

A Selective Review of Colour Mark Issues and Case Law in the EU

Summary

Despite the CJEU's statement in *Libertel* (C-104/01) that colours 'advertise and market goods, without any specific message', commercial operators continue to seek registration of colours as trade marks. This paper looks at when it is possible for a colour per se to be protected, difficulties of spatial delimitation or colour combinations, problems of consumer perception and obstacles in showing acquired distinctiveness through use in the EU. Additional consideration is given to some examples of inter partes conflicts involving colour marks in the EU (OHIM, UK, Austria, Poland and Germany).

I-Introduction

Colour is used in a variety of situations in the trade mark world. Companies sometimes attempt to register a colour per se as a trademark (with or without spatial delimitation), or a combination of colours and, more frequently, use them as complex marks with coloured word and figurative elements. Each one of these possibilities gives rise to different legal considerations.

II-Protecting a colour per se

Obtaining registration for a colour per se or a combination of colours is not an easy task. A sign composed of a combination of colours is specifically recognized under TRIPS¹ as being able to act as a trademark. However, nothing is stated as regards single colours, although it should be noted that the examples of signs given in TRIPS are precisely that – examples - and do not prevent a single colour from being protected. These matters are mirrored in the Harmonization Directive on trade marks and the CTMR, both of which do not mention colour, but for which it is accepted that their lists are not exhaustive and are given by way of example². It would also appear that some national legislations in the EU, as well as the CTMIR³ have specifically inserted colours into the list of examples of signs protectable as trademarks⁴.

¹ Article 15(1) TRIPS refers to 'Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks'.

² See, the eighth recital in the preamble to the trade marks Directive 2008/95/EC.

³ Rule 3(5) CTMIR states: 'Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a reference to a recognized colour code may be added.'

⁴ See Jekaterina Kudrjavceva, *Issues surrounding registration of colour trade marks*, RGSL Research Papers, 1212, p. 9, (available at http://www.rgsl.edu.lv/uploads/files/RP_9_Kudrjavceva_final.pdf), where the author mentions Germany and Latvia by way of example.

It is now some ten years since the CJEU handed down its judgments in *Libertel*⁵ and *Heidelberger*⁶. While not preventing registration of colour marks these judgments pose potentially serious problems to registration. What is more, they leave open unresolved issues that will need further judicial clarification.

In *Libertel*, the Benelux Trade Mark Office refused to register the colour orange for the goods and services for which protection was sought (mainly in the field of telecommunications), unless acquired distinctiveness through use was shown. The applicant had applied for registration of an orange rectangle and, in the space for describing the trade mark, had inserted the word 'Orange' without reference to any colour code. On appeal, the case went all the way up to the Dutch Supreme Court, which, in turn, made a preliminary reference to the Court of Justice in Luxembourg.

The main question referred was essentially whether, and what circumstances, a colour *per se*, not spatially defined, could possess distinctive character for certain goods or services. However, as a preliminary matter, the Court considered itself bound to consider whether a colour *per se* could act as a trade mark within the meaning of Article 2 of the Harmonization Directive⁷. In so doing, the Court stated:

'...a colour *per se* cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used. None the less, a colour *per se* is capable, in relation to a product or service, of constituting a sign.'⁸

In other words, a colour can act as a sign but whether it does or not will depend on the specific circumstances of the case.

Next, applying the criteria in '*Sieckmann*'⁹, the Court emphasised that the sign must satisfy the requirements of graphic representation and be clear, precise, self-contained, easily accessible, intelligible, durable and objective¹⁰. While a mere colour sample would fail to satisfy the criterion of durability (because if paper were used it would fade), an internationally recognised colour identification code would be satisfactory¹¹. So too might a description in words of the colour (depending on the form of words used).

Interestingly, although the Court did recognize that other media exist, apart from paper¹², this matter was not fully explored. It could equally have been pointed out that representing precise shades of colour in electronic format is also sometimes problematic, especially where more nuanced colours are involved.

⁵ *Libertel Groep BV v Benelux-Merkenbureau* (C-104/01) [2003] ECR I-3793

⁶ *Heidelberger Bauchemie* [2004] ECR I-6129.

⁷ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ('Harmonization Directive').

⁸ Para. 7 of the judgment.

⁹ *Sieckmann v Deutsches Patent-und Markenamt* (C-273/00)[2002] ECR I-11737.

¹⁰ Para. 29 of the judgment.

¹¹ Para. 37 of the judgment.

¹² Para. 32 of the judgment.

Regarding the question whether a colour *per se* is capable of indicating the commercial origin of goods, the Court was of the opinion that ‘whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message’¹³.

On the other hand, the Court recognized that while ‘a colour *per se* is not normally inherently capable of distinguishing the goods of a particular undertaking’¹⁴, it ‘may be capable of distinguishing the goods and services of one undertaking from those of other undertakings’¹⁵. It will do so where, in the particular circumstances of the case, it ‘serves as a badge of origin’¹⁶.

Another issue raised by the referring court was whether, in assessing the potential distinctiveness of a specific colour as a trade mark, consideration should be given to the general interest in that colour remaining available to all. In this regard, the CJEU noted, in respect of colours *per se* that are not spatially delimited that:

‘The number of colours which th[e average member of the general] public is capable of distinguishing is limited, because it is rarely in a position directly to compare products in various shades of colour. It follows that the number of different colours that are in fact available as potential trade marks to distinguish goods or services must be regarded as limited’¹⁷.

