

GETTING TECHNIC WITH COLOR: GRAPHIC REPRESENTATION OF COLOR TRADEMARKS IN THE NEW EUROPEAN LEGISLATION ON TRADEMARKS

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Abstract

The paper looks at the changes operated in the very final part of last year to the Trademark Directive and EU Trademark Regulation in order to ascertain some of the effects the change in terms of trademark definition and, especially, graphical representation of colors has produced.

We have analyzed how representing graphically colors has become the crux of determining the possibility to registering color trademarks and how different states have tried to accommodate the need to have an as-wide-as-possible category of registrable signs with the need for legal certainty.

Keywords: *color, trademark, application, registration, procedure, graphical representation.*

1. Introduction

1.1. New laws before the New Year

In the last days of 2015 (23 and 24 December) the Official Journal of the European Union published two new enactments that would modify the European trademark landscape: a new Directive – 2015/2436 – to approximate the laws of the Member States relating to trade marks (and replace the codified Directive 2008/95) and Regulation 2015/2424 (amending Regulation 207/2009 on the Community trade mark and Regulation 2868/95 which had implemented Regulation 40/94 on the Community trade mark).

While the regulation is directly applicable in all member states as of its entry into force, the directive requires that member states transpose its provisions within the deadline set by the directive itself.

Article 4 of Regulation 2015/2424 provides that its provisions shall enter into force on 23 March 2016 except for some which are to take effect from 1 October 2017 and one specific provision will take effect not later than 1 October 2018.

In its turn, article 54 of the Directive provides that member states are to transpose its provisions in their national laws not later than 14 January 2019 with the exception of article 45 which is to be transposed by 14 January 2023. Article 55 indicates that Directive 2008/95 is repealed with effect from 15 January 2019.

Therefore, by means of the above-mentioned enactments, the EU has altered the trademark regime in Europe, in what concerns EU trademarks (the change in denomination being one such alteration)

with quasi-immediate effect and in what concerns national trademark laws, with a delayed effect, depending on the transposition of the provisions and deadline for such.

1.2. The change in representation

Among the changes brought by these two new acts is the enactment of a new article 3 of the Directive which provides for a significant change from the provision as existing in article 2 of Directive 2008/95 and the amendment of article 4 of Regulation 207/2009.

As per article 4 of Regulation 2015/2424, the amendment of art. 4 of Regulation 207/2009 is to take effect from 1 October 2017 only, therefore bringing it closer to the deadline for transposition of the provisions of Directive 2015/2436.

The change that interests the present article is the following:

1.3. The significance of the change with respect to color trademarks

The change identified is obviously significant with respect to non-traditional trademarks. This is evident, given that the Explanatory Memorandum of the Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Recast)¹ states that “[a]t present, signs must be capable of being represented graphically in order to be protected as a trade mark. This requirement of ‘graphic representability’ is out of date. It creates a great deal of legal uncertainty around the representation of certain non-traditional marks, such as mere sounds”. The Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on

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¹ European Commission „Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Recast)”, COM/2013/0162 final - 2013/0089 (COD), p. 5.

Directive 2008/95 – art. 2	Regulation 207/2009 – art. 4
A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.	A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
Directive 2015/2436 – art. 3	Regulation 2015/2424 – art. 4
A 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, provided that such signs are capable of: (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.	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, provided that such signs are capable of: (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the Register of European Union trade marks, (“the Register”), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

the Community trade mark² contains a quasi-identical statement: “Article 4 is amended to remove the requirement of ‘graphic representability’. The prerequisite that it should be possible to produce a graphic representation of the sign applied for is out of date. It creates a great deal of legal uncertainty with regard to certain non-traditional marks, such as mere sounds”.

But non-traditional trademarks refer to more than sounds. AIPPI has advanced the proposition that ‘non-conventional’ trademarks include (without being limited to) colors, shapes, sounds and smells³. Other authors⁴, naming such ‘exotic’ marks, refer to sounds, shapes, colors, smells, gestures etc. Yet another author, when talking about “extensions of trademarks beyond traditional word marks and design marks (logos; trade dress [get-up]) to the more controversial categories” mentions “product shape, colors, sounds, smells, tastes and touch”⁵.

The change thus made has affected all types of non-traditional trademarks, not just sounds, and among those types of sign mentioned in all the above

listings of ‘non-traditional’ trademarks, there is the category of colors.

