

Bugnion SpA

Just colours and sounds, or also source identifiers?

In Italy, graphical representation remains key to registration

According to the law on traditional trademarks, words, logos and wording in special characters enable consumers to distinguish sources of goods and services. However, what about particular colours and sounds that have the ability to identify goods and services belonging to a particular business source?

Article 7 of the Code of Industrial Property provides that if they are capable of graphical representation, all signs – including sounds and colour combinations – may obtain trademark protection through registration. However, the list of distinctive elements which are deemed registrable as a trademark is not completely comprehensive due to the legislature's lack of particular attention to the subject. In fact, the new recently enacted regulation on trademark law and practice governs only non-traditional trademarks, so sounds and colours are still covered by the previous limited law, as well as by the legislature and the judiciary at the European level.

When analysing colours and sounds as trademarks, the main issue that arises is whether they can be graphically represented in accordance with the law.

Colour trademarks

In a limited number of cases the judiciary has provided its opinion on non-conventional trademarks – in particular, colours. In one of the first decisions on this matter the Court of Milan held that primary colours are not registrable (July 30 2002). Subsequently, a lack of extensive governing law and a lack of Italian jurisprudence forced the courts to find principles relating to colours in European Court of Justice precedents (eg, *Libertel*, Case C-104/01, May 6 2003).

Accordingly, the distinctive character of colours in connection with specific goods

and services is subject to clear, exhaustive, objective and graphical representation. This is why the small number of applicants that have decided to seek colour registrations always borrow the internationally accepted and recognised system of colour identification.

In recent years, the demands of Italian brand owners have adapted to international and more sophisticated standards. As a result, a much clearer law on colour trademarks has been issued and confirmed by case law.

Nonetheless, the Supreme Court has decided on a basic and limited framework of protection for colour trademarks through its finding that “the possibility of registering a single monochrome colour is restricted by the general interest of not unjustifiably confining a colour’s availability within a particular channel of trade”. As a result, the court suggests that the distinctive character of a colour may be enjoyed “only if its tone is very peculiar or it is absolutely unusual in connection with the products”. In addition, such evaluation must be made by taking into account the particular colour on a case-by-case analysis (Supreme Court, n 3478, February 12 2009).

Although the above-mentioned decision provides no outstanding directions or strict guidelines on the colour trademark issue, it shows that the time has come for Italian jurisprudence to take up a position and satisfy the need for clarity that has been missing in the past. By stating that the possibility of registering a colour trademark is “restricted”, the Supreme Court, in one of the first decisions at the highest level of the Italian judiciary on this issue, fully recognised the possibility of registering colour trademarks. Seemingly, the shadows surrounding the registration of colours as trademarks have finally been lifted.

In the same decision the Supreme Court denied the distinctive character of the colour violet as a trademark to identify the products, but at the same time raised the issue of unfair competition pursuant to Article 2598 of the Civil Code.

The judges alleged that “even though the color violet (identified as “violet 6433”) does not represent a color trademark... and despite its lack of distinctiveness, such colour as used in connection with the product was primarily recognizable by consumers” because of the colour combination and the particular shape of the product.

Once again, the judges’ arguments infer how the Italian courts (even specialised IP courts) are not used to handling non-conventional trademark cases, apart from those involving commonly known ‘traditional’ trademarks. Thus, “violet 6433” was not recognised as being used for particular goods. However, the matter of confusing similarity was addressed and found to be in existence by combining colour trademarks and matters of unfair competition.

In other words, it seems that the Supreme Court would rather avoid being the pioneer of colour trademark protection, even if it was forced to employ unfair competition rules to ‘save the case’, which was mainly justified by consumers being misled by colours which were actually confusingly similar.

On the other hand, in advance of the Supreme Court’s ruling on this case, a number of specialised IP courts had already provided comments on different aspects of this matter.

In particular, the Court of Bologna issued a decision on a colour trademark consisting of different colour tones that matched the different chromatic

appearance of vinegar throughout the ageing process. The court ruled in favour of the argument that the mark lacked distinctive character. However, this ruling was not issued simply because the mark consisted of colours. The court alleged that the trademark at issue would not be used to distinguish one kind of vinegar bottle, but rather that each bottle would be sold in connection with one of the colour tones and so the bottles would be sold separately in connection with different pieces of the mark.

The unicity of the mark consisting of the different colour tones would be broken because the mark would not be used as a whole to distinguish the goods, but rather different pieces of the mark would be used in connection with different bottles located in different places - perhaps on different grocery store shelves (Court of Bologna, April 28 2008).

In this particular case the court did not deny that the colour trademark lacked individual or distinctive character *per se*; it simply held that use of that colour mark would not be proper.

Sound trademarks

Trademark practitioners are often led to think that combinations of sounds are protected by copyrights. In fact, sounds are considered to be connected with music and, as such, with the subject matter of authorship, rather than with the issue of identifying goods and services by linking them to a particular business source.

Brand owners have recently concluded that if a particular sound identifies their business and adds value to consumers' recognition of their products, it is no more or less a trademark as it functions as any traditional source identifier.

Sound trademarks for which registration has been sought are scarce and, as a result, court decisions for defining clear standards for sound trademarks are insufficient.

Consequently, when the Italian courts are requested to rule on sound trademarks, previous European Court of Justice decisions become the only solution to abstract principles and guidelines for protection. In addition, for this type of non-conventional trademark (more so than for any other), the issue of graphical representation is crucial and raises the first key issue.

According to the Office for Harmonisation in the Internal Market (OHIM) Fourth Board of Appeal (R-708/2006-4, September 27 2007), the scope of the Community trademark register is to



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be addressed to third parties which intend to investigate whether the signs used or to be used in connection with goods or services are already protected by registration. In this vein, it is inferred (and required) that such third parties be able to identify the subject matter of the trademark.

Therefore, proper graphical representation of the sound mark is required and obtained, provided that the competitor of the owner of the sound trademark can translate the image (graphical representation) into sound by means of simple devices.

Frequently, an acceptable graphical representation of a sound trademark is its reproduction through a pentagram or spectrogram. However, many people cannot read a pentagram or understand the meaning of a spectrogram. Therefore, the scope of this legislative rule is not pursued through these kinds of graphical representation. The general public must have easy access to the subject matter of the trademark.

The OHIM has adopted a successful method for making sound trademarks accessible and acknowledgeable which provides for the publication of multimedia files that allow parties to listen to the sound at issue. Moreover, this practice is carried out in accordance with the publication of modern multimedia bulletins.

Unfortunately, this issue was not considered during the recent modification of the Code of Industrial Property; therefore, Article 7 continues to require graphical representations of sound trademarks.

Due to the small number of sound trademark matters being handled by the Italian courts, case law is limited to a few decisions. In one of the first decisions issued, the Court of Naples recognised the subsistence and enforceability of sound trademarks (Case 3753/2006, March 16 2006).

However, the subject matter in this case was a *de facto* sound trademark; therefore, the court was not required to provide comments on the issue of graphical representation. This meant that actual use was sufficient to obtain recognition as a sound trademark. As a result, even though it might seem improper, it is probably easier to enforce sound trademarks whose rights have been acquired through genuine use, rather than seek and obtain their registration. [WTR](#)