruling of the Superior Court can be appealed (via a Cassation Appeal to the Supreme Court of Justice).

There are no unique considerations for Colour Trade Marks compared to other types of Trade Marks.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

This has not been specifically addressed by Peruvian IP legislation. Colour trademarks used in digital or virtual environments will receive the same treatment as other types of trademarks.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

ALIANZA LIMA is a well-loved soccer team in Peru. It successfully opposed several applications filed by the company Nix Media S.A.C., which contained terms alluring to the team's characteristic colours, their nickname and their characteristic blue and white color combination:



Files 954556-2022, 954564-2022, 954582-2022, 954574-2022, 954560-2022, RESOLUCIÓN N° 0528-2025/TPI-INDECOPI, RESOLUCIÓN N° 0530-2025/TPI-INDECOPI, RESOLUCIÓN N° 0531-2025/TPI-INDECOPI, RESOLUCIÓN N° 0532-2025/TPI-INDECOPI, RESOLUCIÓN N° 0533-2025/TPI-INDECOPI

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

The weakness in most cases lies in the fact that the evidence usually includes elements other than the colour trade mark, i.e. a name, design or shape, so that the acquired distinctiveness of the colour by itself is not clearly demonstrated. This would be an essential aspect to consider for filing, opposing, defending, enforcing.

Also, keep in mind that trademarks that are not used over a period of three years after registration become vulnerable to cancellation. They must be used in the way they are registered to defend the registration. Often there will not be appropriate evidence of use, which by excellence are invoices, therefore the registrations become vulnerable to cancellation.

- b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

There are few colour registrations as such. Most similar may be RESOLUTION No. 0632-2024/TPI-INDECOPI: The opposition filed by Tommy Hilfiger Licensing LLC against the SUALIK PERÚ trademark was declared unfounded, and the trademark registration was granted. The opposition alleged the use of the colors red, white, and blue, but Indecopi ruled that these colors were not exclusive to the foreign brand and did not generate confusion. This case underscores that the use of common colors cannot be monopolized unless a strong and distinctive association is

demonstrated. It should be added that Tommy Hilfiger already held trademark registrations for color schemes it typically uses in its products. Furthermore, the resolution notes that the notoriety of Tommy Hilfiger's trademarks was not demonstrated.



- c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

There are no additional fees for Registration and Renewal of Colour Trade Marks in Peru.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

The concept has not been addressed. However, Process 23-IP-98 - The Andean Court of Justice (regarding Decision 344, the predecessor of the current Decision 486) stated that "the seven fundamental colors of the rainbow and secondary colors resulting from their combinations" are not eligible for trademark registration. This prohibition applies only to individual colors and if the color is not "delimited by a specific shape. (...) If two or more colors are arranged together, but not mixed, they can access registration. (...) A mark composed of several colors should be treated in the same way as generic or descriptive signs, and therefore, if analyzed together they provide distinctiveness, they can be registered as a trademark."

9. About the Contributor for the section for Peru



Claudia Fernandini is a highly accomplished attorney with over 25 years of experience practicing intellectual property (IP) and competition law in Peru.

Admitted to the Lima Bar, she holds memberships in prestigious organizations like the Inter American Federation of Attorneys (IABA/FIA), the International Association for the Protection of Intellectual Property AIPPI, the Association of University Technology Managers (AUTM) and the International Trademark Association (INTA) and the Peruvian Association of Intellectual Property (APPI).

Further bolstering her expertise, Claudia has earned Masters degrees in Business Administration and Innovation Project & Product Development.

She has been recognized in some of the most prestigious rankings, such as IAM Patent 1000, WIPR Leaders, IP Stars, Chambers, and has been ranked as one of the most influential women in IP law in 2024 by WIPR Diversity. Ms Fernandini is a published author, having prepared numerous articles and authored and co-authored books; she is also a professor at the Cayetano Heredia University in Lima.

Ms Fernandini is co-founder and managing partner at Mertz Perú, where she directly handles and oversees work for clients. Intellectual property, technology transfer and technology scouting and innovation are three of her main areas of expertise. She helps companies develop plans to protect their innovations, creations and brand names, resulting in powerful IP assets. She has substantial experience with trade secret protection and works on technology scouting and competitive intelligence projects on a regular basis.

Mrs. Fernandini is fluent in Spanish, English and German, with a basic understanding of French, having had a multicultural upbringing and professional experience. This unique multicultural background combined with her multidisciplinary education and experience enables her to address complex issues with tenacity, efficiency and sensibility, speaking and understanding the language of entrepreneurs, researchers, universities, governments and corporations alike. She has an eye for quickly identifying opportunities and challenges in various sectors, and is able to connect experience, knowledge, contacts and opportunities.

Yajaira Saavedra is an Intellectual Property Consultant at MERTZ PERÚ. She is responsible for developing legal strategies and handling proceedings before the National Institute for the Defense of Competition and Protection of Intellectual Property (INDECOPI), particularly before the Trademark Office, the Copyright Office, and other administrative authorities involved in the protection of intangible assets. She also participates in the drafting and review of agreements related to intellectual property and technology transfer.



She holds a degree in Law from the National University of San Marcos and has more than ten years of experience in Intellectual Property. She has been recognized by Leaders League among the recommended professionals

in the areas of Trademark Prosecution and Intellectual Property Litigation. In addition, she has completed specialized courses offered by the World Intellectual Property Organization (WIPO) and has experience in Intellectual Property, Administrative Law, Consumer Protection Law, and Animal Law.

Throughout her career, she has advised researchers, entrepreneurs, startups, and organizations on the protection, management, and commercialization of intellectual property assets. She has also participated in consulting projects developed for the World Bank and CONCYTEC and previously served as a Legal Assistant at INDECOP, gaining valuable experience in administrative and regulatory proceedings.

In addition, she holds a degree in Audiovisual Communications from Toulouse Lautrec and has experience in cultural industries, as well as in the development and production of content related to culture, innovation, and creativity.



Daniel Coaguila is an Intellectual Property and Innovation Consultant at MERTZ PERÚ, where he oversees national and international patent applications, breeder certificates for plant varieties, industrial designs, trademarks, copyrights, and trade secret protection. He holds a Law degree from Saint Paul Catholic University and has developed a strong specialization in patent prosecution, technology transfer, and IP strategy, alongside a deep expertise in digital law, legal tech, blockchain, electronic commerce, and competition law.

He consistently advises clients on innovation management and regulatory compliance, providing tailored legal frameworks that drive technological advancement and market expansion. Recognized for his strategic mindset and business-oriented IP protection strategies, Daniel has been ranked by Leaders League - Latin America (from 2023 -2026 editions) as "Highly Recommended" in Intellectual Property: Trademark Prosecution, and recognized for his "Quality Practice" in Innovation, Technology, and Telecommunications: Data Protection.

Beyond his legal practice, Daniel is deeply engaged in the academic community. He is an Honorary Member of the Intellectual Property Study Group (GEPI) at the National University of San Marcos (UNMSM), where he previously served as Coordinator of the Economic Commission and Academic Commission Member. Furthermore, he has recently lectured undergraduate students at UNMSM on mandatory observance precedents (jurisprudence) in intellectual property issued by the Peruvian Trademark Office (INDECOP).

Daniel collaborates closely with international clients and legal teams, ensuring seamless communication and the structuring of efficient, cross-border legal solutions. His ability to navigate complex IP landscapes and his passion for continuous learning and technology-driven IP strategies position him as a key player and rising leader at the intersection of law, technology, and innovation.



SPAIN

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

In Spain, it is possible to register color marks, color combinations, patterns, and position marks.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

If it is a figurative, three-dimensional, positional, pattern, color, or hologram trademark (and you want to represent it using images), you must do so by attaching a file in gif, bmp, png, tif, tiff, jpg, or jpeg standard compression format to the application.

The trademark must be represented by submitting (i) a reproduction of the color and an indication of said color referring to a generally recognized color code; (ii) a reproduction showing the systematic arrangement of the combination of colors in a uniform and predetermined manner, and an indication of those colors by reference to a generally recognized color code. A description detailing the systematic arrangement of the colors may also be attached.

