

THE REGISTRABILITY OF SINGLE COLOURS AS TRADE MARKS

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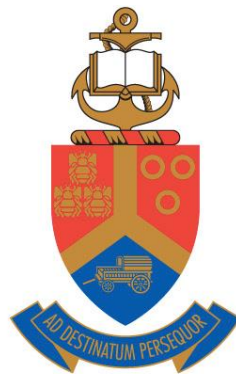
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CHAPTER 1

The Trade Mark Registrability Requirements in South Africa, the United Kingdom, and in the United States of America.

1.1 Introduction

When looking at powerful brands in the world, colour certainly plays a significant role in product and service recognition. From an advertising perspective, graphic designers use certain colours to evoke emotions¹ and send subliminal messages to the consumer. The purpose of using certain colours is to establish brand association in the mind of the consumer. The question arises: can colour really be accepted as a source identifier and consequently a trade mark?

In order to understand the importance of the use of a colour in having a successful brand, the following examples of successful colour registrations should be considered:

In 1845 Charles Lewis Tiffany² used a shade of blue on his company's first jewellery catalogue, and today this blue is used in advertisements and associated with Tiffany & Co, a company with a \$13 billion market cap and \$4.4 billion in assets³. According to the company catalogue, Charles Lewis Tiffany selected the colour after taking inspiration from a turquoise gemstone that was popular that year. Tiffany & Co. registered the colour trade mark in 1998, using its own custom Pantone number, 1837,⁴ to represent the year in which the company was founded⁵.

¹ Ellis M, *Branding Colors: Everything You Need To Choose Your Brand's Color Palette*, available at <https://99designs.com/blog/tips/branding-colors/> [accessed on 09 February 2020].

² Conrat T; *Trademarked Colors we didn't know was trade marked*; available at <http://mentalfloss.com/article/27396/9-trademarked-colors> [accessed on 15 August 2019].

³ Tiffany & Co.; Forbes statistics available at <https://www.forbes.com/companies/tiffany-co/#5ecc4f612d04> [accessed 15 August 2019].

⁴ Ibid at footnote 2.

⁵ Albertson H, *Tiffany & Co. When and how was it founded?* November 2017, *The eye of Jewellery*, available at <https://theeyeofjewelry.com/tiffany-co/tiffany-co-news/tiffany-co-when-and-how-was-it-founded/>, [accessed 17 August 2019].

In 1980 Owens-Corning Fiberglas Corporation⁶ registered the colour pink⁷ for roofing and insulation materials⁸. This specific material is now known as the Pink Panther. The company licenses both the product and the use of their Pink Panther packaging.⁹ Today the company is a Fortune 500 company and employs approximately 19,000 people around the world. This case will be discussed in Chapter 2.

Another protected shade of pink is more commonly known as, “*Barbie*”¹⁰ pink. Mattel Inc¹¹ registered its pink trade mark in more than 100 classes¹². In 1997¹³ Mattel sued MCA Records¹⁴ when Aqua’s¹⁵ “*Barbie Girl*”¹⁶ cover resembled Barbie packaging so closely that it mainly consisted of the “*Barbie*” Pink colour.¹⁷ In 2018, Barbie’s sale revenue was about \$1088 million.¹⁸ This case will be discussed in more detail in Chapter 4.

It can thus be said that colour plays a very significant role when considering the impact of colour on the above-mentioned brands. Understanding the importance of branding and colour, and the connection between branding and trade marks, the question arises: can single colours be registered as trade marks?

⁶ In *Re Owens-corning Fiberglas Corporation*, 774 F.2d 1116 (Fed. Cir. 1985)

⁷ Conrat T; *Trademarked Colors we didn't know was trade marked*”; available at <http://mentalfloss.com/article/27396/9-trademarked-colors> [accessed on 15 August 2019].

⁸ In *Re Owens-corning Fiberglas Corporation*, 774 F.2d 1116 (Fed. Cir. 1985)

⁹ *Ibid* at footnote 8.

¹⁰ Pantone colour - Hex - E0218A - *Barbie pink*

¹¹ Mattel Inc, with headquarters in El Segundo, California

¹² *Mattel Inc v. MCA Records*, 296 F.3d 894 (9th Cir. 2002).

¹³ *Ibid* at footnote 12.

¹⁴ Now referred to as Universal Music Group

¹⁵ Aqua was a Danish-Norwegian Europop music group.

¹⁶ Aqua, *Barbie Girl*; Recorded in 1996; released 14 May 1997.

¹⁷ *Ibid* at footnote 12.

¹⁸ O’Connell L, “*Gross sales of Mattel's Barbie brand worldwide from 2012 to 2018*” available at <https://www.statista.com/statistics/370361/gross-sales-of-mattel-s-barbie-brand/> [accessed 17 August 2019].

At the outset, therefore, the issue of what constitutes a trade mark needs to be understood. This subject will be dealt with by way of looking at various jurisdictions.

Globally, the primary objective of a trade mark is to distinguish goods and services in the marketplace from other goods and services. In *Adidas AG and another v Pepkor Retail Limited*,¹⁹ the court held that the distinguishing function of a trade mark is to prevent deception and confusion amongst consumers as it allows them to differentiate between goods and services, and make decisions accordingly.

In the European case, *Hoffman La Roche & Co v Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse*,²⁰ the court held that the purpose of a trade mark is to prevent confusion between products and services in the marketplace. Thus, it can be said that there should be no confusion in the mind of a consumer as to the origin of a product or service.

A trade mark must therefore serve as a badge of origin, which means that a trade mark must indicate the connection between the supplier and its goods or services. This was confirmed for example in the case of *Verimark (Pty) Limited vs Bayerische Motoren Werke Aktiengesellschaft*²¹. The court held that the purpose of a trade mark is to serve as a badge of origin and must be capable of distinguishing goods and services from those of a competitor:

“It is trite that a trade mark serves as a badge of origin and that trade mark law does not give copyright-like protection. Section 34(1)(a), which deals with primary infringement and gives in a sense absolute protection, can, therefore, not be interpreted to give greater protection than that which is necessary for

¹⁹ *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA, para 20

²⁰ *Hoffmann-La Roche & Co. AG v. Centrafarm Vertriebsgesellschaft. Pharmazeutischer Erzeugnisse mbH*, Case 102/77, [1978] ECR 113.

²¹ *Verimark (Pty) Ltd v Bayerische Motoren Werke Aktiengesellschaft ; Bayerische Motoren Werke Aktiengesellschaft v Verimark (Pty) Ltd* (250/06) [2007] ZASCA 53; [2007] SCA 53 (RSA) ; 2007 (6) SA 263 (SCA) (17 May 2007).

attaining the purpose of a trade mark registration, namely protecting the mark as a badge of origin .”²²

A trade mark also serves as a guarantee to consumers as to the quality of goods and services. Consumers find comfort in knowing the goods or services were produced by the certain manufacturer and in the presumed quality thereof. This was confirmed in the *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another*²³ case. In this case, the court held:

“From the consumer’s point of view, they facilitate choice by identifying the product and guaranteeing its provenance and presumed quality.”²⁴

Considering the above, it is important to understand the statutory definition of a trade mark. As a starting point, international treaties and organisations have set the minimum requirements and standards when it comes to dealing with the definition of a “mark”, “trade marks” and more specifically “non-traditional” trade marks. The most applicable treaties and organisations will be discussed below.

1.2 Aim of This Study

It is important to have a broad understanding of the most important treaties and organisations regarding non-traditional trade marks. Thus, in introducing a new concept which is previously unexplained, this study will focus on how various jurisdictions, trade mark registries and courts have dealt with the registration and enforcement of single colour trade marks. This study will focus on the definition of a “mark” and a “trade mark” in South Africa, the United Kingdom and in the United States

²² *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft; Bayerische Motoren Werke AktienGesellschaft v Verimark (Pty) Ltd* (250/06) [2007] ZASCA 53; [2007] SCA 53 (RSA); 2007 (6) SA 263 (SCA) (17 May 2007), para 5.

²³ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC).

²⁴ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC), para 80.

of America and whether or not the applicable legislation makes provision for the registration and enforcement of single colours as trade marks.