The present article will deal with effects the change will have on the registration and protection of color trademarks, an important topic, given the fact that color trademark applications rank second in number of ‘non-traditional’ trademark applications at the OHIM, though with a very small percentage of actual applications (less than 0.05% of applications)⁶.

2. Content

2.1. From black to black and white

Historically, color trademarks per se could not be registered in most countries.

In Germany, a color per se was deemed not to meet the legal conditions to be registered as a trademark⁷, that having been the position of the German courts for a long time⁸ also in respect of

² European Commission „Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark”, COM/2013/0161 final - 2013/0088 (COD), p. 7.

³ AIPPI, “Resolution on Question Q 181 - Conditions for registration and scope of protection of non-conventional trade marks” in AIPPI *Yearbook*, vol. I, 2004, pp. 579-580.

⁴ Lionel Bently, Brad Sherman *Intellectual Property Law*, 4th ed., Oxford University Press (Oxford, 2014), p. 893.

⁵ Jane C. Ginsburg ““See me, feel me, touch me, hea[r] me” (and maybe smell and taste me too): I am a trademark – a US perspective” in Lionel Bently, Jennifer Davis and Jane C. Ginsburg (eds.) *Trade Marks and Brands. An Interdisciplinary Critique*, Cambridge University Press (Cambridge, 2008), p. 92.

⁶ Lionel Bently, Brad Sherman *Intellectual Property Law*, 4th ed., Oxford University Press (Oxford, 2014), p. 893, note 42.

⁷ Peter Mes “Bericht Q 96 für die Deutsche Landesgruppe” in AIPPI *Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 15.

⁸ Bundespatentgerichtshof in Ständiger Rechtsprechung, Z.B., in *GRUR* 1979, p. 835, 855 (LILA) cit. in Peter Mes “Bericht Q 96 für die Deutsche Landesgruppe” in AIPPI *Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 15.

color combinations⁹. The position was identical in Brazil¹⁰ and Canada¹¹.

In other countries, where color combinations were allowed registration, colors per se were still not able to be registered as trademarks. This was the situation in Spain where, exceptionally, color combinations were allowed registration as trademarks but only for “bull rosettes aimed at distinguishing the bulls or in the making of selvages on cloths”¹² but colors per se were still denied registration (even though there was a proposed amendment that would have allowed registration of colors where such were delimited by a certain shape – but such would not have qualified as a color trademark per se).

In Finland colors per se were not allowed registration but color combinations could be so registered¹³. Hungary presented the same situation, with color combinations specifically allowed by law (article 2.2 of the Hungarian Law on Trademarks) but with colors per se denied registration¹⁴. In Italy color combinations were allowed where “precisely described”, which made such no different from figurative signs in color, but colors per se were not (however colors could be protected under unfair competition provisions where such would grant distinctiveness unto a product or its packaging)¹⁵. In Mexico, while color combinations were allowed with no express provisions authorizing such, the registration of colors per se was expressly forbidden by the law (art. 91 sec. IV)¹⁶. The same applied in Portugal, where art. 79 (2) of the Industrial Property Code expressly excluded colors per se from registration¹⁷. In Norway, the registration of color combinations was allowed where such combination would grant distinctiveness to the sign but colors per se were always denied registration¹⁸. Similarly, in

New Zealand, registration of color combinations was allowed “subject to definition of the relative prominence of the respective colours, by way of representation”¹⁹.

In yet other countries, the position was not yet clear, this being the case in Israel²⁰ and Japan (where color combinations were allowed but only where in a defined/fixed form, i.e. closer to classic figurative trademarks)²¹.

In Denmark²², though the position was that there can be no registration of a color trademark, jurisprudentially the courts have held that a color applied to a product may generate an exclusive right through use (the case of blue scaffolding where the court had apparently denied infringement on account of the fact that the color nuances were different²³).

In the United States colors (either per se or in combinations) would not be normally registered as trademarks except where there would be “an extremely strong showing that the relevant purchasing public attributes trademark significance to the color or colors”²⁴. Special circumstances were also required in the United Kingdom for a color per se to gain registration (such as Blue for paraffin) while the visible surface of the goods, fully covered by a single color, was held to also be registrable in certain circumstances²⁵. The position in Ireland was similar, in that it allowed both the registration of color combinations and colors upon evidence of use²⁶.

