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POSITION OF COLOUR TRADEMARKS, ACCEPTABILITY AND RELATED ISSUES: A COMPARATIVE ANALYSIS

Anuja Misra* and Chitra Ahluwalia**

Abstract

With the growing awareness of the essence of a trademark ranging from small businesses to multinationals, there is a constant development in adopting innovative and unconventional marks. One of such marks, bloomed to the full in recent times are the colour marks; although, they too, in the tedious process of recognition and protection as trademarks, have faced countless impediments. The essence of the paper brings out the same with a comparative analysis of three jurisdictions. Where the Shade Depletion Theory depicts how monopoly over a finite number of colours may lead to ultimate depletion of the colours in public domain, the Confusion Theory suggests innumerable shades of one colour on the Pantone Scale leading to extreme confusion amongst the purchasing public. Another aspect while protecting colour marks the Doctrine of Functionality which relates to the functional or descriptive aspect[1] of the mark. Pink toned milkshake cartons may be presumed as a strawberry product; similarly, monopolising red colour for a fire extinguisher where red represents the colour of danger and high descriptiveness. The second chapter of the paper mentions the plight of the Indian judiciary faced with insuperable difficulties in establishing rights over 'colour combinations' subject to acquired distinctiveness after admittedly hesitating to grant single colour monopolies. Realising the importance that a colour or its combinations play in a trade dress, courts have addressed it through precedents like Colgate Palmolive in light of the unwary consumers. The third chapter of the paper discusses the exclusivity of colour marks across European Union being reluctant in protecting these marks as compared to US where obtaining exclusive right over colour marks is more flexible. The last part of the paper has

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1 Section 9(1)(b), Trademarks Act, 1999

been concluded by raising relevant concerns and providing suggestions regarding the registrability of colour marks. The pace at which businesses are realising the importance of trademarks is impressive and should be tackled with caution as well as creativity.

Colour Mark as a Non-Conventional Trademark

The Indian trademark act in its definition of a trademark states that "a mark which is capable of being represented graphically and which is capable of distinguishing goods or services of one undertaking from those of other undertakings." Since colour at the outset aid in enhancing the visual appeal of a mark, they serve as good graphical representations of a mark. Also, since colours are so distinct that they remain in the minds of the public and help them to identify the goods as coming from the same source, they have proved to be a powerful representation in marketing and advertising. The flashing siren red of Louboutin's[2] sole and the soothing blue colour of Tiffany have great ability of attracting the consumers and henceforth acquire distinctiveness by secondary meaning. As commercialisation grows in the capitalist market, there grows a need to protect such marks.

The European Union has always been apprehensive about granting colour marks. They were from the beginning totally against trademark of primary colours for a simple reason that the primary colours are basic colours and monopolising these basic colours would not only shrink the public domain but also limit its use. Also it has to be kept in mind that if no protection at all is given to these marks then it can lead to widespread copying and deceptively similar competing products will enter the commercial market likely to cause confusion in the minds of the public. A similar thing happened in the Louboutin case where the court did not grant injunction to it against the other competing products and as a result Louboutin suffered great loses in its business.

Colour attributes to the visual perceptibility of a mark and when a word combined with a colour denotes or signifies the products of a brand name, it serves as a successful trademark. What was held in the *Re Owens-Corning*[3] case was that "the colour pink may signify roof insulation, by virtue of both its physical resemblance to, and factual connection with pink roof insulation. Also through the connection of a myth, examined below, the sign pink may associate itself with roof insulation."

2 Kabak, M.L., "*Are Colour Trademarks Valid? : A Sneak Peak at Louboutin's Appeal for Trademark Protection for Red Soled High Fashion Heels*" (2012), http://www.sanfranciscobusinesslawyerblog.com/2012/04/islouboutins-red-sole-for-women-shoes-a-valid-trademark.html.

3 Re Owens-Corning Fiberglass Corp. 774 F.2d 1116 (1985).

Colours play an important role in communicating a lot to people. Like generally we have an assumption that the colour red signifies love or blue signifies peace or green signifies envy and so on. Thus, colours sometimes play this important role of communicating about the products belonging to the trade name company and that is how people remember it and associate the colour with the mark. In the case of *Qualitex v. Jacobson*[4], the court overturned the notion of generic application and held that the ironing pad had acquired its use of the colour green and hence it shall be associated with the company on grounds of secondary meaning. When a colour is being used for a particular product or brand it is easy for people to remember or trace the origin. This is exactly how colours become a 'sign' protected as a trademark.

