



EUIPO Academy

Colour combination marks : getting back to WYSIWYG?

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Private and Confidential

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Colour combination per se marks

What are they?

- ▶ "Corporate colours"
- ▶ Brands that can be identified just from the combination of their colours
- ▶ Abstract colours, with no shape or contours
- ▶ Could be in stripes but do not have to be

Why do people try to protect them?

- ▶ Consumers are drawn to colours (e.g. in crowded supermarket shelves and aisles)
- ▶ To maintain distinct business identity and help build brand loyalty
- ▶ Can be very valuable
- ▶ Often longstanding
- ▶ Easily diluted

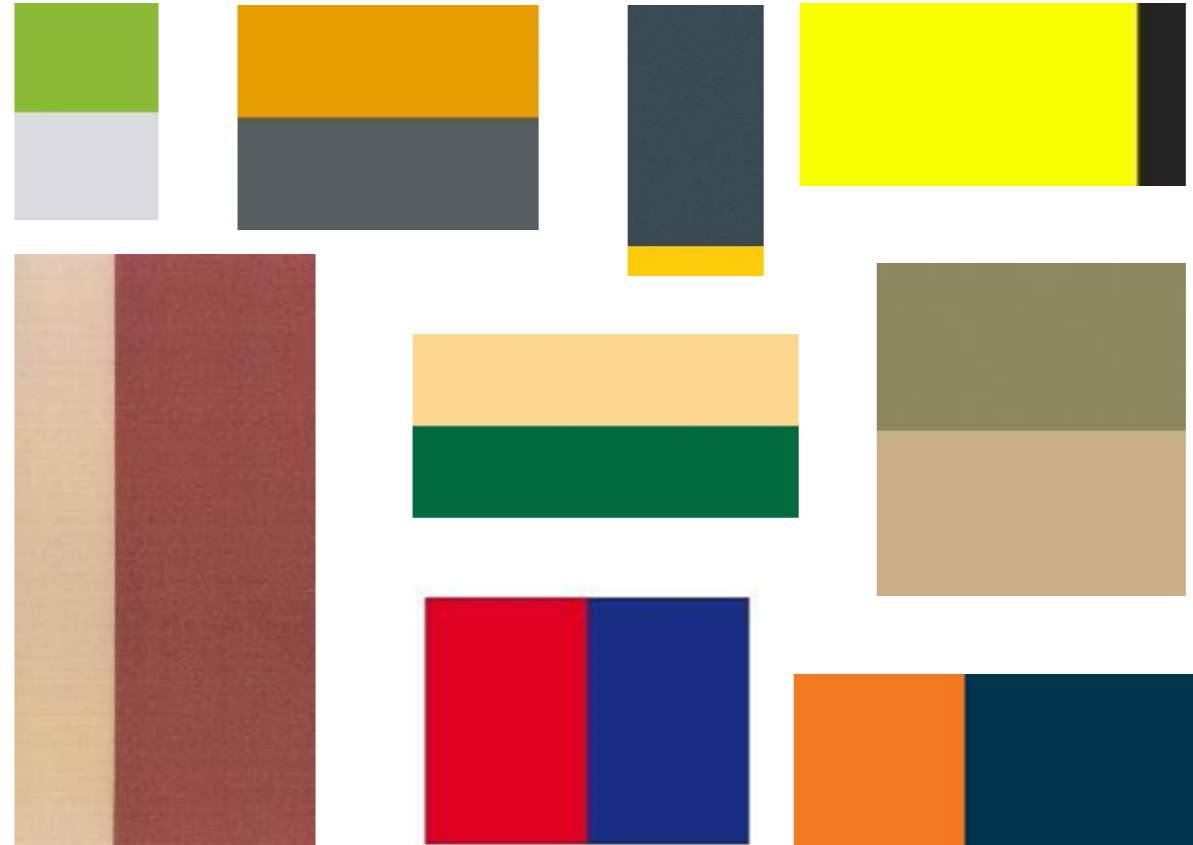


Colour combination per se marks

It's not all about especially famous brands

- ▶ See examples of current two-colour combination marks registered as EUTMs
- ▶ With their owners listed below

