



COLOR-BLIND TRADEMARKS AND ITS REGISTRATION IN INDIA: A COMPARATIVE STUDY WITH INDIA, E.U AND U.S.A

Ms. Barkha Dodai¹ & Mr. Abhilash Arun Sapre²

ABSTRACT

Color-blind trademarks are marks that do not rely on color as a distinctive element and are increasingly gaining popularity among brand owners. This study presents a comparative analysis of the legal framework and practical implications of color-blind trademarks and their registration in India, the European Union (EU), and the United States of America (USA). This study examines the legal requirements for the registration of color-blind trademarks in these jurisdictions, including the relevant statutory provisions and case law. Furthermore, the research analyzes the impact of the registration process on the practical aspects of trademark protection and enforcement in India, the EU, and the USA. The research concludes that while the three regions share some commonalities in their approach to the registration of color-blind trademarks, there are significant differences that need to be taken into account by brand owners and practitioners in these jurisdictions. This research

contributes to the ongoing debate on the evolution of trademark law in the global context and provides valuable insights into the complexities of color-blind trademarks and their registration. Additionally, the research considers the practical implications of the registration process. This includes analyzing the impact of registering color-blind trademarks on the ability of brand owners to protect and enforce their trademarks in each jurisdiction.

Keywords: Color-blind trademark, Enforcement, Protection, Registration, Trademark.

INTRODUCTION

The identification mark of a good or service, by way of which the consumers identify the said goods/products/services, is called the Trademark. The original use of a trademark, which included but wasn't limited to indicating ownership of particular goods or services, has been expanded to include advertising by the seller and denoting

¹ Assistant Professor of Law, MS Ramaiah College of Law, Bengaluru.

² Assistant Professor of Law, Gujarat National Law University, Gandhinagar.

unique status, and preference to the consumer of a particular brand.³ The importance of these marks is attached to the owners of the goods, which is expressed by the societal perception towards the owner of a Mini Cooper Car or a Louis Vuitton handbag⁴ or the treatment any phone owner receives, whose phone's ringing tone is a unique feature of the Apple Company's iPhone. This special power of trademarks in aiding people to associate the brand, label, origin, and value of the product with the respective brand sellers and the class of owners originates from this sense of societal perception.⁵ The traditional trademarks used by the traders conventionally include illustrative elements of a 'combination of colors and 'shapes' of unique nature, comprising various letters, trade names, numbers, logos, pictorial representations of ideas, etc. Recently, there has emerged a newer trend and use of trademarks, comprising of the appearance, motion marks, smell marks, sound marks, shapes, textures, mono-colors, holograms, shades, etc., by various traders/companies. The sound marks may be musical, non-musical, or both; taste marks or gustatory marks; the tactile marks, the scent marks or the olfactory marks, the taste marks or the gustatory marks are perceived by the remaining senses.

Since the inception of the concept of the same, the trademarks have witnessed a rift in the division of their category. The marks that do not fall under the category of the conventional trademarks (including letters, numbers, logos, graphic description, symbols, or those elements which consist of the combinations of such elements) are called non-conventional trademarks. The definition of a non-conventional mark is illustrative. It states that it includes the shape of goods, packaging, and combination of colors within its ambit, based on appearance, shape, sound, smell, taste, textures, etc.

VARIOUS ISSUES PERTAINING TO NON-CONVENTIONAL TRADEMARK

The proliferation in the use of trademarks as an advertisement technique has been one of the core reasons why the Indian law pertaining to the registration of trademarks must be reviewed. Upon comparison with the laws on the subject in the E.U. and the U.S., Indian preparedness on the exact needs tweaking on various levels for readiness on the registration criteria of a trademark. This article attempts to compare the existing legal regimes of the E.U. and the U.S.A. concerning the registration of the non-conventional Trademark.

The registration of the non-conventional Trademark has raised two issues mentioned here under: -

- a. The extent of protection granted to these non-conventional trademarks.
- b. The concerns relating to morality are issued upon ownership of these marks.

The concerns related to brand protection of these unconventional trademarks raise a question on the procedural issue of registrability and the enforcement of the exercise of the right of exclusive use of the mark so granted in various jurisdictions. On the other hand, brand protection techniques for these non-traditional trademarks raise ethical concerns about "owning" a color, "owning a sound," or "owning a fragrance" that might be naturally available elsewhere. These issues drastically impact the competition and tend towards monopolization concerning the other existing and potential competitors.

