Non-Traditional Trademarks in Europe – Shape and Colour Trademarks – Common Issues with Obtaining, Exploiting and Enforcing Rights

Report prepared by
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INTRODUCTION

This report considers the issue of registrability and enforceability of shape and colour trademarks in 36 European jurisdictions including the European Union. The report highlights relevant practices in various European countries and, when appropriate, compares such practices with Community jurisprudence. To the extent possible, the country-by-country analysis gives a general overview of non-traditional trademarks' registrability (three-dimensional and colour marks).

The report illustrates that it is relatively difficult to register non-traditional trademarks in Europe today. Capability of a mark to be graphically represented does not suffice in itself. By far, the most frequent reason for refusal to register non-traditional trademarks such as colour and shape marks is lack of distinctiveness. OHIM statistics show that applications for these marks amount to only little over 1% over the last several years, and that the registrations for the same category are well below 1% of the total number of registered Community Trade Marks (CTMs).

The International Trademark Association favors registrability of non-traditional trademarks (colour, three-dimensional and sound) and advocates that color (whether a combination of colors or a single color) and three-dimensional shape may function as trademarks and, therefore, in appropriate circumstances, should be entitled to trademark recognition, protection and registration.

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**EUROPEAN UNION**

1- Registrability of Colour Marks

In the author's view, registration of colours as trademarks (which is not the same as saying coloured trademarks, although some significant overlapping does take place, as we shall see later on) is in theory possible in the CTM system.

Trademarks consisting of "combinations of colours" should be registrable within certain parameters. Single colour's protection (i.e., a colour *per se*) is still the subject of heated debate but the European Court of Justice (ECJ) has so far set the applicable standard in the Libertel case (case C104-01 of May 6, 2003).

**Case law**

According to the Libertel decision, the correct way to file colour trademark is to indicate their Pantone code: "A colour *per se*, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1) (b) and Article 3 .... provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, equally accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognized identification code." This indicates that the scope of protection granted by single colour marks is extremely limited and should be construed quite narrowly.

In light of the Libertel case and principles, and in particular considering that "the fact that registration as a trademark of a colour *per se* is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of the particular case, to assessing both the distinctive character of the colour in respect of which registration is sought, and whether registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought" (CITE), there is a strict interdependence between colours and goods, but not much attention has been paid to it.

The ECJ also paid special attention to the inherent distinctiveness of the colour sign. The ECJ considers that colours possess little inherent capacity for communicating specific information, in particular as to the origin of a product or service (grounds 39-40). Nonetheless the ECJ rules that a colour *per se* may be found to possess distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of the Directive, provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service for which registration is sought (ground 69). This means that a colour sign must have acquired distinctive character before it can be registered.

The ECJ furthermore acknowledges a public interest in not unduly restricting the availability of colours for competing companies who offer for sale goods or services of the same type as those in respect of which registration is sought (Libertel, grounds 55 and 60).

According to the Libertel case, the graphic representation of a colour mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Merely reproducing the colour in question on paper does not satisfy these requirements, whereas using an internationally recognized colour code does. Colour signs have little inherent
distinctive character and must therefore have acquired distinctive character before they can be registered.

Libertel has been further confirmed by the Heidelberger case (ECJ 24 June 2004, C-49/02) where the ECJ confirmed its reticence regarding the registration of signs consisting of combinations of colours. It ruled that the applicant will have to prove that it has been established that, in the context in which the colours or combinations of colours are used, those colours or combinations of colours in fact represent a sign, and that the application for registration should include a systematic arrangement associating the colours concerned in a predetermined and uniform way.

In conclusion, under current ECJ case law, colour per se registrations, which might have been granted without a showing of acquired distinctiveness, are strongly suspect and most likely invalid.

2- Registrability of (Shape) 3D Marks

The registrability of 3D marks under art. 3(1)(e) of the Harmonization Directive is subject to the evidence that the sign does not consist exclusively of a shape imposed by the very nature of the goods, of a shape of goods, which is necessary to obtain a technical result or of a shape which gives substantial value to the goods.

Case law

The standard has been set by the ECJ (case C-299/99, Philips v. Remington of 18 June 2002). In Philips, the ECJ ruled that Article 3(1)(e) pursues an aim which is in the public interest, namely that a shape whose essential characteristics perform a technical function and were chosen to fulfill that function may be freely used by all. This provision prevents such signs and indications from being monopolized by one undertaking alone because they have been registered as trademarks (ground 82).

The ECJ furthermore held that Article 3(1)(e), second indent, of the Directive must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable pursuant to that Article, if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes that allow the same technical result to be obtained (ground 84).

In a recent case regarding a bottle containing liquid detergent for wool (ECJ 12 February 2004, C-218/01, Henkel) the ECJ ruled that three-dimensional (3D) marks, consisting of the packaging of a product, which for reasons related to the nature of the goods (no intrinsic shape) are put on the market in a packaged form, the packaging of the goods is to be considered equivalent to the shape of the goods in the meaning of Article 3(1)(e) (ground 37).

The exception of Article 3(1)(e) has an absolute character. It applies even if a 3D sign has (acquired) distinctive character. If a 3D sign passes the test of Article 3(1)(e), its distinctive character still needs to be proven before it can be registered (Article 3(1)(b)). The same goes for the other absolute grounds for refusal of Article 3(1)(c) and (d) (ECJ 8 April 2003, C-53/01 to C-55/01, Linde, ground 45).

The criteria for assessing the distinctive character of 3D trademarks are no different from those to be applied to other categories of trademarks (Philips, ground 48 and Linde,
However, in practice it appears to be more difficult to prove distinctiveness due to the fact that 3D trademarks are less capable of distinguishing goods or services than word or figurative trademarks (Linde, ground 48). In Henkel (ground 52) the ECJ adds that only a trademark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character.

As it did in Libertel, the ECJ stresses the public interest that all 3D shape of product trademarks, which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of Article 3 (1)(c), should be freely available to all (Linde, ground 77).

In conclusion, if one of the absolute grounds of refusal of 3D marks applies, the sign is unregistrable, even if it has (acquired) distinctive character. These absolute grounds of refusal cannot be overcome by establishing that with other shapes the same technical result can be obtained. Once the test of art. 3(1)(e) is passed, the applicant still needs to prove that the mark has actually acquired distinctive character in the entire Benelux before it can be registered.

**ALBANIA**

1. **Registrability of Colour Marks**

It is possible to register colour trademarks, either one colour or a combination of colours, without any special design or shape.

The Albanian Trademark Law imposes no restrictions to this protection.

2. **Registrability of (Shape) 3D Marks**

The shape trademarks are also registrable in Albania, without any restrictions.
3. **Case Law**

No case law has been published so far in relation to the above mentioned marks.

**AUSTRIA**

1. **Registrability of Colour Marks**

Under Austrian trademark law colours can be registered as trademarks, even a colour *per se*. In accordance with the decision of the European Court of Justice re **Libertel** the Austrian courts require, that the graphic representation of the colour must be clear and permanent. It is therefore not sufficient, to print the colour on paper. The colour must be identified by an internationally recognized colour code. In addition, to be registrable the colour must be capable of distinguishing the goods and services of one undertaking from those of an other undertaking (*cf.* Austrian Supreme Court, Decision of July 6, 2004, 4 Ob 126/04k).

2. **Registrability of (Shape) 3D Marks**
Section 1 of the Trademark Act expressly mentions the shape of goods and their packaging as sign, which may be registered as a trademark. On the other hand, § 4 sec. 1 cif. 6 Trademark Act excludes the registration of signs that consist only of a shape resulting from the nature of the goods themselves, or which is necessary to obtain a technical result or which gives a substantial value to the goods. The Austrian Administrative Court has confirmed that the distinctiveness of shape marks for packaging shall be determined according to the same criteria that apply to other types of trademarks. There is no justification to use a more restrictive approach (Administrative Court, Decision of April 23, 2003, ZI 2001/04/0105).

However, it has to be established under the particular circumstances of each case, whether the shape is perceived as an indication of origin or whether it makes part of the overall product design, so that the consumer is unable to perceive it as a trademark (Austrian Supreme Court, Decision of January 2, 2004, 4 Ob 222/03f).

3. Case Law

There are no published decisions so far regarding use of shape marks or colour marks.

A recent decision of the Austrian Supreme Court concerned the colour mark YELLOW registered the Austrian Post in class 39 for “transportation services, namely delivery of letters and parcels.” In a newspaper advertisement in the name of the Swiss Post used an almost identical yellow colour together with the term “Swiss Post” and additional design elements to offer its services in Austria. The Austrian Supreme Court held, that the colour yellow was used in the manner of a trademark emphasizing the reference to postal services of the Swiss Post. However, the additional word element “Swiss Post” and the design element of the advertisement made clear, that the Swiss Post is advertising services in Austria. Therefore the court denied danger of confusion (Austrian Supreme Court, Decision of July 6, 2004, 4 Ob 136/04k).

As far as shape marks are concerned a recent decision of the Austrian Supreme Court deals with the shape of water bottles. The plaintiff owned a registered trademark for the shape of its bottle for mineral water, which shows a typical design consisting of 3D horizontal waves. The defendant sold mineral water in bottles with a similar design. Although the defendant’s bottles were covered with a striking label bearing the trademark JUVINA, the court confirmed danger of confusion. The 3D waves, which made part of the defendant’s bottle were nevertheless recognized and perceived as an indication as to the origin of the mineral water, according to the court (Austrian Supreme Court, Decision of January 2, 2004, 4 Ob 222/03f).

**BENELUX**

1. Registrability of Colour Marks

Yes, colour marks are registrable. In accordance with the First Trade Mark Directive (89/104/EEC) ("Directive"), Article 1 of the Benelux Trade mark Act (BTA) states that all signs (therefore also colour signs) can form trademarks provided that such signs can be represented graphically and that they are capable of distinguishing the goods or services of an undertaking. Furthermore, as for all signs, absolute grounds for refusal apply.

2. Registrability of (Shape) 3D Marks
Yes, shape marks are registrable. Apart from the general limitations mentioned above, the second paragraph of art. 1 BTA - based on Article 3(1)(e) of the Trade mark Directive - should more specifically be taken into account. This Article excludes from registration signs which consist exclusively of

- the shape, which results from the nature of the goods themselves; or
- the shape of goods, which is necessary to obtain a technical result; or
- the shape, which gives substantial value to the goods.