In view of that limited availability, ‘a small number of trade mark registrations for certain services or goods could exhaust the entire range of the colours available’ and thereby create ‘an unjustified competitive advantage for a single trader’¹⁸.

The Court went on to note that examination of applications for colour *per se* marks should always be ‘stringent and full’, otherwise the effect would be to shift the work burden from registration authorities to the courts¹⁹.

As to whether a colour *per se* mark is distinctive for the goods or services it seeks to protect in the sense of Article 3(1)(b) of the Harmonization Directive, the Court pointed out that consumer perception is ‘not necessarily the same in the case of a sign consisting of a colour *per se* as it is in the case of a word or figurative mark’²⁰ and that ‘consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element’²¹. Accordingly, ‘distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very

¹³ Para. 40 of the judgment.

¹⁴ Para. 65 of the judgment.

¹⁵ Para. 41 of the judgment.

¹⁶ Para. 41 of the judgment.

¹⁷ Para. 47 of the judgment.

¹⁸ Para. 54 of the judgment.

¹⁹ Para. 59 of the judgment.

²⁰ Para. 65 of the judgment.

²¹ Para. 65 of the judgment.

specific'²². Nevertheless, the possibility of showing acquired distinctiveness through use exists.

In essence, the CJEU recognized that a colour may be registered where:

1. It is a sign,
2. It can be represented graphically,
3. It can distinguish the goods and services of one undertaking from those of other undertakings,
4. It does in fact distinguish the goods and services of one undertaking from those of others either inherently or through use.

The main problem with this judgment is that it ultimately leaves everything up to the particular facts of each and every case. A non-spatially defined colour per se can be a sign, where it acts as a badge of origin and can be graphically represented, where an international colour code is used to describe the colour. However, it will not normally have sufficient distinctive character to be registered unless it has acquired it through use. Even where no use is shown, the Court does not totally 'close the door' to registration since it refers to 'exceptional circumstances' which may justify such a registration, such as an application to register a small range of goods and services and a very specific market.

Further problems arise in that internationally recognized colour codes, such as Pantone, seem to have been acknowledged as a good way of identifying the graphic representation of a particular colour. However, if the colour is highly nuanced, it will not be perceived with the necessary degree of precision by the relevant public –even if reproduced on paper and combined with a code - and will not be committed to memory, since the range of colours that may be perceived by the human brain is relatively limited. Moreover, it may be difficult to reproduce the colour exactly in paper or electronic format. In short, it may well not achieve registration.

Before looking at how these types of colour mark have been treated in practice and how they may obtain acquired distinctiveness, it seems appropriate to consider the case of trade marks for combinations of colours.

III-Colour combinations

The *Heidelberger* judgment involved a preliminary reference from the German Federal Court, arising from the German Patent Office's refusal to register the colours blue and yellow as a trade mark for various goods used in the construction sector (solvents, varnishes, etc). In that Office's view, the sign applied for was not capable of constituting a trade mark and was not capable of being represented graphically.

In this case, the reproduction of the mark in the application form was a rectangular piece of paper, the upper part of which was blue and the lower half yellow, described as 'consist[ing] of the applicant's corporate colours which are used in every conceivable form, in particular on packaging and labels'. Further reference was also made to the specific shade of blue and yellow used in the RAL codes.

²² Para. 66 of the judgment.

The question referred to the Court was whether, and if so under what conditions, colours or combinations of colours designated in the abstract and without contours are capable of constituting a trade mark for the purposes of Article 2 of the Directive²³.

The CJEU recognized that the purpose of assessing whether the mark applied for in fact constitutes a sign is ‘to prevent the abuse of trade mark law in order to prevent an unfair competitive advantage’²⁴ and must ensure that a sign is ‘always [to] be perceived unambiguously and uniformly, so that the function of mark as an indication of origin is guaranteed’²⁵. However, in the Court’s view ‘the mere juxtaposition of two or more colours, without shape or contours, or reference to two or more colours “in every conceivable form” ... does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive...’²⁶.

On the other hand, the Court acknowledged that depending on ‘the context in which they are used, ... colours or combinations of colours [may] in fact represent a sign’²⁷. Moreover, ‘a graphic representation consisting of two or more colours, designated in the abstract and without contours’ could suffice where it is ‘systematically arranged by associating the colours concerned in a predetermined and uniform way’²⁸ and ‘a sample of the colour concerned [is] accompanied by a designation using an internationally recognised identification code’²⁹. In essence, signs must be clearly defined with certainty, which is not open to different interpretations and exhibit the necessary qualities of durability.

The Court went on to point out that the mark would need to satisfy the requirements of minimum distinctive character in order to get onto the register. Whether it did so would again depend on ‘the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought’³⁰ and should take account of the public interest in not unduly restricting the availability of colours for other traders who market competing goods or services.

The judgment in *Heidelberger* confirms the reasoning of the *Libertel* case. Colour trade marks can be registered, but they must be sufficiently defined by the use of recognised colour codes, and the way in which the colours are to be used and how they are used must also be clearly defined with certainty. Reference to colours ‘in every conceivable form’ will not satisfy these requirements, as it would allow numerous different combinations. The colours must also be durable. *Heidelberger* also supports the view taken in *Libertel* case that in most cases colour marks are not inherently distinctive and can only achieve distinctiveness through use.

Advocate General Léger’s opinion in *Heidelberger* argued for a requirement that the colour be spatially delimited in order to satisfy Article 2 of the Harmonization

²³ Para. 15 of the judgment.

