

**DECISION
of the Fifth Board of Appeal
of 8 November 2023**

In case R 798/2023-5

OMV Aktiengesellschaft

Trabrennstr. 6-8
1020 Vienna
Austria

IR Holder / Appellant

represented by Schönherr Rechtsanwälte GMBH, Schottenring 19, 1010 Vienna, Austria

APPEAL relating to International Registration No 1 593 116 designating the European Union

THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson and Rapporteur), P. von Kapff (Member) and A. Pohlmann (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 On 27 January 2021, OMV Aktiengesellschaft ('the IR holder') claiming the priority of Austrian trade mark No 12 685/2020 with a filing date of 23 November 2020 designated the European Union in its international registration for the colour mark



('the IR') for, among others, the following list of goods and services as amended on 5 August 2021:

Class 1: Chemical preparations for use as additive to fuels for improving combustion; chemical additives to motor fuel; hydrogen.

Class 4: Fuels; non-chemical additives for fuels; illuminants; electrical energy; lubricants; industrial oil.

Class 35: Retail services in relation to vehicle equipment, namely lubricants, brake fluid, chemical and non-chemical additives for fuels and lubricants, antifreeze, cleaning and fragrancing preparations; retail services in relation to vehicle parts, fuels, engine oils; wholesale and retail services in relation to chemical substances, chemical materials and chemical preparations, and natural elements for industrial or scientific use, hydrogen, fuels, chemical or non-chemical additives for fuels, illuminants, lubricants, industrial oil, hot water, medicinal and mineral water.

Class 37: Building, construction or demolition of facilities or installations for exploration, exploitation, processing, production, storage, transport or distribution of hydrocarbons, hydrogen, minerals, bitumen, fuels, illuminants, lubricants, industrial oil or energy; installation, cleaning, repair or maintenance of facilities or installations for exploration, exploitation, processing, production, storage, transport or distribution of hydrocarbons, hydrogen, minerals, bitumen, fuels, illuminants, lubricants, industrial oil or energy; refuelling of land vehicles; recharging services for electric vehicles; vehicle service stations [refuelling and maintenance]; automobile cleaning and car washing.

The IR holder claimed the colours:

Gentian blue (RAL 5010), yellow green (RAL 6018).

- 2 On 31 May 2021, the mark applied for was republished by the Office.
- 3 The IR holder maintained its request for the designation notwithstanding the first *ex officio* provisional partial refusal of protection issued by the examiner according to Article 193 EUTMR in conjunction with Article 33 EUTMIR on 14 June 2021, as well as

the second *ex officio* provisional partial refusal of protection the examiner issued according to Article 45(3) EUTMR on 8 September 2022.

- 4 On 6 March 2023, the examiner took a decision ('the contested decision') partially refusing protection of the IR under Article 7(1)(b) EUTMR and Article 182 EUTMR. The decision was based on the following main findings (see also the objections raised by the examiner in the provisional refusals of 14 June 2021 and 8 September 2022):
- The colours blue and green are not unique or exceptional but are merely ordinary colours. Therefore, there are clear indications that they could be used in trade for presenting the objected goods and services.
 - Particularly in the case of a colour mark which is perceived in the same way throughout the European Union, the public will not distinguish the blue-green colour combination applied for from the other usual colours and colour combinations.
 - The colouring claimed is not so striking that the relevant public would be able to identify the colour as a sign of origin, since blue and green belong to the original colours (red, yellow, green, and blue) and are, moreover, common on the markets at hand.
 - Due to its simplicity, the sign applied for does not convey an unambiguous message to the relevant public with regard to any of the goods and services applied for but is perceived primarily as a decorative element or an embellishment serving aesthetic purposes. Thus, the sign lacks the minimum necessary degree of distinctiveness.
 - As the Office has demonstrated in this case, the combination of colours blue and green, is commonly used in relation to a wide range of goods and services in the fuel industry (internet search conducted on 5 September 2022 and verified by the Board on 2 November 2023):

- <https://www.bavaria-petrol.de/>



- http://static.carrefour.es/crs/cdn_static/c4corp-front/images/grupo-carrefour/memoria-sostenible/2017_v2/es/node/8062.html



- <https://www.agla.es/es/estaciones/granada/eess-virgen-de-agua>



- <https://www.wynns.es/producto/tratamiento-gasolina/>



- The arrangement or the shades of the mark applied for are not perceptibly different from the arrangement and shades of blue and green commonly used in the sector to which the goods and services belong. The human brain is only capable of differentiating colour nuances within a colour shade to a very limited extent, especially since each colour can produce a different effect depending on the colour background and the environment. The differences between the claimed colours, and those cited by the Office are hardly perceptible and even less so without a colour chart. The relevant public perceives the colour mark overall as a simple colour combination ‘blue-green’, without any differentiation of a RAL number.
- If motor vehicle drivers were to recognise a service station from a distance by its colour, it would only be if they had become accustomed to it through use, that is they has already ‘learned’ it. Since this is the situation of acquired distinctiveness, it will be examined at a later stage in these proceedings.
- It is up to the IR holder to provide specific and substantiated information to show that the trade mark applied for has distinctive character, either intrinsically or acquired through use.
- The IR holder has not provided any specific and substantiated information showing that the mark applied for has distinctive character on the relevant market sector that could disprove the Office’s analysis, which is based on facts arising from practical experience generally acquired from the marketing of the goods and services concerned.
- The earlier similar registrations by the Office are not binding.
- For the abovementioned reasons, the international registration is declared to be non-distinctive in the European Union for the objected goods and services (as listed in paragraph 1 in the present appeal decision).
- The international registration may proceed for the remaining services.

- 5 On 14 April 2023, the IR holder filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 3 July 2023.

Grounds of appeal

- 6 The IR holder's statement of grounds can be summarised as follows.

