

## Canada: Federal Court Of Appeal Confirms Registrability Of Colour Trademarks

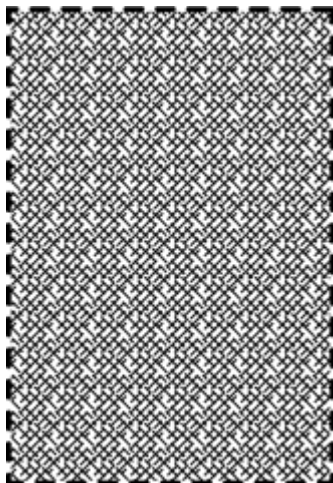
By Timothy Stevenson, Smart & Biggar, Canada

*First published on Mondaq*

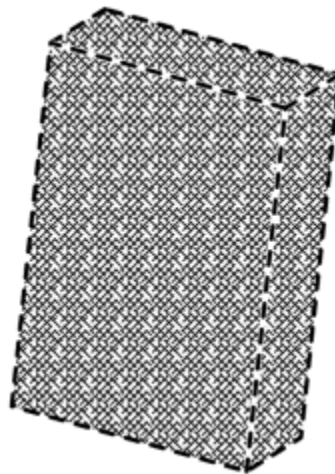
A May 1, 2015 decision of the Canadian Federal Court of Appeal, *Rothmans Benson & Hedges Inc v Imperial Tobacco Products Limited*, [2015 FCA 111](#), has affirmed the principle that, in Canada, a single colour applied to the surface of an object, including product packaging, is capable of being registered as a trademark. Imperial Tobacco was represented in this case by [Steven Garland](#) and [Timothy Stevenson](#) of Smart & Biggar's Ottawa office.

This decision relates to two trademark applications filed by Imperial Tobacco Products Limited ("Imperial Tobacco") for the colour orange applied to cigarette packages in 2-dimensional and 3-dimensional forms. The designs applied for, which were lined for colour in accordance with the *Trademarks Regulations*, are depicted below:

**Application No. 1,317,127**



**Application No. 1,317,128**



Both applications were opposed by Rothmans Benson & Hedges ("RBH"). The grounds of opposition asserted by RBH were that the designs were not accurate depictions of the marks in accordance with the requirements of the *Trademarks Act* in view of, for example, the presence of health warnings, and that the designs were not actually used by Imperial Tobacco as trademarks in view of the presence of other material or trademarks on the package. The Trademarks Opposition Board and Federal Court

rejected both of these grounds of opposition, and RBH appealed the matter to the Federal Court of Appeal.

The Court of Appeal dismissed RBH's appeal, and in particular affirmed the findings of the Opposition Board and Federal Court on the following issues:

- **The designs were properly depicted in the applications.** Even though health warnings and other matter appeared on the packages in the marketplace, the applications nevertheless accurately depicted the trademarks claimed, namely, the colour orange as applied to the visible surface of the packaging.
- **The designs had been used as trademarks.** In particular, Imperial Tobacco submitted sufficient evidence that it had specifically adopted the colour orange to act as a trademark by itself and had used it as such, despite the presence of other matter or marks on the packaging.

In view of amendments to the *Trademarks Act* recently passed into law but not yet in force, applicants in Canada will in the future be able to register colour *per se* without the need to delineate the contours of the object to which the colour is applied, at least in cases where the applicant can establish distinctiveness as of the application filing date. However, these amendments are not scheduled to come into force until late 2016 at the earliest, and the regulatory framework under the amended *Trademarks Act* has not yet been published.

In the interim, this decision of the Federal Court of Appeal reflects the current state of the law regarding colour trademarks in Canada and reinforces the principle that colour can be registered as a trademark so long as the application appropriately depicts the manner in which the colour will be applied to the surface of an object. Indeed, for those trademark owners which use (or intend to use) distinctive colours as part of their brand, it may be advantageous to apply for colour trademarks *before* the amendments to the *Trademarks Act* come into force, because under the current law an applicant is not required to demonstrate acquired distinctiveness as of the filing date of the application, provided that the shape of the object on which the colour will be applied is depicted in the application.

*The preceding is intended as a timely update on Canadian intellectual property and technology law. The content is informational only and does not constitute legal or professional advice. To obtain such advice, please communicate with our offices directly.*

**For more information, please contact:**



Timothy Stevenson  
Smart & Biggar, Canada  
[tostevenson@smart-bigggar.ca](mailto:tostevenson@smart-bigggar.ca)  
[www.smart-bigggar.ca](http://www.smart-bigggar.ca)

For further information regarding this decision and the protection of colour trademarks in Canada, please contact the author or another member of [our firm's Trademarks group](#).