

Legal Issues in 'Retail IP'

Issue: Can exclusivity be claimed over an unregistered single colour mark for passing-off actions against third-parties?

Relevant Legal Provisions

❖ *Section 2(1)(m) of the Trade Marks Act, 1999*

2. Definitions and interpretation.— (1) In this Act, unless the context otherwise requires,—

(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) of the Trade Marks Act, 1999*

2. Definitions and interpretation.— (1) In this Act, unless the context otherwise requires,—

(zb) “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours;

Relevant Judicial Decisions

- ❖ *Colgate Palmolive Company and Ors. vs. Anchor Health and Beauty Care Pvt. Ltd. [Suit No. 691/2003]; Delhi High Court, Single Judge Bench, decided on October 29, 2003*

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

Relevant Judicial Decisions

- ❖ ***Beiersdorf AG Vs. Hindustan Unilever Limited [I.A. 7636/2021 in CS(COMM) 300/2021]; Delhi High Court, Single Judge Bench, decided on May 9, 2024***

"34. The distinctive blue colour ('Pantone 280C') was also given protection by the German Patent and Trademark Office since 2007. It is prima facie evident from the documentation filed, that the colour is not used by plaintiff for a decorative purpose but functions as a 'source identifier' and it has been used extensively by plaintiff for its product, in particular the cream tub. The adoption of the distinctive colour, about a century back and consistent use of the same by plaintiff would certainly lead to a prima facie conclusion that plaintiff's cream product, in this distinctive blue colour tub, will be associated with plaintiff.

37. Prima facie, the colour blue, in particular 'Pantone 280C', is certainly associated for years with plaintiff's product 'NIVEA', which has achieved distinctiveness for plaintiff's product and has become popular. Plaintiff claiming exclusivity in this colour is not the issue, however, the use by defendant in the impugned activity of a blue colour tub is too much of a coincidence to ignore. The allusion seems to be to the distinctive blue colour used by plaintiff." (emphasis supplied)

Relevant Judicial Decisions

- ❖ *Hindustan Unilever Limited Vs. Reckitt Benckiser India Limited [RFA (OS) 50/2008]; Delhi High Court, Division Bench, decided on January 31, 2014*

“14. After making a detailed frame by frame description of the offending advertisement, the learned Single Judge held that:

*...While it is true that there may be other orange coloured soaps and other soaps sold in the pre-dominantly green packaging and other soaps which have an oval shape, it is also true that it is only the plaintiffs soap which has a combination of all the three elements, i.e., orange colour, curved oval shape and predominantly green packaging. Apart from this, it is only the plaintiffs soap which has contours in the manner indicated in the bar of soap in the said advertisement. No evidence has been produced by the defendant to show that there is any ordinary antiseptic soap with the same combination of the aforesaid elements of colour, shape, design and packaging. **I have absolutely no doubt that the orange bar of soap shown in the advertisement refers to the plaintiffs Dettol Original soap.**”*
(emphasis supplied)

Relevant Judicial Decisions

- ❖ *Hindustan Unilever Limited Vs. Reckitt Benckiser India Limited [RFA (OS) 50/2008]; Delhi High Court, Division Bench, decided on January 31, 2014*

*“57. As this Court understands, the plaintiff's grievance is not that HUL simplistically depicted its Dettol Original in a bad light or denigrated it. That argument would have been natural if Reckitt alleged that the soap shown in the advertisement alone constituted denigration of its product. However, **the overall effect on the viewer-the shape of the soap, the green packaging, the number of times the soap was shown, the suggestion made that antiseptic soaps are bad for the skin, as they allow germ build up-is complained to constitute what is termed as a defamatory innuendo.** This court had, earlier in Dabur India, recognized that clever advertising can suggest something which is plainly not said, and create the desired impact in the mind of the viewer.” (emphasis supplied)*

Relevant Judicial Decisions

- ❖ *ITC Limited Vs. Britannia Industries Ltd. [O.S.A.(CAD). Nos. 134 to 138 of 2023]; Madras High Court, Division Bench, decided on November 8, 2023*

*"6.6. The next point for consideration is that since the plaintiff is not aggrieved by using the same set of devices, pictures and combinations in red colour wrap, whether the plaintiff's claim is to be rejected as claiming exclusivity of blue colour? The submission on the part of the defendant that the plaintiff is claiming exclusivity to blue colour is unacceptable to us as the said contention does violence to the context in which the claim is made. **It is the colour per se alone but the colour scheme and getup which gives rise to the proprietary right of the exclusive use.***