²⁴ Para. 24 of the judgment.

²⁵ Para. 31 of the judgment.

²⁶ Para. 34 of the judgment.

²⁷ Para. 42 of the judgment.

²⁸ Para. 40 of the judgment.

²⁹ Para. 36 of the judgment.

³⁰ Para. 42 of the judgment.


Directive. However, that recommendation was not followed by the Court and it has since been argued by legal writers that the CJEU has not given enough coverage to the spatial delimitation point³¹. How can a person viewing a colour *per se* which is not spatially delimited understand the precise form of the sign for which protection is sought?


IV-Applying the case law in practice

A colour *per se* which is not spatially delimited and for which no evidence of acquired distinctiveness has been put forward, has little chance of maturing into a registration. The Court suggested that such marks would only overcome the hurdle of being distinctive in exceptional circumstances, which might include situations where a narrow range of goods and services was at issue and there was a very specific market.

There appears to be little judicial willingness to view circumstances as ‘exceptional’, and more particularly, to recognize a market as ‘very specific’. Even articulated robots that are clearly not everyday items were considered by the Court as not belonging to a ‘specific market’³².

There are quite a number of cases upholding the rejection of colour *per se* marks at the OHIM Boards of Appeal.

In an application for registration³³ of the colour orange  for goods in Classes 7 and 17 relating to collets (a holding device used for clamping) or goods related to collets, the Board found that these goods were used in a broad range of industrial markets (as appeared from the applicant's website) and that the use of colours in relation to collets was, in any event, rather common. Moreover, the Board noted that no evidence had been submitted that the colours of collets or their packaging were generally perceived as indicating their commercial origin. Concerns were also expressed about not giving competitors an unjustified monopoly, given the limited range of colours available.

Even where a colour is delimited, this may not help where that delimitation equates the sign to a banal shape. In rejecting³⁴ an application to register ‘a trade mark in a colour *per se*’ , described as ‘a square with convex sides in chocolate brown’, ‘Pantone No 4625 C’, the Board considered the mark to consist of a conventional representation of a square. This being so, the mark was judged to be devoid of any element which could indicate to the consumer the commercial origin of the goods and services designated by it (perfumery, leather goods, household linen and also hotel and restaurant services as well as hygiene and beauty care services). Moreover, the Board emphasized that consumers in those sectors are unaccustomed to perceiving basic geometric shapes as indicators of the origin of a product or service.

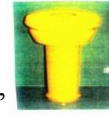
³¹ Paul Bickenell, *Société des Produits Nestlé SA v Cadbury UK Ltd: Colours Par Se and Spatial Delimitation* [2013] E.I.P.R., Issue 2, p.110.

³² Case T-97/08, *KUKA Roboter GmbH v Office for Harmonisation of Internal Market (Trade Marks and Designs)* (OHIM), [2010] 2010/C 301/41, para. 46.

³³ See decision of 24 November 2010 in Case R1200/2009-2

³⁴ See decision 11 June 2009 in Case R0202/2009-1

On the other hand, spatial delimitation, combined with a ‘very specific’ market, will offer the best chance of successfully being able to register a single colour before OHIM, without having to show acquired distinctiveness.



Yellow claimed in respect of ‘rubber teats for milking installations’ was held by the Board³⁵ to be sufficiently inherently distinctive to maintain a CTM registration. The Board considered the number of goods or services for which the mark offered protection to be very restricted and the relevant market very specific. Moreover, it was found that the yellow colour differs markedly from the colour black, which appeared to be the standard colour for objects made of rubber. The cancellation applicant’s attempts to convince the Board that yellow was not unusual were unsuccessful. The evidence provided (a few images) did not show the colour yellow in relation to the goods at issue and it was not clear on which market these goods were used, or when this use was started.

Making an exception for a niche product is essentially what the Court was referring to in *Libertel*, when it considered registration of an inherently distinctive colour. On the other hand, one might question whether a distortion of competition is so much more acceptable in that situation. If the range of colours that are available or clearly perceptible is relatively limited, then the number of competitors in a niche sector needs to be really negligible. Otherwise, the range of colours available to them will still be quickly exhausted.

Consumer perception is often at the root of these cases. If the consumer’s attention is somehow captured from the outset, the mark has more chance of getting registered.

An application for a trademark (colour red Pantone No 18.1663TP) applied to the sole



of a high-heeled shoes was considered by the Board³⁶ to depart significantly from the norm or customs of the sector and have the requisite level of distinctiveness. The Board noted that the registration was not sought in respect of shoes in general but was restricted to high-heeled shoes. Consumers would perceive the sign as imaginative, surprising and unexpected and would thus easily remember it. The Board recalled that, although the existence of such characteristics is not a necessary condition for establishing that a trade mark has distinctive character, the fact remains that, as a rule, the presence of those characteristics is likely to imbue that mark with distinctive character.

On the other hand, consumer perception often leads to a negative result for the applicant. In legal theory, the various types of trademark that exist – be they traditional or non-traditional – are to be treated equally. It is not appropriate to impose stricter examination for one class of trade mark as compared with another³⁷. If consumer perception of these signs is as mechanisms to ‘advertise and market goods, without any


³⁵ See decision of 11 February 2010, in Case R0371/2009-2.

³⁶ See decision of 16 June 2011, in Case R2272/2010-2.

³⁷ See, for example, *Mag Instrument v OHIM* (C-136/02 P), para. 30 ; *Audi v OHIM* (C-398/08 P), para. 38.

specific message'³⁸, the application is doomed to failure and the equal treatment of trademarks theory ends up like the characters in George Orwell's *Animal Farm*, where some are 'more equal than others'.

