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# EU & Japan: Brand Owners Encounter High Threshold to Register Single-Color Marks

By [Katherine Lyon Dayton](#)

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## I. European Union

**Background:** In 2015, Glaxo Group Ltd (“Glaxo”) filed an application for a single-color mark consisting of a shade of purple, which designated “*pharmaceutical preparations for the treatment of asthma and/or chronic obstructive pulmonary disease*” in Class 5 and inhalers in Class 10. The EUIPO rejected the application as being devoid of distinctive character. Glaxo subsequently submitted evidence of acquired distinctiveness, and the application was accepted by the EUIPO for publication.

However, the published application was met with oppositions and ultimately an absolute-grounds objection by the EUIPO, which retracted its earlier acceptance and refused the mark for lack of distinctiveness, both inherent and acquired. The EUIPO found probative evidence that inhalers are frequently classified by color, and that purple inhalers often contain particular combinations of medicinal products for the treatment of asthma.

Glaxo unsuccessfully appealed to the Board of Appeal of the EUIPO, and then to the European General Court.

**General Court:** Glaxo's claims of inherent and acquired distinctiveness were rejected by the General Court, which found that the mark was devoid of any distinctive character. Notably, the court observed that a single-color mark is only inherently distinctive in "exceptional circumstances." Colors and combinations of colors are usually "used for their attractive or decorative powers, and do not convey any meaning."

As for Glaxo's claim of acquired distinctiveness, the court noted this must be "demonstrated throughout the territory of the European Union, and not only for a substantial part or the majority thereof." The court held that various surveys submitted by Glaxo involving general practitioners, pharmacists, and patients, covering a combined total of 15 EU member states, were insufficient to demonstrate acquired distinctiveness and could not be extrapolated to other member states for a finding of distinctiveness throughout the EU. Among other shortcomings of these surveys, the court took into account Glaxo's sales volume, turnover, and market share to hold that the numbers of patient participants were comparatively too low to be reliable (around 1,500 patients in 10 member states). Further, the individuals surveyed were only shown a single image of a shade of purple. They were not asked to choose from among several images, or several shades of purple, the one that was associated with a particular undertaking.

Glaxo's appeal was dismissed, and the EUTM application for Glaxo's shade of purple was rejected.

## II. Japan

In Japan, Hitachi Construction Machinery ("Hitachi") was equally unsuccessful in applying to register a single shade of orange for "*hydraulic excavators, wheel loaders, road loaders, loaders [each moving machines]*" in Class 7 and "*rigid dump trucks*" in Class 12.

**Background:** In a September 2019 decision, the Appeal Board of the Japan Patent Office rejected Hitachi's application, finding that the graphic representation of the mark consists of a "mere single orange color, without contours," and thus lacking distinctiveness—whether inherent or acquired.

Hitachi subsequently limited its goods to "hydraulic excavators" in an effort to better position its application for registration, and appealed the decision to the IP High Court.

**IP High Court's Decision:** On appeal, Hitachi noted it had used the applied-for shade of orange on hydraulic excavators since 1974. It submitted survey evidence suggesting that 95.9% of 193

respondents—traders in the construction industry—were able to identify the color as associated with Hitachi.

The Court held against Hitachi, criticizing the survey, and noting that orange has been commonly adopted at construction sites to signal safety, in connection with helmets and other items, as well as in the agriculture industry.

If anything, the court held, Hitachi’s shade of orange is capable of serving as a source indicator in combination with other excavator design elements, such as the HITACHI word mark in white, and features of the excavator itself such as buckets, cockpits, etc. The Court declined to find that the color orange per se had acquired distinctiveness.

The *Hitachi* case demonstrates that, in Japan, the threshold for acquired distinctiveness for a single-color mark is very high. As in other jurisdictions, this is reserved only for the most widely-known color marks. It is also notable that only a handful of color marks have been registered in Japan at all, and that all of these consist of color combinations rather than a single color.

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These decisions from the European Union and Japan further reflect the careful balance that courts and trademark offices around the world must strike between, on the one hand, protecting a truly distinctive color that serves as a source identifier, and on the other hand, keeping colors generally available for commercial use without giving an undue competitive advantage to a single trader. Protection of single-color marks is therefore reserved, in practice, only for those select few marks that are indeed well-known and can clear a very high hurdle of acquired distinctiveness.

## Primary Contacts

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