



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Second Chamber)

30 November 2017*

(EU trade mark — Invalidity proceedings — EU trade mark consisting of a combination of the colours blue and silver — Absolute ground for refusal — Graphic representation that is sufficiently clear and precise — Need for a systematic arrangement associating the colours in a predetermined and uniform way — Legitimate expectations — Article 4 and Article 7(1)(a) of Regulation (EC) No 207/2009 (now Article 4 and Article 7(1)(a) of Regulation (EU) 2017/1001)

In Joined Cases T-101/15 and T-102/15,

Red Bull GmbH, established in Fuschl am See (Austria), represented by A. Renck, lawyer,

applicant,

supported by

Marques, established in Leicester (United Kingdom), represented initially by R. Mallinson and F. Delord, and subsequently by R. Mallinson, Solicitors,

intervener,

v

European Union Intellectual Property Office (EUIPO), represented by A. Folliard-Monguiral, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

Optimum Mark sp. z o.o., established in Warsaw (Poland), represented by R. Skubisz, M. Mazurek, J. Dudzik and E. Jaroszyńska-Kozłowska, lawyers,

TWO ACTIONS brought against two decisions of the First Board of Appeal of EUIPO of 2 December 2014 (Case R 2037/2013-1 and Case R 2036/2013-1, respectively), relating to invalidity proceedings between Optimum Mark and Red Bull,

THE GENERAL COURT (Second Chamber),

composed of M. Prek, President, E. Buttigieg and B. Berke (Rapporteur), Judges,

Registrar: J. Weychert, Administrator,

* Language of the case: English.

having regard to the applications lodged at the Court Registry on 26 February 2015,
having regard to the responses of EUIPO lodged at the Court Registry on 11 June 2015,
having regard to the responses of the intervener lodged at the Court Registry on 5 June 2015,
having regard to the replies lodged at the Court Registry on 1 September 2015 in Case T-101/15,
having regard to the intervener's rejoinders lodged at the Court Registry on 19 November 2015,
having regard to the order of 18 November 2015 granting Marques leave to intervene in support of the form of order sought by the applicant,
having regard to the statements in intervention of Marques lodged at the Court Registry on 6 January and 22 March 2016,
having regard to the observations of the applicant lodged at the Court Registry on 22 March 2016,
having regard to the observations of EUIPO lodged at the Court Registry on 21 March 2016,
having regard to the observations of the intervener lodged at the Court Registry on 22 March 2016,
having regard to the decision of 9 December 2016 joining Cases T-101/15 and T-102/15 for the purposes of the oral part of the procedure and of the judgment,
having regard to the change in the composition of the Chambers of the General Court,
further to the hearing on 10 March 2017,
gives the following

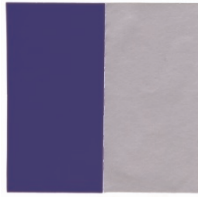
Judgment

Background to the dispute

In Case T-101/15

- 1 On 15 January 2002, the applicant, Red Bull GmbH, filed an application for registration of an EU trade mark at the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), as amended, itself replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).

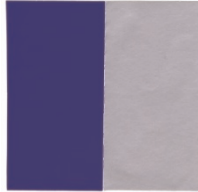
- 2 Registration as a mark was sought for the combination of two colours per se reproduced below ('the first contested mark'):



- 3 By a communication dated 30 June 2003, the applicant submitted additional documents to prove the distinctive character acquired through use of the first contested mark. On 11 October 2004, the applicant submitted a description of the first contested mark that was worded as follows: 'Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%'.
- 4 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: 'Energy drinks'.
- 5 The EU trade mark application was published in *Community Trade Marks Bulletin* No 10/2005 of 7 March 2005. The first contested mark was registered on 25 July 2005 under number 002534774, with an indication that it had acquired distinctive character through use and the description referred to in paragraph 3 above.
- 6 On 20 September 2013, Optimum Mark sp. z o.o. ('the intervener') filed an application for a declaration of invalidity of the first contested mark on the basis of Article 52(1)(a) of Regulation No 207/2009 (now Article 59(1)(a) of Regulation 2017/1001), in conjunction with Article 7(1)(a), (b) and (d) of that regulation (now Article 7(1)(a), (b) and (d) of Regulation 2017/1001), and of Article 52(1)(b) of that regulation (now Article 59(1)(b) of Regulation 2017/1001), in respect of all the goods referred to in paragraph 4 above.
- 7 The application for a declaration of invalidity was based on the following grounds:
- the first contested mark does not meet the requirements of Article 7(1)(a) of Regulation No 207/2009 since its graphic representation does not satisfy the conditions laid down in case-law, according to which a graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective and must be systematically arranged by associating the colours in a predetermined and uniform way;
 - the wording of the description accompanying the application for registration of the first contested mark allows for numerous different combinations of ratios of 'approximately' 50% to 50% of the two colours and therefore numerous arrangements with the result that consumers would not be able to repeat with certainty a purchase experience.

In Case T-102/15

- 8 On 1 October 2010, the applicant filed a second application for registration of an EU trade mark with EUIPO pursuant to Regulation No 207/2009. Registration as a mark was sought for the combination of two colours per se reproduced below ('the second contested mark'):



- 9 The goods in respect of which registration was sought are in Class 32 of the Nice Agreement and correspond to the following description: 'Energy drinks'.
- 10 The EU trade mark application was published in *Community Trade Marks Bulletin* No 48/2011 of 29 November 2010.
- 11 On 22 December 2010, the examiner issued a notice of absence of formal requirements pursuant to Rule 9(3) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), stating that, in the field for describing the trade mark, the proportions in which each colour would be applied had not been indicated and the way in which those colours would appear had not been specified. The examiner requested that the applicant specify 'in which proportion the two colours will be applied (for example, in equal proportion) and how they will appear'.
- 12 On 10 February 2011, the applicant stated to the examiner that 'in compliance with [the examiner's] notification dated 22 December 2010, [the applicant] herewith inform[s] [EUIPO] that the two colours will be applied in equal proportion and juxtaposed to each other'.
- 13 On 8 March 2011, the second contested mark was registered on the basis of distinctive character acquired through use, with the indication of the colours 'blue (Pantone 2747C), silver (Pantone 877C)' and the following description: 'The two colours will be applied in equal proportion and juxtaposed to each other'.
- 14 On 27 September 2011, the intervener filed an application for a declaration of invalidity of the second contested mark on the basis of Article 52(1)(a) of Regulation No 207/2009, in conjunction with Article 7(1)(a), (b) and (d) of that regulation, and of Article 52(1)(b) of the regulation, in respect of all the goods covered by the mark.
- 15 The application for a declaration of invalidity was based on the following grounds:
- the second contested mark does not meet the requirements of Article 7(1)(a) of Regulation No 207/2009 since its graphic representation does not satisfy the conditions laid down in case-law, according to which a graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective and must be systematically arranged by associating the colours in a predetermined and uniform way;
 - since the term 'juxtaposed' could be understood as 'having a border in common' or 'placed side by side' or 'dealt with close together for contrasting effect', the description of the second contested mark does not indicate the type of arrangement in which the two colours would be applied to the goods and is therefore not self-contained, clear and precise.