Both the CJEU and the GCEU see colour marks as non traditional marks and thus equate them, to some extent, to three-dimensional and shape marks. Last year in *Seven Towns Ltd v Office for Harmonization in the Internal Market (OHIM)*³⁹, the GCEU had occasion to review its position in regard to marks applied for combinations of colours.

An application was made to register a colour per se as a CTM for Class 28 goods (toys, 3-D puzzles, etc). The application form contained the following image: , together with the indication red (PMS 200C), green (PMS 347C), blue (PMS 293C), orange (PMS 021C), yellow (PMS 012C), white (white), black (black). The mark was described as 'six surfaces being geometrically arranged in three pairs of parallel surfaces, with each pair being arranged perpendicularly to the other two pairs characterised by: (i) any two adjacent surfaces having different colours and (ii) each such surface having a grid structure formed by black borders dividing the surface into nine equal segments'.

The examiner refused the application under Article 4 CTMR⁴⁰, as it was not a spatially delimited application for a colour mark, and also did not correspond to the description submitted by the applicant. The Board of Appeal annulled the decision for infringement of essential procedural requirements, but then, itself, also rejected the application under Article 4 CTMR.

On appeal, the GCEU confirmed the Board's view that the representation and description were not clear, concise, easily accessible and intelligible⁴¹. The Court was of the opinion that the description of the mark was too difficult for the relevant public (average consumers and traders) to understand and confirmed the Board's view that it would be 'necessary to expend a "huge amount of intellectual energy and imagination" in order to understand with the necessary degree of certainty what sign the applicant wishe[d] to protect'⁴² and that the definition, in fact, attempted to define a three-dimensional mark, or figurative mark, corresponding to the external appearance of a particular object with a specific form (a cube covered in squares with a particular arrangement of colours – namely, the world famous Rubrik's cube). In other words, even if the description had been clear and easily intelligible (which it was not), it would in any event have contained an inherent contradiction so far as concerns the true nature of the sign⁴³.

An additional consideration that arises from *Seven Towns Ltd v Office for Harmonization in the Internal Market (OHIM)* is that the applicant was essentially looking at ways of obtaining IP protection for an expired patent. However, both the OHIM and the Court are notoriously reticent to give trade mark protection to anything

³⁸ *Libertel*, supra, para. 40.

³⁹ Case T-293/10 of 14 June 2012.

⁴⁰ He parallel provision of Article 2 of the Harmonization Directive.

⁴¹ Para. 62 of the judgment.

⁴² Para. 64 of the judgment.


⁴³ Paras. 64, 66 of the judgment.

that has been the subject matter of a patent⁴⁴. In addition, the appearance of this type of mark also brings into question the desirability of a possible overlap (from a public policy perspective) between designs and trademarks, given that a colour may be protected as a design⁴⁵

Clearly, consumer perception will be conditioned to a large extent by common experience. Thus, in *Andreas Stihl*⁴⁶, the GCEU considered that the colour grey, applied to various machines and mechanical apparatus, would simply be ‘perceived as the result of a manufacturing process or as simply a coloured casing’.

It also took a similar approach in its judgment in the *Viking*⁴⁷, where the juxtaposition of the colours green and grey *per se* to be applied on gardening equipment was examined for distinctive character, it was found that colour grey would be perceived as the natural colour of the material, or as a finish⁴⁸. In these circumstances, the Court concluded that the combination would not be seen by the consumer as a sign indicating a particular undertaking.

The OHIM Boards of Appeal have decided a number of cases in the same vein as the Court’s judgments cited above. By way of example⁴⁹, in an application for the colour

mark  (described as ‘The colour light grey is positioned above the colour traffic red (RAL 3020), which is in turn positioned above the colour light grey (RAL 7035); the ratio of the colours, from top to bottom, is light grey; traffic red; light grey = 7 : 1 : 2.’), for ‘transport of passengers and goods by rail’, the GCEU confirmed the Board’s view that the sign would not be perceived as unusual for the services and would be recognised as a decorative, promotional element or as a functional element. ‘Light grey’ is customarily used on the technical railway equipment and ‘traffic red’ is frequently encountered as a warning colour in traffic signs to catch the consumer’s attention. Therefore, individually the two colours lack distinctive character and the grey colour, being very light grey, would only be noticed with difficulty and could also be perceived as ‘dirty white’, thereby making it very close to the combination ‘white/red’ used on the railway crossing gates and traffic signs associated with train traffic.

Some colours must simply always be left free and will never be able to indicate commercial origin because their primary message is to send other messages (danger, environmental friendliness, etc). Others may be able to show that they have acquired a secondary meaning.

⁴⁴ See, for example, the *Lego* judgment.

⁴⁵ This is also particularly apparent in the case of attempts to register tartan patterns – e.g. Cases T-329, T-328/09, T-327/09 and T-326/09.

⁴⁶ Case T-234/01, *Andreas Stihl AG & Co. KG v Office for Harmonisation of Internal Market (Trade Marks and Designs)* (OHIM), para. 34.

⁴⁷ Case T-316/00, *Viking -Umwelttechnik GmbH v Office for Harmonisation of Internal Market (Trade Marks and Designs)* (OHIM).

⁴⁸ Para. 30 of the judgment.

