

JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
25 September 2002 *

In Case T-316/00,

Viking-Umwelttechnik GmbH, established in Kufstein (Austria), represented by
S. Völker, lawyer,

applicant,

v

Office for Harmonisation in the Internal Market (trade marks and designs)
(OHIM), represented by A. von Mühlendahl, E. Joly and S. Bonne, acting as
Agents,

defendant,

ACTION brought against the decision of the First Board of Appeal of the Office
for Harmonisation in the Internal Market (trade marks and designs) of 28 July
2000 (Case R 558/1999-1) refusing registration of a juxtaposition of the colours
green and grey as a Community trade mark,

* Language of the case: German.

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fourth Chamber),

composed of: M. Vilaras, President, V. Tiili and P. Mengozzi, Judges,
Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Registry of the Court on 9 October 2000,

having regard to the response lodged at the Registry of the Court on 4 January 2001,

further to the hearing on 27 February 2001,

gives the following

Judgment

Background to the dispute

- 1 On 30 January 1997 the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (trade marks and

designs) (OHIM) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

- 2 The trade mark in respect of which registration was sought was a juxtaposition of two colours *per se*, represented by a green rectangle corresponding to colour reference Pantone 369c above a grey rectangle corresponding to colour reference Pantone 428u.

- 3 The goods in respect of which registration of the trade mark was sought were in Class 7 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Garden choppers and shredders; rotary cultivators; lawn mowers; front mowers; ride-on mowers; lawn aerators; lawn trimmers; hedge clippers; sweeping machines; snow sweepers; ploughs; motor saws; brush cutters; high pressure cleaning apparatus; all equipment motor driven, with parts, replacement parts and accessories’.

- 4 By a decision of 23 July 1999 the examiner refused the application under Article 38 of Council Regulation No 40/94, on the ground that the green and grey colour combination was devoid of any distinctive character and descriptive of the goods in question within the meaning of Article 7(1)(b) and (c) of that regulation.

- 5 On 31 August 1999 the applicant filed an appeal against the examiner’s decision at OHIM under Article 59 of Regulation No 40/94.

- 6 By a decision of 28 July 2000 (hereinafter ‘the contested decision’), which was notified to the applicant on 7 August 2000, the First Board of Appeal upheld the refusal to register the mark sought. It essentially took the view that the sign was devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

Forms of order sought

- 7 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

- 8 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

- 9 The applicant relies on two pleas in law, alleging infringement of Article 7(1)(b) and of Article 7(1)(c) of Regulation No 40/94.
- 10 It should be pointed out that, although the Board of Appeal considered aspects of description, it none the less decided, at paragraph 24 of the contested decision, that registration of the sign applied for ought to be refused on the basis of Article 7(1)(b) of Regulation No 40/94. The plea of infringement of Article 7(1)(c) is therefore invalid.
- 11 Accordingly it is only necessary to consider the allegation of infringement of Article 7(1)(b) of Regulation No 40/94.

Arguments of the parties

- 12 The applicant points out that colours *per se* are in principle eligible for trade mark protection, as the definition of signs capable of constituting Community trade marks in Article 4 of Regulation No 40/94 makes clear. The applicant points out that that definition reflects the modern view of trade marks, which are increasingly composed of non-traditional signs such as sounds, colours and packaging.

- 13 The applicant argues that using colours as a means of identification rather than as decoration makes it possible for the public to single out one undertaking's range of products from all the others at a distance, though final identification of the product is based on other features, such as a word mark.

- 14 The applicant believes that there is a commercial interest in protecting colours in the abstract, regardless of any shape, because they are used in varying proportions on different types of material and on the goods themselves.

- 15 The applicant explains that it is by use of the green and grey on the plastic case, in particular for small implements, that the claimed colour combination distinguishes the goods.

- 16 It claims that the chromatic combination need not be found to be very unusual for it to be established as distinctive. Such a test is inappropriate because if an undertaking has been using the combination over a long period it no longer is very unusual. Similarly, if an undertaking starts using the combination after registering it as a trade mark, it ceases to be very unusual as soon as it has achieved a measure of success.

- 17 As regards the colour grey, the applicant points out that it is a specific grey (pantone 428u) not generally used for plastic, and that knowledge of the definition of a colour is of little consequence for the purposes of assessing its distinctive character.

- 18 As to the colour green, the applicant observes that its competitors' products use various colours. Green has no particular function in regard to the goods in question, and any association with nature is of little importance for the purposes of assessing its distinctiveness, particularly given that it is a specific tone and is used in combination with another shade.
- 19 Finally, the applicant claims that the particular juxtaposition of precise tones gives the goods a certain visual appearance and identity which distinguishes them from other goods; this imbues the mark with the requisite minimum degree of distinctiveness.
- 20 OHIM challenges the applicant's arguments. It takes the view that the sign applied for must meet the requirements not only of Article 4 of Regulation No 40/94, but also of Article 7(1) of the regulation. In that respect, it considers that the colours must have the effect of enabling the public to distinguish the applicant's products from those of its competitors, and must not be perceived merely as a common decorative feature or as suggesting a characteristic or quality of the product.
- 21 OHIM points out that certain categories of trade mark are intrinsically devoid of distinctive character, in particular where the relevant class of persons does not associate the sign with any individual undertaking. That is true of colours where registration of the configuration of the product is not sought.
- 22 Lastly OHIM takes the view that the effect of juxtaposing the colours green and grey is to create an impression of a shade of green — a colour that is widely used for and enhances the appeal of the goods in question — against a backdrop in a shade of light grey, which is a colour that is not designed to attract attention, as it resembles the colour of metal and is commonly used on many types of material.