In Sweden single colors could not normally be registered (even though color combinations were allowed) but such result could be, in theory, achieved after extensive use²⁷. A similar position was adopted in Switzerland where combinations of colors were allowed if distinctive (i.e. well established on the market), base colors were denied but specific nuances were, theoretically, registrable upon a

⁹ Bundespatentgericht 7, 137, 139 (WHITE-RED) cit. in Peter Mes “Bericht Q 96 für die Deutsche Landesgruppe” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 15.

¹⁰ “Report on Q 96 on behalf of the Brazilian Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 34.

¹¹ R.M. Perry, D. Burwash, R. Carson “Report on Q 96 on behalf of the Canadian Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 39.

¹² “Report on Q 96 in the name of the Spanish Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 55.

¹³ Sirkka-Liisa Lahtinen, Virpi Tiili, Marja Tommila “Report on Q 96 in the name of the Finnish Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 74.

¹⁴ “Rapport sur Q96 au nom du Groupe Hongrois” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 103.

¹⁵ M.E. Boitani, M.G.F. Dragotti, M.G. Pellegrino, M.A. Perani “Rapport sur Q96 au nom du Groupe Italien” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 116.

¹⁶ Mariano Soni “Report on Q 96 in the name of the Mexican Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 123.

¹⁷ “Report on Q 96 in the name of the Portuguese Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 145.

¹⁸ Henry Bakke, Per A. Martinsen, Helge Stensland “Report on Q 96 in the name of the Norwegian Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 127.

¹⁹ “Report on Q 96 in the name of the New Zealand Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 130.

²⁰ Aman Gabrieli “Report on Q 96 in the name of the Israel National Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 111.

²¹ “Report on Q 96 on behalf of the Japanese Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 121.

²² Jette Sandel “Report on Q 96 in the name of the Group of Denmark” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 47.

²³ In *UFR 1962*, p. 860 cit. in Jette Sandel “Report on Q 96 in the name of the Group of Denmark” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 47.

²⁴ Daniel D. Fetterley “Report on Q 96 in the name of the American Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 70.

²⁵ “Report on Q 96 in the name of the British Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 98.

²⁶ “Report on Q 96 in the name of the Irish Group” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 55.

²⁷ Annika Ryberg, Gunnar Sundkvist, Bo Wretling “Report on Q 96 in the name of the Group of Sweden” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 172.

showing of distinctiveness by having been well established on the market²⁸.

It was only in a minority of countries that colors per se were normally allowed registration as trademarks. In Belgium both colors per se and color combinations could be registered as trademarks where they had not become ordinary at the filing date²⁹. The situation was the same in the Netherlands where colors per se³⁰ and color combinations³¹ were allowed registration upon a show of distinctiveness (taken in this case to mean that they were widely recognized by the public as distinctive for the given product)³².

In France the registration of color combinations was provided by law while the registrability of colors per se was a product of jurisprudence³³. However, not base colors but only shades of a color could be registered and these shades needed to be precisely defined so as not to extend the protection to the whole color as registration of a shade was not to preempt use of a different shade of the same color by a competitor³⁴.

Promoting an expansion of the 'registrable trademark', AIPPI proposed in 1989 that "colour per se should be registrable when it is or has become distinctive"³⁵.

In Romania, Law no. 28/1967 concerning manufacturing, trade and service marks³⁶ ("1967 Trademarks Law") expressly provided at art. 2 par. (2) that "trademarks can consist of ... one or more colors, ... or other similar elements". The Decision of the Ministers Council no. 77/1968 for the implementation of the 1967 Trademark Law, provided, at art. 6 letter d), that the application is to be accompanied by 10 reproductions of the sign where a certain color or color combination is claimed as a component of the trademark, in such case the reproductions to be supplied would have to reproduce the colors of the mark.

This would seem enough to conclude that, under the 1967 Trademark Law, colors per se could be registered as trademarks. However, the literature has indicated that, at the time, both authors and courts have held that a single color may not be registered as a trademark³⁷. Moreover, the Instructions issued by the former General Directorate for Metrology, Standards and Inventions, concerning the application of the 1967 Trademarks Law and of the Decision of the Ministers Council no. 77/1968 for the implementation of the 1967 Trademark Law³⁸ had also established that a single color was not distinctive enough to be registered as a trademark³⁹.