Color marks composed exclusively of a single color without outlines or a combination of colors without outlines

1. It must constitute a sign.
2. It must be susceptible to graphic representation, through figures, lines or characters, so that it can be accurately identified. For example, through an internationally recognized identification code or Pantone.
3. It must distinguish the products and/or services of one company from those of others. The distinctive character must be related to the products or services for which registration is requested and, on the other hand, to the perception of the average consumer of the target group.
4. The “secondary meaning” must necessarily be proven, as only the intensive use of the color as a trademark will make it perceived as more than an ornamental or decorative element, but as an element that differentiates the business origin of the product.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

It is only necessary if the examiner considers that the color or combination of colors for which protection is sought is not sufficiently distinctive and is rejected because it falls under one of the absolute prohibitions of Article 5 of the Law.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.



3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

Article 4 of the Trademark Law states that all signs may constitute trademarks, in particular:

- words, including personal names.
- colors

provided that such signs are suitable for:

- a) distinguishing the goods or services of one company from those of other companies, and
- b) being represented in the Trademark Registry in such a way as to enable the competent authorities and the general public to determine the clear and precise object of the protection granted to its owner.

As the registration of the trademark confers on its owner the right to use it exclusively in commercial transactions, the sign must meet a series of requirements for validity and registrability, for which reason the Trademark Law (Articles 5, 6, 7, 8, 9, and 10) establishes a series of prohibitions:

Article 5. 1. Absolute grounds of refusal:

1.9. Signs that reproduce or imitate the coats of arms, flags, and emblems of municipalities, provinces, autonomous communities, the Spanish State, and other States, unless duly authorized.

1.10. Signs that include insignia, emblems, or coats of arms other than those listed in the previous section and that are of public interest, unless authorization has been granted.

b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

- FIGURATIVE: a sign consisting of words, letters, or numbers with non-standard characters, stylization, or arrangement, with or without graphic or color elements, or consisting exclusively of graphic elements.
- PATTERN: signs consisting exclusively of a set of elements that are repeated periodically.
- COLOR: these are signs composed exclusively of a single color without outlines or a combination of colors without outlines.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

Procedurally (theoretically) the same rules apply in Spain (opposition, nullity, cancellation for non-use), but colour marks present several important, practical (and evidentiary) differences related to precision of representation, a higher hurdle on distinctiveness/functionality, and extra difficulty proving use or reputation.

The procedural routes are the same as for any other mark. However, single-colour marks and colour combinations must be represented so the scope is clear and reproducible. Spain follows EU practice: a colour should normally be identified with an internationally recognised colour code (e.g. Pantone) and, for combinations, a systematic arrangement must be shown and described. If the representation is vague, the application/registration can be attacked for lack of clarity.

A colour *per se* is often considered non-distinctive for many goods/services unless the applicant can show acquired distinctiveness (secondary meaning) through use in the market (sales figures, advertising, consumer surveys, evidence that the public recognises that colour as indicating commercial origin).

Colours that are necessary to obtain a technical result, give substantial value (purely aesthetic features that competitors must be free to use), or are customary for the type of goods can be refused or invalidated on grounds that they would grant a monopoly over features competitors need. This is a frequent attack ground in nullity proceedings.

Proving continuous use of the exact colour (same shade, same placement) requires photographic evidence, packaging samples, invoices, marketing materials specifying the colour (e.g. Pantone), and sometimes testimony/surveys. Conversely, challengers often win non-use or lack-of-distinctiveness claims by showing inconsistent use (different shades, occasional/ornamental use) that undermines the registered specification.

If the mark claims a colour applied to a part of a product (not the whole shape), courts will check whether the claim is actually a shape mark in disguise or whether the exclusion of contours and precise application is clear. Spanish/EU case law (e.g. Louboutin and related CJEU guidance) has shaped how such claims are assessed.

- **Opposition:** opponents can (and typically will) challenge the application on both relative grounds (earlier marks) and absolute grounds (lack of distinctiveness, descriptiveness, functionality, unclear representation). Because of representation/differentiation issues, early procedural attacks are common.
- **Nullity (absolute grounds):** the usual absolute-grounds tests (distinctiveness, descriptiveness, functionality) are applied strictly to colour marks; evidence of acquired distinctiveness is decisive.
- **Nullity (relative grounds):** same as with other marks, but similarity analysis includes visual perception of colour — so comparison can be technical (shade/arrangement) and subjective (consumer perception).
- **Non-use cancellation:** the 5-year non-use rule applies, but disputes often arise about whether the use shown corresponds exactly to the registered colour scope.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

Spain treats colour marks in digital/virtual contexts under the same legal principles as in the physical world — but with practical, evidentiary and enforcement wrinkles. The EU/OEPM framework (distinctiveness, functionality exclusion, clarity of representation, non-use rules) applies to colour marks used on websites, apps, virtual goods or in VR, and EUIPO guidance explicitly covers virtual goods and services. However, proving use, scope and consumer perception in digital spaces, and policing infringements across platforms requires different evidence and tactics. For both registration (where you claim acquired distinctiveness) and enforcement/non-use proceedings, the type of proof changes when the mark is digital:

- Screenshots / screen recordings showing the colour in the website, app UI, or VR environment (with dates).
- App store pages / download pages that show the colour as part of the branded UI or virtual goods.

- Server logs / deployment records / release notes / git commits demonstrating when a colour scheme or digital asset was first used and continuously deployed.
- Transaction records (NFT sales, receipts for in-app purchases of coloured virtual goods) linking the colour to commercial activity.
- Metadata attached to NFTs or digital assets that includes identifiers tying the colour/asset to the owner/brand.
- Marketing materials / press coverage / analytics showing consumer recognition in the relevant market; consumer surveys targeted at users of the platform/virtual world are often persuasive for acquired distinctiveness.
- Terms of service / licensing agreements for virtual goods that show brand control and commercial exploitation.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

Not disclosed due to privileged client information.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

Filing strategy — how to maximise registrability:

- Use an internationally recognised colour code (Pantone).
- For colour-per-se marks: provide the exact shade and a short description (“The mark consists of the colour Pantone X applied to the entirety of the surface of the goods”).
- For colour combinations: include a systematic arrangement, not just a list of colours (CJEU *Libertel*, *Heidelberger Bauchemie* principles).
- If the colour applies to part of a product (e.g., a stripe on packaging), describe the placement precisely.
- Avoid broad specifications. If the colour is not distinctive for the entire class, limit goods/services.
- Consider secondary filings (logos/figurative marks incorporating the same colour) to support the “family of marks” evidentiary narrative for acquired distinctiveness.

Distinctiveness arguments:

- Market education evidence showing the colour alone has become a badge of origin.
- Long, intensive and geographically broad use in Spain.
- Consistency of shade over time (same Pantone shown in materials).
- Advertising investment specifically associating the colour with the brand (“look for the red packaging”, “the yellow corner logo”, etc.).
- Consumer surveys—still the most persuasive form of acquired distinctiveness evidence.
- Independent trade evidence: distributors or retailers confirming that they recognize the

colour as designating the brand.

- Media references affirming that a brand is known by a colour.

Evidence:

- Dated packaging samples showing real-world use.
- High-resolution photographs of goods in Spanish physical retail environments.
- Invoices + catalogues linking the colour to the marketed goods.
- Official marketing plans or advertising spend tied specifically to the colour.
- Consumer perception surveys.
- Statements from trade associations or key distributors.
- For digital use: timestamped screenshots, analytics, app stores, server logs demonstrating continuous use of the colour in the UI or digital goods.

