OPINION OF ADVOCATE GENERAL LÉGER

delivered on 12 November 2002/ [1]

1. Can a colour *per se*, not having any shape or contour, constitute a trade mark within the meaning of the First Council Directive 89/104/EEC, [2] for certain goods or services, and, if so, under what conditions? Those are in essence the questions put by the Hoge Raad der Nederlanden (High Court, Netherlands), in the present case.

I — Legal background

2. The relevant legal background comprises the Paris Convention for the Protection of Industrial Property, [3] Community legislation and the Uniform Benelux Law on Trade Marks.

A — The Paris Convention

3. The Paris Convention, to which all Member States have acceded, is the text on which all international rules governing industrial property rights are based.

4. It does not contain any definition of signs capable of constituting a trade mark.

5. Article 6 *quinquies* A provides that every trade mark duly registered in the country of origin shall be accepted for filing and protected as it is in the other countries acceding to the Convention, subject to the reservations indicated in that Article. Article 6 *quinqiues* B(2) states that trade marks shall be denied registration which are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin of the goods, or the time of production, or have become customary in the current language or in *bona fide* and established trade practices of the country where protection is claimed.

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 — Convention of 20 March 1883 (hereinafter 'the Paris Convention').

6. According to Article 6 *quinquies* C, in determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.

B — Community legislation

7. The relevant Community legislation comprises the Directive and Council Regulation (EC) No 40/94. [4]

1. The Directive

8. The Directive was adopted by the Council in order to eliminate the disparities which exist between the laws of the Member States on trade marks which may distort competition within the common market. Its object is the approximation of provisions and laws which most directly affect the functioning of the internal market. [5] It applies only to trade marks acquired by registration. [6]

9. The Directive therefore prescribes the conditions which apply to the registration of a sign as a trade mark. [7] Article 2 is headed 'Signs of which a trade mark may consist', and provides that:

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

10. Article 3 of the Directive, which specifies grounds for refusal or invalidity, reads as follows:

'1. The following shall not be registered or if registered shall be liable to be declared invalid:

(a) signs which cannot constitute a trade mark;

(b) trade marks which are devoid of any distinctive character;

4 — Regulation of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (hereinafter 'the Regulation').

5 — First and third recitals.

6 — Fourth recital.

7 — Seventh recital.

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of the rendering of the service, or other characteristics of the goods;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(e) signs which consist exclusively of:

— the shape which results from the nature of the goods themselves, or

— the shape of goods which is necessary to obtain a technical result, or

— the shape which gives substantial value to the goods;

3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.'

11. According to Article 4 of the Directive, a trade mark may also be refused registration, or declared invalid if registered, if it is identical with an earlier trade mark or if there exists a likelihood of confusion with the earlier trade mark, in relation to goods or services identical with or similar to the goods or services for which the earlier trade mark is protected.

12. In order to guarantee the trade mark as an indication of origin, the Directive also specifies the protection to be enjoyed by registered trade marks within the Member States. [8] Article 5 states:

'1. The registered trade mark shall confer on the proprietor exclusive rights therein.

...

8 — Ninth and tenth recitals.

The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;

(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods and services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.

2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where the use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.'

13. However, the Directive does not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection. [9] Article 5(5) of the Directive accordingly provides that:

'Paragraphs 1 to 4 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.'

14. Registered marks must be used, however, failing which they are subject to revocation. [10] Article 10 of the Directive states that a trade mark shall be subject to revocation if, within a period of five years, the proprietor has not put the trade mark to genuine use. According to Article 10(2)(a), genuine use includes 'use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered'.

9 — Sixth recital.
10 — Eighth recital.

2. The Regulation

15. As with the Directive, the aim of the Regulation is the removal of barriers to free movement of goods and services and the institution of arrangements which ensure that competition is not distorted. [11] It provides for the creation of a protected trade mark having effect throughout the Member States of the Community, without affecting the trade mark law of those States.

16. The provisions of the Regulation relating to the acquisition of rights in trade marks and their effects are expressed in the same terms as in the Directive. Thus, Article 4 reproduces the provisions of Article 2 of the Directive relating to the signs of which a Community trade mark may consist, Article 7 reproduces those of Article 3 of the Directive relative to the grounds on which registration may be refused, and Article 9 reproduces those of Article 5 of the Directive on the rights conferred by a trade mark. Similarly, a Community trade mark is only protected to the extent that it is used. Article 15 of the Regulation reproduces the provisions of Article 10 of the Directive relating to the use of trade marks.

11 — First recital.

C — *Uniform Benelux law on trade marks*

17. The legislation of the three Member States of the Benelux Economic Union on trade marks is set out in in a single act, the Uniform Benelux Law on Marks. [12] This was amended with effect from 1 January 1996 by a Protocol signed in Brussels on 2 December 1992, the purpose of which was to ensure the transposition of the Directive in the three Benelux countries. [13]

18. Article 1 of the BLM states that:

'The following shall be considered individual marks: designations, designs, prints, seals, letters, numbers, shapes of goods or their get-up, and any other symbols which serve to distinguish the goods or services of an enterprise.

However, shapes determined by the very nature of the goods or which affect their actual value or produce industrial results cannot be considered marks.'

12 — Signed at Brussels on 19 March 1962, *Moniteur Belge* of 14 October 1969 (hereinafter 'BLM').

13 — *Moniteur Belge* of 12 March 1996.

19. Article 6 *bis* of the BLM provides that:

'1. The Benelux Trade Mark Office shall refuse to register an application when it considers that:

(a) the sign as filed does not constitute a mark within the meaning of Article 1, particularly due to any lack of distinctive character as provided in Article 6 *quinquies* B(2) of the Paris Convention;

...

3. The Benelux Office shall inform the applicant without delay and in writing of its intention to refuse registration in whole or in part, shall state the grounds and shall give him the possibility of responding within a period of time to be laid down in the Rules.

