

Court of Justice EU, 27 March 2019, Hartwall



## TRADE MARK LAW

Classification given by the applicant when registering a sign as a "colour mark" or "figurative mark" is a relevant factor amongst others to establish whether that sign can constitute a trade mark under Article 2 of the Trade Mark Directive 2008 and whether this mark has distinctive character under Article 3(1)(b)

- Consequently, the answer to the first question is that Articles 2 and 3(1)(b) of Directive 2008/95 must be interpreted as meaning that the classification as a 'colour mark' or 'figurative mark' given to a sign by the applicant on registration is a relevant factor among others for the purpose of establishing whether that sign can constitute a trade mark within the meaning of Article 2 of the directive and, if so, whether it is distinctive within the meaning of Article 3(1)(b) of that directive. [...]

Trade mark authority is obliged to carry out a concrete and global assessment of the distinctive character of the trade mark concerned:

- authority cannot refuse registration of a sign as a trade mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed  
[...] but does not release the competent trade mark authority from its obligation to carry out a global assessment of distinctive character by reference to the actual situation of the mark considered, which means that that authority cannot refuse registration of a sign as a mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed.
- for a colour combination designated in the abstract and without contours, it is necessary to examine whether and to what extent the systematically arranged colour combination is capable of conferring inherent distinctive character on the sign in question

33 Moreover, when the sign registration of which as a mark is sought consists of a colour combination designated in the abstract and without contours, it is the Court's settled case-law that the graphic representation of those colours must be systematically arranged by associating them in a predetermined and uniform way (see, to that effect, judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 33).

34 Thus, in the overall analysis of distinctive character by reference to the actual situation, it is necessary to examine whether and to what extent the systematically arranged colour combination is capable of conferring inherent distinctive character on the sign in question.

**Registration as a colour mark of a sign that is represented as a colour drawing with defined contours, but is described as a colour mark should be refused due to an inconsistency in the application for registration**

- Consequently, the answer to the second question is that Article 2 of Directive 2008/95 must be interpreted as precluding, in circumstances such as those in the main proceedings, the registration of a sign as a mark due to an inconsistency in the application for registration, which it is for the referring court to ascertain.

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## Court of Justice EU, 27 March 2019

(T. von Danwitz, K. Jürimäe, C. Lycourgos, E. Juhász (Rapporteur) and C. Vajda)

JUDGMENT OF THE COURT (Fourth Chamber)

27 March 2019 (\*)

(Reference for a preliminary ruling — Approximation of laws — Trade marks — Directive 2008/95/EC — Articles 2 and 3(1)(b) — Refusal to register or invalidity — Assessment of distinctive character by reference to the actual situation — Classification of a trade mark — Effect — Colour mark or figurative mark — Graphic representation of a mark submitted as a figurative mark — Conditions for registration — Insufficiently clear and precise graphic representation)

In Case C-578/17,

REQUEST for a preliminary ruling under Article 267 TFEU from the Korkein hallinto-oikeus (Supreme Administrative Court, Finland), made by decision of 28 September 2017, received at the Court on 3 October 2017, in the proceedings

Oy Hartwall Ab

interested party:

Patentti- ja rekisterihallitus,

THE COURT (Fourth Chamber),

composed of T. von Danwitz, President of the Seventh Chamber, acting as President of the Fourth Chamber, K. Jürimäe, C. Lycourgos, E. Juhász (Rapporteur) and C. Vajda, Judges,

Advocate General: H. Saugmandsgaard Øe,

Registrar: C. Strömholm, Administrator,

having regard to the written procedure and further to the hearing on 6 September 2018,

after considering the observations submitted on behalf of:

– Oy Hartwall Ab, by J. Palm, oikeudenkäyntiavustaja,

– the Finnish Government, by S. Hartikainen, acting as Agent,

– the European Commission, by É. Gippini Fournier, I. Koskinen and J. Samnadda, acting as Agents, after

hearing the [Opinion of the Advocate General](#) at the sitting on 22 November 2018, gives the following

### Judgment

1 This request for a preliminary ruling concerns the interpretation of Articles 2 and 3(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2 The request has been made in proceedings brought by Oy Hartwall Ab concerning the rejection of a trade mark application submitted by Hartwall by the Patenttija rekisterihallitus (Intellectual Property Office, Finland).

### Legal context

#### Directive 2008/95

3 Recital 6 of Directive 2008/95 states:

*‘Member States should also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration. They can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both. Member States should remain free to determine the effects of revocation or invalidity of trade marks.’*

4 Article 2 of the directive, entitled ‘Signs of which a trade mark may consist’, provides: ‘A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

5 Under the title ‘Grounds for refusal or invalidity’, Article 3 of the directive provides, in paragraphs 1 and 3:

*‘1. The following shall not be registered or, if registered, shall be liable to be declared invalid:*

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

*... 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.’*

### Finnish law

6 The tavaramerkkilaki (7/1964) (Law on trade marks (7/1964)), in the version applicable to the dispute in the main proceedings, provides, in Paragraph 1(2), that ‘a trade mark may consist of any signs capable of being

*represented graphically which enable goods placed on the market to be distinguished from other goods. A trade mark may consist in particular of a word, including personal names, a design, a letter, a numeral, the shape of a product or of its packaging’.*

7 Under Paragraph 13 of that law, ‘the mark to be registered must be capable of distinguishing its proprietor’s goods from those of others. ... When assessing the sign’s distinctive character, account must be taken of all the circumstances of a case, in particular the duration and extent of the use of the trade mark’.

### The dispute in the main proceedings and the questions referred for a preliminary ruling

8 By application lodged on 20 September 2012, Hartwall sought to register, with the Intellectual Property Office, the sign represented below as a colour mark, described as follows: ‘The colours of the sign are blue (PMS 2748, PMS CYAN) and grey (PMS 877)’ (‘the mark at issue’).



9 The goods in respect of which registration was sought are in Class 32 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Mineral waters’.

10 Following a preparatory decision of the Intellectual Property Office, Hartwall clarified that it was applying for registration of the mark at issue as a ‘colour mark’, not a figurative mark.

11 By decision of 5 June 2013, the Intellectual Property Office rejected the application on the ground that the trade mark applied for was devoid of distinctive character.

12 In that regard, the Intellectual Property Office highlighted that the exclusive right to register certain colours cannot be granted if it is not established that the colours in respect of which protection is sought have acquired distinctive character through long-term significant use.

13 The decision of the Intellectual Property Office stated that the market study produced by Hartwall showed that the reputation of the mark at issue was established not with regard to the colours as such but with regard to the figurative sign the contours of which are defined and determined. Therefore, contrary to the requirement resulting from that office’s consistent practice, it found that the colour combination in respect of which protection is sought has not been established as having been used to identify the goods offered by Hartwall for a sufficient length of time and sufficiently

widely to have acquired distinctive character in Finland through use, as of the date on which registration was sought.