The combination of green and grey will therefore not be perceived by the relevant class of persons as an indication of origin.

Findings of the Court

- 23 It must first of all be observed that colours or colour combinations *per se* are capable of constituting Community trade marks in so far as they are capable of distinguishing the goods or services of one undertaking from those of another.
- 24 It does not, however, follow from the fact that signs of a particular category may in principle constitute a trade mark that all signs in that category necessarily possess distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 with regard to a particular product or service.
- 25 Signs that are devoid of any distinctive character under Article 7(1)(b) of Regulation No 40/94 are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or service, thus enabling the consumer who acquired them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition.
- 26 A mark's distinctiveness can only be assessed, first, in relation to the goods or services for which registration has been requested and, second, in relation to the perception of the relevant section of the public.

- 27 It must also be observed that Article 7(1)(b) of Regulation No 40/94 does not draw any distinction between different types of sign. However the perception of the relevant section of the public is not necessarily the same in the case of a sign composed of a colour or colour combination *per se* as it is in the case of a word or figurative mark composed of a sign that bears no relation to the appearance of the goods that it identifies. While the public is accustomed to perceiving word or figurative marks as instantly identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the look of the goods in respect of which registration of the sign is sought.
- 28 It must first of all be observed that the goods referred to in the application for registration are targeted at all consumers, that is, non-specialist consumers. Accordingly, the relevant consumer is deemed to be the average, reasonably well-informed, reasonably observant and circumspect consumer. However, account should be taken of the fact that the average consumer must place his trust in the imperfect picture of the goods that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).
- 29 As regards the colour green, it must be noted that green is in common use for the goods in question, and that it is not therefore likely to be noticed and committed to memory as an indication of commercial origin. In addition, the shade of green used in the juxtaposition sought to be registered is not perceptibly different enough from the shades of green in common use in the sector to which the goods belong.
- 30 The colour grey cannot be said to be endowed with any particular attribute enabling a consumer to suppose that it is anything other than the natural colour of the material, or simply a coloration used on that material, or a finish.

- 31 Since the sign for which registration is sought is composed of those two colours in juxtaposition, it is necessary to assess their distinctiveness, as a whole, when so juxtaposed.
- 32 In that connection, first, as is clear from the examples given in OHIM's response, those two colours, or similar shades, are commonly used together for gardening products.
- 33 It must also be borne in mind that simply juxtaposing the colours green and grey in the way shown in the application for registration is abstract and imprecise in relation to the goods in question, and the combination of colours is not arranged in any particular format. In that connection the Board of Appeal correctly found that no application was made for the colours in any particular arrangement.
- 34 Consequently such a sign will not be noticed and recognised, because displaying the colours on the products in a non-ordered way may mean that there will be a variety of different formats, which will not enable consumers to take in and commit to memory a particular combination on which they could draw to make a repeat purchase directly and with certainty.
- 35 That finding is, moreover, confirmed by the samples from the catalogue produced by the applicant at the hearing, and by the fact that the products bearing the colours claimed come in a variety of forms, making it impossible to establish a consistent association between the colours, such as would enable the sign to be used in a uniform fashion according to a given format, in a particular order,

juxtaposing the two elements. In addition it is clear from that catalogue that for certain products the green and black juxtaposition is more striking.

- 36 Finally, as regard the applicant's argument that the colours used could enable consumers to identify products in the same range from a distance, it is sufficient to note that in arguing that point the applicant also acknowledges that a product's commercial origin is ultimately identified on the basis of other distinguishing features, such as a word mark.
- 37 The consumer will therefore not see the juxtaposition of green and grey as a sign indicating that the goods come from the same undertaking but will rather see it merely as an aspect of the finish of the goods in question.
- 38 It must therefore be concluded that the sign will not enable the relevant consumers to recognise it as distinctive when they come to make a choice on the occasion of a subsequent purchase of the goods in question.
- 39 That conclusion cannot be gainsaid by the applicant's arguments that the test based on the unusual nature of the chromatic combination is inappropriate on the ground that if an undertaking has been using that combination for a long time it ceases to be unusual, just as it ceases to be unusual, once it has achieved a measure of success, if it has been registered as a trade mark. First of all, it does not follow automatically from the fact that an undertaking has been using a chromatic combination for a certain period prior to registration that other

undertakings use that combination for the goods referred to in the application. Secondly, once the combination is registered, assuming the mark achieves a measure of success, the owner retains the right to defend its exclusive rights in the mark, within the limits laid down by Regulation No 40/94.

- 40 It follows that, in finding that the colours were not unusual, and that they were not arranged in a specific way, the Board of Appeal was right in deciding that the juxtaposition of the colours green and grey is not distinctive in relation to the goods in question for the purposes of Article 7(1)(b) of Regulation No 40/94.

Costs

- 41 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay OHIM's costs, in accordance with the form of order sought.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber),

hereby:

1. Dismisses the action;

2. Orders the applicant to pay the costs.

Vilaras

Tiili

Mengozzi

Delivered in open court in Luxembourg on 25 September 2002.

H. Jung

Registrar

M. Vilaras

President