



DISTINCTIVENESS IN TRADEMARK PROTECTION – A COLOURFUL DILEMMA

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ABSTRACT

Distinctiveness is quite an open to interpretation word that serves as a defining meaning to grant of a trademark. It is that certainty which protects and serves to secure the uniqueness of any product in the eyes of law and distinguish it from others. While a variety of attributes serve to shade this distinctiveness, colors form an important part of the discussion. While section 10 of the Trademarks Act of 1999 seeks to codify the colour question, what remains as an intriguing confusion is the nature of colours – whether single or a combination and if single then how can its distinctiveness be showcased. With new cases on this issue, subsequent amendments and TRIPS guidelines, there is a scope of research in ascertaining distinctiveness through this colourful dilemma. Colour is that essential part of a brand name or logo which grabs attention and retains them, becomes a symbol by way of which it gets stored in the memory of consumers and users, and hence assumes fundamental importance in securing protection. While section 10 acts as the statutory authority, there are other executive rules and manual that aides in the substantive codification. Much of the law is beyond codification and reliant upon interpretation and hence research on these matters always bear certain fruitful results.

KEY WORDS –

Distinctiveness

Colour

Mark

Identification

Codification

Statutory

Interpretation

DISTINCTIVENESS IN COLOUR

Trademark rests on the main definition of a distinguished mark – one that serves as an identity mark almost. Under the Trade Marks Act, 1999, ("Act"), as per section 2(1)(zb), "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours and as per section 2(1)(m), "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. The statute is clear in its language of explaining trademark as something that garners attention on the scale of being recognised by its basis. The distinctiveness is not merely an outstanding feature but rather such unique feature that would fit in with people enabling them to associate that particular mark with the goods marked thereto. The entire trademark regime rests on one fundamental principle and that is the defining nature of a mark – the capacity for a visual symbolic representation to disseminate its association with a particular class or genre of goods or a particular specific good. The entire marketing strategy of a product depends firstly on acceptance and secondly on retention. In order for people to retain a concrete memory of a product and be able to identify it amidst tough competitions, its mark has to be bold enough to retain itself in human memory and strike resemblances too. Marketing and creative strategists round the globe are trying hard to produce such a creative mark often coupled with the use of marks, sound – audio visual rendition or even smell to that extent. It all depends on litigation and case to case analysis in the court of law and in the office of Registrar to establish a legal and statutory recognition of the mark.

For the sake of this distinctiveness, colours are also used. A colour or a combination of colours can be registered as a trademark as statutorily codified in the Trademarks Act 1999. In the case of

Loubitin v Yves Saint Laurent –

US court had held that providing exclusivity of trademark protection over the colour red affected competition in the market.

While filing for a color trademark, an applicant is required to submit evidence to show that the said color combination or color that has been claimed is solely associated with the applicant and the public associates the color with the goods mentioned in the application. The evidence can be in the form of such as public surveys demonstrating association of the combination of colors with the applicant's product or brand. However, without sufficient supportive evidence, acquiring protection in this way may be difficult. The burden lies on the applicant to prove that the particular combination of colors has acquired distinctiveness in course of trade or has acquired secondary meaning due to bonafide uninterrupted usage. For example, Orange as a trademark for a drink may be distinctive but when the color orange is claimed for packaging of those bottles would be non-distinctive.¹

The ability of a colour to retain its impression in a person's mind is striking and poignant. Colour helps to create a unique recognition of a brand – it fills the monochrome design with the attractive aesthetic element of colour. It has tremendous appeal to the bare eye, and is able to grab the eyeballs smoothly as well. Hence it becomes immensely important to keep the feature of colour in mind and also strive to grant due trademark protection to it. However the biggest problem with colour is the limitation of its spectrum as visible to human vision and the combinations thereof. This limitation poses a problem to colour trademark recognition- reduces competition, stifles expanse and scope and also becomes difficult to incorporate and recognise the variations. Hence a harmonious approach has to be used.

¹ Dipak Rao, India – Protection of Color under the Trademark Law, 13th June, 2019, available at - <https://www.mondaq.com/india/trademark/814512/protection-of-color-under-the-trademark-law>
Last seen on 01/10/2021.