1.3 The Agreement on Trade-Related Aspects of Intellectual Property Rights

The Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as TRIPS) sets out the minimum standards that all signatories to the agreement must adhere to when providing protection for the different forms of intellectual property rights. TRIPS is administered by the World Trade Organization (hereinafter referred to as WTO) and came into effect in January 1995.²⁵

Article 15²⁶ of TRIPS defines a trade mark as follows:

“Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”²⁷

From the above, it is clear that a trade mark must be capable of distinguishing goods and services in the course of trade from other goods and services in trade. Article 15²⁸ makes provision for a combination of colours to be registered as trade marks, but makes no express provision for single colour trade marks.

²⁵ WIPO, Uruguay Round Agreement: TRIPS Trade-Related Aspects of Intellectual Property Rights, available at https://www.wipo.int/treaties/en/text.jsp?file_id=305907 [accessed 23 October 2019]

²⁶ Article 15 of Agreement on Trade-Related Aspects of Intellectual Property Rights.

²⁷ Ibid at footnote 26.

²⁸ Ibid at footnote 26.

1.4 The Trade Mark Law Treaty and the Singapore Treaty on the Law of Trade Marks

The purpose of the Trade Mark Law Treaty (hereinafter referred to as TLT)²⁹ is to harmonise³⁰ and simplify the administrative processes placed on trade mark registration offices around the world. The TLT is further aimed at simplifying trade mark application processes in multiple countries. The TLT has 51 signatories³¹. In today's modernised era, trade mark applications are preferred to be made electronically. Therefore, provisions were made to accommodate the electronic filing processes³².

The shift towards electronic filing of trade mark applications led to the implementation of the Singapore Treaty on the Law of Trade Marks (hereinafter referred to as STLT)³³.

The STLT aims to “*create a modern and dynamic international framework for the harmonisation of administrative trade mark registration procedures.*”³⁴ The STLT came into force on 27 March 2006³⁵ and had a focus specifically on the modernisation of trade mark application procedures. The STLT takes into consideration the recent developments in technology to enable faster and more effective trade mark applications worldwide and therefore make provision for electronic communications.³⁶

²⁹ Trademark Law Treaty (1994).

³⁰ Trademark Law Treaty (TLT), WIPO, available at <https://www.wipo.int/treaties/en/ip/tlt/> [accessed 11 February 2020]

³¹ TLT Notification No. 1 Trademark Law Treaty, Signatories Accessed at https://www.wipo.int/treaties/en/notifications/tlt/treaty_tlt_1.html [Accessed on 24th of May 2019]

³² Trademark Law Treaty (TLT), WIPO, available at <https://www.wipo.int/treaties/en/ip/tlt/> [accessed 11 February 2020]

³³ Singapore Treaty on the Law of Trade Marks 2006.

³⁴ Kobus J, Bretz A & Hassani A *Become a Successful Designer. Protect and Manage Your Design Rights Internationally: Protect and Manage Your Design Rights Internationally* (2013) 124.

³⁵ WIPO-Administered Treaties, *Singapore Treaty on the Law of Trademarks*, WIPO Webpage, available at <https://www.wipo.int/treaties/en/ip/singapore/> [accessed 09 September 2019].

³⁶ Summary of the Singapore Treaty on the Law of Trademarks (2006) available at https://www.wipo.int/treaties/en/ip/singapore/summary_singapore.html [Accessed on 24th of May 2019].

The STLT has a total of 49 contracting parties and 147 World Intellectual Property Organization (hereinafter referred to as WIPO) Member States³⁷. The United States of America, the United Kingdom and some European countries are party to the STLT. However, South Africa is not yet a signatory³⁸.

The STLT is important in this context, as it specifically makes provision³⁹ for the recognition of non-traditional trade marks.⁴⁰ It applies to all types of marks (which are visible), such as “*holograms, three-dimensional marks, colour, position and movement marks*”, and marks such as “*sound, olfactory or taste and feel marks*”⁴¹ (non-visible). Article 3 of this treaty specifies and explains how each of these marks may be represented in the application.⁴²

The STLT has a number of rules on non-traditional trade marks. In his article, Marcus Höpperger discussed how trade marks were evolving, and made the following statement:

*“...modern trademark law is open to other subject matter being used and protected as trademarks, provided that certain conditions are met.”*⁴³

³⁷ Summary of the Singapore Treaty on the Law of Trademarks (2006) available at https://www.wipo.int/treaties/en/ip/singapore/summary_singapore.html [Accessed on 24th of May 2019].

³⁸ Ibid footnote 37.

³⁹ Höpperger M, *Non-Traditional Marks – Singapore Treaty Enters into Force, WIPO magazine, 2009, volume1/2009*

⁴⁰ The Singapore Treaty on the Law of Trademarks (STLT), Questions and Answers (2015), available at https://www.wipo.int/edocs/pubdocs/en/wipo_pub_508.pdf, page 1. [Accessed on 24th of May 2019]

⁴¹ The Singapore Treaty on the Law of Trademarks (STLT), Questions and Answers (2015), available at https://www.wipo.int/edocs/pubdocs/en/wipo_pub_508.pdf, page 3. [Accessed on 24th of May 2019].

⁴² Ibid at footnote 40.

⁴³ Höpperger H; *Non-Traditional Marks – Singapore Treaty Enters into Force* (February 2009) available at https://www.wipo.int/wipo_magazine/en/2009/01/article_0002.html [Accessed on 24th of May 2019].

The Singapore Treaty is therefore of specific relevance when it comes to the registrability and enforcement of single colours as trade marks.

1.5 South Africa

The South African Trade Marks Act ⁴⁴ defines a “mark” as:

*“any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned”.*⁴⁵

According to the Companies and Intellectual Property Commission guidelines on trade mark registrations, colour falls within the scope of non-traditional trade marks.⁴⁶

In Section 2 of the Trade Marks Act,⁴⁷ the definition of a trade mark is as follows:

“... other than a certification trade mark or a collective trade mark, means a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person.”

⁴⁴ Trade Marks Act No 194 of 1993.

⁴⁵ Section 2 of Trade Marks Act No 194 of 1993.

⁴⁶ Guidelines on the examination of trade mark Applications, insight into the practice of the office of the registrar of trade marks, Version 1, February 2017 available at, page 27, available at http://www.cipc.co.za/files/9514/8844/1228/Guidelines_on_the_Examination_of_Trade_Mark_Applications_South_African_Trade_Marks_Office_2017.pdf [accessed 8June 2019] .

⁴⁷ Section 2 of the Trade Marks Act No 194 of 1993.

1.6 The United Kingdom

According to the United Kingdom Trade Marks Act,⁴⁸ a “trade mark” means:

*“any sign which is capable of being represented on the register in a manner which enables the registrar, other competent authorities, and the public to determine the clear and precise subject matter of the protection afforded to the proprietor”.*⁴⁹

The Act further requires a trade mark to distinguish “goods or services of one undertaking from those of other undertakings”.⁵⁰ A trade mark may, “in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging”⁵¹.

1.7 The United States of America

Trade marks in the United States of America are regulated in terms of the Trademark Act⁵² as codified in 15 U.S.C. Section 1127 (also known as the Lanham Act), which distinguishes between a trademark and a service mark.

According to the Act, “mark” includes any “*trademark, service mark, collective mark, or certification mark*”⁵³ entitled to registration under the Act, whether registered or not.

⁴⁸ Trade Marks Act 1994, Section F1(1).

⁴⁹ Part I Section 1(1)(a) of the Trade Marks Act, 1994.

⁵⁰ Part I Section 1(1)(b) of the Trade Marks Act, 1994.

⁵¹ Part I Section 1 Trade Marks Act, 1994.

⁵² Trademark Act of 1946 codified in 15 U.S.C.

⁵³ Trademark Act of 1946 as codified in 15 U.S.C - Lanham Act

Section 45 of the Trademark Act⁵⁴ defines a trademark as “*any word, name, symbol, or device, or any combination thereof*,”⁵⁵ that identifies and distinguishes the goods of one party from those of others and must be able to indicate the source of the goods. No reference is specifically made to colour.

1.9 Research Problem

Given the importance of colour in the branding of goods and services to suggest and identify their source, under what conditions and circumstances may a single colour satisfy the legal requirements of being capable of distinguishing their goods and services from the goods and services of competitors?

This dissertation interrogates and compares the position in various countries. The registrability of colours as trade marks has been tested in various jurisdictions over the years. However, the question remains, can a single colour serve and be registered as a trade mark and ultimately be used and enforced as a trade mark?