The advancement of technology enabling the validity of such marks,⁶ including multimedia, short video clips, etc., is far behind the pace of the development of the law that must accord protection to these marks, thus, avoiding the absurd

3 LIONEL BENTLY, BRAD SHERMAN, INTELLECTUAL PROPERTY LAW 694 (2 ed. Oxford University Press 2004).

4 WILLIAM CORNISH, DAVID LLEWELYN, INTELLECTUAL PROPERTY: PATENTS, COPYRIGHT, TRADE MARKS AND ALLIED RIGHTS, 603 (6 ed. London, Sweet & Maxwell 2007).

5 *Id.*

6 V.K. Ahuja, *Non-Traditional Trademarks: New Dimension Of Trade Marks Law*, 32(11) EUROPEAN INTELLECTUAL PROPERTY REVIEW 575 (2010).

monopolization of every indication conceivable that is capable of being registered. In this field of study, there must be laws to address the paradigm shift regarding the type of registrable signs, the evolving demands and interests of the applicants, and the relevant stakeholders.

STATUS OF LAWS CONCERNING THE REGISTRATION OF VARIOUS MARKS IN E.U., U.S., AND INDIAN JURISDICTIONS.

Registrability of the mark denotes the fulfillment of the registrable criteria laid down under various jurisdictions, the most common practice being that it should be distinctive and have the capacity to be graphically represented. Multiple jurisdictions have identified the significance of the registration of these marks. However, among these jurisdictions, there is no unanimity regarding the requirements for the registration of non-conventional trademarks.

General Overview of the Legal Regime in the E.U.

The legislation that permitted the registration of non-conventional trademarks in Europe, introduced respectively in 1988 and 1993,⁷ are the E.U.'s Trademarks Directive⁸ and the Community Trademark regulation.⁹

“European trademark law has undergone its most substantial reform since implementing the (former) Community trademark system in 1996.” Since October 1, 2017, the E.U., requirement of the Trademark being capable of graphical representation has been dispensed with, thus opening up the opportunity for trademark owners to

obtain protection for non-conventional trademarks aforementioned.

Article 4 of EUTMR, as amended and effected from October 1, 2017, states as follows: “An E.U. trademark may consist of any sign, like the shape of a product or the way it’s packaged, as long as it can: (a) distinguish the goods or services of one undertaking from those of other undertakings; and (b) be listed on the Register of European Union trademarks (the Register) in a way that lets the authorities and the public know what the protection is for.”¹⁰

“The list of types of marks accepted before EUIPO has been extended and now includes word, figurative, shape, color, sound, position, pattern, motion, multimedia, and hologram. An inessential yet inevitable point is that provision of protection to these marks may still be difficult as marks must satisfy the requirement for distinctiveness and representation – albeit not graphic – pursuant to Article 4(b) EUTMR.” This indicates that olfactory marks or smell marks, for example, are still tough to register.¹¹

General Overview of the Legal Regime in the U.S.A.

On the other hand, the US has taken a comparatively liberal approach towards granting the registration and protection of unorthodox trademarks. The primary function of a trademark is to ensure that it enables source identification of the goods/services so marked and that it fulfils the registrability criteria. Trademark matters are regulated by the Trademark Act of 1946, known as the Lanham Act. It states that a trademark can incorporate non-traditional marks as long as it does not specifically exclude them. The definition of this

7 Op. cit. H. Macqueen, C, Waelde, G. Laurie, 565.

8 First Council Directive of 21 December 1988 to Approximate the Laws of the Member States relating to Trade Marks (89/104/EEC).

9 Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Marks.

10 AnkeNordemann-Schiffel, *Why Product Shape Marks May Be in Bad Shape in the European Union*, INTA BULLETIN, (May 19, 2022, 11:38P.M.), <https://www.inta.org/INTABulletin/Pages/WhyProductShapeMarksMayBeinBadShapeintheEU7318.aspx>.

