

OPINION OF ADVOCATE GENERAL  
LÉGER

delivered on 15 January 2004<sup>1</sup>

1. The present case again concerns the question of the capability of colours per se, that is to say without shape or delineation, of constituting a trade mark within the meaning of Article 2 of First Council Directive 89/104/EEC.<sup>2</sup> In the judgment in *Libertel*,<sup>3</sup> the Court ruled on whether a colour per se satisfies the conditions laid down by that article. In this case, the Bundespatentgericht (Federal Patents Court) (Germany) seeks to ascertain whether two colours per se, that is to say two colours as such, without shape or delineation and in no particular arrangement in relation to one another, are capable of constituting a trade mark within the meaning of the aforementioned Article 2.

mark laws of the Member States, which may distort competition within the common market.<sup>4</sup> It seeks to approximate the provisions of the Member States' trade mark laws which most directly affect the functioning of the internal market.<sup>5</sup> Among those provisions are those which lay down the conditions for registering a trade mark<sup>6</sup> and those which specify the protection enjoyed by lawfully registered trade marks.<sup>7</sup>

3. Article 2 of the directive defines the signs of which a trade mark may consist. It is worded as follows:

## I — Legal context

### A — Community law

2. The purpose of the directive is to eliminate the disparities between the trade

'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of

1 — Original language: French.

2 — Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1, hereinafter 'the directive').

3 — Case C-104/01 [2003] ECR I-3793.

4 — First recital in the preamble.

5 — Third recital.

6 — Seventh recital.

7 — Ninth recital.

their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

4. Article 3 of the directive lists the grounds for refusal or invalidity which may be invoked against the registration of a trade mark. In paragraph 1(b), it provides that trade marks which are devoid of any distinctive character are not to be registered or, if registered, are to be liable to be declared invalid.

5. Article 3(3) of the directive provides that a trade mark is not to be refused registration or, if it is registered, is not to be declared invalid in accordance with Article 3(1)(b) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character.

which transposed the directive into German law and entered into force on 1 January 1995,<sup>9</sup> states in Paragraph 3(1) that ‘all signs, in particular ... colours and combinations of colours, which are capable of distinguishing the goods or services of one undertaking from those of other undertakings’ are protectable as trade marks.

7. Paragraph 8 of the *Markengesetz* states that signs which are protectable as trade marks for the purposes of Article 3 but are not capable of being represented graphically and signs which are devoid of any distinctive character in relation to the goods or services designated in the application for registration are ineligible for registration. It also provides that those grounds do not apply where, following its use in relation to those goods or services, a trade mark has already become accepted by the relevant section of the public at the time of the decision on its registration.

## II — Facts and main proceedings

### B — *National law*

6. The *Gesetz über den Schutz von Marken und sonstigen Kennzeichnungen*<sup>8</sup> (German law on the protection of trade marks and other distinctive signs) of 25 October 1994,

8. On 22 March 1995, the company Heidelberg Bauchemie GmbH<sup>10</sup> applied to the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) for registra-

8 — Hereinafter ‘the *Markengesetz*’.

9 — BGBl. 1994 I, p. 3082.

10 — Hereinafter ‘Heidelberg Bauchemie’.

tion of the colours blue and yellow as a trade mark. In the section of the application intended for the reproduction of the trade mark, there was a rectangular piece of paper, the upper half of which was blue and the lower half yellow. The trade mark was described as follows:

'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.

The specification of the colours is:

RAL 5015/HKS 47 — blue

RAL 1016/HKS 3 — yellow.'

9. The registration at issue was applied for in relation to a large number of construction products, such as additives, adhesives, resins, mould release agents, preservatives, cleaning products, sealants, jointing products, paints, varnishes, thermal insulation products, building materials, cements, fillers, spray guns and spraying equipment.

10. By decision of 18 September 1996, the Deutsches Patent- und Markenamt rejected that application on the ground that the sign in question was not capable of constituting a trade mark. It stated that abstract colours or colour combinations without delineation, that is to say lacking any shape or form of design, are not signs protectable as trade marks for the purposes of Article 3 of the Markengesetz.

11. Heidelberger Bauchemie then relied on the 'black/yellow colour mark' decision of the Bundesgerichtshof (Federal Court of Justice) of 10 December 1998,<sup>11</sup> in which that court accepted that abstract colours and colour combinations without delineation could constitute a trade mark.

12. By decision of 2 May 2000, the Deutsches Patent- und Markenamt, while accepting that the requirements of Article 3 of the Markengesetz were satisfied, again rejected the application on the ground of lack of any distinctive character.

13. Heidelberger Bauchemie brought an appeal against that decision before the Bundespatentgericht.

<sup>11</sup> — GRUR 1999, p. 491.

### III — The reference for a preliminary ruling

14. By order of 22 January 2002, received at the Court on 22 February 2002, the Bundespatentgericht decided to stay proceedings and to submit to the Court the present reference for a preliminary ruling.