Colour Depletion Theory

It has been made clear that if a trademark acts as a sign, it can distinguish between the products of one from another like the purpose of any other trademark; or if it has acquired a secondary meaning, then it can be registered as a valid trademark. However there are certain impediments in the way of colour mark being registered. They can be discussed under:

- Colour depletion theory
- Shade confusion theory
- Doctrine of functionality[5]

The colour depletion theory states that the colours which act as a sign for the registration of trademark are limited in number and when a company acquires trademark on a colour, there becomes one colour less from the existing range of colours available for the public to use. Also, if we see it from the manufacturer's point of view, then they will have one less option for choosing a colour as trademark and this will go on with the remaining manufacturing companies who want to register colour as marks, till all the colours are exhausted. In the case of *Campbell soup Co. v. Armour & Co.*[6], the plaintiffs who used to have their goods packed in red and white packaging barred the defendants from using similar colours. While the defendants got a valid trademark on the colour which acted as a sign and was distinctive in nature, it was still contended that the request to have a monopoly over the two colours was not desirable. This would encourage other manufacturers too, to have their colour marks registered leading to a situation where all the colours would

4 *Qualitex Co. v. Jacobson Products Co.* 514 U.S. 1300 159 (1994).

5 Vana, J.L, *"Colour Trademark"* 7 TIPLJ 387 (1999).

6 F. Supp. 114 (E.D. Pa. 1948).

be claimed monopoly upon, and there would be no colour left in the public domain. This situation, forget the difficulties which it brings with it, is not feasible.

However, in the case of *Qualitex*[7], the U.S Supreme Court rejected the view and held that there are a wide range of colours and the shades of those colours and that the mere granting of trademark to a colour would not lead to a limited supply of colours. The court gave this opinion keeping in mind that the manufacturers would be positioned at an inconvenience if they were refused the right to register these marks as trademarks. But if there is a finite number of colours, then granting protection to all of them would lead to an increase in the number of infringement litigations where the use of any colour mark would violate the registration of the said colour as a trademark.

Shade Confusion Theory

When we talk about shades of a colour, the basic assumption is that if a single colour is registered as a trademark, then the usage of its different shades would lead to confusion. This is not taken into account only when dealing with infringement procedures but also the confusion that the customers will face while purchasing goods. Confusion can be created in the minds of the public by using a slightly different shade of colour when going for a trademark registration[8]. The names and colour codes of different shades of the colours can be found on the *"Pantone Scale[9]"*. However, even though the scale provides apt colour codes for the sake of registration, it seems meaningless when we talk about 'likelihood of confusion' in the minds of the public because howsoever colours there may be specified distinctively on the scale, the close shades of a colour will seem the same to an average person of imperfect recollection[10]. What these manufacturers of like products do once they know that a specific colour has been trademarked by the other company, is that they select a close shade of the same colour from the Pantone Scale and file for registration, least caring about the deceptive similarity that it causes. For e.g. the colour shades of Cream Pink and Petal Pink seem all the same to a layman unless the proper code number is specified. This affects not just the brand owners but the general public.

Functionality Aspect of Colour Marks

The doctrine of functionality in colour marks considers keenly the functional aspect of the marks. In cases where a colour is descriptive of its nature in the sense that it provides a

7 *Supra* note 4 at 3.

8 Denoncourt J, Intellectual Property Law, 146 (3rd ed. 2012).

9 *'Find a Pantone colour',* https://www.pantone.com/color-finder.

10 *Amritdhara Pharmacy v. Satyadeo Gupta, AIR 1963 SC 449*.

technical result, then the mark is not workable under the trademark law to get protection. This is done to stop the monopoly over the functional aspect of the mark. This can be elucidated further by help of an example. The colour Black absorbs heat faster and the reason why it is used in non-stick utensils of different companies so as to help food cook faster. If Prestige acquires a monopoly on this black colour on utensils then the other non-stick utensil companies would not be able to even establish a market. This would lead to an anti-competitive practice and hence not desirable under the trademark law. The colour Red painted on fire extinguishers which usually signifies danger, if monopolised by one company would prove to be a setback for the other fire fighting equipment companies.

