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**ELIMINATION OF THE GRAPHICAL REPRESENTATION  
REQUIREMENT: IMPLICATIONS FOR COLOUR TRADE  
MARKS**

Bachelor's thesis

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I hereby declare that I have compiled the paper independently and all works, important standpoints and data by other authors has been properly referenced and the same paper has not been previously presented for grading.

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## **ABSTRACT**

This thesis has the aim of highlighting the implications of the elimination of the graphical representation requirement on colour trade marks. The thesis will focus on the new statutory language of Article 4 of Regulation (EU) 2017/1001 and Article 3 of Directive (EU) 2015/2436. The aim of this thesis is to answer how the legal status of colour trade marks is changed and clarified after the reform and how it will be easier to register colours in the future. In order to fulfil the aim of the thesis, means of theoretical research and qualitative methods will be utilized. By analysing the effects of the reform, the results indicate that the new definition for a trade mark does not clarify the legal position of colour trade marks nor provide substantial change. Albeit the registration of colours will become more flexible in theory, how the grey points will be addressed and resolved in practise will be left for the European Union Intellectual Property office to examine and, ultimately, the European Court of Justice.

Keywords: Trade mark, registration, graphical representation

## **LIST OF ABBREVIATIONS**

ECJ	European Court of Justice
EU	European Union
EUIPO	European Union Intellectual Property Office
EUTMD	Directive (EU) 2015/2436, OJ L 336, 23.12.2015
EUTMIR	Implementing Regulation (EU) 2017/1431, OJ L 205, 8.8.2017
EUTMR	Regulation (EU) 2017/1001, OJ L 154, 16.6.2017
IP	Intellectual Property
MPI	Max Planck Institute for Intellectual Property and Competition Law
MS	Member State

# 1. INTRODUCTION

## 1.1. Background

With increasing competition in the commercial environment, trade marks have increased not only their financial value but their role in market success. In order to attract and communicate with customers businesses have broadened their innovative and creative endeavours and expanded into new domains of trade mark elements

Whilst symbols and words have traditionally been understood as the crux of a trade mark, new elements, such as colours, have become a part of increasing significance in distinguishing the goods and services of different undertakings. Advertising and packaging have grown in importance to an extent where they can be considered as important as the product itself.<sup>1</sup> As part of the overall appearance, colour is an effective tool for creating brand identification<sup>2</sup> and can become the strongest quality of a brand, as colours give more personality to the product than any other part of the design.<sup>3</sup>

The law governing trade marks inevitably lagged behind. The European Union (EU) trade mark law was initially drafted to serve traditional trade marks, therefore poorly fitting the needs of non-traditional trade marks, such as colours. The requirements for what can constitute a trade mark, and the requirement of graphical representation specifically, created a great deal of legal uncertainty. The conditions for the registration of colour trademarks have predominantly been defined in case law which in itself is controversial and limited. Equally, concerns for the registration and protection of colours as trade marks have been put forward by courts and legal literature alike.

With the introduction of European trade mark Regulation (EU) 2017/1001<sup>4</sup> (EUTMR) EU trade mark (EUTM) is no longer required of graphical representation. The wording of the new EUTMR

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<sup>1</sup> Sahin, O. (2016) The Past, the Present and the Future of Colour and Smell Marks. *European Intellectual Property Review* 38(8), p 5

<sup>2</sup> Ahuja, V.K. (2010) Non-Traditional Trade Marks: New Dimensions of Trade Marks Law. *European Intellectual Property Review*, 32(11), p 4

<sup>3</sup> Lightwood, C.G. (1998) *Brands - the New Wealth Creators*. (Eds.) Hart, S., Murphy, J. New York: New York University Press, p 53 referenced in Palm, J. (2002) *Tavaramerkki, Kilpailu ja Alkuperä*. Helsinki: Suomalainen Lakimiesyhdistys 2002, p 66

<sup>4</sup> OJ L 154, 16.6.2017

is a considerable shift from the language of the previous Regulation (EC) 207/2009,<sup>5</sup> stating that the EUTM can be represented "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" instead of the previous requirement of graphical representation. The new EUTM Implementing Regulation (EU) 2017/1431<sup>6</sup> (EUTMIR) gives a non-exhaustive list of the ways in which EUTMs shall be presented.

## **1.2. Statement of purpose and the research questions**

This thesis will analyse the amendments introduced in EUTMR Article 4, creating a system for registration of EUTMs, EUTMIR Article 3 and the new EUTM Directive (EU) 2015/2436<sup>7</sup> (EUTMD) approximating laws within the Member States (MS). The wording of the old Directive (EU) 2008/95/EC<sup>8</sup> Article 2 will be used as a point of reference when discussing the previous graphical representation requirement for EUTMs.

The aim of this thesis is to look at and analyse the implications of the elimination of the graphical representation requirement on colour EUTMs. The aim of the thesis is to find an answer for the following research questions:

- How does the wording of the two enactments clarify and provide substantial change for the legal status of colour EUTMs?
- How will it be easier to register and protect and colour EUTM after the reform has entered into force?

## **1.3. Methodology**

In order to achieve the aim of the thesis, theoretical research and qualitative methods will be used. The qualitative methods incorporate the interpretation and systematisation of the different sources of law. The research will strive to identify and analyse the relevant legal instruments, case law and

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<sup>5</sup> OJ L 78, 24.3.2009

<sup>6</sup> OJ L 205, 8.8.2017

<sup>7</sup> OJ L 336, 23.12.2015

<sup>8</sup> OJ L 299, 8.11.2008

legal literature. Moreover, in order to reach the aim of the thesis, comparative analysis between EU and US will be drawn.

#### **1.4. Hypothesis**

The hypothesis which the author aims to put forward and demonstrate throughout the thesis is that the reform does not clarify the legal position of colours nor provide substantial change. However, the registration and protection of colours will become more flexible in theory, although how the unclarity will resolve in practice will depend on further case law to be developed in the future.

#### **1.5. Disposition**

The thesis will proceed as follows. The historical developments of EUTM and legal framework will be drawn in the second chapter. It is against this historical background that the recent developments in the EUTM system will be assessed. The context provided is necessary for further discussion to be developed on the graphical representation requirement in the third chapter of the thesis. This is also where the first research question will be answered. The fourth chapter will address the concerns put forward for granting colours the generous protection of EUTMs. The fifth chapter will look at the past, present and future of the legal situation of colour EUTMs in the light of the recent reform. The discussion developed in the fourth and fifth chapters will answer the second research question. The thesis will then move on to draw a parallel to the United States (US), comparing the legal framework as regards colours. Finally, the analysis and discussion developed will be concluded.