15. According to the order for reference, the Bundespatentgericht was faced with the following issues. Until the new German law on trade marks was adopted, a colour or colour combination was considered in German law to be incapable of constituting a trade mark. Colours could be protected only in the specific form in which they were used. Following the adoption of the new law, most legal writers accepted that an abstract colour or colour combination could now constitute a trade mark. That is also the position adopted by the Bundesgerichtshof.

16. The Bundespatentgericht nevertheless takes the view that there are serious legal objections to that position. According to that court, an abstract colour mark admits of an infinite number of forms of design. It is therefore an option taken on trade marks to be designed subsequently, only the colour of which is defined. It is therefore doubtful whether an abstract colour mark is a sign for

the purposes of that article and whether distinctive character can be attributed to it.

17. Moreover, according to the Bundespatentgericht, the registration of abstract colours as trade marks conflicts with the principle of certainty, pursuant to which an application to register a trade mark must enable the protectable subject-matter to be clearly identified. In order to satisfy that requirement, Article 2 of the directive requires the sign in question to be capable of being represented graphically. That requirement is also intended to make it possible to assess the grounds for refusal based on Articles 3 and 4 of the directive and proper use of the trade mark as required by Article 10. A sample of the colours and their designation by an international code do not, therefore, constitute graphic representation for the purposes of Article 2 of the directive because such a trade mark could in reality assume an infinite number of different forms.

18. In view of those considerations, the Bundespatentgericht decided to submit the following questions to the Court for a preliminary ruling:

‘Do colours or combinations of colours which are the subject of an application for registration as a trade mark, are claimed in the abstract, without delineation and in shades which are named in words by

reference to a colour sample (colour specimen) and specified according to a recognised colour classification system satisfy the conditions for capability of constituting a trade mark for the purposes of Article 2 of [the directive]?

den (Netherlands) referred a number of questions for a preliminary ruling, seeking to ascertain whether, and if so in what circumstances, a colour per se, not spatially defined, is capable of possessing distinctive character within the meaning of Article 3(1) (b) of the directive for certain goods or services.

In particular, for the purposes of Article 2 of the directive, is such an '(abstract) colour mark'

- (a) a sign,
- (b) sufficiently distinctive to be capable of indicating origin,
- (c) capable of being represented graphically?'

20. The Court took the view that in order to consider those questions it was necessary as a preliminary matter to determine whether a colour per se is capable of constituting a trade mark for the purposes of Article 2 of the directive. It stated that, to that end, the colour must satisfy the following three conditions: first, be a sign, second, be capable of graphic representation and, third, be capable of distinguishing the goods or services of one undertaking from those of other undertakings.<sup>12</sup>

#### IV — The *Libertel* judgment and the Court's interpretation of Article 2 of the directive

19. After the order for reference was made, the Court delivered its judgment in *Libertel*. In that case, the main proceedings concerned registration of the colour orange per se as a trade mark for telecommunications goods and services. The Hoge Raad der Nederlan-

21. With regard to the first condition, the Court held that, although a colour per se cannot be presumed to constitute a sign since a colour is normally a simple property of things, it is none the less capable, in relation to a product or service, of constituting a sign.<sup>13</sup>

<sup>12</sup> — *Libertel*, cited above, paragraphs 23 to 42.

<sup>13</sup> — *Ibid.*, paragraph 27.

22. With regard to the second condition, the Court took the view that a colour per se is capable of being represented graphically by its designation using an internationally recognised identification code and, in certain cases, by a sample of that colour, combined with a description in words of that colour.<sup>14</sup>

23. With regard to the third condition, the Court took the view that the possibility that a colour per se may in some circumstances serve as a badge of origin of the goods or services of an undertaking cannot be ruled out.<sup>15</sup>

24. It concluded that, where the conditions described above apply, a colour per se is capable of constituting a trade mark within the meaning of Article 2 of the directive.<sup>16</sup>

25. On the basis of those considerations, the Court then examined the questions referred for a preliminary ruling by the Hoge Raad der Nederlanden as regards the criteria which must be taken into account by the national authorities in assessing the distinctive character of a colour per se in relation to the goods or services referred to in the application for registration.

26. First, the Court held that, in assessing the distinctive character which a colour per se may have for certain specified goods or services, it is necessary to take account of the 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.<sup>17</sup> It added that the greater the number of the goods or services for which the trade mark is sought to be registered, the more excessive the right conferred by the mark is likely to be and the more likely it is to come into conflict with the maintenance of a system of undistorted competition.<sup>18</sup>

27. Second, the Court stated that a colour per se may be held to be distinctive within the meaning of Article 3(1)(b) and (3) of the directive provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service referred to in the application for registration. It pointed out that distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific. However, such distinctive character may be acquired, inter alia, following the use

14 — *Ibid.*, paragraphs 31 to 37.

15 — *Ibid.*, paragraphs 40 and 41.

16 — *Ibid.*, paragraph 42.

17 — *Ibid.*, paragraph 55.

18 — *Ibid.*, paragraph 56.

made of the colour per se, after a process of familiarising the relevant public has taken place.<sup>19</sup>

28. Third, the Court held that the fact that registration as a trade mark of a colour per se is sought for a large number of goods or services or not is relevant, together with all the other circumstances of the particular case, to assessing both the distinctive character of the colour in question 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.<sup>20</sup>

29. Fourth, the Court pointed out that the assessment of whether a colour has distinctive character within the meaning of Article 3 (1)(b) and (3) of the directive must of necessity be undertaken by reference to the actual situation.