11 EUIPO’s “new” types of marks in practice: Any takers?, LIMEGREEN IP NEWS, (Jul.18, 2020, 11:00 A.M.), <https://www.limegreenipnews.com/2018/03/euipos-new-types-of-marks-in-practice-any-takers/>.

phrase states that it encompasses “any sign, name, word, or device, or any combination thereof, that identifies and differentiates the services and goods of one person from those of another and indicates the origins of such services and commodities”¹². A reading of the aforementioned provisions makes it clear that there’s no statutory provision or rule that prohibits the registration of the non-conventional Trademark, viz., the sound, scent, motion, three-dimension tactile marks, and flavor. Thus, they are eligible for the protection accorded under the law.¹³

General Overview of the Legal Regime in India

To fulfil its obligations under “the Paris Convention for the Protection of Industrial Property (Paris Convention) and the Agreement on Trade-Related Aspects of Intellectual Property Rights, the Indian government enacted the Trademarks Act, 1999”. The Act was brought into force on September 15, 2003. The procedural facilities provided by the Intellectual Property Office (I.P.O.) have been made productive through various measures, viz., the provision for filing for the registration of the trademark online.¹⁴

Sections 2 (1) (zb)¹⁵ and 2(1)(m)¹⁶ of the Act show “that the concept of a trademark encompasses three-dimensional forms, as well as combinations of colours and packaging.” This is a comprehensive definition, as established in the Trademark Manual; it includes any mark that is capable of being graphically depicted and distinguishes the products or services of one origin/person from those of another. This definition is not specific since it leaves open the potential of include unconventional trademarks. This makes the definition vague. It is important to note that the definition does not appear to leave room for

the inclusion of non-conventional trademarks as a separate category of marks, nor does it allow for any special criterion for the registration of the same. This is something that should be taken into consideration.

According to Section 18 of the Indian Trademark Act, “any application for trademark registration should comply with the rules and fulfil the eligibility criteria laid under. As per Rule 25(12) (b) of the Trademark Rules, 2002, the application for registration of trademark for goods and services has to be in such that it can be depicted graphically”.

Further, Rules 28 and 30 make it clear that the Trademark should be such that it can be presented on paper and further specify that the graphical representation made should be durable and satisfactory in its entirety.

Nevertheless, it is indicated that “particular care” will be required in the registration process for colours, forms, noises, and fragrances. In addition, Rule 29(3) makes it very clear that a three-dimensional mark (commonly known as a 3-D mark) and a combination of colours can both be registered as long as the registration conditions are met.

“Exception to the registration of shapes of the trademark if it emerges from the nature of products, or acquires a technical result, or when the shape offers considerable value to the goods,” which is culminating into the theory of functional use, is provided for in Section 9(3) of the Trademark Act.”¹⁷

COMPARATIVE ANALYSIS OF THE LEGAL REGIMES IN THE E.U., THE

12 Lanham Act, 15 U.S.C. § 1127.

13 *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164 (1995).

14 MohitLahoty, *Registering Unconventional Trademark*, I AM MAGAZINE (May. 20, 2022, 4:00 P.M.), <http://www.iam-magazine.com/reports/Details.aspx?g=2585df7b-fa7a-469d-85d2-601788181d36>.

15 *Id.*

16 *Id.*

17 *Non-Conventional Trademark*, GLOBAL PATENT FILING, (May 30 2020, 10:00 P.M), <https://www.globalpatentfiling.com/blog/non-conventional-trademark>.

U.S., AND INDIA TO FIGURE OUT A BRICOLAGE FOR EASE OF REGISTRATION OF COLOR MARKS IN INDIA

This article focuses on the different approaches adopted by the various jurisdictions concerning the registration of color marks, both single color marks and the combination of colors as trademarks. It further aims to develop a bricolage for overcoming the hindrances faced by the applicants seeking registration of color marks in the Indian jurisdiction basis the result of the comparative analysis of the laws of E.U. and U.S. pertaining to the registration of color marks as they have evolved and exist in the contemporary legal milieu.

Overview of the E.U.'s Legal Regime for registration of color mark

In *Libertel Groep BV v. Benelux-Merkenbureau*¹⁸, the test was used for the first time to decide if a single colour could be registered as a trademark. “Libertel, a phone company, tried to get the colour orange registered as a trademark, but the Benelux Trademark Office said no. After that, the court in the Netherlands sent the case to the E.C.J. to get a preliminary ruling on whether a colour can be unique and can be registered as a trademark. The E.C.J. based its “decision” on the Sieckmann test and the broad definition of a trademark in Regulation (E.C.) No. 40/94. It decided that even if a single colour doesn’t have the ability to tell different goods and services apart by itself, it can still be the subject of a registration as long as it has developed a secondary meaning, which is a unique quality that consumers recognise and which it has gained through its prior commercial use. Post the pronouncement of the decision in the case of Libertel, the E.C.J. considered the matter of registration of color trademarks in two other cases, namely, *Heidelberger Bauchemie GmbH*¹⁹ and *K.W.S. Saat*.²⁰

In Heidelberg’s case, the ECJ observed, “Since the case had alternate colour spaced bars, judges paid more attention to spatial delimitation. The applicant requested to trademark an undefined blue and yellow colour combination in Germany for building sector goods and services. The mark was printed on a rectangle paper sheet with the top half blue and the bottom half yellow, followed by a brief pictorial description: “The trademark applied for consists of the applicant’s corporate colours, which are utilised in every imaginable form, in particular on packaging and labels”.