## 2. EU TRADE MARK LAW

### 2.1. The functions of EUTM

The position of trade marks has significantly strengthened and reformed through history, particularly after Industrial Revolution and technological development.<sup>9</sup> Originally, trade marks have been understood as means by which traders can build and protect their commercial reputation, thus indicating the origin of the product<sup>10</sup> and included a category of words, signs and logos. Later, other ancillary functions developed as a direct consequence of the origin function. As a consequence, the function of a trade mark has shifted from being an indicator of ownership or origin to assisting in purchasing decisions by reflecting a specific manufacturer and standard of quality, to becoming a valuable asset in their own right.<sup>11</sup> This second category of new trade marks, or non-traditional trade marks, includes elements such as colours, sounds and olfactory elements.<sup>12</sup> Trade marks have developed advertising quality being an important marketing tool for communicating information to customers and serving as means for achieving market success. Today, trade marks are widely known for their ability to convey status or emotion and have become an enabling tool for fulfilling our social and practical needs.<sup>13</sup>

### 2.2. Legal framework

Being at the forefront of legal development, not only the function of EUTMs but also their legal position has gone through significant change. The legal status of intellectual property (IP) rights within the EU came about by the establishment of the European Economic Community in 1957<sup>14</sup>

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<sup>9</sup> Pila, J. Torremans, P. (2016) *European Intellectual Property Law*, 2nd Edition. New York: Oxford University Press, p 693-694

<sup>10</sup> Keeling, David (2003) *Intellectual Property Rights in EU Law. Volume 1, Free Movement and Competition Law*. New York: New York University Press, p 147

<sup>11</sup> Cornish, W. (1996) *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 3rd Edition. London: Sweet & Maxwell referenced in Turpela, H. *Väri- ja äänne-merkin erottamiskyky ja suoja-ala oikeuskäytännössä ja kirjallisuudessa*, Master's thesis, University of Helsinki, Department of Law 2015, p 6

<sup>12</sup> Carapeto, R. (2016) *A reflection About the Introduction of Non-Traditional Trademarks*. *Waseda Bulletin of Comparative Law*. Vol. 34, p 25-26

<sup>13</sup> Jon Edge and Andy Milligan, *Don't Mess with the Logo, The Straight-talkers Bible of Branding*, 2009 at 5-6 referenced in Weckström, (2011) *A Contextual Approach to Limits in EU Trade Mark Law*. Helsinki: IPR University Center, p 1

<sup>14</sup> De Burca, G., Graig, P. (2015) *EU Law: Text, Cases and Materials*. Oxford: Oxford University Press, p 4-5

and since then have gone through significant Europeanization and harmonization.<sup>15</sup> The first EUTMD 89/104/EEC was passed in 1988<sup>16</sup> after extensive negotiation and compromise between MSs. The aim of the EUTMD was the harmonization of laws of the MSs and to remove any barriers to free trade within the EU and was novel in that it did not have a counterpart in any MS's national legislation. The second significant element, the EUTM, was established in 1994 with the EUTMR (EC) No 40/94.<sup>17</sup> The EUTM allowed undertakings to gain the widest protection possible for their signs within the EU. Much has changed since the introduction of the EUTMD in 1988. The widening scope of EUTM protection outside the original rationale in addition to the registration and protection of new types of EUTMs have been on the agenda.<sup>18</sup> After the recent amendments, the EUTM system is regulated by EUTMD and EUTMR, supplemented by the European Intellectual Property Office (EUIPO).

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<sup>15</sup> Ohly, A., Pila, H. (2013) *The Europeanization of Intellectual Property Law: Towards a European Legal Methodology*. Oxford: Oxford University press, p 76-77

<sup>16</sup> OJ L 40, 11.2.1989

<sup>17</sup> OJ L 11, 14.1.1994

<sup>18</sup> Nooteboom, E. (1997) *The EC TMD: The View of the European Commission* in Hansen (Ed.) *International Intellectual Property Law & Policy – Volume 5* referenced in Weckström, (2011), *supra nota* 13, p 2

### 3. THE GRAPHICAL REPRESENTATION REQUIREMENT

Trade mark law focuses on what constitutes an EUTM instead of what does not and therefore has been traditionally framed in the form of negative rights.<sup>19</sup> The definition of what comprises EUTM is rather straightforward and, up until the reform was introduced, rested on three basic components. Article 2 of the old EUTMD and Article 4 of the previous EUTMR state that an EUTM may consist of “any signs capable of being represented graphically, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”. Additionally, these provisions contain a non-exhaustive list of examples, namely words, including personal names, designs, letters, numerals, the shape of goods, or of their packaging. Thus, there is unlikely to be any sign in theory which would have been incapable of functioning as an EUTM *per se*. Indeed, the ECJ has clarified that the provisions do not allow MSs to exclude certain signs from being afforded protection.<sup>20</sup> Be that as it may, the requirements for registration of EUTM were that it be a sign, distinctive as to origin and able of being represented graphically.

#### 3.1. Justifications for the graphical representation requirement and its elimination

The ECJ has justified the graphical representation requirement based on three separate grounds,<sup>21</sup> that is to say, by the three functions it served. As formulated in *Sieckmann*,<sup>22</sup> the functions of the graphical representation requirement were the bureaucratic function,<sup>23</sup> the definitional function,<sup>24</sup> and the informational function.<sup>25</sup> At first, the bureaucratic function was based on practicalities. At that time it was thought the application and registration systems for EUTMs would consist of a box into which the trademark should fit into.<sup>26</sup> Particularly during the era of paper filings that appeared to correspond to the possibility of graphical representation and, accordingly, served the needs of traditional EUTMs.<sup>27</sup> The ability to represent the sign applied for in a box allowed the

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<sup>19</sup> Weckström, (2011) *supra nota* 13, p 3

<sup>20</sup> Judgement of the Court, 12.12.2002, Ralf Sieckmann v Deutsches Patent- und Markenamt, Case C-273/00, ECLI:EU:C:2002:748, point 45

<sup>21</sup> Sahin (2016) *supra nota* 1, p 3

<sup>22</sup> Ralf Sieckmann v Deutsches Patent- und Markenamt, *supra nota* 20

<sup>23</sup> *Ibid*, point 50

<sup>24</sup> *Ibid*, point 48

<sup>25</sup> *Ibid*, point 49

<sup>26</sup> Pila, Torremans, (2016), *supra nota* 9, p 368

<sup>27</sup> Sahin (2016) *supra nota* 1, p 3

registrar and any other party to comprehend what was in fact the object of protection. Additionally, it simplified the processes of examination, publication and maintenance of EUTMs for competent authorities.<sup>28</sup> As noted, the ability to represent the sign graphically allowed anyone to see on the register precisely and clearly what the EUTM was and who has applied for its registration. Thus, in the definitional function graphical representation also provided for legal certainty.<sup>29</sup> Likewise, the way in which the EUTM was represented graphically in the application would later define the scope of the protection it would be afforded. Finally, the informational function provided competitors and general public information on the sign. Moreover, if colour EUTM was in uniformity with the requirements for registration and with the graphical representation requirement in particular, and therefore in uniformity with the appearance of EUTMs in the application and registration processes, the graphical representation requirement could also be understood to have a procedural dimension in addition to its substantial dimension.<sup>30</sup>