The situation in Romania had not changed by 1998 with the entry into force of the new trademarks law no. 84/1998 ("1998 Trademarks Law") which provided, at art. 3 letter a) that trademarks may "consist of distinctive signs such as ... color combinations" even though the literature had expressed the view that registration of a color per se could be, under condition of distinctiveness acquired by extensive use, registered as the enumeration in the law is not limitative⁴⁰.

What is to be noted is that the practice of national offices differed and there was no guidance that could generate some predictability in respect of applications for color trademarks.

2.2. The code of colors

Over the next 10 years things changed in respect of color trademarks. At the Eighth Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications⁴¹ the Committee had proposed that further discussion be made in respect of, among others, the definition of a mark, indicating that „Provisions could be proposed to give a more complete and broader definition of a mark, for

²⁸ "Bericht Q96 im Namen der Schweizergruppe der AIPPI" in AIPPI *Annuaire* 1988, vol. VIII, AIPPI (Zurich, 1988), p. 177.

²⁹ Louis Van Bunnin, D. Crassaerts, J. Vigneron, Louis De Roover, Jacques Rosenoer, Fl. Gevers "Rapport sur Q96 au nom du groupe belge" in AIPPI *Annuaire* 1988, vol. VIII, AIPPI (Zurich, 1988), p. 30.

³⁰ Benelux Court of Justice, decision of 9 March 1977 – *Blue color of Camping Gaz tank* in *NJ* 1978, p. 416 cit. in R.E.P. de Ranitz, Ch. Kik, R. Laret, E.A. Mout-Bouwman, A.A.M. Reijns-Kouwenaar, J.H.H. de Carpentier Wolf "Report on Q 96 in the name of the Group of the Netherlands" in AIPPI *Annuaire* 1988, vol. VIII, AIPPI (Zurich, 1988), p. 135.

³¹ Benelux Court of Justice, decision of 5 February 1977 – *Red/black capsules* in *NJ* 1978, p. 415, Benelux Court of Justice, decision of 27 August 1981 – *Rainbow colours* in *BIE* 1982, p. 136, both cit. in R.E.P. de Ranitz, Ch. Kik, R. Laret, E.A. Mout-Bouwman, A.A.M. Reijns-Kouwenaar, J.H.H. de Carpentier Wolf "Report on Q 96 in the name of the Group of the Netherlands" in AIPPI *Annuaire* 1988, vol. VIII, AIPPI (Zurich, 1988), p. 136.

³² R.E.P. de Ranitz, Ch. Kik, R. Laret, E.A. Mout-Bouwman, A.A.M. Reijns-Kouwenaar, J.H.H. de Carpentier Wolf "Report on Q 96 in the name of the Group of the Netherlands" in AIPPI *Annuaire* 1988, vol. VIII, AIPPI (Zurich, 1988), pp. 135-136.

³³ "Rapport sur Q96 au nom du Groupe français" in AIPPI *Annuaire* 1988, vol. VIII, AIPPI (Zurich, 1988), p. 92.

³⁴ *Idem*, p. 93.

³⁵ AIPPI "Resolution on Question Q92 C and Q96 Q92: Absolute grounds of refusal of registration of trademarks Q96: What may constitute a registrable trademark?" in AIPPI *Yearbook* 1989 vol. II, p. 316.

³⁶ Published in *Buletinul Oficial* no. 114/29.12.1967.

³⁷ Yolanda Eminescu *Mărcile de fabrică, de comerț și de serviciu*, Editura Academiei Republicii Socialiste România (Bucharest, 1974), p. 52.

³⁸ Published in *Invenții și Inovații*, 1968, no. 5, p. 174.

³⁹ Yolanda Eminescu *Mărcile de fabrică, de comerț și de serviciu*, Editura Academiei Republicii Socialiste România (Bucharest, 1974), p. 53.

⁴⁰ Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan *Dreptul proprietății intelectuale. Dreptul proprietății industriale. Mărcile și indicațiile geografice*, All Beck (Bucharest, 2003), pp. 55-56.

