



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

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1. Protecting colour per se

- ‘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 goods, without any specific message’ (*Libertel*, C-104/01, para. 40)
 - Rule 3(5) CTMIR foresees registration of colour ; Art. 15(1) TRIPS
 - A colour may be registered where:
 1. It is a sign (*Libertel* para. 7),
 2. It can be represented graphically (clear, precise, self-contained, easily accessible, intelligible, durable and objective)
 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.
- => ‘circumstances of the case’ test

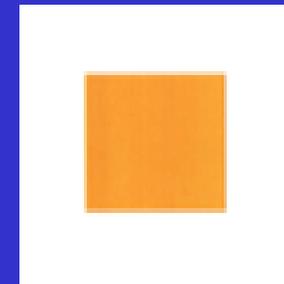


1. Protecting colour per se (cont'd)

- **Public interest and competition:**

‘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’ (Libertel, para. 47)

- **Non-traditional marks => problem of consumer perception**
- **Do colour codes help in a ‘stringent and full’ examination?**
- **‘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 specific’ (e.g. Case R0371/2009-2, Case R2272/2010-2 and Case T-97/08)**

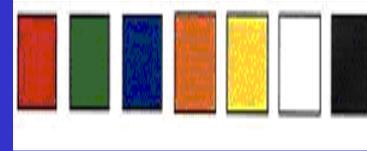




2. Protecting Colour Combinations

Heidelberger Bauchemie (Case C-49/02):

- May be a sign (depending on ‘the context’ of use).
- Graphic representation of two or more contourless colours should be systematically arranged’ in a predetermined and uniform way’, with a sample and code so as to be sufficiently precise, certain and durable, etc.



e.g. Case T-293/10 of 14 June 2012

- Need to satisfy the requirements of minimum distinctive character
=> assessed by ‘the relevant circumstances of the case, including any use’
- May send other, non-TM messages - e.g. Case T-0404/09 
- 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?

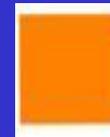


3. Acquired Distinctiveness

- *Windsurfing Chiemsee* (C-108/97 and C-109/97) ‘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’
- ‘Significant proportion’ assessed from the evidence overall and duration and intensity (para. 49)
- Evidence can include: market share, intensity and duration of use, promotion investment, recognition of commercial origin, statements from chambers of commerce or trade associations and surveys or opinion polls => independent, objective evidence
- What about EU-27? Art. 7(2) CTMR; *Lindt* (Case C-98/11), para. 63
- Examples: *John Deere* (Case T-137/08)



Veuve Clicquot (Case R 0148/2004)



Whiskers (Case R 1620/2006-2)





4. Inter Partes Conflicts

- Problem of reputation: Danger of distortion of competition and unjustified monopoly through overprotection
- *Specsavers v Asda* (C-252/12)



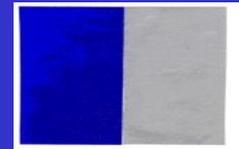
- *BP v John Kelly* [2002] FSR 5



- *BP/Seydak* (Poland 12 Nov. 2012)



- *Red Bull/Cool Run* (Austrian Supreme Court - 2012)



- *Nestlé v Cadbury* (High Court – 1 Oct. 2012)





THE END

THANK YOU FOR YOUR ATTENTION!