



**Protecting a Color as a Trademark in Lebanon,
U.S.A. and the European Union
(Comparative study)**

Authors

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Protection of a Color as a Trademark⁽¹⁾ In Lebanon, U.S.A. and the European Union (Comparative Study)⁽²⁾

Introduction

A trademark ⁽³⁾ is, in general, any sign, symbol or means that can distinguish products, goods and services of a specific merchant/service provider from those of his competitors.

The importance of trademarks is, on one hand, due to the fact that they are a source of trust put by a consumer in a specific trademark to the exclusion of all others prompting him to acquire the products labeled in one of these trademarks and avoid purchasing products on which are affixed other trademarks due to the certainty that the quality and fineness of the former products are superior to the latter ones. It is, on the other hand, due to the fact that the trademark ensures to its owner a wide spread fame and good repute as a result of the existing link, in the consumer minds, between the goods and products of this producer and his trademark. It can be asserted, in general, that a trademark serves the following functions stated as an example and without limitation:

- * It enables the consumer to distinguish the products and services and consequently give preference to the quality and shape of certain goods labeled with a specified trademark.

- * It stands as a distinctive element indicating the source of these goods and services.

- * Repute of the trademark assures fair competition.

- * It is considered an efficient publicity tool.

- * It is an important element of the success of the trade project, if not the source of success itself in some instances.

(1) For expansion purposes in the “protection of the color as a trademark, please refer to “Protection of the Color Mark in Legislation and Jurisprudence in the United States and the European Union; Ph. Obeid, Sader publishers, Beirut 2007.

(2) This article has been published first on Hieros Gamos website. <http://www.hg.org/article.asp?id=4863>.
The arabic text of this study is published in Al A'adel 2007 - issue 3 - p 1066.

(3) The trademark is the sign affixed by the trader on the goods he sells, the industrial mark may be used by the manufacturer on his products and the service mark on the services provided by the service provider. All these denominations are governed by the same rules if used in commerce (Edouard Eid, Commercial Acts, Merchants and Commercial Enterprises, 1971, p. 463 sep.; Naïm Moghabghab, Trader and Industrial Marks, 2005, p.16).

* It gives its owner exclusivity of use and assignment of such right.

In this connection, it is worthwhile mentioning that the value of some trademarks, such as Coca-Cola® or Microsoft®, exceeds tens of billions of dollars, a matter which increasingly stresses the importance of a trademark and the necessity of its protection.

As concerns the color trademark in specific, the questions that come to our mind in the first place are simple, such as:

Can the Coca-Cola Company for example, prevent its competitors from offering in the market a product similar to its products in red color? Can Pepsi-Cola protect a Blue color? What is the importance of blue, white and gold colors of the Visa card for the purpose of protecting its trademark? Is it true that the yellow color is a distinctive element indicating the source of any product or service? Consequently, can we monopolize a color packaging and/or a specific color for a certain article?

The importance of these questions is emphasized in the light of the technological developments in the field of printing and packaging industries. As a matter of fact, the color T.V. and the developments occurring in the printing field resulted in the emphasis on the importance of a color in the field of advertising and packaging of products. Marketing experts have focused on the color packaging of the product as an essential element to boost the sales standard of a product in comparison with other products due to the intangible effects produced on the consumer. A very recent finding made by “Angela Wright”, a specialized researcher in the science of colors, in cooperation with OK company for printing solutions, has revealed that Europeans who care for their health are attracted to food packaged in blue color⁽⁴⁾.

The issue of protecting color as a trademark was raised in the U.S.A. over twenty years ago when the U.S. judiciary, In the Owens-Corning Fiberglass corp., 774 Fed. 1116, 1120 (Fed. cir. 1985), granted protection to the purple color used by Owens-Corning⁽⁵⁾ to distinguish its products. This decision, however, did not put an end to the discussion, on whether a color may serve as a trademark, due to the several difficulties that was pointed out and developed by some legal authors supported by a number of U.S. court decisions.

Before reviewing such theories and searching for legal bases for the protection of color as a trademark and the conditions for such protection, it is necessary to go briefly through the nature and constituents of a trademark in general and a color trademark, in particular.