“When the judges looked into the case, they found that the graphic representation wasn’t precise or consistent enough because it showed too many different ways the colours could look. So, the picture wasn’t enough to show what was going on. “It was decided that a trademark made up of two different colours without any lines between them must be shown graphically by putting the colours together in a certain way to make a certain combination and not have a chance of making other combinations.” The Court decided that colours by themselves can only be used to register a trademark if: “it has been established that, in the context in which they are used, those colours or combinations of colors represent a sign; and the application for registration includes a systematic arrangement of the colors concerned in a predetermined and uniform way”. By putting the systematic arrangement rule in order, the judges in the Heidelberg Bauchemie case created an additional guideline for registering future color trademarks in the E.U.

In *K.W.S. Saat*, the judges looked at the issue of registering color marks again, in light of Article 7 (1) (b) of Council Regulation (EC) No. 40/94, which says that “lack of distinctiveness is an absolute ground for refusal of registration.” The applicant wanted to register orange to set itself apart from the competition’s agricultural and forestry products and services. The E.C.J. said again that “even though the Regulation’s

18 *Libertel Groep BV v. Benelux-Merkenbureau*, [2003] ECR I-3793.

19 *Heidelberger Bauchemie GmbH* C-49/02 (2004).

20 *KWS Saat AG v Office for Harmonisation in the Internal Market*, [2004] ECR I-10107.

provision in question didn't make a difference between different kinds of signs in terms of the requirement for distinctive character, there was a difference between signs that are just one color and signs that are easy to recognize, like words or numbers". By applying the criteria laid down in the case of *Libertel*, the Court once again reiterated that a color per se did not possess distinctiveness outside of its use in practice and dismissed the appeal because the applicant failed to prove such distinctive character.²¹ Moreover, the graphical representation of K.W.S.'s color mark was unable to define any particular form or forms of visual or physical representation in its entirety.

In *Enercon GmbH v. European Union Intellectual Property Office (EUIPO)*, the key challenge was could the symbol, comprising of 'blended hues of green' for wind energy converters and components be registered as a trademark.

The Plaintiff registered the symbol as an EU color mark and applied for a colour mark by including a color code. The EUIPO granted a third party's trademark invalidity request. The Office argued that the Trademark outlines how the registered colors might be utilised in a wind turbine tower and lacks uniqueness as a color mark.

The Plaintiff appealed and argued that the Trademark, rather than being registered as a color mark, should have been registered as a symbolic mark. Moreover, it was not feasible to show acquired uniqueness of the combination of hues. This defence was accepted by the Board of Appeal of the EUIPO; but, on appeal, the E.U. General Court and the CJEU argued that the mark in question was truly a color mark that lacked any uniqueness.

As was indicated before, the necessity for pictorial representation will no longer be necessary in the European Union as of October 1, 2017, in accordance with a Directive from the EU. The ability to portray color marks in a

'clear and exact manner on paper' is now a need for applications to register color marks, therefore this modification does not affect the process of registering color marks. Nevertheless, this change is inconsequential for the process of registering color marks. In order to become legally protected as a trademark, applications for color markings are required to include both a "color code" and a color sample. Furthermore, acquired individuality needs to be presented and proven to the office to the point where they are satisfied. There are several well-known registered trademarks that consist of a single color, such as the color "magenta" for T-mobile, the colour "yellow" for Zwitsal, and the color "purple" for the chocolate bars produced by Milka."²²

The Registrability criteria in the U.S. for the color marks

Like Europe, U.S. courts have refused to register particular colors as trademark since its founding. At the beginning of the 20th century, the U.S. Supreme Court dealt with the question on multiple occasions, and none of the applications (red wire rope, single-colored gasoline, and oil well reamers) were given protection. Some state courts registered color trademarks where a secondary meaning was demonstrated, but for many years, the notion of color depletion precluded colors per se from being protected. There are just a few distinguishable hues and granting them all color trademark protection may hinder new enterprises from joining the market.²³

The entire case dealing with color trademarks in the U.S.A. came up in 1985: In *re Owens-Corning*,²⁴ the 'color depletion hypothesis' was overturned by the United States court under the provisions of the new 'Lanham Act', which made it possible to register the color pink for residual fibreglass insulation. The judgement was made on the basis of the support provided by federal justices for the ability of the color to operate as a mark. This

21 *Id.*

22 *Id.*

23 Gielen, *supra* note 18.

24 *Re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116 (Fed. Cir. 1985).

was confirmed not just by the secondary evidence but also by the registration description that was looked for.