3. Case Law

Colour Marks

Although some lower national courts seem to incline to a more lenient interpretation of the ECJ’s requirements for registration, especially where it regards existing colour marks, the Benelux jurisprudence generally appears to agree with, or at least to follow the subsequent decisions of the ECJ and CFI on colour marks. The standards for registration as initially laid out in the ECJ’s Libertel decision of 6 May 2003 are quite closely adopted by the Benelux Trademarks Office. A few recent cases may be of interest:

In a Belgian case about a colour mark for Champaign (Brussels Court of Appeal, 9th Chamber, 24 June 2004 (Veuve Clicquot)), the court had to determine what the consequences are for (pre-Libertel) colour mark registrations that do not meet all the (new) requirements for registering colours as trademarks. The court held that the proprietor of an existing trademark registration should be allowed to correct the registration by adding a description of the colour by means of an internationally recognised identification code.

However, the Benelux Trademarks Office has already indicated that it will not register any amendments to existing colour mark registrations. A stalemate that can probably only be resolved by a decision of the ECJ or the Benelux Court of Justice.

In another case about liquor bottles, the Court of Appeal of Den Bosch granted trademark protection to the basic colours of the brown capped white Malibu bottle (Hof 's-Hertogenbosch, 29 July 2003, IER 2004/9 (Malibu)). The court decided that white is indeed a colour and that the two-dimensional depiction of the standard, label-less, bottle in the aforementioned colour combination constituted a valid colour and shape mark. No further descriptions or classification codes were required.

In a case about the colour mark of a well known energy drink (Vzngr. Rb Utrecht 23 October 2003, IER 2004/44 (Red Bull) ), the District Court of Utrecht ruled that the Libertel decision does not imply that a colour trademark consisting of two colours has to be specified according to an internationally recognised colour classification code. A description of the trademark can be sufficient. (The more recent ECJ decision in Heidelberger Bauchemie disagrees with this opinion, but the issue has not yet resurfaced in Benelux jurisprudence) In the case at hand, the court found that the colour combination used by Red Bull, blue and silver, had acquired distinctive character as a result of its extensive and exclusive use during a considerably long time.

Shape (3D) Marks
Just as with colour marks, the Benelux jurisprudence generally appears to agree with, or at least to follow the subsequent decisions of the ECJ and CFI on 3D marks.

Officially the criteria for assessing the distinctive character of 3D marks do not differ from those that must be applied to other categories of marks. In daily practice, however, 3D marks are less frequently considered to be distinctive. The shape of goods does not usually have an inherent distinguishing capacity, unless they differ significantly from what is common in the market. On the other hand, a (fairly common) shape of a product can acquire distinguishing character through exclusive use.

A case worth mentioning is a case about the shape of an ice cream (Rb. Den Haag. 28 may 2003 (Unilever v. Arctic)), in which the lower court refers to the Philips and Linde rulings of the ECJ. In compliance with Linde, the court stresses that 3D trademarks do not have inherent distinctive character, because a consumer will not usually regard the shape of the product as an indication that it originates from a particular undertaking. However, the litigious taco shape for ice cream had eventually acquired distinctive character through extensive use.

The preliminary relief proceedings in a case about chip-shapes (vzr Rb. Utrecht, 1 april 2004, IER 2004/58 (Bugles)) are of interest in relation to the grounds of exclusion laid down in art. 1 Benelux Trademarks Act. The court ruled that the conical shape of a savoury snack was not necessary to obtain a technical result (the shape was said to be facilitating sauce dipping only) and constituted a valid shape mark.

In a case concerning the shape of trousers (District Court of Amsterdam, 3 maart 2004 (G-Star v. Poelman)) the court decided that a 2D representation can be enough to visualise a 3D shape. However, the litigious shape was decided to have an essentially aesthetic and decorative value and could therefore not be regarded as a valid trademark.

4. Practical Implications

The recent landmark ECJ decisions on colour and 3D trademarks will most probably have consequences for both registered Benelux trademarks and trademarks still to be registered. It might very well be that a court - upon request of a third party – declares existing non conventional trademarks which do not comply with the requirements as set out and interpreted by the ECJ (such as colour marks without an international colour code) null and void.

Since existing trademark registrations can, according to art. 10 BTA, not be amended, it is highly recommendable for trademark holders relying on protection of such non conventional trademarks to apply for a new registration, in order to ensure that their registration is valid. It could even be argued that, since certain restrictions on trademarks are possible (for example the deletion of certain classes of goods) adding a colour code should be permitted by the Benelux Trademark Office (BTO), since this can also be considered to be a restriction. This is worth trying, especially in cases where it is important to keep the first registration date. For the moment, the BTO does not allow amendments with regard to the colour of a trademark, but it is certainly not unthinkable that a court of law will overrule the BTO on this issue.

When registering a new trademark, the following needs to be observed. The BTO might refuse to register colour marks and 3D marks if they do not comply with the requirements as set out and interpreted by the ECJ or if it cannot be proven that these marks have actually acquired distinctive character in the entire Benelux before registration.
Although non conventional marks might have less inherent capacity to distinguish, it has not been decided by the ECJ that they have none at all. It could therefore be argued that it would not be the right approach to always request a party to prove that the respective mark has acquired distinctive character, let alone that this distinctive character must, as yet, have been acquired in all three Benelux countries.

**REPUBLIC OF BOSNIA-HERZEGOVINA**

1. **Registrability of Colour Marks**

   It is possible to register colour trademarks and no restrictions are imposed. However, no colour trademark application was filed so far, according to the Bosnian records.

2. **Registrability of (Shape) 3D Marks**

   The shape trademarks are also registrable in Bosnia, without any restrictions.

3. **Case Law**

   No case law has been published so far in relation to the above-mentioned marks.

   However, in relation thereof, an interesting example of a potential could be mentioned, dealing with an infringement of a colour trademark for MILKA chocolate. Once received the cease and desist letter, the infringers stopped using the colour violet for chocolate, therefore there was no case before the competent authorities.

**BULGARIA**

Single colour marks are not, on their own, registrable, although colour combinations certainly are. There are, however, two single colour marks that enjoy protection in Bulgaria, but the Court has interpreted these as having acquired distinctiveness together with the fact that they are also represented as part of the geometrical figure. On of them is the purple of the MILKA trademark.

In essence, acquired distinctiveness is required for colour marks to be protectable.

3-D marks are registrable under Bulgarian law. There have, as yet, been no cases relating to 3-D marks.

**CZECH REPUBLIC**

1. **Registrability of Colour Marks**

   Prior to April 2004 it was not possible to register colours as a trademark in the Czech Republic. This was true even if the applicant could prove that the colour had acquired distinctiveness.

   The amendments to the Czech Trademark Act, which entered into force in April 2004, have now changed that situation. The law now expressly provides that a trademark
registration may consist of a colour. It remains to be seen, how the Czech Patent Office will apply that new provision.

2. Registrability of (Shape) 3D Marks

It is possible to have goods or their packaging registered as a 3D trademark under Czech Trademark Law. However, so far the Czech Patent Office has applied a rather restrictive approach. Three-dimensional trademarks for rather conventional designs were usually rejected due to lack of distinctiveness. This bar to registration could only be overcome if the applicant could prove acquired distinctiveness.

3. Case Law

Given that legal situation there are only few registered colour marks and shape marks in the Czech Republic. There is no published case law regarding serious use of such marks or infringement.

**CYPRUS**

1. Registrability of Colour Marks

There is no special provision in the legislation for the registration of colour trademarks *per se*. In practice however such applications are allowed. The Registrar will examine such applications as any other application provided it is identified by its international designation number. Distinctiveness is the major obstacle for registering such trademarks and the Registrar has not yet accepted such applications.

2. Registrability of (Shape) 3D Marks

Legislation (amendment of Law No. 176(I)/2000) allows the registration of the shape of the product for which protection is sought and is distinct from other products and is being used or is intended to be used for the purposes of such distinction.

The representation of the trademark should include the images of the dimensions in a row in one single representation.

3. Case Law

No case law is reported yet.

**DENMARK**

1. Legislative Provisions

Pursuant to the Danish Trademarks Act Section 2, a trademark may consist of any sign capable of distinguishing the goods or services of one enterprise from those of other enterprises and capable of being represented graphically. The definition does list specific examples of permissible trademarks, namely:

- words and word combinations, including slogans, personal names, company names or names of real property;
- letters and numerals;
- pictures and designs; or
- the shape, equipment or packaging of the goods.
All signs that can be represented graphically are registrable. Trademarks that consist exclusively of a shape dictated by the goods themselves, a shape of goods necessary to obtain a technical result or a shape giving substantial value to the goods are excluded from registration.

2. Registrability of Colour Marks

It is possible to register colour mark but so far no colour trademarks have been registered. Colours for goods must have achieved distinctiveness through use before they can be registered. Applications for colours can be registered for services if they are considered to be distinctive for the services in question.

Samples of the colour may be filed and the application shall refer to a colourimetric code or another kind of internationally recognized identification code for the colour(s). The Danish PTO requests that applicants refer to such codes. The mark may be considered inherently distinctive in relation to services but not to goods.

As such, colours are not denied registration. However the colour applied for has to be assessed in connection with the goods and services applied for. Therefore, some colours may be denied if they lack distinctive character for the goods and services.

For example, the colour green or the word “green” will probably be denied registration for garden equipment or services related to the environment on the basis that there is a need to keep them free for general use since this colour is already quite commonly used in connection with these goods. If the colour is not commonly used in connection with the goods applied for, it may be possible to register the colour per se.

If the mark contains a distinctive element, for example a distinctive word, this element will confer the required distinctiveness to the mark as a whole. This does not mean that the specific elements, e.g., the colour, are protected as such.

3. Registrability of (Shape) 3D Marks

Any form, which can be represented graphically may be accepted for registration. In the application form it is possible to mention that the mark is a 3D-mark. The criteria for assessing the registrability of a 3D sign are the same as for more traditional trademarks. In practice this means that the relevant market will be taken into consideration. Consequently, these kinds of marks have to be more special before they are considered distinctive. It may be possible to have a 3D trademark registered without showing any form of use prior to the registration.