1.10 Research Questions

1. What are the trade mark registrability requirements in South Africa, the United Kingdom and the United States of America?
2. What are the legal requirements to register a single colour trade mark in South Africa, the United Kingdom and in the United States of America?
3. The South African Cadbury Case: How Prepared Are South African Courts to Grant a Trade Mark Registration for a Single Colour Compared to the United Kingdom?
4. How does South Africa, the United Kingdom and in the United States of America enforce single colours trade marks?

⁵⁴ Trademark Act of 1946, Section 45.

⁵⁵ Ibid at footnote 51.

1.11 Structure of the Dissertation

Chapter 1:

The trade mark registrability requirements in South Africa, the United Kingdom and in the United States of America.

Chapter 2:

The legal requirements to register a single colour as a trade mark in South Africa, the United Kingdom and in the United States of America.

Chapter 3:

The South African Cadbury Case: How Prepared Are South African Courts to Grant a Trade Mark Registration for a Single Colour Compared to the United Kingdom?

Chapter 4:

The enforcement of single colours as trade marks in South Africa, the United Kingdom and in the United States of America.

Chapter 5:

Conclusion and recommendations.

CHAPTER 2

The Legal Requirements to Register a Single Colour as a Trade Mark in South Africa, the United Kingdom and in the United States of America.

2.1 Introduction

There are some similarities between the registrability requirements for the registration of a trade mark in South Africa, the United Kingdom and in the United States of America. The most prominent requirement in all the above jurisdictions is that a trade mark must be distinctive and indicate the origin of the goods and services in the marketplace. In the following chapter, the legal requirements to register a single colour as a trade mark in these various jurisdictions will be discussed.

2.2 South Africa

As stated in Chapter 1, in terms of section 2(1) of the Act, a mark must be capable of graphical representation. In South Africa, colour trade marks fall within the scope of non-traditional marks as stipulated in the Companies and Intellectual Property Commission of South Africa guidelines⁵⁶(hereinafter referred to as CIPC guidelines). The CIPC is the governing commission for trade mark, patent and design registrations in South Africa. Further, the Act expressly makes provision for the registrability of colour trade marks, unlike other non-traditional marks.

The strict criteria, as provided by the CIPC guidelines, govern the registration of a single colour as a trade mark. An application for registration of a *shape, configuration, colour or pattern of goods* as a trade mark in relation to goods could be accepted if:

- the application is lodged in relation to goods;

⁵⁶ Guidelines on the examination of trade mark Applications, insight into the practice of the office of the registrar of trade marks, Version 1, February 2017 available at http://www.cipc.co.za/files/9514/8844/1228/Guidelines_on_the_Examination_of_Trade_Mark_Applications_South_African_Trade_Marks_Office_2017.pdf [accessed 8 June 2019].

1. *the shape, configuration, colour or pattern is applied to the goods;*
2. *the shape, configuration, colour or pattern, as applied to the goods, is distinctive in relation to the specific goods;*
3. *the application clearly and precisely defines the shape, configuration, colour or pattern of goods through the appropriate endorsement, and that the required representations are attached;*
4. *the shape, configuration, colour or pattern of goods is not necessary to obtain a specific technical result;*
5. *the shape, configuration, colour or pattern of goods does not result from the nature of the goods themselves; and □ the shape, configuration, colour or pattern of goods is not likely to limit the development of any art or industry.*⁵⁷

The CIPC guidelines further require a sample of the colour proposed for registration in order to actualize the requirement of graphical representation⁵⁸. In applying for registration, the applicant must also include a description, in writing, describing how the colour will be applied in relation to the goods and services.

*“where a trade mark consists only of a colour, the relevant international colour code will be required for examination purposes. in cases such as these individual register sheets showing details of colour endorsements will be printed and included in the search reports”*⁵⁹

One of the most renowned cases dealing with the application for the registration of a single colour as a trade mark in South Africa is of the case of *Cadbury Ltd v Beacon Sweets & Chocolates (Pty) Ltd*⁶⁰:

⁵⁷ Guidelines on the examination of trade mark Applications, insight into the practice of the office of the registrar of trade marks, Version 1, February 2017, page 51 available at http://www.cipc.co.za/files/9514/8844/1228/Guidelines_on_the_Examination_of_Trade_Mark_Applications_South_African_Trade_Marks_Office_2017.pdf [accessed 8 June 2019]

⁵⁸ Ibid at footnote 57.

⁵⁹ Ibid at footnote 57.

⁶⁰ *Cadbury Ltd v Beacon Sweets & Chocolates (Pty) Ltd* 2004 BIP 74 (RTM)

“Statutory monopolies are the exception, not the rule and they need to be justified.”⁶¹

In the above case, Cadbury applied for the registration of the colour purple in relation to the packaging for confectionery. Cadbury made the argument that the colour had acquired distinctiveness by it using the colour on a variety of their confectionery products. In this case, Cadbury’s application was rejected. It was held by the Registrar that no single person may have a monopoly right in a single colour.⁶²This case will be discussed in more detail in Chapter 3.

The above decision led to the argument that a single colour trade mark can only be registered if it can be proven that it acquired distinctiveness through use in the marketplace⁶³. Alternative platforms had to be considered.

The apparent lack of success of Cadbury led to an increase in complaints being lodged with the Advertising Standards Authority of South Africa (hereinafter referred to as ASA)⁶⁴. Applicants preferred to enforce their rights through the ASA as this avenue seemed to be more successful for applicants. which has now been replaced by the Advertising Regulatory Board (hereinafter referred to as ARB) of South Africa⁶⁵.

The ARB administers the widely-accredited Code of Advertising Practice which in turn regulates the content of advertising in South Africa. The ARB provides advertising codes⁶⁶ that regulate the way in which advertising is conducted in South Africa as a way of consumer protection.

⁶¹ Cadbury Ltd v Beacon Sweets & Chocolates (Pty) Ltd 2004 BIP 74 (RTM)

⁶²Ibid at footnote 61.

⁶³ Ibid at footnote 61.

⁶⁴ Went into Liquidation in their 50th year of existence according to the Advertising Regulatory Board, Consumer protection through responsible advertising, available at <http://arb.org.za/codes.html> [accessed on 8 June 2019].

⁶⁵ Advertising Regulatory Board, Consumer protection through responsible advertising, available at <http://arb.org.za/codes.html> [accessed on 8 June 2019].

An interesting case in this regard is the ASA complaint of *South African Breweries (Pty) Ltd v Brandhouse Beverages (Pty) Ltd*⁶⁷ which tested the goodwill and reputation attached to a combination of colours. South African Breweries (Pty) Ltd (hereinafter referred to as SAB), lodged a complaint against Brandhouse Beverages in terms of clause 12.19⁶⁸ of the then ASA Code of Practice, for its use of the colours silver and green accompanied by the words 'Lite' on one of their beer products, specifically Amstel Lite. The applicant, in this case, claimed that this passed-off on their product, namely Castle Lite.⁶⁹

SAB submitted evidence that Castle Lite had been on the market for over 20 years. A market survey, reflected that 84% of people who were shown the Amstel Lite label, identified it as Castle Lite⁷⁰. The ASA found that SAB had a reputation and goodwill in the colour combination in relation to beer, and therefore acquired distinctiveness through use⁷¹.

2.3 The United Kingdom

The principles and requirements, as set out in the European Union decision, *Libertel Groep BV v Benelux-Merkenbureau ("Libertel")*,⁷² and *Ralf Sieckmann v Deutsches Patent- und Markenamt ("Sieckman")*⁷³ must be applied when considering the registration requirements for a trade mark in the United Kingdom. The Libertel case set out the test for assessing the registrability of single colour trade marks. This case will be discussed in more detail on Chapter 2 of this dissertation.

⁶⁷ *South African Breweries (Pty) Ltd v Brandhouse Beverages (Pty) Ltd*, Advertising Standard Authority directorate decision 6 February 2015.

⁶⁸ Ibid at footnote 67, para 10.

⁶⁹ Ibid at footnote 67, para 10-11.

⁷⁰ Ibid at footnote 67, par40

⁷¹ Ibid at footnote 67

⁷² *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-0379.

⁷³ *Ralf Sieckmann v Deutsches Patent- und Markenamt ('Methylcinnamat')*, [2002] Case C-273/00 ECR I-11737, para 38 (Hereinafter referred to as "Sieckmann").

