JUDGMENT OF THE COURT (Second Chamber)

24 June 2004 *

In Case C-49/02,

REFERENCE to the Court under Article 234 EC by the Bundespatentgericht (Germany) for a preliminary ruling in the proceedings brought before that court by

Heidelberger Bauchemie GmbH,

on the interpretation of Article 2 of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1),

THE COURT (Second Chamber),

composed of: C.W.A. Timmermans, President of the Chamber, J.-P. Puissochet, J.N. Cunha Rodrigues (Rapporteur), R. Schintgen and N. Colneric, Judges,

Advocate General: P. Léger,
Registrar: H. von Holstein, Deputy Registrar

* Language of the case: German.

after considering the written observations submitted on behalf of:

— Heidelberger Bauchemie GmbH, by V. Schmitz, Rechtsanwalt,

— the Netherlands Government, by H.G. Sevenster, acting as Agent,

— the United Kingdom Government, by P. Ormond, acting as Agent, and D. Alexander, Barrister,

— the Commission of the European Communities, by N.B. Rasmussen and T. Jürgensen, acting as Agents,

having regard to the Report for the Hearing,

after hearing the oral observations of Heidelberger Bauchemie GmbH and the Commission at the hearing on 6 November 2003,

after hearing the Opinion of the Advocate General at the sitting on 15 January 2004,

gives the following

Judgment

1 By order of 22 January 2002, received at the Court on 20 February 2002, the Bundespatentgericht (Federal Patents Court) referred to the Court for a preliminary ruling under Article 234 EC two questions on the interpretation of Article 2 of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) (hereinafter 'the Directive').

2 Those questions were raised in proceedings brought by Heidelberger Bauchemie GmbH (hereinafter 'Heidelberger Bauchemie') against the refusal by the Deutsches Patentamt (German Patent Office) (hereinafter 'the Patent Office') to register the colours blue and yellow as a trade mark for certain products used in the building trade.

Legal framework

The TRIPS Agreement

3 The Agreement on Trade-related Aspects of Intellectual Property Rights (hereinafter 'the TRIPS Agreement'), which is set out in an annex to the Agreement establishing the World Trade Organisation of 15 April 1994, was approved on behalf of the European Community, as regards matters within its competence, by Council

Decision 94/800/EC of 22 December 1994 (OJ 1994 L 336, pp. 1 and 214). It entered into force on 1 January 1995. However, according to Article 65(1) of the Agreement, Members were not obliged to apply its provisions before the expiry of a general period of one year, that is to say before 1 January 1996.

4 Article 15(1) of the TRIPS Agreement states:

'Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.'

Community legislation

5 Article 2 of the Directive, headed 'Signs of which a trade mark may consist', is worded as follows:

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

6 Article 3 of the Directive, headed 'Grounds for refusal or invalidity' provides:

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

(a) signs which cannot constitute a trade mark;

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

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

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

...

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.

...'

German legislation

7 The Gesetz über den Schutz von Marken und sonstigen Kennzeichen (Law on Trade Marks and other Distinctive Signs) of 25 October 1994 (BGBl. 1994 I, p. 3082) (hereinafter 'the Markengesetz'), contained in Article 1 of the Gesetz zur Reform des Markenrechts und zur Umsetzung der Ersten Richtlinien (Law to reform the Law of Trade Marks and implement the First Directive), which entered into force on 1 January 1995, is intended to transpose the Directive into German law.

8 Paragraph 3(1) of the Markengesetz states:

'Any sign, particularly words, including personal names, designs, letters, numerals, acoustic signs, three-dimensional forms including the shape of goods or their packaging as well as other get-ups including colours and combinations of colours, which is capable of distinguishing the goods or services of one undertaking from those of other undertakings may be protected as a trade mark.'

9 Paragraph 8 of the Markengesetz provides:

'1. Signs protectable as trade marks for the purposes of Paragraph 3 but not capable of being represented graphically shall not be eligible for registration.

2. Trade marks shall not be eligible for registration

(1) which are incapable of distinguishing the goods or services concerned,

...

3. Subparagraph 2(1), (2) and (3) shall not apply where the trade mark became accepted by the relevant section of the public before the date of the decision on registration, following its use for the goods and services in respect of which the application for registration was made.'