Simple geometrical shapes like cylinders and squares are denied registration on the basis that there is a need to keep them free for general use. The Danish Trademark Act does not mention that these kinds of shapes cannot be registered but it is interpreted into the criteria of distinctiveness that the mark cannot be registered if it is a simple geometrical shape.

If the mark contains a word, which is distinctive, then this will add to the level of distinctiveness for the mark as a whole. If the mark is registered just because of the distinctive element, then the non-distinctive part (the shape) will be asserted as such in a conflict. If the elements that had no distinctiveness when they were registered have later achieved distinctiveness through use, then this will be taken into account in a conflict.
If the shape of a mark is dictated solely by a technical function, the mark cannot be registered. The Danish Trademark Act mentions that a trademark right shall not be acquired for signs that consist exclusively of a shape of goods, which is necessary to obtain a technical result.

With the differences described above, non-traditional trademarks are treated exactly the same way as traditional trademarks. The scope of protection for non-traditional trademarks has only been tested to a very limited extent in Denmark. In a conflict concerning trademarks it may be possible to claim protection according to the Marketing Practices Act and the Copyright Act, if relevant.

In principle, it has no influence on the registrability that consumers may not understand the non-traditional trademark. However, the examiners are likely to take this aspect into consideration if they will conclude that the mark lacks distinctiveness. It may also have influence on the possibility to enforce the trademark. Non-conventional trademarks may also (more than other types of trademarks) face the risk of dilution.

It has no influence on the registrability that consumers may not understand the non-traditional trademark as an indicator of origin.

General Remarks

In general the Danish practice is very much in line with the practice of OHIM. Please note that in all material aspects the practice described above is the administrative practice. Until now the Danish Board of Appeal and the Danish Courts have only to a very limited extent taken any decisions on both registration and the scope of protection of the described non-traditional marks.

4. Case Law

BLUE BOTTLE
The Danish PTO refused to register Bacardi's bottle in Class 33 on the grounds that the trademark was a representation of the container of the goods without any characteristic function, and thus the mark lacked sufficient distinctiveness. The Board of Appeal reversed the decision on the grounds that the mark was sufficiently distinctive. The decision of the Board was influenced by the registration of the mark as a CTM.

BOX
Following the refusal of registration of a container the Board of Appeal reversed the decision stating that the characteristic (peculiar) geometric shape might be appropriate to act as a characteristic for the goods applied for in Class 30. The decision was somewhat influenced by registrations of the box in other countries.

BAR OF SOAP
The Board of Appeal reversed the PTO's decision, finding that the mark, which looked like a bone, was sufficiently distinctive for soap in Class 3 to distinguish it from the competitor's goods.

ESTONIA

1. Registrability of Colour Marks

The Estonian Trademark Act provides for the registration of colour trademarks in Estonia. The only requirement is that the mark be graphically represented. A colour trademark is not registrable if it is lacking in distinctive character. Article 9.1.2 of the Estonian Trademark Act
provides that a trademark applicant seeking to register a mark represented by a single colour will have their application absolutely refused on the grounds that the mark is lacking in distinctiveness.

2. Registration of (Shape) 3D Marks

The Estonian Trademark Act provides for the registration of shape trademarks in Estonia. Once again, the only requirement is that the mark be graphically represented. A 3D trademark is not registrable if it is lacking in distinctive character. Concerning 3D trademarks, the primary reasons for a finding that a mark is lacking distinctiveness include the following:

- the mark consists exclusively of a shape dictated by the nature of the goods themselves;
- the mark consists exclusively of a shape necessary to obtain a technical result;
- the mark consists exclusively of a shape which provides substantial value to the goods; or
- the mark consists exclusively of signs or indications which have become customary in the bona fide and established practices of the trade.

3. Case Law

It should be noted that the institution of the Estonian legal system is rather recent and that the first Estonian Trademark Act did not come into effect until October 1, 1992, therefore, the number of court rulings is small. In this regard, there have been no cases, court rulings, or decisions of the Industrial Board of Appeals to date dealing with infringement, registration or otherwise of colour trademarks.

There have been two relevant decisions of the Estonian Industrial Board of Appeals concerning 3D trademarks.

- **DECISION No. 345-o of June 5, 2000**: The applicant, COMPAGNIE GERVAIS DANONE, filed a complaint against the decision of the Estonian Patent Office, whereby the Estonian Patent Office had issued the decision on a partial refusal of registration of the figurative trademark (see attachment 1), i.e., with respect of some goods in class 29 based on the fact that the shape of a cup had become customary in the packaging of the goods under question (e.g. milk beverages, etc.). The applicant stated that the packaging provided in the trademark application was not used by any other producer in the Estonian market and therefore, the shape of a packaging could not have become customary. The Board of Appeals cancelled the decision of the Patent Office on the basis of the violation of the procedural provisions of the legislation.

- **DECISION No. 562-o of February 12, 2003**: The applicant, Bacardi & Company Limited, filed a complaint against the decision of the Estonian Patent Office, whereby the Estonian Patent Office had requested a disclaimer against the shape of a bottle, represented by the figurative mark (see attachment 2), as the shape of the bottle had become customary in economic and business activities. The Board of Appeals did not disturb the decision of the Patent Office.
<table>
<thead>
<tr>
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<th>9700168</th>
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<th>Applicant</th>
<th>COMPAGNIE GERVAIS DANONE, société anonyme</th>
</tr>
</thead>
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<tr>
<td>Class 5</td>
<td>meditsiinilised dieetained; imiku-, väikelaste- ja lastetoidud.</td>
</tr>
<tr>
<td>Class 29</td>
<td>konservitud ja kuumtöödeldud juur- ja puuvili; moosid ja konfitüürid; kõik meierei- ja piimatooted, mis kuuluvad sellesse klassi, eelkõige või, võikreem, margariin, rõõsk koor, juust, desserktreemid, tordid, magustoidud, vahukoor, kohupiim.</td>
</tr>
<tr>
<td>Class 30</td>
<td>lehttainas, maiustused, kondiitritooted, toidujää, mesi, suhkrusirup, vürtsikastmed, sinep.</td>
</tr>
<tr>
<td>Class 32</td>
<td>alkoholivabad joogid.</td>
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ATTACHMENT 2

EXTRACT FROM THE ESTONIAN TRADEMARK REGISTER

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<tr>
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<tr>
<td>Application number</td>
<td>M200000349</td>
</tr>
<tr>
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<td>03.03.2000</td>
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<tr>
<td>Status</td>
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<tr>
<td>Expiration date</td>
<td>18.06.2013</td>
</tr>
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<td>Publication date</td>
<td>01.03.2002</td>
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<tr>
<td>Kind</td>
<td>Figurative mark</td>
</tr>
<tr>
<td>Colours claimed</td>
<td>Blue, light blue, light orange</td>
</tr>
<tr>
<td>Disclaimer</td>
<td>The trademark registration does not establish the exclusive rights to the outer shape of a bottle.</td>
</tr>
<tr>
<td>Owner</td>
<td>Bacardi &amp; Company Limited (a corporation of the Principality of Liechtenstein), Millar Road - New Providence BS</td>
</tr>
<tr>
<td>Class 33</td>
<td>alkoholjoogid, sh dzinn.</td>
</tr>
</tbody>
</table>

FINLAND

1. Registrability of Colour Marks

Both colours per se and combinations of colours are registrable under the Finnish Trademark Act (1964/7, as amended). For example:

- Finnish Registration No. 220696 Colour blue, Pantone 280 C
- Finnish Registration No. 227503 Colour orange, NCS S1080-Y40R
- Finnish Registration No. 229870 Colours orange and black
- Finnish Registration No. 229871 Colours orange and black
- International Registration No. 771164 Colours light blue, azure blue, dark blue

It has proved difficult to show a colour has the sufficient distinctiveness required for a trademark registration. Thus, the applicants have had to show distinctiveness acquired through use. The colour marks that have so far been registered have been used for decades in relation to particular goods.

Furthermore, the applications for only one colour have required vast proof of distinctiveness acquired through use, whereas in applications for combinations of colours, lesser amount of proof of distinctiveness acquired through use has been sufficient. Nevertheless, many applicants have failed to show distinctiveness acquired through use.

2. Registrability of (Shape) 3D Marks

Only sufficiently original 3-D marks can be registered. However, in comparison, many more 3-D marks than colour marks have been registered. For example:
3. **Case Law**

We are not aware of any enforcement cases related exclusively to colour or 3-D marks in Finland. However, one case involving a registered design and a 3-D trademark implies that in such cases the scope of protection provided for the 3-D mark is very limited. It is likely that marks will be protected only against registration of identical colour or shape for same and maybe similar goods and services. In addition to the 3-D trademark case mentioned earlier this can also be seen from the co-existence of Finnish Registration No. 220696 Colour blue, Pantone 280 C and International Registration No. 771164 Colours light blue, azure blue, dark blue for same and similar products.

**FRANCE**

1. **Registration of Colour Marks**

Article L711-1 of the French Intellectual Property Code (CPI) provides that:

“A trademark or service mark is a sign capable of graphic representation which serves to distinguish the goods or services of a natural or legal person. The following, in particular, may constitute such a sign:

c) Figurative signs such as: devices, labels, seals, selvedges, reliefs, holograms, logos, synthesized images; shapes, particularly those of a product or its packaging, or those that identify a service; arrangements, combinations or shades of colour.”

Registration of marks consisting of a shade of colour is accepted by the French Trademark Office. Case law requires that the shade of a single colour be precisely identified, for instance by means of an international code such as Pantone. A sample of the colour is therefore not sufficient. This is in line with the criteria set out by ECJ case law for a colour trademark to be validly registered (i.e., “clear, precise, easily accessible, self-contained, intelligible, durable and objective graphic representation”).

Combinations of colours are also accepted for registration, with a colour representation of the proposed mark. Case law requires the colours to be arranged in a specific way in the application for registration. But following the judgement of the ECJ of June 24, 2004 in the Heidelberger case, it would not be surprising that, in a near future, French Courts also require the shade of the colours to be also specifically identified, as for a shade of single colour.

In any case, the scope of protection of colour trademarks is generally rather narrow.