In *NutraSweet Co. v. StadtCorp*²⁵ and *Qualitex Co. v. Jacobson Products Co*²⁶, The so-called ‘shade confusion’ theory came to light in order to rethink the decision that had been made in the Owens-Corning case. The reasoning presented by Owens-Corning, which permitted the registration of individual color marks, was rejected by two circuit courts in the United States due to the fear that it could lead to the registration of confusingly similar colors that only differ in the shade. This, in turn, could lead to a monopoly of one color on a particular market, and it could also lead to ambiguity regarding the colors if both were registered because they were strikingly similar in some aspect. The Owens-Corning reasoning was based the circuit judges in the cases of NutraSweet Company and Qualitex Company were unable to reach a decision, which led to the appeal of the latter case to the U.S. Supreme Court. In *Qualitex Co. v. Jacobsen Products Co., Inc*²⁷, it was held that color can also be used as a criteria that a person uses or intends to use the mark to identify and distinguish the products,” the U.S. Court ruled. Customers begin to associate a product with its color. The functioning concept of trademark law allows colour marks.

By preventing a manufacturer from monopolising a beneficial product characteristic, this philosophy promotes healthy commerce. “A product feature is functional if its exclusive use would place rivals at a considerable non-reputational disadvantage. The philosophy of

utility does not preclude employing color alone as a mark if it does not influence the product’s usage, purpose, cost, or quality. This dispute involves dry cleaning pads’ trademarked green color. Thus, the color’s secondary meaning did not describe the product’s purpose. Thus, color may fit trademark standards. It can be a symbol that differentiates an establishment’s products and identifies their source without serving any other significant function.”²⁸

The Court invoked aesthetic functionality considerations in a case known as *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*²⁹ wherein registration of red color used for women’s high-heeled designer shoe’s soles was allowed. However, protection of the red sole is limited to shoes on which there is a contrast between the outsole and adjoining shoe.

“The court rejected the argument of the defendant because the competition was not significantly hindered.”³⁰ A few more prominent examples of protected colors in the U.S. include Home Depot’s orange color for retail home improvement stores,³¹ Tiffany’s particular shade of blue used on its bags, boxes, and catalogue for jewelry³², United Parcel Service’s (U.P.S.) ‘chocolate brown’ applied to the entire surface of its vehicles and employees’ uniforms for transportation and delivery of personal property by air and motor vehicle.³³

“The protected colors have achieved secondary meaning, as the consuming public associates the protected color with the services provided by the genesis of those services or products. To safeguard a color, the color must be only used for promoting

25 *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1028 (7th Cir. 1990).

26 *Qualitex Co. v. Jacobson Prods. Co, Inc* 514 U.S. 159 (1995).

27 *Qualitex Co. v. Jacobson Prods. Co, Inc* 514 U.S. 159 (1995).

28 *Non-conventional marks*, LEXORBIT, (Apr. 10, 2022, 11:00A.M.), <https://www.lexology.com/library/detail.aspx?g=4339efff-eba0-4339-a5f9-47f2d72ae7d1>,

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

30 R. Rudensky, *A. Senterfitt, Aesthetic Functionality After Louboutin*, INTA BULLETIN, (Jul. 15, 2020, 5:04P.M.), <http://www.inta.org/INTABulletin/Pages/AestheticFunctionalityAfterLouboutin.aspx>.

31 Reg. No. 4,300,027.

32 Reg. No. 4,804,204.

33 Reg. No. 2,901,090.

the brand's identity without affecting the goods or services' functionality."³⁴

The Registrability Criteria in India for the Color Marks

The Act, while defining the concept of a trademark, had included the 'shape of goods, their packaging, and the combination of colors.'³⁵ Thus, the Act recognized that these three product attributes could serve as a mark.