The graphical representation requirement went on to cause more uncertainty and discrepancy than was presumably first predicted, as case law went on to demonstrate. The ability to be represented graphically has been the single most significant obstacle for the registration and protection colours as EUTMs. The issue was first addressed by the ECJ in 2002 in the case *Sieckmann*.<sup>31</sup> The ECJ stated first that signs are not excluded from protection by lack of visual perceptibility. However, in order to fulfil the requirements laid down in Article 2 EUTMD and Article 4 EUTMR, the sign must be able to be represented in a manner that is clear, precise, self-contained, easily accessible, intelligible, durable and objective.<sup>32</sup> As protection will be granted upon registration, EUTMs need to fulfil certain criteria which will be examined absent of any use of the sign and based on the description in the application. For legal certainty the claim must determine exactly what is protected and the full nature and scope of the sign.<sup>33</sup>

Further case law went on to formulate that in order for a colour to fulfil the graphical representation requirement it would first have to be specified using a recognised colour coding system such as Pantone, RAL, RGB, CMYK or Hex.<sup>34</sup> In *Libertel*, a mere description of the colour or a colour

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<sup>28</sup> Sahin (2016) *supra nota* 1, p 3

<sup>29</sup> Palm, J. (2002) *supra nota* 3, p 65

<sup>30</sup> Sahin (2016) *supra nota* 1, p 9

<sup>31</sup> Ralf Sieckmann v Deutsches Patent- und Markenamt, *supra nota* 19

<sup>32</sup> *Ibid*, point 55

<sup>33</sup> Opinion of Advocate General Ruiz-Jarabo Colomer delivered on 6 November 2001, point 36

<sup>34</sup> EUIPO Decision No EX-17-1 adopted by the Executive Director "Guidelines for Examination of the European Union Trade Marks" Published 1 October 2017, Part B, point 9.6. Colour Marks

sample was found to be insufficient<sup>35</sup> as it can deteriorate in time and is not precise and objective. The same stand was taken with regard Heidelberger Bauchemie's trademark application<sup>36</sup> where it was recommended the mark be accompanied with an internationally recognised colour code. In *Nestlé v Cadbury*,<sup>37</sup> the Court found that the trademark applied for was not just the colour purple as a sign, but a variety of different signs in which the colour purple was predominately applied on the whole visible surface of the packaging of the goods<sup>38</sup> and was found to not satisfy the requirement of graphical representation.<sup>39</sup>

In 2009 the Max Planck Institute for Intellectual Property and Competition Law (MPI) undertook a study of the functioning of the EUTM system on behalf of the European Commission. The results of the study were published on 15 February 2011 and suggested that the requirement of graphical representation be removed as it was found to be outdated.<sup>40</sup> MPI consulted several associations involved with the EUTM system most of which were in favour of the amendment of the statutory language in such a way that would allow for a more liberal practice regarding the representation of EUTMs.<sup>41</sup> Among the concerns of opponents were that the graphical representation requirement served for publication, opposition and search purposes. Additionally, it was argued that some EU national offices lack the level of technology and equipment needed which in turn would create unpredictability and divergences between national offices, thus jeopardizing the cost and efficiency of the EUTM system.<sup>42</sup>

### **3.2. New notion for representation**

From 1 October 2017 onwards, the requirement of graphical representation was abolished with the introduction of the new EUTMD and EUTMR. Article 4(b) EUTMR states that representation must be made in a manner which "enables the competent authorities and the public to determine

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<sup>35</sup> Judgement of the Court, 6.5.2003, *Libertel Groep BV v Benelux-Merkenbureau*, Case C-104/01, ECLI:EU:C:2003:244

<sup>36</sup> Judgement of the Court (Second Chamber), 24.6.2004, *Heidelberg Bauchemie GmbH*, Case C-49/02, ECLI:EU:C:2004:384

<sup>37</sup> High Court of Justice of England and Wales-Chancery Vision, *Sociétés des Produits Nestlé SA v Cadbury UK Ltd* [2013] E.W.C.A. Civ. 1174

<sup>38</sup> *Ibid*, point 55

<sup>39</sup> *Ibid*

<sup>40</sup> Study on the Overall Functioning of the European Trade Mark System (2011). Munich: Max Planck Institute for Intellectual Property and Competition Law, p 66-67

<sup>41</sup> *Ibid*

<sup>42</sup> *Ibid*, pp 31-38

the clear and precise subject matter of protection". Article 3(3) EUTMIR lists non-exhaustively ways in which signs can be represented. In the EUTMIR, the Commission explains that the objectives for the new forms of representation are *inter alia* to modernise and improve the existing provisions, to increase legal certainty and clarify EUTM rights in terms of their scope and limitations. The proposed new definition would not restrict the means by which the EUTM applied for is represented but rather allows for representation by technological means offering satisfactory guarantees. Moreover, the Commission notes that the aim is not to make a boundless extension but rather to allow for more flexibility and greater legal certainty.

### **3.3. Implications for the Sieckmann criteria**

After the proposal entered into force, the amendments abolished the graphical representation requirement and allowed for EUTMs to be represented in a manner which would enable competent authorities to determine the subject matter of protection. Consequently, various technical means can be utilized in representation. Thus, some claim that the Sieckmann criteria will be codified<sup>43</sup> whilst others argue that the judgement will be overridden.<sup>44</sup> Onur Sahin argues for the latter, claiming that since the Sieckmann criteria merely describes the way in which the sign must be represented graphically, correspondingly the means which do not meet these requirements will be allowed. In his view, the seven criteria merely provide guidance on determining precise subject of protection, which will be technically eliminated after the reform.<sup>45</sup>

As regards some forms of non-traditional EUTMs, it seems that the Sieckmann criteria would need at least some form of adaption. The statutory language indicates that the sign can be represented using "generally available technology" and thus placing the wording in contradiction with the Sieckmann criteria. Taking for example 3D-marks, the requirement of self-containment excludes the possibility of utilizing a 3D-viewing technology as the term "self-contained" refers to a representation of the EUTM without the aid of exterior means. Even so, the EUTM reform is a

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<sup>43</sup> See for example Adams, M., Scardamaglia, A. (2018) Non-Traditional Trade Marks in Europe: An Historical Snapshot of Applications and Registrations. *European Intellectual Property Review*, 40(10), p 3 or Fields, D., Muller, A. (2017) Going Against Tradition: The Effect of Eliminating the Requirement of Representing a Trade Mark Graphically on Applications for Non-Traditional Trademarks. *European Intellectual Property Review*, 39(4), at p 2

<sup>44</sup> Sahin, (2016), *supra nota* 1, p 11

<sup>45</sup> *Ibid*

significant step in bringing the system on par with innovative signs utilising increasing technological developments and digitalisation.