Inherent distinctiveness of colour combination trade marks

- The Office merely stated in general terms and without specific examination for each of the contested goods and services that the colour combination applied for is not sufficiently different from the basic colours and that the colours are commonplace on the relevant market.
- None of the cases mentioned by the EUIPO trade mark guidelines, in which an objection should exceptionally be made, applies in the case at hand. The application should therefore be granted in analogy to all the registrations granted recently by the Office without proof of acquired distinctiveness.

Peculiarity of the filling station and fuel industry

- The representation of the trade mark application shows that protection is sought for a colour combination ('colour code') consisting of the broadly applied colour gentian blue in combination with a narrow stripe in the colour yellow green. Both colours interact in such a way that the colour combination in its systematic arrangement already indicates the origin from the IR holder's company group, even before the relevant public gets to deal with IR holder's logo or any word element.
- The trade mark application concerns a very specific industry, the oil and gas industry, including the filling station market. If the colour combination blue and green is applied systematically in an arrangement on filling station buildings (where certain goods and services are provided), the public establishes a connection to a certain company on the basis of just a specific colour coding that is perceived. This is due to the fact that the relevant public has learned over time that specific filling station operators use different colour coding – without necessarily knowing which operator uses which colour coding (i.e., this is not related to acquired distinctiveness).
- This occurs rather in the sense of an allocation of origin (e.g., filling stations with the trade mark applied for are operated by a certain company or a licensee/franchisee of this company – in other words, they belong to a certain chain of filling stations or a specific oil company respectively).

Analysis of the market environment – colours applied on the filling station market (standard or industry practice)

- There is no factual basis for the Office's assumptions that the combination of colours blue and green is a common colour combination and that it does not significantly deviate from standards in the filling station/fuel sector.

Inadequate investigation by the Office

- Only obvious facts are meant to be understood as ‘facts arising from practical experience of the Office’, which does not apply to the case at hand. The fact that the combination of the colours blue and green in the specific arrangement as evident in the trade mark application is commonly used on the filling station market cannot be considered as such an ‘obvious fact’.
- All cases in which a colour combination should be rejected are not present: it is not a purely decorative element, it is not the nature of the goods themselves (as might be the case with hair colour, for example), it is not technically functional (such as the colour red for fire extinguishers, the use of certain colours for power cables), nor is it customary (such as yellow for postal services in many countries). It also does not indicate any specific characteristics of the goods, such as a flavour.
- If it can be proven that such a colour combination already occurs on the market, especially if it is used by different competitors, this would be a possible basis for a further legal assessment of a possible lack of distinctiveness.
- The illustrations referred to by the Office to show that the colours blue and green are ‘commonly used’ in relation to the objected goods and services relating to the fuel industry, are not sufficient proof. These search results do not correspond to the colour combination applied for, since the colours blue, green and white are featured in the petrol stations and the allocation of colours is completely different (not depicting a dark blue areal colour with a light green stripe). As to the example of the fuel product, such products use all kinds of colours combined with blue; the combination with green only relates to a specific type of the range, which uses various colours/colour combinations for different types of products.
- All kinds of different colours can and indeed are used in the gas and oil industry, more specifically for the goods and services concerned.
- Therefore, the examples of the Office do not demonstrate that this particular colour combination is commonly, frequently, or even (very) often used in this specific industry. The various objects shown in the screenshots do not feature the combination contained in the trade mark applied for, in particular, not in the specific form applied for. This proves nothing beyond the commonly known fact that almost all goods and services are available in different colours or coloured designs (11/07/2019, R 381/2019-4, LIGHT BLUE, DARK BLUE, RED, § 22).

Analysis of the market environment

- The IR holder is the only participant on the relevant oil and gas market, including the filling station in the EU (in relation to comparable competitors) that uses the specific colour combination in the specific ratio depicted in the trade mark representation.
- To define relevant competitors, reference is made to a ranking of major European filling station retailers online (a total of 11 filling station brands, including the IR holder OMV Aktiengesellschaft) at [https://www.retail-index.com/HomeSearch/EinzelhandelinEuropaDatenbank\(Deutsch\)/TankstellenEinz](https://www.retail-index.com/HomeSearch/EinzelhandelinEuropaDatenbank(Deutsch)/TankstellenEinz)

elhandelinEuropa.aspx (data for 2009; Exhibit B) and <https://www.retail-index.com/sectors/petrolretailersineurope.aspx> (data for 2019; Exhibit C).

- Not a single comparable competitor in the EU uses the IR holder’s colour combination blue and green (certainly not in the specific ratio shown in the reproduction of the trade mark applied for). Reference is made to a compilation of the filling station designs of all these market participants (Exhibit D).
- A more comprehensive analysis in the IR holder’s home market, Austria, compiles an identification of filling stations on the basis of a very extensive list of market participants published by the responsible trade association of the Austrian Chamber of Commerce (*Fachverband der Mineralölindustrie – FVMI*) (Exhibit E). These statistics show an overview of all publicly accessible filling stations in Austria and their distribution by province. It includes the seven ‘major-branded’ filling station brands, i.e., the brands of FVMI member companies (in addition to the IR holder OMV Aktiengesellschaft, this includes Avanti, the Eni Group, Shell, BP, JET and MOL) and 21 ‘other filling stations’ (such as Turmöl, Genol, Avia or A1).
- Not a single competitor of the IR holder in Austria uses the colour combination blue and green (certainly not in the specific ratio shown in the reproduction of the trade mark applied for). Reference is made to a compilation of the filling station designs of all these market participants (Exhibit E).
- As a result, there is no colour combination that constitutes an industry standard or that is common in the oil/fuel industry, specifically the filling station industry. This is obvious due to the fact that the colour combinations of the most important filling station companies operating on the same (especially territorial) market all differ significantly from each other (corresponding to the graphic representation of the equipment of a sales outlet in general; 10/07/2014, C-421/13, Apple Store, EU:C:2014:2070, § 20).
- Different filling station operators deliberately rely on the use of different colour concepts to ensure differentiation by the consumer. Colours are used in the filling station sector precisely not merely as a design, aesthetic or decorative element, but specifically to serve as an indication of origin, in particular as far as the specific market of filling stations is concerned.

