

## **Sieckmann Strikes Again – EUIPO Board of Appeal Cancels “Imprecise” Colour Combination Mark**

By Laurie Smith, J A Kemp, United Kingdom

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The EUIPO Board of Appeal recently upheld a request for a declaration of invalidity against the following grey/orange colour combination trade mark, on the grounds that its imprecision allows for multiple different combinations of the two colours.



The case involved a variety of arguments from the parties relating to inherent and acquired distinctiveness, use of a mark in conjunction with another mark, bad faith, infringement and counterfeit goods. In the end, however, the decision of the Board of Appeal turned on a simple question: does the mark meet the basic requirements for representation of a sign under Article 4 EUTMR? The Board of Appeal held that in the case of marks consisting of combinations of colours per se, the colours must be systematically arranged by associating the colours concerned in a predetermined and uniform way, in order to prevent numerous different combinations of those colours. It must be possible to ascertain the subject-matter of the mark with clarity and precision.

### **Background**

In 2008, German chainsaw manufacturer Andreas Stihl AG & Co. KG (“the EUTM proprietor”) filed an application to register the above colour mark in relation to “chain saws” in Class 7. The application claimed the colours orange (RAL 2010) and grey (RAL 7035) and included the following description:

*“The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw.”*

The application was registered in 2011 on the basis that the mark had acquired distinctiveness through use in the EU.

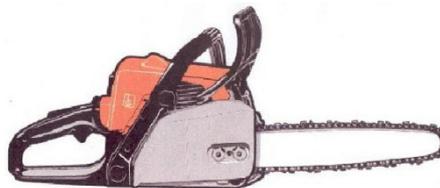
In 2015, Giro Travel Company (“the cancellation applicant”) filed a request for a declaration of invalidity against the registration on the grounds that:

- (i) The mark did not meet the basic requirements of a sign of which an EU trade mark may consist (Article 4 EUTMR). In particular, the sign did not meet the established legal standard known as the “Sieckmann” criteria, namely, that a mark must be clear, precise, self-contained, easily-accessible, intelligible, durable and objective;
- (ii) The mark was devoid of any distinctive character and was customary in the trade, as it comprised two colours that were widely used in the relevant market; and
- (iii) The application was filed in bad faith, since the EUTM proprietor was aware that the colours were widely used by its competitors, and intended to prevent such use.

The EUTM proprietor argued that:

- (a) The mark fulfils the basic requirements of a “sign” under Article 4 – the protection afforded is clear from the colours shown, the Pantone colours provided and the description of the mark;
- (b) The inherent distinctiveness of the mark was irrelevant since the mark was registered on the basis of acquired distinctiveness; and
- (c) There was no bad faith since, at the time of filing the application, the EUTM proprietor had no knowledge of any third party using an identical or similar sign for an identical or similar product, and had a legitimate interest in protecting the colours it had used for 15 years.

The case came before the Cancellation Division, which rejected the request for a declaration of invalidity, holding that graphical representation and the verbal description of the sign were compatible and complementary. The Cancellation Division also noted that the EUTM proprietor had attached to its application observations which made reference to its International Registration No. 872542 for the following mark:



The Cancellation Division held that the international registration made clear how the colours were used in a predetermined and uniform way, such that the colour mark satisfied the basic requirements of Article 4 EUTMR.

As to the cancellation applicant's other arguments, the Cancellation Division held that (i) even if the colours orange and grey were used by other chain saw providers, this did not lead to a finding of bad faith but, rather, was relevant to the inherent distinctiveness of the mark; and (ii) although the mark was inherently non-distinctive, it had, at the relevant dates, acquired distinctive character as a result of substantial use in a significant proportion the EU.

In 2017, the cancellation applicant filed an appeal, reiterating its previous arguments and also pointing out that the EUTM proprietor's International Registration No. 872542 should not have been relied upon by the Cancellation Division when assessing the present registration.

### **The Decision of the Board of Appeal**

In its decision, the Board of Appeal stated that the question to be decided was whether the EUTM proprietor's mark met the basic requirements of Article 4, and pointed out that acquired distinctiveness was irrelevant to such a question.

Making reference to previous decisions of the Court of Justice, the Board set out the general principle that, in the case of marks consisting of combinations of colours per se, the colours must be systematically arranged by associating the colours concerned in a predetermined and uniform way, in order to prevent numerous different combinations of those colours. It must be possible to ascertain the subject-matter of the mark with clarity and precision.

In the case of the EUTM proprietor's mark, the Board held that the graphic representation of the mark consisted of a mere image of two colours without shape or contours, allowing several different combinations of the two colours and, moreover, though the description of the mark specified that the colour orange was applied to the top of the chainsaw housing and the colour grey to the bottom, this did not provide sufficient precision, as the positioning of the two colours in this way could take different forms or layouts.

The Board also criticised the Cancellation Division for taking into account the EUTM proprietor's International Registration No. 872542, since such a reference does not constitute part of the representation of the mark, or the information that would be seen in the publication of the mark on the register.

Taking all of the above into account, the Board concluded that the EUTM proprietor's mark did not meet the Sieckmann criteria that a mark must be represented in a way that is clear, precise, self-contained, easily-accessible, intelligible, durable and objective, and held that the contested trade mark must be declared invalid.

### **Implications of the decision**

Whilst the decision will not come as a surprise to many (particularly those who read the [recent decision of the General Court](#) on the Red Bull blue/grey trade marks), it is nonetheless likely to be frustrating to those interested in registering colour marks that we are yet again being told what does not suffice, but are given little useful guidance on what would satisfy the basic requirements.

Moreover, if trade mark practitioners or brand owners were hopeful that the recent removal of the graphic representation requirement in the EU might make it easier to register such marks in future, it is clear that the basic Sieckmann criteria must still be met, and the registration of colours as trade marks will continue to be challenging.

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***For more information, please contact:***



**Laurie Smith**

Associate, European Trade Mark Attorney  
J A Kemp  
14 South Square  
Gray's Inn  
London WC1R 5JJ  
UK  
+ 44 20 3077 8600  
[www.jakemp.com](http://www.jakemp.com)

Laurie is an associate at J A Kemp, based in London. She joined the firm from another international patent and trade mark attorney firm.

Laurie has worked with clients ranging from startups and SMEs through to multinationals and has extensive experience of preparing, filing and prosecuting UK, EU and International trade mark applications. She has worked with clients across diverse commercial sectors including food and drink, electronics and financial services.

Having studied Law with French at University, Laurie is also proficient in French and spent a year studying French law during her undergraduate degree.

Laurie joined J A Kemp in 2014.