CASE LAWS THAT SHAPED THE COLOURS –

1. Colgate Palmolive Company v. Anchor Health & Beauty Care Pvt. Ltd. –

Colgate sought interim injunction against Anchor from using its trade dress colour combination of two third white and one third red, as it was similar and amounting to passing off as well. The court held that it is the overall impression that a customer get as to the source and origin of the goods from visual impression of color combination, shape of the container, packaging etc. If illiterate, unwary and gullible customers get confused as to the source and origin of the goods which they have been using for longer periods by way of getting the goods in a container having particular shape, color combination and getup, it amounts to passing off. In other words if the first glance of the article without going into the minute details of the color combination, getup or lay out appearing on the container and packaging gives the impression as to deceptive or near similarities in respect of these ingredients, it is a case of confusion and amounts to passing off one's own goods as those of the other with a view to encash upon the goodwill and reputation of the latter. In the said case the Indian judiciary acknowledged color as a part of trade dress and provided protection to it in in the present case by injuncting Anchor from using the color combination of red and white in that order as trade dress on the container and packaging.²

2. Cadbury Uk Limited V. The Comptroller General Of Patents Designs And Trademarks & Société Des Produits Nestlé S.A. (Case No: A3/2016/3082) –

Cadbury proved that the distinct shade of purple (Pantone 2865C) that was used to wrap its products covers had gained a distinctive character and that it became intimately associated with recognising the product. Hence it got protection against Nestle. In order to ascertain this , public opinion survey was taken up by the Court.

3. Deere & Co. & Anr vs. Mr. Malkit Singh & Ors. (CS (COMM) No. 738/2018)

Protection was granted to plaintiff's green- and yellow-coloured tractors manufactured for agricultural use based on well defined criteria. These are as follows –

- The colour coding of green and yellow has been used by plaintiff for over 100 years hence rendering the colour combination very essential as an identification mark of the product.
- Due to distinctiveness in the nature of the trademark colour combination the court held that there was right to seek injunction to prevent use of the registered colour combination of green and yellow.
- Therefore, the mark/combination is reputable, distinctive and stands as an instant source-identifier for the Plaintiffs' agricultural products.
- Use of similar colour combination by defendants amounts to undue advantage of a reputed trademark and also constitutes unfair trade practice and behaviour.

The main principle which became quite evident from this case was that – The impact of colours on a trademark is manifold. Its sense of unique impression vests the mark with an element of identifiability and relatability. When such a colour is either deceptively copied or deliberately used in a rival or competing product then it gives insight into a dishonest trade practice of trying to confuse an bewildered innocent consumers, tricking them into buying a brand, taking advantage of the similar colour trademark's repute.

4. Christian Louboutin v Abu Baker³

- This case significantly opened floodgates of a different thought – the issue of single colour trademarks and its significant absence from the statutes.
- The language of section 2(m) rests on the words combination of colours and hence single colour recognition is not available in the statutes.
- Red colour on the sole of heeled shoes was refused protection on the said ground.
- The bigger question lies in interpreting the statute more liberally and figuring out a way to protect the single colour trademarks.

² 2003 (27) PTC 478 Del

³ CS (COMM) No.890/2018

BIGGER ISSUES – THE WAY FORWARD

Brand names (words or phrases), symbols, signs and logos, all of which may collectively or individually make a mark cannot be without colours and thus colours started gaining significance in terms of trademark. With passage of time, industrialists and big entrepreneurs started using these colours and its combinations; it helps customers to relate the goods to their source which helps to increase the market of a particular source and also excludes others from deriving any benefit accrued from this unique mark.⁴

Importance of an attractive and a colourful trademark rises with increasing diversification of product widths – the same manufacturer advances into different markets and increases product dimensions. In order to help consumers from identifying the efficacy of the brand and use its established goodwill for its newly launched products, the easiest discerning mark becomes the trademark.

In case of single colour trademarks there are some primary issues –

- According to colour depletion theory with a due limit of set colours in the visibly distinct spectrum, there will be no colours left for new brands to register if single colour trademarks are being granted protection.
- According to the set benchmarks for single colour protection, the said mark has to prove its distinctiveness and that it has become a source or origin of identifying the goods associated with the said mark.
- But, acquiring the status of well-known mark is also a big deal. Evidences showing extensive sales and recognition along with past usage for a long period of time are helpful to prove a well-known mark and subsequently to get a single colour trademark registration.