(4) Assafir Newspaper, Thursday 12 April 2007 – issue no. 10672, p. 12.

(5) for the full text of this decision:

<http://home.att.net/~jmtyndall/ustm/774f2d116.html>

First: what is a color trademark?

I – Definition of a color trademark in general.

A - Definition of a trademark

The Lebanese Commercial and Industrial Property System issued by regulation no. 2385 of 1924, gave the trademark, the following definition: “Are considered as industrial or commercial trademarks, names written in a distinctive form, as well as brand names, symbols, stamps, characters, hallmarks, embossed drawings, small drawings, numbers and in general any sign whatsoever used, in the interests of the consumer, the manufacturer or trader for the purpose of distinguishing things from others and characterising the essence and source of goods, industrial, commercial or agricultural produce, forest yields or metals.

A trademark is thus an identity document⁽⁶⁾ showing the consumer needs offered, in a trade market, by a merchant to the consumer, in consideration of a pecuniary amount of money. The characteristics of this I.D. cannot be confined within narrow limits for the simple reason that any sign or means capable of directing the consumer to the wanted goods constitutes, in principle, a trademark. In principle, we say, because there are certain legal limits out of which these signs or means may not be described as trademarks⁽⁷⁾.

B – Definition of a color trademark.

Legislations that have expressly included color among the signs constituting a trademark, did not determine the nature of a color trademark. This is mainly due to the fact that legislations relating to trademarks, in general, concentrate on the sign itself as a trademark instead of the nature thereof.

In fact, article 68 of the Lebanese System of Protection of the Commercial and Industrial Property, issued by regulation no 2385 of 17/01/1924, provides that “Are considered as trade or industrial marks... every sign whatsoever.... used to distinguish things from others and showing the nature and origin of the goods...”

(6) Court decisions have defined the trademark as being the identity through which it goes in the market with a unique and uncommon aspect. The trademark to be protected has this characteristic if one looks globally at its shape, color, design and arrangement (Mount Lebanon court of appeal, 1st civ. ch., decision no. 18. dated 15/2/1995 mentioned in the Reference Book in Intellectual Property, by R. J. Sader, Sader Legal publications 2006, p. 146).

(7) Such as immoral signs or those having a functional role derived from the nature or kind of the goods or their value and source..

This broad definition of a trademark points out the problem of determining the nature of the color trademark in the absence, on the Lebanese and Arab levels in general, of any scholastic study⁽⁸⁾ or court decision.

It can be said that a color trademark is a sign used to distinguish products and services and indicate their origin. A color per se or mixed with other colors or elements may, according to the general legal definition, be considered as a trademark. A trademark may be constituted of a colored sign composing other signs, or of one or more colors dyed on the products themselves or on their wrappings or on the materiel objects inherent to services. In all these instances, a color trademark may be composed of a single color or a composition of colors.

II – Characteristics of a color trademark.

A – Characteristics of a trademark general.

A trademark is composed of all that may constitute a sensorial means of conversation or understanding, regardless of whether it is expressed in words, visually, audibly, through odor, taste or touch...

Traditionally, definition by words in such a form as, for example, Coca-Cola®, NESTLE®, L’Oreal®, ranks among the foremost of signs and means constituting trademarks whereby it constitutes a common element for all consumption needs offered in the commercial markets.

In addition to these wording elements, merchants, manufacturers and service providers provide the identification cards of their products and services through designing elements known as figurative marks, such as:

(8) Excepting the above-mentioned reference book by Ph. Obeid, supra note (1).



<http://www.qualitexco.com/images/logo.gif>



<http://www.thecoca-colacompany.com>



www.saderpublishers.com

And with numbers: numerical marks, such as:



www.nhfournier.es/standard.php?category=6&family=104



www.scotchwhisky.net/blended/vat_69.htm



typophile.com/files/7uP-logo%20original.jpg

It is obvious, within the standards of the different legislations, that these elements enjoy the protection given to a trademark each time they fulfill the legal requirements, according to the legislation of the country concerned.