Additional considerations

- The availability of colours – in particular, of colour combinations – for the other economic operators offering goods or services of the kind covered by the application is not unjustifiably limited here. There are various possible combinations of colours, so that the registration of a specific colour combination in a specific systematic arrangement cannot have a negative impact on the availability of the colours as such for market competitors (11/07/2019, R 381/2019-4, LIGHT BLUE, DARK BLUE, RED (col.), § 13; 02/03/2018, R 1666/2017-4, DEVICE OF A LABEL PLACED OVER A CAN (fig.), § 17).

- It would amount to stricter criteria for a particular category of marks if for colour combinations it would be required to prove distinctiveness by virtue of use whereas for ‘normal’/‘conventional’ trade marks that is not the case.
- A trade mark may fulfil various functions (including decorative purposes or to make goods more aesthetically pleasing), but it is sufficient that one of these functions is that of indicating commercial origin.

‘Colour coding’ on the filling station market - identification of filling station operators via colour concepts

- The relevant public usually approaches filling stations from a long distance and at high speed in a vehicle, and also regularly with poor visibility (rain, fog, or snow). In such scenarios, naturally the consumer only perceives initially the coloured elements of a filling station, specifically the outline of the actual filling station and the colour applied. The colour combination alone enables the consumer to identify the origin of the goods and services offered under the sign - even before a word or logo can even be recognised. The colour combination and its specific positioning therefore serve as an indication of origin and do not have a purely decorative function.
- Specific colour combinations applied to filling station buildings, which are already recognisable from a distance, signal to the approaching person that the filling stations are operated by different undertakings. As with any graphic brand design, the purpose of a successful design is to motivate customers to make a purchase decision; however, the main function is to enable differentiation from other providers. The fact that there may be individual filling stations that are not part of a chain comprising several filling stations and therefore may not use a distinctive colour design in exceptional cases does not mean that the public is not accustomed to the typical use of colour to identify ‘branded filling stations’ (filling station chains) in particular.
- The CJEU has already stated that when assessing the distinctive character of a trade mark applied for as a trade mark for a service, which is composed of coloured motifs and which is intended to be applied exclusively and systematically in a specific manner to a large part of the objects used for the provision of that service, the relevant public's perception of the application of that sign to those objects must be taken into account (08/10/2020, C-456/19, Aktiebolaget Östgötatrafiken, EU:C:2020:813).
- The illustrated market practice, according to which the colour combination is extensively used in the filling station sector to distinguish different filling station companies, shows the suitability of colour combinations to identify origin.
- The public has learned to distinguish generally gas/filling/petrol station (companies) from one another on the basis of their colours and the application of these colours.

Public's general perception of colours on the filling station market

- An expert opinion (Exhibits G and H) comes to the conclusion that: (a) consumers are capable of identifying filling station companies on the basis of the colour combination used, namely a colour combination as applied to building elements and gas pumps that are clearly associated with the brand, (b) in a specific given situation, in road traffic,

(under more difficult conditions of perception), it is likely that consumers will identify undertakings in particular on the basis of the colour combination.












- Colour information contributes to the identification and naming of objects at a very early stage of the perceptual process and the recognition and association of a filling station brand to a provider under difficult visual conditions and with very short fixations; possibly only peripheral perception outside the fovea should be significantly influenced by the available colour information if the perceiving consumers have learned that specific colour combinations serve as cues to different filling station providers.

Specific perception of the trade mark application

- Reference is made to the results of the online studies of November 2022 (Exhibit J) in Austria and of March 2023 in Hungary, Romania and Slovakia (Exhibits K, L and M), showing recognition of the colour combination applied for in relation to oil and gas companies.

The sign can serve as an indication of origin for the goods and services applied for

- The trade mark application relates to a limited number of goods and services, specifically those which are provided in the context of an oil and gas company and which the relevant public expects to receive at filling stations, and which are typically operated by such undertakings (i.e., the IR holder's main business areas).
- The relevant market – the oil and gas industry, which is inseparably connected with the filling station market – is very specific as regards the use of colour codes. Suppliers present on the filling station market differ significantly from the IR holder with regard to the colour combinations they use (Exhibits D and F). The different colour codes enable consumers to recognise from a distance which supplier/chain of filling stations the approaching filling station belongs to. The colour combination enables the public to distinguish between the individual suppliers long before a logo or word can even be recognised.
- The colour combination applied for is perceived as particularly eye-catching in the business area concerned and is memorised by the relevant public irrespective of whether the individual colours are extraordinary in themselves or not.
- The fact that the colour combination is indeed capable of identifying the goods and services in question as originating from a specific company is already evident from our explanations above, if the actual perception of the relevant public is taken as a basis (74 % of the Austrian, 55 % of the Hungarian, 58 % of the Romanian and 48 % of the Slovakian public were of the opinion that filling stations using this colour combination originate from a very specific provider, Exhibits J, K, L and M).
- Reference is made to the following trade marks registered by the Office and to relevant case-law of the EUIPO Boards of Appeal:

Trademark registration no	Representation		
EUTM 018409241 Registration date: 27/07/2021			
EUTM 016178473 Registration date: 10/12/2020			
EUTM 1311587 Registration date: 09/10/2015			
EUTM 008298499 Registration date: 17/02/2010		IR no 1 311 587 (11/09/2019, R 381/2019-4, LIGHT BLUE, DARK BLUE, RED (col.))	
EUTM 004350966 Registration date: 12/11/2009		EUTM no 16 544 141 (06/04/2018, R 2622/2017-4, DEVICE OF A RECTANGULAR LABEL (fig.))	
EUTM 003527579 Registration date: 23/03/2007		IR no 1 313 416 (02/03/2018, R 1666/2017-4, DEVICE OF A LABEL PLACED OVER A CAN (fig.))	
EUTM 002280899 Registration date: 20/08/2004		EUTM no 11 808 573 (06/07/2018, R 2688/2014-4, DEVICE OF PET FOOD PACKAGING (fig.))	