In Cases T-101/15 and T-102/15

- 16 By two decisions of 9 October 2013, the Cancellation Division declared the first contested mark and the second contested mark (together ‘the contested marks’) invalid, finding that the graphic representation of those marks constituted the ‘mere juxtaposition of two or more colours, designated in the abstract and without contours’, in accordance with the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384, paragraph 34), and did not exhibit the qualities of precision and uniformity required by Article 4 of Regulation No 207/2009 (now Article 4 of Regulation 2017/1001), since it allowed numerous different combinations which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase. In addition, it would not allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the contested marks. Thus, the graphic representation of the contested marks, accompanied by the description (in the two variations set out in paragraphs 3 and 13 above), did not make it possible to determine the specific arrangement of colours in a way which defined one particular combination of colours presented in equal proportions, and therefore the subject of the protection afforded by the contested marks, and, consequently, did not comply with Article 4 of Regulation No 207/2009. Although a description of that kind does not need to describe how the trade mark will be used or applied on the various products, it seeks to define the precise subject of the protection afforded to the registration of a mark in accordance with that provision. Moreover, the Cancellation Division stated that, although Rule 3(3) of Regulation No 2868/95 does not require a description of a graphic representation to be submitted, it nevertheless does not exclude the possibility of registration of a trade mark being refused or of a trade mark being declared invalid where a description is necessary to ensure that the registration of a mark complies with Article 4 of Regulation No 207/2009. Last, the Cancellation Division noted that EUIPO was not bound by its earlier decisions but only by the principle of legality, and stated in conclusion that, since the application for a declaration of invalidity had been entirely successful under Article 7(1)(a) of Regulation No 207/2009, it would not proceed to examine the other grounds for invalidity claimed by the interveners.
- 17 On 17 October 2013, the applicant filed two notices of appeal against the two decisions of the Cancellation Division and submitted its statements of grounds of appeal on 10 February 2014.
- 18 By two decisions of 2 December 2014 (‘the contested decisions’) the First Board of Appeal of EUIPO dismissed both appeals as unfounded since the contested marks had been registered contrary to Article 7(1)(a) of Regulation No 207/2009 in conjunction with Article 4 of that regulation. The Board of Appeal based both decisions on the same reasoning.
- 19 The Board of Appeal held that the applicant could not properly rely on the principle of protection of legitimate expectations, which the applicant claimed had been infringed by the Cancellation Division, since the fact that the examiner had requested the inclusion of a description of the trade mark and had accepted, or even suggested, the wording thereof, did not amount to precise, unconditional and consistent information on which the applicant could have based its legitimate expectation. Furthermore, when the contested marks were registered, there was no established practice within EUIPO with regard to the registration of EU trade marks of a colour per se (‘colour per se marks’) and, in any event, any such practice, no matter how current, did not amount to precise, unconditional and consistent information and was irrelevant for the purpose of assessing whether or not the graphic representation of a trade mark met the requirement of Article 4 of Regulation No 207/2009.
- 20 Moreover, the Board of Appeal took the view that the Cancellation Division was right to find that the contested marks had been registered contrary to Article 4 in conjunction with Article 7(1)(a) of Regulation No 207/2009.

- 21 First, the Board of Appeal noted that the fact that a sign has acquired distinctive character through use does not enable the requirements laid down in Article 4 of Regulation No 207/2009 to be overridden. According to the Board of Appeal, the purpose of that provision is to determine the precise subject of the protection afforded by an EU trade mark to its proprietor in order to prevent the abuse of EU trade mark law for the purpose of obtaining an unfair competitive advantage, and to enable the competent authorities to know with clarity and precision the nature of the signs registered and economic operators to have precise information regarding the rights of third parties by accessing the public register held by those authorities.
- 22 Second, the Board of Appeal recognised the registrability of colour per se marks and recalled the case-law in accordance with which a description may be necessary in order to fulfil the requirements of Article 4 of Regulation No 207/2009. Where such a description accompanies the graphic representation, it forms an integral part of it.
- 23 Third, with regard to combinations of two or more colours per se, in paragraph 45 of the contested decisions, the Board of Appeal considered that the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) had established a general principle for the interpretation of Article 4 of Regulation No 207/2009, according to which, in order to be precise and durable as required by the case-law, combinations of colours must be systematically arranged by associating the colours concerned in a predetermined and uniform way. The aim of that general principle is to ensure that a graphic representation which allows for numerous different combinations does not prevent the average consumer from repeating with certainty the experience of a purchase. Accordingly, in paragraph 48 of the contested decisions, it held that the graphic representation of the contested marks, on the one hand, and the accompanying description (in the two variations set out in paragraphs 3 and 13 above), on the other, which must be evaluated in conjunction with each other, indicating a mere juxtaposition of two colours, identified by codes, and the ratios in which those colours are presented, allowed for the arrangement of those two colours in numerous different combinations, producing a very different overall impression. The contested marks were not, therefore, sufficiently precise and uniform.
- 24 Fourth, in the contested decision in Case T-101/15, the Board of Appeal held that it was not necessary to decide whether the approximate indication of the ratio of the colours — by virtue of the word ‘approximately’ — was sufficient under Article 4 of Regulation No 207/2009, since the description was imprecise even without that word.
- 25 Fifth, in so far as the applicant had claimed that the graphic representation of the trade mark applied for was sufficiently precise, since it showed the colour blue on the left and the colour silver on the right, and that those colours were juxtaposed, namely divided into equal proportions by a central vertical line, the Board of Appeal considered, in paragraph 50 of the contested decision in Case T-101/15 and in paragraph 49 of the contested decision in Case T-102/15, that an explicit description to that effect should have accompanied that representation. In the absence of that explicit description, the graphic representation of the contested marks allowed for different arrangements.
- 26 Sixth, the Board of Appeal rejected the applicant’s argument that EUIPO should have allowed it to amend the applications for registration of the mark concerned in order to remedy the deficiencies identified, since Rule 9 of Regulation No 2868/95 cannot serve as a legal basis in that respect.

Forms of order sought

- 27 The applicant, supported by the association Marques (‘the intervening association’), claims that the Court should:
- annul the contested decisions;

- refer the present cases back to EUIPO for examination under Article 7(3) of Regulation No 207/2009 (now Article 7(3) of Regulation 2017/1001);
- order EUIPO and the intervener to pay the costs.

28 EUIPO contends that the Court should:

- dismiss the actions;
- order the applicant to pay the costs.

29 The intervener contends that the Court should:

- dismiss the actions;
- order the applicant to pay the costs, including those incurred by the intervener.

Law

30 In support of its actions, the applicant raises two pleas in law, alleging, first, infringement of Article 4 and Article 7(1)(a) of Regulation No 207/2009 and breach of the principles of proportionality and of equal treatment; and, second, breach of the principle of protection of legitimate expectations.