The functionality doctrine concept under colour trademarks which is not favourable to colours providing a functional element can best be explained with the help of two cases- *Christian Louboutin S.A*[11] and *Maker's Mark Distillery, Inc*[12]. The doctrine seconds the view that such colours cannot be granted monopoly even if they have acquired distinctiveness in the market by secondary meaning[13]. In the *Louboutin* case, the court refused YSL's objection to the use of red colour on soles. The court said that "we see no reason why a single colour mark in the specific context of fashion industry cannot act as a brand or source identifier." Also the court gave protection to the red colour on the sole of Louboutin based on acquired distinctiveness of the brand as it wasn't serving any functionality element. YSL could keep any other colour on the sole as identification. In the other case of *Maker's Distillery,* the plaintiff sued the defendant Jose Cuervo on the use of dripping wax seal on its tequila bottles. The district court barred the defendant from using the red wax seal on the cap of the bottle to which the defendant responded that it was an aesthetically functional feature and appealed to the U.S. Court of Appeals. The apex court upheld the decision of the district court banning the defendant from using the red dripping wax seal on the bottles they were selling.

Therefore, it can readily be concluded that the colour marks are in fact unconventional in its very nature, since they bring along many impediments in their way. Issues in relation to the limited number of colours, confusion amongst the similar/ slightly similar shades of the same colour as well as the functionality aspect making the mark descriptive in nature, wherein the descriptiveness serves as an absolute ground of refusal, are some of the speed

11 *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.,* 696 F.3d 206 (2d Cir. 2012).

12 *Maker's Mark Distillery, Inc. v. Diageo North America, Inc.,* United States Court of Appeals for the Sixth Circuit, 679 F.3d 410 (2012).

13 ZadraSymes, L, *"Sounds, Smells Shapes and Colours Protection and Enforcement of Non-traditional Trademarks in the U.S."*, http://vipo-online.org/wp-content/uploads/2011/10/Sounds_Smells_Shapes_and_Colors-tm-protection-US.pdf.

breakers in the smooth adoption of such marks. The shade depletion theory has been well explained by the US courts in the landmark *Qualitex* judgement stating that refusal to grant protection where a particular colour is associated by the consumers exclusively to such proprietor only, may cause losses to such entity, however on the other hand has also acknowledged that granting protection to over all colours, which lead to an increased infringement cases. Shade depletion theory on the other hand, involves the *Pantone Scale* which provides for a wide range of colours leading to confusion between different shades of a single colour. Another major impediment involved in adoption of a colour is in relation to the functionality aspect of a colour linked with the type of goods/services being provided under it. The functionality is linked directly to the descriptive nature of a mark which has been catered symbolically by the US Courts in *Maker's Distillery*.

Colour Trademark: Position in India

Initial Stage of Non-Acceptance in India

In the Trademarks Act 1999, the definition of "trademark" and the word "mark" both include 'combination of colours' to be acceptable for registration of a trademark provided it is such a graphical representation that it is capable of distinction. Initially the Indian judiciary was a little influenced by the European Union ideology of not granting protection to colours as trademarks because of the colour depletion theory and hence granting monopoly rights over a colour was out rightly rejected.

This was reflected in the case of *Colgate Palmolive*[14], where the court was hesitant in granting a colour a trademark to the red and white trade dress of Colgate giving the reason that both red and white are basic colours and are descriptive in the sense that they depict the colour of tooth and gum. *Prima facie* the court rejected but an exception was held in this case that no party can claim a monopoly in a particular colour but if there is a combination of colours that has been long used by a manufacturer company and due to secondary meaning has been imprinted in the minds of the customer as coming from that particular company only, then such combination could qualify for trademark protection provided it fulfils all the other criteria of a valid trademark. Also if the colour combination, layout, packaging and the overall get up have been attached to a product for quite some time, then in that case, if the competitors come up with a deceptively similar product, there is a very high chance of the public being misled and if the trade dress or the colour is not registered, then, there is only by way of passing off that the infringed can claim their right.

