

Now that *Glaxo Group Ltd v EUIPO* has been decided, what are the unresolved issues over colour marks? Where will the challenges come from?

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Graphical representation of colour marks

Glaxo Wellcome UK Ltd & Anr v Sandoz Ltd [2017] EWCA Civ 335

(a) The Mark in question

1. Glaxo's EUTM:



“The trade mark consists of the colour dark purple (Pantone code 2587C) applied to a significant proportion of an inhaler, and the colour light purple (Pantone code 2567C) applied to the remainder of the inhaler.”

- INID code 558 – the mark consists exclusively of one or more colours
 - Registered in respect of inhalers
2. In response to a claim for trade mark infringement brought by Glaxo based on the above EUTM, Sandoz counterclaimed that the mark was invalid on the basis that it covered a multitude of different forms and so was not capable of being represented graphically as required by Article 4 EUTMR.

(b) The EUTMR

3. Article 4 EUTMR (as it was at the time of the judgment):

“Signs of which an EU trade mark may consist

An EU 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.”

4. Article 4 EUTMR (current):

“Signs of which an EU trade mark may consist

An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, 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 the EU 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.”*

(c) Previous Case Law

5. **Libertel: C-104/01** – Application to register the colour orange in relation to various telecommunications goods and services. The application contained an orange rectangle and the word “orange” without reference to any colour code. On a reference to the CJEU, the CJEU held:

“68 The reply to the first question referred must therefore be that a colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of article 3(1)(b) and article 3(3) of the Directive, provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.”

6. **Heidelberger Bauchemie GmbH: C-49/02** – Application to register the colours blue and yellow with a) a rectangular piece of paper, the upper part of which was blue and the lower part yellow, accompanied by the following description:

“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”

The CJEU Held

“42 In light of the above, the answer to the questions must be that colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for the purposes of Art.2 of the Directive where:

- *It has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign; and*
- *The application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way...”*

7. **Nestlé v Cadbury [2014] RPC 7** – An application by Cadbury to register the colour purple in respect of various goods in Class 30. The application comprised a purple block of rectangular shape and this description:

“The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods.”

(d) The Decision

8. The Court of Appeal, found that the sign was not graphically represented and set out some principles derived from decisions of the CJEU:

“15 Some general points relating to the requirements of art.2 of the directive, which are relevant to this case, can be picked out of the judgments:

The conditions

(1) An application to register a trade mark must satisfy three conditions for the purposes of Article 2:

- a. There must be a sign;*
- b. It must be capable of graphic representation;*
- c. It must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.*

The Purpose

(2) The purpose of the requirements is to prevent abuse of trade mark law in order to obtain an unfair competitive advantage

Identification

(3) Identification requirements for entry of a trade mark on the public register of trade marks include clarity, intelligibility, specificity, precision, accessibility, uniformity, self-containment and objectivity.

Multitude of forms

(4) The identification requirements are not satisfied, if the mark could take on a multitude of different appearances, which would create problems for registration of the mark and give an unfair competitive advantage over competitors.

Colour with a message

(5) Colours are normally a simple property of things, or a means of decorating things. They are not normally capable of being a sign. A sign conveys a message. The sign is

capable of being registered as a trade mark, if the message is about the source of goods or services.

Colours as a sign conveying a message

(6) Depending on the facts and circumstances of the case, colours or combinations of colours, designated in the abstract and without contours and used in relation to a product or service are capable of being “a sign”.

Graphic representation of colour

(7) As for the second condition of graphical representation, in a mark consisting of two or more colours designated in the abstract and without contours, qualities of precision and uniformity are required. The colours must be arranged by associating them in a predetermined and uniform way.

Colour without form/in a multitude of forms

(8) Those requirements are not met by the mere juxta position of colours without shape or contours, or by reference to colours in every conceivable form, so that the consumer would not be able to recall or repeat with certainty the experience of a purchase. The scope of protection afforded by such a mark would be unknown both to the competent authorities responsible for maintaining the register and to economic competitors. Registration would confer unfair competitive advantages on the proprietor of the mark.”

9. In reaching its decision the CoA found that:

- a. The graphical representation encompasses not just the pictorial representation of the sign but also any description which accompanies it.
- b. The INID code used means that the EUTM was and would be understood to be a mark which consists exclusively of one or more colours. It is a colour *per se* mark. It is not a 2-d figurative mark having the appearance of a pictorial representation, nor is it a 3-D mark having a particular shape and coloured in a particular way.
- c. The public would be left in complete uncertainty as to what the protected sign actually was.
- d. The mark lacked clarity, intelligibility, precision, specificity and accessibility that the law demands.

- e. The lack of certainty would give Glaxo an unfair competitive advantage.

Glaxo Group Ltd v EUIPO: Case T-187/19

10. Glaxo sought to register as an EUTM the following colour sign:



With the following description 'Purple – Pantone: 2587C' for goods in Classes 5 and 10.

