

## Colour marks

A mark consisting of a single colour, or a combination of colours, is registrable as a trade mark provided that it has the required capacity to distinguish (section 3(1)).

### Representation and description

- If the applicant is seeking protection for a mark in a colour or colours (whether such colour or colours relate(s) to the whole of the mark or only particular part(s) of the mark), the representation of the mark on the application form (Form T2) must be in such colour or colour(s) and identifies the mark sought to be registered by the applicant.
- Where a colour or colours are claimed as a trade mark, this should be indicated by marking the appropriate box on Form T2A. In addition, the applicant must provide a description or statement in words of the colour(s) concerned on Form T2A. Moreover, the application must also include a representation of the mark in the particular colour(s) claimed.

#### *Example*

“The applicant claims the colours red and yellow as a trade mark.”

This is suitable for use for a trade mark consisting of both a single colour, or a combination of colours.

- For marks which consist of a colour or combination of colours and other kinds of signs, the applicant may wish to claim the colour or colours (part of the mark) as element(s) of the trade mark, that is, as a distinguishing feature(s) of the mark. In such cases, this should also be indicated by marking the appropriate box on Form T2A. In addition, the applicant must provide a statement or description specifying and claiming the colour(s) as element(s) of the mark on Form T2A. Moreover, the

application must also include a representation of the mark which identifies the parts of the mark which are in the particular colour(s) claimed.

*Example*

“The applicant claims the colours yellow and green as elements of the trade mark.”

A statement or description in words alone unaccompanied by a representation of the mark is insufficient. A clear representation of the mark is essential for the mark to be reproduced on the Trade Marks Registry’s computer system and for publication in the Hong Kong Intellectual Property Journal.

- If any of the above requirements (in relation to the completing of Form T2A, the statement or description of the colour claim, the representation of the mark, as applicable) are not met, it will be treated as a deficiency in the application. We will notify the applicant of the deficiency and request him to remedy the deficiency within two months of the date of the notice. If the deficiency is not remedied within the time limit, the application will be treated as abandoned (see chapter on Deficiencies checking).

### **Effects whether colour is claimed or not**

If the representation of the mark is not accompanied by a claim of the colour(s) as an element of the mark, the colour(s) will not be taken into account in assessing distinctiveness.

Because of this, a colour claim is essential if the applicant wishes to highlight the fact that he considers the particular colour or colours to be a distinguishing feature or features of the mark, or if it is the primary element of the mark (see Article 3(1)(x), Trademark Law Treaty, WIPO 1994).

As the scope of amendment for an application under section 46 is very limited, late colour claims will only be acceptable in the case of an “obvious mistake”, such as where the mark consists of a single colour so that there is no other possible distinctive element. Sometimes it can be difficult to decide whether a mark consists of a single colour. See *Woolworths Ltd v BP Amoco Plc* 52 IPR 192, where one of the issues was the amendment of a trade mark (before registration). The original representation of the mark, filed by the applicant BP, bore the following endorsement :

“The trade mark is limited to the colour green as shown in the representation attached to the application form.”

This endorsement was interpreted by the Australian Registrar of Trade Marks to mean that BP was seeking to register the device of a small square which was limited to the colour green, so that amendment of that mark to a mark which consists only of the colour green was said to have been improper.

An amendment of an application, from one without a colour claim to one where colour is claimed as a distinctive feature, would likewise be improper since it may substantially affect the identity of the trade mark under examination.

Where an “obvious mistake” is the basis for an amendment, it must be a mistake that is readily apparent on the face of the application so that the correction will not substantially change the trade mark. For example, the representation included in the application form is in red but the applicant claims the colour green as his trade mark in the statement.

### **Marks consisting of single colour**

The examination of single colours as colour per se marks requires very careful analysis since the effect of acceptance is to bar competitors from using those colours.

A single colour considered in the abstract, is capable of becoming a trade mark. However, by definition a trade mark must be distinctive and capable of serving as an

indication of origin. In other words, it must have the inherent property of distinguishing the goods as having come from a particular undertaking. In assessing its capability to distinguish, the customary use of trade marks as indications of origin in the industry concerned, as well as the relevant consumer's view, are relevant. A single colour, by itself, normally lacks the capacity to distinguish because consumers are not accustomed to making an assumption about the origin of goods on the basis of their colour or the colour of their packaging, in the absence of a graphic or text element.