14 (1998) 1 Comp LJ 171 MRTPC.

Shortly thereafter, the judiciary realised the growing importance of trade dress and colour as a trademark and that it casts a lasting impression in the minds of the customers who begin to associate that particular mark with the product. As per the definition given in the act, combination of colours or even a single colour serves as a trademark although a trademark consisting of combination of colours stands at a better chance of having the mark registered as it would face less opposition and also because of the distinguishability factor. It is seen that at present, in India, the courts are more at ease when it comes to granting trademarks to a combination of colours which on the other hand in case of a single colour, a stronger evidence as to its validity is required. "The judiciary understands the mental association of the colour in the mind of an average buyer[15]." As per the Trademarks Manual guidelines, 'in exceptional circumstances a single colour can be considered for registration if the colour is capable of denoting the origin of a product or service and has acquired a high level of distinctiveness.' The judiciary is still a little unconvinced about granting protection to a single colour but keeping in mind the mental association of the people they have started to change their practice on the pretext that if a company has in fact gained reputation in the market for being associated with a particular colour then it would be unfair if he has to bear infringement costs and loss to his repute because of other deceptively similar marks in the market.

Trade Dress Issue and Stand of Judiciary

Trade dress generally refers to the outer facade or the packaging of a product that makes it visually appealing. It is a form of intellectual property and is nowhere as such defined or protected under a different act. Its sanctity flows from the Trademark Act 1999, under section 2(zb)[16] that defines trademark to be inclusive of *"shape of goods, their packaging and combination of colours."* Protection to trade dress began to be given after the manufacturer company without due registration of his trademark established quite a repute and goodwill in the market, and then was threatened by the other party who tried to bring in the market a deceptively looking similar product quite similar to the earlier goods by its outer appearance or packaging. Thus in the cases of alleged infringement of the trade dress, the owner has to prove his established goodwill along with substantial damage to it. The concept of trade dress has been taken from the U.S Lanham Act[17]. A trade dress may include in addition to packaging, graphics, design, shape, size, colour combination, texture or placement of words on it amounting to the general outer appearance of the product.

15 *Rupa and Co. Ltd. v. Dawn Mill Co. Ltd.* AIR 1998 Guj 247, (1999).

16 "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.

17 Section 43(a), US Lanham Act, 1946.

The *Colgate Palmolive Co. v. Anchor Beauty Care Pvt. Ltd.*[18] is an important case addressing the issue of trade dress in India. In that the court said that "It is the overall impression that customer gets as to the source and origin of the goods from visual impression of colour combination, shape of the container, packing etc. If illiterate, unwary and gullible customer gets confused as to the source and origin of the goods which he has been using for longer period by way of getting the goods in a container having a particular shape, colour combination and getup, it amounts to passing off."

The court in the case held that there was no monopoly on the particular colour but since similar reproduction of the combination of colours created a likelihood of confusion in the minds of the people, there was a ground for stopping the defendants.

Registrability Issue

Trademarks are generally composed of words or letters or accompanying slogans, but since the recent developments in the law of trademarks has brought in various types of trademarks, there has been considerable controversy regarding colours as a trademark. In India for the registration of a colour, the shade has to be graphically represented on a sheet of paper whereas in U.S. and E.U. the representation is done on the Pantone scale. Even after having all these requirements for registration of the colour on a sheet of paper, in India there are some problems that cannot be done away with when it comes to colour marks. Some of the problems include shade confusion theory and the material to which it is applied. At the time of registration, the applicant is not supposed to submit a sample of the material to which the proposed colour needs to be applied, which makes it all the more difficult to ascertain that over a period of time the shade fades away or changes when applied to a different material, making it extremely difficult to keep a legal record of such legal requisites.

Keeping this entire debate aside the Indian judiciary, which was earlier apprehensive about granting trademarks to colours, now has started believing that colours and the trade dress constitute an important part of the product because of the mental association that it casts in the minds of the consumers. It is now comparatively relaxed in this regard but still suffers from certain hurdles in registration of a single colour as a trademark. There are some desired suggestions that need to be applied for the registration process of colour trademarks which have been separately dealt with in the last part of the paper.