First plea in law, alleging infringement of Article 4 and Article 7(1)(a) of Regulation No 207/2009 and breach of the principles of proportionality and of equal treatment

31 In the first place, the applicant, supported by the intervening association, submits that the contested marks comply with the requirements laid down in Article 4 of Regulation No 207/2009 and that the Board of Appeal interpreted the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) unduly strictly, resulting in the disproportionate and discriminatory treatment of colour per se marks only, as against other types of trade mark. According to the applicant, that judgment does not apply to the registration of trade marks such as the contested marks. First, it applies only to applications for registration of combinations of colours per se containing a description expressly claiming protection ‘in every conceivable form’, unlike the description of the contested marks. Second, the version in the language of the case (German) of paragraph 34 of that judgment, which used the word ‘Zusammenstellung’, criticised only an ‘arbitrary combination’ of two or more colours and not a ‘juxtaposition’, the term used in the French version, which refers, by contrast, to a ‘combinaison précise’ (precise combination). The graphic representation of the contested marks involves a precise combination of that kind and not an arbitrary combination.

32 In the second place, the Board of Appeal had required a detailed description of the way in which the colours would be used on the products, and therefore of the applicant’s intended use of the contested marks, a question that is relevant for the purposes of Article 7(3) of Regulation No 207/2009 or Article 15 of that regulation (now Article 18 of Regulation 2017/1001), while the question as to whether registration of a sign as an EU trade mark complies with Article 4 of that regulation involves an abstract assessment of the precision of a graphic representation. In addition, such a description, first, is not a legal requirement and, second, would give the sign at issue the quality of a figurative mark.

33 In the third place, as regards that description, to recognise the need for an ‘explicit’ description of the actual use of a colour per se mark would be tantamount to imposing an additional condition for the registration of that type of trade mark, which is not a legal requirement for the registration of EU

trade marks in the light of the applicable legislation or case-law, nor, moreover, is it required for other types of ‘non-traditional marks’, such as three-dimensional marks or sound marks, or for traditional figurative or word marks, and which has never been required in previous decisions of EUIPO or in the case-law. Thus, in the applicant’s submission, the Board of Appeal also breached the principles of proportionality and of equal treatment of different types of trade mark.

34 It is argued that it is sufficient, for the purposes of registering an EU trade mark consisting of a combination of colours per se, in accordance with Article 4 of Regulation No 207/2009, for such a mark to be stated to be a mark of that kind, to be shown graphically, and for the colours to be identified by reference to internationally recognised colour identification codes. The rule that ‘what you see is what you get’ conveys visually the remaining parameters needed in order to identify the trade mark concerned.

35 EUIPO and the intervener dispute those claims.

36 As a preliminary point, it must be noted that the various claims raised in the context of the first plea in law can be regrouped, in essence, into three parts, alleging, respectively (i) infringement of Article 4 and of Article 7(1)(a) of Regulation No 207/2009; (ii) breach of the principle of equal treatment; and (iii) breach of the principle of proportionality.

First part, alleging infringement of Article 4 and of Article 7(1)(a) of Regulation No 207/2009

37 Article 4 of Regulation No 207/2009 provides that an EU 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.

38 In accordance with Article 7(1)(a) of Regulation No 207/2009, signs which do not conform to the requirements of Article 4 of that regulation are not to be registered as EU trade marks.

39 It is apparent from the case-law that, in order to constitute an EU trade mark under Article 4 of Regulation No 207/2009, colours or combinations of colours must satisfy three conditions. First, they must be a sign. Second, that sign must be capable of being represented graphically. Third, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings (see, by analogy, judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 22 and the case-law cited).

40 As the Court of Justice has already held, colours are normally a simple property of things. Even in the particular field of trade, colours and combinations of colours are generally used for their attractive or decorative powers, and do not convey any meaning. However, 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 judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 23 and the case-law cited).

41 For the purposes of the application of Article 4 of Regulation No 207/2009, it is necessary to establish that in the context in which they are used, colours or combinations of colours which it is sought to register in fact represent a sign. The purpose of that requirement is in particular to prevent the abuse of trade mark law in order to obtain an unfair competitive advantage (see, by analogy, judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 24).

- 42 In addition, as regards the requirement that a sign be capable of being represented graphically within the meaning of Article 4 of Regulation No 207/2009, it is apparent from the case-law that that graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified (see, by analogy, judgment of 12 December 2002, *Sieckmann*, C-273/00, EU:C:2002:748, paragraph 46).
- 43 Further, in order to perform its function, the graphic representation within the meaning of Article 4 of Regulation No 207/2009 must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (see, by analogy, judgment of 12 December 2002, *Sieckmann*, C-273/00, EU:C:2002:748, paragraphs 47 to 55).
- 44 Such an interpretation is necessary for the proper working of the EU trade mark registration system. The function of the requirement of graphic representation is in particular to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor. The entry of the mark in a public register has the aim of making it accessible to the competent authorities and to the public, particularly to economic operators. 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 applications for registration and the publication and maintenance of an appropriate and precise register of trade marks. On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties (see, by analogy, judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraphs 26 to 30).
- 45 In those circumstances, in order to fulfil its role as a registered EU trade mark, a sign must always be perceived unambiguously, uniformly and durably, so that the function of that mark as an indication of origin is guaranteed (see judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraphs 31 and 32).
- 46 So far as concerns colour per se marks, the Court has held that a sample of a colour does not per se constitute a graphic representation within the meaning of Article 4 of Regulation No 207/2009. On the other hand, a verbal description of a colour, in so far as it was composed of words which themselves were made up of letters, did constitute a graphic representation of the colour, provided that it satisfied the conditions mentioned in paragraphs 44 and 45 above (see, by analogy, judgment of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244, paragraphs 33 to 35).
- 47 With regard to trade marks consisting of a combination of two or more colours per se, the Court has made clear that, in order to satisfy the conditions mentioned in paragraphs 44 and 45 above, a graphic representation consisting of two or more colours, designated in the abstract and without contours, has to be systematically arranged by associating the colours concerned in a predetermined and uniform way. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours ‘in every conceivable form’, does not exhibit the qualities of precision and uniformity required by Article 4 of Regulation No 207/2009. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark (see, by analogy, judgment of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraphs 33 to 35).
- 48 The Court must examine in the light of those considerations whether the contested decisions are vitiated by errors of assessment.

