

COLOUR:AN UNCONVENTIONAL TRADEMARK

- NABHALI M. MHATRE

ABSTRACT

Trademark law protects the owner's exclusive rights to use the mark, thereby preventing any unauthorized use of the mark which shall cause confusion in the minds of the general public. It aims at promotion of goods or services in the market, at the same time restricting competitors from using the mark and gain profits through imitation. It also aspires to protect both the interest of the consumer and the traders in the market. It plays a crucial role in adding monetary value to the economic structure of a business.

This article highlights India's approach in the adoption and implementation of unconventional marks such as colour marks. Its input in furtherance of innovation and enhancement of industrial welfare is well established. The article also discusses some important judicial decisions in the field of colour marks in India.

INTRODUCTION

With growing industrialization, branding and trademarks have played a crucial role in marking one's product and services as unique, definite and attractive, to compete with other products in the commercial sector. Innovation & technology has paved the way to increase the scope of trademark and its subject matter.

Trademark is a mark capable of being represented graphically and distinguishes the goods and services of one person from those of others.¹ The definition of trademark is inclusive in nature. This means any word, device, brand, heading, letter, numeral, etc. can be included in the list if distinctiveness and graphical representation are present, hence be registered as a trademark. For instance, the famous e-commerce giant Amazon has excluded all others from using its mark (the lettering amazon with a yellow arrow underneath) as it not only recognizes the brand's identity but bestows the company with the goodwill attached to it.

¹Section 2 (1)(zb) of Trademarks Act, 1999

However, the problem arises in cases which fall outside the ambit of conventional or traditional trademarks, the registration of which becomes difficult to be given exclusive status. Such category of trademark is known as unconventional marks. These are mainly found in the form of smell marks, shape marks sound marks, or colour marks.

The Trademark Act, 1999 draws influence from both US trademark law as well as UK. The doctrine of functionality and graphical representation which forms an integral part of US and UK law finds a place in Indian trademark law as well.

THE COLOUR DILEMMA

With the passage of time, businesses have started using colours and its combinations in brand names, symbols, signs and logos; in turn helping consumers to identify the source of the goods, leading to an increase in the market of a particular source. An individual or an entity cannot register itself as the owner of a colour, however it can own a certain pattern of a particular colour like McDonald does not own the red colour but it does own the pattern or the shape in that red colour and hence no one can replicate it.

The registrability of a single colour mark forms a grey area in the trademarks as it inherently lacks distinctiveness and it becomes very difficult for consumers to identify the source of goods or services just by a single colour.²

While filing for a particular single colour trademark, an applicant is required to submit evidence to show that the said colour combination or colour that has been claimed is solely associated with the applicant and the public associates the colour with the goods mentioned in the application. The burden lies on the Applicant to prove that the particular colour or sound has acquired distinctiveness in course of trade or has acquired secondary meaning due to bonafide uninterrupted usage. However, if the colour that is applied is common to trade then it might be difficult to claim distinctiveness over the colour. For example, Orange as a trademark for a drink may be distinctive but when the colour orange is claimed for packaging of those bottles would be non-distinctive.

²UK: *Colour Marks: The Issue of Trademarking Colours*, Jack Kenny

Similarly, if a particular applicant is granted a single colour trademark it is likely to attract opposition from other players in the industry on the grounds of there being a limited number of colours.

LEGAL JURISPRUDENCE RELATING TO TRADEMARKS IN INDIA

This issue of single colour marks was addressed by World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)³ which broadened the legal definition of trademark to encompass "*any sign...capable of distinguishing the relevant goods or services of one undertaking from those of other undertakings.*"⁴ The only benchmark for registrability of a colour is that it is "*visually perceptible*", "*inherently capable of distinguishing the relevant goods or services*" or "*registrability which may depend upon distinctiveness acquired through use.*" The definition of the word 'mark' and 'trademark' provides for "*combination of colours*" or "*any combination thereof.*"⁵ A single colour is nowhere expressly or impliedly excluded from the preview of these definitions.

The Trademark Rules, 2017 ushered in a new era in the domain of registration of unconventional marks, wherein it shall be protected on strict evidence of acquired distinctiveness and protection granted strictly to the extent of that particular shade of colour. Sounds marks are awarded protection under Rule 26(5) while protection for colour marks can be secured by submitting a reproduction of that combination of colours. Till date, there exists no provision for registration of smell marks in India.

The Indian judiciary has acknowledged colour as a part of trade dress and provided protection to it in *Colgate Palmolive Company v. Anchor Health & Beauty Care Pvt. Ltd.*⁶ Also in the famous Cadbury case, Cadbury proved that its distinctive shade of purple (Pantone 2865C) on the wrappers packaging for its milk chocolates had gained a distinctive character. Public survey was submitted as a proof to this assertion and the same was granted on 1st October 2012 after a long drawn out legal battle with Nestle. However, later when Cadbury attempted to widen the scope

³TRIPs is an international treaty which sets down minimum standards of protection and regulation for most forms of intellectual property in all member countries of the WTO.

⁴Article 15(1)- Protectable Subject Matter, TRIPs Agreement

⁵Section 2(m) defines the word 'mark' and Section 2(zb) defines the word 'trademark' in the Trademarks Act, 1999

⁶2005(31) PTC 583 DEL

of its trademark to widen its shade to its other products, it was rejected by the court of appeals.⁷ While graphical representation of colour is possible by referring to any international system of colour, it is almost impossible for a colour to be inherently distinctive.

The Hon'ble Delhi High Court in one of its recent judgment on May 25, 2018, in the case of Christian Louboutin v Abu Baker⁸, held that the use of a single colour of Christian Louboutin SAS does not qualify the single colour to be a trademark in view of provisions of Sections 2(m) and 2(zb) of the Trade Marks Act.

The Judiciary in India has laid down contradictory judgments in this regard which adds to the existing confusion among applicants and thereby forcing them to apply for a unique combination of colours rather than a single colour, on the other hand the corporate giants take the benefit as well as the risk of protecting single colours in their favour.

CONCLUSION

It is therefore, clear that for registration of single colour trademarks there needs to be a 'plus' factor to the colour, because single colour on its own lacks the inherent capacity to be distinct. At present, there is no strict test laid down to determine whether the colour has acquired distinctiveness and if the customers associate the colour with the brand.

It is the need of the hour that, the Hon'ble Supreme Court or the Parliament of India, lay down strict principles in regards to this aspect to avoid contradictory judgments of the High Court. If not, the Trade Marks Registry should initiate steps to formulate rules and follow a uniform practice in registering single colours as trademarks. This is difficult but not impossible.

⁷ *CADBURY UK LIMITED v. THE COMPTROLLER GENERAL OF PATENTS DESIGNS AND TRADEMARKS & SOCIÉTÉ DES PRODUITS NESTLÉ S.A.* (Case No: A3/2016/3082)

⁸ CS (COMM) No.890/2018