Mania Zakład Produkcji - Elematic Oy Ab -
WeltN24 GmbH - Putzmeister Engineering GmbH -
TECMATE INTERNATIONAL S.A./N.V. -
Feldsaaten Freudenberg GmbH & Co. KG -
EVOLUTION INTERNATIONAL S.R.L. -
International Sport Nutrition s.r.l. - Demp B.V.



The EUTM Law

No express reference to colours or combinations of colours as possible EUTMs until revisions of 2016/17:

- ▶ Article 4 EUTM Regulation 2017/1001 "Signs of which an EU trade mark may consist" :
 - > *An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, **colours**, the shape of goods or of the packaging of goods, or sounds*
- ▶ Article 3(3)(f)(ii) EUTM Implementing Regulation 2017/1431 "Representation of the trade mark"
 - > *in the case of a colour mark, (i) where the trade mark consists exclusively of a **single colour without contours**....(ii) where the trade mark consists exclusively of a **combination of colours without contours**...*

Despite this there are hundreds of single colour and colour combination EUTMs on the register

Such signs were expressly recognised as possible to register as trade marks:

- ▶ Article 15(1) TRIPS Agreement (1994): *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.*
- ▶ Council/Commission joint declaration (1996): *Article 2 does not exclude the possibility ...of registering as a trade mark a **combination of colours** or a single colour...provided that they are capable of distinguishing ...*



The challenge of "graphic representation" (old law)

Article 4 EUTM Regulation (old)

- ▶ Must be "a sign", i.e. one sign
- ▶ Must be "capable of graphic representation"
- ▶ Must be "capable of distinguishing" goods/services

Rule 3(3) EUTM Implementing Regulation (old)

- ▶ The application **may** contain a description of the mark.

Rule 3(5) EUTMIR (old)

- ▶ Where registration in colour is applied for, the representation of the mark ...**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.

CJEU case law:

- ▶ Sieckmann (2002) graphic representation must be "**clear**, **precise**, self-contained, easily accessible, intelligible, durable and objective"
- ▶ Libertel (2003)
 - > Colour per se could be a trade mark
 - > **Must** give internationally recognised colour code
- ▶ Heidelberger Bauchemie (2004):
 - > Must be "**precise** and **durable**" (para 32)
 - > Must be "**systematically arranged** by associating the colours concerned in a **predetermined and uniform way**" (para 33)

Subsequent application/interpretation:

- > No GC/CJEU case law on this Article 4 point for 13 years
- > EUIPO practice and Guidelines



Development of EUIPO Guidelines

Applicants "free to use [their] own description" of the colours and ensure that the image was consistent with that.

Version 1: Pre-Libertel

Colour **must** be represented "without contour" and proportion of colours **must** be specified together with "**how they will appear**" [*somewhat vague and no reference to appearance on products*]

Version 3 (2008)

What is protected is shade of colour(s) and their ratio and position, which **must** be systematically arranged by associating them in predetermined and uniform way. Image **must** "spatially delineate" colours so as to determine the scope of the right and **must** "clearly indicate proportion and position of the various colours". Example given distinguishing yellow stripe above red from red/yellow side by side. Repeats Version 2 text in purple.

Version 5 (2016) – post-revisions

Version 2 (2006) – post-Libertel/HB

The GR "as filed will determine the mark, including the proportion and position of the various colours, which shall be clear from the representation ("**WYSIWYG**, what you see is what you get)." Indication of how colour would appear on product not required. "What matters is subject-matter of the registration, not the way it is or can be used on the product."