For example, colour alone does not normally serve to identify a certain pharmaceutical tablet or a washing detergent tablet, not to mention one which comes from a single trade source. Instead, customers and the relevant trades are more likely to perceive certain colours to be indicative of specific pharmaceutical compositions or, in the case of laundry tablets, certain cleaning properties or ingredients. *Prima facie* objection should be raised under section 11(1)(b), (c) or (d).

Unless the mark is for very specific goods for a very specific clientele, or comprises a colour or shade which is extremely unusual and peculiar in the relevant trade, evidence will normally be required to establish factual distinctiveness. In such cases, the burden of proof is likely to be substantial.

See *Re Application by Cadbury Ltd* 55 IPR 561 (the colour purple) where the Australian Registry held that the colour as applied for was not to any extent inherently adapted to distinguish, as traders in confectionery will have a legitimate desire to use the colour purple on their packaging. Notwithstanding the commercial prominence of Cadbury's moulded milk chocolate blocks in purple packaging and that Cadbury has used the colour purple liberally in marketing those chocolate blocks, the evidence did not show that the purple packaging was functioning as a trade mark at the relevant date, nor that it distinguished Cadbury's chocolates from those of other traders.

If the colour forms part of a device mark which is itself distinctive, evidence may not be required. Alternatively, even though the mark may not be distinctive, the colour element may assist in establishing the mark's distinctiveness (see chapter on Shape marks). In such case, the applicant must claim colour as an element of the mark in his application.

## **Two or more colours or colour plus other element(s)**

Two or more colours combined and presented as a colour per se trade mark may be *prima facie* registrable, but this would depend on the circumstances.

We need to consider how the colours are presented, how they would be applied, and in view of the goods and services applied for, whether the relevant public would perceive the combination as a badge of origin.

In determining whether colours are capable of conveying specific information, in particular as to the origin of a product or service, it must be borne in mind that colours possess little inherent capacity for communicating specific information, including any origin specific message, especially since they are commonly used, because of their appeal, in order to advertise and market goods and services, without any specific message.

Moreover, colours that serve in the trade or business to designate the kind, quality, intended purpose, characteristic, etc of the goods or services claimed cannot be accepted. For example, a blue-and-white laundry tablet is likely, in the trade, to denote certain cleaning properties or ingredients, and objection should be raised under section 11(1)(b), (c) or (d).

### **Colour(s) applied to the packaging of goods**

A single colour applied to the packaging of the goods is unlikely to be recognised as a trade mark. A combination of colours or shades which is unusual in the relevant trade could be accepted but evidence will normally be required to establish factual distinctiveness. In such cases, the burden of proof is likely to be substantial because colour combinations on packaging are not normally regarded as indications of source.

## Colour marks for services

As with colour marks for goods, it is likely that considerable evidence of use will be required to show that the colour or colours are capable of distinguishing the service and are therefore within the meaning of section 3(1) of a trade mark.

## Marks consisting of the name of a colour

This refers to a word mark which consists solely of the name of a colour. *Prima facie* objection should be raised under section 11(1)(b) or (c), especially where colour is a dominant feature of the goods claimed, e.g. items of clothing, footwear and headgear. Evidence will normally be required to establish factual distinctiveness.

Objections under section 11(1)(b) or (c) may not readily apply to a mark consisting solely of the name of a colour for services as services are not normally associated with particular colours.

A word of warning, however. Over the years, some colours have acquired common, secondary meanings. GREEN OFFICE for office equipment would be objectionable on the basis of section 11(1)(c), for being descriptive of the environmental friendly nature or quality of the goods rather than being seen as the name of a colour. SUPER GOLD for banking services, similarly, would be objectionable primarily because of section 11(1)(c) and (d), as the word “GOLD” has come to signify premier status or standards of service in banking and financial services, and SUPER is simply non-distinctive.

Apart from colours which have acquired secondary meanings, where the name of a colour is used side-by-side with a distinctive word, that is, the mark does not consist exclusively of descriptive or generic matter, it does not conflict with section 11(1)(c) or (d), and may as a whole be registrable, e.g. BLACK KNIGHT for confectionery.

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