Reasons

- 7 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 8 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.
- 9 However, the appeal is not well founded.

Scope of appeal

- 10 The extent of the appeal covers only the objected goods and services in Classes 1, 4, 35 and 37 (listed in paragraph 1 of this decision) which were rejected by the examiner (Article 67(1) EUTMR).
- 11 By contrast, the remaining services applied for in Classes 35, 37, 39, 40, 42, 43 and 44 not rejected by the examiner and for which the contested decision is favourable to the IR holder, do not fall within the subject matter of this appeal. As a result, the contested decision has become final in so far as the IR designating the European Union was allowed to proceed.

Admissibility of the evidence filed before the Boards of Appeal

- 12 According to Article 95(2) EUTMR, the Office may disregard evidence which is not submitted in due time by the party concerned.
- 13 Pursuant to Article 27(4) EUTMDR, the Board of Appeal may accept facts or evidence submitted for the first time before it only where those facts or evidence meet the following requirements: (a) they are, on the face of it, likely to be relevant for the outcome of the case and (b) they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been

submitted in due time, or are filed to contest findings made or examined by the First Instance of its own motion in the decision subject to appeal (see also Article 54 of Decision 2020-1 of 27 February 2020 of the Presidium of the Boards of Appeal on the BoA RoP).

- 14 The IR holder submitted additional evidence at the appeal stage with its statement of grounds (Exhibits A to M).
- 15 In the present case, the conditions for accepting the belated evidence submitted by the IR holder at the appeal stage have been met. The documents submitted before the Boards of Appeal refer to the requirements of Article 7(1)(b) EUTMR. The information and evidence produced at the appeal stage are supplementary to the documents presented before the examiner in relation to the distinctiveness of the contested mark:
 - Exhibit A: previous registrations of colour combination marks by the Office;
 - Exhibits B-C: ranking of major European service station retailers in 2009 and 2019;
 - Exhibit D: a compilation of colour concepts applied to filling station designs EU wide;
 - Exhibit E: an overview of filling stations in Austria 2021;
 - Exhibit F: a compilation of colour concepts applied to filling station designs Austria-wide;
 - Exhibit G: Univ.-Prof. Dr. Arnd Florack, Head of the Institute for Work, Economic and Social Psychology and Professor of Applied Social Psychology and Consumer Behaviour Research at the University of Vienna;
 - Exhibit H: an expert opinion by Univ.-Prof. Dr. Arnd Florack on ‘Distinctiveness of filling station brands on the basis of colour striping/colour design on the building and on the gas pumps’ (original in German) including an English translation;
 - Exhibit J: results of Market Research Colour Trademark 2022 Austria;
 - Exhibit K: results of Market Research Colour Trademark 2023 Hungaria;
 - Exhibit L: results of Market Research Colour Trademark 2023 Romania;
 - Exhibit M: results Market Research Colour Trademark 2023 Slovakia.
- 16 The additional evidence is also, prima facie, relevant for the outcome of the present case, as, among others, the examiner found that the IR holder did not provide convincing evidence on the distinctiveness of the mark at issue for the relevant goods and services. Finally, there is also nothing to suggest negligence or delaying tactics in the present case (18/07/2013, C-621/11 P, Fishbone / FISHBONE BEACHWEAR (fig.) EU:C:2013:484, § 36).
- 17 It follows that the applicable criteria for accepting the belated evidence have been fulfilled. Therefore, all the facts and evidence submitted by the IR holder will be taken into account as being admissible by the Board.

Probative value of market surveys

- 18 The case-law of the Court of Justice of the European Union and the General Court has established a number of factors which affect the relevance and probative value of market surveys. These criteria are included, *inter alia*, in Decision 2020-8 of 6 November 2020 of the Presidium of the Boards of Appeal concerning market surveys as evidence before the Boards of Appeal ('Presidium decision on market surveys as evidence').
- 19 Market surveys are adduced in proceedings before the Boards of Appeal usually to show distinctiveness acquired through use, or reputation of a mark, but can also be used for other purposes. In all cases where such evidence is adduced, the Board must assess whether the survey is relevant and reliable before assessing its probative value.
- 20 In the present case, four market surveys are to be considered, i.e., the online studies of November 2022 in Austria (Exhibit J) and of March 2023 in Hungary, Romania and Slovakia (Exhibits K, L and M), showing recognition of the colour combination applied for in relation to oil and gas companies.
- 21 The Board notes that the sample is sufficiently representative, and the survey methodology is reliable. However, the illustrated reputation of the IR holder's mark is irrelevant for the assessment of distinctiveness under Article 7(1)(b) EUTMR. The IR holder itself admits that these surveys '...follow the concept of proof of acquired distinctiveness...'. However, the concept of proof of acquired distinctiveness is only relevant under the conditions of Article 7(3) EUTMR, which has not been examined by the Office yet.

Article 7(1)(b) EUTMR

- 22 Under Article 7(1)(b) EUTMR, 'trade marks which are devoid of any distinctive character' are not to be registered. The same applies if the contested mark is an IR designating the EU (Articles 182 and 193(1) and (6) EUTMR).
- 23 For a trade mark to possess distinctive character for the purposes of Article 7(1)(b) EUTMR, it must serve to identify the goods and services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (29/04/2004, C-456/01 P & C-457/01 P, *Tabs (3D)*, EU:C:2004:258, § 34; 13/09/2010, T-97/08, *Colour (shade of orange) II*, EU:T:2010:396, § 28).
- 24 According to Article 3(3)(f) EUTMIR, a colour mark consists exclusively of either 'a single colour without contours' or 'a combination of colours without contours'. Where the mark consists exclusively of a combination of colours without contours, the mark shall be represented by submitting a reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner and an indication of those colours by reference to a generally recognised colour code. A description detailing the systematic arrangement of the colours may also be added.
- 25 In order to determine whether a colour *per se* or a colour combination is capable of distinguishing the goods or services of one undertaking from those of other undertakings within the meaning of Article 7(1)(b) EUTMR, it must be determined whether the colours *per se* or colour combinations are liable to convey precise information, particularly as regards the origin of a product or service (06/05/2003, C-104/01, *Libertel*, EU:C:2003:244,

§ 39; 24/06/2004, C-49/02, Blau / Gelb, EU:C:2004:384, § 37; 13/09/2010, T-97/08, Colour (shade of orange) II, EU:T:2010:396, § 30; 27/09/2018, T-595/17, GELB-GRAU (fig.), EU:T:2018:609, § 19; 09/09/2020, T-187/19, Colour Purple, 2587C (col.), EU:T:2020:405, § 35).