Version 4 (2015)

Colours **per se** means that TM protection is sought "**regardless of any specific shape or configuration.**" Protection is given to shade of the colour(s) and... "**the ratio in which the colours are distributed.**" Proportion must be specified in description. Mark "**may** be represented by showing the colour or colours as they will be applied to something. In such cases, a mark description is required to clarify the nature of the mark"

Development of EUTM filing, examination and opposition practice

EUIPO examiners must apply the Guidelines strictly

Unsurprisingly, most EUTM applicants for colour combination marks sought to do so as well

- ▶ Most depict the colours in **blocks or stripes** (examples shown earlier)
- ▶ Nearly all identify the colours by reference to Pantone® or equivalent **recognised codes** (following *Libertel*)
- ▶ Most **state the proportions** with precision, e.g. Duracell's EUTM no. 8148934 with description "colours copper and black in relationship of 1/3 copper and 2/3 black" (and with Pantone numbers given)
- ▶ Some include the words "approximately", "around" or "roughly", e.g. EUTM no.12047544 (dark blue and red)
- ▶ Some do not even state the proportions but this is apparent from the image, Ikea's EUTM no.4638177 for yellow and blue

These sorts of EUTMs have been relied on in many oppositions, including at least 8 Board of Appeal decisions

- ▶ Implied assumption that the subject matter of the registration was sufficiently clear to be relied upon
- ▶ E.g. Case R-828/2012-1 relying on EUTM 9566051 (blue/black combination)

...and then there was Red Bull...

Red Bull EUTMs (by filing date) registered on basis of acquired distinctiveness



2002 - "Indication of colour – ID591" : "*the ratio of the colours is approximately 50% - 50%*"

2010 - "Description – ID571" : "*the two colours will be applied in equal proportion and juxtaposed to each other*"

Optimum applies to cancel both

- ▶ October 2013 cancelled by the Cancellation Division
- ▶ December 2014 cancellations upheld by Board of Appeal
- ▶ November 2017 cancellations upheld by General Court, with intervention by MARQUES
- ▶ CJEU appeal by Red Bull pending

Key issues

- ▶ Compliance with Article 4 "graphical representation" and interpretation of *Heidelberger Bauchemie*
- ▶ Breach of principles of
 - > equal treatment of different types of trade marks
 - > proportionality from overly strict interpretation of *Heidelberger Bauchemie*
 - > legitimate expectations in light of prior Guidelines, examination practice and Board of Appeal/GC decisions



Heidelberger Bauchemie (CJEU – 2004)

German TM application (1995) for colour combination blue/yellow for solvents etc. used in the building trade

- ▶ Colours identified with RAL numbers
- ▶ "The trade mark applied for consists of the applicant's corporate colours which are used **in every conceivable form**, in particular on packaging and labels"

German court referred questions, in particular

- ▶ Do colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours and in shades which are named ... satisfy the conditions for capability of constituting a trade mark for the purposes of Article 2?
[NB no reference to "in every conceivable form"]



Answer:

- ▶ Yes they can [**important acceptance that abstract colour marks can potentially be registrable in principle**] where
 - > it is established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and
 - > the application...includes a systematic arrangement associating the colours concerned in a predetermined and uniform way



Interpretation of Heidelberger Bauchemie and the Red Bull decision

Apart from lack of clarity in para 33 terms "systematically arranged" and "predetermined and uniform way":

- ▶ 34 The **mere juxtaposition** of two or more colours, without shape or contours, **or** a reference to two or more colours 'in every conceivable form', **as is the case with the trade mark which is the subject of the main proceedings**, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive, as construed in paragraphs 25 to 32 of this judgment.
- ▶ 35 **Such** representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.