### **3.4. Where does this leave colours?**

As regards colours, the access for registration and protection could be expanded by the new statutory language and the propositions of clarity, precision, accessibility and objectivity. However, one should note that even before the reform colours could be perceived by sight and as such demonstrated visually with the addition of a colour code and systematic arrangement of the colour in question. Instead, colour signs have had problems with exhibiting distinctiveness upon registration as they are considered to lack demonstrable inherent distinctiveness.<sup>46</sup> Besides, one should note that the elimination of the graphical representation requirement does not make passing the distinctiveness test any easier, as the latter is what colours have struggled with in particular, and hence the reform is unlikely to introduce significant change in the future.<sup>47</sup>

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<sup>46</sup> Aplin, T., Davis, J. (2013) *Intellectual Property Law: Text, Cases and Materials*. Second edition. Oxford: Oxford University Press, p 342-343

<sup>47</sup> Clark, B., Wilkinson-Duffy, R. (2017) *Open to Interpretation? Court of Appeal Confirms the Invalidity of Purple Inhaler Trade Mark*. *European Intellectual Property Review*. 39(10), p 5-6

## 4. CONCERNS RELATED TO COLOUR TRADE MARKS

The recognition and protection of elements which were previously not understood as EUTMs has been steadily increasing and the undergoing legislative reform seems to support this trend. As noted, these elements include, but are not limited to, advertising, investment and communication. There is lack of clarity as to why other than the essential functions of EUTMs should be protected and it is important at this stage to address some of those concerns and controversies arisen from the protection of such elements.

### 4.1. What is the subject matter of protection and should it be protected?

Non-traditional EUTMs generally seek to protect features and elements which are part of the design or aesthetic of the product. As indicated earlier, the function of EUTM has developed drastically in the past decades as a result of the changes in economy and the rise of EUTMs in general. Indeed, today any sign can be registered as an EUTM. Some argue that the need to protect features such as visual material is not compatible with the traditional functions the EUTM system is aiming to serve.<sup>48</sup> This issue was famously addressed by Advocate General Léger in *Libertel*.<sup>49</sup> As regards colours, Léger argued that "colour is merely a concept which is intuitively understood by everybody"<sup>50</sup> and is not "a pre-existing objective reality of which we require only to become conscious."<sup>51</sup> Undoubtedly, colour does not exist independently but rather is always an attribute of something else<sup>52</sup> and thus belongs to a category of signs produced by nature and limited in supply.<sup>53</sup> Indeed, Jukka Palm argues that colours *per se* should not have been equated with traditional EUTMs.<sup>54</sup> Similar arguments have been put forward by other jurists such as Ann Bartow who argues that colours should not be protected due to their aesthetic functions.<sup>55</sup>

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<sup>48</sup> Calboli, I. (2018) Hands Off "My" Colors, Patterns and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation. - The Protection of Non-Traditional Trademarks. (Eds.) Calboli, I., Senftleben, M. (Eds.) Oxford: Oxford University Press, p 293

<sup>49</sup> Opinion of Mr Advocate General Léger delivered on 12 November 2002

<sup>50</sup> *Ibid*, point 43

<sup>51</sup> *Ibid*

<sup>52</sup> *Ibid*

<sup>53</sup> Aplin, T., Davis, J. (2013) Intellectual Property Law: Text, Cases and Materials. Second edition. Oxford: Oxford University Press, p 332-333

<sup>54</sup> Palm, J. (2002), *supra nota* 3, p 66-80

<sup>55</sup> Bartow, A. (2008) The True Colors of Trademark Law: Greenlighting a Red Tide of Anti-Competitive Blues. - Kentucky Law Journal, Vol 97, No 2, p 289-290



## 4.2. Standardisation

The undergoing EUTM reform in theory makes it easier to register and protect visual features and elements. As a consequence, the reformed EUTM framework supports and encourages standardisation which, in turn, halts the development of innovation and creativity. Irene Calboli sees the negative effects of the registration of non-traditional EUTMs as twofold.<sup>56</sup> First, businesses are encouraged to standardise certain design and aesthetic features and to use them repeatedly in order to gain the distinctiveness necessary for EUTM protection. Second, the subsequent increase in non-traditional EUTMs and their protection leads to less investment in not only innovation and creativity but also in product quality. This is presumably due to protection being granted which is, in essence, unlimited in time<sup>57</sup> and extends to not only identical and similar signs on identical or similar goods or services,<sup>58</sup> but also to dissimilar goods or services in relation to well known signs.<sup>59</sup>

The notion of distinctiveness is at the core of the function of an EUTM and is also where, in part, EUTM law differs from other branches of IP. EUTMs are not considered to be achievements of creativity and innovation in their own right and thus worthy of protection, but rather are protected based on their ability to communicate information.<sup>60</sup> However, the notion of distinctiveness has become looser and its interpretation shifted. With regard non-traditional signs, the ability to become distinctive seems to be enough for registration and protection even though it has been argued that colours *per se* have very little ability to communicate information to consumers and to distinguish between different sources.<sup>61</sup> Furthermore, these visual elements being granted protection are not inherently distinctive nor clear and precise and can in practice take on multitude of visual forms<sup>62</sup>. As Sir John Mummery noted, the whole notion of being able to distinguish has become such a complicated, uncertain and unpredicted area, a subject which was designed to prevent confusion and which has become a source of confusion itself.<sup>63</sup>

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<sup>56</sup> Calboli, (2018) *supra nota* 46, p 288

<sup>57</sup> See The Agreement on Trade-Related Aspects of Intellectual Property 15 April 1994, Article 18 and OJ L 205, 8.8.2017, Article 48

<sup>58</sup> OJ L 154, 16.6.2017, Article 8(1)(a)

<sup>59</sup> The Agreement on Trade-Related Aspects of Intellectual Property, *supra nota* 58, Article 6 *bis*

<sup>60</sup> Dreier, T., Kur, A. (2012) *European Intellectual Property Law: Text, Cases and Materials*. Cheltenham: Edward Elgar Publishing, p 157

<sup>61</sup> See for example Opinion of Mr Advocate General Léger (2002), *supra nota* 47 or Palm (2002), *supra nota* 3

<sup>62</sup> Bickell, P. (2014) *Societes des Produits Nestle SA v Cadbury UK Ltd: Single Colour Marks Predominately Applied to the Whole Visible Surface of the Goods*. *European Intellectual Property Review*. 36(3), p 3

<sup>63</sup> Parson, G., Watt, A. (2014) *A Fight on the Tiles*, *European Intellectual Property Law Review*. 36(4), p 262