Concluding the position of the colour marks within India, it can be seen that, the initial phase of introduction of these unconventional marks, the Judiciary was essentially hesitant

18 2003 (27) PTC 478 Del.

in offering monopoly to colour marks. This was also reflected in the case of *Colgate Palmolive* where it was pointed out that the combination of red-white was descriptive in nature as it represented the gum-tooth assemblage. However, the court was flexible enough to acknowledge the mental association of the colours by the consumers in respect of only one product thereby providing that such monopoly can only be granted in cases where a mark has acquired a secondary meaning in its favour by the public at large. It cannot be ignored that the concept of trade dress has also been recognised in the same judgement by the Indian courts wherein the overall getup including the colours as shown within the packaging reflects the knowledge of consumers in respect of that product. Indian courts have been comparatively open to adoption of colour combinations instead of monopolising a single colour wherein exceptional circumstances may have to be proven. In practicality, there may be several issues a proprietor may have to face for obtaining protection over his unconventional mark including the graphical representation of a colour, fading away of the colours or the change in the shade of a colour when applied to a different material. Indian courts have usually kept a traditional approach while incorporating new concepts in the field of any intellectual property, however we have witnessed an increased number of instances wherein they have come out of this comfort zone and accorded protection over unconventional marks.

Position across Other Jurisdictions

The TRIPS Agreement, to which all the member states have to be in coherence with provides with a standard definition of Trademark as, "*any sign or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combination of colours as well as any combination of such signs, shall be eligible for registration as trademarks.*"[19]

European Union

The legislation dealing with the registration of Trademark in European Union is the EU Directive which has defined Trademark in Article 2[20]. The registration and enforcement of Community Trademark is regulated by the "Council Regulation on Community Trade Mark" (CTMR).

19 Article 15(1), Agreement on Trade Related Aspects of Intellectual Property Rights, 1995.

20 Article 2**:** A Trademark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertaking.

The purpose of trademark is essentially to differentiate one's products from others. The concept of trademark protection in European Union is considerable young as compared to US, which is why it has been centralized.[21]

The TRIPS Agreement expressly mentions that 'combination of colours' can be registered as a trademark but does not mean to exclude the registration of a single colour.[22] Whereas there has been no explicit mention on the same in the definition under the EU Directive but it abides itself by the definition under TRIPS and the list given in its definition of trademark is hence not exhaustive. Following this, the trademark laws of many of the members of the EU have directly incorporated the registration of colour marks as well, which includes the German and Latvian laws.

Fulfilling the registrability criteria can be difficult when it comes to colour marks. From the time period of 1996 to 2012, the OHIM had received around 880 applications pertaining to colour trademarks, out of which only 276 had been accepted and approved.

However, the criteria to apply for the registrability of a colour mark had been laid down in the *Sieckmann's case*[23], according to which the graphical representation of a trademark should be "clear, precise, self-contained, easily accessible, intelligible, durable and objective".

However, in the *Libertel case*[24] of 2003 the general criterion of Sieckmann was observed to be applicable for colour trademarks as well. The court further held that the graphic representation of a colour mark can be fulfilled by consisting of a "description in word, a sample of the colour combined along with the description and designating the colour through an internationally recognised identification code." The court therefore laid down two essentials to get a protection over a colour mark:

1. Capable of graphical representation
2. Capacity to distinguish

21 Taylor Piscionere, *Imitation may not Always be the Sincere Form of Flattery: Why Colour Wars in the United States and Europe may result in Brand Dilution and Colour Depletion*, 25 Pace Int'l L. Rev. 43 (2013).

22 D. GERAVIS, THE TRIPS AGREEMENT: DRAFTING, HISTORY AND ANALYSIS, 2nd Ed. (Sweet & Maxwell) (2003).

23 *Ralf Seickmann v. Deutsches Patent*. C-273/00

24 *LibertelGroep BV v. Benelux*. C-104/01

In the case of *Heidelberger BauchemieGmBH*[25], filed an application for registration in the German Patent and Trademark Office consisting of a "rectangle having the colours blue on the top and yellow below it", which was to be used in connection with the building materials the application was rejected on the ground that it was impossible to represent the sign graphically and neither did it have any distinctive character. Upon an appeal to the Federal court in the present case, the ECJ gave certain guidance regarding the issue. ECJ confirmed the decision by stating that even though single colours are protectable but a combination of colours which is in every conceivable form" may not be able to fulfil the requirement of graphical representation. The court further observed that while dealing with applications relating to combination of colours the exact ratio or proportion must be provided by the owner.