The applicant must be able to table the evidence which proves that a particular color combination is related with the applicant or ultimately designates his goods/services. The following conditions need to be fulfilled for the registration of color as a trademark:

- The color or combination of colors can differentiate a product from other similar products.
- The color combination of color is exclusively connected with the applicant who wants registration of Color as a trademark.³⁶

The Act imposes certain restrictions and limitations in registering a combination of colors as marks concerning its distinctiveness and registration without the restriction of a color. The Act states that wherein any application for registration of a variety of colors crops up, the

tribunal has to consider the application in the light of its distinctiveness criteria.³⁷

However, the registration of a single color as a mark is still complex in India, as single color is not recognized as a trademark by the Indian courts in the cases they have dealt with.

The discussion concerning the registration of color marks originated in the Colgate case³⁸, wherein the Court recognized the color combination of 'white and red' used by the company. The Court thus held Anchor's use of the same variety in its toothpaste as passing off.

The Court stated that "a color combination is a trademark under the meaning of the Act, as there is no exemption in the term and the law of passing off protects even a single color". "In this case, the defendant used the same red and white colour scheme on its dental products as the plaintiff's trademark, which was made up of one-third red and two-thirds white."³⁹ However, this recognition of even a single trademark was later denied.

In a subsequent case⁴⁰, the Court decided that a single-color combination or a combination of colors is not a trademark and cannot be protected under the common law of passing off. The plaintiff said that its blister packaging, which had an orange, oval-shaped tablet inside, was a trademark. However, it was ruled that even if there was a deliberate replication of the similar color and shape of plaintiff's tablets, it will not amount to passing off. Reason being the color and shape

34 Justin M. Jacobson *A Look at Non-Traditional Trademarks: Color, Sound & Scent In The United State*, INTELLECTUAL PROPERTY BLAWG, (Jul. 28, 2020, 5:00P.M.), <http://www.intellectualpropertyblawg.com/trademarks/non-traditional-trademarks-color-sound-scent-us>.

35 *Id.*

36 *Color Trademark in India*, AAPKA CONSULTANT(Jul. 25th May 2022, 12:55 P.M.), <http://www.aapkaconsultant.com/blog/colour-trade-mark-in-india/>.

37 The Trademarks Act, 1999, No.47, Acts of Parliament, 1999 (Section-10) (Limitation as to color- (1) A trademark may be limited wholly or in part to any combination of colors and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trademark.

(2) So far as trademark is registered without limitation of color, it shall be deemed to be registered for all colors.

38 Colgate Palmolive Company v. Anchor Health and Beauty Care Pvt Ltd, 2003 VIIIAD Delhi 228.

39 *Non Conventional Trademarks: Analysis of the Indian Structure*, ROSTRUM LAW REVIEW, (Apr. 29, 2022, 11:00 A.M.), <https://rostrumlegal.com/journal/non-conventional-trademarks-analysis-of-the-indian-structure/>.

40 Cipla v MK Pharma, *MIPR* 2007 (3) 170.

are not indicative of the drugs, neither are they associated with the trademark.⁴¹

In the case of *Deere and Co v S Harcharan Singh*⁴², Plaintiff filed an action to protect its yellow and green colors. The Delhi High Court declared the word mark JOHN DEERE, the leaping deer logo, and the company's green-and-yellow color mark to be well-known trademarks that had goodwill in the manufacture and sale industry of farm equipment in India. Another sold kits with John Deere's logo and color scheme under the Moniker Surinder. Therefore, a suit for trademark infringement and passing off was filed and injunctions were sought by John Deere, who filed extensive evidence in support of each criterion needed to prove well-known trademark status, including:

- the use of the color scheme for past 100 years;
- the extensive sales accumulated in favor of the plaintiffs; and
- the comprehensive recognition of its trademark in abroad as well as by millions of Indian farmers.⁴³

Further, the extensive sales literature and localized documents presented before the Court established that the reputation of the John Deere trademarks had percolated deep into the Indian agricultural industry.

John Deere owned the color mark, not green and yellow. Pantone calls these colors John Deere Green and Yellow. Further, it has also been established that “monopolizing any of the seven

primary colors is against the color-depletion theory, securing trademark registrations over particular shades and combinations of such shades complies with the principles of trademark law.”⁴⁴

In 2018, the Delhi High Court, in *Christian Louboutin S.A.S. v. Ashish Bansal & Anr.*⁴⁵, granted an ex parte permanent injunction restraining the defendant from using Plaintiff's registered Red Sole trademark for footwear. The Court also awarded ‘delivery up’ of the infringing goods along with damages and costs of the suit to the plaintiff.⁴⁶ The Court observed that no further proof is necessary to determine infringement if the defendant's mark is identical or deceptively similar. However, the Court did not delve into whether or not a single color is eligible for trademark protection under Indian trademark law in this case.