### 4.3. Competition

The justifications for EUTM protection are mainly economic. Unlike in other branches of IP, EUTMs function as an enabling tool within competition rather than restrain it.<sup>64</sup> Simultaneously, EUTM grants its proprietor power in restraint of competition and thus has to be constructed according to the principle of *numerous clausus*.<sup>65</sup> Economic freedom will only function if the appropriation of EUTMs is not restrictive on competition and grant on its proprietor anticompetitive advantages. By setting distinctiveness thresholds and raising functionality bars, EUTM law incorporates these competition considerations.<sup>66</sup> Unlike traditional EUTMs, non-traditional EUTMs such as colours are not infinite in supply and thus their protection can grant a monopoly on its proprietor. As regards colours, the ability to distinguish between goods and services has to be balanced against the general interest of not unduly restricting the number of colours available. Unlike traditional EUTMs, registering and protecting non-traditional EUTMs such as colours has been understood to terrorize the consumer market in granting monopolies.<sup>67</sup>

### 4.4. Creativity and innovation

Granting an exclusive right to a particular colour not only creates a monopoly for its owner on certain visual elements, but also halts the proprietor's creativity in having to use the colour repeatedly in order to make it stand out and easy to identify. For instance, Tiffany & Co. has been repeatedly using robin's egg blue on its jewellery in order to maintain distinctiveness.<sup>68</sup> Repeated use of a specific colour can have detrimental results on these companies' creativity as well as the industry at large, including but not limited to the fashion industry.<sup>69</sup> Furthermore, the need to continue the repetition of same aesthetic features in products in order to legally protect the EUTM seems to result in less investment in product quality.<sup>70</sup> Thus, protecting colours can decrease the

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<sup>64</sup> Dreier, Kur (2013), *supra nota* 58, p 157

<sup>65</sup> Ghidini, G. (2010) *Innovation, Competition and Consumer Welfare in Intellectual Property Law*. Cheltenham: Edward Elgar Publishing, p 17

<sup>66</sup> Liakatou, V., Maniatis, S. (2012) Red Soles, Gas Bottles and Ethereal Market Places: Competition, Context and Trade Mark Law. *European Intellectual Property Review*. 34(1), p 1

<sup>67</sup> Hasan, A. (2016) Color Blocking: How the Harmonization of Color Protection May Catalyze Color Depletion in Global Markets. *Indiana Journal of Global Legal Studies* Vol. 23 (1), p 303

<sup>68</sup> Bagnall, M., Wood, I. (2013) Colour Marks: a Purple Decision Clears the Way Forward, *European Intellectual Property Review*. 35(5), p1

<sup>69</sup> Calboli, (2018) *supra nota* 46, p 306

<sup>70</sup> *Ibid.*

amount of innovation, creativity and investment companies put into their product design and quality in the long term.

#### 4.5. Cultural expression

The protection of colours as EUTMs does not raise concerns purely on economic grounds. Colours, as visual materials of artistic endeavours and innovation, can also be understood to have value in the public domain and thus have resonance in cultural expression. As noted above, the recognition and protection of non-traditional signs aggravates the overlap of trademark law with other branches of IP such as copyright law and thus the concerns arising from cumulative protection.<sup>71</sup> The cumulative protection in turn halts innovation and creativity.<sup>72</sup> The potentially infinite EUTM protection should not be allowed to undermine competition as there is a strong interest in free use of intellectual resources and innovation, and vice versa copyright should not be available to get around the formalities and registration requirements for EUTMs.

As regards further critique, some go as far as arguing that the recognition and protection of non-traditional EUTMs can count as means of cultural control since colours can communicate information, ideas and emotion in a manner which overrides language barriers.<sup>73</sup> Moreover, since products can be considered as status symbols the protection of non-traditional EUTMs can have cultural effects.<sup>74</sup> Whilst others argue that exclusive rights in colours should not be allowed as such elements can communicate expression protected by the freedom of expression and have other functions which are not related to the function of identifying product source, and as such can be considered as means of suppressing expression without sufficient justifications<sup>75</sup>

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<sup>71</sup> Senftleben, M. (2018) A Clash of Culture and Commerce: Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation. - The Protection of Non-Traditional Trademarks. (Eds.) Calboli, I., Senftleben, M. Oxford: Oxford University Press, p 310

<sup>72</sup> *Ibid*, p 311

<sup>73</sup> Hasan (2016), *supra nota* 65, p 321

<sup>74</sup> Assaf-Zakharow, K. (2018) Non-Traditional Trademark Protection as (Non-Traditional) Means of Cultural Control. Oxford: Oxford University Press. - The Protection of Non-Traditional Trademarks. (Eds.) Calboli, I., Senftleben, M. (Eds.) Oxford: Oxford University Press. p 363

<sup>75</sup> Ramsey, L.P. (2018) Non-Traditional Trademarks and Inherently Valuable Expression. Oxford: Oxford University Press. - The Protection of Non-Traditional Trademarks. (Eds.) Calboli, I., Senftleben, M. Oxford: Oxford University Press, p 338

## 5. LEGAL SITUATION: PAST, PRESENT AND FUTURE

### 5.1. Registration of colours in EU

As noted, the attitude towards non-traditional EUTMs in the EU in the past has been to some extent sceptical and restrictive. The requirement of graphical representation has to a significant extent framed and limited the registration of non-traditional EUTMs. It was not until recent changes in EUTM legislation that a shift towards a more liberal and enabling stance was taken. At present, the embracing of non-traditional signs has brought the essential function of an EUTM on par with the other functions, including but not limited to advertising and communication.

Over the period from 1 January 1996 to 31 December 2016, a total of 11,041 applications were made for non-traditional EUTMs.<sup>76</sup> The vast majority of these applications, 9,042 in total, were for shapes followed by colours.<sup>77</sup> The EUIPO received 1,210 applications for colours, constituting 10.96 per cent of total applications for non-traditional EUTMs out of which 0.41 per cent were registered.<sup>78</sup> From all of the applications for non-traditional signs, 62.2 per cent have been registered, 53.6 per cent are currently registered as EUTM, 33.9 per cent were never registered and 3.9 per cent are currently pending.<sup>79</sup>

See Annex I

### 5.2. EUIPO guidelines

As regards colours, the new EUIPO guidelines<sup>80</sup> differentiate between colours *per se* and figurative signs.<sup>81</sup> Upon registration, the representation of a colour must consist of a "representation of the colour or colours without contours in one single JPEG file or on one single A4 sheet" and where the mark consists of several colours, the representation must show "the

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<sup>76</sup> Adams, Scardamaglia, (2018) *supra nota* 41, p 3-4

<sup>77</sup> *Ibid*, pp 6-9

<sup>78</sup> *Ibid*,

<sup>79</sup> *Ibid*,

<sup>80</sup> EUIPO Decision No EX-17-1 (2017), *supra nota* 31

<sup>81</sup> *Ibid.*, p 27-28

systematic arrangement of the colour combinations."<sup>82</sup> The guidelines further indicate that the colour applied for must be accompanied with a reference to a colour code.<sup>83</sup>