This could lead us to the conclusion that, a liberal approach in order to fulfil the criteria of 'graphical representation' may lead to incorrect decisions and legal uncertainty. It would allow too much monopolization of the mark and the consumers would also not be able to differentiate the products from others.[26]

Therefore, if a mark comprises of multiple shades the accuracy should be higher and the proportion of the colours should be specifically mentioned in the application.

In the 2010 case of *BCS v. John Deere*[27], registration application for the combination of colours green and yellow to be used with respect to agricultural machines was applied on the basis of acquired distinctiveness of the colours in the market. There was evidence to prove the long subsisting use of the colours which was interpreted as an indication to the source or origin by way of books, catalogues and trade fairs and that there was a long persisting usage of the colours which was even recognised by the consumers within the relevant market.[28]

Cadbury had also been successful in protecting the colour purple with respect to its packaging of which was bearing the pantone number 26854c. The court in this case also held that the mark had acquired so much distinctiveness that the consumers associate it with the product of the applicant. Evidence in the form of public survey was also submitted in regard of the same.

25 C-49/02, Heidelberger BauchemieGmBH

26 R 799/2004-1, First Board of Appeal, July (2005), IKEA (Blue & Yellow)

27 T-137/08

28 Hogan Lovells, *Green+Yellow=John Deere; Protection Granted for an Abstract colour Trademark*, Lexology, July (2010), Available at https://www.lexology.com/library/detail.aspx?g=565d82e7-9c70-4d35-b68d-4dc7975c4204

Trade Dress

Trade Dress in European Union is considered to comprise of the product design along with its packaging. Although the relevant statute does not provide with any explicit definition for trade dress, but has been cited in many case laws and has differed across various jurisdictions. The Community Trademark Law extends protection to trade dress only when the particular requirement for distinctiveness has been met. The ECJ has time and again emphasised that the standards to assess the distinctivity is uniform for all types of marks.

The rationale for granting protection to trade dress depends on the subject matter under which it is to be protected. From the perspective of Trademark, a trade dress which has acquired distinctiveness and secondary meaning within the relevant sector of the market can be protected. Moreover, if protected under designs the trade dress should not be an imitation or already publicly known.[29]

United States

Registration of trademarks in US is governed under the Lanham Act and registration procedure is done at the United States Patent and Trademark Office (USPTO). Since trademarks are territorial in nature, the act provides protection to the registered trademarks only in US and after the registration; it is notified to all the other states as well. The act provides liability against the infringer to sue them being a legitimate and viable owner of the trademark.[30] Section 45 of the act defines the trademark and what all could constitute to be a trademark.

The statutory definition does not seem to expressly mention colour mark as a type of trademark and hence not eligible for protection as per the traditional ongoing rule. However, for a long period of time it was not extended to colour marks until the landmark judgement of *Qualitex Co. v. Jacobson Product Co.*[31] For a better understanding of the case, it is necessary to know about the situation prevailing 'Pre-Qualitex' as well.

Pre-Qualitex Position

Previously, colour mark was not recognised or not considered to be capable of registration and the rationale behind the said contention was that it being a 'weak mark', the consumers cannot identify and indicate the origin or source of goods. This has been observed in a

29 Report of Trade Dress Protection in Europe, Sept (2007) pp 1-6.

30 Section 32, US Lanham Act, 1946.

31 514 U.S. 159 (1995).

plethora of judgements.

In the case of *Diamond Match Co. v. Saginaw Match Co.*[32], the court refused the application for registration on the ground that a single colour mark would not be able to serve the purpose of the trademark and hence could not be registered. Thereafter, the court in the case of *Campbell Soup Co. v. Armour & Co.*[33] *(1949)* dealing with the same issue denied the trademark to "horizontal red and white Campbell's soup labels" to the owner. The court reasoned its decision by saying that it would lead to colour monopolization, depletion in colours available as well as confusion of shades. If trademark is given over a particular colour it will grant them the exclusive rights to restrain anyone to use the colour. However, the traditional practice did not bar the registration of a colour absolutely but it was held that in order to make the colour an essential feature of the mark, it should be so intricately connected with the mark or design that the manufacturers of similar products know what they may be allowed to pursue with.