4. If the objections of the Benelux Office to registration have not been lifted within the fixed time-limit, registration of the mark applied for shall be refused in whole or in part. The Benelux Office shall inform the applicant without delay and in writing and state the grounds of refusal and advise of the remedy against such decision referred to in Article 6 *ter*.

5. Refusal to register a mark in respect of all or some of the products render the application wholly or partially invalid. Such invalidity shall not take effect until the time-limit for appeals referred to in Article 6 *ter* has expired, without having been used, or until the request to order registration has been irrevocably rejected.'

20. Article 6 *ter* of the BLM reads as follows:

'The applicant may, within two months following the communication referred to in Article 6 *bis*, paragraph 4, file with the Brussels Cour d'Appel, The Hague Gerechtshof or the Luxembourg Cour d'Appel a request for an order to register the mark applied for. The court with territorial competence shall be determined by the address of the applicant, the address of his representative or the postal address given in the application.'

II — Facts and procedure

21. On 27 August 1996, Libertel Groep BV [14] applied to the Benelux Trade Mark Office [15] to register the colour orange.

14 — Hereinafter 'Libertel'.

15 — Hereinafter the 'BTO'.

22. In the schedule to the application, the space designated for the representation of the sign was coloured orange. The section intended *inter alia* for recording the colour of the trade mark was completed with the word 'Orange'. [16]

23. The goods and services to which the application for registration of that colour related were those in classes 9 and 35 to 38 laid down by the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended. In the application, Libertel stated that the goods covered by class 9 comprised telecommunications apparatus. In respect of classes 35 to 38, the application referred to telecommunications services and to the physical, financial and technical management of telecommunications systems. [17]

24. By letter of 21 February 1997, the BTO informed Libertel's trade mark consultant of its provisional refusal to register the application on the ground that Libertel had failed to show that the colour orange had acquired a distinctive character through use. [18]

25. Libertel lodged observations intended to show that a distinctive character had in fact been acquired.

26. By letter of 10 September 1997, the BTO intimated its decision definitively to refuse to register the application on the grounds that it lacked any distinctive character.

27. Libertel's appeal against that decision to the Gerechtshof (Regional Court of Appeal) of The Hague was rejected for the same reason.

28. Libertel appealed against the decision of the Gerechtshof of The Hague to the Hoge Raad der Nederlanden.

III — Questions referred for a preliminary ruling

29. By order of 23 February 2001, the Hoge Raad der Nederlanden decided to stay the proceedings and refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Is it possible for a single specific colour which is represented as such or is

16 — Order for reference, paragraph 3.6.

17 — Opinion of the State Prosecutor of the Hoge Raad der Nederlanden, note at the foot of page 1 (Annex 1 to the order for reference).

18 — Order for reference, paragraph 3.1.

designated by an internationally applied code to acquire a distinctive character for certain goods or services within the meaning of Article 3(1)(b) of the Directive?

(2) If the answer to the first question is in the affirmative:

(a) in what circumstances may it be accepted that a single specific colour possesses a distinctive character in the sense used above?

(b) does it make any difference if registration is sought for a large number of goods and/or services, rather than for a specific product or service, or category of goods or services respectively?

(3) In the assessment of the distinctive character of a specific colour as a trade mark, must account be taken of whether, with regard to that colour, there is a general interest in availability, such as can exist in respect of signs which denote a geographical origin?

(4) When considering the question whether a sign, for which registration as a trade mark is sought, possesses the distinctive character referred to in Article 3(1)(b) of the Directive, must the Benelux Trade Office confine itself to an assessment *in abstracto* of distinctive character or must it take account of all the actual facts of the case, including the use made of the sign and the manner in which the sign is used?'

IV — Analysis

A — *Subject-matter of the dispute*

30. It should be observed that according to the settled case-law of the Court it is solely for the national court before which a dispute has been brought, and which must assume responsibility for the subsequent judicial decision, to determine in the light of the particular circumstances of the case both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the questions which it submits to the Court. [19] Nevertheless, the Court takes the view that it is its duty to interpret all provisions of Community law which national courts need in order to decide the actions pending before them, even if those provisions are not expressly

19 — See for example Case C-415/93 *Bosman* [1995] ECR I-4921, paragraph 59.

indicated in the questions referred to it by those courts. [20]

31. Thus, it provided an interpretation of a measure of secondary legislation in the case of *Swaddling*, [21] even though the reference related only to the interpretation of certain articles of the EC Treaty.

32. In the present case, the national court has put several questions for a preliminary ruling to the Court relating to Article 3 of the Directive in order to establish under what conditions a colour without any shape or contour may have a distinctive character for certain goods and services.

33. As the Commission has rightly pointed out, [22] in order to consider these questions it is necessary to determine first of all whether a colour *per se* is a sign capable of constituting a trade mark within the meaning of Article 2 of the Directive.

34. Only those signs which meet the requirements of that article may be registered as a trade mark. Article 3(1)(a) of the Directive confirms that signs which do not meet those requirements are, by definition, incapable of constituting a trade mark.

35. It is therefore necessary to consider whether Article 2 of the Directive should be interpreted as meaning that a colour *per se*, without any shape or contour, constitutes a sign capable of being represented graphically and of distinguishing the goods and services of one undertaking from those of other undertakings.

B — *Arguments of the interveners*

36. Libertel, [23] the BTO, [24] the Netherlands Government, [25] the United Kingdom Government, [26] and the Commission [27] are of the opinion that a colour *per se* may be registered as a trade mark.

37. According to the Commission, a colour, as a visual statement, is by definition capable of being represented graphically. [28] Moreover, a colour may, generally speak-

20 — Case C-280/91 *Viessmann* [1993] ECR I-971, paragraph 17. See also Case C-350/99 *Lange* [2001] ECR I-1061, paragraphs 20 to 25.

21 — Case C-90/97 [1999] ECR I-1075, paragraph 21.