30. The judgment in *Libertel*, cited above, was one of a series of three decisions in which the Court specified what signs or

indications are capable of constituting a trade mark for the purposes of Article 2 of the directive.

31. In *Sieckmann*,<sup>21</sup> which was the first in the series, the point at issue was whether an odour is capable of constituting a trade mark for the purposes of Article 2 of the directive.<sup>22</sup> The Court held that that article does not exclude odours,<sup>23</sup> but that the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.<sup>24</sup>

32. In *Shield Mark*,<sup>25</sup> the Court ruled on the possibility of registering sound marks.<sup>26</sup> It held that sounds are capable of constituting a trade mark.<sup>27</sup> It pointed out that the requirement of graphic representation is satisfied where the sign is represented by means of written notes on a score, accompanied by the clef determining the inton-

21 — Case C-273/00 [2002] ECR I-11737, paragraphs 46 to 55.

22 — The main proceedings concerned the refusal of the Deutsches Patent- und Markenamt to register as a trade mark the pure chemical substance methyl cinnamate (cinnamic acid methyl ester), the chemical formula of which is  $C_9H_8$ ,  $CH = CHCOOCH_3$ . The applicant had also submitted a sample of the odour in question in a container and stated that the scent was usually described as 'balsamically fruity with a slight hint of cinnamon'.

23 — Paragraph 44.

24 — Paragraph 73.

25 — Case C-283/01 [2003] ECR I-14313.

26 — The main proceedings concerned the validity of 14 sound marks registered by the Benelux Trade Mark Office, of which 11 had as their motif the opening bars of the piano study *Fur Elise* by Ludwig van Beethoven and the other three a cock's crow.

27 — Paragraph 35.

19 — *Ibid.*, paragraphs 66 and 67.

20 — *Ibid.*, paragraph 71.

ation, by the time signature establishing the rhythm and the relative value of each note, and by an indication of the instruments on which they are to be performed. On the other hand, descriptions using written language, including onomatopoeia, an indication of the tune or a sequence of the names of the musical notes do not meet that requirement.<sup>28</sup>

33. By letter of 8 May 2003, the Court sent the *Libertel* judgment to the Bundespatentgericht and asked that court whether it maintained its decision to make a reference for a preliminary ruling. By letter of 15 May 2003, the Bundespatentgericht replied that it maintained the questions which it had referred for a preliminary ruling.

## V — Assessment

34. As the Bundespatentgericht correctly states in its order for reference, the view that two colours per se constitute a sign of which a trade mark may consist for the purposes of Article 2 of the directive has no decisive basis in the relevant legislation. Consequently, although it is established that

the list of signs contained in that article is not exhaustive, it is none the less true that it does not mention colours.<sup>29</sup>

35. With regard, next, to the Agreement on Trade-related Aspects of Intellectual Property Rights, known as the TRIPS Agreement, to which the Community and the Member States are parties,<sup>30</sup> it cannot be inferred from the term ‘combinations of colours’ in Article 15<sup>31</sup> that the contracting parties expressly intended to convey the meaning that two or more colours per se, in no particular arrangement, are capable of constituting a trade mark. The word ‘combination’ does not have exactly the same meaning in the three languages in which the TRIPS Agreement was drafted and which are

29 — In *Libertel*, cited above, paragraph 25, the Court held that the declaration made jointly by the Council of the European Union and the Commission of the European Communities, entered in the minutes of the Council meeting on the adoption of the directive, stating that they ‘consider that 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 goods or services of one undertaking from those of other undertakings’, could not be taken into account when interpreting that article.

30 — That agreement is set out in an annex to the Agreement establishing the World Trade Organisation, signed by the representatives of the Community and the Member States on 15 April 1994. It was approved on behalf of the European Community, as regards matters within its competence, by Council Decision 94/800/EC of 22 December 1994 (OJ 1994 L 336, pp. 1 and 214), and entered into force on 1 January 1995.

31 — Article 15(1) defines the types of signs which are eligible for protection as trade marks as follows: ‘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. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.’

28 — Paragraph 59.



equally authentic.<sup>32</sup> Thus, whereas in English and Spanish the words 'combination' and 'combinaciones' do not refer to a particular system or organisation, in that they may simply denote 'two or more things joined or mixed together to form a single unit'<sup>33</sup> and a 'unión de dos cosas en un mismo sujeto',<sup>34</sup> the term 'combinaison' has a more restrictive meaning in French, since it is defined as 'un assemblage d'éléments dans un arrangement déterminé' (an assemblage of elements in a particular arrangement).<sup>35</sup>

36. However, in the light of the grounds of the *Libertel* judgment, and of the Court's very wide interpretation of Article 2 of the directive, there appears to be no doubt that the analysis adopted in that judgment, that a colour per se is capable of constituting a trade mark within the meaning of that article, could also be applied to two colours per se.