Commercial activity has lately witnessed a striking development on the American and European levels as concerns enlarging the scope of the meaning of a trademark so as to reach new kinds of definition elements such as taste, smell, sound and color⁽⁹⁾.

(9) Samir Fernan Bali and Nouri Jammo, Technical Encyclopedia in Trademarks, Geographical indications, Industrial Designs and Patents, El Halabi Legal publication, 2007. p. 23&24. Moreover Article too of the Syrian law no. 8 of 2007 relating to the protection of trademarks, geographical indications, Industrial designs and patterns, provides that a trademark is any sign capable of distinguishing products or services of a physical or juristic person. A trademark may, for example, be composed of names, denominations... or a combination of colors, their arrangement, shades or...”..

This study shall be focused on the color trademark exclusively due to the large legal discussion raised by this subject in a number of countries.

B – Characteristics of a color mark.

The color mark is either composed of a color per se or of a combination of colors. A color per se, regardless of its distinctive feature, is not considered a trademark⁽¹⁰⁾ but some countries have admitted, within certain conditions, exceptions to this principle.

1 – Color per se

A color per se may be considered a trademark or a service mark provided it fulfills the conditions of distinctiveness and functionality⁽¹¹⁾.

A color per se constituting a color mark is the color chosen by a specified merchant amidst a list of colors for the purpose of affixing it on his products or services in order to make them distinct from those of his competitors.

This color may take the shape of a geometrical design (a circle, a rectangle...) or a fixed figurative design (horse, crown...), despite the difference in shape of the products, goods or matters on which it is affixed. The shape of this color per se may be determined by the tangibles forming the subject-matter of the mark. This does not, however, disqualify the color per se to act as a trademark as long as it is apt to distinguish the products and services and is not only ornamental.

2 – Color combination⁽¹²⁾.

A trademark composed of a color combination is a compound of more than a single color to be affixed on products and services for the purpose of distinctiveness and of indicating their commercial or service origin. This combination must appear under a figurative shape determined clearly and precisely:

* The combination shape.

(10) Edouard Eid, op. cit., p. 470; Naim Moghabghab, op. cit., p. 40.

(11) U.S. court decisions consider color unregistrable in case it has a functional role, such as the blue in *Ambrit v. Kraft* where the claimant company adopted this color on its marketed products (frozen foods) and when it noticed that the Kraft company was marketing similar products under the same color, it sued her for counterfeiting. The court considered the blue color as a cool color and its use is common in the frozen food industry and ice creams.

Ambrit Inc. v. Kraft Inc. 812 f 2d, 531, 1548, 1 U.S.P.Q. 2d 1161, 1171 (11th cir. 1986).

(12) We point out here that the dragsters of the draft new Lebanese law on trademarks have used the expression “mixture of colors which, in the opinion of Philip Obeid in his book referred to above, is not a proper expression because it is used to indicate a blend of two or more colors to reach one color combining the characteristics of the mixed color without any similarity with any of these colors, such as the oily color resulting from a mixture of the two colors: green and yellow. This author suggests the use of the expression “color combination” which indicates that each of the colors composing this combination preserves its proper characteristics and appear independent from each other but within such a homogeneous and organized group allowing the consumers memory to look at it as one element (op. cit., p. 20).

* The shape taken by each color.

* The position, order and coordination of colors within this combination.

The color combination composing a trademark may, as is the case in a color per se, take a fixed shape that is not altered by the change in the aspect of objects and tangibles on which it appears as it may also take the shape of the objects on which it is affixed. This does not affect the color combination as long as it can distinguish the similar product and services provided it is not functional.

The protection of the color combination by the legislations relating to trademarks does not give an absolute protection for the colors constituting this combination; it rather aims at protecting the mode of arranging these colors inside the combination. A color mark may, in this respect, be assimilated to a word mark where the trademark, constituted of a color per se, is similar to the trademark composed of a single character from the stand point that the protection of a single character or a color per se ensures the exclusivity of its use by other merchants on similar goods or services. However, the protection of a specified word should not result in the exclusive use of the characters forming this word in different arrangements that does not lead to confusion between the two marks in the mind of a careful consumer.