⁴⁹ Judgment of 12 November 2010 in Case T-0404/09 *Farbmarke (Grau-Rot)*. A parallel judgment was also rendered by the GCEU in case T-0405/09 involving the same colour scheme but arranged vertically.

V-Acquired distinctiveness through use

Given that all trade marks are to be treated equally for the purposes of absolute grounds examination, it should follow that proving acquired distinctiveness for colour marks is no more difficult than for other types of mark. However, it has to be borne in mind that even showing that a colour satisfies the requirements of Article 2 of the Harmonization Directive or Article 4 CTMR –that it is a sign – is an uphill task. Therefore, the starting point for showing that the mark has acquired distinctiveness is that much further back than for other, traditional forms of mark. If the mark is barely convincing as a sign then a considerable amount of effort needs to be expended in order to turn it into a source identifying instrument that will enable consumers to identify and distinguish the goods it marks from those of competitors without any risk of confusion and enable them to repeat their purchase experience with the same guarantees.

On the other hand, the legal framework for showing acquired distinctiveness is more or less invariable. The same rules apply to all types of mark.

At OHIM, the distinctive character has to have been shown to have been acquired prior to the date of filing the CTM application. However, the situation may be different in certain Member States, since the Harmonization Directive allows national registration authorities to register a mark where distinctiveness is proven to have been acquired at a later date.

According to the *Windsurfing Chiemsee* judgment⁵⁰, distinctiveness is shown to have been acquired where ‘the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark’⁵¹.

The ‘relevant class of persons’ refers to the relevant public for the goods or services that the trade mark applied for seeks to protect. Where average consumers are concerned (as opposed to say professionals), they are presumed to be reasonably informed and observant. However, what is not clear is what precisely constitutes a ‘significant proportion’ of that relevant public. In any event, the Court did not consider that what is a ‘significant proportion’ is to be seen in terms of fixed percentages but emphasized that ‘the competent authority must make an overall assessment of the evidence’⁵² and have regard to the duration and intensity of the use⁵³.

More specifically, the Court states that acquired distinctiveness through use may be shown by reference to:

- the market share held by the mark;
- how intensive, geographically widespread and long-standing use of the mark has been;

⁵⁰ Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v. Boots- und Segelzubehör Walter Huber and Franz Attenberger*, [1999] ECR I-2779.

⁵¹ Para. 47 of the judgment.

⁵² Para. 49

⁵³ Para. 50

- the amount invested by the undertaking in promoting the mark;
- the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and
- statements from chambers of commerce and industry or other trade and professional associations

Where the competent authority has difficulty in assessing the existence of acquired distinctiveness, it may also have 'recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment'⁵⁴.

In reality, opinion polls and surveys are often commissioned in these circumstances by CTM applicants and used before OHIM. These must be carefully worded, since leading or 'loaded' questions that seek to elicit a particular answer from an interviewee will undermine the worth of the evidence. They are expensive items of evidence but when used correctly, can be highly effective.


Evidence should also be as independent as possible. A mere affidavit, without more, from the finance director of the applicant company, stating that millions of euros have been spent on advertising is not likely to hold much sway. Similarly, solely relying on a statement from a regional chamber of commerce –in which the applicant company's director is also involved in the administration – will not suffice. A combination of various different forms of evidence is probably going to be the most effective tool.

In any event, a CTM that lacks distinctive character must, to obtain registration, show that it has acquired it through use in the geographical area for which the objection has been raised. In the case of a word mark, the objection will often be confined to a specific linguistic zone (for example, Member States in the EU that have English as an official or co-official language). For other marks (including colour marks), the situation is much more difficult. The lack of distinctiveness objection will be taken to be pan-EU. That means that evidence of acquired distinctiveness through use must be shown throughout the EU. If one Member State is missing, the use is inadequate.

Although more recently, the GCEU has intimated⁵⁵ that it may be appropriate to relax that hurdle somewhat, it has not yet done so and nor has it examined in more detail how that might be achieved.

Yet, despite such a high barrier, some companies can and do achieve registration of their colour marks at OHIM. In all cases, these are global players with large financial resources to fall back on. Another common trait is that use of the colour marks in question usually goes back decades and, in some cases, for even longer time periods.

In *BCS v John Deere*⁵⁶, an Italian competitor applied for the invalidity of John Deere's

colour CTM , which had been registered for agricultural machinery, on the basis

⁵⁴ Para. 53 of the judgment.

⁵⁵ See judgment of 24 May 2012 in Case C-98/11P *Chocoladefabriken Lindt & Sprüngli AG v OHIM*, para. 63.

of acquired distinctiveness. In the CTM application the mark was described as being



used in the following way: . It was claimed that the contested trade mark had no distinctive character and that there was insufficient evidence that it had acquired distinctive character by use in *all* Member States of the EU.

The Court confirmed the view of the OHIM Cancellation Division and Board of Appeal that the invalidity request should be rejected. Evidence was provided *inter alia* from pictures from trade fairs, catalogues, and books showing the long established use of these colours on John Deere's tractors. There were also statements from trade associations that the colour combination was perceived as an indication of source, and that John Deere had used the same colours consistently for a long time.

Accepting that the evidence submitted indicated trade mark use of the colours (despite sometimes being used in combination with word marks), the Court confirmed that acquired distinctiveness had to be shown in the entire territory of the EU⁵⁷. However, it went on to confirm that the evidence did not have to be the same and thus survey evidence did not have to be submitted for each and every Member State. Instead, acquired distinctiveness may be gleaned from secondary evidence such as market share, revenue and advertising expenditure⁵⁸ (para. 41). John Deere had submitted this type of information for all Member States. In the event, the Court found that given relatively expensive, long lasting investment in goods such as John Deere tractors, a comparatively lower market share could be sufficient to establish acquired distinctiveness where the trade mark has been used for a long time and consistently (in this case use in some Member States had been on-going for well over 30 years⁵⁹).