In the United States, single colour trademarks are being given protection on the ground if it has attained a secondary meaning to it. This has to be interpreted with the emerging importance that the mark garners for itself through sustained usage and applicability. In order to establish a strong distinctiveness, it has to be in use for a prolonged period of time and it must have helped people identifying the product through that colour feature. Section 124 of the Trademark Rules 2017 also sanction the same.

In the case of Cipla Limited vs M.K. Pharmaceuticals⁵ -

Delhi HC refused protection to the orange-coloured oval tablets of the company, thereby making an exclusive interpretation of colours in trademark.

In the appeal filed by Louboutin company pestering its case, the single colour trademark was associated with it being a device trademark – the mark being visible at one particular point in the matter for sale – the shoe. Hence a change or a supplementary attribute has to be affixed on the subject of single colour so as to make it distinct. This supplementary attribution goes a long way in helping to defend single colour defence in registration and litigation as well. In the light of this, another case has to be substantially dealt with –

In the case of Marico Ltd. vs. Mr. Mukesh Kumar & Ors⁶ - it was a case where a competing brand of Parachute oils had made deceptively similar packaging and trade dress, involving the issue of the use of blue colour as well.

“With regard to the issue of infringement and passing off in colour combination, this Court is of the view that the plaintiff is not claiming monopoly over a single colour inasmuch as the plaintiff’s bottle is not only blue in colour but it also contains amongst others a coconut tree, a broken coconut device, a flag which has a dark blue background and certain descriptions written in white font. Consequently, the plaintiff is not claiming

⁴ Gaurav Tiwari, Single Colour Trademarks – The Dilemma, available at <https://www.mondaq.com/india/trademark/782690/single-colour-trademarks--the-dilemma>
Last seen on 03/10/2021.

⁵ MIPR 2007 (3) 170

⁶ 2018(76)PTC168(Del)

exclusivity in blue colour as a stand alone factor, but in a combination of factors, which includes the blue colour.”

The protection that was granted by the court relied on the single colour only in association with the other attributes and not simply by itself.

In, Colgate Palmolive Company and Anr. Vs. Anchor Health and Beauty Care Pvt. Ltd.⁷

An excerpt is notable –

"60. In the case of passing off and for that purpose infringement of trademark which are already in existence, the second or for that purpose the subsequent comer has certain obligation to avoid unfair competition and become unjustly rich by encashing on the goodwill or reputation of the prior comer. They have to establish and bank upon on their own trade dress or distinctive features so as to establish their own merit and reputation and attract the attention of the purchasing public and if there are no substantial dissimilarities of marks, colour combination, getup or layout on the container or packing or covering of the goods of the prior comer these are likely to create confusion in the minds of customers between his goods and the goods of the prior comer in the market as underlying and hidden intention of the second comer is to encash upon the successful rival."

"62. Significance of trade dress and colour combination is so immense that in some cases even single colour has been taken to be a trademark to be protected from passing off action. Colour combination is a trademark within the definition of the TMM Act as there is no exclusion in the definition. Even a single colour has been held to be a trade mark. There may be exception also. Exception is that where the colour cannot be protected as the blue colour is for the ink and red colour is for the lipstick. Red and white has nothing to do with the pink. Teeth as white line and gum as pink colour alone at least sometimes can meet the basic requirements as a trademark. Colour depletion theory is unpersuasive only in cases where a blanket prohibition is being sought."

CONCLUSION -

From the different cases and the trends of interpretation by the Courts there are some points that call for a summarised analysis –

- ❖ Be it single colour or a colour combination, the interpretation has to be liberally done and inclusively considered as well.
- ❖ Combination of colours is not an exhaustive mandate by the act
- ❖ Single colour becomes distinctively important in case it gets associated with identifying the product by consumers in the market.
- ❖ Source Identifier is the analytical construct for the same.
- ❖ Blanket prohibition is not demanded by the single colour registrations – it just identifying that style of colourful representation along with other combinations of colours.
- ❖ Need for Courts to lay down criteria distinctly for single colour trademark considerations is the need.
- ❖ Executive manuals and rules also need to take the issue into some due consideration.

⁷ 2003 SCC OnLine Del 1005

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