37. Consequently, with regard to the first condition, relating to the existence of a sign, the Court's statement that a colour per se is capable, in relation to a product or service and depending on the context in which it is used, of constituting a sign, could apply to two colours per se. In a certain context, particularly where they are arranged in a specified way, two colours may constitute a sign. Similarly, as the Court held in *Libertel*, two colours per se could be represented

graphically in accordance with the requirements of Article 2 of the directive, where they are designated by an internationally recognised identification code. Finally, with regard to the third condition, relating to the capability of having distinctive character, the Court stated in very general terms that 'colours per se may be capable' of having such character.

38. It should therefore follow from the case-law cited above that the answer to the questions referred by the Bundespatentgericht is that two colours per se, the exact shades of which are described by reference to a colour sample and specified according to a recognised colour classification system, satisfy the conditions for constituting a trade mark in accordance with Article 2 of the directive, in the sense that they can be regarded as a sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and of being represented graphically.<sup>36</sup>

32 — They are Spanish, English and French.

33 — *Oxford Advanced Learner's Dictionary*, 2000 edition.

34 — RAE, Vigésima Edición 1984.

35 — *Le Nouveau Petit Robert*, 1993 edition, and *Le Grand Robert de la langue française*, under the editorship of Alain Rey, 2001 edition.

36 — That is the position adopted by the Court of First Instance of the European Communities in Case T-316/00 *Viking-Umwelttechnik v OHIM* [2002] ECR II-3715 (juxtaposition of green and grey) and Case T-234/01 *Andreas Stihl v OHIM* [2003] ECR II-3715 (combination of orange and grey), in which it held that colours or colour combinations per se are capable of constituting Community trade marks within the meaning of Article 4 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, the wording of which reproduces that of Article 2 of the directive. However, it should be pointed out that the question whether one or more colours per se are capable of constituting a trade mark was not discussed before the Court of First Instance in either of the cases cited above.

39. It could also be inferred from that case-law that it is for the competent German authorities to determine whether the colours blue and yellow per se can be registered as a trade mark for the goods referred to in the application for registration, taking into account the criteria identified by the Court in *Libertel*. Consequently, those authorities should take account of all the circumstances of the case, in particular the use which has been made of those colours, the general interest in not unduly restricting the availability of those colours for the other operators who offer for sale goods of the same type and, finally, the number of products in respect of which registration is sought, since that criterion is relevant to assessing both the distinctive character of the colours concerned and the general interest in keeping them available.

40. I am unable to endorse that case-law. Although the reasons on which I base my view that two colours per se do not satisfy the conditions laid down in Article 2 of the directive largely correspond with those which I previously set out in my Opinion in the *Libertel* case, I consider that the particular circumstances of this case, relating to an application for registration for two colours per se, and the maintenance by the Bundespatentgericht of the present reference for a preliminary ruling despite that judgment, make it appropriate to request the Court to reconsider the question.

41. I shall not reproduce here all the arguments which I set out in my Opinion in *Libertel*. I would ask that the Court kindly refer to that Opinion as necessary. I shall merely set out here the main reasons why I believe that two colours per se do not satisfy the conditions laid down in Article 2 of the directive. I shall also state why, in my opinion, the opposite conclusion could be contrary to the objectives of the directive.

*A — The conditions laid down in Article 2 of the directive*

42. As I have stated, Heidelberger Bauchemie seeks registration as a trade mark for the colours blue and yellow as they are represented in its application for registration and designated by their reference in the RAL identification code, in no particular arrangement. As the Bundespatentgericht states very clearly, such an application must be interpreted as meaning that the appellant seeks protection for the colours per se in general and abstract terms, without any two- or three-dimensional delineation or the least configuration, that is to say, without limitation as to particular form, shape, presentation or arrangement. In such a case, the applicant wishes to be able to use those colours in the manner desired by it in order to designate the goods referred to in the application for registration and to be pro-

tected in relation to all those uses. The protectable subject-matter is therefore the use of the two colours in question in order to designate the goods referred to in the application for registration, irrespective of the arrangement in which those colours are to appear in relation to those goods.<sup>37</sup>

43. In the light of those considerations, I take the view that the conditions laid down in Article 2 of the directive are not satisfied. I shall begin with the condition of capability of having distinctive character, which is the essential function of a trade mark.

#### 1. Capability of having distinctive character

44. As we have seen, where an application for registration relates to two colours per se, it seeks exclusive rights in those colours,

37 — Such an application is therefore different from applications to register trade marks comprising colours applied to a product in a particular arrangement, as was the situation in the cases which the Court of First Instance has had to hear and determine, which concerned tablets for washing machines or dishwashers (see, inter alia, Case T-335/99 *Henkel v OHIM* [2001] ECR II-2581 (rectangular red and white tablet) and Case T-30/00 *Henkel v OHIM* [2001] ECR II-2663 (image of a detergent)). In those cases, the trade marks at issue were three-dimensional or figurative, in the form or representation in perspective of a tablet consisting of two layers of different colours). However, the main action in this case is comparable to that in the cases which gave rise to the judgments in *Viking-Umwelttechnik v OHIM* (juxtaposition of green and grey) and *Andreas Stihl v OHIM* (combination of orange and grey), cited above, in which the applicants had applied to the Office for Harmonisation in the Internal Market (trade marks and designs) (OHIM) for registration as a Community trade mark of two colours — green and grey in the first case and orange and grey in the second — which were in no particular arrangement in relation to each other.

irrespective of the arrangement in which those colours are likely to appear in relation to the goods or services referred to in that application. The answer to be given to the question whether those two colours are capable of distinguishing the goods or services of one undertaking from those of another undertaking, irrespective of the arrangement in which they will appear in relation to those goods or services, must therefore follow logically from the assessment of their capability of having distinctive character for the purposes of Article 2 of the directive.