14 Hartwall appealed against the Intellectual Property Office's decision before the markkinaoikeus (Market Court, Finland); the appeal was dismissed.

15 In support of that decision, the markkinaoikeus (Market Court) observed that the graphic representation of the sign in respect of which protection was sought did not include a systematic arrangement associating the colours concerned in a predetermined and uniform way and, therefore, that mark did not satisfy the requirements with regard to the graphic representation of a sign as laid down by the Law on trade marks (7/1964).

16 Hartwall appealed against the decision of the markkinaoikeus (Market Court) to the referring court, the Korkein hallinto-oikeus (Supreme Administrative Court, Finland).

17 The referring court states that, to its knowledge, the Court has not yet settled the question whether a sign represented as a colour drawing can be registered as a 'colour mark'. It adds that the Court has not ruled either on the effect of the classification of a mark as a colour mark on the assessment of that mark's distinctive character.

18 The referring court highlights the importance of the answer to that question in the matter brought before it, in so far as the Intellectual Property Office is of the view that, as regards colour marks, the distinctive character of a sign must be proved by evidence of long-term significant use of the sign.

19 It is therefore unsure as to the consequences of the classification given to a sign by the person seeking protection of that sign under trade mark law.

20 In those circumstances, the Korkein hallinto-oikeus (Supreme Administrative Court) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

*'(1) For the interpretation of Article 2 of Directive [2008/95] and the condition relating to the distinctive character of a trade mark within the meaning of Article 3(1)(b) thereof, is it of relevance whether the trade mark is to be registered as a figurative mark or a colour mark?*

*(2) If the classification of the mark as a colour mark or figurative mark is of importance in the assessment of its distinctive character, is the mark, regardless of its representation as a drawing, to be registered as a colour mark in accordance with the trade mark application, or can it be registered only as a figurative mark?*

*(3) If it is possible to register, as a colour mark, a mark represented in the form of a drawing in the trade mark application, is it necessary for the registration as a colour mark of a mark which has been graphically illustrated in the trade mark application with the accuracy required by the case-law of the Court of Justice relating to colour marks (and which is not the registration as a mark of a colour in itself, abstract, without shape or contours), is it necessary to submit in*

*addition solid evidence of use as required by the [Intellectual Property Office] or any such evidence?'*

#### **Consideration of the questions referred**

21 At the outset, it should be borne in mind that Directive 2008/95 does not establish categories of marks and Article 2 and Article 3(1)(b) and (3) of the directive make no distinction between different categories of trade marks (see, to that effect, judgment of 19 June 2014, *Oberbank and Others*, C-217/13 and C-218/13, EU:C:2014:2012, paragraph 46).

22 According to recital 6 of Directive 2008/95, it is for the Member States to determine what form the procedures concerning the registration and invalidity of trade marks are to take and they remain entirely free to adopt rules governing those procedures in that field.

23 Such freedom should not, however, run counter to the harmonised definition of the notion of 'trade mark' and to the criteria governing the distinctive character of a mark, both flowing from Articles 2 and 3(1) of Directive 2008/95, which could deprive the directive of its effectiveness and be detrimental to the proper functioning of the system of trade mark registration.

#### **The first question**

24 By its first question, the referring court asks, in essence, whether Articles 2 and 3(1)(b) of Directive 2008/95 must be interpreted as meaning that the classification as a 'colour mark' or 'figurative mark' given to a sign by the applicant on registration is a relevant factor in order to determine whether that sign can constitute a trade mark and, if so, whether it has distinctive character within the meaning of Article 3(1)(b) of that directive.

25 In that regard, it should be noted, first of all, that the fact that the registration of a sign is sought as a 'colour mark' or 'figurative mark' is relevant in order to determine the subject matter and scope of the protection conferred by trade mark law for the purpose of applying Article 2 of Directive 2008/95. The classification of a sign as a 'colour mark' or 'figurative mark' serves to clarify the subject matter and scope of the protection sought under trade mark law, in that it enables it to be specified whether the contours are part of the subject matter of the application for registration.

26 As for the effect of the classification of a sign as a 'colour mark' or 'figurative mark' on the assessment of distinctive character, it must be held that when a competent authority examines a trade mark application, it must, in order to determine whether the sign in respect of which protection is sought under trade mark law has distinctive character within the meaning of Article 3(1)(b) of Directive 2008/95, carry out an examination by reference to the actual situation, taking account of all the circumstances of the case and in particular any use which has been made of the sign (see, to that effect, judgments of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244, paragraph 76; of 12 February 2004, *Koninklijke KPN Nederland*, C-363/99, EU:C:2004:86, paragraphs 31 to 35; and of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 41).



27 The examination of the distinctive character of a mark cannot therefore be carried out in the abstract (judgment of 12 February 2004, *Koninklijke KPN Nederland*, C-363/99, EU:C:2004:86, paragraph 31).

28 Moreover, the Court has held that the criteria of assessment of the distinctive character of colour marks are the same as those applicable to the other categories of marks. The potential difficulties in establishing the distinctive character of certain categories of marks because of their nature — difficulties which it is legitimate to take into account — do not justify laying down stricter criteria supplementing or derogating from application of the criterion of distinctive character as interpreted by the Court with regard to other categories of marks (see, to that effect, judgment of 19 June 2014, *Oberbank and Others*, C-217/13 and C-218/13, EU:C:2014:2012, paragraphs 46 and 47).

29 However, although the criteria relating to the assessment of distinctive character are the same for colour marks and figurative marks, it is apparent from the Court's case-law that the perception of the relevant public is not necessarily the same in the case of a sign consisting of a colour per se as it is in the case of a word or figurative mark. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, a colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking (see, to that effect, judgment of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244, paragraph 65).

30 Thus, the Court has held that, in the case of a colour per se, distinctiveness without any prior use is inconceivable save in exceptional circumstances and, even if a colour per se does not initially have any distinctive character, it may acquire such character in relation to the goods or services in respect of which registration of the mark is sought following the use made of it (judgment of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244, paragraphs 66 and 67).

31 Moreover, in assessing the potential distinctive character of a colour per se or a colour combination as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought (judgments of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244, paragraph 60, and of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 41).

32 That being said, the Court's case-law recalled in the paragraphs above does not release competent trade mark authorities from the obligation to carry out an examination of distinctive character by reference to the actual situation, taking account of all the circumstances of the case. Thus, it would run counter to such an examination if those authorities could establish distinctive character of a colour per se or colour combination only on account of such a colour sign being used in relation to the goods or services claimed.

33 Moreover, when the sign registration of which as a mark is sought consists of a colour combination designated in the abstract and without contours, it is the Court's settled case-law that the graphic representation of those colours must be systematically arranged by associating them in a predetermined and uniform way (see, to that effect, judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 33).

34 Thus, in the overall analysis of distinctive character by reference to the actual situation, it is necessary to examine whether and to what extent the systematically arranged colour combination is capable of conferring inherent distinctive character on the sign in question.