It remains to point out that a number of countries have admitted, through their trademark legislations, the possibility of protecting the color combination as being a distinctive sign of products and services while refusing registration and protection of a color per se as a trademark. Among these countries we may cite as an example: Portugal, South Korea, Spain, Japan, China, Taiwan, Brazil, Mexico⁽¹³⁾ and Syria.

(13) www.inta.org/downloads/tap_color_1996

Second: The legal status of a color trademark.

I – The legal basis of a color trademark.

A – The color trademark in comparative law ⁽¹⁴⁾.

The definition of a trademark, used by the Lebanese legislator, did not directly deal with the color trademark for the simple reason that this definition did not focus on defining the elements that are susceptible to form a trademark, as much as focusing on the role of a trademark.

As a matter of fact the definition of a trademark in comparative legislations is not much different from that specified in article 68 of the Lebanese Law Regulating the System of Commercial and Industrial Property issued by regulation No. 2385 of 17/01/1924. We shall herein-below examine the definition used in both the American and European legislations, of the trademark and the place occupied by the color trademark in this definition.

1 – The color trademark in the United States of America.

The U.S.A. Law on trademarks issued in 1946 defines, in section 45, the trademark as follows:

Shall be considered a trademark any word, name, symbol or device or any combination thereof:

1 – Used by a person; or

2 – which a person has a bona fide intention to use in commerce and applies to register on the principal Register established by this act to identify and distinguish his or her goods, including a unique product from those manufactured or sold by others to indicate the source of the goods even if that source is known⁽¹⁵⁾.

(14) For example, article two of the Trademarks Law of the U.A.E. provides that “Is considered a trademark anything which takes a distinctive shape; names, words, signatures, characters, numbers, designs, symbols, addresses, imprints, stamps, photos, carvings, advertisings, refills or any other mark or a combination thereof if it is, or intended to be used to distinguish goods, products or services of whatever source; or to indicate that the goods or products are the property of the trademark owners on account of their manufacturing, selection or trading therein; or to indicate providing one of the services. Sound may constitute part of the trademark if used in conjunction therewith”.

It is worthwhile mentioning that the trademark office at the Ministry of Economy and Commerce in the U.A.E. has relied upon the text of this article and the registrations obtained by Mars Incorporated in many countries, in order to register the orange color used by this company on these products labeled UNCLE Ben’s. The registration of this color trademark (under no. 80022 dated 12/4/2007) composed of a color per se (Orange, Pantone 021c) is considered the first registration of a color mark in the U.A.E., owned, as mentioned above, by Mars Incorporated and covers all products mentioned in class 30 of the international classification of products (e-mail dated 18/04/2007 on the web site www.worldtrademarklawreport.com).

(15) <http://www.lectlaw.com/files/inp25.htm>

Despite the fact that the American legislator did not expressly mention color among the signs considered as a trademark, the above text, however, did not exclude protection of colors as trademarks.

This position is in line with that of section two of the "Lanham Act" which states that the United States Patents and Trademarks Office (USPTO) has no right to refuse registering a trademark except in the instances provided for in this Act.

§1052. Trademarks registrable on the principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a)

Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USC §3501(9)]) enters into force with respect to the United States.

(b)

Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c)

Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d)

Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in

connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e)

Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [[15 USC 1054](#)], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f)

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act [enacted Dec. 8, 1993].

A mark which when used would cause dilution under section 43(c) [[15 USC 1125\(c\)](#)] may be refused registration only pursuant to a proceeding brought under section 13 [[15 USC 1063](#)]. A registration for a mark which when used would cause dilution under

section 43(c) [[15 USC 1125\(c\)](#)] may be canceled pursuant to a proceeding brought under either section 14 [[15 USC 1064](#)] or section 24 [[15 USC 1092](#)] ⁽¹⁶⁾.

2 – The color trademark in the European Union.

The definition of a trademark adopted by the European legislator whether in the “Directive 104/89 dated 21/12/1988 or in the Community Trademark Regulation of 1994 did not directly deal with the color trademark.

Article two of the mentioned Directive gives the same definition as that of Article four of the Community Trademark Regulation which stipulates that:

“A trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings⁽¹⁷⁾.