45. I think that the answer to such a question should be in the negative. The number of potential arrangements of two colours together in relation to a product or service is practically unlimited. Thus the proprietor of a trade mark consisting of the colours blue and yellow per se could use them on the external surface of the goods concerned or their packaging by alternating blue and yellow stripes, or with geometrical figures such as blue circles on a yellow background, etc. However, the overall impression produced by those colours and therefore their ability to have distinctive character will be very different depending on the arrangement chosen by the proprietor and the proportion in which each of those colours is used in relation to the other.

46. As the Court pointed out in *Libertel*, whilst colours are capable of conveying certain associations of ideas, and of arousing

feelings, they possess little inherent capacity for communicating 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.<sup>38</sup> Two colours together are therefore capable of having distinctive character only in the context of certain specified arrangements.

47. However, to accept that two colours per se are capable of having distinctive character on the ground that they may satisfy that condition, but only in the context of certain specified arrangements, would amount, in my view, to misinterpreting the very purpose of the application for registration, which seeks exclusive rights in all the possible forms in which those colours may appear. In the case of a word mark, that would amount to accepting that a number of letters may have distinctive character and that each of them may be the subject of exclusive rights on the ground that, where those letters form a certain word, they are capable of having distinctive character.

48. Contrary to what Heidelberger Bau-chemie maintains and to the position

adopted by the Court in *Libertel*,<sup>39</sup> I likewise do not believe that one or more colours per se can acquire distinctive character through the use made of them. As Heidelberger Bauchemie very honestly stated in its written observations<sup>40</sup> and at the hearing, undertakings wishing to accustom the public to their 'house' colours and to use those colours in order to identify their products will be wary of resorting to forms of appearance which no longer make it possible to distinguish an origin and, in practice, those colours are always used in a certain configuration. That is also the analysis accepted by the Court of First Instance in its judgments in *Viking-Umwelttechnik v OHIM* (juxtaposition of green and grey)<sup>41</sup> and *Andreas Stihl v OHIM* (combination of orange and grey),<sup>42</sup> cited above, in which it held that displaying the colours on the products in question in an unsystematic 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.

49. That assessment can be generalised. I think that a familiarisation process can succeed in conferring distinctive character on one or more colours only if they are used in relation to the same product or service under identical or sufficiently similar conditions. In the same way, that process can succeed for goods or services belonging to different categories only if the conditions

39 — Paragraph 67.

40 — Page 7.

41 — Paragraph 34.

42 — Paragraph 37.

38 — Paragraph 40.

under which the colours appear in relation to all the goods and services concerned have enough common features to enable consumers to attribute the same origin to all those goods and services. In other words, I do not think that familiarising consumers with an undertaking's two 'house' colours gives grounds for presuming that those same consumers could recognise that undertaking's goods or services regardless of the arrangements in which those colours will be used subsequently in relation to those goods or services.

50. In the light of those considerations, I therefore take the view that two colours per se should not be regarded as being capable of having distinctive character for the purposes of Article 2 of the directive. Their capability of satisfying the second condition, relating to graphic representation, seems even more questionable.

## 2. Graphic representation

51. It is clear from the case-law that the graphic representation required by Article 2 of the directive must enable the sign to be represented visually, particularly by means of

images, lines or characters, so that it can be precisely identified, and that the representation in question must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.<sup>43</sup>

52. It is also clear from the case-law referred to above that that requirement meets *inter alia* the following two objectives. The first is to enable the competent authorities to carry out the prior examination of registration applications and the publication and maintenance of an appropriate and precise register of trade marks. The second objective, which is largely dependent on the satisfactory attainment of the first, is to make it possible for economic operators to be able to acquaint themselves with registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties.<sup>44</sup> In that respect, the system of trade mark law contributes to legal certainty.<sup>45</sup>

53. Contrary to what the Court held in *Libertel*, I do not think that the designation of a colour by an internationally recognised identification code and, *a fortiori*, such a designation of two colours could enable the objectives specified above to be attained. The attainment of those objectives implies that

<sup>43</sup> — *Sieckmann*, cited above, paragraphs 46 to 55; *Libertel*, cited above, paragraphs 28 and 29; and *Shield Mark*, cited above, paragraph 51.

<sup>44</sup> — *Sieckmann*, paragraphs 48 to 51.

<sup>45</sup> — *Ibid.*, paragraph 37.

the competent authorities and the other economic operators must be able to determine whether a trade mark consisting of two colours per se is identical or poses a likelihood of confusion with another sign designating identical or similar goods or services.