35 Consequently, the answer to the first question is that Articles 2 and 3(1)(b) of Directive 2008/95 must be interpreted as meaning that the classification as a 'colour mark' or 'figurative mark' given to a sign by the applicant on registration is a relevant factor among others for the purpose of establishing whether that sign can constitute a trade mark within the meaning of Article 2 of the directive and, if so, whether it is distinctive within the meaning of Article 3(1)(b) of that directive, but does not release the competent trade mark authority from its obligation to carry out a global assessment of distinctive character by reference to the actual situation of the mark considered, which means that that authority cannot refuse registration of a sign as a mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed.

#### The second question

36 By its second question, the referring court asks, in essence, whether Article 2 of Directive 2008/95 must be interpreted as precluding the registration of a mark, such as that at issue in the main proceedings, submitted, in the application for registration, in the form of a drawing of a colour mark.

37 In the present case, the referring court states that, according to the application for registration submitted by Hartwall, the sign protection of which is sought is represented by a colour drawing with defined contours, whereas the classification given by Hartwall to the mark registration of which is sought is that of a colour combination without contours.

38 In that regard, it should be noted that, according to the Court's settled case-law, a sign may be registered as a mark only if the applicant provides a graphic representation in accordance with the requirement in Article 2 of Directive 2008/95, to the effect that the subject matter and scope of the protection sought are clearly and precisely determined (see, to that effect, judgment of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244, paragraph 29 and the case-law cited).

39 The verbal description of the sign serves to clarify the subject matter and scope of the protection sought under trade mark law (see, to that effect, judgment of 27 November 2003, *Shield Mark*, C-283/01, EU:C:2003:641, paragraph 59, and, as an example, judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 34).

40 As the Advocate General set out, in essence, in [points 60 to 63](#) of his Opinion, when the trade mark application contains an inconsistency between the sign, protection in respect of which is sought in the form of a drawing, and the classification given to the mark by the applicant, the consequence of which is that it is impossible to determine exactly the subject matter and scope of the protection sought under trade mark law, the competent authority must refuse registration of the mark on account of the lack of clarity and precision of the trade mark application.

41 In the present case, the sign protection in respect of which is sought is represented by a figurative drawing, whereas the verbal description relates to a protection concerning two colours alone, that is, blue and grey. Moreover, Hartwall has clarified that it seeks to register the mark at issue as a colour mark.

42 Those circumstances appear to reveal an inconsistency showing that the application for protection under trade mark law is unclear and imprecise.

43 Consequently, the answer to the second question is that Article 2 of Directive 2008/95 must be interpreted as precluding, in circumstances such as those in the main proceedings, the registration of a sign as a mark due to an inconsistency in the application for registration, which it is for the referring court to ascertain.

#### The third question

44 In view of the answer to the second question, there is no need to reply to the third question.

#### Costs

45 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Fourth Chamber) hereby rules:

1. Articles 2 and 3(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the classification as a ‘colour mark’ or ‘figurative mark’ given to a sign by the applicant on registration is a relevant factor among others for the purpose of establishing whether that sign can constitute a trade mark within the meaning of Article 2 of the directive and, if so, whether it is distinctive within the meaning of Article 3(1)(b) of that directive, but does not release the competent trade mark authority from its obligation to carry out a global assessment of distinctive character by reference to the actual situation of the mark considered, which means that that authority cannot refuse registration of a sign as a mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed.

2. Article 2 of Directive 2008/95 must be interpreted as precluding, in circumstances such as those in the main

proceedings, the registration of a sign as a mark due to an inconsistency in the application for registration, which it is for the referring court to ascertain.

[Signatures]

## OPINION OF ADVOCATE GENERAL

### SAUGMANDSGAARD ØE

delivered on 22 November 2018(1)

Case C-578/17

Oy Hartwall Ab

Interested party:

Patentti- ja rekisterihallitus

(Request for a preliminary ruling from the Korkein hallinto-oikeus (Supreme Administrative Court, Finland))

(Request for a preliminary ruling — Trade marks — Directive 2008/95/EC — Article 2 — Article 3(1)(b) and 3(3) — Grounds for refusal or invalidity — Distinctive character — Distinctive character acquired through use — Inherent distinctive character — Graphic representation — Colour mark or figurative mark — Colour mark presented as figurative mark — Registration requirements — Trade mark categories — Trade mark types — Discrepancies in the trade mark application)

#### I. Introduction

1. In this request for a preliminary ruling, the Korkein hallinto-oikeus (Supreme Administrative Court, Finland) refers to the Court for a preliminary ruling a number of questions concerning the interpretation of the requirement relating to graphic representation laid down in Article 2 of Directive 2008/95/EC (2) and the requirement relating to distinctive character laid down in Articles 2, 3(1)(b) and 3(3) thereof.

2. The request for a preliminary ruling has its origin in a dispute between Oy Hartwall Ab and the Patentti- ja rekisterihallitus (Finnish Patent and Registration Office). The latter refused a trade mark application from Oy Hartwall for registration of a colour mark on the ground that the trade mark applied for was devoid of distinctive character as a colour mark. In the application, the colour mark was represented graphically as a figure.

3. The case thus raises the question as to how the requirement relating to graphic representation and the requirement relating to distinctive character laid down in Directive 2008/95 are to be interpreted in relation to possible registration of a colour mark. By the questions which it has referred, the national court essentially asks whether Articles 2 and 3 of the directive preclude registration of a colour mark where it is represented graphically as a figure in the trade mark application.

4. In this Opinion, I will set out the reasons why I think, first, that Articles 2 and 3(1)(b) and 3(3) of that directive must be interpreted as meaning that it is relevant to the interpretation of the requirement relating to distinctive character whether a trade mark is to be registered as a figurative mark or as a colour mark and, second, that Article 2 precludes registration of a trade mark such as that in the present case, which shows a

figure in its graphic representation, but which the applicant seeks to register as a colour mark.

## II. Legal framework

### A. Directive 2008/95 (3)

5. Article 2, entitled '*Signs of which a trade mark may consist*', is worded as follows:

*'A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'*

6. Article 3(1)(b) and 3(3), concerning grounds for refusal or invalidity, states:

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

*...*

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

*...*

*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.'*

### B. Finnish law

7. Directive 2008/95 was transposed into Finnish law by Trade Mark Law No 7/1964 of 10 January 1964, the version of which relevant to this case was most recently amended by Law No 56/2000.

8. Under Paragraph 1(2) (the version of which relevant to this case was most recently amended by Law No 39/1993), any sign which is capable of being represented graphically, and which is capable of distinguishing the goods or services of one undertaking from those of other undertakings, may constitute a trade mark. The provision further states that a trade mark may consist of particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging.

9. Under Paragraph 13 (the version of which relevant to this case was most recently amended by Law 56/2000), the trade mark to be registered must serve to distinguish the trade mark proprietor's goods from others' goods. A trade mark which may serve, exclusively or solely in a slightly altered or supplemented form, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the products, must not be regarded as having distinctive character per se. Under that provision, in assessing the sign's distinctive character, account must be taken of all circumstances, particularly how long and how extensively the trade mark has been used.