However, in the case of *Re Owens-Corning Fibreglass*[34], the Court of Appeals for the Federal Circuit brought about a twist by stating that the tradition of not granting colour trademarks should be done away with and should be scrutinised or judged as per the facts and circumstances of each case. The fact that Owens-Corning used the colour pink in connection with his insulation products for over 30 years, has acquired distinctiveness among the consumers over a period of time. The court observed that the colour was arbitrarily chosen and could not be connected to the products in any way, and therefore had acquired a secondary meaning. But the judgement was unable to bring about a significant change in the minds of the judges, following which the seventh and ninth circuit courts refused to comply with this decision. This ideology was subsisting until the U.S. Supreme Court decision in the *Qualitex* case.

Post-Qualitex Position

The plaintiff company used to manufacture iron pads that were 'Green-Gold' in colour since 1950s for the purpose of dry-cleaning. The court in this case out rightly accepted that the green-gold colour has acquired distinctiveness among the consumers so much so that it has acquired a secondary meaning and therefore granted the colour mark.

32 142F, 727.

33 175 F.2d 795.

34 774 F.2d 1116.

Trade Dress

It is pertinent to discuss the concept of Trade Dress with regard to issues under colour marks. Trade dress is a form of intellectual property which comprises of the visual elements of the product or its packaging which makes it easier for the consumers to identify the source or its origin.[35]

The Lanham Act does not per se grant recognition to Trade Dress, but Section 43[36] provides for certain remedies available against the infringement of trade dress, when not registered. It states that when a plaintiff files a suit for unregistered trade dress, he shall bear the burden of proving that the "matter sought to be protected is not functional." Thus, one requirement on which it clears its stance is that it should not be functional in nature. Therefore, it is possible to protect trade dress in US till the time it is not functional in nature and of course distinctive in character.

Journey so Far

Having discussed the position of colour trademarks in the European Union and the United States, one thing has prominently been brought into light that nowhere do we have an express denial of the recognition of colour marks as trademarks. The Lanham Act might not expressly recognise it, however in EU or in India the phrase 'combination of colours' is mentioned. Where on one hand the TRIPS Agreement which sets out the minimum standards to be followed by the member countries includes in its understanding of the term 'sign', letters, numerals, figurative elements and combination of colours and any combination of such signs[37], the EU Directive and the Lanham act have in a way by identifying packaging and trade dress exhibited flexibility in extension of protection to instances where the mark through its colour has established association with the attached brand name and has gained popularity among the public for the same.

Agreed that the packaging not only comprises the colour scheme in the backdrop but a combination of that with probably lines or a pattern or how a particular brand name is written, it all adds up to enhancing the visual appeal. Even so, the colour plays a predominant role in the association of the trademark with the manufacturer company that advertises and markets

35 Rituraj Shrivastava, *Trade Dress: Concept*, Mondaq, Sept (2013), http://www.mondaq.com/india/x/262928/Trademark/Trade+Dress+Concept+And+Indian+Practice.

36 § 43 (15 U.S.C. § 1125). False designations of origin; false description or representation:
(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

37 Article 15 of the TRIPS Agreement.

it. Hence colour trademarks have garnered importance lately By way of 'combination of colours' and 'packaging' many countries all over the world are trying to expand protection to intellectual creativity.

Conclusion and Suggestions

Conclusion

Colours tend to leave behind an impression in the mind of the viewer. It becomes easy for people to identify and recognise things through colour marks. The recent trademark trend has been to look for innovative ways which are fascinating enough for the consumers of the relevant market. A single colour or a combination of it tends to distinguish the products of one owner from the products of others. It also forms a part of the packaging of the product and is even covered under the ambit of trade dress essentially. However, issues regarding monopolization of a colour can be reconsidered and ignored when the relevant market tends to link that particular colour to the product of the trademark owner. Recent trends have shown a development and modernised ideas have been inculcating with the acceptance of colour marks in US and EU.