Enforcement strategy (infringement or unfair competition):

- Courts in Spain apply the same EU standards: infringement depends heavily on consumer perception of colour as an indicator of origin.
- Successful enforcement typically requires:
 - Strong acquired distinctiveness evidence.
 - Distinctive placement (e.g., colour used in a specific location on packaging).
 - Demonstrating likelihood of association, not only confusion.
- Consider parallel actions under Unfair Competition Law (Ley de Competencia Desleal) when the competitor uses a nearly identical colour scheme that evokes your well-known trade dress, even if trademark distinctiveness is arguable.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Colour marks can co-exist, but only under specific market conditions:

- Marks use different shades, even within the same colour family.
- The colour is applied to different parts of the product (e.g., full-surface vs accent stripe).
- The goods/services are not closely related, reducing risk of confusion.
- One of the marks is part of a more complex sign (figurative/word + colour), reducing overlap.

Co-existence is unlikely when:

- The earlier mark has acquired strong distinctiveness in a specific shade for specific goods.
- The market norm is monochromatic branding (e.g., telecoms, energy drinks, home care products) slight changes in shade may still evoke association.
- Both marks claim colour-per-se, without shape or figurative elements, for identical goods.

Co-existence of Colour Trade Marks in Spain; practical insights:

The co-existence analysis for colours is closer to trade dress assessment than standard trademark comparison. Courts look carefully at:

- Overall market context,
- Sector colour conventions, and
- Consumer habits in perceiving colour as origin.

- c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No additional fees apply.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

Spain does not recognize this concept.

UNITED KINGDOM

Contributor: Ms. Laurie Bray of Withers & Rogers LLP

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Single colours and colour combinations are both, in principle, registrable as trade marks in the United Kingdom. They are specifically mentioned under Section 1(1) of the Trade Marks Act 1994, which provides that:

“trade mark” means any sign which is capable—

- (a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and
- (b) of distinguishing goods or services of one undertaking from those of other undertakings”.

A trade mark may, in particular, consist of [...] **colours** [...].

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

A mark consisting of colour alone will be considered to be appropriately represented if it is filed with a sample of the colour, together with a written description of the colour (e.g. ‘dark blue’), and it is accompanied by the relevant code from an internationally recognised colour identification system, e.g. Pantone®, RAL or Focoltone®.

Alternative ways of representing colour marks may be accepted, as long as they satisfy the criteria of being clear, precise, self-contained, easily accessible, intelligible, durable and objective.

For marks consisting of a combination of colours in the abstract, without contours, the representation must also include a systematic arrangement associating the colours in a predetermined and uniform way. The UKIPO does not have specific requirements as to how this should be represented, but a sample of the colours, together with a written description and relevant codes from an internationally recognised colour identification system, would be

appropriate. Written descriptions should categorically define how the colours are arranged/used. The description “as shown on the form of application” is no longer acceptable.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

Evidence of distinctiveness is not a formal requirement but, in practice, may be needed, since many colour mark applications encounter objection on the grounds of inherent non-distinctiveness.

The UKIPO will look for evidence demonstrating more than mere recognition/association between the mark and the goods; the evidence must demonstrate that the colour (as opposed to any other mark which might also be present) acts as a badge of origin. In practice, such evidence may include survey evidence, and it should be noted that the UK has very specific requirements when it comes to survey evidence. Evidence showing the colour used is unique in the relevant marketplace and witness statements from independent third parties may also be considered persuasive. Evidence of general use of the mark, such as sales figures, marketing spend, market share and promotional materials, may be filed in support of the application, but may not be considered sufficient in itself to show that the colour alone acts as an indication of origin.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

UK Registration No. UK00004178460



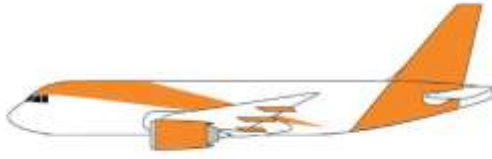
Mark Description/Limitation:

The colour yellow, being the Pantone Colour Code 7408C, applied to the whole of a teat cup component of a milking machine.

Goods:

Class 7 - Milking machines; automated milking machines and installations; milking installations for automatic milk extraction and suctioning; milking machine teat cups.

UK Registration No. UK00004167036

**Mark Description/Limitation:**

The trade mark applied for consists of the colours orange (Pantone 021C) and white (Pantone 000C) applied as shown to the aircraft. The orange and white colours are applied as shown to the fuselage, wings, engines, flap track fairings and tail of the aircraft. The contours and outlines of the aircraft are not part of the position mark and serve only to indicate the exact context and application of the claimed position mark.

Services:

Class 39 - Transportation of passengers, travellers by air; airline services.

UK Registration No. UK00004079319

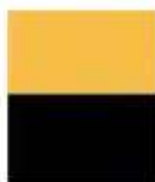
**Mark Description/Limitation:**

The mark consists of the colours "Razzmatazz Red (HEX FE2C55), Splash Blue (HEX 25F4EE), Black (HEX 000000)" in the arrangement/position depicted in the pictorial representation of the mark.

Goods/Services:

Various in Classes 9, 35, 38, 41, 42 & 45

UK Registration No. UK00003920024

**Mark Description/Limitation:**

The colour yellow (HEX #FEBD17) is applied to the top of the housing of the battery and the colour black (HEX #000000) is applied to the bottom of the housing of the battery.

Goods:

Class 9 – Batteries for power tools.

UK Registration No. UK00003839313**Mark Description/Limitation:**

The mark consists of the sequence of the following colours: yellow [PANTONE 10117C], orange [PANTONE 10147C], pale pink [PANTONE 10166], fuchsia [PANTONE 10176C], purple [PANTONE 10213C], blue [PANTONE 10249C], teal [PANTONE 10273C] and green [PANTONE 10289 C].

Goods/Services:

Various in Classes 9, 14, 18 and 25

UK Registration No. UK00003600158**Mark Description/Limitation:**

The trademark contains the colours Pantone green 348 C and Pantone gold 130 C presented within a circle. The distribution and ratio of the width of the colours from left to right is green 35%, gold 30%, green 35%, whereby the gold strip runs horizontally between the surrounding green areas, these colours being applied to the whole visible circular surface area of the top of the bottled beverage products included in the specification, as depicted in the illustrative representation attached to the application.

Goods: Beverages in Classes 29 & 30

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The governing statute is the UK Trade Marks Act 1994 which, as noted above, states that trade marks may consist of colours. There are no other provisions in the Act relating specifically to colours, but all of the provisions in the Act relating to registration of trade marks generally apply to colour trade marks, including that the sign must be capable “of distinguishing goods or services of one undertaking from those of other undertakings.

EU case law predating Brexit remains applicable to UK trade mark proceedings (unless/until UK trade mark legislation is amended, in which case the extent to which EU case law remains applicable will depend on the amendment). Thus, various well-known EU cases remain relevant,

at least as at the current date. These cases include *Libertel*, which established that single colours are capable of acting as trade marks and can be registered provided that they are defined in a sufficiently clear manner; *Sieckmann*, which established the criteria that colour marks must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”; *Heidelberger Bauchemie*, which established that applications for two or more colours, designated in the abstract, must be systematically arranged by associating the colours in a predetermined and uniform way; and *Red Bull*, which highlighted the difficulty in defining the precise arrangement of colour combinations, and the fact that applications must not allow for numerous different arrangements.

In terms of UK case law specifically, in 2022, following opposition by Nestlé based on absolute grounds, the High Court issued a decision allowing Cadbury (the British confectionery company) to register two out of three applications for the colour purple. The applications which were allowed consisted of:

- (1) “The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface of the packaging of the goods”; and
- (2) “The colour purple (Pantone 2865C), as shown on the form of application”.

The application which was refused consisted of:

- (3) “The colour purple (Pantone 2685C), as shown on the form of application, applied to the packaging of the goods”.
- (1) and (2) were considered to be sufficiently clear in their descriptions, but the description of (3) was deemed unclear on the basis that it allowed the mark to assume many different forms. The same issue did not apply to (2), because it was considered to be a ‘colour per se’ mark and therefore a multiplicity of forms argument would not apply, because the colour per se would not change in different contexts.