It is clear that the wording of this article does not make any reference to the color trademark. It is equally clear that the enumeration cited by the European legislator is made as an example and is not restrictive. The European notion of a trademark is large and applies to any sign that can be materialized in the form of a graphical design provided it is distinctive. This constitutes the legal basis on which the French courts of all degrees have reclined on to give color the description of a trademark.

As concerns Lebanon, in the light of the broad definition of a trademark, being “any sign... capable of distinguishing products and services, and in comparison with the U.S. Trademarks Act and with the European Directive no. 104/89, as developed both in doctrine and jurisprudence and in view of the actual legislative position in Lebanon, there is no objection in our point of view to protect the color trademark that satisfies the conditions set forth in the system regulating the rights of commercial and industrial property issued by regulation no. 2385 acted 17/01/1924⁽¹⁸⁾.

(16) <http://www.bitlaw.com/source/15usc/1052.html>

(17) eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:31989L0104:EN:HTML

(18) Several Lebanese court decisions concerning trademarks counterfeiting has relied upon the color of these trademarks or the color of the products on which they are affixed or the color of the packaging considered one of the elements that may lead to confusion in the consumers minds. In one of these decisions, it was mentioned that “Taking a quick glance on the two packagings and by comparing them it is clear that there exists a large similarity between them as concerns color, the manner of arranging these colors, their composition and the word used and their color surroundings and the manner they are written...”.

(Bekaa court of appeal, 2nd civ., ch., decision no. 30/97 dated 24/2/1997, mentioned in R.J. Sader’s reference book, op. cit., p.p. 287 – 288).

B – Criticism of the color trademark theory.

The two main criticisms are color Depletion and Shade confusion.

1 – Color Depletion.

This theory takes its inception from the reality of the restricted number of colors. The color trademarks, contrary to all other trademarks, allows only to a few number of traders and manufacturers (equal to the number of colors) who produce similar goods or extend uniform services (the banking sector for example) to monopolize the rights resulting from the ownership of a color trademark.

This fact, as contended by the followers of this theory, is in contradiction with one of the most important principles on which is based the trademark legal systems, i.e. to keep the traders on an equal distance from the prerogatives created by this law in such a manner as to give them equal chances and thus maintain the fair competition principle.

Despite the arguments raised by the followers of the Color Depletion theory, the Supreme Court of the United states rejected these arguments in the famous Qualitex case⁽¹⁹⁾ on 28/03/1995 in which the court stated that “This argument is unpersuasive, however, largely because it relies on a occasional problem to justify a blanket prohibition. When a color serves as a mark, normally alternative colors will likely be available for similar use by others.”⁽²⁰⁾

2 – The shade confusion theory.

The starting point of this theory is the physical composition of colors and the close similarity in visual perception of similar colors to a degree making it impossible for the judges, in general, who are jurists and not color scholars – to ascertain the presence of counterfeiting or similarity. This theory, alike the previously mentioned one, is of American origin and the courts in this country influenced by this theory have, for a while, rejected protection of color signs as trademarks.

The Federal Supreme Court, however, in its decision in the Qualitex case (mentioned above) rejected the argument stating that ascertaining the presence or absence of similarity is a matter which the courts and registration office usually do regardless of the nature of the mark whether it is written, pictorial or digital; the test is not exclusively applied to color trademarks.

The Supreme Court also stated that the courts already decided difficult questions about whether two words are confusingly similar. Nothing prevents the courts from applying the same norms followed in distinguishing traditional trademarks to those composed of colors.

(19) <http://supreme.justia.com/us/514/159/case.html>

(20) <http://home.att.net/~jmtyndall/ustm/1995SCT41.htm> (See part III par. 5.)

II – Conditions for the protection of color marks.

The judicial, legislative and doctrinal consecration of the color mark protection was accompanied by a number of problems namely the conditions required in a color sign in order to be able to constitute a trademark.

It is true that these conditions are formally in line with those required in all other traditional trademarks, but they take, as to substance, a different dimension.