### 5.3. Elevation of the functionality bar

At this stage, it is important to note another significant amendment which is likely to affect the legal situation of colour EUTMs in the future and which may even outweigh the effect the elimination of the graphical representation requirement may have on the EUTM system: the elevation of the functionality bar. The undergoing EUTM reform introduced changes to Article 7(1)(e) of the EUTMR, amending the absolute ground for refusal for signs that consist exclusively of the shape or "another characteristic" of the goods. In the light of these amendments, although the types of signs registrable has been expanded the addition of the words "or another characteristic" can be considered as counterbalancing the elimination of the graphical representation requirement<sup>84</sup> and thus extending the prohibition on functional EUTMs. Thus, as the scope of signs which can be registered as EUTM has expanded so have the grounds on which they can be refused registration. The amendments made place some non-traditional EUTMs under threat of being rejected without offering a possibility to overcome the functionality hurdle based on acquired distinctiveness.<sup>85</sup> Louboutin and its red sole, having gone through litigation both in EU and US,<sup>86</sup> could stand as an example of a colour being at a particular risk based on aesthetic functionality.

It is unclear at this stage how the ECJ will interpret the amendments made in statutory language including the wording "or another characteristic" in Article 7(1)(e) of the EUTMR. Albeit the definition for what can constitute EUTM has been relaxed, there may nevertheless be a decrease in the number of registered non-traditional EUTMs as a result of the narrowed scope of the types of marks eligible for registration in Article 7(1)(e) EUTMR. In the contrary, the amount of

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<sup>82</sup> *Ibid.*

<sup>83</sup> *Ibid.*

<sup>84</sup> Fields, Muller, (2017) *supra nota* 41, p 7

<sup>85</sup> Adams, Scardamaglia, (2018) *supra nota* 41, p 3

<sup>86</sup> See for example Judgement of the Court (Grand Chamber), 12.6.2018, Christian Louboutin and Christian Louboutin Sas v Van Haren Schoenen BV, case C-163/16, ECLI:EU:C:2018:423 and United States District Court, S.D. New York, 10.8.2011, Christian Louboutin S.A. v. Yves St. Laurent Am., Inc., 778 F.Supp. 2d 445

combination signs may see an increase in the years to come as a preventive measure. At present, the combination of shape and colour already make up a large proportion of the dataset.<sup>87</sup>

#### **5.4. The future of colours**

As mentioned, the registration process for colours has not been significantly simplified.

Whether a colour is purely an embellishment, a visual element of artistic endeavours or able to function as a EUTM and thus distinguish products and communicate information to the public will remain a cause for uncertainty. This will particularly be the case after the elevation of the aesthetic functionality bar which may overweight the impact the elimination of the graphical representation requirement may have on registration and protection of colours. Moreover, the registration of EUTMs will be further affected by the harmonization of EUTMD which will provide national signs equal opportunity for registration.<sup>88</sup> Conclusively, the direction towards which the registration and protection of colours will develop will ultimately depend on the way in which the new EUTMD and EUTMR will be interpreted by EUIPO and the ECJ, as MSs ultimately have to ensure compliance with the position taken by the ECJ.<sup>89</sup>

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<sup>87</sup> Adams, Scardamaglia, (2018) *supra nota* 41, p 11

<sup>88</sup> OJ L 336, 23.12.2015, Article 3

<sup>89</sup> Ohly, A., Pila, H. (2013) *The Europeanization of Intellectual Property Law: Towards a European Legal Methodology*. Oxford: Oxford University press, p 81

## 6. COMPARATIVE ANALYSIS

### 6.1. Divergences within the EU

Historically the way in which different EU MSs have viewed colour signs has varied significantly. At the ninth session of the World Intellectual Property Organization the Standing Committee proposed a questionnaire on the definition of a trade mark which was revised in the eleventh session.<sup>90</sup> Upon revision out of the 73 answers provided 45 countries stated it was possible to register a single colour and 68 indicated it was possible to register a colour combination. Within the EU, some MSs required reference to an internationally recognised colour code whilst in others both a sample as well as a verbal description was mandatory.<sup>91</sup>

Interestingly, even today with the harmonized EU standards, different courts and tribunals seem to be engaging in different modes of analysis as regards non-traditional EUTMs.<sup>92</sup> Indeed, the study conducted by MPI states that "currently there seem to be inconsistencies in the application of standards for registration and requirements for graphic representation that vary between national offices and the OHIM."<sup>93</sup> As noted above, the wording of the EUTMD indicates that MSs' signs will be provided equal opportunity for registration consequent to harmonization and thus making it easier for MSs to operate in cross border matters.

### 6.2. US

The approach to non-traditional trade marks and colours respectively has been more relaxed in the US. The determination of what can constitute a trade mark has been to a wide extent left to the subjective judgement of individual examiners and judges.<sup>94</sup> As a result, judges have been more liberal in their evaluation which in turn has facilitated the expansion of trade mark law to include

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<sup>90</sup> Burta, P.G. (2016) Getting Technical with Color: Graphic Representation of Color Trademarks in the New European Legislation on Trademarks. *Challenges of the Knowledge Society*, 6(-), p 266

<sup>91</sup> *Ibid*

<sup>92</sup> Gangjee, D.S. (2018) Paying the Price for Admission: Non-Traditional Marks across Registration and Enforcement. - *The Protection of Non-Traditional Trademarks*. (Eds.) Calboli, I., Senftleben, M. Oxford: Oxford University Press. pp 72-83

<sup>93</sup> Max Planck Institute for Intellectual Property and Competition Law (2011), *supra nota* 37, p 35 point 2.22

<sup>94</sup> Hirsch, J., Pozen, R. C. (2009). US and EU Trademark Protection. Accessible: [https://edisciplinas.usp.br/pluginfile.php/4115991/mod\\_resource/content/1/US%20and%20EU%20trademark%20protection.pdf](https://edisciplinas.usp.br/pluginfile.php/4115991/mod_resource/content/1/US%20and%20EU%20trademark%20protection.pdf), 26 April 2019

non-traditional signs.<sup>95</sup> In as early as 1942, which is when the passage on trade marks was published in 15 U.S.C. § 1127, the term "trade mark" included

any word, name, symbol, or device, or any combination thereof-

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

A couple of years later in 1946 this broad conception was codified in the Lanham Act to include as a trade mark "any word, name, symbol, or device, or any combination thereof."<sup>96</sup> Subsequently, the same liberal view was reiterated in *Qualitex Co. v Jacobsen Products*<sup>97</sup> where the Supreme Court noted that a colour is capable of satisfying the definition of a trade mark<sup>98</sup> so long as it is source-distinguishing.<sup>99</sup>