In an earlier case dating from 2017, both the UK High Court and Court of Appeal ruled on a registration owned by Glaxo Smith Kline, of a mark comprising two specific shades of purple, one “applied to a significant proportion of an inhaler” and the other “applied to the remainder of the inhaler”. The registration was held to be invalid because it covered a multitude of different forms. Although the registration included a pictorial representation, this did not provide sufficient clarity as to how the mark would be applied to the goods. Glaxo Smith Kline has, however, successfully registered other colour trade marks in the UK, including a specific shade of purple as a colour per se, based on acquired distinctiveness, and a combination of specific shades of purple together with a sufficiently clear and precise description/pictorial representation.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

The UKIPO does not provide guidance on the scope of protection of colour trade mark registrations. Nevertheless, the standard provisions apply, i.e. protection does extend to similar marks (in relation to identical/similar goods/services) if there is a likelihood of confusion. In practice, similarity and likelihood of confusion between colour marks remains untested in the UK courts, and it is therefore difficult to say just how far the scope of protection of a colour mark would reach. The perception of the relevant consumer will be the key factor in determining

whether the marks are sufficiently similar to give rise to a likelihood of confusion, whether they are accustomed to perceiving colours as trade marks in the relevant marketplace, as well as the level of distinctiveness of the colour mark in question.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

UK colour trade mark applications/registrations may be opposed, invalidated or cancelled via the trade mark office, i.e. the UKIPO. There are no unique considerations for opposing/invalidating/cancelling colour trade marks compared to other types of trade marks.

Proceedings based on relative grounds (earlier rights) must be brought by the earlier rights holder. Opposition/invalidity proceedings may also be based on absolute (inherent) grounds, and these can be filed by any interested third party, as can non-use revocation actions.

5. Use of Color Trade Marks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

There are no specific guidelines or precedents for protecting colours in digital or virtual contexts. They are treated in the same way as other trade marks.

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

We are not aware of any such cases having been decided in the UK based on registered colour trade marks.

Following the invalidation of Glaxo Smith Kline's purple inhaler registration (as discussed above at 3(a)), Glaxo's case continued as a passing off action against pharmaceutical company Sandoz (i.e. based on unregistered rights in the colours). The High Court dismissed the action, finding that the evidence was deemed insufficient to prove goodwill and that patients viewed the colour purple merely as indicating an inhaler with a particular purpose/active ingredient.

7. Strategies for Managing Colour Trade Mark Applications

a) What strategies would you recommend for successfully filing, opposing, defending

or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

In terms of filing, getting the mark description right is key in the first instance, particularly where the mark is not for a colour ‘per se’. Ensure that the description is precise and does not allow for a multiplicity of forms (e.g. the colour being applied ‘predominantly’ or to ‘more than 50%’ of a product).

In the event of a distinctiveness objection, evidence of acquired distinctiveness will need to show not only significant use of the mark, but that the colour (as opposed to any other mark) is perceived by consumers as an indication of origin. This may entail the commissioning of consumer surveys, and care must be taken as the UK has strict requirements regarding survey contents and methods.

As noted above, oppositions against colour marks based on relative grounds (i.e. earlier rights) are untested in the UK, as are enforcement actions. In both cases, evidence of actual consumer confusion is likely to be particularly useful, if available.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

The number of UK colour trade mark registrations is comparatively low and it is therefore difficult to draw any particular conclusions at this time with regard to co-existence.

Where a colour is used by a number of different competitors in a particular field, this is likely to render the mark non-distinctive.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

There is no specific recognition of the concept of colour depletion by the trade mark office or the courts. The concept has been touched upon in an academic context but not to a notable degree.

9. About the Contributor for the United Kingdom section



Laurie Bray is a Senior Associate at Withers & Rogers with over 15 years’ experience in all aspects of trade mark clearance, protection, prosecution and enforcement.

UNITED STATES OF AMERICA

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Yes, it is possible to register a color trademark in the United States. Color marks are marks that consist solely of one or more colors. A mark that includes a color merely as a component, for example, a logo mark with color claimed as a feature, is not a color mark.

Color, whether a single overall color or multiple colors applied in a specific and arbitrary fashion, is usually perceived as an ornamental feature of the goods or services that fails to function as a mark unless it serves as a source identifier and is non-functional. Proposed color marks that are functional or generic are not registrable.

The U.S. Supreme Court in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (U.S. Cal., 1995) confirmed that a single color alone can meet the statutory definition of a trademark, provided it is not functional and has acquired distinctiveness. The registrability of a color mark depends on the manner in which the proposed mark is used. Trademark Manual for Examining Procedure (TMEP) §1202.05. A color(s) takes on the characteristics of the object or surface to which it is applied, and the commercial impression of a color will change accordingly. *Id.*

Single-color marks are *never inherently distinctive* and require proof of acquired distinctiveness under §2(f) of the Lanham Act. See a U.S. Supreme Court case, *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (U.S., 2000). Multi-color marks, particularly when applied to product packaging, may in limited circumstances be inherently distinctive, depending on the character and arrangement of the design. See a U.S. Federal Circuit case, *In re Forney Indus., Inc.*, 955 F.3d 940 (Fed. Cir. 2020).

Color marks are generally treated as a subset of trade dress and may take various forms, including an overall color, a color applied to part of a product or its packaging, a combination of

colors, or, in some instances, gradations or patterns. Registrability is contingent upon non-functionality, non-genericness, and, except in limited cases, acquired distinctiveness.

2. Application Requirements For A Color Trademark

b) What specific requirements must accompany an application for a color Trademark (e.g., color codes such as Pantone, graphical representation, or description)?

The unusual format of color marks often requires extra attention when preparing and submitting an application for registration. An overview of the requirements for applications for color trademarks is below.

Drawing Requirement

- A color mark requires a color drawing.
- Applications without a drawing are denied a filing date. An application for a color mark with a proposed drawing page that states "no drawing," or sets forth only a written description of the mark, will be denied a filing date.
- For drawings of color marks in trademark applications, in most cases, the proposed color mark drawing will consist of a representation of the product or product package. The drawing must be a substantially exact representation of the mark as used, or intended to be used, on the goods.
- The product or packaging shape must appear in broken/dotted lines (if not claimed). In the absence of a broken-line drawing, the USPTO will assume that the proposed mark is a composite mark consisting of the product shape, or the product package shape, in a particular color.
- For drawings of color marks in service mark applications, the drawing must display the manner in which the mark is used in connection with the services.

See TMEP §§1202.05(d) and 807.07–807.07(g) for color mark drawings.

Color Claim

A statement that the color(s) is a feature of the mark.

Description of the Mark

A clear and specific written description:

- Identify the color(s) using ordinary language, including if the applicant is claiming a shade of color (e.g., "maroon," "turquoise", "navy blue").
- Describe where and how the color appears.
- Identify any gradations if applicable.

See TMEP §§1202.05(e) and 808–808.03(f) for description of the mark.

Pantone or other color codes are not mandatory but are often included for precision.

Specimen

An applicant who applies to register a color mark must submit a specimen showing use of the color, either with a §1(a) actual use base application or with an allegation of use (i.e., either an amendment to allege use under Title 15 of the United States Code (U.S.C.) (the Lanham Act (Trademark Act of 1946)) §1051(c) or a statement of use under 15 U.S.C. §1051(d)), in a §1(b)

intent-to-use application. TMEP §1202.05(f).

- The specimen must show the color as used in commerce.
- Black-and-white specimens are unacceptable.
- For goods: color may be used on the entire surface of the goods, on a portion of the goods, or on all or part of the packaging for the goods. TMEP §1202.05.
- For services: materials showing the color used in rendering or advertising the services.

See TMEP §§904.03–904.07(b) regarding trademark specimens and 1301.04–1301.04(d) regarding service mark specimens.

Distinctiveness Requirements

c) [Is Evidence of distinctiveness required during prosecution of a color Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?](#)

Yes. Because color marks are generally not inherently distinctive, proof of acquired distinctiveness under §2(f) of the Lanham Act is usually required. The burden of proving acquired distinctiveness is substantial. See *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985).

