

CHAPTER 2**COLOUR****INDEX**

- 2.1 Introduction
- 2.1.1 General
- 2.1.2 Monochrome representations
- 2.1.3 Coloured representations or specimens
- 2.1.4 Colour-coded representations
- 2.1.5 Contemporaneous applications
- 2.1.6 Anticipations
- 2.1.7 Conclusion
- 2.2 Case law reference
- 2.3 Colour does not preclude registration

INTRODUCTION

2.1 There is no reference to colour in the definition of design. However it seems that colour on its own cannot constitute a design (*Grafton v. Watson* (1884) 50 LT 420), but it may still form an element in a design. In *Smith, Kline and French Laboratories Ltd.'s Design Application* [1974] RPC 253, Graham J stated that:

"...colour cannot be ignored, though normally differences in colour are unlikely to be important. Colour may or may not make a material difference, depending upon the circumstances and nature of the design in question."

Graham J illustrated this by two extreme examples:

- (i) material having a strong underlying geometrical pattern, offered in a number of basic colour schemes, and
- (ii) coloured patterns like those used for the Ishihara colour blindness test.

In the first of these, colour would play no part, whereas for the second example the proper choice of colours for different parts of the pattern might be an essential feature of the design.

Graham J also asked the UK Office to supply a statement of practice on dealing with design applications where colour was involved. This statement is as follows:

2.1.1. *"General*

The office practice concerning the part played by colour in design registration is based on the understanding that on the reported authorities, whilst colour may form an element in a design, colour or colouring as such does not constitute design: ie., that, unless the change of colour creates a new pattern or ornament, registration will be refused.

2.1.2. *Monochrome Representations.*

In the large majority of cases the representations filed in support of a design application comprise monochrome drawings or photographs, any pattern or ornament on the article being represented by means of shading the various areas in tones of grey corresponding to the tonal density of the colours thus represented.

2.1.3. *Coloured Representation or Specimens*

In a relatively small number of cases applicants file coloured representations or specimens in support of an application, together with a statement of novelty worded to the effect that : The feature of the design for which novelty is claimed is the pattern

or ornament created by the tonal contrast of the colours applied to the article as shown in the representations". Whilst the Office is in some doubt as to the validity of such a claim, the application is accepted for registration, provided that the design possesses the necessary substantial novelty.

2.1.4. *Colour-coded Representations*

The official records show that in at least one instance the Office has accepted monochrome drawn representations in which the coloured areas on the article have been indicated and identified by means of stippling and hatching, a colour key identifying the actual colour of each of those areas being provided on the representation.

2.1.5. *Contemporaneous Applications*

Circumstances have arisen where an applicant has filed more than one application on the same day for a number of designs which differ one from the other only in the particular combination and disposition of the colours adopted for each design. Similarly, occasions have arisen where an applicant has filed two applications on the same day, each application being supported by monochrome representations, the only difference between the representations being that, whereas the representations for one application show, for example, a pattern formed by white stars on a black background, the representations for the other application show an otherwise identical pattern with the polarity reversed, i.e., black stars on a white background.

As however these contemporaneous applications cannot anticipate one another and cannot be said to be identical, if the designs which form the subject of the applications possess the necessary novelty they have been accepted for registration accordingly.

2.1.6. *Anticipations.*

When making a search among prior registered designs and/or trade publications, etc., in order to test the novelty of a design, circumstances may arise where the design which is the subject of the search differs from a prior published or registered design only in the matter of tonal variation (in the case of monochrome representations) or colour variation (in the case of coloured representations or specimens) of certain elements forming the pattern or ornament.

If the novelty claim relating to the design being searched is for the shape or configuration of the article, that shape or configuration would therefore be anticipated and an objection for registration would be raised against the application accordingly.

Again, if the novelty claim relating to the design being searched is for the pattern or ornament of the article or for the shape or configuration and pattern or ornament of the article and in the opinion of the Office no new pattern or ornament has been

created, i.e., the differences in the pattern or ornament resulting from the alteration of the colours forming that pattern or ornament are not substantial, an objection to registration would be raised against the application accordingly.

2.1.7. *Conclusion*

It is difficult, if not impossible, to lay down hard and fast rules as to the degree of difference which alteration of colour or colours within a pattern or ornament may impart to a design and each application must be judged on its merits. For example, the degree of difference may to some extent depend upon the comparative simplicity or complexity of the designs being considered. However, it may be said that, generally speaking, alteration of colour or colours in a design which is in other respects not substantially different from a prior design would be regarded by the Office as being in the nature of a variant commonly known in the trade and would not in itself impart the substantial novelty necessary to substantiate a valid registration."

CASE LAW REFERENCE

- 2.2 Graham J did not disagree with anything in this statement. This is also the practice of the Australian Designs Office on colour (*Re Application by Bourjois Ltd.* 11 IPR 625). This practice was the basis for the decision in *Re Application by Nigel Louez Graphic Design Pty. Ltd.* 15 IPR 570.

COLOUR DOES NOT PRECLUDE REGISTRATION

- 2.3 Basically, the underlying principle is that the inclusion of colour does not preclude registration. The only time colour becomes an issue is when questions of newness and originality arise.