

Color Trademark Litigation: Key Takeaways for Companies in Vietnam

Colors are not just about aesthetics, they are the soul of a brand. In a landmark ruling, the German Supreme Court has confirmed that the gold color of the Lindt Gold Bunny can enjoy unregistered trademark protection in Germany. This decision marks a victory for Lindt in a years-long legal battle to protect its iconic product - the well-known chocolate bunny - from trademark [infringement](#).


Although the German Supreme Court's ruling does not directly apply to Vietnam, it can be considered a valuable reference for entities engaged in manufacturing and business in Vietnam in their fight against the increasingly sophisticated problem of product packaging counterfeiting.

KENFOX IP & Law Office, with extensive experience in the field of intellectual property (IP), would like to share the key points from the Lindt case and analyze the relevant Vietnamese legal provisions related to the protection of color trademarks to help identify challenges and build effective protection strategies for businesses.

Background of the Case

Lindt & Sprüngli ("Lindt") is a premium chocolate manufacturer known for its Lindt Gold Bunny wrapped



in gold foil (). In Germany, Lindt has used this gold color for its Gold Bunny product since 1994 and has sold over 500 million Gold Bunnies in the past 30 years, accounting for over 40% of the chocolate Easter Bunny market share in Germany in 2017.

However, Lindt has faced challenges in protecting the trademark for the shape and packaging of the Gold Bunny. In 2012, the Court of Justice of the European Union ruled that the trademark for the shape and packaging of the Gold Bunny lacked distinctiveness.

In 2018, Lindt sued another chocolate manufacturer after they marketed a chocolate bunny wrapped in gold foil during Easter. Lindt argued that they had an unregistered trademark right in the gold color of the product, which they had established through long-term use of the product in commerce.

Supreme Court Ruling

The German Federal Court of Justice overturned the Munich Higher Regional Court's ruling and affirmed that Lindt had established secondary meaning for the gold color of the Gold Bunny. The Court found that:


- Lindt had used the gold color consistently and extensively for the Gold Bunny for over 25 years.
- The gold color had become strongly associated with the Lindt Gold Bunny in the minds of German consumers.
- Surveys showed that 70% of German consumers associated the gold color with Lindt when used in connection with chocolate bunnies.

The Court concluded that these factors demonstrated that the gold color had acquired secondary meaning as an indication of the origin of Lindt's product, and therefore could be protected as an unregistered trademark.

Color Trademark Protection in Vietnam: What Businesses Need to Know?



1. The aforementioned ruling represents a significant step forward in the protection of trademarks for abstract elements such as colors and can be considered a precedent for handling disputes and infringements involving color trademarks, not only in Germany but also in Vietnam and other jurisdictions. This ruling will have a significant impact not only on chocolate manufacturers but also on other industries that utilize "color trademarks" in their products.


2. With reference to Vietnamese law, it is important to note that a "single color" cannot be exclusively protected as a trademark. A sign that is "only a color" without being combined with a word mark (in the form of letters, numbers) or a figurative mark, or is not presented in the form of a word mark or figurative mark, is not protectable as a trademark (Article 26.2(b) Circular 23/2023/TT-BKHCN). The Intellectual

Property Office of Vietnam has [refused](#) to protect the trademark "" (consisting of only one red color) under International Registration No. 801739.

This implies that trademarks consisting solely of "a single color" without any distinguishing elements such as images, letters, or logos will be denied protection. The rationale behind this is that colors are considered to be common and difficult to distinguish, and granting exclusive protection to a "single color" could restrict the freedom of other businesses to use that color for marketing similar goods or services, thereby hindering commercial activities and contradicting public policy.

However, if a trademark is composed of "two" or "multiple" colors combined, such a trademark may be

protectable. In Vietnam, trademarks combining two colors, such as "" or "" (registered under National Trademark Registration Certificates No. 128370 and

448054, respectively) or "" (registered under International Registration No. 680987), have been granted protection. Therefore, color trademarks can be protected in Vietnam if they meet two conditions: **(i)** they are composed of two or more colors, and **(ii)** the colors must be represented in a specific form without having to contain any other distinctive elements.

3. Under what circumstances can a "single color" trademark be protected? An exception to the general rule of non-protectability for single-color trademarks exists if the mark acquires "**secondary meaning**" – distinctiveness through commercial use.

Secondary meaning is established when an element (a sign) that is not inherently distinctive, such as a color, becomes associated with a particular brand in the minds of consumers. In this case, the color gold may be linked to Lindt, even though people recognize other "design elements" that have been used alongside the gold foil. This means that while the "other design elements" (the sitting rabbit, red collar, etc.) are widely recognized, this does not diminish the ability of the gold color to also be recognized as a sign of Lindt. To illustrate, consider the example of a "red carpet". Typically, it's generally associated with Hollywood awards shows. However, if a specific movie theater consistently uses a red carpet for all its premieres, over time, people might start associating that red carpet specifically with that theater, even though they still recognize red carpets in general.

It is noteworthy that the German Supreme Court has clarified that while the "other design elements" (*the sitting rabbit, red collar, etc.*) are widely known and contribute to the overall brand recognition of the Lindt bunny, the "gold color" itself can still acquire "secondary meaning" as long as consumers recognize it as a sign of Lindt.

This case revolves around the issue of "trademark infringement". The [enforcement](#) of trademark rights aims to protect the unique identifying features of a trademark and prevent consumer confusion. Trademark infringement occurs when a sign that is identical or [similar](#) to another owner's trademark is used in a manner that is "likely to cause confusion" among consumers as to the origin of the goods or services. This confusion can lead consumers to believe they are purchasing a product from one manufacturer when, in fact, they are purchasing a product from a different manufacturer.

Vietnam's IP law does not establish specific requirements regarding the extent of "widespread" commercial use necessary for a non-inherently distinctive trademark to acquire "distinctiveness" or "secondary meaning." However, guidance can be drawn from Article 19.1(d) of Circular 11/2015/TT-BKHCN on the enforcement of anti-unfair competition rights. To demonstrate [widespread commercial use](#) of a trade indicator in Vietnam, the following information and documents should be provided: "*Information on advertising, marketing, and exhibition displays; Sales revenue; Number of products sold; Distribution network, joint ventures, and affiliations; Investment scale; Assessments by*

government agencies, media outlets, consumer polls, and other information reflecting the reputation of the business entity associated with the trade indicator in its business activities in Vietnam”.

The objective is to demonstrate that the color – trade indicator has become associated with the company's brand in the minds of consumers and is recognized as a sign for the origin of the product.

Final thoughts

Colors make a first impression, convey messages, evoke emotions, and connect businesses with customers in a subtle and effective way. Therefore, color is a powerful tool for brand identity, helping customers remember the brand more easily, creating a positive shopping experience for customers and encouraging them to return to buy, thereby forming a distinct brand identity and enhancing the brand's competitive position in the market.

Unfortunately, colors chosen and used by reputable companies are often targets for copying and imitation. Copycats are always lurking, plotting to steal the fruits of intellectual labor, threatening the position and reputation of genuine businesses. The Lindt case mentioned above is a prime example.

Businesses should establish a long-term, consistent, and cohesive color usage strategy that is tightly linked to the brand across all brand aspects, from products, packaging, and advertising to websites and other communication materials, to build "secondary meaning". Maintaining detailed records of color usage in products, advertising, packaging, and other areas will help businesses convincingly and effectively demonstrate their intellectual property rights in the color mark, strongly support claims of IP infringement against infringers, and increase the likelihood of winning in IP disputes.

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