Typical forms of evidence include the length and exclusivity of use, sales figures and market share, advertising expenditures, “look-for” advertising campaigns (e.g., “Look for the pink insulation” for the Owens Corning insulation pads), consumer declarations, survey evidence, and media coverage. Consumer surveys are particularly persuasive. For example, in *T-Mobile US, Inc. v. Aio Wireless LLC*, 991 F. Supp. 2d 888 (S.D. Tex. 2014), the court credited survey evidence showing over 50% consumer association between magenta and T-Mobile. Mere long use is insufficient without evidence of consumer perception.

Showing any use of a color trademark in advertising promotes the trademark's association with the goods or services at issue, such as a tagline that advises consumers to look for a particular color or recognize the applicant's goods by their color. However, the applicant should make sure any advertising examples do not highlight functional aspects of the mark.

Functionality Refusal

A color mark is not registrable on the Principal Register under the Lanham Act §2(f), or the Supplemental Register, if the color or colors are functional. A color may be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. A color may also be functional if it is more economical to manufacture or use. For example, a color may be a natural by-product of the manufacturing process for the goods. In such a case, appropriation of the color by a single party would place others at a competitive disadvantage by requiring them to alter the manufacturing process.

The doctrine of “aesthetic functionality” may apply in some cases where the evidence indicates that the color at issue provides specific competitive advantages that, while not necessarily categorized as purely “utilitarian” in nature, nevertheless dictate that the color remains in the public domain.

If the record indicates that the proposed mark is functional, the examining attorney should issue a refusal of registration on the Principal Register under §2(f), or on the Supplemental Register. See TMEP §1202.05(i). However, a mark in a Madrid-based §66(a) application cannot be registered on the Supplemental Register under any circumstances. 15 U.S.C. §1141h(a)(4); Title 37 of the Code of Federal Regulations (C.F.R.) §§2.47(c), 2.75(c).

Generic Refusal

A color mark is not registrable on the Principal Register under §2(f) or on the Supplemental Register, if the color or colors are generic. A color may be generic when it is incapable of functioning as an indicator of source because it is understood by the relevant public primarily as a category or type of trade dress.

See TMEP §1202.05(b) regarding when a proposed color mark is functional or generic.

3. Examples of Registered Color Trademarks

Please provide examples of Color Trade Marks (single colors or color combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Color Trade Mark Registration.

Notable examples include:

- Tiffany Blue – jewelry (Class 003, 008, 014, 016, 018, 020, 021, 025, 028, 035) (Registration No. 2184128)
- Pullman Brown (UPS trucks and uniforms) – Transportation services (Class 039) (Registration Nos. 2131693, 2159865, 2901090)
- Red sole for high-end footwear (Louboutin) - footwear (Class 025) (Registration No. 3361597)
- Blue turf – Stadium artificial turf (Class 041) (Registration No. 3707623)
- Magenta (T-Mobile) - telecommunications services (Class 038) (Registration No. 3263625 on Supplemental Register)
- Yellow motor housing (fans) – Electric fans (Class 011) (Registration No. 5845676)
- Red cap on packaging – Scent-reducing products (Class 028) (Registration No. 6393737)

4. Legal Framework for Color Trade Marks

a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Color Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Color Trade Marks are dealt with.

Primary Statutory Framework: Lanham Act §§1, 2, 45 (15 U.S.C. §§1051, 1052, 1127)

- §2(f) – Acquired distinctiveness
- §2(e)(5) – Functionality doctrine

Primary USPTO Guidance: TMEP §1202.05 (Color as a Mark), §807 (Drawings), §1212 (Acquired

Distinctiveness)

Landmark Case Examples:

- *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985). The Federal Circuit reversed the USPTO's refusal to register the applicant's pink color mark for fiberglass insulation. The court found that the color was not functional as applied to the goods and had acquired sufficient secondary meaning as a trademark.
- *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (U.S. Cal., 1995). The U.S. Supreme Court held that a single color, standing alone, may qualify for trademark registration. In an infringement dispute between competing manufacturers of dry-cleaning press pads, the Court determined that the plaintiff could claim trademark rights in the green-gold color of its product. Because the color was non-functional and had acquired secondary meaning in the marketplace, it was entitled to protection under trademark law.
- *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (U.S., 2000). The U.S. Supreme Court held that product design trade dress can never be inherently distinctive and is protectable only upon proof of acquired distinctiveness (secondary meaning). The Court distinguished product design from packaging, emphasizing that consumers are less likely to perceive product design features as source identifiers absent secondary meaning.
- *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012). Relying on *Qualitex*, the United States Court of Appeals for the Second Circuit overturned the district court's categorical conclusion that a single color can never function as a protectable trademark in the fashion industry. The court further held that Christian Louboutin S.A. had established secondary meaning—albeit in a limited scope—in its red lacquered outsole for women's high-fashion footwear. Accordingly, the red sole was entitled to trademark protection, but only insofar as it appeared in contrast with a different color on the remainder of the shoe.
- *In re Forney Indus., Inc.*, 955 F.3d 940 (Fed. Cir. 2020). The United States Court of Appeals for the Federal Circuit set aside the Trademark Trial and Appeal Board (TTAB)'s decision upholding the refusal to register a multi-color product packaging mark and remanded the matter for further consideration of whether the mark was inherently distinctive. In its analysis, the court expressly recognized that certain color marks applied to product packaging may, in appropriate circumstances, possess inherent distinctiveness. At the same time, the opinion suggested that inherent distinctiveness is more plausibly found in multi-color packaging configurations, as opposed to single-color marks.
- *In re Florists' Transworld Delivery, Inc.*, 119 USPQ2d 1056 (TTAB 2016). The TTAB upheld the refusal to register a black color mark for floral packaging, concluding that the proposed mark was aesthetically functional. The Board determined that competitors have a legitimate need to use the color black to evoke notions of elegance and luxury in the floral industry, and that exclusive rights would place them at a significant competitive disadvantage.
- *In re PT Medisafe Technologies*, 134 F.4th 1368 (C.A.Fed., 2025). The Federal Circuit affirmed the TTAB's refusal to register the color teal for specified medical devices based

on an existing registration covering the color blue for related goods. The Federal Circuit held that the appropriate test for assessing whether a color mark is generic is a two-step inquiry considering: (i) the genus of goods or services at issue, and (ii) whether the color sought to be registered is understood by the relevant public primarily as a category or type of trade dress for that genus of goods or services.

- b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Color Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

Protection generally extends beyond an exact Pantone shade and may encompass confusingly similar shades. The scope depends on how narrowly the mark is described, evidence of consumer perception, competitive need, and functionality concerns. For example, in *In re Cook Medical Technologies, LLC*, 105 USPQ2d 1377 (TTAB 2012), the Trademark Trial and Appeal Board treated “blue” broadly enough to encompass teal. When describing the mark narrowly, applicants may face challenges proving that similar shades would also cause confusion.

Courts have noted that context matters: the same color may be protectable in one product category but not in another if it is generic or functional.

5. Opposition and Invalidation Procedures for Color Trademarks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Color Trade Mark in your jurisdiction. Are there any unique considerations for Color Trade Marks compared to other types of Trade Marks?

Oppositions and cancellations are heard before the Trademark Trial and Appeal Board (TTAB), while infringement and declaratory actions proceed in federal courts.

Unique considerations:

- Heavy reliance on expert testimony and surveys.
- Functionality defenses are common.
- Greater evidentiary burden for demonstrating distinctiveness.
- Expert testimony on color perception and consumer psychology is more common for color marks than for standard word or logo marks.
- Evidence that the color is widely used in the industry may form a central argument for cancellation.

6. Use of Color Trademarks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Color Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

U.S. law applies standard trademark principles in digital and virtual contexts. Color marks used in websites, mobile applications, and virtual environments are evaluated for source

identification, distinctiveness, and non-functionality. Variability in digital displays does not undermine protection if consumer association is established, as recognized in *T-Mobile US, Inc. v. Aio Wireless, LLC*.