**Colour Marks Case Law**

The following are some illustrative decisions:
The shade chosen by the company Candia SA being precisely described, Pantone 212, the sign is therefore sufficiently determined. [Paris Court of Appeal, November 25, 1998 – PIBD 1999 672 III 114]

Although the description of the trademark and of its colours is optional, the company Neymann cannot rely on the absence of such a description to try to prevent its competitors from using brown and yellow colours, whatever their shade and arrangement, as it would result in a monopoly on these colours [Colmar Court of Appeal, April 5, 2000 – PIBD 2000, 708 III 561]

When a trademark is composed of a combination of colours arranged in a specific way, the scope of protection cannot extent to the use of other colours. [Paris Court of Appeal, Burburry, June 10, 1998, PIBD 661 III 468]

If its registration does not give to Candia a monopoly on the colour pink, the fact remains that the shade of pink is very close to the registered colour, whereas it was possible to choose other shades of pink. So, the visual similarity of the involved colours creates a likelihood of confusion in the public's mind which can be led to attribute them to a common origin [Paris Court of Appeal, June 9, 2004- PIBD 2004, 796 III 621].

2. Registration of (Shape) 3D Marks

Shape trademarks are registrable. See Article L711-1 CPI cited above. There are no limitations or specific conditions to take into consideration except where the sign is exclusively constituted by the shape imposed by the nature or function of the product or gives the product its substantial value (Article L711-2 § c CPI).

For the moment, shapes and 3D trademarks can be easily registered in France without objection as to their inherent distinctiveness. But one can reasonably expect French Trademark Office and courts to be influenced by ECJ case law on this issue. Thus, in a near future, the Trademark Office may consider that, since the average consumer is not used to identify the origin of goods by their shape or the shape of their packaging, every shape trademark is not distinctive enough to be accepted for registration in the absence of additional word or device elements.

Shape (3D) Case Law:

About Distinctiveness:

To be validly filed as a trademark, the shape of a packaging must be distinctive, i.e. it must show arbitrary and fanciful characteristics so that the public can distinguish the goods or services from others which have another origin [District Court of Créteil 25/03/03, PIBD 771 III 452].

About a registered 3D trademark of the shape of a pastille with a convex upper side:

...because it does not evidence [...] that the shape has been perceived as a trademark, the company Bourjois cannot rely on an alleged distinctiveness acquired through use; therefore, the three-dimensional trademark claimed by Bourjois cannot distinguish the goods from others which have another origin. [Paris Court of Appeal, March 22, 2002 – PIBD 743 III 244].

About Functionality:

A sign composed of shapes which are...functional and related to a technical result can only be accepted to the extent that it is composed of other non-functional
shapes, independent from the technical result and which are sufficiently distinctive, in the eyes of the customer, to distinguish the goods or services from others which have another origin [District Court of Paris, 13/06/03, Philips vs. Remington, PIBD 776 III 612].

GERMANY

1. Registrability of Colour Marks

In principal both combinations of colours as well as a colour per se are registrable under German practice, provided that they have distinctive character for the goods or services in question. Section 8 sec. 2 sub sec. 1 Trademark Act excludes the registration of trademarks which are devoid of any distinctive character. The Federal Supreme Court applies the same test which has been developed to determine the distinctiveness of word marks. Even a minimal distinctiveness is sufficient. If the colour is not descriptive for the goods in questions and is not perceived by the relevant consumers as a pure decoration there is no factual basis justifying the assumption that the trademark is devoid of any distinctive character (cf. Federal Supreme Court, I ZB 6/99, WRP 2002 p. 452–Processor Cases Coloured in Green; Federal Supreme Court, I ZB 57/98, GRUR 2001, 1154–Colour Violet per se).

2. Registrability of (Shape) 3D Marks

Both goods and their packaging may be registered as a 3D trademark under German Trademark Law. However, a sign will not be registered, which consists exclusively of the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods, § 3 sec. 2 Trademark Act. Further more, a shape mark must not be devoid of any distinctive character, an absolute ground for refusal which applies to each type of trademark.

To be distinctive a packaging must somehow differ from what is common in the respective field of goods. If similar designs are used by a number of competitors, this may be a strong indication for lack of distinctiveness. For example, the German Patent Court has confirmed registrability of the DIMPLE-bottle due to its original shape (Federal Patent Court, GRUR 1998, 580).

The shape of a good itself may be registrable provided that the consumer will perceive it also as an indication as to the origin of the good. If the shape consists of characteristic elements which go beyond typical shapes and elements which are technically necessary for such kind of goods, this is usually sufficient to assume that the shape is distinctive. As far as esthetic designs are concerned the courts examine whether or not such a design is common within the relevant field of goods. For example registrability of the shape of a watch has been denied since it consisted of a combination of common design elements and was therefore devoid of any distinctive character although this specific combination of design elements had not been used by any competitor so far (Federal Supreme Court, GRUR 2001, p. 418–Montre).

3. Case Law
Shape marks must be used three-dimensionally. A two-dimensional representation will not be recognized as serious use of the mark as it is registered.

As regards trademarks which consist of a colour *per se* it is still to be decided, how such trademarks need to be used to maintain protection. Some legal authors take the view that such marks need to be used in new figurative designs again and again while other authors hold that use of the colour in one single form should be sufficient.

In two recent decisions the Federal Supreme Court has given a ruling on several aspects of infringement of colour marks (Federal Supreme Court, GRUR 2004, p. 151 – Colour mark infringement I; Federal Supreme Court, GRUR 2004, p. 154 – Colour mark infringement II). The plaintiff was Deutsche Telekomm AG who owns trademark registrations for the colour “magenta” and has also established trademark rights in this colour by intensive use. The competitor Mobilcom had used an almost identical colour in several advertisements. In particular the advertising slogan, the price and the dial-in number of Mobilcom where printed in that colour. Mobilcom had denied trademark infringement arguing that it did not use the colour magenta in the manner of a trademark. The Federal Supreme Court held that a trademark infringement can only be confirmed, if the design of the advertisement and the use of the colour in the advertisement makes the customer perceive the colour as an indication as to the origin of the services offered. The court took the view that colours used in an advertisement are usually not considered as an indication as to the origin of the services offered. However, under particular circumstances it may be possible, that the colour stands out and is perceived as a trademark. In that particular case the court found, that the colour “magenta” was unusual for telecommunication services, it was the house colour of Deutsche Telekomm AG and had only been used by this company so far. The colour enjoyed a recognition of at least 58 per cent at that time. Under these particular circumstances the use of the almost identical colour by Mobilcom in its advertisements constitutes use in the manner of a trademark, according to the court.

In a similar case the owner of a colour mark for the colour “purple” intensively used for MILKA Chocolate proceeded against the use of a similar colour on the packaging for chocolate cookies. The Higher Regional Court of Bremen confirmed a trademark infringement in view of the intensive use of the colour purple on MILKA Chocolate packagings and its high recognition among consumers (Higher Regional Court of Bremen, WRP 2002, 460 – Purple packaging).

As far as shape marks are concerned a number of published decisions relates to the alleged infringement of the shape of ball point pens. The Higher Regional Court of Frankfurt confirmed, that the clip of a WATERMAN-pen, which shows a typical slit lengthways, is perceived as an indication as to the origin of the pen and an imitation of such a clip may therefore constitute a trademark infringement (Higher Regional Court of Frankfurt, MarkenR 2001, 162 – Product catalogue).

A recent decision of the Federal Supreme Court deals with packaging for chocolate in the shape of gold ingots. The plaintiff owns a 3D trademark registration for a respective shape mark consisting of the form of the packaging and the word “Gold,” while the alleged infringer used a chocolate packaging of the same shape and the additional word mark “Feodora” on it. The court held that in the field of chocolate the shape of packagings mainly serves functional and esthetic purposes. Therefore the customer is not used to perceive such packagings as an indication as to the origin of the chocolate. For that reason both packagings are dominated by the word elements, “Gold” on one hand and “Feodora” on the other hand, which are clearly different. Thus, the court denied a trademark infringement (Federal Supreme Court, WRP 2003, 889 – Gold ingots).
GREECE

1. Registrability of Colour Marks

Colour *per se* and not accompanied by other elements lacks distinctive character, consequently, can not be accepted for registration. However, in certain conditions and particularly if the colour sign has been established in the market, the Trademark may be accepted for registration by the Administrative Committee. Nevertheless, the courts do not share this view and do not accept such registrations until now. In a fairly recent Decision of the Administrative court of Athens on a matter of a colour *per se* Trademark, the Court upheld the refusal by the Administrative Committee of Trademarks of the colour green for electrical equipment and/or conduit application boxes in Class 9 since the trademark consisted of a simple colouring, without any other design or original formation and therefore lacks distinguishing power.

2. Registrability of (Shape) 3D Marks

According to Article 1.1.2 of the Greek Trademark Law, 3D Trademarks are accepted for registration under the reservation of Article 3.1.e, which states that Trademarks are not accepted if they consist exclusively of the shape, which results form the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape, which gives substantial value to the goods.

3. Case law

No case law reported

HUNGARY

1. Registrability of Colour Marks

Colour marks are registrable. The Hungarian Trademark Regulations (Act XI of 1997 on the Protection of Trademarks and Geographical Product Markings) states that any sign that can be graphically represented and is suitable for distinguishing goods and services from other goods and services can be protected by a trademark.

This Act provides an exhaustive list on the types of signs that may be protected as a trademark: word, combination of words, including personal names and slogans; a letter, a number a diagram, a picture; a flat or 3D figure, including the shape of goods, or packaging; a colour, a combination of colours, a light signal, a hologram; a sound, as well as a combination of the individual signs listed above.

Any other signs not mentioned in the list of the Act were excluded from trademark protection. However, the amendment of the trademark act (introduced when Hungary joined the European Union in May 2004) has provided a list of examples of signs that may be subject to trademark protection for those signs that were not mentioned in the Trademark Act.

In the case of non conventional trademarks the following two issues are worth mentioning:

i) the distinctive character of the mark and
ii) the prohibition on the monopoly of commonly used marks on the basis of public interest purpose and in view of the possible violation of the fair competition rules.
The general aspects of the assessment of the distinctive character of trademarks do not differ from those elements concerning the so-called non-conventional trademark categories. However, strict requirements should be used in the course of examining as to whether the given non-conventional trademarks have a distinctive character.

The underlying reason is that the perception of consumers differs in the cases of trademarks having the shape and colour of their product from the cases involving word marks. While consumers are used to the fact that the purpose of word trademarks are to identify the product, this is not necessarily the case if the trademark forms an inseparable unit with the exterior of the goods (e.g., in the form and colour).

