

Legal Issues in ‘Special & Unconventional Trademarks’

Issue: Is the Threshold for Distinctiveness for Colour Marks Higher than for Conventional Marks?

Introduction

❖ What are Unconventional Marks?

- Unconventional Marks are those types of trademarks that do not fall under the description of a traditional trademark. These marks include the colour, smell, shape of goods, motion, taste, texture as well as hologram marks. In India, sound marks, colour marks, shape marks and in some cases motion marks have been registered and granted protection under the provisions of the Trademark Law.

❖ What are the requirements to be fulfilled for registration as an Unconventional Mark?

- The conditions to be met in order to register an Unconventional Mark are –
 - a) The mark should be distinctive.
 - b) The mark should be able to distinguish the goods and services under the Mark from that of the Goods and Services of others.
 - c) The mark should be capable of graphical representation.

Introduction (Contd.)

❖ What is the threshold for ‘Distinctiveness’?

- A mark may be inherently distinctive, that is, it may be classified as an intrinsically recognizable trademark and therefore, eligible for trademark protection. Marks that may be arbitrary, fanciful, subjective, and suggestive are also thought to be inherently distinctive.
- A mark may also acquire distinctiveness, when due to the extensive and substantial use of the mark, it gains a secondary meaning, wherein the consumers associate the mark exclusively with the goods and services for which the it has been used.

Relevant Legal Provisions

❖ Section 2(1)(m), Trade Marks Act, 1999 –

“(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;”

❖ Section 2(1)(zb), Trade Marks Act, 1999 –

““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;”

❖ Section 9(1)(a), Trade Marks Act, 1999 –

*“9. Absolute grounds for refusal of registration.—(1) The trade marks—
(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person; Shall not be registered”*

Relevant Legal Provisions (Contd.)

❖ Section 10, Trade Marks Act, 1999 –

“10. Limitation as to colour.—(1) A trade mark may be limited wholly or in part to any combination of colours and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trade mark.”

❖ Section 32, Trade Marks Act, 1999 –

“32. Protection of registration on ground of distinctiveness in certain cases.—Where a trade mark is registered in breach of sub-section (1) of section 9, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration and before commencement of any legal proceedings challenging the validity of such registration, acquired a distinctive character in relation to the goods or services for which it is registered.”

Relevant Judicial Decisions

❖ ***Colgate Palmolive Company v. Anchor Health & Beauty Care Pvt. Ltd.* [108 (2003) DLT 51]**

“54. ...no party can have monopoly over a particular colour but if there is substantial reproduction of the colour combination in the similar order...which over a period has been imprinted upon the minds of customers it certainly is liable to cause not only confusion but also dilution of distinctiveness of colour combination...”

“55. The difference in the style of the words appearing on the container or packing identifying its manufacturers by way of style, colour combination or textures or graphics is certainly significant or relevant for determining the overall imitation of the container but if a product having distinctive colour combination, style, shape and texture has been in the market for decades as in this case it is in the market since 1951 it leads to ineluctable inference of having acquired secondary meaning on account of its reputation and goodwill earned at huge cost.”

Relevant Judicial Decisions (Contd.)

❖ ***Christian Louboutin SAS v. Mr. Pawan Kumar & Ors.*** [CS (COMM) 714/2016, Delhi High Court, December 12, 2017].

“6. The distinctive nature of the plaintiff's 'RED SOLE' trademark has also been recognized by Trade Mark offices all around the world. The plaintiff's 'RED SOLE' trademark wherein a specific tone of colour red (pantone no. 18.1663TP) is applied to the outsole of a shoe, is unique in its own accord and became known in the world of fashion only after being introduced by the plaintiff herein..”

“14. From the material on record it is evident that the plaintiff's 'RED SOLE' trademarks have acquired a well-known character for the following reasons:-

- i. The plaintiff is well-known luxury brand with presence in over 60 countries including India:*
- ii. The plaintiff has been using its 'RED SOLE' trademarks extensively and continuously since 1992;*
- iii. The plaintiff's 'RED SOLE' trademarks are known to customers throughout India;”*

Relevant Judicial Decisions (Contd.)

- ❖ ***Deere & Co. & Anr v. Mr. Malkit Singh & Ors.* [CS (COMM) 738/2018, Delhi High Court, April 23, 2018].**

“20. ...it is apparent that in India, the definition of trade mark under Trade Marks Act, 1999, include combination of colours. However, in order to constitute a trade mark, a colour or combination of colours must be capable of distinguishing the goods or services of one trader from those of other traders.”

“22. The plaintiffs had used the green and yellow colour combination over agricultural products for the first time in 1910... The manner of use is very peculiar and unique to the plaintiffs i.e. Green colour for the body and yellow colour for the seat and the wheels/rims...Consequently, the colour combination of green and yellow in relation to agricultural equipment is associated solely with the plaintiffs...Consequently,...the use of the colour combination of green and yellow by the defendants, in conjunction with other elements, is liable to be taken as use in the sense of a trademark, especially when the defendants claim that it helps set apart their products.”

Relevant Judicial Decisions (Contd.)

❖ ***Marico Ltd. v. Mukesh Kumar* [CS (COMM) 1569/2016, Delhi High Court, August 27, 2018]**

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

“53. In the present case, the get-up is not only novel, but distinctive and acts as a source identifier, even though it consists of a combination of commonly used parts...it seems prima facie that plaintiff’s packaging is exclusively associated with the plaintiff and the products bearing the plaintiff’s trade dress are recognized by the public as being sourced from the plaintiff and from no one else.”

Relevant Judicial Decisions (Contd.)

❖ ***Christian Louboutin v. Abu Baker* [RFA (OS) (COMM) 13/2018 & CM 29064/2018, Delhi High Court, April 11, 2019]**

“27. ...”single colour not being a mark, the single colour cannot be claimed as a trademark”. The Plaintiff assails this to be based on an incorrect understanding of the Plaintiff’s mark. From the averments in the plaint, it is evident that the Plaintiff is claiming distinctiveness over the use of „pantone red”, which is a particular shade of the colour red and used at a specific part of a shoe...That if the RED SOLE trademark is emblematic, it is due to the promotional efforts of the Appellant.”

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“28. ...The specific case of the Plaintiff is that the said trademark was a "device trademark" consisting of a combination of a colour red and the placement of the said colour at a specific position on the outsole of a shoe and that it would be wrong to assume that it consists only of an individual single colour. It is pointed out that the determination of the nature of the trademark was a ‘mixed question’ of law and fact.”

Conclusion

- ❖ A color cannot be inherently distinctive, however, a combination of colours which has acquired meaning can gain distinctiveness and is capable of being registered and protected as a trademark under the Indian Trade Mark law.
- ❖ Judicial precedents have established that a combination of colours, and in rare cases, a single colour can be granted protection under the provisions of the Trade Mark law if the colour mark has become exclusive to the goods & services provided under the mark.
- ❖ Therefore, distinctiveness in case of a colour mark is acquired only when the colour or the combination of colours used is unique to and can be solely associated with the goods & services provided thereunder. The colour or the combination of colours in itself must be capable of distinguishing the goods or services of one trader from those of other traders.

THANK YOU!

Questions?

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