⁴¹ WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications „Suggestions for the Further Development of International Trademark Law”, SCT/8/3, 26 April 2002.

example by going beyond current definitions such as “visible signs” (Article 2(1)(a) TLT). The provisions could build on Article 15(1) of the TRIPs Agreement in providing that Members “shall” require, as a condition of registration, that signs be visually perceptible, or capable of being represented graphically, depicted or described by written notation, diagram or any other visual means. They also could expressly include hologram marks, sound marks and olfactory marks”. At the Ninth Session of the Committee a Questionnaire was proposed, and it was revised at the Eleventh Session. When answers to the revised questionnaire were reviewed, at the Fourteenth Session of the Committee out of the 73 valid answers provided, 45 countries indicated that it was possible to register a single color as a trademark there and 68 that it was possible to register a color combination as a trademark. The group of 45 countries that now indicated that they allowed the registration of a single color as a trademark included Germany, Canada, Spain, Finland, Hungary, Italy, Norway, New Zealand, Israel, the United States, the United Kingdom, Ireland, Sweden, Switzerland, Belgium, France and the Netherlands.

Brazil, Mexico, Portugal, Japan indicated that it was still not possible to register a single color as a trademark while the position had become unclear in Denmark.

Interestingly, in spite of the position taken by the literature, the official position in Romania in 2005 was that it was not possible to register a color trademark *per se*.

The change in position was probably most striking in Germany where there had been for many years attempts to register color trademarks⁴² and where, starting with 2002, there was an increasing number of applications for such trademarks and over 20 of those had been successful by 2004⁴³.

This momentum for registering single colors as trademarks was linked⁴⁴ to the decision of the CJEU (under its previous denomination) in *Libertel*⁴⁵.

This was a CJEU case concerning the registrability of a color *per se*⁴⁶ in which the Hoge Raad had referred the following questions: “(1) Is it possible for a single specific colour which is represented as such or is designated by an internationally applied code to acquire a distinctive character for certain goods or services within the

meaning of Article 3(1)(b) of the Directive? (2) If the answer to the first question is in the affirmative: (a) in what circumstances may it be accepted that a single specific colour possesses a distinctive character in the sense used above? (b) does it make any difference if registration is sought for a large number of goods and/or services, rather than for a specific product or service, or category of goods or services respectively? (3) In the assessment of the distinctive character of a specific colour as a trade mark, must account be taken of whether, with regard to that colour, there is a general interest in availability, such as can exist in respect of signs which denote a geographical origin? (4) When considering the question whether a sign, for which registration as a trade mark is sought, possesses the distinctive character referred to in Article 3(1)(b) of the Directive, must the Benelux Trade Office confine itself to an assessment in abstracto of distinctive character or must it take account of all the actual facts of the case, including the use made of the sign and the manner in which the sign is used?”⁴⁷.

In his Opinion, AG Léger, importantly noted that the Joint Declaration of the Council of the European Union and the Commission appearing in the minute of the meeting of the Council at which the Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks⁴⁸ was adopted and in which it was stated that “the Council and the Commission consider that Article 2 [of the Directive] does not exclude the possibility: of registering as a trade mark a combination of colours or one colour alone ... provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings” does not have legal force.

The AG held that “[c]onsideration of the scheme of the Directive and the purpose underlying the requirement in question also suggests that a colour *per se* should not be a sign capable of constituting a trade mark”⁴⁹. He founded his opinion on the following reasoning: Since protection of the trademark is to be granted upon registration, it is upon registration that a number of conditions are to be fulfilled⁵⁰. Since these conditions are to be examined before registration, independently of any use of the sign, these are to be weighed in consideration of the sign as described in the application⁵¹. Therefore the sign as filed must allow

⁴² Bundespatentgerichtshof in Ständiger Rechtsprechung, Z.B., in *GRUR* 1979, p. 835, 855 (LILA) cit. in Peter Mes “Bericht Q 96 für die Deutsche Landesgruppe” in *AIPPI Annuaire 1988*, vol. VIII, AIPPI (Zurich, 1988), p. 15

⁴³ “On the Art of Protecting a Color as a Trademark” in *Markenbusiness*, 9 November 2004, <<http://www.markenbusiness.com/en/news.php?newsid=1722>>

⁴⁴ *Idem*.

⁴⁵ CJEU, *Libertel Groep BV v. Benelux-Merkenbureau* (C-104/01), 6 May 2003 in *ECR-I* p. 3793.

⁴⁶ See Spyros Maniatis, Dimitris Botis *Trade Marks in Europe: A Practical Jurisprudence*, 2nd ed., Sweet & Maxwell (London, 2006), p. 70.