GC in Red Bull case rejected Red Bull/MARQUES's arguments and concluded that

- ▶ Para 34 and 35 of *Heidelberger Bauchemie* do apply to the RB type of marks
- ▶ The three principles of proportionality, equal treatment and legitimate expectation had not been breached

General Court's primary position

- ▶ The graphic representation of the RB marks are a "mere juxtaposition" of two colours, **allowing "numerous different combinations"**
- ▶ The descriptions do not provide precision on the systematic arrangement **"from which it might be inferred"** that there is only one arrangement, and so again allowing "numerous different combinations"
- ▶ The **nature of colour combination per se marks**, "where the systematic arrangement is not apparent", means that an "explicit description" is needed to more clearly define the subject matter of "the protection afforded" by such marks



Is the "nature" of two-colour combination marks so different from word marks?

VW (word mark)

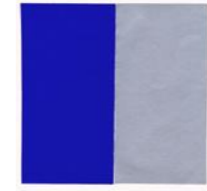


Questions to consider from Red Bull decision

General Court effectively reads "in every conceivable form" into RB's description

1. Is this giving too little weight to the EUTM image and too much to the words?
2. Does this ignore the "WYS" element of the WYSIWYG principle? – **see test**
3. Should there be a test of how would a reasonable person interpret the combination of the image, as read with (but not expanded by) the description?
4. Could the image be interpreted as a single sign, being two monolithic and shapeless "blobs" of each colour that are touching and of equal sizes?
5. Where a survey is done using the image, should positive results be taken to show that consumers must perceive something singular and consistent as otherwise they could not attribute a common source to it?
6. Is it appropriate to take into account the applicant's actual use when the survey is not done on that arrangement and instead shows that consumers have come to recognise the colours just in the generic block/"blob" arrangement?
7. Should account be taken of the applicant's view that its mark confers protection covering different arrangements and not just the two vertical block arrangement?
8. Should "WYG" and scope of protection play any part at this registration stage?
9. Should the fear of conferring disproportionate competitive advantage with such registrations look at what advantage has been conferred in fact since registration?

When you look at this:



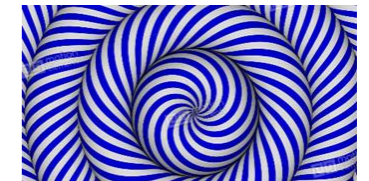
Do you see this?



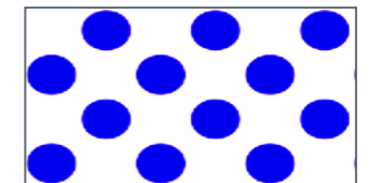
Or perhaps this?



Or this?



Or this?



The post-graphical representation world

Overall intention was to codify and reflect existing case law and practice

- ▶ Article 4(b) CMTR sets the test of enabling "*the competent authorities and the public to determine the **clear and precise***" subject matter of the protection.
- ▶ Article 3(1) CTMIR : *The trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the register in a **clear, precise**, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public **to determine with clarity and precision** the subject-matter of the protection afforded to its proprietor.*
- ▶ Article 3(2) CTMIR2 : *The **representation of the trade mark shall define the subject matter of the registration**. Where the representation is accompanied by a description pursuant to paragraph 3(d), (e), (f)(ii), (h) or paragraph 4, such description shall accord with the representation **and shall not extend its scope**.*
- ▶ Article 3(3)(f)(ii) CTMIR ..."*where the trade 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."*

Does this change things?

- ▶ Arguably Article 3(2) codifies WYSIWYG: the image prevails – need for case law to determine when there is accord or extension
- ▶ Article 3(3)(f)(ii) retains the optional description for colour combinations - General Court in Red Bull makes it mandatory



Conclusions

Single colour trade marks are easier to satisfy Article 4 requirements and so are much easier to register

- ▶ And yet they grant a much wider monopoly
- ▶ Many more possible two-colour combinations

Various cases pending may lead to greater clarity

- ▶ Red Bull appeal to CJEU
- ▶ Reference to CJEU from Finish Supreme Administrative Court re Oy Hartwall's "colour per se" national TM application below



- ▶ Possible references to come out of pending UK litigation GSK v Sandoz relating to "colour per se" EUTM for mark below





Thank you for listening.

Questions?

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