This order appears to take an opposite view from the order of the same Court delivered on May 25, 2018, in the case of *Christian Louboutin S.A.S. v. Abubaker and Ors.*⁴⁷ In this case (involving the plaintiff's Red Sole trademark)⁴⁸, the Court, while examining the statutory definition of a ‘mark’ and a ‘trademark’ under Indian law, held that the color red—being a single color—does not qualify to be a mark under the Indian statute and is therefore not entitled to trademark protection, and thus, dismissed the trademark infringement and passing off suit on the ground that the Plaintiff makes out no legal cause of action.⁴⁹

The Court also held that “the use of a single color as against a combination of colors does not come under the meaning of a ‘mark’ as described under Section 2(1)(m) and a ‘trade mark’ under

41 *Id.*

42 *Deere and Co v S Harcharan Singh* MANU/DE/2873/2015.

43 *Id.*

44 RanjanNarula and RachnaBakhru, *India: A shift in protection of non-traditional trademarks*, WORLD TRADEMARK REVIEW, (Aug. 1, 2020, 1:00 P.M.), <https://www.worldtrademarkreview.com/trademark-law/india-shift-protection-non-traditional-trademarks>.

45 *Christian Louboutin SAS v. Ashish Bansal & Anr.*, CS (Comm) No. 503/2016, IA No.5766, (2016).

46 Registration No. 1922048.

47 *Christian Louboutin SAS v. Abubaker and Ors.*, CS (Comm.) No. 890/2018 (2018).

48 Registration No. 1922048.

49 *Christian Louboutin SAS v. Abubaker and Ors.*, CS (Comm.) No. 890/2018 (2018).

Section 2(1) (zb) of the Act”. Another important observation of the Court was that “when a registered trademark is being used as a characteristic of a good, i.e., it is serving a non-trademark function, then the use of the same by another person as characteristic of his goods cannot be termed as infringement”.

The latest decision, however, appears to be in sync with the Delhi High Court’s ruling in 2017, *Christian Louboutin S.A.S. v. Pawan Kumar and Ors.*⁵⁰, involving the plaintiff’s Red Sole trademark under Registration No. 1922048, wherein the Court had ruled Louboutin’s ‘Red Sole Trademark’ to be a ‘well-known mark’.⁵¹

While all three infringement suits appear to have similar facts and involve the plaintiff’s Red Sole trademark, there are diametrically opposite views in the Delhi High Court’s rulings on the point of protection of single-color marks.⁵²

Such inconsistent views pave way to misunderstand surrounding the principles of protection that apply to color marks.⁵³ There is no one-size-fits-all test to see if a color has become distinctive. Instead, it depends on how customers see the color and how the Court can catch it. Aside from the cases we’ve already talked about, the Wipro mark has also been registered in India. It uses a mix of colors.

POSSIBLE BRICOLAGE AND TAKEAWAYS FROM THE REGISTRABILITY CRITERIA EXISTING IN E.U. AND THE U.S.A. FOR THE INDIAN LEGAL REGIME

Contradictory judgments have caused confusion among applicants. They would be forced

to play safe and apply for a unique combination of colors rather than a single color and would continue to push so in the absence of the written guiding manual in respect of the same. Contrariwise, giant businesses with big pockets having the capacity to fight high-profile cases will take the benefit and risk of protecting single colors as their trademark, thus, creating the risk of monopolizing the single colors. The absence of a concrete legal regime paves the path for unfair competition. Thus, the ‘Supreme Court’ or ‘the Parliament’ should lay down strict principles regarding this aspect to avoid contradictory judgments of the High Courts. The legal regime ought to protect anti-competitive practices. If not, the Trademarks Registry should issue rules or follow a consistent pattern in registering single colors as trademarks. This is difficult but not impossible.⁵⁴

Depending upon the registrability of non-traditional trademarks, the trademark has to comply with specific statutory requirements. These requirements may vary from country to country depending on the laws existing on the subject matter. The TRIPS Agreement provides this flexibility through international treaties such as Paris Convention, Trademark Law Treaty, Singapore Treaty on the Law of Trademarks, etc.