## III. The main proceedings, questions referred for a preliminary ruling and procedure before the Court

10. On 20 September 2012 Oy Hartwall sought to register the sign set out below with the Patentti- ja rekisterihallitus. According to the graphic representation of the sign, it consists of a blue band with a thin grey line around the edges. The sign was to be registered as a colour mark for goods in Class 32: mineral waters. Oy Hartwall described the colours as follows: The colours of the sign are blue (PMS 2748, PMS CYAN) and grey (PMS 877).



11. In the application, Oy Hartwall had submitted a market survey to the Patentti- ja rekisterihallitus in which the mark applied for had been presented to persons taking part in the study, and a declaration by two of the company's employees on the use of the trade mark to identify the company's products.

12. Following a preparatory decision of the Patentti- ja rekisterihallitus, Oy Hartwall indicated that it was applying for registration of the mark as a colour mark and not a figurative mark.

13. By decision of 5 June 2013, the Patentti- ja rekisterihallitus refused the application on the ground that the trade mark applied for was devoid of distinctive character. The grounds for the decision stated inter alia that, according to the established practice of the Patentti- ja rekisterihallitus, the exclusive right to register certain colours cannot be granted without solid evidence that the colours for which registration is sought have become distinctive to the goods over a long period and as a result of extensive use.

14. According to the decision, the market study established the reputation, not of the colours themselves, but of the figurative mark. It has not been established that, at the time the application was filed, the colour combination for which registration is sought had been used to identify the company's goods for long enough or extensively enough to have acquired a distinctive character in Finland as a result of such use.

15. Oy Hartwall appealed against the decision to the Markkinaoikeus (Market Court, Finland), which dismissed the company's appeal.

16. In the grounds for its decision, the Markkinaoikeus (Market Court) stated that Oy Hartwall sought registration of a colour combination. The Markkinaoikeus (Market Court) observed inter alia that the graphic representation of the sign in the application did not include a systematic arrangement associating the colours at issue in a predetermined and uniform way. Thus, in the view of the Markkinaoikeus (Market Court), the colour mark applied for did not satisfy the requirements with regard to graphic representation laid



down in Paragraph 1(2) of Trade Mark Law No 39/1993, which is necessary for registration.

17. Oy Hartwall appealed against the decision of the Markkinaoikeus (Market Court) to the Korkein hallinto-oikeus (Supreme Administrative Court), the referring court.

18. The Korkein hallinto-oikeus (Supreme Administrative Court) must now decide whether Oy Hartwall's trade mark should be registered as a colour mark. The Korkein hallinto-oikeus (Supreme Administrative Court) is unsure as to the importance to be given, in an application for the possible registration of the trade mark at issue, to the classification of the mark as a colour mark in the application.

19. By judgment of 28 September 2017, the Korkein hallinto-oikeus (Supreme Administrative Court) decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

‘(1) For the interpretation of Article 2 of Directive 2008/95/EC of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (codified version) and the condition relating to the distinctive character of a trade mark within the meaning of Article 3(1)(b) thereof, is it of relevance whether the trade mark is to be registered as a figurative mark or a colour mark?

(2) If the classification of the mark as a colour mark or figurative mark is of importance in the assessment of its distinctive character, is the mark, regardless of its representation as a drawing, to be registered as a colour mark in accordance with the trade mark application, or can it be registered only as a figurative mark?

(3) If it is possible to register, as a colour mark, a mark represented in the form of a drawing in the trade mark application, is it necessary for the registration as a colour mark of a mark which has been graphically illustrated in the trade mark application with the accuracy required by the case-law of the Court of Justice relating to colour marks (and which is not the registration as a mark of a colour in itself, abstract, without shape or contours) to submit in addition solid evidence of use as required by the Patentti- ja rekisterihallitus or any such evidence?’

20. Written submissions have been submitted by Oy Hartwall, the Finnish Government and the European Commission. The Finnish Government and the European Commission took part in the hearing on 6 September 2018.

#### IV. Analysis

##### A. Preliminary remarks

21. At the hearing questions were raised as to the Court's jurisdiction in this case. In light of that, I will note briefly that the Court does have jurisdiction to answer the questions referred. As my analysis of those questions will show, this case does not concern the interpretation of Finnish law, but the interpretation of Articles 2 and 3 of Directive 2008/95. It may be inferred from the sixth recital of the directive that the Member States remain free to fix the provisions of procedure concerning the registration of trade marks.

However, as the Finnish Government also pointed out at the hearing, the Member States' provisions of procedure are to be laid down and administered in such a way as to guarantee compliance with the requirements relating to registration of trade marks, which are harmonised by the directive. In other words, the national authorities are to ensure that the requirements of the directive are complied with, including those laid down in Articles 2 and 3, according to which all trade marks must, in order to be registrable, be capable of being represented graphically and have distinctive character.

##### B. The questions referred for a preliminary ruling

1. The relevance of whether the trade mark is to be registered as a figurative mark or a colour mark to the interpretation of Article 2 of Directive 2008/95/EC and the condition relating to the distinctive character of a trade mark within the meaning of Article 3(1)(b) and 3(3) thereof? (Question 1)

22. By its first question, the referring court essentially asks the Court, whether, for the interpretation of Article 2 of Directive 2008/95/EC and the condition relating to the distinctive character of a trade mark within the meaning of Article 3(1)(b) and 3(3) thereof, it is of relevance whether the trade mark is to be registered as a figurative mark or a colour mark. (4)

23. I note at the outset that the Finnish Government stated at the hearing that the Finnish authorities alone have the power to determine whether the trade mark applied for can be registered as a colour mark. This is so because, according to the information provided, under Finnish law, the Finnish authorities do not have the power to alter the choice of the trade mark type which was made in the trade mark application. Since Oy Hartwall applied for registration of a colour mark, (5) the Finnish authorities thus have no power to examine whether the trade mark is registrable instead — or also — as a figurative mark. (6)

24. In the light of this, I proceed below from the assumption that the subject matter of the trade mark applied for is a colour mark. I will therefore not give any consideration to whether Oy Hartwall Ab also sought to register the mark as a figurative mark. (7)

25. In order to analyse Question 1, it is, as the Commission has stated, necessary to ask the following two questions: Firstly, whether it is relevant, for establishing the subject matter to be protected by registration, whether the trade mark is to be registered as a figurative mark or a colour mark (a) and, secondly, of what relevance is it for the assessment whether the trade mark has distinctive character, whether the trade mark is to be registered as a figurative mark or a colour mark (b).

(a) The relevance of the fact that a mark is to be registered as a figurative mark or a colour mark to establishing the subject matter of the trade mark applied for

26. To answer this question, it is necessary to describe the subject matter of a colour mark and a figurative mark, in particular what the difference between the two types of trade mark is.

27. In that connection, I note firstly that Directive 2008/95 is based on a clear premiss that there are different types of trade mark.