However, certain level of clarity is needed as far as the registration of colour marks is concerned. Courts have a major role in laying down certain minimal standards to be fulfilled in order to get registration of a colour mark as a trademark. The two main requirements put forward and reaffirmed in cases like *Sieckmann*and *Libertel* includes the possibility of a colour to be capable of graphical representation and the existence of acquired distinctiveness of that colour within the consumers.

Indian courts have now chosen a liberal path in respect of the same issue for example, PayTm has now been granted a trademark over the colour combination of white and blue. However, the judiciary still seems too apprehensive while granting single colour marks as trademarks due to the fear of monopolization and further a misuse. However, the functionality aspect is also one of the major issues while speculating such cases because the justification for the same has been that if the colour is of a functional character it cannot be registered under trademark, same can be observed from the major dispute between *Colgate v. Anchor*.

A balanced approach could be the ideal situation wherein the interests of both the trademark applicant as well as the consumers should be kept in mind. The courts have to judge from the point of view of a person of an average intellect. Colour marks are therefore yet at an

infant stage wherein the judiciary has to play a major role by putting forward the facts and circumstances of each case.

Suggestions

In spite of the colour mark serving as a good trademark, there exist still certain hurdles to the successful registration of the same. Following are some suggestions that can help overcome these issues:

1. As already discussed, Indian scenario is still a little hesitant in granting colour trademarks to a single colour. To this issue, proper guidelines should be set out by the Trademark registry, outlining the problems that can crop up and how to deal with such problems along with ascertaining experienced people who shall deal with the same.

2. With respect to colours, the confusion as to the particular shade of the colour is bound to happen. Robust registration search systems should be made that can find out the exact difference between the colours and also whether there is a chance or likelihood of the public getting confused with the two colours or not.

3. Another issue that was raised was that the shade of the colour proposed to be registered depends on the material that it is applied to, and may change if applied to another material. In this regard, the Registrar along with asking for the exact shade of the colour from the *Pantone scale* should also ask the applicant to furnish along with the colour, a sample of the material to which the colour is proposed to be applied as a live example so that the exact shade of the colour can be registered. To prevent further confusion, the Registrar should have the powers to restrict the applicant to that particular shade only and prevent him from using the colour on a different material as submitted.

4. The issue that came up in the *Nexium* drug case was that people identified drug with the colour bringing up the stance that in India, trade dress is becoming increasingly important in the pharmaceutical sector. Before the registration of a particular colour to a drug, efforts should be made to ensure that it does not coincide with another drug of the same or similar colour and if so, then either the applicant should be notified to change the shade of the drug colour or a public notice should be issued along with big advertisements ensuring that the public which consumes these essential drugs are in no way confused by either the name of the company or the colour.

5. Special individual recognition should be given to trade dress in order to make these two branches i.e. trademark and trade dress, different and eliminate confusion. Also, it would be easier for the courts to litigate on matters when they know what the subject matter pertains to.

On a clear establishment of the fact that colours not only play a vital role in creating a lasting impression in the minds of the public thereby making it way easier for them to choose the product of a company of their choice amidst hundreds of alternatives of the same product available in the market, it goes on to add a visual appeal to the product. Even though a lot many cloth detergents companies have gone for the regular white and blue packaging, with their respective trademarks a part of the same, we have diversity with *'Ariel'* choosing the colour green and *'Tide'* choosing an absolutely out of the box, unrelated colour orange for its packaging to create this lasting impression in the minds of the public ensuring and making the best efforts with their creative thinking so that their product cannot be confused with another's at all costs.

However, the paper surely raises concerns about monopolising particular colours majorly the primary colours, which have been many a time refused by the courts until and unless they are presented in a combination with other colours or are different shades on the pantone scale or have proven the strength of their mark to be well known having earned secondary meaning after years of operating in the market. Be it Cadbury's purple or PayTm's blue, all had to go through a rigorous tussle in the courts to prove their strength of the mark, although examples like Christian Louboutin's red sole[38] does give us a hint that there is light at the end of the tunnel after all!

38 *See,* Anand and Anand, *'Single-colour trademarks – enforcement of Christian Louboutin's 'red sole' trademark',* World Trademark Review, 19 December 2019, https://www.worldtrademarkreview.com/single-colour-trademarks-enforcement-christian-louboutins-red-sole-trademark