The reason for such distinction stems on one hand, from the nature of the physical composition of colors and, on the other, from the impression created by colors in the consumer's mind in relation to a specific product or service. This is in addition to the difficulties raised by this fact on the level of substantive conditions; i.e. the two conditions of distinctiveness and non functionality.

A – Formal condition of protection.

In general, the penal protection of a trademark is based on the procedure of registration in the trademark register kept with the competent department (usually the Intellectual Property Department at the Ministry of Economy) and the ensuing publicity formality⁽²¹⁾.

The applicant for registration of a trademark has to submit a written application to the registration Bureau in which he reproduces the necessary characters, designs and colors used to identify the trademark applied for.

Trademark legislations in the different countries have expressed this fact.

As a start, we refer to the Lebanese system of regulating the commercial and industrial property rights issued by Regulation no. 2385 which provides in article 79 the following:

“The owner of the mark or his proxy shall submit, under penalty of voidance, a written application containing the following information:

(21) Article 701 of the Lebanese Penal Code stipulates the following: “Shall be considered industrial or trade marks, within the meaning of this paragraph, names written in a distinctive manner...” if these marks are registered and published in accordance with the laws in force.

Decree 11174 dated 14/10/1997 which fixes the subscription fees and publication of advertisings in the Official gazette, as amended by Decreed 13363 dated 10/9/2004 amending the trademarks publication fees in the official gazette distinguishing in this respect between the publication of black and white and the colored publication as follow:

| Measurement | Black & white | Colored |
|--------------|---------------|----------------|
| 7.5 x 7.5 cm | L.L. 72.000 | L.L. 288.000 |
| 14 x 14 cm | L.L. 288.000 | L.L. 1.152.000 |

1 -....

4 – Very brief description of the mark...”

In the European Union, a directive was issued under no. 104/89 dated 21/12/1988, with a view to coordinate between the legislations of the countries member of the Union in the field of trademarks. Article two of the said directive provides that “a trademark may consist of any sign capable of being represented graphically...”

The American Trademark Act states that a written application should be submitted to the United States Patents and Trademarks Office in order to register a trademark.

The registration of a traditional trademark (composed of characters, graphics or numbers) under these legal systems did not raise any difficulty, however the emerging of new kinds of trademarks (color, sound, smell, taste....) raised some obstacles as concerns the condition of graphic representation that must accompany the registration of a trademark.

Courts have dealt with these obstacles in the following manner:

1 – The formal condition for protection in the United States of America.

Application for registration of a trademark submitted to the United States Patents and Trademarks Office must be accompanied with a descriptive design of the mark to be deposited or registered, with the exception of sound and scent trademarks.

Each application not including a descriptive design of the mark shall not be accepted for registration⁽²²⁾.

Systems and applications adopted by the said Office suppose in the applicant for registration of a color mark, that he follows in the application, for the purpose of describing his color mark, the pattern of reproducing colors through color bars which number is fixed by the office to twelve as follows:

Red/pink, brown, blue, gray/silver, violet/purple, green, orange, and yellow/gold⁽²³⁾.

The applicant shall choose from among these sample bars those which express the color of the trademark that he wants to register accompanied with a written description of the trademark. So, for example, if the applicant for registration wishes to deposit a color mark composed of the maroon color, he is bound to choose the sample representing the red color and mention in the description that the color he wants to protect is the maroon color and not the red.

(22) www.bitlaw.com/source/tmep/1202_04.html

(23) www.law.washington.edu/CASRIP/newsletter/Vol6/newsv6i2Caldarola.html

2 – Formal condition of protection in the European Union.

A judgment rendered by the European Court of justice in the Libertel case on 6/05/2003 confirmed that the condition required for the acceptance of the application for registration of a color mark is that this application must include a written, clear, precise, self contained, easily accessible, intelligible and objective description.

“A sample of a color, combined with a description in words of that color, may therefore constitute a graphic representation within the meaning of article 2 of the directive, provided that the graphic description is **clear, precise, self contained, easily accessible, intelligible, and objective**”⁽²⁴⁾.