28. Under Article 2 of the directive, entitled ‘Signs of which a trade mark may consist’, a trade mark may consist of any signs capable of being represented graphically, provided that the sign concerned is capable of distinguishing the goods or services of one undertaking from those of others. The provision lists the examples ‘words, including personal names, designs, letters, numerals, the shape of goods or of their packaging’. (8) Although Article 2 does not contain an actual categorisation of various trade mark types, the listed signs show that trade marks can take various forms.

29. I further note that both figurative marks and colour marks can constitute trade marks within the meaning of Article 2. As regards figurative marks, they are in fact covered by the examples of ‘designs’ listed in Article 2. Colour marks, on the other hand, do not feature among the examples listed in Article 2, (9) but the Court held in the two reference judgments on colour marks, namely *Libertel* (10) and *Heidelberger Bauchemie*, (11) that colour marks can constitute trade marks within the meaning of Article 2. (12)

30. This takes me on to the central question, namely what is meant precisely by ‘colour mark’ and ‘figurative mark’ and how do the two types of trade mark differ.

31. A colour mark is a sign which consists of a colour or a combination of colours per se with no shapes or contours. (13)

32. The particular feature of registration of a colour mark is that it is the colour or combination of colours per se which is afforded protection. As an example of a colour mark I refer to the judgment in the case of *Louboutin* and *Christian Louboutin*, which was given recently by the Grand Chamber of the Court of Justice. (14) That case concerned a Benelux trade mark, consisting of the colour red, which is applied to the sole of a high-heeled shoe. The contour of the shoe was not part of the registered trade mark. (15) In the judgment, the Court confirmed that the fact that a colour is applied to a product, which thus in practice will constitute the outline of the colour, does not mean that the shape forms part of the trade mark. (16) In other words, the sole was not part of the trade mark even though the registered colour was given an outline when applied to the sole of a high-heeled shoe.

33. As the Court indicated in its judgment in *Libertel*, registration of colour marks provides quite comprehensive protection. The fact that the number of colours actually available is limited means that a small number of trade mark registrations for certain services or goods could exhaust the entire range of the colours available. (17)

34. As regards figurative marks, on the other hand, they consist of a figurative element. Where figurative marks are registered, it is the figurative element, as shown in the graphic representation of the mark, which is

afforded protection. Where the figurative mark is in colours, it is the figurative mark, as shown in the stated colours, which is afforded protection by registration. (18)

35. As is apparent from the foregoing, the two categories of trade mark are therefore different in that a colour mark protects the right to use a certain colour or combination of colours per se, that is to say without any contours, whilst a figurative mark protects the right to use the figurative mark exactly as it is shown in the graphic representation thereof, with contours and any colours.

(b) The relevance of the fact that a trade mark is to be registered as a figurative mark or a colour mark to the assessment of the mark’s distinctive character.

36. The question then arises as to whether it is of relevance to the assessment of the requirement relating to distinctive character whether the applicant seeks protection for a colour mark or a figurative mark. In my view, the answer to this question can be deduced from the Court’s settled case-law, which I will set out below.

37. It is a fundamental requirement for registration of a trade mark that the trade mark has distinctive character (Articles 2, 3(1)(b) and 3(3)). Distinctive character means that the mark must serve to identify the product or service covered by that mark as originating from a particular undertaking, and thus to distinguish that product or service from goods of other undertakings.

(19) The essential function of a trade mark is therefore to guarantee the identity of the origin of the marked goods or service to the consumer by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. (20)

38. It is settled case-law of the Court that, whether inherent (Article 3(1)(a)) or acquired through use (Article 3(3)), the distinctive character of a mark must be assessed in relation to two parameters: on the one hand, to the goods or services covered by that mark and, on the other, to the presumed expectations within the trade circles concerned. (21)

39. The Court has further specified how the assessment of distinctive character acquired through use is to be assessed in practice. The competent authority must carry out an examination by reference to the actual situation and make an overall assessment of the evidence that the mark has, among the relevant class of persons, come to identify the goods or services concerned as originating from a particular undertaking. Moreover, that evidence must relate to use of the mark.

(22) In the context of that assessment, the following items may, inter alia, be taken into consideration: the market share held by the mark in question; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identifies goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations. (23)



40. Next, as regards the question as to what relevance the assessment of the requirement relating to distinctive character has to whether a trade mark is to be registered as a colour mark or figurative mark, the Court has held previously that Article 2 and Article 3(1)(b) and (3) of Directive 2008/95 make no distinction between different categories of trade marks. The criteria for assessing the distinctive character of colour marks, including whether that mark has acquired a distinctive character as a consequence of use, are thus in principle no different from those to be applied to other categories of trade mark, including figurative marks. (24) Therefore, stricter criteria supplementing or derogating from application of the criterion of distinctiveness cannot be laid down in respect of certain types of marks. (25)

41. I should point out, however, that it also follows from the Court's case-law that, in respect of certain types of trade mark, which have a specific quality, account must be taken of the specific characteristics of those trade mark types. This is so inter alia in the case of colour marks, in respect of which I deduce from the Court's case-law referred to below that account must be taken of two factors on account of colour marks' specific characteristics.

42. Firstly, the Court has held that save in exceptional cases, in particular where markets are very specific, a colour mark does not initially have a distinctive character. (26) Colour marks seldom have distinctive character initially because consumers are not normally in the habit of making assumptions about the origin of goods solely based on their colour or the colour of their packaging. Therefore, perception of the relevant public is not necessarily the same in the case of a colour mark as it is in the case of a word or figurative mark. (27)

43. Secondly, the Court has previously ruled that there is a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type. (28) In assessing the potential distinctiveness of a colour mark, it is therefore also necessary to ensure that registration of the colour mark would not be contrary to that public interest. (29)

44. As is apparent from the foregoing, as a result of a mark's specific characteristics it can therefore be more difficult in practice to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories. (30) However, I should point out that the Court has also stressed that that fact cannot exempt the trade mark authorities from having to carry out an examination, on a case-by-case basis, of whether the trade mark applied for has distinctive character. (31)

45. In the light of the foregoing, I propose that the Court's answer to the first question should be that Articles 2 and 3(1)(b) and 3(3) of Directive 2008/95 must be interpreted as meaning that it is relevant for the assessment of the requirement relating to distinctive character whether the mark is to be registered as a figurative mark or a colour mark in the sense that colour marks' specific characteristics require that they

be taken into account in assessing whether a colour mark has distinctive character. In that connection, it must be borne in mind both that a colour mark seldom has distinctive character initially and that there is a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type.

2. How a trade mark is to be registered where there is a discrepancy between the graphic representation of the trade mark and the choice of the trade mark category which was made in the trade mark application (Question 2)

46. I understand the second question as the referring court essentially asking how a trade mark is to be registered where there is a discrepancy between the graphic representation of the trade mark, which shows a figure, and the choice of trade mark category which was made in the application and which characterises the trade mark as a colour mark.