The most important case dealing with the application for registration of a single colour as a trade mark in the United Kingdom is *Société des Produits Nestlé SA v Cadbury UK Ltd*.⁷⁴

Cadbury UK Ltd (“*Cadbury*”) applied for the registration of the colour of purple (Pantone 2685C) as “*applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods*”⁷⁵ in relation to a range of chocolate-based goods in class 30 of the Nice Classification⁷⁶.

Société des Produits Nestlé SA (“*Nestlé*”) opposed the application by Cadbury. The opposition was based on the ground that Cadbury was only entitled to register the mark in respect of goods for which the colour had acquired distinctiveness. According to Nestlé, Cadbury had only acquired distinctiveness in the colour insofar as it is applied to the packaging for chocolate bars and chocolate in tablet form, eating chocolate, drinking chocolate and preparations for making drinking chocolate. Nestlé submitted that the colour purple did not constitute a sign and nor was it capable of graphical representation in terms of Article 2 of the Directive.⁷⁷

In October 2012, the registry held that Cadbury was entitled to register the colour purple as a trade mark in respect of its packaging used for milk chocolate confectionery, although this could not extend to other types of chocolate or goods.⁷⁸

Nestlé appealed the decision and the appeal was upheld. The registry’s decision allowing the registration of Cadbury’s trade mark for the colour purple was consequently overturned. The Court of Appeal found that the description of the trade mark application, as applied for and properly interpreted, did not constitute “*a sign*” that is satisfied the requirement of graphical representation within Article 2 of the United Kingdom Act. The court also found that it would “*offend against the principle of*

⁷⁴ *Société des Produits Nestlé SA v Cadbury UK Ltd* (2013) RPC 14 (ChD.), para 2.

⁷⁵ *Société des Produits Nestlé SA v Cadbury UK Ltd* (2013) RPC 14 (ChD.), para 4.

⁷⁶ Nice Classification, 11th Addition

⁷⁷ *Société des Produits Nestlé SA v Cadbury UK Ltd* (2013) RPC 14 (ChD.), para 79.

⁷⁸ *Ibid* at footnote 77.

fairness by giving a competitive advantage to Cadbury and by putting Nestlé and its other competitors at a disadvantage”.⁷⁹ This case will be discussed in more detail in Chapter 3 of this dissertation.

The *Libertel Groep BV v Benelux-Merkenbureau*⁸⁰ case dealt with the registration of a single colour as a trade mark in the European Union. The court held that in order to meet the requirements of the *Sieckmann*⁸¹ test, the application for registration of a colour must be accompanied by a sample of the colour and a “*designation of a colour using an internationally recognised identification code*”.⁸² The purpose of providing the internationally recognised colour code is that it provides legal certainty in order to comply with the requirements as set out in the *Sieckmann*⁸³ case. When a colour is represented; it should be clear and precise as required by the criteria discussed in *Libertel* case above. However, the court held the following:

“...it must be borne in mind that, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message...

...However, that factual finding would not justify the conclusion that colours per se cannot, as a matter of principle, be considered to be capable of distinguishing the goods or services of one undertaking from those of other undertakings. The possibility that a colour per se may in some circumstances serve as a badge of origin of the goods or services of an undertaking cannot be ruled out. It must therefore be accepted that colours per se may be capable of distinguishing the goods or services of one undertaking from those of other undertakings.”⁸⁴

⁷⁹ *Société des Produits Nestlé SA v Cadbury UK Ltd* (2013) RPC 14 (ChD.), para 79.

⁸⁰ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-0379.

⁸¹ *Ibid* at footnote 80, para 28.

⁸² *Ibid* at footnote 80, para 37.

⁸³ *Ibid* at footnote 80, para 29.

⁸⁴ *Ibid* at footnote 80, para 40 and 41.

2.4 The United States of America

Firstly, it is important to understand how the registration procedure in the United States of America functions. There are two registers on which trade marks can be registered.⁸⁵ The first register is referred to as the principal register⁸⁶. Which register is used where trade marks are inherently distinctive, or if the marks have acquired distinctiveness⁸⁷ through use.⁸⁸

In the case where marks are not yet considered to be sufficiently distinctive to qualify for registration on the principal register, they can be registered on the supplemental register until distinctiveness is acquired.⁸⁹

Section 1127 of the Lanham Act is similar to Article 15 of TRIPS insofar as it provides examples as to what constitutes a trade mark (this list is not exhaustive)⁹⁰. This section allows various kinds of marks, including non-traditional trade marks such as sound, scents and colours to qualify as trade marks. Section 2(f) of the Lanham Act provides:

“Nothing herein shall prevent the registration of a mark used by the Applicant which has become distinctive of the Applicant’s goods in commerce.”⁹¹

Considering the above, an argument can be made that a colour trade mark may be registered, if it has acquired distinctiveness through use on the principal register. The first requirement for registration of a colour as a trade mark in the United States of America, is therefore that it has to have acquired a secondary meaning or acquired distinctiveness through use.

⁸⁵ Sharpe *C Patent, Trade Mark, and Copyright Searching on the Internet* (1999) 71

⁸⁶ Lanham Act § 1052, 15 U.S.C. § 1052

⁸⁷ Lanham Act § 1052, 15 U.S.C. § 1127.

⁸⁸ Ibid at footnote 89.

⁸⁹ Lanham Act § 1052, 15 U.S.C. § 1052

⁹⁰ Article 15 of the Agreement on Trade Related Aspects of Intellectual Property Same as text

⁹¹ Lanham Act § 2(f), 15 U.S.C. § 1127.

In the early case of *Leschen & Sons Rope Co. v. Broderick Jacobson Products Co*⁹², in 1906, the court held that colour may not be registered as a trade mark as it does not fulfil the primary function⁹³ of a trade mark. This was, the court held, because a single colour is not sufficient to distinguish goods and services or have the capability to indicate origin:

*“It is the plain intention of the act that, where the distinction of the mark depends upon color, that will not do. You may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you can not register a mark of which the only distinction is the use of a color, because practically, under the terms of the act, that would give you a monopoly of all the colors of the rainbow.”*⁹⁴

In *Campbell Soup Co. v. Armour & Co*,⁹⁵ in 1949, the court held that a monopoly right regarding a red and white label for wines couldn't be granted to a single proprietor. The court further held there are only so many colours to be used, and in granting the proprietor exclusive rights in the colour combination, would lead to an unfair advantage being awarded to the competition.⁹⁶ This case specifically dealt with the *colour depletion doctrine*.

The *colour depletion doctrine* is to a theory that there are a limited number of colours in the colour palette and therefore it would be unfair to grant a monopoly right to one individual. The purpose of the doctrine is to prohibit ownership of colours as trade marks, that when monopolized, would hinder competition⁹⁷.

⁹² *Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U. S. 166, 171 (1906), .

⁹³ As explained in Chapter 1 of this dissertation.

⁹⁴ *Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U. S. 166, 171 (1906) at Page 201 U. S. 172

⁹⁵ *Campbell Soup Co. v. Armour Co.*, 175 F.2d 795,798 (3d Cir. 1949).

⁹⁶ *Campbell Soup Co. v. Armour Co.*, 175 F.2d 795,798 (3d Cir. 1949) at page 798

⁹⁷ Functionality Doctrine Law and Legal Definition, Us Legal, available at <https://definitions.uslegal.com/f/functionality-doctrine/> [accessed on 9 June 2019]

*“What the plaintiffs are really asking for, then, is a right to the exclusive use of labels which are half red and half white for food products. If they may thus monopolise red in all of its shades the next manufacturer may monopolise orange in all its shades and the next yellow in the same way. Obviously, the list of colours will soon run out.”*⁹⁸

Another eminent case on acquired distinctiveness, was *In Re Owens-Corning Fiberglas Corporation*⁹⁹ .

In this case, the applicant applied for registration of the colour pink in relation to building insulation material. The court found that the colour pink had acquired a secondary meaning because this colour had been used on insulation material for 29¹⁰⁰ years, and when considering the applicant’s financial expenditure on advertising the product, that the colour pink had become well known in the market.¹⁰¹ The court further held that the colour pink was so well known in the market that it was sufficient to distinguish the applicant’s goods from those of its competitor.