The main proceedings and the questions referred

10 On 22 March 1995, Heidelberger Bauchemie applied to the Patent Office for the registration of the colours blue and yellow as a trade mark. The section headed 'reproduction of the mark' comprised a rectangular piece of paper, the upper part of

which was blue and the lower half yellow. The following description of the mark accompanied the application:

'The trade mark applied for consists of the applicant's corporate colours which are used in every conceivable form, in particular on packaging and labels.

The specification of the colours is:

RAL 5015/HKS 47 — blue

RAL 1016/HKS 3 — yellow.'

11 Registration of the mark was applied for in relation to a list of various products used in the building trade, including adhesives, solvents, varnishes, paints, lubricants and insulating materials.

12 By decision of 18 September 1996, the Patent Office rejected that application on the grounds, first, that the sign which it was sought to register was not capable of constituting a trade mark and was not capable of being represented graphically and, secondly, that the mark was devoid of any distinctive character. However, following the 'black/yellow colour mark' decision of the Bundesgerichtshof (Federal Court of Justice) (Germany) of 10 December 1998, the Patent Office reviewed its position. By decision of 2 May 2000, it accepted that colours are in principle able to constitute a

trade mark, but rejected the application on the ground of lack of any distinctive character. Heidelberger Bauchemie brought an appeal against that decision before the Bundespatentgericht.

13 The Bundespatentgericht considered that it was uncertain whether abstract, undelineated marks could be treated as 'signs' capable of being represented graphically within the meaning of Article 2 of the Directive. That provision refers to signs that are clearly defined and specific, indirectly visible and capable of being represented graphically. The capability of a sign of being graphically represented specified in Article 2 of the Directive reflects the principle of precision, which is a prerequisite of registration under trade mark law. It is doubtful whether a mark consisting of an abstract colour can satisfy that principle. An interpretation of Article 2 of the Directive is therefore necessary in order to determine whether abstract colours or combinations of colours are signs capable of constituting a trade mark. Consideration should also be given to how far the protection of 'abstract colour marks' is compatible with the requirement of legal certainty for all operators in the market or prevents the free movement of goods and services by granting the proprietors of trade marks over-extensive monopoly rights which are unreasonable from the point of view of their competitors.

14 In those circumstances, the Bundespatentgericht decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

'Do colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours and in shades which are named in words by reference to a colour sample (colour specimen) and specified according to a recognised colour classification system, satisfy the conditions for capability of constituting a trade mark for the purposes of Article 2 of [the Directive]?

In particular, for the purposes of Article 2 of the Directive, is such an "(abstract) colour mark"

(a) a sign,

(b) sufficiently distinctive to be capable of indicating origin,

(c) capable of being represented graphically?'

The questions referred

15 By its questions, which should be dealt with together, the national court is essentially asking whether, and if so under what conditions, colours or combinations of colours designated in the abstract and without contours are capable of constituting a trade mark for the purposes of Article 2 of the Directive.

16 In that regard, the Court noted at paragraphs 24 to 26 of its judgment in Case C-104/01 *Libertel* [2003] ECR I-3793 that the Council of the European Union and the Commission made a joint declaration, entered in the minutes of the Council meeting on the adoption of the Directive, that they 'consider that Article 2 does not exclude the possibility ... of registering as a trade mark a combination of colours or a single colour ... provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings' (OHIM OJ No 5/96, p. 607).

17 That declaration cannot be used to interpret a provision of secondary legislation where, as in this case, no reference is made to the content thereof in the wording of the provision in question and it therefore has no legal significance (Case C-292/89 *Antonissen* [1991] ECR I-745, paragraph 18, and Case C-329/95 *VAG Sverige* [1997] ECR I-2675, paragraph 23). The Council and the Commission also explicitly recognised that limitation in the preamble to their declaration, which states: 'since the following statements of the Council and the Commission are not part of the legal text they are without prejudice to the interpretation of that text by the Court of Justice of the European Communities'.

18 Accordingly, it is for the Court to determine whether, and if so under what conditions, Article 2 of the Directive is to be interpreted as meaning that colours or combinations of colours designated without any form of spatial delimitation are capable of constituting a trade mark.

19 Article 15(1) of the TRIPS Agreement provides that 'combinations of colours ... shall be eligible for registration as trade marks'. However, that Agreement does not define a 'combination of colours'.

20 Since the Community is a party to the TRIPS Agreement, it is required to interpret its legislation on trade marks so far as possible in the light of the wording and purpose of that Agreement (see, to that effect, Case C-53/96 *Hermès* [1998] ECR I-3603, paragraph 28).