54. Thus, under Article 4 of the directive, the competent authorities must refuse to register a sign if it is identical with an earlier mark and if the goods or services covered by that sign and that mark are also identical. The same article also provides that those authorities must refuse registration if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods and services concerned, there exists a likelihood of confusion on the part of the public.

55. Similarly, Article 5 of the directive provides that the proprietor of a trade mark is to be entitled to prevent all third parties, in the course of trade and not having his consent, firstly, from using any sign which is identical with a trade mark in relation to goods or services which are identical with those for which the trade mark is registered. Secondly, he may also prevent the use of any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services in question, there exists a likelihood of confusion on the part of the public.

56. However, assessing ‘identity’ and ‘likelihood of confusion’ necessarily implies precise knowledge of the sign and the trade mark in question as they may be perceived by the relevant section of the public. That analysis follows from the Court’s case-law relating to the criteria on the basis of which those concepts must be assessed, to the effect that those criteria must be identical under Articles 4 and 5 of the directive.<sup>46</sup>

57. Thus, in *LTI Diffusion*, the Court stated that the definition of ‘identity’ implies that the two elements compared should be the same in all respects.<sup>47</sup> It inferred from that that there is identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.<sup>48</sup> However, it added that the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect, and that the sign must be viewed as a whole.<sup>49</sup>

58. Similarly, according to the case-law, the likelihood of confusion on the part of the

46 — See, to that effect, Case C-291/00 *LTI Diffusion* [2003] ECR I-2799, paragraph 43.

47 — Paragraph 50.

48 — Paragraph 51.

49 — Paragraph 52.

public must be appreciated globally, taking into account all factors relevant to the circumstances of the case.<sup>50</sup> That global appreciation must take into account *inter alia* the visual, aural or conceptual similarity of the marks in question and be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components.<sup>51</sup> Finally, that appreciation must be made in the light of the perception of the mark in the mind of the average consumer of the goods and services concerned.<sup>52</sup>

59. It follows that the graphic representation of the trade mark must enable the competent authorities and the other economic operators to compare the overall impressions created by the sign and the trade mark in question, bearing in mind their distinctive and dominant elements. Clearly, the competent authorities would have the greatest difficulty in making such a comparison where the trade mark consists of two colours *per se*. In reality, such a trade mark may assume very different forms. It is undeniable that, depending on the arrangement in which the colours appear and, in particular, the proportion of each colour in relation to the other, the overall impression created by the trade mark, as well as its distinctive and dominant elements, may be very different.

50 — Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 16; Case 342/97 *Lloyd SchuhfabrikMeyer* [1999] ECR I-3819, paragraph 18; and Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40.

51 — *SABEL*, cited above, paragraph 23, and *Lloyd Schuhfabrik Meyer*, cited above, paragraph 25.

52 — *Idem*.

60. Consequently, faced with an application to register two colours *per se*, the competent authorities would find it very difficult to assess, on the basis of the criteria laid down in the case-law cited above, whether that trade mark could be deemed identical or pose a likelihood of confusion with a trade mark already registered for identical or similar goods or services and made up of those colours or of one of them, or of similar shades. Similarly, if a mark consisting of two colours *per se* were registered, the competent authorities could not determine whether, pursuant to those criteria, the application to register a sign made up of one of the two colours in question, or of similar shades, should fail on one of the grounds for refusal referred to in Article 4 of the directive. It should be recalled that, in *Libertel*, the Court pointed out that the scheme of the directive, which is founded on review prior to registration, not on a *posteriori* review, implies that the examination of the application for registration should not merely be a minimal check but, on the contrary, must be stringent and comprehensive in nature, in order to prevent trade marks from being improperly registered.<sup>53</sup>

61. For the same reasons, an economic operator, faced with a trade mark consisting of two colours *per se*, would be unable to determine with certainty what his rights were in relation to those colours and similar shades in respect of goods or services identical or similar to those for which that

53 — Paragraph 59.

trade mark was registered. Consequently, he might consider, like the Netherlands Government,<sup>54</sup> that he was entitled to use those colours in a figurative sign because a trade mark made up of two colours per se is so general and unspecific that there is no similarity or likelihood of confusion between it and that sign. On the other hand, he might think, like the United Kingdom,<sup>55</sup> that the proprietor of a trade mark consisting of two colours per se is protected against use in the course of trade of identical or similar colours, irrespective of the form in which those colours are used. Such uncertainty demonstrates that the requirement of legal certainty, which constitutes one of the objectives underlying the condition that a sign must be capable of being represented graphically, would not be observed.

62. The designation of two colours per se by an internationally recognised identification code cannot therefore be considered a graphic representation for the purposes of Article 2 of the directive.

### 3. Existence of a sign

63. It was in *Libertel* that the Court first made the existence of a sign a separate

condition for capability of constituting a trade mark for the purposes of Article 2 of the directive. However, it did not give a definition of 'sign'. In the ordinary sense of the term, a sign is a thing perceived which demonstrates the existence or truth of another thing, to which it is linked. A sign is therefore something which is perceived and which can be identified as such.