The breakthrough case in 1995 in the United States of America concerning the registration of a single colour as a trade mark, is the case of *Qualitex Co. v. Jacobson Products Co Inc.*¹⁰² The applicant applied for registration of the colour green in relation to cleaning pads. The court stated the following: "*aesthetic functionality was the central question in this case*"¹⁰³ and further:

“Although it is important to use some colour on press pads to avoid noticeable stains, the court found no competitive need in the industry for the green-gold colour, since other colours are equally usable. Accordingly, unless there is some

⁹⁸ *Campbell Soup Co. v. Armour Co* 175 F.2d 795,798 (3d Cir. 1949) at para 798

⁹⁹ *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985)

¹⁰⁰ *Ibid* at footnote 99.

¹⁰¹ *Ibid* at footnote 99.

¹⁰² *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995).

¹⁰³ Trademark Manual of Examining Procedure (October 2018) available at <https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e1975.html> [accessed 9 February 2020)

special reason that convincingly militates against the use of colour alone as a trademark, trademark law protects Qualitex's use of its green-gold colour."¹⁰⁴

The "secondary meaning" requirement was established as the most vital requirement to register a colour as a trade mark in the United States of America. The court also established certain factors to be taken into consideration when establishing if a colour acquired a secondary meaning¹⁰⁵. These factors include:

1. *the period of time the trade mark had been used;*
2. *successful sales during this time;*
3. *advertising expenditure and media coverage; and*
4. *whether the colour was required for use in the industry.*¹⁰⁶

The *Qualitex* case led to severe criticism, as academics were convinced that the registration of a single colour would ultimately lead to unfair competition, as the monopoly right in a single colour would certainly constrain competition.¹⁰⁷

In 2000, the *Wal-Mart Stores, Inc. v. Samara Bros* case the court stated that a colour mark can only be registered on the Principal Register if it acquired distinctiveness through use:

*"Color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f)."*¹⁰⁸

The second registration requirement in the United States of America is that the colour must not fulfil an aesthetic or functional purpose. Therefore, the mark must not be

¹⁰⁴ French S; *Cases and Text on Property*, Seventh Edition; New York law School; 2019; page 222.

¹⁰⁵ *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985)

¹⁰⁶ *Ibid* at footnote 105.

¹⁰⁷ A. Bartow, "The True Colors of Trade Mark Law: Greenlighting a Red Tide of Anti Competition Blues", *Kentucky Law Journal*, Vol. 97, No. 2, 2008 available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1314951 [accessed 9 June 2019].

¹⁰⁸ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211-12, 54 USPQ2d 1065, 1068 (2000).

functional¹⁰⁹ in terms of the functionality doctrine, or serve a functional purpose¹¹⁰. The functionality doctrine provides “...that the functional features of a trademark, or those features having primarily a utilitarian purpose, are not granted protection”¹¹¹. A color mark is not registrable on the Principal Register under §2(f), or the Supplemental Register, if the color is functional¹¹²

One of the cases dealing with aesthetic functionality is the case of *Christian Louboutin v. Yves Saint Laurent*.¹¹³

Christian Louboutin is a well-known designer and designs some of the world’s most elaborate shoes¹¹⁴. The designer is known for his famous “red bottom shoes”.¹¹⁵ Christian Louboutin’s registration for the bright red undersole as a trade mark was granted in 2008. In this case, Yves Saint Laurent (hereinafter referred to as YSL) released a collection of shoes including shoes with bright undersoles.¹¹⁶

Christian Louboutin applied for a preliminary injunction preventing YSL from marketing and selling their shoes with a red undersole. YSL then filed a counterclaim asking the court to cancel Christian Louboutin’s trade mark, on the basis that the trade mark lacked distinctiveness and granted an unfair monopoly to the proprietor. YSL further

¹⁰⁹ Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 165-66, 34 USPQ2d 1161 (1995)

¹¹⁰ Trademark Manual of Examining Procedure (October 2018) available at <https://tmepp.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e1975.html> [accessed 9 February 2020]

¹¹¹ Functionality Doctrine Law and Legal Definition, Us Legal, available at <https://definitions.uslegal.com/f/functionality-doctrine/> [accessed on 9 June 2019]

¹¹² *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985)

¹¹³ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013).

¹¹⁴ Peter O, *King of soles Christian Louboutin reveals he'd love to see the Queen wearing his shoes* available at <https://www.independent.co.uk/life-style/fashion/christian-louboutin-interview-queen-exhibition-paris-2020-red-soles-a8988251.html> [accessed 9 February 2020]

¹¹⁵ Schneier M, *Christian Louboutin on Cardi B and His 'Red Bottoms'*, The New York (2 October 2017) Times available at <https://www.nytimes.com/2017/10/02/fashion/christian-louboutin-cardi-b-bodak-yellow-paris-fashion-week.html> [accessed 9 June 2019]

¹¹⁶ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) at background.

stated that the registered trade mark was purely ornamental and therefore an aesthetic, functional trade mark.¹¹⁷

The court found that it would be unfair to grant a monopoly¹¹⁸ to the colour red in relation to undersoles. The court ordered the trade mark registration had to be amended to limit Louboutin's trade mark protection for the colour red to the sole of the shoe, with the rest of the shoe being a contrasting colour. The court directed the amendment of the registration as follows:

*"...make appropriate entry upon that Office's records to reflect that U.S. Trademark Registration No. 3,361,597, held by Christian Louboutin and dated January 1, 2008, is limited to a red lacquered outsole on footwear that contrasts with the colour of the adjoining ("upper") portion of the shoe."*¹¹⁹

The enforcement of the above mentioned trade mark will be discussed in more detail in Chapter 4.

¹¹⁷ Ibid at footnote 116

¹¹⁸ Ibid at footnote 116) at para 34.

¹¹⁹ Ibid at footnote 116, judgement conclusion.

CHAPTER 3

The South African Cadbury Case: How Prepared Are South African Courts to Grant a Trade Mark Registration for a Single Colour Compared to the United Kingdom.

3.1 Introduction

This chapter will have a closer look and compare how and why the Registrar did not grant Cadbury's single colour trade mark registration in South Africa and compare it to the United Kingdom with specific reference to the *Cadbury Ltd v Beacon Sweets & Chocolates (Pty)*¹²⁰ and *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks*¹²¹ judgements.

3.2 United Kingdom

Recently, as already mentioned in Chapter 3, the United Kingdom Appeal Court¹²², refused the registration of Cadbury's trade mark application for the colour purple that Cadbury had been using for the previous 150 years in relation to its chocolate wrapping.¹²³ According to the findings of the court, the trade mark specification would, as applied for, grant a perpetual monopoly over the purple colour¹²⁴ in relation to all packaging for chocolate.¹²⁵

In 2004, Cadbury had applied for the registration of the colour purple in Pantone 2685C, as a trade mark in terms of the Trade Marks Act.¹²⁶ Its application showed its purple coloured trade mark as a rectangular purple block in relation to "*chocolate in bar and tablet form, chocolate confectionery, chocolate assortments, cocoa-based*

¹²⁰ *Cadbury Ltd v Beacon Sweets & Chocolates (Pty) Ltd* 2004 BIP 74 (RTM)

¹²¹ *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* [2018] EWCA Civ 2715.

¹²² Ibid at footnote 121.

¹²³ Van Zyl C, *Colour trade marks and Cadbury's case – Precision defined imprecisely by the Courts*, November 2013, Polity.

¹²⁴ Ibid at footnote 121, para 56.

¹²⁵ Ibid at footnote 121, para 3.

¹²⁶ Trade Marks Act 1994 (UK).

beverages, chocolate-based beverages, preparations for chocolate-based beverages, chocolate cakes"¹²⁷ and claimed trade mark proprietary rights in the following endorsement:

*"The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods."*¹²⁸

The Registry had to establish whether the word "*predominant*" as submitted by Cadbury was sufficient to define the trade mark, which was the subject of the application. Nestlé opposed the registration and argued that *Cadbury's* application was too vague to constitute a sign capable of graphical representation.¹²⁹

In considering the definition and interpretation of the word "*predominant*", the Registrar considered various factors. It found that the word "*predominant*", as used by Cadbury in its application, was dependent on human subjectivity and other uncertain factors. The uncertainty of the meaning would create a monopoly which would lead to anti-competitive effects and uncertainty. In this case, the word "*predominant*" led to more vagueness than certainty.¹³⁰

The court stated that the word "*predominant*"¹³¹ was too subjective, too imprecise and inadequately clear and intelligible to be capable of registration, therefore not adhering to the requirements as set out in the *Sieckman* and *Libertel* cases¹³². The Court of Appeal agreed with the Nestle's argument above. On appeal, the judge also took the

¹²⁷ Fhima SI, "*Chocs away for registration of Cadbury's purple*", 2012, *Journal of Intellectual Property Law & Practice*.