In the US colours have not been constrained by the graphical representation requirement as in the EU. Rather, the requirement is that upon application the sign be accompanied by a separate statement naming the colours and describing where they appear and how they are used in the mark.<sup>100</sup> The description of the colour must be clear and specific, using ordinary language in its description such as "maroon" or "navy blue."<sup>101</sup> The colour sign drawing is customarily a representation of the product or its package, whereas the object is represented in dotted lines.<sup>102</sup> Moreover, unlike in the EU, in the US there is no requirement to accompany the colour applied for with an internationally recognised colour code upon application, although the US Patent and Trademark Office has accepted Pantone colour codes.<sup>103</sup>

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<sup>95</sup> *Ibid.*

<sup>96</sup> 15 U.S.C. § 1127

<sup>97</sup> United States Supreme Court Judgement, 28.3.1995, *Qualitex Co. v. Jacobsen Products Co., Inc.*, 514 U.S. 159

<sup>98</sup> *Ibid.*, point 162

<sup>99</sup> *Ibid.*, point 164

<sup>100</sup> United States Patent and Trademark Office (2018) Trademark Manual of Examining Procedure [Online] <https://tmep.uspto.gov/RDMS/TMEP/current> (20.2.2019) point 1202.05(d)

<sup>101</sup> *Ibid.*, point 1202.05(e)

<sup>102</sup> Froemming, J., Groebl, M., Ling Li, C., Mehler, U., Raimer, A., Takahashi, M. (2015) Lending Color to Trademarks: Protection and Enforcement of Color Marks in the U.S., EU, China and Japan. *INTA Bulletin*, Vol. 70 No. 12.

<sup>103</sup> Ahuja (2010), *supra nota* 2, p 5



### 6.3. Comparative analysis between the EU and US

As there has not been graphical representation requirement in the US, in theory there is less clarity as to what exact colour is being claimed for. In the US trade mark rights are obtained through use of the sign.<sup>104</sup> In practice this can lead to two undertakings claiming for the same colour with the court having to rely on photographs in order to determine the specific object of protection.<sup>105</sup> Still, the colour code requirement in EUTM system does not seem to provide much of a solution. To exemplify, if two competing undertakings use colours which are identical to the consumer but technically different in terms of colour coding, the protection of the colour is not straight forward. The inclusion of Pantone or alternative code will not resolve the issue of whether consumers will be able to differentiate between the colours and their source-identifying functions. However, some argue that only the colour coding system provides specificity and uniformity<sup>106</sup> and that the US should consider moving towards the practice in EU and demand greater precision for what is being claimed protection for.<sup>107</sup> This could be achieved by the inclusion of the requirements for not only colour codes but also the representation to be "clear, precise, self-contained, easily accessible, intelligible, durable and objective" and in "any appropriate form using generally available technology" including but not necessarily "by graphic means" in the US legal language.<sup>108</sup>

The elevation of the functionality bar in the EU seems to be a step towards the aesthetic functionality doctrine limiting the protection of non-traditional signs in the US. The aesthetic functionality doctrine implies, in essence, that a product feature is aesthetically functional when its exclusive use would put competitors at a significant, non-reputation related disadvantage, affect the cost or quality of the product or is essential to the use or purpose of the product.<sup>109</sup> In *Deere & Co. v Farmhand Inc.* the District Court ruled that in order for a colour to be registered it cannot be considered as functional.<sup>110</sup> Similarly in the EU, the ECJ examined the functionality doctrine in

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<sup>104</sup> Kudrjavceva, J. Issues Surrounding Registration of Colour Trade Marks, Master's Thesis, Riga Graduate School of Law, 2012, p 48

<sup>105</sup> See for example decision of United States Trademark Trial and Appeal Board, 23.4.1987, Amsted Industries Inc. v West Coast Wire Rope & Rigging Inc.

<sup>106</sup> Roth, M.E. (2005) Something Old, Something New, Something Borrowed, Something Blue: a New Tradition in Non-Traditional Trademark Registrations. 27 *Cardoz Law Review*, p 457 referenced in Kudrjavceva (2012, *supra nota* 109, p 48

<sup>107</sup> Desai, D. (2018) Should Trademark Law Protect Non-Traditional Trademarks? A Look at How Marketing Practices Try to Capture Essences. - *The Protection of Non-Traditional Trademarks.* (Eds.) Calboli, I., Senftleben, M. Oxford: Oxford University Press, p 146

<sup>108</sup> *Ibid*

<sup>109</sup> *Qualitex Co. v. Jacobsen Products Co.*, *supra nota* 97, point 165

<sup>110</sup> United States District Court, S.D. Iowa C.D., 30.6.1982, *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp.

Hauck v Stokke.<sup>111</sup> At the time of the judgement, the functionality bar was lower and applicable to shapes only, but the logic used in the case can be understood to apply to the newly amended legal language. The Court explained that such EUTMs must be refused registration where they "consist exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors."<sup>112</sup> The Court stated that the functionality doctrine served to balance the exclusive and permanent right EUTM confers to its proprietor.<sup>113</sup>

In the US for a colour to avoid the aesthetic functionality hurdle it should have acquired secondary meaning and thus cannot be understood to be inherently distinctive.<sup>114</sup> Secondary meaning frames the registrability of signs that do not have inherent distinctive, generic or descriptive character and is determined as a question of fact.<sup>115</sup> Evidence is generally provided and is often presented by a percentage figure which has been established between 25 and 30.<sup>116</sup> In the EU, according to the ECJ jurisprudence it is understood that a colour can be inherently distinctive<sup>117</sup> and thus constitutes one of the most significant differences in comparison to the US.

As noted, in the US the definition of what can constitute a trade mark has largely been determined by the subjective evaluation of examiners and judges, which in turn has facilitated trade mark law to extend protection to include colours. One of the explanations offered is that the US as a common law country is not bound by statutes to the same extent as civil law countries who thus have less scope in interpretation of the facts and the law.<sup>118</sup> In the EU the requirements for what can constitute EUTM, and that of graphical representation specifically, have not allowed for the type of subjective determination which has facilitated the liberal expansion of US trade mark law. To elaborate, United Kingdom (UK) historically had a more liberal view on trade marks in align with the stand taken in the US.<sup>119</sup> In the twentieth century the UK legal framework had nothing in

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<sup>111</sup> Judgement of the Court (Second Chamber), 18.9.2019, Hauck GmbH & Co. KG v Stokke A7S and Others, Case C-205/13, ECLI:EU:C:2014

<sup>112</sup> *Ibid*, point 18

<sup>113</sup> *Ibid*, point 19-20

<sup>114</sup> Ahuja (2010), *supra nota 2*, p 5

<sup>115</sup> Caldora, M.C. (2013) Questions Relating to Abstract Colour Trade Marks: Recent Developments in Germany. European Intellectual Property Review, 25(6), p 5

<sup>116</sup> *Ibid*

<sup>117</sup> Libertel Groep BV v Benelux-Merkenbureau, *supra nota 32*, point 42

<sup>118</sup> Hirsch, J., Pozen, R. C. (2009). *supra nota 92*

<sup>119</sup> *Ibid*

contravention with protecting colours and such signs were registered and protected.<sup>120</sup> However, through the introduction of EUTMD and EUTMR UK had to narrow down its scope of registration in order to comply with the standards set by the EU.