47. In what follows, I will explain why in the event of such a discrepancy a mark cannot, in my view, be registered either as a colour mark or a figurative mark under EU law. In that connection, I will first explain why it is essential for registering a trade mark that the trade mark's precise subject matter can be established (a), and then explain the consequences of discrepancies in an application as in the present case (b).

**(a) The need to establish the subject matter of a trade mark**

48. If it is appropriate to establish the precise subject matter of the trade mark applied for, it is because under Article 2 of Directive 2008/95 it is a fundamental requirement for the registrability of a trade mark that it consist of a sign which is capable of being represented graphically. The purpose of the requirement laid down in Article 2 that any sign must be capable of being represented graphically is to establish the exact subject matter of the trade mark for which the applicant seeks protection. According to the judgment in Sieckmann, in order to fulfil its function, the graphic representation of the trade mark must essentially be clear, precise, self-contained, easily accessible, intelligible, durable and objective. (32)

49. In that judgment, the Court explained that such an interpretation is required to allow for the sound operation of the trade mark registration system. (33) On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of registration applications and to the publication and maintenance of an appropriate and precise register of trade marks. On the other hand, economic operators must, with clarity and precision, be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties. (34)

50. It is therefore on the basis of the establishment of the precise subject matter of a trade mark that all other conditions for the mark's possible registration must be

assessed, including whether the mark has distinctive character.

51. Whilst it is a fundamental requirement for all trade marks that they are capable of being represented graphically, (35) I note that the precise subject matter of certain types of trade mark cannot be established in practice solely on the basis of a graphic reproduction of the trade mark applied for. Although a graphic reproduction of a figurative mark in colours certainly shows precisely the element for which protection is sought, this is not so in the case of colour marks.

52. In the *Libertel* judgment, which concerned the possibility of registering a colour mark consisting of a single colour, the Court ruled that a mere sample of a colour does not per se satisfy the requirement for graphic representation laid down in Article 2, particularly since a sample of a colour may deteriorate with time (it can fade, for example). Therefore, a sample of a colour is not capable of establishing the precise subject matter of a colour mark. However, the requirement laid down in Article 2 can be satisfied if the sample of a colour is supplemented with a description of the colour mark in words, provided that that description is clear and precise, or an internationally recognised identification code as such codes may be considered to be precise. (36)

53. As regards colour marks which consist of combinations of colours, the Court further ruled in its judgment in *Heidelberger Bauchemie* that a combination of colours in respect of which registration is sought must — in order to satisfy the requirement relating to clarity laid down in Article 2 — also be systematically arranged by associating the colours concerned in a predetermined and uniform way. (37) The purpose of the systematic arrangement is precisely to establish the particular combination in which the colours are included. (38)

54. I would add in this regard that, before an authority can determine whether the subject matter of a colour mark applied for can be established with the requisite clarity, as follows from the judgments in *Libertel* (39) and *Heidelberger Bauchemie*, (40) it must naturally be a requirement that the authority can establish that the mark concerned is a colour mark.

55. In the present case there appears to be a discrepancy in Oy Hartwall's application in this regard, as the referring court's second question also indicates. Whilst the graphic representation of the trade mark applied for shows a mark with contours in the form of a figure (a blue band with a thin grey line around the edges), Oy Hartwall indicated in the accompanying description (with reference to international codes for the colours used) and categorisation that the mark concerned is a colour mark.

56. As regards the graphic representation of the colour mark applied for, I note that in principle it may be possible to represent colour marks graphically with contours. That is so where the graphic representation illustrates how the colour mark is to be applied to the goods or services of the undertaking concerned. By

way of example, I refer to the abovementioned judgment in *Louboutin and Christian Louboutin*. (41) The graphic representation of the colour mark in that case, which is reproduced at paragraph 8 of the judgment, showed an image of a high-heeled shoe to whose sole the colour red at issue was applied. The description of the colour mark clarified that the contour of the shoe was not part of the trade mark and was merely intended to show the positioning of the mark. Although the graphic representation of the mark contains contours (the shape of the shoe, including the shape of the sole), these contours were not part of the mark, which the Court also confirmed in that case, as stated at point 32 of this Opinion.

57. If the trade mark applied for in the present case were presented graphically in a similar manner, the graphic representation would have to show how the colour mark for which registration was sought was applied to Oy Hartwall's products, which in this case consist of bottles of water. However, the graphic representation of the trade mark does not show a bottle of water, but a band, as the Commission and the Finnish Government also point out. In the light of the foregoing, I conclude that there is a discrepancy in Oy Hartwall's trade mark application since the contours used are not even capable of showing how the colour mark is to be used on the products indicated.

#### **(b) The consequences of discrepancies in the trade mark application**

58. In my view, and as also argued by the Commission and the Finnish Government, Article 2 of Directive 2008/95 precludes a colour mark from being registered in the event of a discrepancy such as that in the present case.

59. It is not possible to establish, on the basis of the trade mark application, whether the precise subject matter of the application is a colour mark or a figurative mark. It is therefore uncertain in relation to which subject matter the other substantive conditions laid down in the directive, including the requirement relating to distinctive character, are to be assessed. Furthermore, the authorities use the different categories of trade mark to navigate the trade mark register. This is also true of the Finnish register, where I can see that searches can be made in various trade mark categories, including the categories 'figurative marks' and 'colour marks'.

60. In that connection, it would create confusion for the public and competing undertakings if the trade mark were registered as a colour mark but in its graphic representation appeared as a figurative mark. It would thus be unclear what element — the colour mark or the figurative mark — was protected by the registration. Consequently, I concur with the Commission and the Finnish Government that the objective of the requirement relating to graphic representation laid down in Article 2, as specified in the *Sieckmann* judgment, (42) that is to say that the subject matter of the trade mark can be established clearly and precisely, thus cannot be attained in the case of an application such as that in the present case.

61. Such an interpretation of Article 2 is also supported by the Court's judgment in the Shield Mark case. (43) That case concerned, inter alia, the conditions on which a sound sign (44) is capable of being represented graphically within the meaning of Article 2 of the directive. In that case the Court ruled inter alia that a sign, whose graphic representation is composed of musical notes or written language, cannot be registered as a sound mark where the applicant has failed to state in the application for registration that the sign in question must be understood as being a sound sign. As the Court held, in such a case where a trade mark is registered, the competent registration authority and the public are entitled to consider that it is a word mark or a figurative mark as represented graphically in the application for registration. (45)

62. For the reasons I set out above in point 59 of this Opinion, I consider that the same considerations apply to a trade mark application where the graphic representation shows a figure, but the trade mark is stated as being a colour mark in the accompanying categorisation and description. Although the Shield Mark case concerns a lack of clarity in the application and not an actual discrepancy, the outcome in the Shield Mark case must apply all the more in the case of a discrepancy. (46)

63. Where the national authorities are to establish the precise subject matter of a trade mark applied for, and the applicant seeks protection for a colour mark, it is therefore essential that the trade mark application is in compliance, that is to say that the trade mark — in its graphic representation, including the trade mark categorisation and accompanying description — is to be registered as a colour mark. Only in this way is it possible for the authorities and the public to know, first, that the applicant is seeking protection for a colour mark and not a figurative mark and, second, to establish the precise subject matter of the colour mark.