22 — Paragraph 69 of its written observations.

23 — Paragraph 7.2 of its written observations.

24 — Paragraph 4.1 of its written observations.

25 — Paragraph 23 of its written observations.

26 — Paragraph 13 of its written observations.

27 — Paragraph 74 of its written observations.

28 — Paragraph 71 of its written observations.

ing, have a distinctive character. The Commission points out that colours may represent an important part of communications between an undertaking and its customers or consumers; they attract attention, they may have an inherent meaning and provoke certain associations in the beholder. [29]

38. In support of their analysis, the Commission, Libertel and the BTO refer to the joint declaration of the Council of the European Union and the Commission appearing in the minute of the meeting of the Council at which the Directive was adopted. This declaration stated that: 'the Council and the Commission consider that Article 2 [of the Directive] does not exclude the possibility: of registering as a trade mark a combination of colours or one colour alone... provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings'. [30]

39. Lastly, the Commission, the United Kingdom Government and the BTO point out that their position is shared by the Office for Harmonisation in the Internal Market (Trade marks and Designs) (OHIM). According to OHIM, a colour *per se* may, generally speaking, acquire protection as a trade mark by reason of Article 4 of the Regulation since it falls within the meaning of the wording 'any signs', which should be given the broadest interpretation. It states that to restrict the protection of colour marks to a specific presentation would be contrary to the spirit of Community trade mark law and that a contour or delimitation is not required for the purposes of a graphical representation within the meaning of Article 4 of the Regulation. [31]

C — *Analysis*

40. Unlike the interveners, I am of the view that Article 2 of the Directive does not permit a colour without any shape or contour to be registered as a trade mark.

41. It is my opinion that a colour *per se* does not meet the requirements of this article as, first, it does not constitute a sign capable of being represented graphically and, secondly, it is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29 — Paragraph 73 of its written observations.

30 — OJ OHIM No 5/96, p. 607.

31 — Decision of the Third Board of Appeal of 18 December 1998, case R 122/1998-3, paragraphs 17 and 18. In that case, the applicant sought registration of the colour 'light green' for chewing gum for cosmetic, medical and non-medical usage.

42. Nevertheless, before considering each of these requirements, it may be useful to give a brief description of certain essential features of the concept of 'colour'.

1. The concept of 'colour'

43. 'Colour is a concept which is intuitively understood by everybody, but which is very difficult to define in a universal manner.' [32] It is nevertheless accepted that colour is a sensation. It involves perception by the eye and transmission to the brain of the effects of luminous radiation on matter. Colour is thus not a pre-existing objective reality of which we require only to become conscious, such as a film placed over an object. It depends both on the nature and intensity of light, and on the eye of the observer. The colour of an object therefore changes in relation to lighting conditions and the distance from which the object is observed. Its perception also varies depending on the individual seeing it. [33]

44. Colour has been the object of several methods of analysis. Newton, who is thought to have provided the first interpretation of the splitting apart of a combination of light by a prism, set the number of principal colours of the spectrum at seven. [34] Painters distinguish primary colours, namely yellow, red and blue, from which it is possible to produce other colours, which are termed 'composite'. For industrial colour applications, professionals have mapped out different groups of specimens, strictly differentiated using a system of rules which allow a very large number of tonalities to be defined. [35] Nevertheless, the human eye can only distinguish a limited number of shades with certainty. [36] Moreover, the number of particular words used to name colours is even more restricted. [37] The number of colours capable of being identified and described with precision by an observer thus remains extremely limited.

45. Lastly, colour is a language. As it involves a sensation which reflects the appearance of things, it may provoke feelings in the observer. It may also transmit items of information. These feelings and these items of information are purely cultural phenomena. They are based on

32 — 'La couleur', dossier pour la science No 27 (available on website http://www.pourlascience.com).

33 — Ibidem. See also *Manuel de la couleur*, Solar, 2001, pp. 6 and 138.

34 — Red, orange, yellow, green, blue, indigo, violet (by reference to the seven notes of a scale).

35 — See the chromatic dictionaries, the Pantone, RAL, ACC, etc. systems (for example, the ACC system, Acoat Colour Codification, can define up to 2.4 million colours).

36 — According to Pastoureau, M., *Dictionnaire des couleurs de notre temps*, Bonneton, Paris, 1999, under a hundred shades, maybe two hundred in the case of those who have had most training in the field.

37 — Generally speaking, fewer than a dozen in western culture: white, red, black, green, yellow, blue, grey, brown, pink, violet and orange. Names borrowed from plants (for example lemon, lilac), animals (for example fawn, raven), minerals (for example ruby, turquoise), natural phenomena (for example dawn, horizon) or miscellaneous substances (for example straw, rust) are also used to designate colours. However, the precise identification of the colour shades thus described is subject to a high degree of subjectivity.

conventions of a psychological, symbolic, religious or other order which vary from time to time and place to place. [38] In reality however, colour does not exist independently. Being the result of the interaction of luminous radiation and matter, it is always the attribute of something else. So visual memory, which experience tells us is powerful and lasting, [39] is made up of mental representations of the objects which surround us.

46. It is in the light of these observations that the two requirements laid down under Article 2 of the Directive fall to be considered.

2. A sign capable of being represented graphically

47. It should be observed that the Court has consistently held that, in interpreting a provision of Community law, it is necessary to consider not only its wording but also the context in which it occurs and the objects of the rules of which it forms part. [40]

48. I am of the view that the arguments of the interveners, based on the wording of Article 2 of the Directive and the intention of the legislature, in support of allowing a colour *per se* to be registered as a trade mark are not persuasive.

49. If one begins by considering the wording of Article 2 of the Directive, which is consistent on the point in most of the languages in which it is published, I am of the opinion that no conclusion can be drawn from the expression 'any sign' or from the indicative character of the list of signs set out in this article as being capable of being graphically represented.