From the above discussion it can be concluded that the recent reform in EU is a significant step towards a more liberal view on trade mark law and an embrace of non-traditional signs. The elimination of the graphical representation criteria allows for flexibility and discretion facilitating expansions in trade mark law, such as has already taken place in the US and even within the EU MSs previously. The new notion of what can constitute an EUTM in the EU not only corresponds with the progressive view taken in the US but also marks as a step towards harmonization of trade mark laws worldwide.

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<sup>120</sup> Dworkin, G., Taylor, R. (1988) Blackstone's Guide to the Copyright, Design and Patents Act 1988. Blackstone Press. p 140

## CONCLUSION

The developments in EUTM law have been considerable and so has the shift from EUTM's essential functions to the new era of advertising and branding. The law governing EUTMs inevitably lagged behind and the requirement of graphical representation particularly created an obstacle for non-traditional signs. The recent EUTM reform is the most significant change in EUTM law since its initial adoption and will, to an extent, relax the requirements for registration. The aim of this thesis was to analyse what implications the reform, and the elimination of the graphical representation requirement specifically, has for colour signs. The thesis sought an answer for the following research questions:

- How does the wording of the two enactments clarify and provide substantial change for the legal status of colour EUTMs?
- How will it be easier to register and protect colour EUTM after the reform enters into force?

In order to achieve the aim of the thesis, theoretical research and qualitative methods have been used. The qualitative methods incorporated the interpretation and systematisation of the different sources of law. The research has aimed to identify and analyse the relevant legal instruments, case law and legal literature. In order to reach the aim of the thesis, comparative analysis between the developments in the EU and the US has been used.

The immediate conclusion of the analysis is twofold. First, the author of this thesis found that the wording of the two enactments do in theory clarify the legal status of colours. The new amended statutory language seems to pave the way for a wider, more flexible definition stating that the representation of EUTM must be made in a manner which enables the competent authorities and the public to comprehend what is the subject matter of protection. Indeed, the access for registration and protection could be expanded by the new statutory language and the propositions of clarity, precision, accessibility and objectivity. However, whether a colour is merely an embellishment of a product or able to function as EUTM and thus distinguish will remain a cause for uncertainty in the future. This is particularly the case due to the elevation of the functionality bar and the inclusion of other features than shapes, placing even current colour EUTM's legal situation at risk. Moreover, as the research of this thesis found, several considerations as regards

colour EUTMs remain with no significant change. Those concerns relate to *inter alia* competition, standardisation, innovation, creativity and cultural expression considerations.

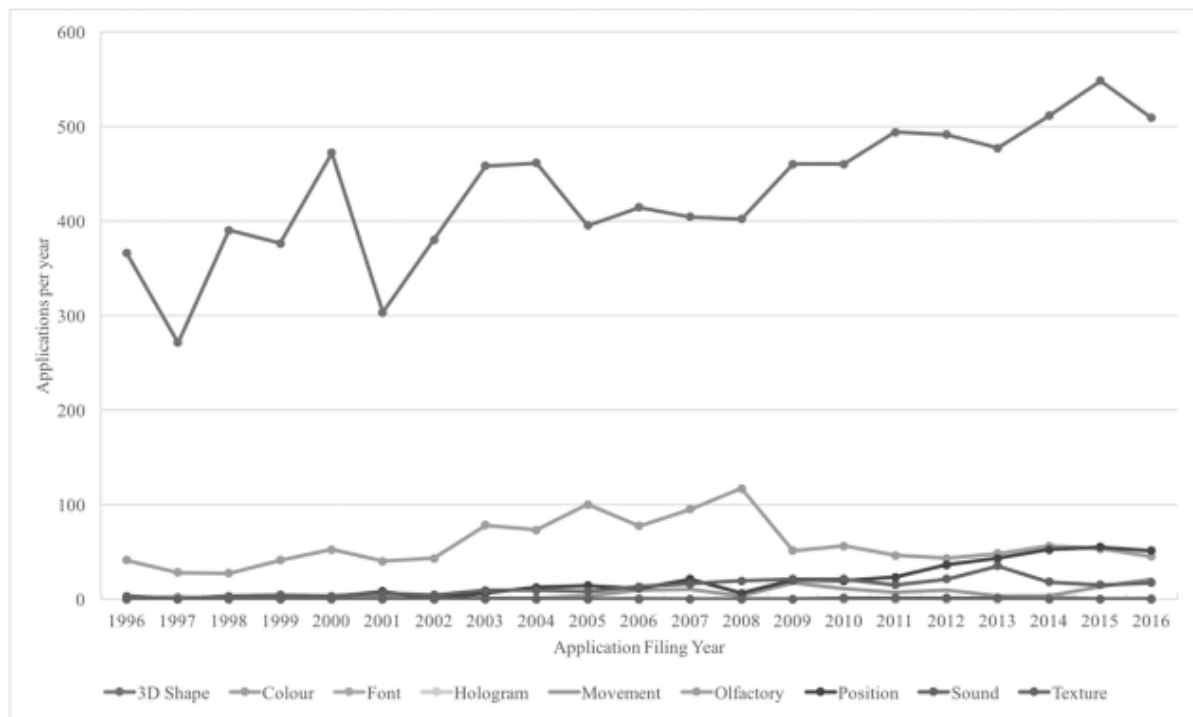
Second, during the research the author of this thesis found that the registration process for colours has not been significantly amended. Even before the reform colours could be demonstrated visually and thus pass the graphical representation test with the addition of a colour code and specified application of the colour in question. Instead, problem lied in distinctiveness and originality, for which the reform does not introduce alleviation. As further analysis found, there are considerable divergences between not only the EU and US, but also within the EU MSs with regard the stance taken on graphical representation. The divergences within MSs will be partly facilitated by the harmonization of the EUTMD, giving national trade marks equal opportunity of registration. Moreover, the reform in EU will facilitate worldwide harmonization of trade mark laws and marks as a step towards a more liberal development on trade marks such has already taken place in the US.

The reform has indeed been a considerable step in not only bringing the EUTM system on par with technological and digital developments, but also for embracing non-traditional EUTMs, such as colours. Ultimately, the way in which the EUTM system will develop further and how the new amended statutory language will be interpreted will eventually depend on EUIPO along with ECJ practice to be established.

# ANNEX

## Annex I - Applications by Filing Basis

Figure 1 Annual Applications by Filing Basis 1996-2016



Adams, M., Scardamaglia, A. (2018) Non-Traditional Trade Marks in Europe: An Historical Snapshot of Applications and Registrations. *European Intellectual Property Review*, 40(10), 623-629

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