However, the CTM applicant was not so fortunate in *CNH Global NV v OHIM*⁶⁰. This case involved a combination of colours red, black and grey (applied to the exterior of a



tractor): . The Court, relying on the unitary character of the CTM, noted that distinctive character had to have been shown to have been acquired throughout the EU. Accordingly, the applicant's failure to show acquired distinctiveness in the ten new Member States proved fatal to its application.

In an EU-27 situation⁶¹ it is undoubtedly hard to show an equally intense pan-European level of activity. Many companies in the EU tend to be more active in their home market, or markets where the consumers speak the same language as the home market consumers, and find it difficult to display a sufficiently intense use elsewhere:

⁵⁶ Case T-137/08 BCS SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), ECR II – 04047.

⁵⁷ Para. 39 of the judgment.

⁵⁸ Para. 41 of the judgment.

⁵⁹ Para. 43-44 of the judgment.

⁶⁰ Judgment of 29 September 2010 in Case T-378/07 CNH Global NV v OHIM,

⁶¹ The EU will as of June 2013 increase to 28 members with the incorporation of Croatia.

The Board of Appeal, in a case involving the colour yellow for excavators⁶², noted that although the applicant had a very high market share and turnover in the United Kingdom and Ireland, it was significantly lower in other Member States and the evidence submitted was insufficient to show acquired distinctiveness.

On the other hand, survey evidence can convince the registration authority that the colour mark should be registered. This happened in the *Whiskas* case⁶³, which was decided by the Board of Appeal.

The applicant sought registration of the colour purple Pantone code 248C for pet



The survey evidence showed that 58% of the interviewees spontaneously associated the colour purple with the ‘Whiskas’ brand and 40% of those mentioned ‘Whiskas’ as the first brand with which they associated the colour. In addition, that evidence showed that 53% - 75% of interviewees associated the colour purple with Whiskas. Furthermore, apart from the applicant being able to demonstrate high recognition of the colour mark in the EU, it also was able to show a substantial presence in all Member States over many years as well as significant market share and considerable investment in marketing and advertising.

Sometimes, if convincing evidence is adduced from other sources, acquired distinctiveness can be proved without having recourse to survey or opinion poll evidence. In a decision involving registration of the Veuve Clicquot Orange colour⁶⁴



, the Board of Appeal was called upon to assess distinctiveness acquired through the use of that colour for champagne. The Board noted that the relevant consumer of champagne is not the general public but a specific and attentive sector of the general public: champagne being an expensive wine usually consumed on special occasions. The Board took into account the evidence provided (i.e. high sales in many EU countries and high market share in those countries, the existence of considerable publicity, catalogues and press articles mentioning and showing the ‘orange colour’ for Veuve Clicquot Champagne. Additionally, the Board took into account the existence of national registrations in France, the United Kingdom and the Benelux as well as the national judgment of a Belgian Court about the likelihood of confusion between a Belgian beer and Veuve Clicquot Champagne because of the orange colour. Moreover, consideration was given to a statement by the General Director of the inter-professional committee of champagne wine that the applicant was the only producer using this colour for champagne.

⁶² Bamford Excavators Limited (Yellow, Colour mark), decision of 6 October 2005 in Case R 255/2004-2.

⁶³ Decision of 4 May 2007 in Case R 1620/2006-2 (Purple).

⁶⁴ Decision of the Second Board of Appeal of 26 April 2006 in Case R 0148/2004.

The Board decided to uphold the appeal, and accept distinctiveness acquired through the use of the colour orange for champagne, even though some of the evidence submitted showed use of the colour with verbal or figurative elements. The Board was of the view that, following reasoning in the ‘HAVE A BREAK’ judgment⁶⁵, the fact that the colour was used with other verbal or figurative elements did not exclude the distinctiveness acquired by the use of the colour. The appeal was allowed.

These are just some of the cases in which applicants have successfully secured a CTM for a particular colour. In all these cases the CTM has been applied for by large corporations, usually global operators, with a long established presence on the market and a considerable history of investment in promotion of the colour marked goods or services. A generous approach has sometimes been taken with regard to the presence of word elements, used in conjunction with the colour. It is legitimate to question whether it is correct to give any single operator a monopoly on a single colour under any circumstances. The range of colours that may be perceived and retained in the mind’s eye is limited. Colours may, in some circumstances, serve as a prompt in product or service recognition but word elements will ultimately give a more precise identification of commercial origin.

Veve Clicquot might be the only champagne producer using orange but what about



sparkling white wines? Would Veve Clicquot

be able, for example, to



oppose the following use by a Luxembourg producer of white sparkling wines? Does a colour mark registration really give the proprietor proper protection?

VI-Inter partes conflicts

Where an applicant manages to get his or her colour mark onto the register, this will not be the ‘end of the story’. The next immediate difficulty will be to know how much protection it will receive. Can it be used in infringement proceedings against signs using similar shades? It has been argued that to do so threatens a colour monopoly and thus an unfair distortion of competition⁶⁶. If it does not then can consumers with imperfect recollection really store a precise image of the registered shade in their minds?