Commenting on the said decision, Paul Blondel approves the statement that the color sample accompanied with a written description is not, in principle, sufficient unless it is accompanied with an internationally recognized Code⁽²⁵⁾.

B – Substantive protection condition.

1 – Distinctiveness

The major role of trademarks, which are, as mentioned above, signs affixed on good and tangible objects accompanying services, is to distinguish products and services of a specified trader/service provider from those of his competitors.

Consequently, colors and their combination in general are capable of forming a trademark provided they are apt to distinguish products and services of a specific trader from those of his competitors; because a sign or mark devoid of the distinctiveness character does not allow it to play the role of a trademark or perform its functions. The most important of these functions is to indicate to the consumer the source of the goods in such a manner as to allow him to accept the product or the service, if desired, or refuse it if it does not satisfy his needs.

It can be said in general that there are two instances where the color constituting the trademark may perform a role of distinctiveness: inherent or acquired.

*** Inherent distinctiveness:**

The capability of a color sign to distinguish differs according to the difference of the color elements constituting this sign. It is well known that a color mark may be constituted of a color per se as it may be composed of a color combination.

(24) judgment of the court, 6 may 2003 in case-104/01, Libertel Groep BV.V Benelux Merkenbureau. Par.36. (www.eu.int)

(25) oami.eu.int/en/offices/ejs/pdf/blondeel%20en

(Pantone system, RAL system) where each color has a fixed unchangeable symbol (for example the orange color symbol is HKS7) distinguished from the color designed on the application for registration which is subject to change with time. (Ph. Obeid, op. cit., p. 57).

Judicial experience, though relatively scarce, in the western legal systems have consolidated the necessity of being extremely cautious before granting protection to a trademark composed of a color per se.

Furthermore the Federal Supreme Court of the United States has denied this protection to a color per se unless it is established by the right owner of the mark, that it has acquired the character of distinctiveness as a result of its use⁽²⁶⁾.

A number of decisions were issued on the European Union level, relating to disputes arising from the registration of a mark composed of a color per se.

Thus, the Court of Appeals in the European Union has rejected the registration of a color mark composed of a color per se – light green – on grounds that this color is widely used in the field of products object of the trademark⁽²⁷⁾, to which can be added the possibility for this color to play the role of a descriptive mark for the purpose of indicating a specific flavor such as an apple⁽²⁸⁾. Consequently, the potentiality for a color trademark in presenting the character of inherent distinctiveness is accrued by the increase of the number of colors constituting the mark. The legislations of some countries have gone so far as to restrict the protection of a color mark to the sign constituted of more than one color (a color combination). This, however, does not mean the automatic and absolute protection of color combinations.

In reviewing the decisions rendered in the field of color marks, one may notice the extreme care of the courts in analyzing each and every element constituting the combination prior to looking at it as a whole.

We can read, for example, in a decision rendered, by a court of the first degree in European Union, on 09/07/2003, the following:

“In assessing distinctiveness in a trademark, the court is not supposed to look at it as a whole but nothing prevents examining the mark in its details at the stage preceding registration”⁽²⁹⁾.

*** Acquired distinctiveness**

Where the color constituting the trademark does not have the character of inherent distinctiveness, it remains to the mark owner to establish the availability of

(26) www.lgu.com/publications/trademark/5.shtml

(27) Products that are the object of a color mark consist of gums used for beauty purposes (falling within class three of the international classifications of products), gums used for medical purposes and gums used for other than medical treatment.

(28) Oami.eu.int/legaldocs/boa/1998/en/r0122_1998-3

(29) www.ip-firm.de/eught234-01e

Judgment of the court of first instance (4th chamber) 9 July 2003 in case T-234/01 (Andreas Stihl AG & KG V. OHIM).

distinctiveness as a result of use. This means that the trader has focused on the color, object of the color mark aiming at distinguishing his products and indicating its source for a long period of time thus allowing the consumers of such products and services to establish an intangible link between the color and the source. Legislations of a number of countries have expressed the possibility of protecting a trademark in general and more specifically a color mark on basis of acquired distinctiveness unless the color is enjoying inherent distinctiveness.

For example Article six, paragraph (b) (2) of the Paris Convention stipulates the following.