- 49 In the present case, the Board of Appeal, in paragraph 53 of the contested decision in Case T-101/15 and in paragraph 52 of the contested decision in Case T-102/15, confirmed the decisions of the Cancellation Division declaring the contested marks invalid on the basis of Article 4 and Article 7(1)(a) of Regulation No 207/2009, since they could not be considered to be sufficiently precise. The Board of Appeal based its conclusion on the combined analysis of the graphic representation and the description accompanying each of the contested marks. Since, apart from indicating two colours, the description was confined to indicating a certain ratio between those colours, the Board of Appeal considered that the mere indication of such a ratio allowed for the arrangement of the two colours in numerous different combinations and did not therefore associate the colours in a predetermined and uniform way, as required by Article 4 of Regulation No 207/2009, as interpreted in the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384).
- 50 In the first place, the applicant, supported by the intervening association, claims, in essence, that the Board of Appeal's interpretation of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) and the way in which it applies that judgment in the present case are wrong.
- 51 In particular, the applicant submits that the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) applies only to a graphic representation consisting of a mere 'combination' of colours — one that is arbitrary and unspecified — and does not cover a juxtaposition of colours, which is not a mere 'combination' within the meaning of that judgment. Furthermore, that judgment essentially dealt with the issue of claiming protection in respect of two colours 'in any conceivable form'. Thus, the word 'or', used in paragraph 34 of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), should be seen in the light of the phrase 'in every conceivable form'. It follows that a juxtaposition of two colours next to each other with an appropriate indication of the relationship between them, expressed in terms of a percentage, does not mean that a graphic representation is imprecise or unclear, unless those parameters are clearly contradicted by the description filed simultaneously. The two elements should therefore be assessed cumulatively. The contested marks do not consist of a mere combination of colours and the application for their registration does not claim protection 'in every conceivable form'. That judgment should not, therefore, be applied in the present case.
- 52 According to the intervening association, the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) is applicable to two types of graphic representation: on the one hand, signs consisting of the mere juxtaposition (to be interpreted as the 'mere combination') of two or more colours without shape or contours, and, on the other, signs consisting of two or more colours which are stated to be 'in every conceivable form'. Paragraph 34 of that judgment thus covered two alternative situations and the contested marks do not fall within either of them.
- 53 The reasoning followed by the applicant and by the intervening association with regard to the scope of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) must be rejected, in so far as it is based on a misinterpretation of that judgment.
- 54 Paragraphs 33 to 35 of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), recalled in paragraph 47 above, must be read in conjunction with, and in the light of, the principles referred to in paragraphs 24 and 26 to 30 of that judgment, recalled in paragraphs 41 and 44 above.
- 55 It is clear that, in order to determine precisely the subject matter of the protection afforded by an EU trade mark consisting of a combination of colours per se, those colours must be represented in accordance with a specific arrangement or layout, associating the colours in a predetermined and uniform way, in order to prevent numerous different combinations of those colours which would not permit the consumer to perceive and recall a particular combination, as the Court stated in paragraph 35 of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384).

- 56 That condition is consistent, first, with the need for the mark to be able to fulfil its function as an indication of origin by being perceivable and recognisable by consumers when applied to products, given that colours are normally a simple property of things and are generally used for their attractive or decorative powers, without conveying any meaning; second, with the requirement of legal certainty, in the sense that it allows the competent authorities and economic operators to know with clarity and precision the nature of the signs of which a mark consists and the rights of third parties; and, third, with the requirement that the availability of colours should not be unduly restricted in business practices by the creation of monopolies for a single undertaking.
- 57 It is important, therefore, to consider whether the contested marks allow numerous different combinations of the two colours at issue, within the meaning of paragraph 35 of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384).
- 58 The graphic representation of the contested marks consists of the vertical juxtaposition of the two colours blue and silver, in the ratio of 50% to 50%. This graphic representation is accompanied by a different description in each of the two cases. The description that accompanies the first contested mark, at issue in Case T-101/15, identifies the two colours by reference to the internationally recognised colour identification code 'RAL', and states that the ratio is 'approximately 50%-50%'. The description in the case of the second contested mark, at issue in Case T-102/15, identifies the two colours by reference to the internationally recognised colour identification code 'Pantone', and states that the colours 'will be applied in equal proportion and juxtaposed to each other'.
- 59 It must be held, first, that the Board of Appeal was right in finding that the graphic representation of the contested marks consisted of a mere juxtaposition of two colours without shape or contours, allowing several different combinations of the two colours.
- 60 It must be held, second, that the Board of Appeal was also right in considering that the descriptions which accompanied the graphic representation of each of the contested marks did not provide additional precision with regard to the systematic arrangement associating the colours in a predetermined and uniform way and precluding a number of different combinations of those colours, as required by the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384).
- 61 Those findings are not called in question by the various arguments put forward by the applicant, supported by the intervening association.
- 62 First, the Court must reject as ineffective the arguments of the applicant and the intervening association concerning the interpretation of the German word 'Zusammenstellung' in the various language versions of paragraph 34 of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), in so far as, while not referring to some arbitrary combination, as the applicant and the intervening association maintain, the term 'juxtaposition' also does not necessarily constitute a systematic arrangement for the purposes of paragraph 33 of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384). While, admittedly, juxtaposition indicates the direct placing of two or more colours side by side, they may be so placed in a number of different arrangements. That juxtaposition can thus take different forms, giving rise to different images or layouts, while still being in a 'ratio of ... approximately 50%-50%' or 'in equal proportion'.
- 63 The information that is added by the indication of the proportions in the description of the contested marks is merely that each colour will occupy one half of the space occupied by both, regardless of how they are juxtaposed. It follows that the Court must also reject the interpretation of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) advocated by the applicant, supported by the intervening association, according to which the clarification of the proportions or the relationship between the different colours is sufficient to satisfy the requirement of a systematic arrangement such as that mentioned in the judgment.

- 64 The arrangement of two colours may fail to be predetermined or uniform not only because of the different proportions of those colours but also because of the different spatial position of those colours in the same proportions.
- 65 Second, the claim by the intervening association that the vertical juxtaposition of two blocks of colour, blue on the left and silver on the right, in approximately equal proportions constitutes the only systematic arrangement associating the colours in a predetermined and uniform way must be rejected. It has been made clear in paragraphs 54 to 60 above that, in the present case, the graphic representation of two juxtaposed colours accompanied by an indication in percentage terms of their respective proportions is insufficient for the purpose of determining the systematic arrangement of those colours. It must, moreover, be noted that the applicant's applications for registration, filed on the basis of the acquired distinctiveness through use of the contested marks, were accompanied by evidence which reproduced those marks very differently in comparison to the vertical juxtaposition of the two colours shown in the graphic representation included in those applications.
- 66 The applicant itself therefore maintains that the contested marks, colour per se marks, defined in the abstract, confer protection that covers different arrangements of the colours blue and silver and not only the arrangement consisting of two equal vertical blocks, the one on the left, blue, the other on the right, silver, as the intervening association claims. The applicant thus acknowledges that the graphic representation of the contested marks, as registered, allows a plurality of reproductions, which are neither predetermined in advance nor uniform.
- 67 That is precisely the outcome which the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) seeks to prevent, in so far as it is incompatible with the underlying objectives of Article 4 of Regulation No 207/2009, referred to in paragraphs 41 and 44 above and which consist in guaranteeing the function of the mark and enabling consumers to perceive, to recognise and to recall a mark, which implies that the visual appearance of the mark is as registered.
- 68 Third, if, as the intervening association claims, it was sufficient, for the purpose of guaranteeing the qualities of precision and uniformity required by Article 4 of Regulation No 207/2009, to apply the 'what you see is what you get' rule, it would have to be concluded that the vertical juxtaposition of two equal blocks, blue on the left and silver on the right, is the only arrangement covered by the protection afforded by the registration of the contested marks. However, that cannot be the case, as is evident from paragraph 65 above.
- 69 On the contrary, it is precisely the application of that rule which requires that the graphic representation, as filed and as visible ('what you see'), be the only subject matter of the protection afforded by the contested marks ('what you get'). In that sense, the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) serves to clarify the practical consequences of that rule in terms of the conditions of registration of colour per se marks.
- 70 Fourth, the application, in the present case, by the Board of Appeal of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) does not, contrary to the submissions of the applicant and the intervening association, amount to a denial of the existence or registrability of that type of trade mark, contrary to Article 4 of Regulation No 207/2009, as amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Regulation No 2868/95, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21), according to which an EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of (i) distinguishing the goods or services of one undertaking from those of other undertakings; and (ii) being represented on the Register of EU

trade marks 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. However, that regulation is applicable only from 1 October 2017.

