

Trade Dress – Colour, A Distinctive Feature of a Mark

Appeal before the Divisional Bench of the Sindh High Court

Appellant: Golden Thread Industries

Respondent: J & P Coats Limited and another

Decision: Appeal Dismissed

In our Hello (Issue 03/2011) we reported the decision of a Single Bench of the Sindh High Court in which it granted injunction to J & P Coats Limited and another (**the Respondents**) against Golden Thread Industries (**the Appellant**). It was held that the trade mark label device of the Appellant when compared with that of the Respondents' seems to have been copied, imitated and adopted similar to the Respondents' colour scheme, design, shade, lettering, get-up, positioning and packing appearance. Against the decision of the Single Bench the Appellant preferred an appeal before a Divisional Bench of the Sindh High Court, which confirmed the findings of the Single Bench.

In the appeal the Appellant argued that its registered trade marks "BUTTERFLY" and "S GOLDEN" are totally different, phonetically as well as visually from the Respondents' registered trade mark "ANCHOR" and that the colour scheme of the Respondents' mark is not registered therefore, no cause of action accrued to the Respondents and the Appellant cannot be prevented from using its own registered trade mark. The Bench observed that the contention of the Respondents is not that of infringement of the registered trade mark rather, it is a case of passing off as the packaging of the Appellant is almost identical to that of the Respondents.

In its judgment the Bench stated "*where colours have been formed into device or devices or where device or devices are used in a backdrop of any colour combination, mark as a whole may form a distinctive mark*". It also stated that due to identical size of the packs and colour scheme it will cause confusion and an unwary purchaser will not be able to distinguish between the products. Interestingly, in a passing remark, the Bench also stated that, "*there is no doubt that colour per se cannot be a trade mark*" which statement might perhaps not hold good as in the definition of a 'mark', Section 2(xxiv) of the Trade Marks Ordinance, 2001, colour is one of the types of the mark, which reads as:

(xxiv) "mark" includes, in particular, a device, brand, heading, label, ticket, name including personal name, signature, word, letter, numeral, figurative element, colour, sound or any combination thereof;

Nevertheless, in its conclusion the Bench stated that in a product's identification its colour scheme plays a vital role especially when the consumer is illiterate. Accordingly the appeal was dismissed.