“... may be rejected or annulled:

1 -

2 – Marks devoid of any distinctiveness. In determining the distinctive feature of a mark, all surrounding circumstances and facts should be taken into consideration, namely the period of use of this trademark”.

Article seven, paragraph 3 of the Community Trademark Regulation no. 40/94 issued in the European Union in 1993 provide the following:

“1 – The following may not be registered:

a -

b – A trademark devoid of any distinctive character.

3 – Paragraph 1 (b) may not be applied in case the trademark has acquired the character of distinctiveness in connection with products and services as a result of use.

2 – Non functionality.

The ability of a color mark to distinguish products or services of a specific trader from similar ones provided by his competitors, even if material, is not sufficient per se to confer to the color sign the description of a trademark. This presupposes to ascertain whether color plays any functional role in connection with the service or product provided.

The functionality doctrine has in the past, and in conjunction with other doctrines (such as shade confusion and color depletion), stood as an obstacle preventing colors from acquiring the characteristics of a trademark.

Despite the fact that a number of legal systems (on the legislation or court decisions levels) have gone beyond these doctrines and began to gradually admit the protection of the color mark, still the functionality role is present till nowadays due to its relation with some main elements of the color mark.

We point out, as a start, that the functionality role finds a legal basis in a number of legislations and conventions such as article 6 of the Paris Convention which states the following:

“... may be rejected or annulled:

1)

2) Marks devoid of any distinctive character or marks exclusively composed of signs or indications that may be used in commerce to indicate the kind, description, quantity, place of export, value, source of origin, date of production; or marks used in common language or proper trade usages in the country where protection is requested...”.

As to the U.S. Trademark Act of 1946, it provides in article 1052 (5) (5) that:

“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on account of its nature unless it comprises any matter that, as a whole, is functional”⁽³⁰⁾.

On the European level article 7(1)(d) of the Union Directive refused registration of trademarks – signs widely used in commerce. Decisions of the European courts have considered that this article applies to the elements used in advertising, not as a descriptive indication but rather as a means to attract clients.

On the Lebanese level in the absence of any provision expressly prohibiting the protection of marks having a functional role, article 68 of the system regulating commercial and Industrial Property issued by regulation no. 2385 may be relied upon. This article provides for the following:

“Are considered marks... any sign aiming at distinguishing things from others and indicating the source of the goods...”

It can be deduced from the above text that in order for a sign to be capable of distinguishing things from others, it must not be taken from or based on elements, descriptions or characteristics common between the things to be distinguished, as it may not be composed of the elements mostly used for decorative or persuasive targets.



⁽³⁰⁾ <http://www.lectlaw.com/files/inp25.htm>

Conclusion

The invention of colored TV and the developments in the field of printing resulted in the emergence of the importance of color in the fields of publicity and the packaging industry⁽³¹⁾.

This technical development has participated in accentuating the effect of colors on the sale of products and services and their demand by the consumers.

Parallel to these technical developments, traders frequently use colors in order to distinguish their products and services by affixing it on the product itself, on its packaging, on the tangible things used in conjunction with the services or through advertising. At the same time that the world market of goods, products and services is getting larger, the color marks play a more prominent and important role, specially in a market where languages and educational limits are different. Nevertheless and due to the difference between legislations in the various countries, a shadow of doubt covers the economic society as to the possibility of registering and protecting the color mark and those composed of a single color. Therefore, the success to be achieved in the world market by a specific good, in relation to the color mark, shall go astray if it is not possible to protect this mark.

In Lebanon, and in the light of the actual legal position, it is our opinion that there is no objection to register and protect colors as a trademark being considered signs capable of distinguishing the products and services of a specific trader/service provider from those similar provided by his competitors. This opinion is based on the fact that regulation no. 2385 dated 17/01/1924 defines a trademark as being any sign capable of distinguishing products. This of course does not, in our opinion, exempt the Lebanese legislator from the necessity of amending this regulation, namely the provision defining a trademark and taking a decisive position as concerns the color mark and more specifically the extent to which protection covers the color per se and the color combination as well, or this latter alone.

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