7. Enforcement of Color Trademarks

Please provide examples of cases in your jurisdiction where registered Color Trademarks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

- *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012)

The United States Court of Appeals for the Second Circuit held that Louboutin's red lacquered outsole had acquired secondary meaning and was enforceable as a trademark, but only when used in contrast with a differently colored upper. Enforcement was therefore successful in part and unsuccessful in part: the court limited the scope of protection and permitted Yves Saint Laurent's monochromatic red shoe, finding no infringement because the protected mark was confined to contrasting designs. The outcome turned on (i) proof of acquired distinctiveness in the relevant high-fashion market, (ii) the precise articulation of the mark's scope, and (iii) functionality and competitive concerns, which led the court to narrowly tailor protection rather than grant exclusivity over all uses of red on shoe soles.

- *T-Mobile US, Inc. v. Aio Wireless LLC*, 991 F. Supp. 2d 888 (S.D. Tex. 2014)

The United States District Court for the Southern District of Texas granted injunctive relief enforcing T-Mobile's magenta color mark for telecommunications services. The court found that the magenta shade had acquired strong secondary meaning, supported by survey evidence showing substantial consumer association, and that Aio's use of a similar shade created a likelihood of confusion. The decisive factors included robust survey evidence, extensive and consistent "look-for" advertising, significant market presence, and the absence of functional necessity for competitors to use the specific magenta hue in the telecommunications sector.

- *In re Florists' Transworld Delivery, Inc.*, 119 USPQ2d 1056 (TTAB 2016)

The TTAB affirmed the refusal to register the color black as applied to floral packaging, concluding that the proposed mark was aesthetically functional. The Board determined that black conveys elegance and luxury in the floral industry and that granting exclusive rights would place competitors at a significant disadvantage. The outcome turned primarily on aesthetic functionality and competitive need, rather than on a lack of use; even if distinctiveness could be shown, the functional character of the color in that market precluded registration.

8. Strategies for Managing Color Trademark Applications

a) What strategies would you recommend for successfully filing, opposing, defending

or enforcing a Color Trade Mark Application in your jurisdiction?

Applicants are advised to develop “look-for” advertising, ensure consistent shade application, commission methodologically sound surveys, avoid claiming abstract color in the abstract, and anticipate functionality challenges. Documenting consistent brand use over time across multiple media strengthens the acquired distinctiveness argument.

Opponents should provide industry evidence of common color use, demonstrate utilitarian or aesthetic functionality, challenge survey methodology, and argue genericness where applicable.

For defense, gathering evidence of competitor reliance on functional use of the color can preempt infringement claims.

Enforcing a color trademark can be difficult. For example, there are inherent challenges in searching color trademarks that make it more difficult to monitor infringement of the trademark. There are also few successful precedents to provide guidance. In addition, specific elements of enforcement actions may be harder to prove. For example, the similarity between trademarks may be harder to show because there is little developed legal precedent.

b) Can you provide any insights as to the co-existence of Color Trade Marks in your jurisdiction.

Coexistence is possible where colors differ sufficiently, the industries do not overlap, and where consumer confusion is unlikely.

c) Are there additional fees for Registration and Renewal of Color Trade Marks in your jurisdiction?

There are no special additional USPTO filing or renewal fees specifically for color marks. Standard filing and maintenance fees apply.

9. Color Depletion

Due to the Registration of Color Trade Marks, fewer colors remain available for use by businesses. Does your jurisdiction recognize the concept of “color depletion”? If so, how.

U.S. law does not formally recognize “color depletion” as a standalone doctrine. The Supreme Court in *Qualitex Co. v. Jacobson Products Co.* rejected a categorical color depletion rule but acknowledged competitive concerns, which are addressed via the functionality doctrine, aesthetic functionality, genericness, and the requirement for strict acquired distinctiveness.

10. About the Contributors for the section on the United States of America



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Makiko Coffland and **Kelsey Coplan** are intellectual property attorneys at Christensen O'Connor Johnson Kindness (COJK), a full-service boutique IP firm assisting domestic and international clients to protect, defend, and enforce their valuable IP assets. Makiko Coffland is a member at COJK with experience across the full spectrum of IP law. She focuses her practice on trademark law, advising U.S. and foreign clients on building and enforcing trademark portfolios to protect brands worldwide. She also specializes in pharmaceutical trademarks, assisting life sciences companies protect brands in this highly regulated industry. Kelsey Coplan is an associate in the firm's trademark practice group, where she focuses her practice in the development, maintenance, enforcement, and licensing of national and international trademark portfolios. She also advises clients on copyright related matters.

VENEZUELA

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1. Legal Recognition and Protection of Colour Trade Marks

- a) How are single colours or colour combinations protected as Trade Marks in your jurisdiction? Is it possible to register a “Colour Trade Mark” (e.g., a specific shade like Tiffany Blue, Cadbury’s Purple, Louboutin Red Sole, a combination of colours, or a gradient of colours) in your country?

Under the Venezuelan Industrial Property Law, trademarks are defined in broad terms (any sign, figure, drawing, word or other sign that is novel and capable of distinguishing goods or businesses). However, Article 33(6) expressly excludes from registration “the shape and colour given to goods by the manufacturer, as well as colours or combinations of colours by themselves”.

As a result, **single colours and combinations of colours “per se” cannot be registered as trademarks in Venezuela**. This means that pure “colour marks” (e.g. Tiffany Blue, Cadbury’s purple, or a bare red colour for shoe soles) are, in principle, not registrable as such.

Nevertheless, **figurative or composite marks that incorporate colours** (for example, a logo or label with a specific colour scheme, including gradients) **may be registered**, provided they meet the general requirements of distinctiveness and novelty. In such cases, colours are protected as part of the overall figurative or mixed sign, not as an abstract colour mark.

- b) What specific requirements must accompany an application for a colour Trade Mark (e.g., colour codes such as Pantone, graphical representation, or description)?

Under Venezuelan law, “single colours” or “combinations of colours by themselves” **cannot be registered as trademarks** (Article 33(6) of the Industrial Property Law). Therefore, a “colour mark per se” is not admissible.

However, **when colours form part of a figurative or composite mark**, the application must include:

1. **A clear graphical representation** (the facsimile of the figurative/mixed mark).
2. **A detailed description of the sign**, expressly indicating the colours that appear in the mark.
3. **Precise identification of the colour shades**, typically by reference to a **recognized colour system (e.g., Pantone)**—this is not mandated by statute but is **required in practice** to ensure clarity and precision.

In summary, although a colour alone cannot be registered as a trademark, **any figurative or mixed mark incorporating colours must be represented graphically and described with sufficient precision**, including specification of colour codes when necessary for clarity.

- c) Is Evidence of distinctiveness required during prosecution of a colour Trade Mark Application at the Trade Mark Office, such as proof of acquired distinctiveness through Use? If so, what type of Evidence of distinctiveness is typically accepted?

There is **no explicit requirement before the Venezuelan Patent and Trademarks Office (SAPI) to submit evidence of acquired distinctiveness (proof of use, consumer recognition) when registering a figurative or mixed mark that includes colours**. The formal requirements are limited to graphical representation, detailed description (including colours), classification, and standard formalities. Therefore, while “colour-only” marks remain unregistrable under Article 33.6 LPI, a composite mark with colours may be registered without demonstration of distinctiveness acquired through use.

Acquired Distinctiveness claims are not regulated nor supported in our statutory regulations.

2. Examples of Registered Colour Trade Marks

Please provide examples of Colour Trade Marks (single colours or colour combinations) that have been successfully registered in your jurisdiction. Please include the Classes of the Goods and/or Services of the Colour Trade Mark Registration.

Under Venezuelan Industrial Property Law, **single colours and combinations of colours “by themselves” cannot be registered as trade marks** (Article 33(6) of the Industrial Property Law).

As a result, **there are no registered “Colour Trade Marks” in Venezuela** — neither single-colour marks (e.g., Tiffany Blue, Cadbury Purple) nor colour-combination marks as standalone colour signs.

Therefore, **no examples of registered Colour Trade Marks (single or combination) exist in Venezuela**, and **no Nice Classes can be associated** with such registrations because the legal system does not recognize this category of trade mark.