11. The mark was initially rejected as being devoid of distinctive character contrary to Article 7(1)(b) EUTMR. Glaxo filed evidence to support its claim to acquired distinctive character through use under Article 7(3). However, this was also rejected. Accordingly, Glaxo appealed to the Boards of Appeal who dismissed the appeal. Glaxo therefore appealed to the General Court which also dismissed its appeal.
12. The evidence which Glaxo relied on in support of its claim to acquired distinctiveness through use included:
 - a. Samples of marketing and promotional material, including packaging, leaflets, images taken at international exhibitions, samples of merchandising goods and a list of merchandising expenditures as regards the products (for 15 out of 28 member states);
 - b. Tables containing confidential data from IMS health showing sales and market share figures generated by the products 'Seretide' and 'Aliflus' between 2000 and 2014 in *all* EU member states;
 - c. Survey evidence on acquired distinctiveness 'of a purple colour' in various member states;
 - d. Print out from an article and blogs in various member states in order to show the recognition of the mark among the general public;
 - e. Declarations and witness statements from Glaxo employees;
 - f. Printouts showing rankings of the top selling drugs worldwide;

- g. Previous decisions from national courts in infringement proceedings by Glaxo in Germany and Sweden.

13. The General Court dismissed the appeal and made the following findings:

In relation to inherent distinctiveness:

- a. For a colour mark *per se*, distinctive character without any prior use is inconceivable save in exceptional circumstances
- b. On the relevant market and in particular, inhalers, colours could be used to convey to the public, information relating to the characteristics of the goods
- c. It would not be in the public interest for the availability of a colour to be restricted
- d. Novelty and originality are not relevant criteria in the assessment of whether a mark has distinctive character.

In relation to acquired distinctiveness:

- e. The function of a trade mark is just as important for the end user as it is for intermediaries involved in its marketing. Accordingly, patients were also an average consumer.
- f. Acquired distinctiveness must be demonstrated in the part of the EU where the mark was found to be devoid of distinctiveness. As there are no differences of language with a colour mark, the relevant area would be the whole of the EU.
- g. Sales figures and advertising material could only be considered as secondary evidence.
- h. The survey evidence adduced was insufficient/unreliable. The probative value of survey evidence depends on:
 - i. The method used and whether there is evidence to show that it is reliable;
 - ii. Whether the survey is carried out in the objective circumstances in which the mark at issue is present;
 - iii. Whether the interviewees have been shown several images;
 - iv. The accuracy/specificity of the colour shade(s) used;

- v. The number of persons surveyed;
- vi. How representative the chosen sample of interviewees are.

What issues and challenges remain in relation to colour marks?

‘Niche’ issues

14. In certain cases, an applicant for a colour mark *per se* may encounter the following same/similar issues to those which arose in Glaxo:
- a. The possibility that the colour may be found to be descriptive of a characteristic of the goods. Pharmaceuticals is only one example of a relevant market in which colours can play such a role.
 - b. Connected to a. above is the risk of the existence of Formal/Informal colour conventions.
 - c. The impact of having a monopoly. In Glaxo, the BoA found that the fact that the product that Glaxo uses the relevant colour for, was patent protected until 2013 affected the findings of the survey carried out in 2015 such that the findings would not mean that the specific colour of purple was perceived as a trade mark but rather, that they simply reflected the factual situation of the relevant market.

Wider issues – acquired distinctiveness

15. As well as there being found, in Glaxo to be a specific public interest in the availability of a colour being restricted (because it found to indicate a characteristic of the relevant goods), applicants for colour marks for different goods/services may also have to resist the argument that there is a public interest in not restricting the availability of colours generally.
16. It seems that in every case, an applicant for a colour mark will have to prove acquired distinctiveness across the whole of the EU. This could give rise to various issues, not only in terms of what amount/type of evidence will be sufficient but wider issues such as proportionality and the cost of the process of acquiring protection for a colour mark.
17. As with many other areas of trade mark law, surveys are likely to continue to raise issues.

Unresolved issues – Article 7(1)(e)(iii) EUTMR/s.3(2)(c) TMA

18. Article 7(1)(e)(iii) EUTMR provides,

“Absolute grounds for refusal

1. The following shall not be registered:

...

(e) signs which consist exclusively of:

(iii) the shape, or another characteristic, which gives substantial value to the goods.

19. In *Louboutin*, the words ‘or another characteristic’ had not yet been introduced. As a result of the introduction of these terms, could a colour mark (even one which has overcome the hurdles of (i) having a clear and precise graphical representation, and (ii) distinctiveness (proven through use)) be invalidated on the basis that it constitutes ‘another characteristic’ which gives substantial value to the goods? Or, if colour is found to constitute ‘another characteristic’ will the assessment under Article 7(1)(e)(iii) be limited to the intrinsic value of the shape or other characteristic, excluding the reputation of the mark or its proprietor?

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