50. On the contrary, the presence of an ambiguity in the article in question on the issue of whether a colour alone may be considered to be a sign capable of being a trade mark is evidenced by the fact that the transposition of this article into the legislation of the different Member States has given rise to differing solutions. Thus, the registration of a colour *per se* is expressly

38 — For example, blue, which in Europe today is thought to be a 'cold' colour, was considered in the Middle Ages and the Renaissance to be a 'warm' colour. Similarly, in Japan today, it is less important to know whether a colour is red, blue or yellow than whether it is a matt or glossy colour (Pastoureau, M., ibidem).

39 — According to the *Encyclopédie Hachette Multimedia*, people are able to recognise 90% of 2 500 slides shown over a period of several days. Conversely, specific recall of colours is extremely short-lived. In support of these propositions, the encyclopaedia suggests an amusing experiment: read a phrase of five or six words printed in letters of different colours (for example blue, red, yellow and green) and try to reproduce the same colours using felt pencils and the same colours for each letter. It is very difficult to remember any more than a few letters in the right colour, whereas it is easy to recall the phrase itself (http://www.ani.chmel.hachette-multimedia.fr).

40 — See for example Case C-191/99 *Kvaerner* [2001] ECR I-4447, paragraph 30.

excluded by Portuguese legislation.[41] It is allowed under French and Italian law only for shades of colours[42] and chromatic tonalities[43] respectively. It is permitted under German law.[44] Lastly, Benelux, Danish, Greek, Irish, Austrian, Finnish, Swedish and United Kingdom law make no express reference to the point. The same has been the case in Spanish law since the entry into force on 31 July 2002 of the new law on trade marks.[45]

51. Secondly, the joint declaration of the Council and the Commission referred to above appears to me to have no legal force for two reasons.

52. First, in its decision in the *Antonissen* case[46] the Court held that a declaration recorded in the minutes of a meeting of the Council at which a provision of secondary legislation was adopted could not be used for the purpose of its interpretation where no reference was made to the content of the declaration in the wording of the provision in question, and the declaration therefore had no legal significance. This approach was confirmed by the Court in the *VAG Sverige* case.[47]

53. Secondly, it should be noted that the Council and the Commission indicated in the preamble to the declaration that it did not seek to pre-empt the interpretation of the Directive by the Court.[48] The Council and the Commission were thus careful expressly to limit the legal effects of their declaration. It would therefore be wrong to draw conclusions from the intention of the legislature in order to interpret Article 2 of the Directive.

41 — According to Article 166(1)(d) of the Codigo da Propriedade Industrial (Industrial Property Code) approved by Decree-Law No 26/95 of 24 January 1995, colours may not be registered as trade marks 'unless several colours are combined with one another or with other items in a particular and distinctive manner'.

42 — Article L 711-1 of the French intellectual property code, as amended by a law of 4 January 1991, states that figurative signs such as 'compositions, combinations or shades of colours' may constitute a trade mark.

43 — Article 16 of the Italian law on trade marks, as amended by a legislative decree of 4 December 1992 provides that: '[a]ll new signs capable of being represented graphically, in particular... combinations of colours or chromatic tonalities, provided they are capable of distinguishing the goods or services of one undertaking from those of other undertakings, may be registered'.

44 — Article 3 of the Gesetz über den Schutz von Marken und sonstigen Kennzeichen (German law on the protection of trade marks and other distinctive signs) of 25 October 1994 states that: '[a]ll signs... including colours and combinations of colours that are capable of distinguishing the goods or services of one undertaking from those of other undertakings qualify for protection as trade marks'. Nevertheless, the question of whether an abstract colour may constitute a trade mark remains under consideration by the Bundespatentgericht, Germany (Federal Patent Court), which has referred a preliminary question to the Court in the case of *Heidelberger Bauchemie* (Case C-49/02). This case is pending before the Court and will be discussed in greater detail below.

45 — The development of the Spanish legislation is indicative of the ambiguity of the wording of the Directive on the question in issue as Article 11 of Law No 32/88 on trade marks provided expressly that a colour *per se* could not be registered and that a colour could only be registered if it was delimited in shape. The new law follows the text of the Directive and leaves open the question of whether a colour *per se* is capable of constituting a trade mark.

46 — Case C-292/89 [1991] ECR I-745, paragraph 18.

47 — Case C-329/95 [1997] ECR I-2675, paragraph 23.

48 — The preamble reads as follows: 'The declarations of the Council and the Commission set out below not forming part of the legislative text, they do not seek to pre-empt the interpretation of the latter by the Court of Justice of the European Communities'.

54. In this context, it is worth noting that Article 15 of the Agreement on Trade-related Aspects of Intellectual Property Rights [49] to which both the Member States and, to the extent that it falls within its competence, the Community have acceded refers only to combinations of colours. [50] This limitation allows one to assume that in the negotiations leading to the WTO agreements a colour *per se* had been considered ineligible for registration as a trade mark. This analysis is strengthened by the fact that the original text of the article, dating from 1990, referred to colours. [51]

55. Consideration of the scheme of the Directive and the purpose underlying the requirement in question also suggests that a colour *per se* should not be a sign capable of constituting a trade mark.

56. It is apparent from the scheme of the Directive that it contemplates the protection of a trade mark immediately it is registered, and before its use. Registration is therefore subject to a certain number of conditions which require to be verified by the competent authority.

57. Thus the sign in question must be capable generally of constituting a trade mark in terms of Articles 2 and 3(1)(a) of the Directive. It must also not be subject to any of the other grounds for refusal set out in Article 3(1), nor must it conflict with earlier rights of the kind referred to in Article 4 of the Directive.

58. As these conditions fall by definition to be examined independently of any consideration of the possible use of the mark, such examination can only take place on the basis of the sign as it is described in the application for registration.