The CJEU, GCEU and OHIM have yet to judge a conflict between two colours per se or combinations of colours. One of the major problems in this area is that such marks are likely to enjoy a reputation or, at the very least, enhanced distinctiveness. If the colour marks were not well known, they would never have got on the register in the first place.

The CJEU has been criticized for overly ‘broaden[ing] the scope and reach of EU trademark protection’ by ‘developing a flexible concept of trademark use that

⁶⁵ Judgment in Case C-353/03 Société des produits Nestlé SA v Mars UK Ltd (‘Have a break’), [2005] ECR I-6135.

⁶⁶ See <http://ipkitten.blogspot.com.es/2007/03/mobile-phone-wars-aussie-colour-mark.html>.

encompasses referential and decorative use, ... with the adoption of a remarkably low threshold for a showing of reputation'⁶⁷. More specifically, criticism is levied against making an adverse effect on the communication, investment and advertising functions of a mark actionable in infringement proceedings. The basis for this wide approach seems to be the incentive and reward rationales that justify the exploitation of rights in other fields of intellectual property but are inapplicable in this context. As Professor Seftleben puts it, 'unlike inventors and authors, the brand owner cannot validly claim to have created intellectual property that furthers science or art. The trademark does not fall into the public domain after a limited period of time to enrich mankind's universal treasury of intellectual creations. Against this background, it remains unclear why the CJEU paved the way for more generous brand protection that becomes more readily available.'

Accordingly, the danger is that in upholding the protection offered by a colour mark in an inter partes context, where dilution is at issue, decision-makers risk making a gross distortion of competition. The proprietor of a colour mark, with reputation, could end up getting an overly wide scope of protection and an unjustified monopoly. The fairer result would be to give a narrow scope of protection to a particular shade of colour.

The issue of conflicting use of CTM colour signs (used with word elements that are the subject of separate registrations) and reputation is currently the subject of a preliminary reference from the UK Court of Appeal to the GCEU⁶⁸, made on 16 May 2012. The UK Court has referred the following five questions:

A. Where a trader has separate registrations of Community trade marks for:

- 1. a graphic device mark;*
- 2. a word mark; and uses the two together, is such use capable of amounting to use of the graphic device mark for the purposes of Article 15 of Regulation 40/94? If yes, how is the question of use of the graphic mark to be assessed?*

B. Does it make a difference if:

- 1. the word mark is superimposed over the graphic device?*
- 2. the trader also has the combined mark comprising graphic device and word mark registered as a Community trade mark?*

C. Does the answer to A or B depend upon whether the graphic device and the words are perceived by the average consumer as (i) being separate signs; or (ii) each having an independent distinctive role? If so, how?

D. Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours such that it has become associated in the mind of a significant portion of the public (in a part but not

⁶⁷ See Martin Seftleben, *Bringing EU Trademark Protection Back Into Shape – Lessons to Learn From Keyword Advertising*, p. 26 (available at <http://www.epip.eu/conferences/epip06/papers/Parallel%20Session%20Papers/SEFTLEBEN%20Martin.pdf>).

⁶⁸ *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd and Specsavers Optical Superstores Ltd v Asda Stores Ltd* (Case C-252/12).

the whole of the Community) with that colour or combination of colours, is the colour or colours in which the defendant uses the sign complained of relevant in the global assessment of (i) likelihood of confusion under Article 9(1)(b) or (ii) unfair advantage under Article 9(1)(c) of Regulation 40/94? If so, how?

E. If so, is it relevant as part of the global assessment that the defendant itself is associated in the mind of a significant portion of the public with the colour or particular combination of colours which it is using for the sign complained of?



In particular, it will be interesting to see whether the CJEU follows its findings in the HAVE A BREAK judgment in which it held that:

‘the expression “use of the mark as a trade mark” must .. be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking. Yet, such identification ... may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.’⁶⁹

Whether the CJEU will, like in the *Veuve Clicquot* decision of the Board of Appeal, be inclined to take a broad and generous approach to the combined use of colour and word elements, remains to be seen. Moreover, any clarifications it has to offer on bringing reputation into the equation will likewise be welcomed.

There are, of course, examples of conflicts between colour marks at national level. In *BP Amoco plc v John Kelly Ltd*⁷⁰, BP owned a registered trade mark for the colour



green (Pantone 348C) applied to the exterior surface of service stations where the lubricants and fuels it covered were sold. Mr Kelly adopted a green coloured service station design and was sued by BP for infringement. The Court of Appeal of Northern Ireland upheld the claim and seems to have taken good note of evidence put forward by BP on marketing investment and market research data showing that BP was the best recognised brand in the UK because of its colour. Moreover, the Court dismissed as ‘minor and incidental’ arguments that the colour in question denoted

⁶⁹ Para. 29-30 of the judgment.


⁷⁰ [2002] FSR 5.

Ireland (i.e. geographic origin) and environmental friendliness (i.e. a characteristic of the goods).

BP has not been so successful in a recent decision of the Adjudicative Board of the Polish Patent Office⁷¹.

BP filed a request for invalidation against the registration of a Polish mark



for goods such as fuel, lubricants and oil as well as hotel, motel and restaurant services. Based on its earlier complex  sign, BP filed a request for the invalidation of the SEYDAK trade mark. It argued that the contested sign used a composition of colours (green and yellow) that that were in the reputed trade marks owned by BP. Citing both EU⁷² and national trade mark law, BP claimed that it is not possible to assume that in the case of complex trade marks, the word elements always dominate because sometimes colours or images may dominate and give rise to associations between trade marks.