64. That is also the interpretation of 'sign' which the Court seems to have adopted in *Libertel* when it states that a colour per se cannot be presumed to constitute a sign, because normally a colour is a simple property of things. A colour may therefore constitute a sign only in a certain context.<sup>56</sup>

65. However, the Court went on to state that a colour per se is capable, in relation to a product or service, of constituting a sign.<sup>57</sup> That conclusion is not consistent with the foregoing. If, as I also believe, a colour can constitute a sign only in a certain context, that is no longer a colour per se, that is to say, a colour as an abstract entity, because the latter is never encountered in reality. The sign is the colour used within that particular context, that is to say, as it covers a product or the packaging of a product or as it appears

54 — Written observations, point 35.

55 — Written observations, point 33.

56 — Paragraph 27.

57 — *Idem*.



within a well-defined shape or outline. It is that very particular context which enables a colour to become a sign. As that ability to become a sign depends on that context, a colour per se may serve to form various signs for the purpose of designating certain goods or services.

66. The same analysis is dictated, a fortiori, with regard to an application to register two colours per se. Two colours may serve to form a large, or even unlimited, number of signs in relation to goods or services. As I have stated previously, that is indeed the aim pursued by the applicant seeking such a trade mark, who intends thereby to reserve to himself the right to use the colours in question as he sees fit to designate his goods or services. It follows that, in such a case, the applicant is not depositing a sign for registration, but the elements from which he will subsequently be able to create all the signs he wishes.

67. As the Bundespatentgericht rightly maintains, the scheme of the directive places on the applicant an obligation to be precise with regard to the sign which he will use or has actually been using, that obligation being the consideration for the exclusive rights which registration of that sign will confer on him. For those reasons, I am of the opinion

that two colours per se do not constitute a sign within the meaning of Article 2 of the directive.

68. Finally, I think that the addition of colours per se to the list of signs of which a trade mark may consist, which is set out in Article 2 of the directive, is not in keeping with the objectives of the directive.

#### B — *The objectives of the directive*

69. The purpose of the directive, as stated in the first, seventh, ninth and tenth recitals in the preamble, is to make the acquisition of a right in a trade mark and the protection of the rights which the trade mark confers on its proprietor subject to identical conditions in all the Member States. It is also established that that harmonisation is intended to eliminate the disparities in the trade mark laws of the Member States, which may impede the free movement of goods and freedom to provide services. The directive thus seeks to encourage free competition in the common market.

70. The attainment of those objectives therefore implies that the registration of a trade mark and the protection which that registration confers on its proprietor should

be subject to identical conditions in all the Member States. In that regard, as we have seen above, the Court has specified the criteria on the basis of which 'identity' and 'likelihood of confusion' must be assessed, both under Article 4, which concerns the grounds for refusing registration, and under Article 5, which specifies the rights conferred by a trade mark.

therefore not preclude an application to register those colours per se as a trade mark. Moreover, the proprietor of such a trade mark could not oppose the use of the same colours or similar shades by his competitors in very specific figurative marks. The registration of trade marks consisting of two colours per se would therefore be granted all the more readily since such marks would be regarded as 'weak' marks.

71. However, as I have also pointed out, the national authorities would have the greatest difficulty in applying those criteria to a trade mark consisting of two colours per se, in view of the fact that those colours do not represent the sign used or to be used in reality by the applicant in order to designate his goods or services, but represent a large, or even unlimited, number of potential signs. They might therefore consider, like the Netherlands Government, that a trade mark consisting of two colours per se is so abstract that it does not pose a likelihood of confusion with figurative marks which use the same colours or similar shades in a well-defined configuration. Thus they might take the view, for example, that a trade mark consisting of the colours blue and yellow per se was not identical and did not pose a likelihood of confusion with a sign consisting of a yellow circle in the centre of a blue square, since such a sign was distinguished from the trade mark in question by virtue of its very specific shapes, namely a circle in a square. The existence of figurative marks made up of the colours in question would

72. On the other hand, the competent authorities of other Member States might consider that the registration of colours per se as trade marks is such to confer on their proprietors exclusive rights in those colours and similar shades, irrespective of the form or arrangement in which those colours may appear in relation to the goods or services concerned. In those circumstances, the earlier registration of figurative marks made up of one or both of the two colours in question could be regarded as an obstacle to an application to register those colours per se or similar shades as a trade mark. Similarly, the registration of such a trade mark could enable its proprietor to oppose any use, in any form whatsoever, in the course of trade of those colours in relation to the goods or services referred to in the application for registration.

73. Accepting that two colours per se may be registered as a trade mark could therefore give rise to major differences between the

competent national authorities as to the conditions under which such trade marks can be registered and protected. Those differences would also be such as to jeopardise free competition on a given market. An economic operator designating his goods or services with a figurative trade mark made up of one or more colours could be prevented from offering his goods or services for sale under the same trade mark in another Member State, in which the registration of colours per se as trade marks is construed as conferring exclusive rights in any use of those colours in relation to goods or services identical or similar to those covered by the registration. In any event, the uncertainty as to the rights which the registration of colours per se as trade marks confers on their proprietors in a given State could on its own dissuade that operator from offering his goods or services for sale in that State so as not to run the risk of being sued.