- 71 It is sufficient, for that purpose, for the proprietor of the mark to file a graphic representation of the mark corresponding precisely to the subject matter of the protection he wishes to secure. The proprietor may not, however, file a graphic representation while at the same time claiming a broader protection than that afforded by that representation or which does not correspond to it, in direct contradiction of the rule that ‘what you see is what you get’.
- 72 Fifth, in relying on the opinion of a consultant, the applicant recognises that the valid objective of a description of a sign is to ensure the consistent reproduction of the mark in practice, while allowing for possible but inevitable ‘minor inconsistencies’ in the commercial reproduction of the sign. Nevertheless, in the present case, it must be noted that the differences between the contested marks as represented and described and the way in which they are reproduced are not minor, since the juxtaposition of two equal vertical blocks, one of the colour blue on the left and the other of the colour silver on the right, is certainly not reproduced on the applicant’s products.
- 73 Sixth, the applicant and the intervening association submit that to require a description of a systematic arrangement of colours that are the subject matter of a trade mark consisting of a combination of colours per se would effectively remove, in essence, the distinction between colour per se marks and figurative marks.
- 74 That criticism cannot be accepted. Even if the representation or the description of the precise arrangement of colours helps to make a colour per se mark more akin to a figurative mark, the subject matter of the protection afforded by those two categories of mark remains distinct.
- 75 Furthermore, as the intervener correctly emphasises, the colour per se mark may be applied, without contours, over the whole surface of the goods covered, irrespective of their shape or their packaging, which is not the case for figurative marks (see, to that effect, judgment of 28 January 2015, *Enercon v OHIM (Gradation of five shades of the colour green)*, T-655/13, not published, EU:T:2015:49, paragraph 16). An undertaking will therefore always retain an interest in registering a colour mark, given the broader protection afforded by that type of mark as against that afforded by a figurative mark.
- 76 In the second place, the applicant submits, first, that the obligation to provide an explicit description, as referred to by the Board of Appeal in paragraph 50 of the contested decision in Case T-101/15 and in paragraph 49 of the contested decision in Case T-102/15, is not apparent either from the applicable legislation or from the case-law; second, that it has never been held in the case-law that that description must cover the actual use that will be made of the mark at issue; and, third, that such a requirement, applied solely to colour per se marks, represents a breach of the principle of equal treatment. The Board of Appeal thus, according to the applicant, created an additional condition for the registration of colour per se marks only, and one that is not provided for in Article 4 of Regulation No 207/2009.
- 77 It should be made clear at the outset that the Board of Appeal did not state in the contested decisions that there was an obligation to provide an explicit description of the mark applied for. It merely noted that an explicit description was required ‘in the present case’.
- 78 As to whether the Board of Appeal was entitled to find that an explicit description of the contested marks was required in the present case, first, it should be noted that Rule 3(3) of Regulation No 2868/95 provides that the application for registration ‘may contain a description of the mark’.

- 79 As the Board of Appeal correctly found in paragraph 48 of the contested decisions, if a description is included in the application for registration, it must be evaluated in combination with the graphic representation.
- 80 In addition, as the Board of Appeal correctly pointed out in paragraph 43 of the contested decisions, it follows from the judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244) that a description of a sign may be required in order to fulfil the requirements of Article 4 of Regulation No 207/2009.
- 81 That is notably the case where the systematic arrangement associating the colours in a predetermined and uniform way is not apparent from the graphic representation and the latter does not, therefore, enable the subject matter of the protection to be clearly defined, as noted in paragraph 59 above.
- 82 Consequently, the Board of Appeal was right in considering, in paragraph 50 of the contested decision in Case T-101/15 and in paragraph 49 of the contested decision in Case T-102/15, that an explicit description of the systematic arrangement associating the colours in a predetermined and uniform way would have been required in the present case.
- 83 Second, the applicant's criticism that the Board of Appeal required the description to cover the actual use that would be made of the mark at issue must also be rejected.
- 84 Although paragraph 48 of the contested decisions refers to the 'scope' of the protection afforded by a sign, a concept generally considered when assessing relevant use for the purposes of Article 7(3) or Article 15 of Regulation No 207/2009, in the present case, that term, as used in the contested decisions, must be interpreted as referring to the 'subject' of the protection afforded by an EU trade mark, as EUIPO confirmed during the hearing.
- 85 The requirement that a mark consisting of a combination of two or more colours exhibit a systematic arrangement associating the colours in a predetermined and uniform way does not amount to a requirement that the actual use of a trade mark applied for be defined. However, the abstract nature of such a mark and the colours' limited intrinsic ability to convey some precise meaning and thus to indicate the commercial origin of a product or service are such that the subject matter of the protection afforded by the mark at issue must be defined in appropriate detail. Colour per se marks thus differ from other types of mark which are, by nature, more precise and better able to convey meaning. Accordingly, in view of the nature and inherent characteristics of colour per se marks, the requirement that the subject matter of the protection afforded by such marks be defined in appropriate detail does not constitute a breach of the principle of equal treatment.
- 86 Third, as regards the alleged breach of the principle of equal treatment, it must also be stated that colour per se marks are not limited spatially or by shape, unlike three-dimensional marks, nor are they limited by contours, unlike figurative marks; they are manifested visually and not by a sound or by characters, like sound or word marks.
- 87 In the case of a combination of colours, the only way in which the colours can be positioned within a contour-free space is by being juxtaposed in various arrangements. The only details that can be given are thus the specific shades of the colours concerned and the proportions in which each of them is displayed. Such a representation results in the subject of protection afforded by the trade mark being too broad, which is hard to reconcile with the requirement of the colours' availability and which must, therefore, be clarified, as soon as the application for registration is filed, with respect to the systematic arrangement associating the colours in a predetermined and uniform way.
- 88 Furthermore, as the Board of Appeal correctly noted in paragraph 51 of the contested decision in Case T-101/15 and in paragraph 50 of the contested decision in Case T-102/15, it is apparent from the judgment of 12 December 2002, *Sieckmann* (C-273/00, EU:C:2002:748) that the requirement that a

sign be clear, precise, self-contained, easily accessible, intelligible, durable and objective must be individually determined for each category of marks, depending on their nature and inherent characteristics.

- 89 It follows from all of the foregoing that the Board of Appeal did not err in finding, in paragraphs 48, 49 and 51 of the contested decision in Case T-101/15 and in paragraphs 48 and 50 of the contested decision in Case T-102/15, that the mere indication of the ratio of the two colours blue and silver allowed for the arrangement of those colours in numerous different combinations and did not therefore constitute a systematic arrangement associating the colours in a predetermined and uniform way, producing a very different overall impression and preventing consumers from repeating with certainty a purchase experience. It was therefore fully entitled to conclude that the graphic representation supplied in the present case, accompanied by a description indicating only the proportions of the two colours, could not be considered sufficiently precise and that the contested mark had been registered contrary to Article 7(1)(a) of Regulation No 207/2009.
- 90 In addition, as the Board of Appeal correctly noted in paragraph 49 of the contested decision in Case T-101/15, that conclusion applies to both contested marks. The presence of the word ‘approximately’ in the description of the first contested mark merely reinforces the imprecise nature of the graphic representation, which is identical in respect of both contested marks and which allows for different arrangements of the two colours at issue, since it is accompanied by a description that does not provide details from which it might be inferred that there is only one arrangement associating the colours in a predetermined and uniform way.
- 91 Accordingly, the first part of the first plea in law must be rejected in its entirety.

