



## **According to Advocate General Szpunar, a trade mark combining colour and shape may be refused or declared invalid on the grounds set out under EU trade mark law**

*The analysis must relate exclusively to the intrinsic value of the shape and take no account of attractiveness of the goods flowing from the reputation of the mark or its proprietor*

Mr Christian Louboutin is a fashion designer who designs, amongst other things, high-heeled shoes for women. A particular feature of those shoes is that the outer sole is always red. Mr Louboutin and his company registered that trade mark in Benelux for 'footwear' in 2010 and for 'high-heeled shoes' in 2013. The trade mark is described as consisting 'of the colour red (Pantone 18 1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)'. It is reproduced below:



The Van Haren company operates shoe retail outlets in the Netherlands. In 2012, Van Haren sold high-heeled women's shoes with red soles. Mr Louboutin and his company brought proceedings before the Netherlands courts seeking a finding of trade mark infringement by Van Haren. Van Haren claims that the mark at issue is invalid. The EU trade mark directive sets out a number of grounds on which registration of a mark may be refused or declared invalid, particularly in relation to signs that consist exclusively of a shape that gives substantial value to the goods.<sup>1</sup> The Rechtbank Den Haag (District Court of The Hague, Netherlands) decided to refer questions to the Court of Justice in that regard. The referring court considers that the mark at issue is inextricably linked to shoe soles and that, according to the directive, the concept of 'shape' covers not only the three-dimensional properties of goods (such as their contours, measurements and volume), but also colours.

In his additional Opinion following the reopening of the oral procedure,<sup>2</sup> **Advocate General Maciej Szpunar maintains his view that the prohibition set out in the trade mark directive is capable of applying to a sign combining colour and shape.** Accordingly, he proposes that the Court's answer should be that the grounds on which registration of a mark may be refused or

<sup>1</sup> Article 3(1)(e)(iii) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

<sup>2</sup> On 28 February 2017, the Court of Justice decided to refer the case to the Ninth Chamber. A hearing was held on 6 April 2017. On 22 June 2017, the Advocate General delivered his first Opinion. On 13 September 2017, the Ninth Chamber decided to request the Court, pursuant to Article 60(3) of the Rules of Procedure of the Court of Justice, to assign the case to a formation composed of a greater number of Judges. The Court subsequently reassigned the case to the Grand Chamber. By [order](#) of 12 October 2017, the Court decided to reopen the oral procedure and invited the interested parties to participate in another hearing, which took place on 14 November 2017.

declared invalid are capable of being applied to a sign consisting of the shape of the goods, and seeking protection for a certain colour.

In his first Opinion, the Advocate General had stated that the mark at issue had to be equated with one consisting of the shape of the goods, and seeking protection for a colour in relation to that shape, rather than one consisting of a colour per se. He maintains that point of view, given that this is not a wholly abstract shape, or one of negligible importance, but always the shape of a sole. Moreover, he expresses doubts as to whether the colour red can perform the essential function of a trade mark, that of identifying its proprietor, when that colour is used out of context, that is to say, separately from the shape of a sole.

Nevertheless, the Advocate General points out, as he had done in his first Opinion, that the classification of the mark at issue is a factual assessment to be made by the referring court. The same applies to the question as to whether the red colour of the sole gives substantial value to the goods. In his view, the position of the Netherlands court is clear on that point, since it is proceeding from the premise that that question must be answered in the affirmative.

The Advocate General also considers that the introduction of the concept of a 'position' mark into EU law<sup>3</sup> is not liable to qualify his considerations concerning the applicability of the ground for refusal or invalidity (laid down in the EU trade mark directive) to a sign such as that at issue.<sup>4</sup>

Similarly, the Advocate General has examined the scope of the new trade mark directive, the deadline for transposition of which is 14 January 2019.<sup>5</sup> In that regard, he takes the view that the reasons for the amendments introduced by the new directive (strengthening the trade mark proprietor's monopoly and restricting third party rights) cannot easily be applied to the grounds for refusal or invalidity.

The Advocate General also takes the view that the reference to the public's perception as a factor which, among others, determines the characteristics giving substantial value to the goods, argues in favour of the ground for refusal or invalidity<sup>6</sup> applying to signs consisting of the shape of the goods and seeking protection for a colour in relation to that shape. In practice, the deciding factor in relation to the public's perception is not the distinction between shape, colour or position marks, but rather the identification of the origin of the goods on the basis of the overall impression created by a sign.

With regard to the classification of the mark, the Advocate General points out that it is to be assessed whether the registration of that sign would not run counter to the general interest in not unduly restricting the availability of the characteristics represented by that sign for other operators offering for sale goods or services of the same type.

Lastly, as he stated in his first Opinion, the Advocate General notes that his **analysis relates exclusively to the intrinsic value of the shape, and must take no account of attractiveness of the goods flowing from the reputation of the mark or its proprietor.**

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**NOTE:** The Advocate General's Opinion is not binding on the Court of Justice. It is the role of the Advocates General to propose to the Court, in complete independence, a legal solution to the cases for which they are responsible. The Judges of the Court are now beginning their deliberations in this case. Judgment will be given at a later date.

**NOTE:** A reference for a preliminary ruling allows the courts and tribunals of the Member States, in disputes which have been brought before them, to refer questions to the Court of Justice about the interpretation of European Union law or the validity of a European Union act. The Court of Justice does not decide the

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<sup>3</sup> Article 3(3)(d) of Commission Implementing Regulation of 18 May 2017 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark (OJ 2017 L 205, p. 39).

<sup>4</sup> Article 3(1)(e)(iii) of Directive 2008/95/EC.

<sup>5</sup> Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1).

<sup>6</sup> Article 3(1)(e)(iii) of Directive 2008/95/EC.

dispute itself. It is for the national court or tribunal to dispose of the case in accordance with the Court's decision, which is similarly binding on other national courts or tribunals before which a similar issue is raised.

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The [full text](#) of the judgment is published on the CURIA website on the day of delivery.

Press contact: Holly Gallagher ☎ (+352) 4303 3355

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