⁴⁷ *Idem*, par. 20.

⁴⁸ Published in *OJ* 1989, L 40, p. 1.

⁴⁹ Opinion of AG Léger of 12 November 2002 in case *Libertel Groep BV v. Benelux-Merkenbureau* (C-104/01), *ECLI:EU:C:2002:650*, par. 55.

⁵⁰ *Idem*, par. 56.

⁵¹ *Idem*, par. 58.

a precise determination of what is claimed protection for, which means that the requirement of the sign being capable of being represented graphically is based on the principle of legal certainty⁵² (quoting the Opinion of the AG in *Sieckmann*⁵³). He concluded that the graphic representation must meet two conditions: “First, the representation must be clear and precise in order that one may know beyond any possible doubt what it is that is being given the benefit of exclusive rights. Secondly, it must be intelligible to persons wishing to inspect the register, namely other manufacturers and consumers. It should not be necessary to go to inordinate lengths to ascertain what sign the applicant will actually use”⁵⁴. Finally, he concluded that colors per se did not meet either of these conditions: “the reproduction or designation of a colour in itself does not provide any means of determining what sign the applicant proposes to use in order to distinguish his goods and services”⁵⁵ and “registration of a colour *per se* as a trade mark would not allow other traders inspecting the register to determine what their rights were”⁵⁶.

The AG went on to state that a color per se could not have an intrinsic distinctive character⁵⁷ mainly because it can’t “be defined in a way that is sufficiently precise that it indicates without any possible confusion the origin of goods or services”⁵⁸.

In its judgment in *Libertel* the court indicated that “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”⁵⁹.

With regard to graphic representation of the color, the court established that the *Sieckmann* criteria would need to be met in order for its function to be fulfilled, to which end a mere sample of the color (which could deteriorate in time) would not suffice⁶⁰, but a verbal description or a combination of sample and description could (if it were clear, precise, self-contained, easily accessible, intelligible, and objective)⁶¹ just as a “designation of a colour using an internationally recognised identification code may be considered to constitute a graphic representation”⁶².

Importantly, the court also noted that “there is, in Community 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. The greater the number of the goods or services for which the trade mark is sought to be registered, the more excessive the exclusive right which it may confer is likely to be, and, for that very reason, the more likely is that right to come into conflict with the maintenance of a system of undistorted competition, and with the public interest in not unduly restricting the availability of colours for the other traders who market goods or services of the same type as those in respect of which registration is sought”⁶³ and that “registration as a trade mark of a colour per se is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of the particular case, to assessing both the distinctive character of the colour in respect of which registration is sought, and whether its registration would run counter to the general interest in not unduly limiting 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”⁶⁴.

Following the court’s judgment in *Libertel*, the President of EUIPO (under its former denomination) issued Communication No 06/03 of the President of the Office of 10 November 2003 concerning colour marks, by means of which the Office indicated that “In accordance with Rule 84 (1) of the Implementing Regulation (CTMIR) the Register of Community Trade Marks is, in practice, kept in electronic form. The representations of all trade marks, except word marks, are scanned and stored electronically. The question of durability addressed by the Court does not, therefore, arise in respect of Community trade marks. Nevertheless, the Office would recommend that where registration for a colour mark per se is applied for the indication of the colour required under Rule 3 (5) CTMIR should where possible include a designation from an internationally recognised identification code. Where such an indication is not possible, for example because the

⁵² *Idem*, par. 61-62.

⁵³ CJUE, Ralf Sieckmann v. Deutsches Patent- und Markenamt (C-273/00), decision of 12 December 2002 in *ECR-I* p. 11737.

⁵⁴ Opinion of AG Léger of 12 November 2002 in case *Libertel Groep BV v. Benelux-Merkenbureau* (C-104/01), *ECLI:EU:C:2002:650*, par. 64, cit. omitted.

⁵⁵ *Idem*, par. 66.

⁵⁶ *Idem*, par. 73.

⁵⁷ *Idem*, par. 84.

⁵⁸ *Idem*, par. 88.

⁵⁹ CJEU, *Libertel Groep BV v. Benelux-Merkenbureau* (C-104/01), 6 May 2003 in *ECR-I* p. 3793, par. 27.

⁶⁰ *Idem*, par. 33.