3. Legal Framework for Colour Trade Marks

- a) Please identify the relevant Statutes, Regulations, or Case Law in your jurisdiction that govern the registration and protection of Colour Trade Marks. If relevant, are there any notable cases illustrating the boundaries of this protection? If applicable, please highlight any landmark cases that have shaped how Colour Trade Marks are dealt with.

The protection and registrability of trade marks in Venezuela is governed primarily by the Industrial Property Law (Ley de Propiedad Industrial, 1955). This statute expressly prohibits the registration of single colours or combinations of colours “by themselves.”

Relevant Statutory Provision:

- Industrial Property Law (1955), Article 33(6):

Prohibits the registration of “the shape and colour given to goods by the manufacturer, as well as colours or combinations of colours by themselves.”

This statutory prohibition means that Venezuela does not recognise “Colour Trade Marks” as a standalone category, and therefore such signs cannot be registered in the same manner as in jurisdictions that accept non-traditional marks.

Regulations / Administrative Practice:

The Venezuelan Patent and Trademarks Office (SAPI) only allows figurative or composite marks that include colours as part of a graphical representation. These are registered as figurative marks, not as colour marks.

Case Law:

Venezuela does not have publicly accessible case law or administrative precedents recognising or analysing “colour marks,” because colour-per-se marks are legally inadmissible under Article 33(6). As a result, there are:

- No landmark decisions,
- No boundary-defining cases, and
- No jurisprudence shaping the treatment of colour marks,

since the statutory prohibition prevents such claims from reaching the stage where judicial interpretation would be required.

Conclusion:

In Venezuela, the governing statute categorically bars the registration of colour trade marks. The legal framework has therefore not generated case law on colour marks, and all protection related to colour must instead occur through figurative marks, packaging/trade dress, or unfair competition principles, not through colour marks as such.

b) If applicable, please outline any guidance provided by the Trade Mark Office and/or Courts in your jurisdiction on the scope of protection of Colour Trade Mark Registrations (e.g., does protection extend to similar shades or only the exact colour specified (Pantone code)?

Because Venezuelan law **does not permit the registration of colour marks “per se”** (Industrial Property Law, Article 33(6)), the Venezuelan Patent and Trade Marks Office (SAPI) has issued **no guidance, criteria, or case law** regarding the substantive scope of protection of colour marks.

As a result:

- There is **no doctrine** on whether protection would extend to **similar shades**,
 - No guidance on whether protection would cover **only the exact colour specified (e.g., Pantone code)**,
- And **no judicial or administrative interpretation** addressing likelihood of confusion involving colour-only signs.

In Venezuela, colours can only be protected as **elements of a figurative or composite mark**, and in that context:

- The protection extends to the **overall figurative sign**, not to the colour as an independent right.
- SAPI has **not** issued rules stating that a Pantone code or precise shade would receive standalone protection.
- Any enforcement would therefore rely on the **general assessment of similarity of figurative**

marks, not on colour as a protected feature per se.

Conclusion:

Venezuela provides **no specific guidance** on the scope of protection of Colour Trade Marks because such marks cannot be registered at all. Any analysis of colour similarity occurs only as part of the comparison of **figurative/mixed marks** and not as a distinct colour-based right.

4. Opposition and Invalidation Procedures for Colour Trade Marks

Please describe the forum (e.g., Trade Mark Office, Court) and procedures for opposing, invalidating, or canceling a Registered Colour Trade Mark in your jurisdiction. Are there any unique considerations for Colour Trade Marks compared to other types of Trade Marks?

Because Venezuelan law does not allow the registration of single colours or combinations of colours “by themselves” (Industrial Property Law, Art. 33(6)), there are no “Registered Colour Trade Marks” in Venezuela.

As a result, the opposition, invalidation, or cancellation of colour-per-se marks is procedurally inapplicable. Any attempted filing of a colour-only sign would be refused ex officio by the Venezuelan Patent and Trade Marks Office (SAPI) on absolute-grounds inadmissibility, preventing it from ever reaching registration or being subject to post-grant challenges.

Any party can oppose a published trademark application that petitions trademark rights over a color or combination of colors “by themselves or themselves” as part of the claim. In Venezuela there is no specific limitation to oppose a published trademark, no legitimate interest has to be shown and absolute grounds for refusal can be claimed against the contested application.

Forum for Opposition / Invalidation (General Trademark Procedure):

- Opposition: Venezuelan Patent and Trade Marks Office (SAPI) (Administrative Agency level) — applies only to marks that are admitted for publication. Colour marks should not reach this stage because they fail at the formalities examination phase.
- Invalidation / Cancellation:
 - Venezuelan Patent and Trade Marks Office (SAPI) (administrative nullity based on absolute grounds), or
 - Administrative Courts (Contentious Administrative Jurisdiction) if judicial review is sought.

These mechanisms apply only to registered marks.

Unique considerations for Colour Trade Marks:

- The only “unique” consideration in Venezuela is the statutory prohibition itself, which removes colour marks entirely from the system.
- There are no special procedures, no extended standing, no evidentiary rules, and no case law dealing with the cancellation or invalidation of colour-*per-se* signs, because such marks cannot exist as registered rights.

Conclusion:

In Venezuela, colour marks cannot be registered; therefore, they cannot be opposed, invalidated, or cancelled. Any challenge involving colour arises only in the context of figurative or composite marks that include colours, which follow ordinary trademark procedures and do not receive any special or colour-specific treatment.

5. Use of Color Trademarks in Digital and Virtual Environments

How does your jurisdiction address the registration and enforcement of Colour Trade Marks in digital or virtual contexts, such as website designs, mobile applications, or virtual reality environments? Are there specific guidelines or precedents for protecting colors in these emerging spaces or are they treated in the same way as other Trade Marks?

Venezuelan law does **not** recognize Colour Trade Marks as registrable signs, due to the prohibition in Article 33(6) of the Industrial Property Law. This prohibition applies **regardless of the medium**, meaning that Venezuela does **not** provide a distinct legal regime for colour marks in digital environments such as websites, mobile applications, software interfaces, or virtual-reality platforms.

Registration:

- Because colours “by themselves” cannot be registered in Venezuela, **digital or virtual uses of colour cannot be protected as Colour Trade Marks**.
- Only **figurative or composite marks** that incorporate colour as part of a graphic sign (e.g., logos used in apps or websites) can be filed, and they follow ordinary trademark rules—no special treatment for digital contexts.

Enforcement:

- Enforcement in digital/virtual environments is conducted under the **same principles** that apply offline: comparison of **figurative or mixed marks**, assessment of likelihood of confusion, and general unfair-competition rules.
- There are **no special guidelines, regulations, or precedents** addressing colour protection in websites, UI/UX designs, metaverse assets, or virtual goods.

Precedents or guidance:

- There are **no published cases or administrative decisions** in Venezuela discussing colour protection in digital environments.
- No SAPI guidance exists regarding protection of Pantone codes, digital palettes, gradients, or colour-based branding in virtual spaces.
- As a consequence of the statutory prohibition, **colour-only claims cannot be asserted**, and therefore no enforcement precedents have developed in online or virtual contexts.

Conclusion:

In Venezuela, digital and virtual uses of colour are treated in exactly the same way as offline uses:

- **Colour per se cannot be registered or enforced as a trademark.**
- **Only figurative/mixed marks containing colour may be protected.**
- **There are no special frameworks or precedents for digital or virtual environments.**

6. Enforcement of Colour Trade Marks

Please provide examples of cases in your jurisdiction where registered Colour Trade Marks were enforced against third-party uses (successfully or unsuccessfully). What were the key factors influencing the outcome of these cases (e.g., evidence of confusion, distinctiveness, or functionality arguments)?

There are **no cases in Venezuela involving the enforcement of registered Colour Trade Marks**, whether successful or unsuccessful. This is because Venezuelan law **does not allow the registration of single colours or combinations of colours “by themselves”** under Article 33(6) of the Industrial Property Law.

As a result:

- **No registered Colour Trade Marks exist** in Venezuela;
- **No administrative or judicial enforcement actions** have ever arisen on the basis of colour-per-se rights;
- There are **no precedents** dealing with confusion, distinctiveness, functionality, or infringement involving colour-only signs.