¹²⁸ *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* [2018] EWCA, Civ 2715 para 6.

¹²⁹ Special Notice on Colour Trade Marks, *UK Trade Mark Journal*, 2 April 1997, para 5.

¹³⁰ *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* [2018] EWCA Civ 2715, TM 3 form.

¹³¹ Malovic N; "*Whole visible surface or predominant colour? Cadbury's plays spot the series mark Saturday*", April 2019, *IPKat*.

¹³² *Libertel Groep BV v Benelux-Merkenbureau* (Case C-104/01) - [2004] Ch 83.

above argument into consideration. The description as provided by Cadbury would ultimately grant a monopoly in the market because the word “*predominantly*” could “*obviously be used in an infinite variety of ways*”.¹³³

However, in 2014, Cadbury submitted to the United Kingdom Intellectual Property Office (hereinafter referred to as UKIPO) that its trade mark “*in fact sets out a series of two marks*”:¹³⁴

1. firstly, on the basis that the colour purple (Pantone 2685C) “*applied to the whole visible surface of the packaging of the goods*”;¹³⁵ and,
2. secondly, that the same colour purple “*being the predominant colour applied to the whole visible surface of the packaging of the goods.*”¹³⁶

Cadbury applied to delete the second of its supposed series of marks, whilst retaining the first.¹³⁷

Cadbury appealed the 2014 decision to the United Kingdom High Court in 2015, which was dismissed in April 2016.¹³⁸ Cadbury again appealed, which led to the 2018¹³⁹ decision.

It was the UKIPO which had the logical argument, claiming:

“...that Cadbury’s approach would make the system of registration unworkable. The registrar would be unable to tell whether it was necessary to apply the tests in section 41(2); the registrar and the public would not be able to know the nature and scope of the monopoly if he granted the application; and neither the

¹³³ Merelle A, Ward Monday, November 05, 2012 “*The Color Purple: Nestlé v Cadbury*”, IP cat.

¹³⁴ *Société Des Produits Nestlé SA v Cadbury UK Ltd* [2014] EWHC 16 (Ch) (17 January 2014)

¹³⁵ *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* [2018] EWCA Civ 2715, para 44.

¹³⁶ *Ibid* at footnote 135, para 44.

¹³⁷ *Société Des Produits Nestlé SA v Cadbury UK Ltd* [2014] EWHC 16 (Ch) (17 January 2014).

¹³⁸ *Société Des Produits Nestlé SA v Cadbury UK Ltd* [2016] EWHC 79 (Ch).

¹³⁹ *Société Des Produits Nestlé SA v Cadbury UK Ltd* [2018] EWCA Civ 2715

proprietor nor any other person inspecting the register would know whether the registration was a series and therefore if it was possible to delete any part of it.”¹⁴⁰

In the 2015 decision, Lord Justice Floyd agreed with this point, and the appeal was unanimously dismissed.

“In my judgment, the reader would conclude that the 876 registration was an attempt to register a single mark which falls foul of the requirements of clarity and precision. Whilst one can feel sympathy for Cadbury that it is its adherence to the Guidance which has given rise to the breach of these requirements, it would be a potentially farreaching step to allow the consequent lack of clarity to be read, instead, as an attempt to register a number of marks. I agree with the registrar that such an approach to interpretation would give rise to grave difficulties for the examination of trade marks. It must be for the applicant to state clearly the type of monopoly for which he contends.”¹⁴¹

3.3 South Africa

In South Africa, as previously discussed in Chapter 2, in 2004, Cadbury had applied for registration of the colour purple in relation to chocolate. Its application consisted of two rectangles having the colour purple as applied for. Its trade mark application was later amended to indicate the specific Pantone for which Cadbury sought protection.¹⁴²

According to Cadbury, the colour purple, in connection with its confectionary, more specifically, chocolate, had become distinctive through use.¹⁴³ The application for the registration of the colour purple was rejected by the Trade Marks Registrar because

¹⁴⁰ *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* [2018] EWCA Civ 2715, para 44.

¹⁴¹ *Ibid* at footnote 140, para 56.

¹⁴² Van Zyl C ‘*Colour Trade Marks and Cadbury’s Case: Precision Defined Imprecisely by the Courts*’ available at <http://www.vonseidels.com/colour-trade-marks-and-cadburys-case-precision-defined-imprecisely-by-the-courts/> [accessed 21 July 2019].

¹⁴³ *Ibid* at footnote 140, para 108.

Cadbury failed to prove this. Cadbury's trade mark application was also rejected by the Registrar on the basis that the application was applied for in "*an abstract*" and that the applicant had failed to provide a sufficient description as to how the trade mark would be applied and used on specific goods.¹⁴⁴

According to the Registrar, by granting the registration, it would grant an unfair monopoly over the colour purple to Cadbury. The Registrar's decision confirmed the principle that a single colour can only be registered if it acquired distinctiveness through use.

3.4 General considerations regarding the United Kingdom and South African Cadbury judgements

To better understand the *Cadbury* cases in 3.1 and 3.2 above, it is important to explain the criteria as set out and applied in in the *Libertel*¹⁴⁵ case when it comes to an application for registration of a single colour as a trade mark. It is of value for purposes of this chapter to understand why *Libertel* was successful in application to secure rights in a single colour as a trade mark and why Cadbury failed in their attempt to obtain a monopoly right in a single colour.

In the *Libertel*¹⁴⁶ case, the court found that an application to register specific Pantone orange colour together with the word trade mark "*orange*"¹⁴⁷ was sufficient to secure trade mark protection in a single colour as a trade mark. The question is why was *Libertel* successful in the *Libertel*¹⁴⁸ judgement?

The distinction lies in how the description accompanying the application for the single colour as a trade is motivated and endorsed. If the mark is not accurately described

¹⁴⁴ *Libertel Groep BV v Benelux-Merkenbureau* (C-104/01) [2003] ECR I-3793.

¹⁴⁵ *Ibid* at footnote 144

¹⁴⁶ *Ibid* at footnote 144.

¹⁴⁷ *Ibid* at footnote 144, at para 69.

¹⁴⁸ *Ibid* at footnote 144.

and correctly referenced as to how the mark will be applied to the goods or services, the court may find that the mark is imprecisely defined.

Both the United Kingdom and the South African Cadbury judgements (hereinafter referred to as the *Cadbury* judgements) explained that an unfair monopoly cannot be granted to a single colour as a trade mark.

The trade mark endorsement as applied for in the *Cadbury* judgements lacked clarity and precision. According to the *Sieckman*¹⁴⁹ case, an unclear trade mark endorsement will offend against fairness and ultimately grant an unfair monopoly in the single colour as a trade mark. By allowing a registration that is unclear and unambiguous it will contradict the purpose of the Trade Marks Acts by allowing Cadbury to have an unfair advantage over its competitors. Even though Cadbury had been using the colour purple for more than 150 years, these two decisions will make it difficult for Cadbury to prevent competitors from using the colour purple for the packaging of chocolate, and claiming a monopoly on the particular Pantone colour.

At this point, Cadbury's only cause of action would be to rely on other trade mark registrations, goodwill and common law principles to protect its brand.

¹⁴⁹ *Ralf Sieckmann v Deutsches Patent- und Markenamt* ('Methylcinnamat'), [2002] Case C-273/00 ECR I-11737

CHAPTER 4

The Enforcement of Single Colour Trade Marks in South Africa, the United Kingdom and in the United States of America.

4.1 Introduction

As previously stated in Chapter 1 on page 1, colour plays a significant role in companies' advertising and branding strategies. In order to protect these brands, statutory protection could be obtained through registration. However, does the registration of a single colour trade mark award sufficient rights against a competitor instituting opposition and infringement proceedings? This chapter will discuss how courts and other platforms deal with the enforcement of a single colour as a trade mark.

4.2 South Africa

To date, there has been no High Court judgement dealing with the enforcement of a single colour as a trade mark in South Africa.

