

## Intellectual Property Law



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### Single color protection as trademark protection.

Currently a contentious court case is taking place in the United States of America, in which a famous producer of luxury footwear, Christian Louboutin, demands a ban on the sale of shoes with a red sole characteristic for the French fashion house – Yves Saint Laurent. In a wider spectrum, the dispute is connected with the possibility of obtaining protection for a trademark in the form of a single color, in the way of a registration. The issue of opportunity to obtain protection for a color treated as a trademark has been causing controversy for a long time.

As stated within in the Act of 30 July, 2000 on Industrial Property Law (further referred to as “IPL”), the indication of markings that can obtain protection as a trademark, does not exclude the possibility of obtaining protection for a single color. In accordance with Article 120 of the IPL, a trademark can be any marking which can be presented in a graphic form, if such marking is also eligible for distinguishing a product of one entrepreneurship from a product of another entrepreneurship. The essential element within the scope connected with the estimation of the possibility of a color as a trademark registration, is also the regulation prohibiting the granting of protection on markings constituting the form or other attribute of a product, conditioned solely on functional grounds, or significantly increasing the value of products. Similar regulations are enclosed in the European Council Regulation (EC) No 207/2009 on European Community trade marks, that regulates the procedure of gaining protection for trademarks which are effective over the whole territory of the European Community.

The jurisprudence of Polish and European courts proves that the key issue in estimating the chances for obtaining protection on a single color is establishing whether the color in question possesses a distinctive capability, that is the evaluation, whether solely on the basis of color, consumers are able to distinguish products of a specific entrepreneur from competitive products. The requirement to possess a distinctive capability through a marking means that generally it will not be possible to register a color which has not been used for a given product before. In general

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consumers do not consider the color or the packaging a marking that distinguishes the producer - they usually only have an esthetic meaning.

The situation, however, is different in the case, when a product with a specific, characteristic color has functioned on the market for a longer time in a way that makes consumers associate this color with a specific product. In a situation like this it is possible to acknowledge that the color has gained a distinctive capability with respect to its use for products (it is the so-called secondary distinctive capability). If from the consumer's point of view, a specific color becomes characteristic for a particular producer and consumers define the product's origin on the basis of its color even without referring to other markings of the product (e.g. verbal), then it is considered that a color is capable of fulfilling the basic function of a trademark, which consists in transferring information about the origin of a product to a specific manufacturer. Examples of colors which became characteristic due to their long-lasting use and the registration of which was eventually conducted, are inter alia, purple – registered to the benefit of the producer of Milka chocolate and purple – registered to the benefit of the producer of cat food – Whiskas.

It should be emphasized that in the case of submitting a registration statement of a color as a trademark, it is the proponent who should prove, in the registration proceedings, that the clients identify the submitted color with his products, without the need to refer to other markings placed on the product or its packaging. The Patent Office of the Republic of Poland and also the Voivodeship Administrative Court in Warsaw have drawn attention to this aspect, declining the registration of the color red as a trademark on behalf of a well-known tool producer – Hilti.

It should be emphasized that the registration capability of a color cannot be considered separately from the character of a product for which a specific trademark is destined. The American court put emphasis on this aspect by dismissing Louboutin's application for banning the introduction of shoes with a characteristic red sole. The court decided that in relation to footwear a color has a very important esthetic function, thus the monopolization of the use of a specified color of shoe sole towards one producer would have unfavorable effects in terms of market competition.

It seems also that on the grounds of Polish law, gaining protection for a color for clothing products would be impossible. According to Article 131 IPL, any marking which constitutes only a 'product's attribute' are excluded from registration. Whereas in reference to clothing, color is definitely a very important product attribute, usually possessing the key meaning in the decision-making process when it comes to clients.

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To summarize, registration of a color as a trademark is possible, however, it is necessary for the color -for which an entrepreneur is applying for protection - to gain the capability of distinguishing their products on the market from the consumers' point of view, before the date of filling the application. Each time it is also necessary to assess whether, in relation to specific goods, color has a functional meaning and if it constitutes a significant attribute of a product. The answer to the question of whether registration of a specific color is possible, requires, therefore, the conducting of an individual analysis of each case.

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