Second part, alleging breach of the principle of equal treatment

- 92 As a preliminary point, it should be made clear that the applicant does not explicitly invoke a breach of the principle of equal treatment in the context of its application, but only in the context of its reply by referring to the arguments set out in its consultant’s opinion, and in the context of its observations on the statement in intervention of the intervening association, in the paragraphs concerned with the principle of proportionality.
- 93 Nevertheless, the express reference to the principle of equal treatment in the reply merely formalises, in essence, the complaint already relied on in the application.
- 94 In the present case, the applicant submits in particular that the need to describe, when applying for registration, the way in which the subject matter of the trade mark is actually applied on the goods or services concerned does not exist for other categories of trade mark, such as three-dimensional marks, sound marks or word marks. Moreover, that requirement would imply a different treatment of the contested marks, having regard to EUIPO’s practice in previous decisions and the case-law of the General Court in relation to colour per se marks.
- 95 The principle of equal treatment, enshrined in EU law, requires that comparable situations be treated in the same way. It is apparent from the case-law that discrimination can arise only through the application of different rules to comparable situations or the application of the same rule to different situations (see judgment of 10 May 2012, *Commission v Estonia*, C-39/10, EU:C:2012:282, paragraph 48 and the case-law cited).
- 96 In the first place, as regards the comparison with other types of trade mark, as has been explained in paragraphs 85 to 88 above, it follows from the nature of a mark consisting of a combination of colours per se, without contours or shape, that, in order for the precise subject matter of its protection to be clear and perceivable by consumers and economic operators and for it to thus fulfil

its essential function of indicating origin while not conferring disproportionate competitive advantages, its graphic representation or the accompanying description must show the precise shades of the colours in question, the ratios and their spatial arrangement. That degree of precision is required because of the intrinsically less precise nature of colour per se marks, which distinguishes such marks from other types of trade mark. Accordingly, different treatment is justified in the light of the case-law referred to in paragraph 95 above.

- 97 In the second place, as regards the comparison with EUIPO's previous practice in relation to colour per se marks, suffice it to note that decisions concerning registration of a sign as an EU trade mark which the Boards of Appeal are called on to take under Regulation No 207/2009 are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, the legality of the decisions of Boards of Appeal must be assessed solely on the basis of that regulation, as interpreted by the judicature, and not on the basis of a previous decision-making practice of those boards (judgment of 15 September 2005, *BioID v OHIM*, C-37/03 P, EU:C:2005:547, paragraph 47).
- 98 Admittedly, in the light of the principles of equal treatment and of sound administration, it has been held that EUIPO must, when examining an application for registration of an EU trade mark, take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not (judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraph 74).
- 99 Nonetheless, the way in which those principles are applied must be consistent with respect for legality. Consequently, a person who files an application for registration of a sign as an EU trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed to the benefit of someone else (judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraphs 75 and 76).
- 100 In the present case, first, the applicant relies on the EUIPO guidelines, according to which: 'Where a combination of colours per se is applied for, the graphic representation filed must spatially delineate these colours so as to determine the scope of the right applied for (what you see is what you get). The graphic representation should clearly indicate the proportion and position of the various colours, thus systematically arranging them by associating the colours in a predetermined and uniform way'. It infers from this that it was EUIPO's practice to examine applications for registration of colour per se marks on the basis of the rule that 'what you see is what you get'.
- 101 In that regard, no breach of that practice can be relied on in the present case. It is apparent from paragraph 69 above that the requirement of a systematic arrangement, as identified by the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), is not in any way inconsistent with that rule. On the contrary, it must be held that such a requirement flows directly from the wording of the paragraph of the EUIPO guidelines invoked by the applicant.
- 102 Second, the applicant relies on EUIPO's practice after the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), from which it is apparent that EUIPO accepts, on the basis of the rule that 'what you see is what you get', applications for registration of EU trade marks consisting of combinations of colours per se, similar to the contested marks, and the validation of those applications by certain decisions of the Boards of Appeal.
- 103 As observed in paragraph 99 above, the applicant cannot rely, to its advantage, on a possibly unlawful act committed to the benefit of someone else (see also, to that effect, judgment of 22 March 2017, *Intercontinental Exchange Holdings v EUIPO (BRENT INDEX)*, T-430/16, not published, EU:T:2017:198, paragraph 45 and the case-law cited).

104 Third, the applicant maintains that the Court has never held that the exact arrangement of the colours as used on the products needed to be indicated in the application for registration. It relies, in particular, on the judgments of 28 October 2009, *BCS v OHIM — Deere (Combination of the colours green and yellow)* (T-137/08, EU:T:2009:417); of 12 November 2010, *Deutsche Bahn v OHIM (Horizontal combination of the colours grey and red)* (T-404/09, not published, EU:T:2010:466); of 12 November 2010, *Deutsche Bahn v OHIM (Vertical combination of the colours grey and red)* (T-405/09, not published, EU:T:2010:467); and of 28 January 2015, *Gradation of five shades of the colour green* (T-655/13, not published, EU:T:2015:49).

105 Suffice it to note in that regard that the judgments invoked did not concern the infringement of Article 4 and Article 7(1)(a) of Regulation No 207/2009, and so the General Court was not obliged to rule on the question of the requirements of the clarity and precision of the signs at issue.

106 In the light of all of the foregoing, the Court must reject the second part of the first plea in law.

Third part, alleging breach of the principle of proportionality

107 So far as concerns this part of the first plea, it must be noted that, again, the applicant does not explicitly rely in its application on breach of the principle of proportionality, but refers to it for the first time in its reply. Contrary to EUIPO's contention, this part of the first plea must be accepted as being admissible. In the case of a submission put forward for the first time at the reply stage, it must be noted that it follows from Article 76(d) in conjunction with Article 84(1) of the Rules of Procedure of the General Court that the application initiating the proceedings must state the subject matter of the proceedings and contain a summary of the pleas in law relied on, and that no new plea in law may be introduced in the course of proceedings unless it is based on matters of law or of fact which come to light in the course of the procedure. However, a plea which constitutes an amplification of a submission previously made, either expressly or by implication, in the original application and is closely linked to it must be declared admissible. The same applies to a submission made in support of a plea in law (see, to that effect, and by analogy, judgment of 21 March 2002, *Joyson v Commission*, T-231/99, EU:T:2002:84, paragraph 156).

108 In the present case, the complaint regarding the disproportionate nature of the outcome resulting from EUIPO's application of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) as regards the compatibility of the graphic representation of a colour per se mark with Article 4 of Regulation No 207/2009 follows indirectly, on the one hand, from the applicant's claims that there is no need for an explicit description to accompany the graphic representation of the contested marks, and, on the other, from the non-existence of a legal requirement to that effect, claims which had already been put forward at the application stage.