- 26 In that connection, it must be borne in mind that, whilst colours or colour combinations are capable of conveying certain associations of ideas, and of arousing feelings, they are unlikely to communicate 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 (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 40; 24/06/2004, C-49/02, Blau / Gelb, EU:C:2004:384, § 38; 13/09/2010, T-97/08, Colour (shade of orange) II, EU:T:2010:396, § 31; 10/09/2015, T-143/14, YELLOW (col.), EU:T:2015:616, § 35; 27/09/2018, T-595/17, GELB-GRAU (fig.), EU:T:2018:609, § 22; 09/09/2020, T-187/19, Colour Purple, 2587C (col.), EU:T:2020:405, § 36).
- 27 The perception of the relevant public is not necessarily the same in the case of a sign consisting of a colour or colour combination *per se*, as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods which it identifies. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the external appearance of the goods or where the sign is composed merely of a colour or colours used to signal goods or services (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 65; 21/10/2004, C-447/02 P, Colour (shade of orange), EU:C:2004:649, § 78; 13/09/2010, T-97/08, Colour (shade of orange) II, EU:T:2010:396, § 32; 10/09/2015, T-143/14, YELLOW (colour mark), EU:T:2015:616, § 24; 28/10/2009, T-137/08, Green / Yellow, EU:T:2009:417, § 29; 04/05/2023, T-618/22, GREEN, ORANGE, EU:T:2023:238, § 15).
- 28 In the case of a colour or colour combination, distinctiveness without any prior use is inconceivable save in exceptional circumstances, particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 66; 21/10/2004, C-447/02 P, Colour (shade of orange), EU:C:2004:649, § 79; 13/09/2010, T-97/08, Colour (shade of orange) II, EU:T:2010:396, § 33; 10/09/2015, T-143/14, YELLOW (colour mark), EU:T:2015:616, § 25; 27/09/2018, T-595/17, GELB-GRAU (fig.), EU:T:2018:609, § 23; 09/09/2020, T-187/19, Colour Purple -2587C (col.), EU:T:2020:405, § 39). However, it cannot be inferred that any colour mark is necessarily distinctive, on the sole ground that it designates only a very restricted number of goods or services and that the relevant market is very specific (04/05/2023, T-618/22, GREEN, ORANGE, EU:T:2023:238, § 20 and the case-law cited).
- 29 It should also be noted that, to the extent that trade mark rights constitute an essential element in the system of undistorted competition established by the Treaty, the rights and powers that trade marks confer on their proprietors must be considered in light of that objective. However, in light of the fact that a trade mark confers on its proprietor an exclusive right, in relation to certain goods and services, that allows him or her to monopolise the sign registered as a trade mark for an unlimited period, the possibility of registering a trade mark may be limited for reasons relating to the public interest (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 48-50; 13/09/2010, T-97/08, Colour (shade of orange) II, EU:T:2010:396, § 34).

- 30 In that regard, the fact that the number of colours actually available is limited means that a small number of trade mark registrations for certain goods or services could exhaust the entire range of the colours available. Such an extensive monopoly would be incompatible with a system of undistorted competition, in particular because it could have the effect of creating an unjustified competitive advantage for a single trader. It must therefore be acknowledged that there is, in trade mark law, a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought (06/05/2003, C-104/01, *Libertel*, EU:C:2003:244, § 54, 55; 13/09/2010, T-97/08, *Colour (shade of orange) II*, EU:T:2010:396, § 35; 27/09/2018, T-595/17, *GELB-GRAU (fig.)*, EU:T:2018:609, § 24; 09/09/2020, T-187/19, *Colour Purple -2587C (col.)*, EU:T:2020:405, § 38; 04/05/2023, T-618/22, *GREEN, ORANGE*, EU:T:2023:238, § 16).
- 31 That distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (29/04/2004, C-456/01 P & C-457/01 P, *Tabs (3D)*, EU:C:2004:258, § 35; 13/09/2010, T-97/08, *Colour (shade of orange) II*, EU:T:2010:396, § 29; 04/05/2023, T-618/22, *GREEN, ORANGE*, EU:T:2023:238, § 14).

The relevant public

- 32 *Chemical preparations for use as additive to fuels for improving combustion; chemical additives to motor fuel; hydrogen in Class 1 and fuels; non-chemical additives for fuels; illuminants; electrical energy; lubricants; industrial oil*, in Class 4 as well as the related services in Classes 35 and 37 at issue are mainly offered in the automobile, machinery and energy industry; they target the general public, namely retail consumers of fuels and vehicle refuelling/recharging stations, as well as professionals in the industry of the supply of products and services related to fuels and vehicle refuelling/recharging stations (18/11/2014, T-308/13, *ELECTROLINERA*, EU:T:2014:965, § 27; 17/06/2015, T-60/14, *GO (fig.) / GO (fig.)*, EU:T:2015:390, § 25; 25/10/2022, R 2187/2021-4, *Ushuaïa (fig.) / USHUAÏA (fig.)*, § 32). The degree of attention varies from average to high, depending on the specialised nature of the goods and services, the frequency of purchase/use and their price.
- 33 The perception of a colour *per se* or a colour combination *per se* does not require knowledge of any language in order to be read or understood. Therefore, the public to be taken into account with regard to the distinctiveness of the sign applied for consists of the entirety of consumers within the European Union (24/03/2021, T-193/18, *GREY AND ORANGE (col.)*, EU:T:2021:163, § 34).