64. I therefore propose that the Court's answer to the second question should be that Article 2 of Directive 2008/95 must be interpreted as precluding a trade mark from being registered where, on account of discrepancies in the application, it is not possible to establish the precise subject matter in respect of which the applicant seeks protection. This is so, for example, in the case of a trade mark application for registration of a colour mark, whose graphic representation, however, shows a figurative mark.

### **3. Practice of the Patentti- ja rekisterihallitus (Question 3)**

65. I understand the third question as the referring court essentially asking — if the answer to the second question is in the affirmative and it is thus possible in principle to register the trade mark at issue as a colour mark — whether the Court's case-law on distinctive character in respect of colour marks applies to such a trade mark and, if so, whether the practice of the Patentti- ja rekisterihallitus is then consistent with that case-law.

66. Given that I have proposed that the Court should answer the second question in the negative, there is no

need to answer the third question. However, should the Court answer the second question in the affirmative, I will set out the following alternative considerations.

67. The question relates to the assessment by the Patentti- ja rekisterihallitus as to whether the trade mark applied for had acquired distinctive character through use. In that connection, the order for reference shows that the grounds for the Patentti- ja rekisterihallitus' refusal of the application stated inter alia that 'according to the normal practice of the [Office], registration of a sole and exclusive right to certain colours cannot be permitted unless there is solid evidence to show that the colours applied for have acquired distinctive character through lasting and extensive use in relation to the goods in respect of which registration is sought'. (47)

68. To answer that question, it is first necessary to determine whether the Court's case-law on distinctive character in respect of colour marks (the judgments in *Libertel* (48) and *Heidelberger Bauchemie* (49)) applies to such a mark.

69. Since the question is based on the assumption that the trade mark concerned is a colour mark, and the subject matter of that mark is therefore assumed to be a colour or a combination of colours with no contours, the question must, as indicated by the Finnish Government and the Commission, be answered in the affirmative.

70. Specifically, this means that, in assessing whether a colour mark has distinctive character, account must be taken of the colour mark's specific characteristics. As stated at paragraphs 42 to 43 of this Opinion, this implies, first, that account must be taken of the fact that a colour mark seldom has inherent distinctive character and, second, that account is taken of the public interest in not unduly restricting the availability of colours for the other operators. (50)

71. Secondly, it is necessary to consider whether the practice of the Patentti- ja rekisterihallitus is consistent with the Court's case-law on colour marks.

72. It is for the referring court to make that determination, having regard to the elements of the Court's case-law which I set out above at points 38 and 44 of this Opinion, and all the relevant factual information on the practice of the Patentti- ja rekisterihallitus. (51)

73. As regards the distinctive character acquired through use, it must be stressed that the competent authority must carry out an examination by reference to the actual situation and make an overall assessment of all the evidence that the mark has come to identify the goods or services concerned as originating from a particular undertaking. (52) In that connection, it follows from the Court's judgment in *Oberbank* that it is contrary to Directive 2008/95 for the assessment of a colour mark's distinctive character acquired through use to be based solely on the results of a consumer survey. In that case, the Court held that even though a consumer survey may be one of the factors in the



assessment, the results of a consumer survey cannot be the sole decisive criterion. (53)

74. I therefore propose, in the alternative, that the Court's answer to the question referred should be that, if a trade mark is to be registered as a colour mark, in assessing whether the trade mark applied for has distinctive character, account must be taken of the colour mark's specific characteristics. In this regard, it should be borne in mind, first, that colour marks seldom have distinctive character initially and, second, that there is a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type. If the competent authorities consider that the colour mark applied for has inherent distinctive character, there is no need to demonstrate the use made of the mark. If, on the other hand, the colour mark does not have inherent distinctive character, it is necessary to assess whether the mark has acquired distinctive character through use. In making that assessment, an examination by reference to the actual situation must be carried out and an overall assessment must be made of the evidence that the mark has come to identify the goods or services concerned as originating from a particular undertaking. This evidence must relate inter alia to the use which has been made of the mark and the following items may be taken into consideration in that assessment: the market share held by the mark in question; how intensive, geographically widespread and long-standing use of that mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identifies goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

## V. Conclusion

75. In the light of the foregoing, I propose that the Court should give the following answers to the questions referred by the Korkein hallinto-oikeus (Supreme Administrative Court, Finland):

(1) For the interpretation of Article 2 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks and the condition relating to the distinctive character of a trade mark within the meaning of Article 3(1)(b) and 3(3) thereof, it is of relevance whether the mark is to be registered as a figurative mark or a colour mark in the sense that the specific characteristics of colour marks require that they be taken into account in assessing whether a colour mark has distinctive character. In that connection, it must be borne in mind both that a colour mark seldom has distinctive character initially and that there is a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type.

(2) Article 2 of Directive 2008/95 must be interpreted as precluding registration of a trade mark where, on account of discrepancies in the application, it is not

possible to establish the precise subject matter in respect of which the applicant seeks protection. This is so, for example, in the case of a trade mark application for registration of a colour mark, whose graphic representation, however, shows a figurative mark.

1 Original language: Danish.

2 Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25) ('Directive 2008/95').

3 Directive 2008/95 repealed and replaced First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1). Articles 2 and 3 of Directive 2008/95, which are to be interpreted in this case, are a reproduction in identical terms of Articles 2 and 3 of Directive 89/104. The case-law concerning Directive 89/104 is therefore also relevant in this case. Directive 2008/95 was replaced by the new trade mark directive, Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1), the deadline for transposition of which is 14 January 2019.

4 In its wording of the question the national court referred only to the requirement relating to distinctive character laid down in Articles 2 and 3(1)(b) of the directive, that is to say 'inherent' distinctive character. Given that distinctive character acquired through use (Article 3(3) of the directive) is also a focal point of the national dispute underlying the question referred, as Oy Hartwall claims that the trade mark applied for has both inherent distinctive character and distinctive character acquired through use, I have also included Article 3(3) in my answer.

5 See points 10 and 12 of this Opinion.

6 Similarly, the order for reference merely states that the referring court is to decide whether the trade mark applied for 'in the form of a colour drawing may be registered as a colour mark'.

7 That conclusion could be reached since, although the trade mark is to be registered as a colour mark, according to the order for reference Oy Hartwall Ab states both that the company did not seek protection 'simply for blue or grey colours in all conceivable forms', and that the 'trade mark is to be protected when it is clear from the graphic representation in the trade mark application that its constituent colours are not an endless variation in every conceivable shade'.

8 The fact that the signs listed in Article 2 are merely examples, and thus do not constitute an exhaustive list, is also supported by recital 8 of the directive. According to that recital, '[a]ttainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark be, in general, identical in all Member States. To this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of

other undertakings'. Article 2 of the directive contains a list of the examples referred to in recital 8.