109 It follows from this that the plea relating to the principle of proportionality raised by the intervening association in its statement in intervention must also be considered admissible, in accordance with Article 142(1) of the Rules of Procedure.

110 As to the substance of this plea, it must be stated that, in so far as the arguments advanced by the applicant in that context seek to criticise the different treatment of colour per se marks as compared with other categories of trade mark, those arguments actually relate to the principle of equal treatment and must, accordingly, be rejected, as is apparent from paragraphs 94 to 106 above.

111 Moreover, as regards the criticism that the Board of Appeal's preferred interpretation of the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) involves an overly strict application of the requirements applicable to the graphic representation of colour per se marks, given the objectives of those requirements, and an unnecessarily high threshold, it must be borne in mind that the principle of proportionality requires that measures adopted by EU institutions do not exceed the

limits of what is appropriate and necessary in order to attain the objectives legitimately pursued by the legislation in question; when there is a choice between several appropriate measures recourse must be had to the least onerous, and the disadvantages caused must not be disproportionate to the aims pursued (judgments of 12 July 2001, *Jippes and Others*, C-189/01, EU:C:2001:420, paragraph 81, and of 22 January 2013, *Sky Österreich*, C-283/11, EU:C:2013:28, paragraph 50).

- 112 However, first, as has been noted in paragraphs 41, 43 and 44 above, the main objectives pursued by Article 4 of Regulation No 207/2009 are, in particular, to safeguard the function of an EU trade mark as an indication of origin, which presupposes that it is perceived unambiguously, uniformly and durably; to ensure legal certainty, which presupposes that the precise subject matter of the protection afforded by the EU trade mark, both to its proprietor and to the competent authorities and other economic operators, is defined; and to uphold the general interest in not unduly restricting the availability of colours and in preventing the abuse of EU trade mark law for the purpose of obtaining an unfair competitive advantage.
- 113 Second, by highlighting the requirements of clarity and precision for a trade mark consisting of a combination of colours per se in order to prevent numerous different combinations, the Court of Justice weighed the proportionality of that requirement in the light of the objectives pursued by that provision.
- 114 Third, the proportionate nature of that requirement for marks consisting of a combination of colours per se flows directly from the nature of those marks, in accordance with the analysis in paragraphs 84 to 86 above. In order for the precise subject matter of the protection afforded by such a mark to be defined, its representation must, even at the stage of the application for registration, be objective and represent the arrangement in the form in which the consumer will perceive and recall it.
- 115 In view of the foregoing, it must be concluded that the application, in the present case, of the requirements laid down by the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384) was not disproportionate given the aims of those requirements.
- 116 Furthermore, if EUIPO were to agree to protect a combination of two or more colours allowing, as a matter of fact, numerous different combinations, that approach would amount to affording protection that would be disproportionate in the light of the aim pursued by trade mark law, which is to safeguard the function of indicating the origin of goods in commercial practice in the interest of consumers.
- 117 Fourth, the intervening association asserts that the breach of the principle of proportionality is all the more flagrant as the new Regulation 2015/2424 has dropped the requirement for a graphic representation, by introducing Article 4(b) in Regulation No 207/2009 (now Article 4(b) of Regulation 2017/1001), which now requires only that the sign be capable of being represented ‘in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor’.
- 118 In that regard, although Article 4(b) of Regulation No 207/2009, as amended by Regulation 2015/2424, is not applicable in the present case, suffice it to note that that argument is based on an erroneous interpretation of that provision. The new wording of Article 4 of Regulation No 207/2009, which is intended to reinforce legal certainty, is more restrictive than the previous wording, in so far as it expressly incorporates into the body of that provision the objectives identified in the judgments of 12 December 2002, *Sieckmann* (C-273/00, EU:C:2002:748), and of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), and is thus perfectly consistent with that case-law and also with its application by the Board of Appeal in the contested decisions.
- 119 Furthermore, contrary to what is claimed by the applicant, but in common with the intervener, it must be observed that it is neither impossible nor disproportionate to require that an application for registration relating to a trade mark consisting of a combination of colours per se be represented

graphically or accompanied by a description containing the systematic spatial arrangement of the colours in such a way as to enable the subject matter of the protection afforded by that mark to be grasped clearly and precisely.

- 120 Having regard to all of the foregoing, the third part of the first plea relating to breach of the principle of proportionality must be rejected as unfounded, as, accordingly, must the first plea in law in its entirety.

Second plea in law, alleging breach of the principle of protection of legitimate expectations

- 121 In the context of the present plea, the applicant, supported by the intervening association, criticises the Board of Appeal for having concluded that the fact that the examiner accepted, or even suggested, the wording of the description at the time when the applications for registration of the contested marks were filed did not support a legitimate expectation and, moreover, that an established practice of EUIPO either did not exist or did not amount to information on which a legitimate expectation could be based.
- 122 Last, the applicant submits that, having registered the contested marks on the basis of the distinctiveness they had acquired through use, EUIPO implicitly ruled on the compliance of those marks with Article 4 of Regulation No 207/2009.
- 123 EUIPO and the intervener dispute those arguments.
- 124 In accordance with Article 52(1)(a) of Regulation No 207/2009, an EU trade mark is to be declared invalid on application to EUIPO or on the basis of a counterclaim in infringement proceedings where the EU trade mark has been registered contrary to the provisions of Article 7 of that regulation.
- 125 According to settled case-law, the possibility of relying on the principle of the protection of legitimate expectations is open to any individual whom an institution, by giving him precise assurances, has led to entertain legitimate expectations. Regardless of the form in which it is communicated, precise, unconditional and consistent information which comes from an authorised and reliable source constitutes such assurance (see judgment of 5 April 2006, *Kachakil Amar v OHIM (Longitudinal line ending with a triangle)*, T-388/04, not published, paragraph 26 and the case-law cited).
- 126 However, such assurances must comply with the applicable provisions and rules, since promises which do not take account of those provisions of EU law cannot give rise to a legitimate expectation on the part of the person concerned (see, to that effect, judgment of 27 June 2012, *Interkobo v OHIM – XXXLutz Marken (my baby)*, T-523/10, EU:T:2012:326, paragraph 83 and the case-law cited).
- 127 In addition, it is clear from the case-law that, in order to be able to rely on the principle of the protection of legitimate expectations, an applicant must be able to show expectations based on specific assurances by the administration such as to give rise to pardonable confusion in the mind of a party acting in good faith and with all the diligence required of a normally informed operator (see judgment of 9 September 2011, *dm-drogerie markt v OHIM – Distribuciones Mylar (dm)*, T-36/09, EU:T:2011:449, paragraph 114 and the case-law cited).
- 128 In the present case, in paragraph 29 of the contested decisions, in the first place, the Board of Appeal considered that the applicant could not rely on the principle of protection of legitimate expectations, since the suggestions for a description given by the examiner upon the application for registration being filed did not amount to precise, unconditional and consistent information that could lead the applicant to entertain legitimate expectations as regards the validity of the registration of the contested marks.