59. If the sign complies with the specified requirements, it will be registered as a trade mark. It is only after the mark is registered that the competent authority can determine whether a competitor's sign is identical to the mark or presents a likelihood of confusion with it in terms of Article 5 of the Directive. Lastly, any analysis of the question whether the proprietor of a trade mark has put it to genuine use, so as not to be deprived of his rights under Article 10 of the Directive, can likewise only follow registration.

49 — Set out in Annex 1C to the Agreement establishing the World Trade Organisation, approved in the name of the Community with regard to that portion of it which falls within its competence by Council Decision 94/800/EC of 22 December 1994 (OJ 1994 L 336, p. 1).

50 — Article 15(1) of the Agreement reads 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 trademark. 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 trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make such registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.'

51 — Gervais, D., *The TRIPS Agreement: drafting history and analysis*, Sweet & Maxwell, 1998, p. 105.

60. It therefore follows from the scheme of the Directive that it is the graphic representation of the sign set out in the application for registration that allows an assessment to be carried out as to whether all the conditions relating to the acquisition of rights to the trade mark are complied with and which determines the rights and obligations conferred by its registration.

61. The scheme of the Directive thus indicates that the first condition under Article 2 is designed to allow precise identification of the sign that will be used by the applicant in order to distinguish his goods and services.

62. This interpretation is supported by the purpose underlying the requirement in question. As Advocate General Ruiz-Jarabo Colomer explained in his Opinion in the *Sieckmann* case (Case C-273/00) pending before the Court, [52] the requirement that the sign be capable of being represented graphically is based on the principle of legal certainty.

63. According to the Advocate General, '[a] registered trade mark confers a monopoly on its proprietor, allowing him exclusive use of the signs constituting it, to the exclusion of all other parties. An inspection of the register should allow a person to know, with as much certainty as the registration system will allow, the nature and scope of the signs, indications and symbols appearing on the register and it is for this reason that they require to be represented graphically. If an undertaking acquires a monopoly in certain signs and indications in order to distinguish its goods and services from those of other undertakings, it is necessary to be able to establish clearly what the symbols are which constitute it so that the others are aware of what it is they must refrain from doing'. [53] The counterpart of the monopoly conferred by registration of the trade mark is that third parties must be clearly informed as to the sign which is protected.

64. It follows that not every form of graphic representation will suffice. Two conditions must be met. First, the representation must be clear and precise in order that one may know beyond any possible doubt what it is that is being given the benefit of exclusive rights. Secondly, it must be intelligible to persons wishing to inspect the register, namely other manufacturers and consumers. It should not be necessary to go to inordinate lengths to ascertain what sign the applicant will actually use. [54]

65. I do not consider that a colour *per se* meets these conditions. I should say at the outset that I make no distinction between a colour which is reproduced in the application for registration and a colour which

52 — In that case, the Court is asked whether a smell could constitute a trade mark.

53 — Point 36 of his Opinion.

54 — Ibidem, point 38.

is designated by an internationally applied body of rules. In the latter case, it does not seem to me that the effort demanded of a consumer or a competitor in inspecting the relevant group of specimens in order to see what shade the applicant claims is excessive. Unless such a collection of specimens were difficult of access, a designation of this kind would allow a person to know clearly and unambiguously what colour the applicant had selected.

66. I am, however, of the view that the reproduction or designation of a colour in itself does not provide any means of determining what sign the applicant proposes to use in order to distinguish his goods and services.

67. As was mentioned at point 45 of this Opinion, a colour is always the attribute of something else. Unlike the signs listed in Article 2 of the Directive, such as words, designs, letters, numerals, the shape of goods or their packaging, a colour alone has no independent existence.

68. In other words, it would not be possible to determine precisely how the colour applied for will appear on the goods in relation to which the application for registration is made. It could equally well extend to the colouring of the whole of their external surface or their packaging, or appear on only some of these, or (in the case of very distinct designs) be surrounded by the generic colour of the goods.

69. The same applies to services. By definition, services have no material form in themselves, and thus have no colour. The trade mark could therefore only be applied to documents, vehicles or other objects used in connection with their supply. Once again, the colour applied for could appear on the whole of the surface of the item concerned, or (in the case of very distinct designs) on part only of it.

70. Moreover, if the applicant were to apply for registration of a colour *per se*, thereby seeking to obtain a monopoly in its use, this would suggest that he was trying to reserve all these possibilities.

71. This is shown all the more clearly if, as in the *Heidelberger Bauchemie* case cited above, the applicant were to apply for registration of several colours *per se*.[55] The absence of any arrangement of these col-

55 — In that case, an application was made to the German Patent and Trade Mark Office for registration of the colours blue and yellow. The application for the trade mark contained the following description: 'The trade mark applied for consists of the colours of the applicant's undertaking which are used in all conceivable shapes, particularly in packaging and labels. The precise reference of the colours is RAL 5015/HKS 47 — blue and RAL 1016/HKS 3 — yellow'.

ours in a single whole or in a pattern specified in the application for registration would obviously allow for a multitude of possible combinations to be used.

72. It would thus be very difficult in practice for a competent authority, faced with an application relating to a colour without shape or contour to ascertain whether the other conditions required for the registration of a trade mark had been met. Depending on whether it covered the whole surface of the goods or was a very distinct design, the colour might appear to a consumer to be wholly ornamental or a part of a distinctive sign. One might also ask in what conditions the competent authority could properly establish the likelihood of confusion between the sign applied for and a previously registered trade mark which included the colour applied for or a shade of it.

73. I would go on to submit that the registration of a colour *per se* as a trade mark would not allow other traders inspecting the register to determine what their rights were.

74. Under Article 5 of the Directive, a proprietor may prevent the use in course of trade in relation to any goods or services identical with or similar to those for which the trade mark has been registered, not only of a sign identical to it, but also of any sign capable of being confused with the trade mark on the part of the public.

75. If the registered trade mark is the colour *per se*, other traders would have difficulty in establishing in what way it would still be possible for them to use that colour for goods or services identical with or merely similar to those for which registration of the colour had been permitted.