⁶¹ *Idem*, par. 34-36.

⁶² *Idem*, par. 37.

⁶³ *Idem*, par. 55-56.

⁶⁴ *Idem*, par. 71.

colour or shade of colour does not exist in the coding system, appropriate indications to this effect may be made under the aspect of "indication" pursuant to Rule 3 (5) CTMIR. The Office is of the view that the indication of the colour code as well as any description are formalities which should not be confused with the examination for distinctiveness, which will be based on the colour mark as represented in the database of the Office and the goods and services for which registration is claimed. As regards colour marks per se filed before the date of this communication or already registered, the Office will accept clarifications as to the indication seeking to add a colour code indication or an explanation for the absence of such colour code indication".

As can be seen from the above, the Communication of the President seems to have taken the CJEU's decision in *Libertel* as clearly allowing the registration of colors *per se* as trademarks and, with respect to the condition of susceptibility of graphic representation, has noticed that there needs to be no change made to the EUTM registration process, since the electronic storage of the applications would allow for a retrieval of the sample unaffected by time.

The Communication obviously ignores all the concerns the Court and the AG had expressed with regard to the difficulty in such signs fulfilling the functions of a trademark and in clearly delimiting the exclusive rights granted, all this with potential detrimental effect on the legal certainty of third parties.

These concerns were however mentioned in the Working Guidelines on Q 181 ("Conditions for registration and scope of protection of non-conventional trademarks") of AIPPI⁶⁵ and so was the variation in the legislation and practice in various states in respect of color marks.

In Australia⁶⁶, for instance, all that was required consisted of "a clear and concise

description and a pictorial representation of the trade mark", such representation needing to "show the colour claimed and the manner in which it is to be applied to the goods or packaging" but not necessarily having to indicate "the outline, contours or proportions in which, or the shape or object to which, the colour is to be applied". The indication of the color as specified by an international color code was not mandatory but commonplace in practice⁶⁷. The approach was identical in Paraguay⁶⁸, Peru⁶⁹, Portugal⁷⁰, Singapore⁷¹ and similar in Spain⁷² where a sample was required but the designation of the color by code was deemed more pertinent

A similar position was adopted in Denmark where samples or color codes were not required but the Danish Patents and Trademarks Office was recommending that codes be filed⁷³. This approach was also used in South Africa⁷⁴ where, in absence of express requirements, filing a sample and code became standard practice.

In Latvia, both a sample and verbal description were required, with the colorimetric reference optional⁷⁵.

In Belgium, where there was a more liberal approach to start with, after *Libertel* (and the Communication of the President of EUIPO), the Benelux Office has decided that it would allow for (but not require) an indication of the color code as per an internationally-recognized system while only requiring a description in words of the color⁷⁶. Similarly, in France, the requirement was for a sample with the code indication being optional⁷⁷.

Interestingly, the Czech Patent Office seems to have been refusing the code indication as insufficient while only allowing the application upon the filing of a sample⁷⁸. Clearly this approach has no longer been tenable after the Czech Republic's accession to the EU.

In Finland, following *Libertel*, there was a requirement to file both a sample "or to otherwise depict the colour in question the application for the

⁶⁵ Luis-Alfonso Duran, Jochen E. Bühling, Ian Karet, Dariusz Szeleper, Thierry Calame „Working Guidelines on Q 181 – Conditions for registration and scope of protection of non-conventional trademarks” in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 220.

⁶⁶ Peter Chalk, Matthew Swinn "Report on Q 181 in the name of the Australian Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 252.

⁶⁷ Idem.

⁶⁸ "Report on Q 181 in the name of the Paraguayan Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 457.

⁶⁹ "Report on Q 181 in the name of the Peruvian Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 452.

⁷⁰ Ana Ferreira Silva "Report on Q 181 in the name of the Portuguese Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 473.

⁷¹ "Report on Q 181 in the name of the Singaporean Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 483.

⁷² Antonia Ruiz Lopez, Isidro José García Egea, Joan Salvá Ferrer, Enrique Sánchez Quiñones, Sara Serrat Viñas, Santiago Soler Lerma, Eva Toledo Alarcón "Rapport sur Q 181 au nom du Groupe espagnol" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 496.

⁷³ Christian Akhøj, Henriette V. Rasch "Report on Q 181 in the name of the Danish Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 303.