- 129 In the case of the first contested mark, it is apparent from the file that the examiner asked the applicant's representative, in telephone conversations that took place between 11 August and 3 September 2004, to clarify the application for registration, taking into account the registration requirements identified by the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), and, in particular, to add information regarding the proportions of the two colours concerned and the way in which those colours would appear. Following that request by the examiner, the applicant filed the description referred to in paragraph 3 above on 11 October 2004, and the first contested mark was registered on 25 July 2005.
- 130 In the case of the second contested mark, as noted in paragraphs 11 to 13 above, following the examiner's notice of absence of formal requirements, asking that the proportions in which each colour would be applied to the products, and the way in which those colours would appear, be specified, the applicant provided a description stating that the 'colours will be applied in equal proportion and juxtaposed to each other'. On 8 March 2011, the second contested mark was registered.
- 131 Those facts are not disputed by EUIPO.
- 132 In that regard, it should be stated that, as EUIPO confirmed at the hearing, in both cases, the examiner merely asked the applicant to clarify the description provided by indicating the proportions of the two colours concerned and how they would appear. The clarification provided by the applicant was subsequently accepted. However, that does not mean that the examiner, in both cases, gave precise, unconditional and consistent assurances that those descriptions met the legal requirements laid down by Article 4 of Regulation No 207/2009.
- 133 First, although, on two occasions, the examiner accepted two descriptions that did not comply with the requirements identified by the judgment of 24 June 2004, *Heidelberger Bauchemie* (C-49/02, EU:C:2004:384), those circumstances cannot preclude the contested marks being declared invalid if they were registered in breach of one of the absolute grounds for refusal provided for in Article 7 of Regulation No 207/2009.
- 134 Second, even on the assumption that the information supplied by the examiner may be described as precise and unconditional assurances, it is apparent from the case-law referred to in paragraph 126 above that, in so far as such assurances did not comply with the applicable provisions, they could not sustain a legitimate expectation.
- 135 Third, the registration of an EU trade mark, whether or not preceded by discussions concerning the information to be supplied in order to ensure that the application is in order and complete, cannot protect the proprietor of that mark from the risk of its being declared invalid pursuant to Article 52(1) of Regulation No 207/2009. It is apparent from the case-law mentioned in paragraph 126 above that the requirement of legal certainty, which is the general interest pursued by that provision, necessarily outweighs any legitimate expectation and the private interest that an EU trade mark proprietor might possibly be able to claim.
- 136 Furthermore, the objective of Article 52(1) of Regulation No 207/2009 is precisely to enable any errors made by examiners at the time when an application for registration is filed to be corrected, regardless of whether or not the error was preceded by discussions with the applicant for the trade mark, since, in either case, a supposedly correct registration has been completed but may yet be cancelled because of an absolute ground for invalidity, as the wording of that article makes clear.
- 137 In the second place, the Board of Appeal considered that the applicant was not entitled to base any legitimate expectation on EUIPO's practice in previous decisions.

- ¹³⁸ In that regard, as noted in paragraphs 98 and 99 above, EUIPO is under a duty to exercise its powers in accordance with the general principles of EU law. Although, in the light of the principles of equal treatment and sound administration, EUIPO must take into account the decisions already taken in respect of similar applications and must consider with especial care whether it should decide in the same way or not, the way in which those principles are applied must be consistent with respect for legality. Consequently, a person who files an application for registration of a sign as an EU trade mark cannot rely, to his advantage and in order to secure an identical decision, on any unlawful act committed to the benefit of someone else. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and comprehensive, in order to prevent EU trade marks being improperly registered. Accordingly, such an examination must be undertaken in each individual case. The registration of a sign as an EU trade mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (see judgment of 12 December 2014, *Comptoir d'Épicerie v OHIM — A-Rosa Akademie (da rosa)*, T-405/13, not published, EU:T:2014:1072, paragraph 63 and the case-law cited).
- ¹³⁹ It follows from this that the Board of Appeal was right in concluding that the applicant cannot properly rely, in support of a claim of breach of the principle of protection of legitimate expectations, on previous decisions of EUIPO (see, to that effect, judgment of 12 December 2014, *da rosa*, T-405/13, not published, EU:T:2014:1072, paragraph 64 and the case-law cited).
- ¹⁴⁰ Moreover, the Board of Appeal did not err in recalling in paragraph 29 of the contested decisions that, according to the case-law, a mere practice, no matter how current, does not amount to precise, unconditional and consistent information within the meaning of the case-law referred to in paragraph 125 above (see judgment of 25 March 2009, *Anheuser-Busch v OHIM — Budějovický Budvar (BUDWEISER)*, T-191/07, EU:T:2009:83, paragraph 49 and the case-law cited).
- ¹⁴¹ Furthermore, as the Board of Appeal correctly states in paragraphs 30 to 33 of the contested decisions, the applicant cannot rely on previous decisions of EUIPO or of the Boards of Appeal or on judgments of the EU judicature, concerning EU trade marks consisting of combinations of colours per se similar to the contested marks, that are based solely on Article 7(1)(b) of Regulation No 207/2009, in order to claim that a practice exists in respect of the registrability of such trade marks for the purposes of Article 4 of that regulation.
- ¹⁴² It cannot be inferred from the fact that the examiner, the Board of Appeal or the EU judicature have ruled only on the lack of distinctive character of those marks that they have been deemed to comply with Article 4 of Regulation No 207/2009. Accordingly, those decisions could not be regarded as amounting to a practice on the part of EUIPO or the EU judicature of accepting applications for registration of marks of that kind as EU trade marks. Similarly, the Court must reject the applicant's argument that, by registering the contested marks on the basis of the distinctiveness they had acquired through use, EUIPO had implicitly ruled on the compliance of those marks with Article 4 of Regulation No 207/2009.
- ¹⁴³ In the third place, in so far as the intervening association relies on EUIPO guidelines, it has already been held that there is no basis for the proposition that these take precedence over the EU rules applicable (see, to that effect, judgment of 25 March 2009, *BUDWEISER*, T-191/07, EU:T:2009:83, paragraph 48).
- ¹⁴⁴ It follows from all of the foregoing that the Board of Appeal was right in concluding that the applicant could not rely on the principle of protection of legitimate expectations.
- ¹⁴⁵ The second plea in law must, therefore, be rejected. Accordingly, without there being any need to rule on the admissibility of the applicant's second head of claim, the action must be dismissed in its entirety.

Costs

- ¹⁴⁶ Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs in accordance with the form of order sought by EUIPO and the intervener.
- ¹⁴⁷ Moreover, under Article 138(3) of the Rules of Procedure, the Court may order an intervener other than those referred to in Article 138(1) and (2) to bear its own costs. In the present case, the intervening association which intervened in support of the applicant must bear its own costs.

On those grounds,

THE GENERAL COURT (Second Chamber),

hereby:

- 1. Dismisses the action;**
- 2. Orders Red Bull GmbH to pay the costs, including those incurred by the European Union Intellectual Property Office (EUIPO) and by Optimum Mark sp. z o.o.;**
- 3. Orders Marques to bear its own costs.**

Prek

Buttigieg

Berke

Delivered in open court in Luxembourg on 30 November 2017.

E. Coulin
Registrar

S. Gervasoni
President