76. Besides, this uncertainty would affect not only the colour as reproduced in the register or designated in an internationally agreed set of rules, but a large number of shades close to it. As was pointed out in points 43 and 44 of this Opinion, people's ability to distinguish shades of colours without risk of confusion is limited both by the properties of the human eye and the variable nature of the colour of objects having regard to lighting conditions and the distance from which they are observed.

77. I am of the opinion that these difficulties are contrary to the principle of legal certainty underlying the requirement that a sign be capable of being represented

graphically. It should be recalled that in its judgment in *Canon*,[56] the Court expressly recognised the importance that should be attached to this principle in the field of trade marks.[57]

78. In light of all of the above, I am of the opinion that a colour without shape or contour cannot be considered to be a sign capable of being represented graphically within the meaning of Article 2 of the Directive.

79. Nor does a colour *per se* meet the second requirement under Article 2 of the Directive, which provides that for a sign to constitute a trade mark it must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

3. The ability to distinguish the goods and services of one undertaking from those of other undertakings

80. I am of the view that Article 2 of the Directive excludes categories of signs or indications which are intrinsically incapable of having a distinctive character.

81. Such an analysis is not contrary to the case-law of either the Court of First Instance of the European Communities[58] or the Court of Justice,[59] which states that the distinctive character of a trade mark can be assessed only in relation to the goods or services in respect of which registration of the sign is applied for.[60] This case-law was based on an analysis of the absolute grounds for refusal specified in Article 7(1)(b) to (e) of the Regulation and the corresponding provisions of the Directive, in cases concerning signs covered by a category expressly referred to in Article 4 of the Regulation or Article 2 of the Directive, or in the context of the application of Article 3(3) of the Directive relating to the acquisition of a distinctive character through use.[61]

82. Moreover, any other interpretation would deprive the second requirement of Article 2 of the Directive of much of its practical effect. The same would apply to a large extent to Article 3(1)(a) of the Directive, which provides that signs which cannot constitute a trade mark cannot be registered.[62] It should be borne in mind

56 — Case C-39/97 [1998] ECR I-5507, paragraph 27.

57 — At paragraph 21 of that judgment, the Court held that in any event, for reasons of legal certainty and proper administration, it is necessary to ensure that trade marks whose use could be challenged before the courts are not registered.

58 — The Court of First Instance stated this rule in its first judgment given in the field of Community trade mark law (Case T-163/98 *Procter & Gamble* v *OHIM (Baby Dry)* [1999] ECR II-2383, paragraph 21), and has regularly restated it in later judgments (see, for example, Case T-87/00 *Bank für Arbeit und Wirtschaft* v *OHIM (Easybank)* [2001] ECR II-1259, paragraph 21).

59 — Case C-299/99 *Philips Electronics* [2002] ECR I-5475, paragraph 59.

60 — I am of the opinion that the Regulation and the Directive, which are worded in identical terms, should be interpreted in the same way.

61 — Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 30.

62 — Article 7(1)(a) of the Regulation is even more explicit as it states that signs that do not conform to the requirements of Article 4 of the Regulation cannot be registered.

that the requirement that trade marks which are devoid of any distinctive character should not be registered is expressly repeated in Article 3(1)(b) of the Directive.

83. Moreover, even though the Court has not yet had to pronounce on the question whether an application for registration of a sign or indication not listed in Article 2 of the Directive [63] or Article 4 of the Regulation may be refused on the basis of these provisions alone, it has on several occasions affirmed the overriding nature of the requirements specified in Articles 2 and 3(1)(a) of the Directive. [64] Likewise, in its judgment in *Phillips Electronics,* cited above, it stated that 'it is clear from the wording of Article 3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are *not generally capable* of being a trade mark'. [65]

84. The question at this stage is therefore one of determining whether a colour *per se* can have a distinctive character having regard only to its intrinsic characteristics. In my view there are two reasons why it cannot.

85. First, and as has just been pointed out, an application for registration of a colour *per se* would not allow determination of the sign actually appearing on the goods or in association with the services in question. An assessment of whether or not a sign is capable of having a distinctive character requires in my view that one should be able to know exactly what the sign is.

86. Secondly, I am of the opinion that a colour *per se* cannot fulfil the task of indicating the origin of goods or services. It should be recalled that the Court has defined this task as being one which is 'to guarantee the identity of the origin of the marked product to the consumer or ultimate user by enabling him without any possibility of confusion to distinguish that product from products which have another origin'. [66] The trade mark should guarantee the origin of the product bearing that mark. [67] The colour must therefore be capable of being very clearly defined.

87. As was pointed out in point 45 of this Opinion, if a colour *per se*, that is to say as an abstract entity, is to have meaning and provoke feelings, this is only because of the conventions in force in a society at a given time. [68] Moreover, even this meaning or these feelings, which may be based on deeply-rooted cultural phenomena, are

63 — There are several cases pending before the Court on this topic. As well as the *Sieckmann* and *Heidelberger Bauchemie* cases referred to above, an action is also pending in which it is asked to rule on whether a trade mark may be constituted by noises or sounds (Case C-283/01 *Shield Mark* ECR I-1413).

64 — See the judgments of the Court in *Canon*, paragraph 27, and *Merz & Krell,* paragraphs 23 and 24, both cited above.

65 — Paragraph 37, emphasis added.

66 — See, for example, Case C-10/89 *HAG GF* [1990] ECR I-3711, paragraph 14; *Canon,* cited above, paragraph 28, and *Merz & Krell,* cited above, paragraph 22.

67 — Case C-143/00 *Boehringer Ingelheim and Others* [2002] ECR I-3759, paragraph 29.

68 — Thus black signifies mourning, white purity (Pastoureau, M, cited above, pp. 31 and 157).

dependent on the conditions in which the colour is seen. [69] It follows that a colour can only be clearly defined if it is seen in the context of a particular shape or design. [70]

88. It is therefore wrong in my opinion to think that a colour without shape or contour can be defined in a way that is sufficiently precise that it indicates without any possible confusion the origin of goods or services.