The Adjudicative Board of the Polish Patent Office was not convinced that the defendant's registration should be invalidated. It seems to have been persuaded by the arguments of the defendant's representative that the overall similarity of the signs, particularly in view of the verbal elements, made them dissimilar and that in any event, the defendant was a local operator with five service stations, all off the main roads.

The result seems reasonable in this 'David versus Goliath' scenario, especially since the word element of the contested mark is so prominent. On the other hand, in the case law of the CJEU, mere decorative use that calls to mind the protected earlier reputed mark may be enough to constitute use of a trade mark.

In the 'Lila Postkarte' case⁷³, the German Federal Court of Justice had to rule on the marketing of postcards that parodied the trade marks and advertisements of Milka. Purple colour postcards, corresponding to Milka's colour per se trade mark, ridiculed the scene of cows and mountains used in Milka's advertising campaigns. The postcards also displayed a humorous poem attributed to Rainer Maria Milka (instead of the famous German writer Rainer Maria Rilke). The Court held this to be trade mark use and therefore assessed the parody from the perspective of trade mark infringement (detriment to distinctive character or repute and taking unfair advantage). In the event, the Court accepted that there was 'due cause' on the part of the parodist – namely, freedom of art which prevailed against the complaint of disparagement.


The Lila Postkarte case did not just concern a colour per se, since other figurative and verbal factors were involved. Nevertheless, the colour registration had a role to play and contributed to the defendant parodist being 'dragged' through the courts.

⁷¹ Decision of 12 November 2012 in case no. Sp. 566/09 BP v Przedsiębiorstwo Usługowo Handlowe Marian Seydak (see https://www.marques.org/Class46/Article.asp?D_A=20121206&XID=BHA3044)


⁷² E.g. judgment of 3 September 2009 case C-498/07, 'Carbonell'.

⁷³ Judgment of 3 February 2005, Case I ZR 159/02, cited in C. Geiger - 2012 - *Constructing European Intellectual Property: Achievements and New Perspectives*, Google books, p. 158.

Sometimes, one may wonder whether national interests skew the scales of justice in giving too much protection to colour per se. In a somewhat surprising recent decision of the Austrian Supreme Court⁷⁴, Red Bull successfully sued a Polish company for

infringing its silver red coloured Community Trade Mark  by taking unfair advantage of its reputation. The defendant had, under licence, produced drink cans in Austria. The Austrian Supreme Court found that the Red Bull colour were known to 54% of the Austrian population and 89% of consumers of energy drinks. Reputation was established in Austria, which was enough for the Community Trade Mark to be deemed to be reputed.

Red Bull's Community Trade Mark had obtained registration by showing acquired distinctiveness through use. However, it was – at the time of the proceedings – subject to no less than five cancellation requests⁷⁵. If any of those cancellation requests subsequently prove successful, the Supreme Court's judgment will have to be reversed.

Finally, the conflicting purple colour of chocolate wrappers was litigated in the UK last year in a decision of 1 October 2012 in *Nestlé v Cadbury*⁷⁶. Cadbury, a famous chocolate manufacturer, had obtained registration of a trade mark for the colour purple  (Pantone 2685C) 'applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods' for goods in Class 30 (chocolate bars and other miscellaneous chocolate products). Nestlé sought to invalidate the registration on the grounds that the colour purple was not 'a sign' and was not 'capable of being represented graphically'. Judge Birss held that the use of the word 'predominant' in the trademark application's description of the representation of the colour on the goods it sought to cover did not 'introduce any more vagueness or uncertainty than is already present and acceptable in a trade mark registration of this kind'. It therefore conformed to the *Libertel* and *Heidelberger* criteria. Cadbury's registration was capable of being a sign and on the evidence had acquired distinctiveness for chocolate. The registration was therefore held to stand

While it is true that Cadbury had shown that it had been using this colour for close to 100 years, one may wonder whether the words 'predominantly purple' do not subtract from the requisite legal certainty. If they do not, then are descriptions in writing of the colour redundant? Moreover, the colour purple is a favourite with international chocolate manufacturers. Clearly, the shades used are different but the more different shades of purple that come onto the market for these products, the harder it is going to be for consumers to retain them accurately in their memories. Registration of colours in this situation may be shifting the litigation burden from an absolute grounds context to a relative grounds one.

⁷⁴ Case 17 Ob 27/11 m, June 12, 2012 .

⁷⁵ See <http://www.zeinerlaw.at/en/news/> .

⁷⁶ Judgment of the High Court, Chancery Division, delivered by HH Judge Birss.

VII-Conclusion

Colours can satisfy the requirements to be considered signs and to be graphically represented. Unless those signs are for a narrow market and very specific goods and services, they will only obtain registration where the acquisition of distinctive character through use is shown. Uncertainty subsists in what is a narrow market and very specific goods might be. Difficulties continue for obtaining a CTM through acquired distinctiveness because of the need to prove EU-27 use. This leads to a situation where it will usually only be global operators that satisfy that geographical spread of use. Monopolies of colours are therefore in the hands of a very few but often for similar or competing products. Inter partes conflicts at EU level over colours have not yet been tested. The protection afforded by reputation in this area is an unknown quantity at EU level. The guidance available from national court decisions is limited either because of their diverging nature or because they appear skewed in favour of national interests.

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Alicante, 11 March 2013

⁷⁷ Member of the OHIM Boards of Appeal. The views and opinions expressed in this paper are those of the author and do not necessarily reflect any position of the OHIM.