With regard to the current practice of the European Court of First Instance as well-founded and to be followed, namely that trademark protection can be granted to non-conventional signs if such sign displays certain futures that are sufficiently unusual and arbitrary to enable the relevant consumers to recognize the product, purely on the basis of its appearance, as emanating from a specific undertaking.

Trademark protection, which may last without time limitation, given to signs for their colour and shapes lacking distinctive character would unreasonably restrict the market competition.

2. Registrability of (Shape) 3D Marks

Three-dimensional marks are registrable. See above.

3. Case law

There has been no case law regarding colour trademarks or 3D (shape) trademarks.

IRELAND

1. Registrability of Colour Marks

Section 6 of the Irish Trade Marks Act 1996 provides as follows:

(1) in this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

(2) Without prejudice to sub-section (1), a trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or of their packaging.

While registration of colour marks is not specifically mentioned, colours have been held to be registerable even under the 1963 Trade Marks Act (for example, see, Parke Davis & Co's Application 1976 FSR 195).

Colour marks have traditionally been difficult to register in Ireland as the Patent Office has been reluctant to grant a monopoly over the use of a colour in a particular industry. In addition, it has been difficult for applicants to show that a colour mark was a sign capable of graphical representation and had distinctive character. It is common for this to be shown by reference to use of that colour mark and in particular the Irish Patent Office is willing to consider survey evidence indicating that the colour has been used by the applicant as a trademark and is capable of being associated with the goods or services of the applicant by members of the public.
In addition to the above, the colour must not in itself serve a functional purpose and it should be a specific colour by reference to an international standard of colour references such as pantone references.

Finally, the application for a colour mark is also considered in light of public interest and is likely to be refused if the colour has any practical relevance to the industry in question.

2. Registrability of (Shape) 3D Marks

Section 6 of the Irish Trade Marks Act 1996 provides as follows:

(1) in this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

(2) without prejudice to sub-section (1), a trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or of their packaging."

Shape trademarks are, therefore, specifically permissible in Ireland pursuant to Section 6(2) of the 1996 Trade Marks Act.

Section 8(2) of the Trade Marks Act 1996 provides as follows:

a sign shall not be registered as a trade mark if it consists exclusively of
a. the shape which results from the nature of the goods themselves; or
b. the shape of goods which is necessary to obtain a technical result; or
c. the shape which gives substantial value to the goods.

The Irish Patent Office is also reluctant to create a monopoly over a shape by creating a trademark when the same shape would only have 10-20 years protection as a registered design. The Patent Office will follow the principles laid down in the Philips case such that the applicant will have to show that the shape has acquired a distinctive character. Consequently, when deciding upon whether the shape mark can be registered the Patent Office considers the industry and the goods that will be sold under the shape trademark. If the applicant can prove that a shape is not purely or predominantly functional and has acquired a distinctive character or is capable of acquiring a distinctive character the application will not be refused.

3. Case Law

There have been no court cases in Ireland dealing with infringement, registration or otherwise of colour trademarks.

There have been no Irish court cases dealing with the infringement, registration or otherwise of shape trademarks.

There have been some Patent Office decisions relating to applications for shape trademarks and in particular the Patent Office recently accepted that a medicinal tablet contained features that were sufficiently unusual to enable the relevant consumers to recognise, solely on the basis of its appearance, that the tablet originated from the applicant; Les Laboratoire Serbier. In this case the tablets had a distinct green colour, had a stylised '8' engraved in a heart on one side and a logo made up of a star and two triangles which was considered to give the tablets sufficient distinctiveness.
ITALY

1. Registrability of Colour Marks

Italian Trade mark law Art. 16 allows registration of any new sign which can be represented graphically, particularly words, including personal names colour combinations or tonalities, provided that they are capable of distinguishing the goods or services of one enterprise from those of other enterprises.

The language is not entirely clear and a comparison with the Harmonization Directive text does not help much since the Directive does not mention colours (Article 2 reads “A trademark 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”).

Combinations of colours (two or more) seem perfectly allowable. Registrability of a single colour does not seem entirely barred under an interpretation that reads "tonalities" as making reference to as particular shade of a colour. In other words, not simply RED, but CRIMSON RED, not BROWN, but TERRA DI SIENA, not GREEN but EMERALD GREEN and so forth.

However it is not known whether or not colours per se (either individual or tonalities) have been filed in Italy and there are not known judicial precedents. In any case, at present, even if it were possible to file an individual colour or if combinations of colours were filed, a specific search to determine their existence does not seem possible to be carried out. This is mainly due to the fact that in the official trademark applications forms, indications of colours are allowed but not required and usually everyone files for all colours and protection is granted to all colour versions.

2. Registrability of (Shape) 3D Marks

In general 3D marks (or "the shape of the goods or their packaging" as indicated in Article 16), are registrable provided that they are distinctive and do not consist exclusively of a shape imposed by the very nature of the goods, of a shape of goods which is necessary to obtain a technical result or of a shape which gives substantial value to the goods.

The Italian courts have in the past interpreted the term "exclusively" not in a very uniform way and there have been cases where a 3D mark was held valid even though the form was functional since it was proved that it was possible to achieve the result in another way.

In light of the Phillips case, some or many 3D registrations could most likely be invalid. However, the trend is not exactly clear and the practice is oscillating.

In particular there is some confusion between what is necessary to overcome objections based on the lack of distinctive character.

3. Case Law

No significant case law has been found.
LATVIA

1. Registrability of Colour Marks

The Latvian Law on Trademarks and Indications of Geographical Origin permits registration of colour trademarks. There are no limitations or specific conditions that would relate only to colour that are to be taken into consideration. Shades of colours and combinations of colours are permitted to be registered as trademarks (see Article 3, part 2 of the Latvian Law on Trademarks and Indications of Geographical Origin).

2. Registrability of Shape (3D) Marks

Three-dimensional shapes, the shapes of goods or their packaging can be registered in Latvia as trademarks. There are certain limitations in relation to shapes for registration. The Latvian Law on Trademarks and Indications of Geographical Origin provides that the following shall not be registered as trademarks:

1) those which consist solely of a shape which is directly determined by the kind of goods; or which result directly from the nature of the goods themselves; or which is necessary to obtain a particular technical result; or which gives substantial value to the goods;
2) those which are contrary to public policy or contrary to socially accepted principles of morality.

3. Case Law

a. Colour Marks

The case between Paulig Ltd. of Finland and Julius Meinl International of Austria concerned a colour trademark for the coffee PRASIDENT, with the letter "a" having a special accent mark on it (see Attachment 1). The assertion made by Paulig Ltd. during court proceedings was that both marks served to confuse consumers with respect to the products of the two producers. An assertion also was made that Julius Meinl International was not famous and employed unfair business practices to gain a better position in the marketplace. (The Austrian company registered its trademark in Latvia two years after registration by "Paulig Ltd"). The counter argument by the Austrian company was that Julius Meinl International is a major company, established in 1854, and it would be of no purpose for them to employ the practices complained of. The Decision issued by the court found that an image of a cup having a gold colour and accompanied by the word combination PAULIG PRESIDENT used on a package for coffee as produced by Paulig Ltd. differed from the image of the head of a boy in a red hat accompanied by the word PRASIDENT and would not result in the confusion of consumers. As such, the court did not grant the claim by Paulig Ltd. for cancellation of the colour trademark PRASIDENT for coffee packaging.

b. 3D Marks

On June 3, 2002, the Riga District Court granted the claim of A/S Latvijas balsams, a local producer of alcoholic drinks, including the famous BLACK BALZAM against SIA Latvijas keramika A, a local producer of clay bottles in the original shape for BLACK BALZAM (see Attachment 2). A/S Latvijas balsams applied for the registration of a clay bottle as a shape trademark.
The case concerned a request for cancellation of a 3D trademark for clay bottles used for the drink BLACK BALZAM. As may be appreciated, this case was over the right to use the bottles in Latvia and the right for exporting them. SIA Latvijas keramika A presented as a counterclaim that A/S Latvijas balzams was not a designer of the bottle/bottles of this particular type. The argument presented by A/S Latvijas balzams was that the bottles in question have been manufactured especially for the use of A/S Latvijas balzams. The counter-argument by SIA Latvijas keramika A was that this fact does not mean that A/S Latvijas balzams as drink producer is the owner of the bottle. The court did not grant the counter-claim of SIA Latvijas keramika A. Thus, under these circumstances, according to the court, the only legal owner of the 3D trademark for a clay bottle for BLACK BALZAM is A/S Latvijas balzams.
Attachment 1
LITHUANIA

1. Registrability of Colour Marks

Article 5, Paragraph 5 of the Lithuanian Trademark Law provides that a colour, combinations of colours and arrangement of colours may constitute a mark. Lithuanian Trademark law provides that a sign shall not be capable of constituting a mark in the event that it has no distinctive character.

Additionally, the Regulations on the Registration of Trademarks, No. ZR/01/2001, provide that when registering a sign, which consists only of one colour or combination of colours, a relation between the sign and the goods to be marked with such sign should be evaluated. When determining if such sign has distinctive character in respect of goods to be registered, the use of the sign and recognition in the market should be evaluated.

It also should be noted that the colour mark applied for should not perform a functional or practical role for the claimed goods or services and should not perform a competitive role in the relevant market. Therefore, it is better to claim a narrower specification of the goods or services in the application.

In Lithuania, it is possible to register a colour for certain goods if it could be proved that the colour has obtained a distinctive character and a secondary meaning in respect of the goods or has become well known. Proof of usage, evidence that other traders do not use the colour applied for and that the public recognizes the colour as an indicator of origin
(for example, through the use of survey materials) may be required by the Examiner to prove the distinctiveness of a colour mark.

2. Registrability of (Shape) 3D Marks

Article 5, Paragraph 4, of the Lithuanian Trademark Law provides that 3D forms (the shape of goods, their packaging or containers) may constitute a mark. Article 6, Paragraph 7, of the Lithuanian Trademark Law provides that a sign shall not be recognized as a mark and shall be refused registration, or the registration of a registered mark shall be declared invalid, if the sign consists exclusively of the shape that results from the nature of the goods themselves or the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods.