89. It is nevertheless true that the OHIM has registered a colour *per se* as a trade mark on several occasions. For example, the colour lilac/violet has been registered for chocolate, [71] the colour magenta for goods and services in the telecommunications field [72] and the colour yellow for anticorrosion products. [73] OHIM took the view that each of these colours had acquired a distinctive character in relation to the goods or services in question through the use made of it. [74]

90. Registrations of this kind appear to me to be questionable having regard to the nature of the sign which consumers truly perceive and which they have learned to recognise as indicating the origin of the goods and services in question. As mentioned above, colour is always an attribute of something else. Therefore, what consumers have learned to recognise is not the colour in itself, but an object vested with this colour. [75] Colour is thus always mentally associated with something else. Usually, the association will be with a logo or a series of letters. [76] As a minimum, the other thing will comprise the shape of goods that have been put on the market.

91. If this other thing is lacking, consumers will no longer be able to identify the origin of the goods or services concerned with certainty. In other words, if the logo or the series of letters that they were used to seeing on goods or their wrapping were no longer to be there, or if the shape of goods were to have changed, consumers might be in doubt as to their origin, even though the colour remained the same.

92. Accordingly, to reduce signs to an abstract colour and to register that as a

69 — Wearing a black veil suggests mourning; however, wearing a black dress at an evening reception does not necessarily mean the same.

70 — Klinkenberg, J.-M., 'Qu'est-ce que le signe?', *Le Langage*, Editions Sciences Humaines, p. 105. The author gives the following example, taken from the highway code: when combined with a round shape, the colour red signifies a prohibition; when combined with a triangular shape, it signifies a danger.

71 — Registration of 27 October 1999, No 31336.

72 — Registration of 3 August 2000, No 212787.

73 — Registration of 9 January 2001, No 396176.

74 — As OHIM statistics do not include details relating to colours *per se*, it is difficult to confirm that no trade mark of this kind had been registered previously. Nevertheless, it is possible to conclude from the decisions of OHIM that if such registrations have been permitted it has only been in very exceptional cases (see for example Case R 122/1998-3, cited above, paragraphs 17, 18 and 21).

75 — See in this regard point 70 of my Opinion in Case C-112/99 *Toshiba Europe* [2001] ECR I-7945.

76 — If a car driver is able to associate green with BP filling stations, this is because in that company's logo the letters 'BP' appear against a green background and some parts of the exterior of the service station buildings of that company adopt the same colour. Likewise, the letters 'Milka' appear on the wrapping of chocolate bars in relation to which the colour lilac/violet has been registered as a trade mark by OHIM.

trade mark amounts in my view to treating a part of the trade mark as representing the whole. The trade mark does not consist of the colour *per se*, but of that colour associated with another thing or applied to an object.

93. This approach has been followed by certain national trade mark offices. The competent authority in the United Kingdom did not register the colour green *per se* on an application by the petroleum company BP for goods and services sold in its petrol filling stations, but did so for that colour when applied to the exterior of premises or buildings conforming to schedules annexed to the application forms. [77] In the same way, the authority did not register the colour pink *per se* for insulation materials, but 'the colour pink, as defined by Pantone No 196C, applied to the entire surface of the goods'. [78] In the field of service marks, the competent authority in Ireland allowed United Parcel Service of America to register a trade mark defined as: 'The mark consists of the colour brown as shown on the form of application, being the predominant colour applied to the visible surface of the uniforms worn by staff in the performance of the services.' [79]

94. Moreover, this analysis, in terms of which it is not the colour *per se* that can acquire a distinctive character through use, corresponds with the rules currently applied by the United States Patent and Trademark Office. [80] In this regard, it should be noted that the Qualitex trade mark, which allowed the Supreme Court of the United States to rule for the first time on the protection of colour marks and to accept that the concept was possible, does not consist of the shade of green-gold in itself, but in 'a particular shade of green-gold applied to the top and the surfaces of the goods'. [81]

95. In the light of the above, it is my opinion that these examples of the registration of a colour *per se* as a trade mark do

77 — High Court of Justice in Northern Ireland, Chancery Division, 16 June 2000, *BP Amoco PLC* v *John Kelly Ltd and Glenshane Tourist Services Ltd.*

78 — Registration of 25 October 1996, No 2004215. The representation of the trade mark on the register shows a drawing of insulating material.

79 — Registration dated 27 October 1998, No 221818. The representation of the trade mark on the register shows a uniform in the colour referred to in the application.

80 — According to the Trademark Manual of Examining Procedures, June 2002 version, the registration of a trade mark is conditional on its previous use. Section 1202.05, headed 'Color as a mark' states: 'Color marks are marks that consist solely of one or more colors used on particular objects. For marks used in connection with goods, the color may be used on the entire surface of the goods, on a portion of the goods, or on all of the packaging for the goods... Similarly, service marks may consist of color used on all or part of materials used in the advertising and rendering of the services... Color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness...' (http://www.uspto.gov).

81 — Registration No 1633711. The representation of the mark on the register shows a drawing of the product. In its judgment in *Qualitex Co.* v *Jacobson Products Co.* 514 U.S. 159 (1995), the Supreme Court held that a colour cannot be registered as a trade mark unless it is established that it has acquired over time 'a secondary meaning', that is to say that consumers recognise it as indicating a product's origin. The Supreme Court confirmed its position in its judgment in *Wal-Mart Stores Inc.* v *Samara Brothers, Inc.* 165 F.3d120 (2000).

not affect my interpretation of Article 2 of the Directive. [82]

96. On the contrary, I am of the view that the registrations referred to in point 93 of this Opinion show that traders who use a colour to identify their goods or services should be able to benefit from the protection conferred by trade mark legislation without it being necessary to register the colour *per se*. Moreover, those traders could equally make use of the law of their Member States relating to unfair competition, to civil liability or to consumer protection, as the sixth recital and Article 5(5) of the Directive show.