*6.7. When the other similarly coined and adopted devices of the defendant used in red wrapper, it would still pass the test of distinctiveness and identifiability by the customer by a casual look or in racks and shelves of supermarkets and shops etc. Only in that context, the claim of the plaintiff is in respect of injuncting the defendant from selling its product as depicted above in blue wrapper. **Use of blue colour as the back ground in wrapper is the last straw on the camel, and make the defendant's product offending the proprietary rights of the plaintiff to their trademarks and trade dress and their copyright. The same also leads to the inference of dishonest adoption on the part of the defendant in order to pass off its goods so as to unjustly enrich itself.**" (emphasis supplied)*

Relevant Judicial Decisions

- ❖ *Colgate Palmolive Company Limited & Anr. vs. Patel & Anr. [IA 3412/03, 4489/03 in CS(OS) No. 672/03]; Delhi High Court, Single Judge Bench, decided on October 6, 2005*

*"50. The above texts and the colour diagrammes also indicate that the **exclusivity and monopoly of a colour and a colour scheme is not favored**. Not only is the red colour one of the seven primary colours but it along with white and black colours has in fact been described as one of the three basic colours in nature. Furthermore, even though the colour combination of the registered mark indicates red and white, in essence the carton of the plaintiffs for which registration has been granted is entirely in red except the logo in the form of the word 'COLGATE' and other small ancillary words such as the price, quality etc. which are printed in white. It is this placement of small print in white containing the word 'COLGATE' in a small area placed on the back ground in red which contributes to the commercial impact of the plaintiff's carton in the market place and indeed gives exclusivity and distinctiveness to the plaintiff's mark. Thus, the mark COLGATE in white on a red background highlights the plaintiff's product and gives a distinct identity to the combination, and such a combine is certainly entitled to protection from not only passing off, but infringement too. However, I am also of the view that the red and white colour combination per se without the word/mark 'COLGATE' is not entitled to protection from infringement."* (emphasis supplied)

Relevant Judicial Decisions

- ❖ ***Cipla Limited Vs. M.K. Pharmaceuticals [IA No. 811/2004 in CS (OS) No. 112/2004]; Delhi High Court, Single Judge Bench, decided on July 23, 2007***

"5. The next issue arises whether defendant can copy the colour of the plaintiff's tablets and shape of the plaintiff's tablets. It is settled law that there can be no monopoly over colours. The plaintiff is in the field of manufacturing a wide range of medicines. Plaintiff may colour its tables in any colour starting from violet to red. Merely because plaintiff has started using a particular colour for its tablets plaintiff does not get monopoly over colour so that no one else can use that colour. The medicines are not bought by colours by the customers. There are thousand types of tablets available with Chemist for different ailments. No one goes to a chemist and asks for red, blue, orange, peach or white colour of tablets. All medicines are purchased at the advise of Doctors and they are sold on prescription. Even those tablets readily available without prescription, are known by their names. You will not find any manufacturer advertising his tablets by colour or shape. Even the common brands Crocin, Anacin, Disprin, Coldarin etc. are sold by name and not by shape or colour of the tablets. It is preposterous to believe that a person would go to the Chemist and ask the Chemist to give him tablets of such and such colour for such and such ailments. Neither colour of the tablet can be associated with any brand." (emphasis supplied)

Conclusion

- ❖ Courts have recognized that exclusivity can be claimed over a single colour mark if it has acquired distinctiveness and acts as a “*source identifier*”. If consumers associate the colour with a specific brand, it may qualify for protection. However, generic or functional colours—like red for lipstick or blue for ink—are generally not granted exclusivity, as they serve a necessary industry function rather than indicating origin.
- ❖ Even where a single colour mark is used, courts often look at the broader trade dress—such as packaging, shape, and overall getup—to determine whether exclusivity can be claimed. If a colour plays a crucial role in brand identity and distinguishes a product in the market, it may strengthen a passing-off claim.
- ❖ Courts are hesitant to grant monopoly over colours per se, especially in industries where colours serve functional purposes or lack consumer association with a specific brand. Protection is more likely when the colour has acquired secondary meaning through extensive use.

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THANK YOU!
Questions?

Adyanshi Kashyap
Associate

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