Furthermore, the Regulations on the Registration of Trademarks, No. ZR/01/2001, provide that an Examiner may not accept a 3D sign and should not register it, if the sign consists exclusively of the shape, which results from the nature of the goods themselves, or the shape which is necessary to obtain a technical result or the shape which gives substantial value to the goods. A sign should not be accepted as a 3D trademark, if its shape is identical or similar to the item or goods for which the application is filed (for example – a bottle, without distinctive character - for bottles); its shape describes features which are necessary to obtain a technical result; its shape reserves for the goods of the applicant a dominant position as compared with the other producers, under principles of unfair competition.

3. Case Law

Colour Marks

In Lithuania, there are very few cases where colour marks have been registered. The Lithuanian Patent Bureau has registered the brown colour in the name of UNITED PARCEL SERVICES OF AMERICA, INC. in respect of “express parcel delivery” in Class 39 following an appeal, in view of the fact that it was proved that the brown colour has obtained the fame and secondary meaning in respect of such services in a very special field of service providers.

The combination of colours white and green in a square has been registered in the name of BENDRA ĮMONĖ UAB A.SABONIO ŽALGIRIO KREPŠINIO CENTRAS in respect of sports articles and souvenirs in Classes 21, 25, 26 and for the services of arranging basketball competitions in class 41 following an appeal, in view of the fact that the combination of colours white and green has obtained the fame, distinctive character and secondary meaning in respect of basketball competition related goods and services and that consumers relate these goods and services to a certain basketball club in Lithuania.

However, the usual practice of the Lithuanian Patent Bureau is not to register a single colour or even a pair of colours in an elementary geometrical figure, such as a square.

The Examiners of the Patent Bureau claim that a single colour sign does not have distinctive character. It is their view that the mark is merely an elementary geometrical figure painted in a single colour. According to the rules of the Lithuanian Trademark Law, the mark has no distinctive character if it exclusively is made of elementary geometrical figures or lines (a triangle, circle, square, line or simple combination of these elements).
Shape (3D) Marks

In Lithuania, 3D marks are registered when they have distinctive character. There exists many trademark registrations for bottles, toothbrushes, cookies, ice-cream, shoes, etc., which have certain distinctive characteristics. There are cases where the Appeals Department has not registered 3D signs as trademarks, for example, a chair has not been registered as a trademark where the Appeal Department considered that the chair had not obtained distinctive character in Lithuania. In this case, there was not enough evidence provided that consumers relate the chair to one producer and differentiate it from other chairs in Lithuania’s market.

A review of the decisions of the Appeals Department found that there have only been about ten appeals involving 3D marks. In those cases, the Appeals Department generally requests proof that the 3D shape of the item is not common, is original, is not used by any other entity in Lithuania and, therefore, may function as a trademark.

Moreover, it is possible to register 3D trademarks if it can be proved that the 3D mark has obtained a distinctive character and secondary meaning and that consumers relate these marks to a certain producer. Proof of usage and recognition that the 3D mark is distinctive must be submitted and opinion survey data may also be required.

MADEDONIA

1. Registrability of Colour Marks

Article 124, (2) of the Macedonian Trademark Law states:

“Trademark shall protect signs suitable for distinguishing, in particular: words, letters, numerals, pictures, drawings, combinations of colours, three-dimensional forms, including shapes of goods or their packaging, as well as combinations of all the above-mentioned signs.

(3) The words and letters referred to in paragraph (2) of this Article may be written in any language and alphabet.”

Therefore, the Macedonian Trademark Law enables protection of colour trademarks. This protection is however restricted since a single colour cannot be protected, but only a combination of two or more colours.

2. Registrability of (Shape) 3D Marks

The above-quoted Article enables registrability of shape trademarks as well, posing no restrictions to this protection whatsoever. While filing an application of a 3D mark, the Applicant should submit a two-dimensional representation of the mark, and colours of the mark, if any, are to be précised.

3. Case Law

There is no published case law regarding serious use of such marks or infringement.

MALTA

1. Registrability of Colour Marks
A relatively small number of applications have been filed with the Directorate in Malta for the registration of colour marks as trademarks. The requirements to be observed by the trademark applicant in his application are relatively simple. First of all, the applicant is required to provide a clear representation of the colour mark and information on the various colours found in the mark. This information should consist in submitting the various international identification colour codes, such as in CMYK format or Pantone. It would also be important for the trademark applicant to give a short description of the colour mark, in particular of the manner of presentation of the various colours, and a clear indication of the exclusivity being sought by means of trademark registration.

2. Registrability of (Shape) 3D Marks

A good number of 3D trademark applications have been filed in Malta. The policy adopted by the Directorate has been that of first examining whether the mark may be refused registration on any of the absolute grounds of refusal found in the Act. Section 4(2) of the Act states that a sign shall not be registered as a trademark if it consists exclusively of:

(i) the shape, which results from the nature of the goods themselves,
(ii) the shape of goods, which is necessary to obtain a technical result, or
(iii) the shape, which gives substantial value to the goods.

Once a 3D trademark manages to successfully overcome or avoid being caught by any of the above grounds, the Directorate's policy is that of requesting the trademark applicant to submit sufficient evidence which shows that the mark is being used in such a manner as to distinguish the goods claimed in the application from those of other undertakings. The evidence that will be required would need to be specific to the shape of the mark itself and must show that consumers would be able to identify the goods in question by the shape of the mark on its own, i.e. without the addition of any other signs, markings or indications on the shape mark.

3. Case Law

There is no Maltese case-law dealing with colour or 3D marks.

NORWAY

1. Registrability of Colour Marks

Colour trademarks may be registered in Norway. For instance the colour pink has been registered for insulating material after the applicant documented that the colour, through long and extensive use, was well known within the circle of trade concerned in Norway as a distinctive sign for the insulating material. It is not clear how many colour marks have been registered.

The Norwegian Patent Office has been reluctant to accept registration of colour trademarks, mainly due to the difficulty of identifying specific colours and the need to keep the colours free for use. Furthermore, a colour trademark will in general not be considered to meet the requirement of distinctiveness. When applying for registration of a
colour trademark the application has to be accompanied by a written description of the
colour, a colour sample and a colour number corresponding with an international
standard.

2. Registrability of shape (3D) marks

The Norwegian Patent Office does not have an exact number of registrations but estimate
that more than 5000 shape trademarks have been registered in Norway.

The Norwegian Trade Mark Act Section 13 allows for the registration of a shape
trademark:

Trade Marks which consist exclusively of the shape of the goods or their
packaging may not be registered if the shape or the packaging results from the nature
of the goods themselves, is necessary to obtain a technical result, or imparts
considerable value to the goods.

In addition to meeting the requirement in this provision a shape trademark has to be
distinctive. A shape trademark will not be registered if the shape results from the nature
of the goods or is necessary to obtain a technical result. Likewise a shape that imparts
considerable value to the goods will not be registered.

POLAND

1. Registrability of Colour Marks

Pursuant to the effective provisions, any sign represented or capable of being represented
graphically may be considered as trademark. Furthermore, according to Polish Act of
June 30, 2000, on Industrial Property Law, combinations of colours, the 3D shape of
goods or of their packaging may be considered as trademarks.

Generally, a single colour cannot be registered as trademark. Yet, according to the
practice of the Polish Patent Office, it is possible to register a trademark that is
represented by a single colour, provided that in the Official proceedings the applicant
proves that such sign is capable of distinguishing the goods of the same kind of one
undertaking from those of other undertakings.

Usually, it is necessary to demonstrate that due to long-term use, intense promotional
actions, advertising campaigns etc., single colour acquired secondary meaning. (for
instance the single lilac colour of MILKA for chocolate in cCass 30).

2. Registrability of (Shape) 3D Marks

The situation is similar in respect of shape (3D) trademarks, as Polish law allows their
registration. Nevertheless, in this case "a right of protection shall not be granted for a
sign, if it constitutes a form or another feature of the goods or their packaging, which is
dictated exclusively by their nature, is necessary to achieve a technical result or it gives
substantial value to the goods".

Set out below are some examples of copies of 3D trademarks which enjoy national
protection in Poland.
3. **Case Law**

In an interesting development in the Polish Trademarks Registry, a decision allowing a 3D mark has been reversed, following a decision in the European Court of Justice in respect of the identical marks.

Initially, the Polish Trademarks Registry allowed a rectangular 3D mark (including as a dishwasher tablet) comprising either coloured layers or speckling in respect of goods for bleaching, soaps, detergents, dishwashers and the like. It considered there were no real grounds for objecting.

The identical mark for the identical goods, however, did not achieve registration at OHIM. OHIM considered that the sign lacked a distinctive character pursuant to Article 7(1)(b). The applicants, Procter & Gamble, appealed the decision of OHIM (in relation to the various applications for these 3D marks) all the way to the ECJ. The ECJ upheld OHIM in its decision in joined cases C-468/01 – C-472/01 and dismissed Procter & Gamble's appeals.

Following this decision, the Polish Trademarks Registry reconsidered its earlier decision to allow registration, and has reversed its original decision.

**PORTUGAL**

1. **Registrability of Colour Marks**
The Portuguese Industrial Property Code provides that a trademark may be composed of a combination of colours in a peculiar and distinctive way. However, colours per se may not be registered as trademarks. Article 223°, 1, e) of the Portuguese Industrial Property Code states that:

*The following do not meet the requirements of the preceding article (composition of trademarks):
(…)
e) colours, except when they are combined together or with graphics, wording or other elements in a particular and distinctive manner.*

As mentioned above, colours per se may not be registered. The law states that what may be registered as a trademark are combinations of colours that form a particular and distinctive sign.

2. Registrability of (Shape) 3D Marks

Three-dimensional marks are registrable. The Portuguese Industrial Property Code provides that a trademark may be composed of the shape of a product or its packaging. Article 222°, 1 of the Portuguese Industrial Property Code states that:

"A trademark may be composed of a sign, or group of signs capable of graphic representation, such as words, including personal names, drawings, letters, numbers, sounds, the shape of a product or its packaging, and which are capable of distinguishing the products the products or services of one company from those of other companies".