The lack of distinctive character

- 34 The contested mark  was registered with the colour claim: gentian blue (RAL 5010) yellow green (RAL 6018). The contested sign is a colour mark consisting of the combination of two colours applied to the goods and services at issue in Classes 1, 4, 35 and 37 related to vehicle refuelling/recharging stations pursuant to Article 4 EUTMR in conjunction with Article 3(3)(f) EUTMIR. In this regard, the Board notes that, although not obligatory but legally possible (last sentence of Article 3(3)(f)(ii) EUTMIR), the colour mark applied for neither describes how the combination appears or is supposed to

be used on the goods and services at issue nor specifies whether the colour combination claimed follows a particular systematic arrangement (e.g. horizontal, vertical, diagonal, etc.; compare 24/03/2021, T-193/18, GREY AND ORANGE (col.), EU:T:2021:163, § 35-36).

- 35 For the purposes of assessing the distinctive character of the contested mark, which consists of the combination of two colours, that mark must be considered as a whole. However, that does not preclude a prior examination of the individual elements of which it is composed (27/09/2018, T-595/17, GELB-GRAU (fig.), EU:T:2018:609, § 32), namely each of the colours, gentian blue (RAL 5010) and yellow green (RAL 6018).
- 36 Not every use of a sign, in particular the use of a combination of two colours, necessarily constitutes use as a trade mark (28/10/2009, T-137/08, Green / Yellow, EU:T:2009:417, § 35).
- 37 The colour blue is a basic, simple and common colour, as correctly stated by the examiner (20/07/2017, T-612/15, RAPPRESENTAZIONE DI TRE STRISCE VERTICALI (fig.), EU:T:2017:537, § 45; 26/10/2022, T-621/21, BLAU, EU:T:2022:676, § 57-60). While it is true that the colour for ecological nature or environmental protection is green (03/05/2017, T-36/16, GREEN STRIPES ON A PIN (col.), EU:T:2017:295, § 14), the colour blue refers, among others, to the planet (Earth) as such, since about two thirds of the Earth's surface consists of water and the Earth therefore appears predominantly blue when viewed from space, which is why it is also called the Blue Planet (14/11/2022, R 1146/2022-1, 1% FOR THE PLANET (fig.), § 46). It is therefore common knowledge that the colour blue stands above all for the colour of the ocean and the sky, and that blue is very often used in the field of the environment to distinguish products that respect the environment (e.g., in the automotive field, all electric or hybrid cars are usually represented by a blue logo; the same applies to the cleanest European beaches which are marked with a blue flag).
- 38 The colour blue is common for goods such as chemicals, solvents, brake fluids, industrial oils, greases etc. That primary colour is not in any way unusual in relation to services such as the repair and maintenance of vehicles or the services of a vehicle service station (04/12/2007, R 1101/2005-1, Blue, § 36). The colour blue is also very common in the field of business, since it indicates confidence, reliability and responsibility (18/10/2019, R 942/2019-5, S T A R Situation Task Action Result (fig.), § 47). The colour blue, including also its shade gentian blue (RA 5010) may thus be perceived as a reference or allusion to the environmentally-friendly characteristics of the goods and services at issue, namely that they have no negative impact upon the Earth's water or air.
- 39 The colour green is also a basic colour, as correctly stated by the examiner (22/07/2022, R 2006/2021-5, GREEN, ORANGE, § 26, confirmed by 04/05/2023, T-618/22, GREEN, ORANGE, EU:T:2023:238). Across the market, the use of the colour green as representing ecology and environmental protection is usual and common (11/04/2013, T-294/10, Carbon green, EU:T:2013:165, § 25; 27/02/2015, T-106/14, Greenworld, EU:T:2015:123, § 24; 28/01/2015, T-655/13, Grün, EU:T:2015:49, § 39-40; 03/05/2017, T-36/16, GREEN STRIPES ON A PIN (col.), EU:T:2017:295, § 45-46; 04/08/2020, R 2707/2019-5, Farbmarke an sich, § 27). At the same time, the colour green – as an antithesis to red, orange or yellow – is a signal colour which stands for the normal, unproblematic, positive or orderly. Green is generally used to indicate processes that work or are permitted (04/08/2020, R 2707/2019-5, Farbmarke an sich, § 27). It is also used to camouflage

buildings, apparatus or people in nature (28/01/2015, T-655/13, Grün, EU:T:2015:49, § 35). The colour green, including also its shade yellow green (RAL 6018), may thus be perceived as a reference or allusion to the environmentally-friendly characteristics of the goods and services at issue, namely that they have no negative impact upon the Earth's vegetation.

- 40 As regards the contested mark in its entirety, it is composed of a combination of two colours which, considered individually, are devoid of distinctive character. There is nothing that indicates that the combination is more than the sum of the elements and that the combination of these two colours would render the contested mark distinctive. Both the colours blue and green are used to indicate ecology and environmental protection. Their combination amounts to nothing more than the reinforcement of the environmentally-friendly connotation of each of the constituent colours.
- 41 In any event, as can be seen from the examples cited by the examiner in the grounds of refusal (see paragraph 4), the use of green or blue or a combination of both is common on the automotive market, and in particular in the field of fuels and vehicle refuelling/recharging stations. Not only does the IR holder use the colour combination green and blue on its products and installations, but also its competitors BAVARIA petrol, Carrefour Gasolinera, and La Asociación de Gasolineras Libres de Andalucía (AGLA).
- 42 For the sake of completeness only, and as a mere supplementary confirmation of the well-known facts that have already been sufficiently demonstrated above (26/07/2023, T-315/22, Sütat, EU:T:2023:432, § 83), reference is made to the findings of an internet search of 3 November 2023:

- <https://www.jemaenergy.com/en/e-mobility/jema-to-supply-ratp-with-more-than-150-chargers-to-electrify-paris-bus-depots/>



- <https://www.walmart.com/ip/PEAK-Blue-32-Ounce-Liquid-All-Season-Cetane-Mileage-Booster-for-Diesel-Engines/289706977>