However, in South Africa, it may be possible to enforce rights to a single colour through the common law remedy of passing off and/or through the Advertising Regulatory Board (hereinafter referred to as ARB).¹⁵⁰

As already mentioned in Chapter 2, the ARB administers the widely-accredited Code of Advertising Practice, which regulates the content of South African advertising and publication materials.¹⁵¹ This Code provides a platform for trade mark proprietors to

¹⁵⁰ Previously known as the Advertising Standards Authority, website available at <http://www.arb.org.za/index.html> [accessed 12 February 2020]

¹⁵¹ Welcome to the Advertising Regulatory Board available at <http://www.arb.org.za/index.html> [accessed 11 August 2019].

lodge complaints with the ARB if a competitor's product is being advertised in a way that is prejudicial to their advertising goodwill.

Practitioners choose this route because it is usually more cost-effective than instituting and resolving infringement matters in the High Court, and matters are generally disposed of far quicker.¹⁵²

4.3 The United Kingdom

The recent judgement in *Glaxo Wellcome UK Ltd v Sandoz Ltd*¹⁵³ (hereinafter referred to as *Glaxo*) dealt with the validity of Glaxo's registration of a single colour (purple) in relation to the packaging for a respiratory inhaler. Glaxo was the proprietor of the trade mark which is visually represented by a photograph of an inhaler in two shades of purple.¹⁵⁴ The endorsement against the trade mark registration read as follows:

*"... colour dark purple (Pantone Code 2587C) applied to a significant proportion of an inhaler and the colour light purple (Pantone Code 2567C) applied to the remainder of the inhaler".*¹⁵⁵

In 2015 Sandoz launched an inhaler having the colours white and purple. Glaxo instituted infringement proceedings and Sandoz¹⁵⁶ counter claimed for the cancellation of the colour trade mark registration on the basis that the registration was vague and granted an unfair monopoly¹⁵⁷. The court considered the tests as set out in

¹⁵² Welcome to the Advertising Regulatory Board available at <http://www.arb.org.za/index.html> [accessed 11 August 2019].

¹⁵³ *Glaxo Wellcome UK Ltd v. Sandoz Ltd* [2017] EWCA Civ 335.

¹⁵⁴ *Glaxo Wellcome UK Ltd v. Sandoz Ltd* [2017] EWCA Civ 335, summary available at <http://www.8newsquare.co.uk/cases/357/Glaxo+Wellcome+UK+Ltd+v.+Sandoz+Ltd+%5B2017%5D+EWCA+Civ+335.html#> [accessed 8 August 2019].

¹⁵⁵ *Glaxo Wellcome UK Ltd v. Sandoz Ltd* [2017] EWCA Civ 335 at para 4

¹⁵⁶ *Glaxo Wellcome UK Ltd v. Sandoz Ltd* [2017] EWCA Civ 335 at para 43

¹⁵⁷ Woolar A, October 2019, *GSK fails in purple inhaler passing off claim against Sandoz and Vectura (...and breathe)* available at <http://ipkitten.blogspot.com/2019/10/gsk-fails-in-purple-inhaler-passing-off.html> [accessed 23 October 2019]

the *Sieckman*¹⁵⁸ and the *Libertel*¹⁵⁹ cases and found that the registration was not valid because its description lacked the required *clarity, precision, self-containment, durability and objectivity* to qualify for registration.¹⁶⁰

The court in *Glaxo* referred to the UK *Cadbury* case and, specifically, to the following statement:

*“To allow a registration so lacking in specificity, clarity and precision of visual appearance would offend against the principle of certainty. It would also offend against the principle of fairness by giving a competitive advantage to Cadbury and by putting Nestlé and its other competitors at a disadvantage.”*¹⁶¹

The court found that there was *“no strict congruence between the visual representation and the description”*¹⁶². The court further held there was *“no automatic precedence between the visual representation of the trade mark and its description”*¹⁶³.

4.4 The United States of America

As previously discussed in Chapter 1, Mattel Inc. (a toy manufacturing company) instituted action against MCA Records for trade mark infringement. This suit was brought on the basis that a recorded song (and its album cover) for *“Barbie Girl”*, by the artist Aqua, infringed and diluted Mattel’s registered trade mark.¹⁶⁴ The album cover and the music video for *“Barbie Girl”* contained the signature and registered “Barbie” pink trade marks associated with Barbie products. Mattel argued that under

¹⁵⁸ *Sieckmann v Deutsches Patent-und Markenamt* (Case C-273/00) [2003].

¹⁵⁹ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793.

¹⁶⁰ *Glaxo Wellcome UK Ltd v. Sandoz Ltd* [2017] EWCA Civ 335 at para 43 and para 80-83

¹⁶¹ *Société Des Produits Nestlé SA v Cadbury UK Ltd* [2014] EWHC 16 (Ch) (17 January 2014).

¹⁶² *Glaxo Wellcome UK Ltd v. Sandoz Ltd* [2017] EWCA Civ 335 para 44

¹⁶³ Woolar A, October 2019, GSK fails in purple inhaler passing off claim against Sandoz and Vectura (...and breathe) available at <http://ipkitten.blogspot.com/2019/10/gsk-fails-in-purple-inhaler-passing-off.html> [accessed 23 October 2019]

¹⁶⁴ *Mattel Inc v. MCA Records*, 296 F.3d 894 (9th Cir. 2002), page 899.

the Federal Trademark Dilution Act (hereinafter referred to as FTDA)¹⁶⁵, “*Barbie Girl*” diluted their Barbie trade marks¹⁶⁶ in two ways:

1. firstly, the use of “Barbie’s” name tarnished the doll’s image because the lyrics were inappropriate for young girls; and ¹⁶⁷
2. secondly, the use of “Barbie’s” name diminished Mattel’s ability to identify and distinguish its product.¹⁶⁸

The lawsuit filed by Mattel was dismissed by the lower courts¹⁶⁹, and this dismissal was upheld on appeal. Mattel requested a review by the Supreme Court of the United States, but its petition was denied.¹⁷⁰

One of the more recent judgements, already briefly discussed in Chapter 2, dealt with the enforcement of a single colour trade mark registration and acquired distinctiveness, in *Christian Louboutin v. Yves Saint Laurent*.¹⁷¹

In 2008 Louboutin registered its red-lacquered undersole as a trade mark at the United States Patent and Trade Office (hereinafter referred to as the USPTO) subject to following endorsement:

*“The color(s) red is/are claimed as a feature of the mark. The mark consists of a lacquered red sole on footwear.”*¹⁷²

¹⁶⁵ The Federal Trademark Dilution Act of 1995.

¹⁶⁶ *Mattel Inc v. MCA Records*, 296 F.3d 894 (9th Cir. 2002), page 902

¹⁶⁷ *Mattel, Inc. MCA Records*, Case Briefs, Trademark Law available at <https://www.casebriefs.com/blog/law/intellectual-property-law/intellectual-property-keyed-to-merges/trademark-law/mattel-inc-mca-records/> [accessed 17 august 2019].

¹⁶⁸ *Ibid* at footnote 166.

¹⁶⁹ Wallack H, *DePaul Journal of Art, Technology & Intellectual Property Law*, Vol. 12, Iss. 2 [2016], Art. 7

¹⁷⁰ *Ibid* at footnote 169

¹⁷¹ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013).

¹⁷² *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) at background 2.

In 2011, Yves Saint Laurent (hereinafter referred to as YSL) brought out a line of monochrome shoes in purple, green, yellow, and red. These shoes had the same red-lacquered undersoles showing as Louboutin's trade mark registration¹⁷³. Consequently, Louboutin initiated proceedings based on trade mark infringement and included in its claim: counterfeiting, false designation of origin, unfair competition, and trade mark dilution¹⁷⁴. A preliminary injunction was sought to prevent YSL from selling any shoe, of any colour, incorporating the '*Red Sole trade mark*'. YSL counterclaimed that the '*Red Sole trade mark*' should be removed from the register on the basis that it was invalid and served mostly an ornamental and functional¹⁷⁵ purpose.

The court had to decide on the following:

*"The question presented is whether a single color may serve as a legally protected trademark in the fashion industry and, in particular, as the mark for a particular style of high fashion women's footwear."*¹⁷⁶

The court then had to decide whether there were grounds for infringement. The court directed the USPTO¹⁷⁷ to limit the scope of Louboutin's '*Red Sole trade mark*' and restricted the registration of the trade mark only to be used with contrasting colours on the remaining parts of the shoe.¹⁷⁸ By limiting the scope of their registration, the court enforced the "*Red Sole Trademark*".