A trademark consisting of a shape may not consist of a shape that results from the nature of the goods themselves. Article 223°, 1, a) of the Portuguese Industrial Property Code states that:

*The following do not meet the requirements of the preceding article (composition of trademarks):

a) signs that consist exclusively of the shape resulting from the nature of the product itself, the shape of the product necessary for obtaining a technical result or the shape that gives the product its own substantial value.*

Article 223°, 2, of the Portuguese Industrial Property Code states that:

*The generic elements mentioned in a) b) and c) of the preceding paragraph, that constitute part of a trademark shall not be for the exclusive use of the applicant, unless the signs have acquired in commercial practice distinctive character.*

3. Case Law

a. Colour Marks

There has been no case law regarding colour trademarks.

b. Shape (3D) Marks
There are several decisions on shape marks, but mainly at the Patent and Trademark Office level that show the Examiners are strict when granting 3D trademarks. There is a case of a 3D mark for a medicinal product (pill) where the trademark was refused, even after the Applicant tried to prove that the shape had acquired distinctiveness.

There are also some 3D mark cases related to the shape of chocolate products where the Examiner requires sufficient proof of distinctiveness before it grants the trademark.

ROMANIA

1. Registrability of Colour Marks

The Romanian Trademark Law provides that a colour, combinations of colours and arrangement of colours may constitute a mark. In principle, only colour combinations are to be accepted for registration. However, jurisprudence and doctrine accept the notion of the protection of a single colour if that colour has become distinctive through utilization.

2. Registrability of (Shape) 3D Marks

The Romanian Trademark Law provides that 3D forms (the shape of goods, their packaging or containers) may constitute a mark. Article 5, Letter e, of the Romanian Trademark Law provides that trademarks made up exclusively of the shape of a product, imposed by the nature of the product, necessary to obtain a technical result or give a substantial value to the product shall be refused registration.

3. Case Law

Regarding the exploitation and enforcement of colour trademarks, there have been no decisions to date. There have been difficulties encountered when seeking to register a single colour as a trademark in the Romanian Patent and Trademark Office. However, the colour brown has been registered for the United Parcel Services of America, Inc., on the grounds of extensive use in Romania and acquired distinctiveness.

Regarding the exploitation and enforcement of 3D trademarks, there have been no decisions to date. The only issues encountered have been administrative instances before the Romanian Patent and Trademark Office.

RUSSIA

1. Registrability of Colour Marks

According to the Article 5 of the Law of the Russian Federation “On Trademarks, Service Marks and Appellations of Origin” (adopted on September 23, 1992), word designations, designs, 3D and other designations and combinations thereof may be registered as trademarks. A trademark may be registered in any colour or combination of colours.

Article 6 of the Law on Trademarks disallows registration of designations with lack of distinctiveness.

Neither the Law, nor regulations or guidelines of the Russian Trademark Office specifically comment on the issue of registrability of trademarks, consisting of mere colours without any word or figurative elements included. In such cases the general
distinctiveness test will be applied. While the Trademark Register contains many marks in colour, including trademarks, consisting of combination of colours (multi-colour stripes etc.), a designation, consisting of just one colour, appears to have very low chances to be registered as a trademark in view of its low distinctiveness.

2. Registrability of (Shape) 3D Marks

According to the Article 5 of the Law of the Russian Federation “On Trademarks, Service Marks and Appellations of Origin” (adopted on September 23, 1992), word designations, designs, 3D and other designations and combinations thereof may be registered as trademarks.

Article 6 of the Law disallows the registration of designations, representing the shape of goods, which is determined exclusively or mainly by properties or purpose of the goods.

According to the Article 2.2. of the Rules on Preparation, Filing and Consideration of Trademark Applications (adopted by the Russian Trademark Office on March 5, 2003), 3D designations include 3D objects, figures and combinations of lines, figures. Article 2.3. states that 3-dimensional objects, the shape of which is defined by exclusively functional purpose, are not registrable.

Recommendations on Specific Issues of Examination of Trademark Applications (adopted by the Russian Trademark Office on March 23, 2001) discuss the issue of functional shapes in details. The Recommendations *inter alia* point out that an applicant of a 3D mark may submit evidence indicating on existence of alternative shapes of certain goods on the market, and, thus, applied-for shape, even though apparently functional, may be nevertheless recognized as distinctive and registrable. The useful qualities of certain shape should not be recognized as obstacles for trademark registration of such shape (*e.g.*, if certain shape of a pill leads to easy and painless swallowing of this pill, this factor alone should not prevent trademark registration of such shape). Finally, acquired distinctiveness of the shape, if proven, may lead to its trademark registration even despite the presence of functional purpose of this shape.

3. Case Law

In absence of full official database of case law and rulings in Russia, only some court or administrative decisions are publicly accessible. Since colour and 3D trademarks are less widespread in Russia than “traditional” marks, no decisions are known in this regard. However, it is known that the Russian Trademark Office in its practice has conducted many examinations of 3D marks v. similar or confusingly similar 3D marks (for example, bottle designs etc.).

**SERBIA AND MONTENEGRO**

1. Registrability of Colour Marks

Colour combinations can be protected if distinctive. A single colour may be protected only if it has acquired distinctiveness through use (*example*: single lilac colour IRE Reg. No. 644464 as used for the Milk product packaging)

2. Registrability of (Shape) 3D Marks
Protection is provided for distinctive shapes of product or packaging. Excluded from protection are shapes that are determined by the nature of the product, and shapes that are necessary for obtaining certain technical results.

3. Case Law

No case law for colour marks. Many cases involving the unauthorized use of the lilac colour for chocolate products have been settled out of court.

No case law for 3D marks.

**SLOVAK REPUBLIC**

1. **Registrability of Colour Marks**

Article 1(1) of Act No. 55/1997 Coll. On Trademarks as amended by Act No. 577/2001 Coll. reads:

*A trademark is any sign capable of being represented graphically, consisting particularly of words, including personal names, letters, numerals, drawings, shape of goods or of their packaging, or their mutual combinations capable of distinguishing goods or services of one person from the goods and services of other person, registered in the Register of the Trademarks.*

The law does not expressly provide that a trademark registration may consist exclusively of a color.

2. **Registrability of Shape (3D) Marks**

It is possible to have goods or their packaging registered as 3D trademarks under the Slovak Trademark Law. The Slovak Patent Office applies a restrictive approach. Three-dimensional trademarks for conventional designs are usually rejected due to the lack of distinctiveness. This obstacle to registration could only be overcome if the applicant could prove acquired distinctiveness.

3. **Case Law**

There are no registered color marks on the national trademark register in the Slovak Republic. As of April 2005, there are about 211 three-dimensional trademarks registered on the national register. The oldest one was registered in 1943.

There is no published case law regarding serious use or infringement of colour or 3D marks. A famous producer of alcoholic beverages from the Czech Republic was subject to attacks and attempts to imitate its products protected by dozens of trademarks, some of which were also three-dimensional trademarks. These activities were stopped by a series of preliminary rulings and judgments, but in none of these cases was the three-dimensional trademark the sole subject matter.

**SLOVENIA**

1. **Registrability of Colour Marks**

Article 42 (Subject-matter of mark protection) of the Slovenian Industrial Property Act:

*Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of another undertaking, and capable of being graphically represented, in particular words, including personal names,*
letters, numerals, figurative elements, three-dimensional images, including the shape of goods or of their packaging, combinations of colours as well as any combination of such signs, shall be eligible for registration as marks. In deciding whether a sign is eligible for registration as a mark, all circumstances, in particular the duration of its use, shall be taken into account.

The nature of the goods or services to which a mark is to be applied shall in no case form an obstacle to the registration of the mark.

Article 98 (Substance of requirements of a mark application) of the Slovenian Industrial Property Act:

(1) The request for the registration of a mark shall contain data concerning the applicant (surname, forename and address, or firm and seat), where the sign is in colours, an indication of colours, where the mark is a three-dimensional mark or a collective mark, a statement to that effect, and other data relating to the application which are prescribed by an executive regulation. (2) Goods and services shall be classified in the list of goods or services in accordance with the Nice Classification.

In general, the trademark must be inherently distinctive (not necessary to prove distinctiveness) or must acquire distinctiveness through use (necessary to prove distinctiveness).

In practice the Slovenian IP Office (SIPO) registers trademarks which are comprised of combinations of colours (more than one trademark), or a combination of a colour and shape (for example blue circle). If a trademark is comprised of one single colour without shape, the SIPO will request evidence on acquired distinctiveness.

2. Registrability of (Shape) 3D Marks

Three-dimensional marks are registrable. In general, the trademark must be inherently distinctive (not necessary to prove distinctiveness) or must acquire distinctiveness through use (necessary to prove distinctiveness). In practice the SIPO registers shapes of a packaging or a bottle if it is not too common. If the shape is rather common, then a label should be added (before the application of course).

3. Case Law

No such case law re colour marks or 3D marks.

SPAIN

1. Registrability of Colour Marks

Traditionally, in Spain it has not been possible to register marks consisting of colours alone. The Law of 1929 prohibited registering a colour alone although it was possible to register the colour in combination with a characteristic shape. (Art. 126) The Trademark law of 1988 contained a similar provision prohibiting the registration of the colour per se, although a trademark made up of a colour limited by a determined shape would be declared eligible for registration.

The total implementation of the Harmonization Directive did not take place in Spain until 1 July 2002, when the Trademark Law 17/2001 went into force. It lists the absolute ground for refusal in Art. 5, similar to Art. 3 of Council Directive of 21 December 1988,
and so it does not contain any specific provision on the registrability of marks made up of colours.

However, the Spanish Office still applies the former practice and so they systematically refuse marks consisting of a single colour, shade or combinations of colours which are not sufficiently distinctive, although they register marks that are made up of colours together with characteristic shapes. For simple shapes registration is possible by filing evidence of distinctiveness acquired through use.

According to the information obtained from the Spanish Office, up until now apparently no trademark consisting of a colour or shade of a colour alone has been registered.

2. Registrability of (Shape) 3D Marks

The Law of 1929 only considered the possibility of registering 3D marks in the case of containers under the condition that they include some word or distinctive design (Art. 124.9). The Trademark Law of 1988 went into force on 12 March 1989, and it considered marks made up of 3D forms, including wrapping, containers and the shape of a product or its presentation to be registrable (Art. 2.a). The Trademark Law of 2001 contains a provision which is identical to the previous one (Art. 4.2 d), and so it expressly admits the registrability of 3D marks.

It is prohibited to register marks that consist exclusively of the shape resulting from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape that gives substantial value to the goods.

Up until now the Spanish Office has been quite tolerant and they have registered marks made up, for example, of shapes of service stations, pharmaceutical tablets, containers for cleaning products, perfumes or lubricants, etc.

