

**LEGAL ALERT**

**COURT OF LAST INSTANCE RULES COLOR MAY CONFER  
DISTINCTIVENESS TO A GENERIC MARK**

January 6, 2021



In a decision contrary to the findings of the IP Office and of the First and Second Instance Courts, the Macau Last Instance Court determined that an otherwise non-distinctive sign could be registered as a Trade Mark if a color was added to it that rendered the final result distinctive enough.

This decision is relevant not only for the jurisprudence created with respect to the registrability of non-distinctive signs when color is added, but also for being one of the very few judgments reversing three prior concurrent decisions on the same matter.

Trade Mark applications for a green colored rectangular shape filed by the applicant in international classes 9, 16, 35, 36, 37, 38, 41 and 42 were refused by the Macau IP Office for lacking the required distinctiveness under a legal provision that deems unregistrable any sign comprised exclusively of elements that have become common in fair and customary trade practices.

Successive appeals saw the First and Second Instance Courts upholding the IP Office's findings, deciding that the applicant could not be granted an exclusive right to a simple rectangle, even if a specific color was claimed.

Under the appeal rules in place until the 3<sup>rd</sup> April 2019, the complete overlapping of the decisions issued by the First and Second Instance Courts would have determined the end of the appeals stage and the Second Instance Court's decision would have become final. However, new procedural rules have been enacted that allowed this to be one of the first Intellectual Property cases to benefit from the possibility of resorting to the highest Court under such circumstances.

The Last Instance Court agreed with the lower Courts that the sign in question would, under Macau regulations, lack registrability, but considered that the addition and claim of a color (in case, a specific Pantone) rendered the sign distinctive and registrable.

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