¹⁷³ Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc., No. 11-3303 (2d Cir. 2013) at para 213

¹⁷⁴ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) para 215.

¹⁷⁵ Doctrine of functionality – as explained in chapter 2 of this dissertation. In general terms, a product feature is functional, and cannot serve as a trade mark, 'if it is essential to the use or purpose of functional nature.

¹⁷⁶ *Ibid* at footnote 174, para 211

¹⁷⁷ *Ibid* at footnote 174, para 212

¹⁷⁸ Lago M '*Shoe Wars: Christian Louboutin vs. Yves Saint Laurent*' available at <http://sashahalima.com/blog/2011/04/shoe-wars-christian-louboutin-vs-yves-saint-laurent/> [accessed 11 August 2019].

By limiting the scope of the registration, the court was able to enforce the trade mark without granting an unfair monopoly in favour of Louboutin.

CHAPTER 5

Conclusion and Recommendations

5.1 Introduction

From the previous chapters, it is clear that in order for a colour to be registered as a trade mark, the application for registration must be accompanied by a very specific and unambiguous trade mark endorsement as to the colour for which protection is sought. There must be a balance between the applicant's right to obtain a monopoly in a colour in the marketplace and the limitation such a registration will place on other traders in the market. This chapter will be a summation of all the positions and will include recommendations as to the trade mark filing strategies to secure rights in a single colour as a trade mark in each jurisdiction.

5.2 South Africa

As already discussed in Chapter 1, the Trade Marks Act of South Africa¹⁷⁹ makes provision for the registration of a single colour as a trade mark. A colour per se is not sufficiently inherently capable of distinguishing the goods and services in trade, and therefore does not adequately indicate the origin of the goods or services.

Some brand owners choose to file more than one trade mark application¹⁸⁰ in a number of ways to cover various possibilities in which the colour might be used in advertising campaign. Others choose to file part marks in terms of Section 18 of the Trade Marks Act¹⁸¹ in order to overcome the difficulty of proving the colour as a trade mark became distinctive over time.

¹⁷⁹ Section 18, Trade Marks Act No 194 of 1993

¹⁸⁰ *Shillings United Minerals (Pty.) Ltd. v. The Seven-Up Company*, 1962 (4). S.A. 444 (T)

¹⁸¹ Webster CE and Joubert I, *Webster and Page, South African Law of Trade Marks*, Butterworths, Service Issue 22, November 2019, para 4.9.

Section 18 of the Act deals with the registration of parts of trade marks:

(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(2) Each such separate trade mark must satisfy all the requirements for registration of a trade mark under this Act and shall for all purposes be a registered trade mark.

In the case where certain parts of the trade mark registration is vague or do not fulfil the requirements as set out in the *Sieckmann*¹⁸² case, the registrar can remove or limit the scope of protection awarded by the trade mark registration. From the *Cadbury*¹⁸³ case, it is evident that the description in order to obtain a colour trade mark must be certain, precise, clear and unambiguous.

It is important to understand that trade mark law is constantly evolving and must adapt to the creative ways in which brands are created and adopted by the brand owners. Brand owners of long-standing non-traditional marks should review their portfolios to ensure that older registrations remain valid and enforceable.

5.3 The United Kingdom

As already mentioned in Chapter 2, the United Kingdom (UK) Trade Marks Act¹⁸⁴ defines a “*trade mark*” to mean:

“any sign which is capable of being represented on the register in a manner which enables the registrar and other competent authorities and the public to

¹⁸² *Sieckmann v Deutsches Patent-und Markenamt* (Case C-273/00) [2003]

¹⁸³ *Cadbury Ltd v Beacon Sweets & Chocolates (Pty) Ltd* 2004 BIP 74 (RTM)

¹⁸⁴ Trade Marks Act No 194 of 1993.

determine the clear and precise subject matter of the protection afforded to the proprietor.”¹⁸⁵

As discussed in Chapter 2, the Act further requires a trade mark to distinguish goods or services of one undertaking from those of other undertakings.¹⁸⁶

When it comes to the registration of a single colour as a trade mark, it is necessary to be as precise as possible¹⁸⁷. The endorsement of the application for a colour trade mark, the Pantone code, and the accompanying illustration, should be clear. If the trade mark is not sufficiently and accurately described, the courts will argue that an unfair monopoly will be granted to the proprietor.

“As the registration of a trade mark creates a form of intellectual property conferring a potentially perpetual monopoly in the mark and excluding everybody else from use in various ways, the point of principle has some public importance.”¹⁸⁸

5.4 The United States of America

As previously explained in Chapter 1, Section 45 of the Trademark Act¹⁸⁹ defines a trade mark as *“any word, name, symbol, or device, or any combination thereof,”* that identifies and distinguishes the goods of one party from those of others, and must be able to indicate the source of the goods. No reference is specifically made to the possibility of registering a single colour as a trade mark.

¹⁸⁵ Section F1(1), Trade Marks Act 1994

¹⁸⁶ Scott G, *Colour trade marks – Still no purple patch*, August 2016, available at <https://www.golegal.co.za/colour-trade-marks-still-no-purple-patch/> [accessed 28 October 2019]

¹⁸⁷ *Sieckmann v Deutsches Patent-und Markenamt* (Case C-273/00) [2003]

¹⁸⁸ *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* [2018] EWCA Civ 2715.

¹⁸⁹ Section 45, Trademark Act of 1946,

Both the Lanham Act¹⁹⁰ and the Trademark Act provides the owner or the proprietor of a trade mark with the “*enforceable right to exclude others from using the trade mark.*”¹⁹¹ However, the purpose of trade mark law is not intended to provide the registrant with a monopoly over certain goods or services. Trademark law must seek to preserve a “*vigorously competitive market*”¹⁹² for the benefit of consumers.

The challenge for trade mark attorneys and practitioners are to craft a suitably clear and specific endorsement that makes the trade mark acceptable without unduly limiting the applicant's scope of protection.

5.6 Conclusion

There are similarities between the above jurisdictions regarding the definition of a “*mark*” and a “*trade mark*” and what will ultimately qualify for a registrable and enforceable colour trade mark. The reason for these similarities is due to the minimum standards of protection required by international organisations and treaties.

The first overlapping requirement in order to succeed with an application for a single colour as a trade mark is the issue of “*distinctiveness*”. Secondly, when applying for the registration of a colour as a trade mark, the “*graphical representation*” of the colour must be “*clear, precise, self-contained, easily accessible, intelligible, durable and objective*” as set out in the *Sieckmann case*¹⁹³ .

However, even if an application meets the above criteria, the Registrar will only grant the registration for a single colour as a trade mark if convinced that the monopoly right granted by the registration will not result in undue restrictions on competitors.

It should also be noted that, if the prior use is inconsistent with the way in which the trade mark is described in the application, and the scope of protection sought for with

¹⁹⁰ The Lanham Act 15 U.S.C. § 1052(e)(5).

¹⁹¹ *La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271 (2d Cir. 1974).

¹⁹² *Yurman Design, Inc.*, 262 F.3d 101 (2d Cir. 2001) para 71.

¹⁹³ *Ralf Sieckmann v Deutsches Patent- und Markenamt ('Methylcinnamat')*, [2002] ECR I-117

grants an unfair monopoly, the Registrar would most likely not grant the trade mark registration. Applicants using colour in their branding and advertising will need to ensure that the “*graphical representation*” requirement is adequately met and the endorsement as applied to the Trade Mark Office must be consistent with the intended use thereof. The onus of accurately describing the application for a single colour trade mark ultimately resides with the applicant.

“*Graphical representation*”¹⁹⁴ as a requirement is seldomly overcome as illustrated in the various cases discussed in Chapter 2 of this dissertation. Further, the endorsement accompanying the TM 3 form must not grant an unfair monopoly to the applicant. In most cases, the Registrar will refuse the application for a single colour as a trade mark on the basis of the application being vague and not satisfying the “*graphical representation*”¹⁹⁵ requirement.

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¹⁹⁴ Trade Marks Act No 194 of 1993

¹⁹⁵ Ibid at footnote 194.

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