⁷⁴ Alan Smith, Lucy Signorelli "Report on Q 181 in the name of the South African Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 487.

⁷⁵ Harijs SONDORS "Report on Q 181 in the name of the Latvian Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 418

⁷⁶ L. Van Bunnem, Antoine Braun, Emmanuel Cornu, Brigitte Dauwe, Charlotte Garrigues, Isabelle Goes "Rapport sur Q 181 au nom du Groupe belge" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 264.

⁷⁷ Evelyne Roux, Delphine Brunet, Valérie Delaunay, Juliette Disser, Stéphane Guerlain, Catherine Mallet, Sophie Micallef, Béatrice Thomas "Rapport sur Q 181 au nom du Groupe français" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 327.

⁷⁸ "Report on Q 181 in the name of the Czech Group" in AIPPI *Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 297.

graphical representation of the mark” and “to specify the colour in question with a colorimetric reference, colour code or in other sufficiently precise manner”⁷⁹. The same approach was followed in Italy⁸⁰ and Switzerland⁸¹.

In Germany the *Libertel* approach was followed thoroughly: a mere sample of the color on paper was insufficient but a sample and color could suffice. A reference to a standardized color code was preferred⁸². The situation was identical in Norway⁸³, Malaysia⁸⁴, the Netherlands⁸⁵, Panama⁸⁶, Sweden⁸⁷, the United Kingdom⁸⁸.

AIPPI’s resolution on Q 181 established that “Non-conventional” trade marks should, in principle, be capable of constituting registered trade marks. 2) The representation of a “non-conventional” trade mark must be clear, precise, easily accessible and intelligible. The public must be able to understand the nature of the trade mark. 3) A colour per se can be capable of registration as a trade mark. In many cases a colour per se will only be registrable on the basis of distinctiveness acquired through use. There may also be circumstances where a colour per se may be registered on the basis of inherent distinctiveness in relation to certain goods or services”⁸⁹.

From the above, one can notice that there was growing international consensus on the importance of the color coding that was to be employed for the applications as a trend towards harmonization of applications for such trademarks.

2.3. Beyond the code: the future in technic color

As we have mentioned in the introduction to this paper, the change operated in the provisions of the Trademark Directive and EU trademark

Regulation will have explicitly removed any precondition for a code of color to be provided upon application. This should mean that colors per se should be more easily registered as trademarks, given the leeway the modifications have insured.

Now the limit of ‘graphic representation’ appears to solely refer to the technical possibility to record the sample electronically (or in such a way that it remains unaffected by the passage of time). We do not know how far that possibility will now (or later) extend.

3. Conclusions

The paper has focused on the legislative changes to the condition of graphical representation and how different states have sought to accommodate this condition with the wider implications this can have. We have shown that this delicate balance had shifted after *Libertel* in the sense that such has opened the doors to have more color trademarks applied for and registered. In this context the latest moves have clearly tipped the scales in favor of registrability of such signs.

However, we need to point out that in focusing solely on the technical issue of graphic representation, the debate surrounding this issue has lost out of sight all the concerns that had prompted AG Léger to reject the possibility of registering a single trademark.

In this context it is imperative that research in this matter is continued and the scope of graphical representation tied to the concerns mentioned by the European courts and the national courts, especially those of EU Member States.

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⁷⁹ Rainer Hilli, Petteri Häkkinen, Markus Mattila, Jarkko Vuorinen, Jan Vidjeskog, Laura Wennonen, Kenneth Wrede, Niklas Östman “Report on Q 181 in the name of the Finnish Group” in *AIPPI Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 316.

⁸⁰ Renata Righetti, Giovanni Pellegrino, Carlo Fiammenghi, Lamberto Liuzzo “Report on Q 181 in the name of the Italian Group” in *AIPPI Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 407.

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⁸² Franz Hacker “Bericht Q181 im Namen der Deutschen Landesgruppe” in *AIPPI Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 362.

⁸³ Debbie Rønning and Fredny Bade “Report on Q 181 in the name of the Norwegian Group” in *AIPPI Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 442.

⁸⁴ “Report on Q 181 in the name of the Malaysian Group” in *AIPPI Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 422.

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⁸⁶ Ileana Del C. Martinelli “Report on Q 181 in the name of the Panamanian Group” in *AIPPI Yearbook 2004*, vol. I, AIPPI (Zurich, 2004), p. 447.

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