



The Colour, Shape and Smell of Things to Come

Gillian Akerman, a senior solicitor specialising in intellectual property at Wedlake Bell examines recent developments in trade mark law.

A number of recent court rulings have examined some of the more unusual aspects of trade mark applications, clarifying issues which have to date been rather murky.

Registration of colours

A recent landmark decision of the European Court of Justice clarified the issue of whether colours are capable of trade mark registration. On 6 May 2003 the ECJ in *Libertel Groep BV –v- Benelux-Merkenbureau* ruled that colours can in certain circumstances achieve registration. This case involved an application by Dutch telecommunications group Libertel which wanted to register the colour orange as a trade mark.

The Law

The ECJ considered the application of Articles 2 and 3 of Council Directive EEC 89/104 to approximate the laws of member states relating to trade marks. Article 2 provides that

" a trade mark may consist of any sign which is capable of being represented graphically...provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings".

Further, Article 3(1) of the Directive provides that

" a trade mark shall not be refused registration if before the date of application for registration and following the use which has been made of it, it has acquired distinctive character "

The Issues

The questions referred to the ECJ related to whether, and if so, in what circumstances, a colour per se, not spatially defined, was capable of possessing distinctive character for certain goods or services.

The Judgment

In considering the question of whether a colour was capable of graphic representation, the ECJ held that it is not sufficient to merely reproduce on paper the colour in question. The problem identified with that approach was that a sample of a colour may deteriorate with time. On the other hand a verbal description, in so far as it is composed of words which are

themselves made up of letters, does not constitute a graphic representation of the colour. However it was held that the designation of colour using an internationally recognised identification code may be considered to constitute a graphic representation which is sufficiently precise and durable.

The Court went on to consider whether a colour per se is capable of distinguishing the goods or services of one undertaking from those of other undertakings within the meaning of Article 2 of the Directive. In doing so it looked at whether colours per se are capable of conveying specific information, in particular as to the origin of a product or service. The Court emphasised that although colours possess little inherent capacity for communicating specific information due to their widespread use to advertise and market goods without any specific message, they could, in principle, serve as a badge of origin of the goods or services of an undertaking. It followed that a colour per se was capable of constituting a trade mark within the meaning of Article 2 of the Directive.

The Court further commented that in assessing the distinctiveness of a colour as a trade mark, regard had to be had to the general interest in not unduly restricting the availability of colours for other traders who offered for sale goods or services of the same type as those in respect of which registration was sought. It stated that the greater the number of goods or services for which the trade mark is sought to be registered, the more excessive the exclusive right which it may confer is likely to be, and, for that very reason, the more likely is that right to come into conflict with the maintenance of a system of undistorted competition, and with the public interest in not restricting colours available for other traders.

Finally the Court ruled that in assessing whether a trade mark has distinctive character within the meaning of Article 3 of the Directive, the competent authority must 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 mark.

Registration of Smells

Conversely smells have not had it so good. The ECJ in the *Libertel* case made a number of references to the judgment given on 12 December 2002 in the case of *Ralf Sieckmann –v- Deutsches Patent und Markenamt*. In this case Mr Sieckmann applied to register a smell in Germany which he described as a "*balsamically fruity scent with a slight hint of cinnamon*". His application was accompanied by an odour sample and the chemical formula of the smell. The German Trade Marks Office rejected his application but Mr Sieckmann appealed to the German Federal Patent Office arguing that in theory smells could be an independent means of identifying a company. The Federal Patent Office referred the case to the ECJ since German trade mark law is based on the European Directive.

The Issue

The main issue of interest considered by the ECJ was whether a smell was capable of being represented graphically in accordance with Article 2 of the Directive.

The Judgment

The Court emphasised that the graphic representation must enable the sign to be represented visually by means of characters, images or lines in order for it to be identified precisely. For this reason the odour sample was not sufficient. The Court commented that few people would recognise the smell from a formula and noted that different factors could influence the manner in which a smell could be perceived, such as concentration, quantity, temperature or the substance bearing the odour. Further, it commented that a chemical formula does not represent the smell of a substance, but the substance as such. The conclusion of the Court was therefore that Mr Sieckmann had not provided a representation which satisfied Article 2 and the refusal of the German Federal Patent Office was upheld.

Registration of Shapes

Shapes have fared rather better recently but the decision in *Procter & Gamble Company – v- Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")* also given on 12 December 2002 highlights the difficulty in registering shapes. Procter & Gamble sought to register the shape of a bar of soap.

The Judgment

The European Court of First Instance upheld OHIM's refusal to register the shape on the ground that the sign consisted exclusively of a shape which resulted from the nature of the goods for which the registration was sought.

It was not sufficient for there to be only a minor variation from the typical shape of soaps and the Court commented that the public would primarily perceive the soap's shape as having a purely utilitarian function which was intended to enable the soap to be gripped easily. Under Article 3 of the European Directive on trade marks this is a fundamental barrier to registration.

Conclusion

These cases demonstrate the difficulties to be overcome in making applications of this type. It seems likely that as a result of the *Sieckmann* decision, smells are incapable of being registered as trade marks in Europe. Colours need to be sufficiently precisely identified but companies are cautioned not to seek to attempt to monopolise a colour for a wide range of goods or services, and careful thought must be given to the nature of the unique features which a mark relating to a shape seeks to protect. It will be interesting to see how this body of case law develops and in particular to see how the courts address issues of infringement.

This publication is produced for general information only. Specific advice should always be sought for individual cases.

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