- https://www.amazon.de/-/en/dp/B09GKSDFS2/ref=emc_b_5_i?th=1



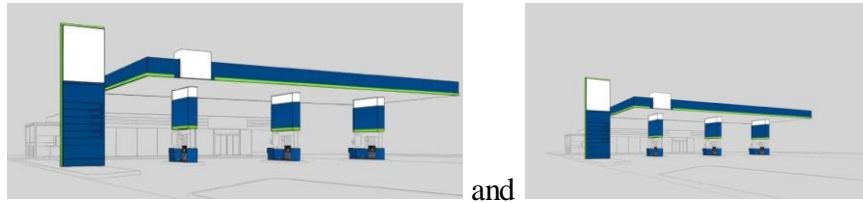
and presented as ‘products related to this item’ on the same link:



- 43 When the colours of which the trade mark is composed are common to the goods or services covered by that mark, they are less likely to indicate the origin of those goods or services (27/09/2018, T-595/17, GELB-GRAU (fig.), EU:T:2018:609, § 60).
- 44 As seen above, it is not rare to come across fuel-related products and vehicle refuelling/recharging stations in the combination of both colours of the contested mark or one of them, or in similar shades of these. Commonly, the colours green or blue or a combination of both will not enable the relevant public to distinguish immediately and with certainty the IR holder’s fuel-related products and vehicle refuelling/recharging stations from other goods and services in the same field in particular marketed by its competitors (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 33; 12/11/2010, T-404/09, colours grey and red, EU:T:2010:466, § 28). Rather, it will perceive the colours claimed as an indication of ecology and environmental protection. The contested mark will not be perceived as an indication of origin and is not distinctive per se.
- 45 It should also be borne in mind that the general public and the trade circles targeted rarely have the opportunity to directly compare the corresponding range of goods and services. When purchasing a fuel-related product and/or visiting a refuelling station, the public will merely assume a further form of representation or decoration but will not recognise a trade mark in the present case.
- 46 In light of the foregoing, a consumer cannot conclude that the colour combination applied for is anything other than a simple colour for fuel-related products and services. Moreover, when applied at a three-dimensional building, such as a vehicle refuelling station, one of the two colours of the claimed colour combination may be invisible since nothing obliges the IR holder to implement systematically both colours, in a concrete arrangement, on all visible sides of the building. The same applies for the application of the contested mark on the various sides of the packaging of the three-dimensional goods at issue.
- 47 In this context, it should also be borne in mind that the ‘raison d’être’ of all advertising, packaging and decorative features consists of ‘being perceived’ or ‘leaving an impression/having an impact on the consumer’. Therefore, the mere effect of attracting the

consumer's attention is not synonymous with distinctive character within the meaning of Article 7(1)(b) EUTMR (23/09/2019, R 121/2019-5, PANTONE 805 C, § 36).

- 48 On account of its simplicity, the sign applied for (colour combination of two simple colours) does not convey a clear message to the targeted public in relation to the goods and services at issue, but rather will be perceived primarily as a decorative element or an embellishment serving aesthetic purposes.
- 49 The IR holder's submissions cannot call these findings into question.
- 50 The IR holder argues that the relevant public has learned over the time that specific filling station operators use different colour coding (without necessarily knowing which operator uses which colour coding) and that, if the colour combination blue and green is applied systematically in an arrangement on filling station buildings (where certain goods and services are provided), then the public establishes a connection to a certain company on the basis of just a specific colour coding that is perceived. This allegation was not substantiated. On the contrary, spontaneously the public, when confronted with the contested colour combination will perceive it immediately and inherently as a mere decoration or embellishment of the visible appearance of the refuelling station or of the packaging of the contested goods, not as a source identifier. In order to arrive at the result alleged by the IR holder, first it would need to 'educate' the public accordingly, through extensive and continuous advertising and promotional efforts. However, the existence and outcome of such 'training' efforts can only be lawfully examined under the conditions of Article 7(3) EUTMR.
- 51 The IR holder also argues that, when the relevant public usually drives up to filling stations from a long distance and at a high speed, and regularly with poor visibility (rain, fog, or snow), initially the consumer naturally perceives the outline of the filling station building, and the colour concept applied. However, under such imperfect conditions impairing their sight while driving, it is impossible for the driver to safely identify the origin of the goods and services offered under the colour combination alone before a word or logo can be recognised. While driving, a driver must focus their observation on the vehicle's trajectory and thus they cannot appreciate the details of a building located on the right-hand side, namely the detailed colours, shades and arrangement of those colours across the visible surface of the buildings. Accordingly, even in the driving situations claimed by the IR holder, the contested mark cannot inherently serve as a source identifier, even if it is assumed that all those details are, under static observation conditions, perfectly visible.
- 52 In other words, a great number of drivers who will be observing from a distance while driving the building views as shown below (which anyway do not correspond to real-life observation conditions, since all other visible parts of the building and of its surroundings are grey-shaded, so as to highlight the blue/green areas) will be unable to even notice the green-coloured lines; even if the drivers were to notice the green-coloured lines, they would be unable to perceive the concrete systematic arrangement between the blue and green colours. Accordingly, no safe trade mark related decision can be made by the relevant consumer on the basis of the contested mark alone; the respective argumentation of the IR holder relates to Article 7(3) EUTMR, which has not been examined by the Office yet:










- 53 In the Board's view, the same conclusion is corroborated by the expert opinion of Univ.-Prof. Dr. Arnd Florack, who has taken into account the market survey of 2022 in Austria (Exhibit J). In particular (emphasis added): (a) as to the question of potential distinctiveness of the colour combination blue green with regard to the identification of a certain service station company, the expert mentioned that 'the assignment to the brand must be distinguished from the assignment to the category *gas stations*. The assignment to the category is presumably given by building design (flat roof and columns) alone. This type of assignment was not tested in the study. The study only addresses the distinctiveness of the colour combination within the category. *It is highly probable that the colour combination only gives a clear indication of the brand if the building itself is recognised as a gas station*'; (b) in the overall assessment, the expert concludes that 'colour design elements are used for differentiation and assignment if they have been *learned* as correspondingly distinctive'.
- 54 The Board further notes that, even if colour information contributes to the identification and naming of objects at a very early stage of the perceptual process, the relevant public does not necessarily attribute to colour information an origin identification function in the sense of trade mark law. It is only after the relevant consumers have learned that specific colour combinations serve as cues to different filling station providers that the educated consumers acquire the capability of identifying filling station companies on the basis of the colour combination alone. This also applies in the specific given situation in road traffic (under more difficult conditions of perception).
- 55 Moreover, the IR holder argues that the colour combination at issue gentian blue (RAL 5010) and yellow green (RAL 6018) had not been used by any other competitor, and that it is the only participant on the relevant oil, gas and filling station market in the EU (in relation to comparable competitors) that uses the specific colour combination, in particular in the specific ratio depicted in the trade mark representation. In this regard, it must be recalled that uniqueness, novelty or originality are not relevant criteria in the assessment of whether a mark has distinctive character (09/09/2020, T-187/19, Colour Purple 2587 C (col), EU:T:2020:405, § 54). Instead, it has to be assessed if the contested mark is perceived as an indication of the commercial origin of the goods. In any event, as can be seen from the analysis above, the colours green or blue or the combination of both are indeed used by competitors on the relevant market.
- 56 The overall submission that the relevant customer circles are well aware that the IR holder only uses the colour combination gentian blue (RAL 5010) and yellow green (RAL 6018) has to be assessed in the context of distinctiveness acquired by use and not in the assessment of inherent distinctiveness per se.


Previous registrations

- 57 Lastly, the IR holder refers to previous EUTM registrations, which it considers to be similar, and which should be considered as indicators for the registrability of the contested


mark. However, decisions concerning the registration of a sign as an EU trade mark are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of these decisions must be assessed solely on the basis of that regulation, as interpreted by the judicature, and not on the basis of a previous decision-making practice of the Office (20/07/2017, T-612/15, RAPPRESENTAZIONE DI TRE STRISCE VERTICALI, EU:T:2017:537, § 71; 30/11/2017, T-101/15 – T-102/15, Blue and Silver (colour mark), EU:T:2017:852, § 97).

- 58 Furthermore, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 77 and the case-law cited).
- 59 The considerations set out above apply even if the sign in respect of which registration as an EU trade mark is sought is composed in a manner identical to that of a mark in respect of which the EUIPO has already approved registration as an EU trade mark and relates to goods or services identical or similar to those in respect of which registration of the sign in question is sought (12/12/2013, C-70/13 P, PHOTOS.COM, EU:C:2013:875, § 45; 07/11/2019, T-240/19, Device of a bell, EU:T:2019:779, § 78; 13/05/2020, T-503/19, Xoxo, EU:T:2020:183, § 59). Consequently, the same principles must apply in the case of earlier signs which are not identical, but at best similar.
- 60 The examples quoted by the IR holder (see above paragraph 6, last indent 7), relate to cases that are not fully comparable to the present case. Indeed, in five examples, the marks consist of three colours, in one example four colours, and each of them contains a very specific description on how the colours are applied to the relevant goods and the parts of vehicle service stations, i.e. EUTM No 18 409 241 , EUTM No 8 178 473 , IR No 1 311 587 designating the EU , EUTM No 8 298 499 , EUTM No 4 358 966 , EUTM No 2 280 899 . A specific description is also included in the two-colour combination EUTM 3 527 579 . The rest of the examples demonstrate more elaborated colour combinations/graphic representations and are registered for different goods, i.e.:




- EUTM No 16 544 141  (Class 5, topical ointment containing emu oil for use in relieving joint or muscle pain);



- IR No 1 313 416  (Classes 32 and 33, *non-alcoholic* and *alcoholic beverages*);



- EUTM No 11 808 573  (Classes 5 and 31, *veterinary preparations* and *animal foodstuffs*).

- 61 In any event, the principle of equal treatment and the principle of good administration must be consistent with respect to legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her advantage and in order to secure an identical decision, on a possibly unlawful act committed to the benefit of someone else (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 76; 03/09/2020, C-214/19 P, *achtung!* (fig.), EU:C:2020:632, § 43).
- 62 The reasons for the refusal are clear and unambiguous in both the contested decision and the present decision of the Board. The Board therefore comes to the conclusion that the prior registrations put forward by the IR holder do not cast doubt on the legality of the refusal at hand.

Conclusion

- 63 For all the reasons stated above, the contested mark clearly falls within the scope of the prohibition laid down by Article 7(1)(b) EUTMR. The appeal is therefore unfounded and dismissed and the contested decision is upheld.

Subsidiary claim to distinctive character acquired through use

- 64 In reply to the examiner's first objection and, again, in the statement of grounds, the IR holder has made a subsidiary claim to acquired distinctive character through use, within the meaning of Article 7(3) EUTMR, and as provided for under Article 2(2) EUTMIR.
- 65 Once this decision has become final, the proceedings will be resumed for the examination of the subsidiary claim based upon Article 7(3) EUTMR and Article 2(2) EUTMIR as regards the objected goods and services.
- 66 The IR holder is to be given the opportunity to submit evidence to substantiate this claim and the evidence already submitted shall also be taken into account. The distinctive character acquired through use of the mark must be demonstrated throughout the territory of the European Union (28/10/2009, T-137/08, *Green / Yellow*, EU:T:2009:417, § 39; 09/09/2020, T-187/19, *colour (shade of colour purple)*, EU:T:2020:405, § 86).

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal.**
- 2. Remits the case to the Examination Division for further prosecution on the IR holder's subsidiary claim under Article 7(3) EUTMR and Article 2(2) EUTMIR as regards the objected goods and services.**

Signed

V. Melgar

Signed

P. von Kapff

Signed

A. Pohlmann

Registrar:

Signed

H. Dijkema