Enforcement practice implications:

- Any disputes involving colour usage in Venezuela proceed **only** under:
 - the comparison of **figurative or composite marks** that include colour as one element; or
 - **unfair competition / passing off-type analyses**, where colour may form part of the overall trade dress;
- However, such disputes do **not** treat colour as an independent source-identifying right, and thus **do not constitute colour-mark enforcement cases**.

Conclusion:

Because Colour Trade Marks cannot be registered in Venezuela, **there are no enforcement cases**, and consequently **no factors such as confusion evidence, acquired distinctiveness, or functionality tests** have been evaluated in colour-mark disputes.

7. Strategies for Managing Colour Trade Mark Applications

- a) What strategies would you recommend for successfully filing, opposing, defending or enforcing a Colour Trade Mark Application in your jurisdiction? For example, are there specific arguments or Evidence types that are particularly effective in demonstrating distinctiveness or use during proceedings at the Trade Mark Office or in the Courts?

Because Venezuelan law **prohibits the registration of single colours or colour combinations “by themselves”** (Industrial Property Law, Art. 33(6)), a Colour Trade Mark Application cannot succeed as a colour-per-se claim.

Therefore, the only viable strategy in Venezuela is to reframe the protection toward (i) a **figurative or composite mark** that includes colour, or (ii) **trade dress / unfair competition** principles when colour forms part of the overall presentation of the goods or services.

Below are the strategies applicable in practice:

Strategies for Successful Filing (Registrability)

- a) **Do not file a colour-per-se mark**
A colour-only sign will be refused automatically under Art. 33(6). The only workable filing route is:
- b) **File a figurative or composite mark incorporating colour**
The mark must be presented as a **graphic sign** (logo/label/device) where colour is **one**

element of the overall design — *not* the sign itself.

c) Use precise colour identification (e.g., Pantone)

While this does *not* create a colour right per se, precise coding strengthens clarity of the figurative mark and reduces objections.

d) Provide a detailed description

Venezuelan Patent and Trade Marks Office (SAPI) relies heavily on the written description claim chapter. Clearly describe:

- The graphic elements;
- The colours used;
- Their placement;
- The relationship between elements.

This increases certainty and survivability in later enforcement.

Strategies for Opposing Third-Party Filings

Although there should not be colour-mark applications published for oppositions, you may oppose **figurative/mixed marks** that imitate your colour-based branding.

Key strategies:

a) Argue overall visual similarity

Since colour cannot be monopolised, the argument must be framed around **likelihood of confusion** based on the **totality of the figurative sign**.

b) Emphasise consistent market use (even if not a colour mark)

Evidence of continuous use of the figurative mark (advertising, packaging, screenshots, invoices) helps establish that your design has become a recognisable identifier.

c) Use trade dress arguments

If the competitor imitates colour schemes in packaging, store layout, or product presentation, raise **unfair competition / passing off** concerns.

Strategies for Defending Your Own Registration

a) Ensure the figurative mark is distinctive beyond colour

Because colour alone cannot be protected, include distinctive shapes, typography, patterns, or arrangements that can survive scrutiny.

b) Maintain consistent commercial use

SAPI and courts may rely heavily on marketplace evidence to assess distinctiveness of figurative signs.

c) Avoid claims that imply exclusivity over the colour itself

This prevents vulnerability on grounds of “attempt to monopolise colour per se,” which is legally inadmissible.

Strategies for Enforcement

a) Frame enforcement around the figurative mark

The claim must be: the competitor’s overall design imitates your **registered figurative/mixed mark**, not your colour.

b) Use evidence of actual marketplace confusion

Particularly effective:

- Side-by-side comparison of packaging or visual branding;
 - Consumer testimony;
 - Online confusion (screenshots of mistaken posts, comments).
- c) **Functionality arguments (defensively or offensively)**
Colours commonly used in industry (e.g., safety colours, conventional sector colours) can be argued as **non-distinctive** or **functional**, useful when opposing copycats.
- d) **Rely on unfair-competition principles for trade dress**
If the overall get-up (including colour scheme) is copied in the digital or physical marketplace, this can support claims even without a colour mark registration.

What is *not* effective or admissible in Venezuela

- Evidence of “acquired distinctiveness of a colour per se” → *irrelevant*, because colour-only marks are legally barred.
- Claims seeking exclusive rights over a Pantone shade → *inadmissible*.
- Attempting to enforce a “colour family” → *not recognised*

In Venezuela, the recommended strategy is **not to pursue a Colour Trade Mark per se**, as such marks are legally prohibited. Instead, applicants should (i) protect colour-based branding through **figurative or composite marks**, (ii) rely on **trade dress and unfair competition** for overall colour schemes, and (iii) support enforcement with strong **marketplace evidence of confusion**. No evidence of acquired distinctiveness of colour alone is effective, because colour-per-se rights cannot exist in this jurisdiction.

b) Can you provide any insights as to the co-existence of Colour Trade Marks in your jurisdiction.

Because Venezuelan law **does not allow the registration of single colours or combinations of colours “by themselves”** (Industrial Property Law, Art. 33(6)), **Colour Trade Marks do not exist in Venezuela**.

Consequently, there is **no legal framework, doctrine, or administrative practice** governing the co-existence of Colour Trade Marks.

Key implications:

- **No co-existence agreements** involving colour-per-se marks have been recorded or recognised, because no colour marks can be registered.
- The Trade Mark Office (SAPI) has **never issued guidance** on how similar or overlapping colours could co-exist, nor how to delineate exclusive colour zones.
- Courts have **no jurisprudence** on colour-based conflicts, co-existence, or delimitation of colour rights.

Co-existence in practice (indirect or analogous situations):

Any co-existence analysis involving colour in Venezuela occurs only in the context of:

- **Figurative or composite marks** that incorporate colour as one element;
- **Trade dress / unfair competition** situations, where colour forms part of the global presentation of goods or services.

In such cases, any “co-existence” is assessed using **traditional trademark principles** (overall impression, likelihood of confusion, distinctiveness of the figurative design), **not** colour-per-se rights.

Conclusion:

Venezuela offers **no mechanism** for the co-existence of Colour Trade Marks because colour-only marks are legally inadmissible. Any issues involving similar colour schemes are treated under the general rules for figurative trademarks or trade dress, not as co-existing colour rights.

c) Are there additional fees for Registration and Renewal of Colour Trade Marks in your jurisdiction?

No. There are **no additional fees** for the registration or renewal of Colour Trade Marks in Venezuela because **Colour Trade Marks cannot be registered** under Article 33(6) of the Industrial Property Law.

Since colours “by themselves” are legally inadmissible as trade marks, the Venezuelan Trademark Office (SAPI) does **not** charge a separate or premium fee category for colour-per-se applications.

Only **standard trademark fees** apply—those corresponding to:

- Filing a **figurative or composite mark**, even if it contains colour;
- Renewal of such figurative/composite marks;
- Publication and administrative formalities.

No surcharges, add-ons, or special fee schedules exist for colour-related claims.

8. Colour Depletion

Due to the Registration of Colour Trade Marks, fewer colours remain available for use by businesses. Does your jurisdiction recognise the concept of “colour depletion”? If so, how.

Venezuela does **not** recognise the concept of “colour depletion,” because **Colour Trade Marks cannot be registered** under Article 33(6) of the Industrial Property Law.

Since single colours and combinations of colours “by themselves” are **legally inadmissible**, the trademark system never grants **exclusive rights over colours**, and therefore:

- There is no risk of colours being monopolised by certain businesses;
- The legal system has no need to address colour exhaustion, scarcity of available colours, or policy limits on colour monopolisation;
- Courts and the Trade Mark Office (SAPI) have not developed any doctrine or analytical framework concerning colour depletion.

Practical consequence:

Any use of colour in Venezuela remains **free for all market participants**, except where the colour forms part of a **figurative or composite mark** (e.g., a specific logo). In such cases, protection applies only to the **overall graphic sign**, not to the colour itself.