However, the Spanish Office has been recently examining this type of mark in a stricter manner applying EU case law, although recent cases include, for example, the registration of 3D marks consisting of the shape of a Cartier watch, the frosted bottle of Freixenet sparkling wine, etc., although in these cases the applicants proved distinctiveness acquired through use.

3. Case Law

Since up until now apparently no Spanish trademark or International Registration designating Spain consisting of a colour *per se* has been registered, there is no case law concerning use and enforcement of colour trademarks.

As for 3D marks, there are two relevant cases:

- Judgment by the Supreme Court of 10 May 1990 according to which the coincidence in the product container may suffice to cause a risk of confusion between two container trademarks, made up of the container and other graphic or word elements, when the container has a special distinctive strength in the whole of the mark.

- Judgments by the Provincial Court of Valencia of 22 March 2000 and 10 July 1997 and by the Provincial Court of Baleares of 6 November 2000. In all of these cases the courts concluded that due to their special distinctive strength, the product containers could cause a risk of confusion despite the fact that the remaining graphic or word elements of the marks in conflict were different.
1. **Registrability of Colour Marks**

To date there is no trademark registered in Sweden (national filings) which refers to a colour *per se*.

As regards colours *per se*, the difficulty is to prove the colour functions as a designation of the goods and/or services. In an older case, the goods referred to plastic expanding plugs. The applicant was able to show that consumers were aware of the different colours, but the court (the Court of Patent Appeals) concluded that consumers perceived the colours as an indication of the sizes of the plugs, and not the commercial source. In a more recent case, the company Owens Corning was denied registration of the colour pink for an insulating material, in spite of the fact that this specific colour must be regarded as rather unusual for building material. The applicant could show consistent use since 1989 but still the court did not consider the documents filed sufficient to show that the colour pink alone functions as a trademark.

As long as there is no leading case from the Court of Patent Appeals, it is highly unlikely that the Patent Office will take a decision to grant registration of a colour.

2. **Registrability of (Shape) 3D Marks**

Applications for mark for the shape of the goods encounter similar problems. The first objection from the Patent Office would be that the mark does not function as a trademark since it only represents the shape of the goods. The applicant will then have to show that the shape is not primarily only functional. The applicant will also have to show that the shape differs from other shapes on the market for the goods. Further, the applicant will have to show that the circle to whom the mark is addressed, consumers and others in the trade, perceives the shape as an indication of origin.

3. **Case Law**

For marks consisting of the shape of the goods, there are two cases from Swedish courts that are of interest. The first case refers to a cancellation action directed against the registration of the shape of the Philip’s Phillishave shaving head. In the first instance, the District Court of Stockholm, the action from the plaintiff was denied. However, in the verdict from the Appeal Court of Svea in January this year, the registration is cancelled. In between these two opposite verdicts, there is the ECJ ruling of June 18, 2002, Case C-299/99, with Philips and Remington Consumer Products Ltd, which clarifies the interpretation of Article 3.1 e in the trademark directive.

The other case refers to the shape of the goods, the design of a children’s chair. In this case, the court, The District Court of Lundby, concluded that the subjected design was not essentially functional and that the design was clearly distinctive and functions as a trademark. After concluding that the shape of the children’s chair was protected, the other chair in the case was found infringing and an injunction, coupled with damages, was imposed.

There is also an interesting case referring to the possible protection for a colour *per se*, in this case the colour yellow for transport and courier services. The company Posten AB (the former Postal Administration) filed an action, including claim for interlocutory injunction, against the transport company Danzas. The injunction included the use of a
horn symbol and the colour yellow. Both the District Court Stockholm and the Appeal Court of Svea allowed an interlocutory injunction as regards the horn symbol, but not for the colour yellow. One argument was that there are other actors in the transport- and courier business that are using the colour yellow. Posten AB was thus not able to show that they had a sole right to the colour yellow through acquired distinctiveness.

SWITZERLAND

1. Registrability of Colour Marks

Swiss legislation allows registration of colour trademarks and 3D trademarks, in general. According to Art. 1 (2) of the Swiss Trademarks Act, trademarks may consist, in particular, of words, 3D shapes or combinations of such elements with each other or with colours.

2. Registrability of (Shape) 3D Marks

According to Art. 2 (b) of the Act, trademark protection is not available to shapes that constitute the nature of the goods themselves or shapes of the goods or of their packaging that are technically necessary. However, the practice with respect to the registration of a 3D trademark is rather strict and colours as such are only registered if they have acquired distinctiveness through use.

3. Case Law

a. Colour Marks

A wordmark for a colour, such as BLACK & WHITE for clothes or BLUE for cars is considered as being descriptive. As to pure colour marks, these trademarks are in principle not distinctive because they are usually used for decorative purposes. As a consequence, colours are not recognized as a trademark which points out to a certain undertaking. Furthermore, colours must be freely used since their number is limited.

According to the Swiss practice, inter alia the following colour marks having acquired distinctiveness through use have been registered:

- YELLOW for a limited number of postal services
- LILA for chocolate

b. 3D Marks

In two decisions issued around two years ago, the Federal Commission of Appeals in Intellectual Property denied the registrability of shapes as trademarks:

- The shape of a simple rectangular with bevelled edges and 4 rounded corners was not considered as distinctive for cleaning and washing preparations. The fact that shape of the tablet was claimed together with the colours white and blue did have any influence since different colours are often used to refer to different active substances.
The shape of a packaging for a milk bottle was not recognized as a sign of origin and was thus not registrable as a trademark. The indentations and the grooves of the bottle have been considered as being usual and functional, since they prevent the hand from slipping.

UNITED KINGDOM

1. Registrability of Colour Marks

*Colour marks are registrable* although it is difficult to search for them on the UK trademark register and so establish how many there might be. In *Libertel* (C-104/01), the ECJ decided that colour *per se* may have a distinctive character within the meaning of Article 3(1)(b) of Directive 104/89 for certain goods and services provided, amongst other things, that the mark is represented graphically. To be represented graphically, the mark must be presented "clear, precise, self-contained, easily accessible, intelligible, durable and objective" (the *Sieckmann* criteria). The court decided it is not sufficient to satisfy the graphical representation requirement to only provide a paper sample of the colour as the sample of a colour may deteriorate over time and is not therefore durable. However, a sample of the colour along with a verbal description of that colour may satisfy the graphical representation requirement provided that the description satisfies the *Sieckmann* criteria. Colours may be designated using an internationally recognised colour identification system code such as Pantone, RAL or Focoltone.

Although, the ECJ's decision only covers applications to register colour alone, the UK Trade Mark Registrar intends to apply the court’s findings to applications to register colour(s) in the abstract and colour(s) as applied to the goods or their packaging, or to other items used in the course of trade.

Colour identification codes will not be required for pictoral, figurative or word marks incorporating colour, but will be recorded if filed.

To register colour(s) in the abstract it will be necessary to establish that the colour(s) is distinctive irrespective of the medium on which it appears, and it may, in practice, be more difficult to establish this than that a colour is distinctive when it is applied to a particular item, *e.g.*, applied to the packaging of the goods.

The UK Trade Mark Registrar will adopt the following approach when considering whether marks consisting of colour alone have been graphically represented: colour samples on paper are not durable enough to constitute a graphical representation of this type of mark; a written description of the colour(s) (*e.g.*, dark blue) accompanied by the relevant code(s) from an internationally recognised colour identification system is an acceptable means of representing the colour(s); other means can only be accepted if, on the facts, they can be shown to meet the *Sieckmann* criteria.

If the mark consists of the colour(s) applied to the goods or their packaging, or to other commercial items, an appropriate description should be included as part of the representation of the mark. Where colour is applied to the whole (or substantially the whole) surface of the object in question, a statement in words to this effect will suffice. In other cases a picture or diagram may be necessary identifying the area(s) of the item to which the colour(s) is/are applied.

2. Registrability of (Shape) 3D Marks
Three-dimensional marks are registrable. Under the TMA 1994 the shape of goods or their packaging are registrable trademarks. However, there are still relatively few registrations for shape marks in the United Kingdom as it is proving difficult to satisfy the UK Trade Marks Registrar that a shape indicates to a consumer the trade origin of a product rather than its technical function.

The uniqueness of a shape will not in itself be sufficient to identify the trade origin of a product. Additional features such as colour, words or get-up will not help secure registration either, unless they are distinctive features, which help the mark as a whole to perform a trademark function. Also, the shape of a product, which is determined by the function of the product, is not registrable as a trademark.

In the Phillips case, the Court decided that although extensive use of a shape trademark might show that the trademark has become distinctive, no amount of use will enable a purely functional shape to be registered. Besides objections based on the functionality of a shape, the most common objection, which is difficult to overcome, is on grounds of distinctiveness. Procter & Gamble's attempt to register the shape of detergent tablets, Mag Instrument Inc.'s attempt to register the shape of torches, and Unilever's attempt to register the shape of soap bars also failed. Again, the view was that the shapes in question were not different enough from the standard shape of such products for the public to take them as indicators of origin. However, a UK application for a bottle shape incorporating a distinctive word was recently upheld by the Registry in opposition proceedings. This decision was taken despite the Hearing Officer having found the bottle shape alone to be non-distinctive. Taking the mark as a whole, it was considered distinctive.

In general, the Registry and the courts are unwilling to grant a monopoly over a common shape to any one party. However, it is possible to register a shape mark where the shape is very distinctive, for example the bottle shape applied for by Nestlé Waters France. Where the shape is less distinctive, extensive evidence of acquired distinctiveness through use is likely to be required, and in the case of a shape determined by the function of a product even strong evidence of use is likely to be insufficient.

**UKRAINE**

It is known that the Ukrainian Trademark Office accepts for registration trademarks, representing colours and 3D designations. The main requirement is the presence of technical possibility of their identification and inserting into the State Trademark Register as well as their official publication.

1. **Registrability of Colour Marks**

According to the Article 5 of the Law of the Ukraine “On protection of rights on Trademarks and Service Marks,” the subject matter of a trademark may be any designation or any combination thereof. These can be words, names, letters, numbers, figurative elements, colours and combinations thereof.

2. **Registrability of (Shape) 3D Marks**

Ukrainian law does not directly regulate registration and protection of non-traditional designations (with the exception of explicit mentioning of colours). On the other hand, no prohibitions for registration of non-traditional designations exist.

3. **Case Law**
No case law.