9 I note that colour is referred to explicitly as an example of a trade mark in Article 3 of new Trade Mark Directive 2015/2436.

10 Judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244).

11 Judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384).

12 In those cases the Court held that a colour mark must accordingly satisfy three conditions. Firstly, it must constitute a sign. In that connection, the Court ruled that in the particular field of trade colours are generally used for their attractive or decorative powers, and do not convey any meaning, but that it is possible that colours or combinations of colours may be capable, when used in relation to a product or a service, of being a sign; see judgments of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 27), and of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384, paragraph 23). Secondly, the sign must be capable of being represented graphically and, thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings; see judgments of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 23), and of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384, paragraph 22). As regards the application of the latter two conditions to colour marks, I refer to my answer below to the questions referred for a preliminary ruling, which also concerns them.

13 See, for example, paragraphs 14 and 21 of judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244), which refer to a colour mark as a colour per se, not spatially defined, and paragraph 15 of judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), which refers to colours or colour combinations designated in the abstract and without contours. The same definition is also used for the registration of EU trade marks; see Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431 (OJ 2018 L 104, p. 37). The regulation applies to the registration of EU trade marks from 14 May 2018 (see Article 39(2) thereof) and Article 3(3)(f) of the regulation describes a colour mark as a trade mark which consists exclusively of a single colour without contours or of a colour combination without contours.

14 Judgment of 12 June 2018, *Louboutin and Christian Louboutin* (C-163/16, EU:C:2018:423).

15 Judgment of 12 June 2018, *Louboutin and Christian Louboutin* (C-163/16, EU:C:2018:423, paragraphs 7 to 10).

16 Judgment of 12 June 2018, *Louboutin and Christian Louboutin* (C-163/16, EU:C:2018:423, paragraph 24).

17 Judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 54).

18 See, to that effect, the definition of figurative marks set out in Article 3(3)(b) of Commission Implementing Regulation 2018/626, under which a figurative mark is a mark where non-standard characters, stylisation or layout, or a graphic feature or a colour are used, including marks that consist exclusively of figurative elements or of a combination of verbal and figurative elements.

19 See judgment of 19 June 2014, *Oberbank* (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 38 and the case-law cited).

20 See judgment of 26 April 2007, *Alcon v OHIM* (C-412/05 P, EU:C:2007:252, paragraph 53 and the case-law cited).

21 See judgment of 19 June 2014, *Oberbank* (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 39 and the case-law cited).

22 See judgment of 19 June 2014, *Oberbank* (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 40 and the case-law cited).

23 See judgment of 19 June 2014, *Oberbank* (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 41 and the case-law cited).

24 See, to that effect, judgment of 19 June 2014, *Oberbank* (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 46 and the case-law cited).

25 See judgment of 19 June 2014, *Oberbank* (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 47 and the case-law cited).

26 See judgments of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 66), and of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384, paragraph 39).

27 See judgments of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 65), and of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384, paragraph 38).

28 See judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraphs 54 to 59).

29 See judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 60).

30 See judgments of 12 July 2012, *Smart Technologies v OHIM* (C-311/11 P, EU:C:2012:460, paragraph 26 and the case-law cited), and of 9 September 2010, *OHIM v BORCO-Marken-Import Matthiesen* (C-265/09 P, EU:C:2010:508, paragraph 33 and the case-law cited).

31 See judgment of 9 September 2010, *OHIM v BORCO-Marken-Import Matthiesen* (C-265/09 P, EU:C:2010:508, paragraph 37).

32 See judgments of 12 December 2002, *Sieckmann* (C-273/00, EU:C:2002:748, paragraphs 48 to 55), and of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 29).

33 See judgment of 12 December 2002, *Sieckmann* (C-273/00, EU:C:2002:748, paragraph 47).

34 See judgment of 12 December 2002, Sieckmann (C-273/00, EU:C:2002:748, paragraphs 50 to 51). See also judgment of 24 June 2004, Heidelberger Bauchemie (C-49/02, EU:C:2004:384, paragraphs 26 to 30).

35 I would point out that the requirement relating to graphic representation is omitted from new Trade Mark Directive 2015/2436. Article 3(b) of the directive, which concerns which signs can constitute a trade mark and corresponds to Article 2 of the directive now in force, provides instead that the sign applied for must be capable of being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. The background to this change is referred to in recital 13 of the directive. According to that recital, in order to fulfil the objectives of the registration system for trade marks, namely to ensure legal certainty and sound administration, it is essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. It further states that a sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.

36 See judgment of 6 May 2003, Libertel (C-104/01, EU:C:2003:244, paragraphs 31 to 37).

37 See judgment of 24 June 2004, Heidelberger Bauchemie (C-49/02, EU:C:2004:384, paragraph 33).

38 See judgment of 24 June 2004, Heidelberger Bauchemie (C-49/02, EU:C:2004:384, paragraph 34).

39 Judgment of 6 May 2003, Libertel (C-104/01, EU:C:2003:244).

40 Judgment of 24 June 2004, Heidelberger Bauchemie (C-49/02, EU:C:2004:384).

41 Judgment of 12 June 2018, Louboutin and Christian Louboutin (C-163/16, EU:C:2018:423).

42 Judgment of 12 December 2002, Sieckmann (C-273/00, EU:C:2002:748, paragraphs 48 to 51).

43 Judgment of 27 November 2003, Shield Mark (C-283/01, EU:C:2003:641).

44 A sound mark is a trade mark consisting exclusively of a sound or combination of sounds (see, for example, the definition set out in Article 3(3)(g) of Commission Implementing Regulation 2018/626).

45 See judgment of 27 November 2003, Shield Mark (C-283/01, EU:C:2003:641, paragraph 58).

46 In this regard, I also refer to the judgment of the General Court of 14 June 2012, Seven Towns v OHIM (Representation of seven squares of different colours) (T-293/10, EU:T:2012:302). In that case, the General Court rejected the claim that an EU trade mark could be registered as a colour mark on the ground that the colour mark was not represented graphically as a colour mark but as a figurative mark or a three-dimensional mark. The General Court found that in that case there was an inherent discrepancy as regards the subject

matter of the trade mark which rendered it unregistrable (see paragraph 66 of the judgment).

47 See point 13 of this Opinion in this regard.

48 Judgment of 6 May 2003, Libertel (C-104/01, EU:C:2003:244).

49 Judgment of 24 June 2004, Heidelberger Bauchemie (C-49/02, EU:C:2004:384).

50 See judgment of 6 May 2003, Libertel (C-104/01, EU:C:2003:244, paragraphs 60, 65 and 66).

51 I note that the Court itself does not have this information.

52 See judgment of 19 June 2014, Oberbank (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 40 and the case-law cited).

53 Judgment of 19 June 2014, Oberbank (C-217/13 and C-218/13, EU:C:2014:2012, paragraph 48).