74. Moreover, the virtual impossibility of applying the criteria identified by the case-law for the purpose of assessing 'identity' and 'likelihood of confusion' with regard to a sign consisting of two colours per se is also liable to result in very different applications by the competent national authorities of the criteria identified in *Libertel*. In particular, taking into account the requirement of availability could give rise to very different applications

depending on whether or not the national authorities considered that the registration of two colours per se as a trade mark prevented other economic operators from using those same colours or similar shades in any form whatsoever.

75. Finally, contrary to the Commission and Heidelberg Bauchemie, I do not think that the legal uncertainties which would arise from registering colours per se as trade marks could be resolved by the case-law in a manner fully consistent with the scheme and objectives of the directive. We have seen that the question of how to assess 'identity' and 'likelihood of confusion' with a trade mark made up of two colours per se may give rise to two different views of the extent of the rights conferred by such a trade mark: it may either be regarded as a 'weak' trade mark or as a trade mark which confers exclusive rights in any use of the colours in question and similar shades in relation to goods identical or similar to those referred to in the application for registration.

76. In my view, either of those alternative approaches would be questionable in the light of the scheme and objectives of the directive.

77. With regard to the view that trade marks made up of two colours per se would be 'weak' trade marks, it is not consistent with the intention of the legislature which did not want to encourage the development of such trade marks in the directive. On the contrary, it wished to limit the number of trade marks registered and to confer on those trade marks the same high level of protection in all the Member States.<sup>58</sup> Moreover, that view would deprive the registration of that type of trade mark of much of its advantage for economic operators.

78. With regard to the opposite view, that registration of two colours per se as a trade mark would confer on the proprietor exclusive rights in those colours, irrespective of the arrangement in which those colours might appear in relation to the goods and services concerned, it has the effect of conferring on the trade mark proprietor more extensive protection than the sign which he has been or will be using in reality. That consequence is contrary to the system of trade mark law. It is a paradox of that system that it confers on one economic operator in particular exclusive rights of unlimited duration in signs serving to market goods and services for the purpose of encouraging competition on a given market. The case-law has very logically inferred from that paradox that such exclusive rights may be granted only to the extent that the signs in

question actually fulfil their function as an indication of origin.<sup>59</sup>

79. Moreover, registration of two colours per se as a trade mark would undermine the effectiveness of the provisions of Articles 10 and 12 of the directive with regard to the obligations of the proprietor of such a trade mark. We know that, pursuant to Articles 10 and 12 of the directive, the proprietor of a trade mark must put it to genuine use, failing which it will be revoked. Under Article 10(2), genuine use of a trade mark means its use in a form differing in elements which do not alter its distinctive character in the form in which it was registered. It follows that the implementation of those provisions necessarily implies that the registration of two colours as a trade mark should be allowed only if the colours are in a particular arrangement. If the trade mark consists of the colours per se, any use of those colours to designate the goods or services concerned

59 — See, inter alia, Case C-206/01 *Arsenal Football Club* [2002] ECR I-10273, paragraph 51, and *LTI Diffusion*, cited above, paragraph 48. To that effect, reference should also be made to the Court's interpretation of Article 30 EC, according to which the derogations allowed by that article from the principle of free movement of goods for the purpose of ensuring the protection of industrial and commercial property are justified only in so far as they are intended to safeguard rights which constitute the specific subject-matter of that type of property (see, inter alia, Case 119/75 *Terrapin* [1976] ECR 1039, paragraph 5, and Case C-143/00 *Boehringer Ingelheim and Others* [2002] ECR I-3759, paragraph 28). See, also, the Court's case-law on the interpretation of Article 7 of the directive, relating to exhaustion of the rights conferred by a trade mark (see, inter alia, Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb and Others* [1996] ECR I-3457, paragraphs 41 and 42).

58 — Eighth to tenth recitals in the preamble.

could then suffice to constitute genuine use of the trade mark and thus preserve exclusive rights in those colours for an unlimited period.

80. In the light of all those considerations, I take the view that the registration of two colours per se as a trade mark should not be assessed restrictively on a case-by-case basis

under Article 3 of the directive, but should be excluded in principle under Article 2. That is why I propose that the Court should reverse the position adopted in the *Libertel* judgment and reply to the Bundespatentgericht that colours or combinations of colours which are the subject of an application for registration as a trade mark, are claimed in the abstract and without delineation and in shades named in words by reference to a colour sample and specified according to a recognised colour classification system do not satisfy the conditions laid down in Article 2 of the directive.

## VI — Conclusion

81. In the light of the foregoing considerations, I propose that the Court should answer the questions referred by the Bundespatentgericht as follows:

Colours or combinations of colours which are the subject of an application for registration as a trade mark, are claimed in the abstract and without delineation and in shades named in words by reference to a colour sample and specified according to a recognised colour classification system do not satisfy the conditions laid down in Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, since they do not constitute a sign capable of being represented graphically and of distinguishing the goods and services of one undertaking from those of other undertakings.