It is apparent that while America’s approach towards these trademarks is liberal, the E.U. has displayed somewhat of a hybrid system. Unfortunately, unprepared India has imported E.U. guidelines regarding these marks without any modifications, even though the E.U. has removed the requirement for a graphical representation of an impact. The latest development in the E.U. has removed several impediments concerning the registration of a color mark, while confusing judgments have resulted in India.

50 *Christian Louboutin SAS v. Pawan Kumar and Ors.*, CS (Comm.) No. 714/2016 (2016).

51 Dishti Titus, *INDIA: Conundrum Surrounds Trademark Protection of Single Color Marks*, INTABULLETIN, (Apr. 24, 2022, 1:36 P.M.),

https://www.inta.org/INTABulletin/Pages/India_7401.aspx.

52 *Id.*

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54 Gaurav Tiwari, *Single color marks: A Dilemma*, MONDAQ, (June 4, 2022, 4:30 P.M.), <https://www.mondaq.com/india/trademark/782690/single-colour-trademarks--the-dilemma>.

The E.C. and U.S. practice warned that it is not easy for these non-conventional marks to be registered and that registration has been complex. In the E.U., these marks had a difficult start. The dispensation with the graphic representability requirement in 2017 by the Directive epitomizes an important step toward developing I.P. rights according to the challenges and conditions of the current business environment.

CONCLUSION AND SUGGESTIONS

WIPO's intervention concerning uniform guidelines regarding the graphical representation of non-traditional trademarks is the need of the hour. The WIPO Standing Committee on Information Technologies (SCIT) can provide insight into this procedural aspect and overcome hindrances.

A color mark that has acquired an extensive distinctiveness, even if the mark employs a single color, should be allowed registration because of its distinctiveness and the benefits that can be accrued from the mark. Hence, several points should be considered, such as representing the exact shade of color along with its shade number, as even a slight difference in the shade can lead to confusion.

It is further suggested that by requiring an international color code, color mark registrations would become easy, provide precision, and enable clear identification of unique colors. To offer increased clarity and notice to the marketplace, publication of the sample in the Official Gazette and making it available for search in the electronic registry should be mandatory procedural compliance. Also, a combination of colors should be encouraged, as there is no limitation concerning their registration.

In conclusion, the issue of color-blind trademarks and their registration has been a topic of discussion in India, the EU, and the USA. India has taken steps towards accepting and registering color-blind trademarks, following the lead of the EU and the USA. The EU and the USA have more progressive laws and regulations in this regard, which have enabled them to have a wider range of registered color-blind trademarks. However, India is catching up, with more recent

cases acknowledging the validity of color-blind trademarks. In any case, it is clear that the concept of color-blind trademarks is becoming increasingly relevant, particularly in a world where brands must distinguish themselves from competitors. Thus, it is essential for countries to continually update their laws and regulations to accommodate emerging trends and technologies, ensuring that they remain competitive in the global marketplace.

The registration of color-blind trademarks in India requires a comprehensive and nuanced analysis of the legal landscape, taking into account the domestic laws and international obligations. This research paper has explored the legal framework for color-blind trademarks in India, the European Union, and the United States, and has highlighted the similarities and differences between them. It has become clear that there is no universal approach to the registration of color-blind trademarks, and each jurisdiction has its own unique requirements and considerations.

The Indian legal system has undergone significant reforms in recent years, including the introduction of the Trade Marks Act, 1999, and the establishment of the Intellectual Property Appellate Board. However, the lack of clarity in the Indian law on color-blind trademarks and the absence of any specific guidelines for the registration of such trademarks has resulted in confusion and inconsistency in the application process. In contrast, the EU and the US have clearer legal frameworks for the registration of color-blind trademarks, although the registration process can be complex and time-consuming.

This research paper recommends that the Indian government takes a proactive approach to address the issues related to the registration of color-blind trademarks by providing clear guidelines and regulations. This can not only help to streamline the application process but also provide greater certainty for businesses operating in India. Moreover, India should look to learn from the experiences of other jurisdictions and explore the possibility of harmonizing its legal framework with international norms.

Overall, the registration of color-blind trademarks is an important aspect of protecting intellectual property rights and promoting innovation and creativity, and it is essential that the legal system provides an effective and efficient mechanism for achieving these objectives. The harmonization of trademark systems worldwide

would encourage investment flows and technology transfer in the global and national markets. The non-conventional trademarks should be well protected, and India needs to match the pace of the development of the laws and the genesis rate of the non-conventional marks.