



Reports of Cases

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

* Language of the case: Finnish.

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 Patentti- ja 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]