97. That being so, there is no reason to believe that the protection given to those traders against competitors who, in using the same colour or a shade of it, would be seeking to gain from the reputation or distinctive character of their trade mark, would be eliminated or reduced by the exclusion of colours *per se* from the categories of signs referred to in Article 2 of the Directive.

98. On the other hand, there are good reasons to believe that the registration of colours *per se* as trade marks could have negative implications for the freedom of competition which, as was pointed out in point 8 of this Opinion, is the object of the Directive.

99. Registration of a colour *per se* would, by application of Article 5 of the Directive and, at the very least, by reason of the impossibility faced by other traders of establishing precisely whether and how they could continue to use that colour, result in conferring a right to exclusive use of it on the proprietor of the trade mark. Furthermore, as was pointed out at point 76 of this Opinion, that exclusive use would extend not only to the colour as reproduced in the application for registration or designated by an internationally agreed set of rules, but could extend to a large number of shades of it. In other words, it is very likely that registration of a particular shade of blue as a trade mark would lead to

82 — The same applies to the judgments of the Court of First Instance in Case T-316/00 *Viking-Umwelttechnik* v *OHIM* (*juxtaposition of green and grey*) [2002] ECR II-3715, and Case T-173/00 *KWS Saat* v *OHIM* (*shade of orange*) [2002] ECR II-3843, delivered after the hearing in the present case. In these cases, the Court of First Instance held as a preliminary point that colours or colour combinations *per se* are capable of constituting Community trade marks in so far as they are capable of distinguishing the goods or services of one undertaking from those of another (see *Viking-Umwelttechnik* (*juxtaposition of green and grey*), paragraph 23, and KWS Saat (*shade of orange*), paragraph 25). Moreover, in the KWS Saat (*shade of orange*), case, that Court held that a shade of the colour orange *per se* was capable of having a distinctive character in relation to certain services. I would note, first, that the question of whether a colour *per se*, not having any shape or contour, is capable of constituting a Community trade mark within the meaning of Article 4 of the Regulation was not discussed before the Court of First Instance. Secondly, I do not believe that the reasoning of the Court of First Instance on which the decision to hold that a colour *per se* could have a distinctive character in relation to certain services was based requires me to reconsider my analysis.

conferring on the proprietor of the mark the exclusive right to use the colour blue. [83]

100. It would then follow, having regard to the feelings they may provoke in an observer and their more or less visible nature, that the number of colours capable of being used in practice for particular goods or services would be even more limited. This can be seen if one refers to the 'colours of the petroleum distribution companies' given as an example by those who were in favour of the registration of colours *per se* as trade marks. [84] The number of colours used by those companies on the exterior of their buildings and in their logos is lower than the number of colours having a specific name and most of them are used concurrently by several companies. [85]

101. It would thus be enough for several colours *per se* to be registered as trade marks to confer a real monopoly of use of the colour on a few traders. Such a monopoly could distort competition.

102. As the Commission quite correctly pointed out in its written observations, [86] colours are now of great importance to undertakings. More and more of them have taken to colouring their goods and objects associated with the provision of their services. [87] These colours serve to attract the attention of consumers. [88] Moreover, because they provoke feelings, they allow undertakings to place their goods and services in our imagination. [89] Colours have thus become a real means of communication between undertakings and consumers. It is likely that their use will grow, given the dominant role that images possess in communications today.

103. It is thus possible to conceive that a trader who was prevented from using colours or even a certain number of them would be disadvantaged in relation to his competitors and that a monopoly of use of

83 — This point of view is shared by OHIM. For the colour blue, see the decision of the Second Board of Appeal of 29 February 2000, Case R 342/1999-2, rejecting an application for registration lodged by ARAL. See also decision R 122/1998-3, cited above, paragraph 29.

84 — See Libertel's written observations, paragraph 7.1.

85 — For example, yellow is used by Shell, Agip and BP, blue by ARAL, Total and ELF, red by Total and ELF, an orange shade by Total and Esso, an so on.

86 — Paragraph 73.

87 — According to *Géodys 2000/2001*, *'La marque dans tous ses états'*, 'numerous industries have set up in their design departments a group specialising in colours and materials. It was Moulinex which started, in 1997, by producing its small domestic appliances in yellow or green. Nowadays, Apple colours its IMac, Nurofen its medicine packaging and Philips its television sets', p. 218.

88 — According to Kapferer, J.-N., 'colour is the first indicator of a trade mark for a consumer in a self-service store', in *Les marques, Capital de l'entreprise, Les chemins de la reconquête*, Les éditions de l'organisation 1995, Paris, p. 355.

89 — Slightly acid colours signify regression and trigger memories of the colours of childhood in the consumer, loud colours signify transgression and give the consumer the impression of being freed from convention, natural tints signify authenticity and provide goods with a calming rural aspect, high-tech colours (e.g. metallic green) signify security and provide reassurance because they are synonymous with perfection (*Géodys 2000/2001*, p. 218).

colours could even stop new traders entering a particular market.

104. It follows from this that an analysis of the objectives of trade mark law supports the conclusion that colours *per se* should not be allowed to be the subject of exclusive use by certain traders and that they should remain available to all.

105. In the light of the reasons set out above, I propose that the Court should reply that Article 2 of the Directive should be interpreted as meaning that a colour *per se*, without shape or contour, cannot constitute a sign capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of other undertakings.

106. Given that answer, the other questions put by the national court are irrelevant to the main proceedings. I am of the view that they do not require to be answered.

V — Conclusion

107. In light of all the foregoing considerations, I propose that the Court answer the questions put by the Hoge Raad der Nederlanden as follows:

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, should be interpreted as meaning that a colour *per se*, without shape or contour, does not constitute a sign capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of other undertakings.