21 It should therefore be established whether Article 2 of the Directive can be interpreted as meaning that 'combinations of colours' are capable of constituting a trade mark.

22 To constitute a trade mark under Article 2 of the Directive, colours or combinations of colours must satisfy three conditions. First, they must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings (see, to that effect, *Libertel*, paragraph 23).

23 As the Court has already held, colours are normally a simple property of things (*Libertel*, paragraph 27). 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.

24 For the purposes of the application of Article 2 of the Directive, 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 trademark law in order to obtain an unfair competitive advantage.

25 Moreover, it is clear from the Court's case-law (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraphs 46 to 55, and *Libertel*, paragraphs 28 and 29) that a graphic representation in terms of Article 2 of the Directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified.

26 Such an interpretation is necessary for the proper working of the trade mark registration system.

27 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.

28 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.

29 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.

30 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.

31 In those circumstances, in order to fulfil its role as a registered trade mark, a sign must always be perceived unambiguously and uniformly, so that the function of mark as an indication of origin is guaranteed. In the light of the duration of a mark's registration and the fact that, as the Directive provides, it can be renewed for varying periods, the representation must also be durable.

32 It follows from the above that a graphic representation for the purpose of Article 2 of the Directive must be, in particular, precise and durable.

33 Accordingly, a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way.

34 The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive, as construed in paragraphs 25 to 32 of this judgment.

35 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.

36 As regards the manner in which each of the colours concerned is represented, it is clear from paragraphs 33, 34, 37, 38 and 68 of *Libertel* that a sample of the colour concerned, accompanied by a designation using an internationally recognised identification code, may constitute a graphic representation for the purposes of Article 2 of the Directive.

37 As regards the question whether, for the purposes of this provision, colours or combinations of colours are capable of distinguishing the goods or services of one undertaking from those of other undertakings, it must be determined whether or not those colours or combinations of colours are capable of conveying precise information, particularly as regards the origin of a product or service.

38 It follows from paragraphs 40, 41 and 65 to 67 of *Libertel* that, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message.

39 Save in exceptional cases, colours do not initially have a distinctive character, but may be capable of acquiring such character as the result of the use made of them in relation to the goods or services claimed.

40 Subject to the above, it must be accepted that for the purposes of Article 2 of the Directive colours and combinations of colours, designated in the abstract and without contours, may be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

41 It should be added that, even if a combination of colours which it is sought to register as a trade mark satisfies the requirements for constituting a trade mark for the purposes of Article 2 of the Directive, it is still necessary for the competent authority for registering trade marks to decide whether the combination claimed satisfies the other requirements laid down, particularly in Article 3 of the Directive, for registration as a trade mark in relation to the goods or services of the undertaking which has applied for its registration. That examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought (*Libertel*, paragraph 76, and Case 363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 37). That examination must also take account of the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought (*Libertel*, paragraphs 52 to 56).

42 In light of the above, the answer to the questions must be that colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for the purposes of Article 2 of the Directive where:

— it has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and

— the application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way.

Even if a combination of colours satisfies the requirements for constituting a trade mark for the purposes of Article 2 of the Directive, it is still necessary for the competent authority for registering trade marks to decide whether the combination claimed fulfils the other requirements laid down, particularly in Article 3 of the Directive, for registration as a trade mark in relation to the goods or services of the undertaking which has applied for its registration. Such an examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought. That examination must also take account of the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought.

Costs

43 The costs incurred by the Netherlands and United Kingdom Governments and the Commission, which have submitted observations to the Court, are not recoverable. 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.

On those grounds,

THE COURT (Second Chamber),

in answer to the questions referred to it by the Bundespatentgericht by order of 22 January 2002, hereby rules:

Colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for the purposes of Article 2 of the First Council

Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks where:

— it has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and

— the application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way.

Even if a combination of colours satisfies the requirements for constituting a trade mark for the purposes of Article 2 of the Directive, it is still necessary for the competent authority for registering trade marks to decide whether the combination claimed fulfils the other requirements laid down, particularly in Article 3 of the Directive, for registration as a trade mark in relation to the goods or services of the undertaking which has applied for its registration. Such an examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought. That examination must also take account of the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought.

Timmermans Puissochet Cunha Rodrigues

Schintgen Colneric

Delivered in open court in Luxembourg on 24 June 2004.

R. Grass

Registrar

C.W.A. Timmermans

President of the Second Chamber