International Trademark Association
1133 Avenue of the Americas, New York, NY 10036-6710 USA
Telephone: 212-768-9887 Fax: 212-768-7796

July 6, 2001

Libertel Groep B.V.
Maastricht
To the attention of Prof. D.W.F. Verkade
Stibbe, Amsterdam, The Netherlands

Re: Libertel Groep B.V./Benelux Merkenbureau; reference by Dutch Supreme Court to the European Court of Justice; decision of 23 February 2001

Dear Sir or Madam:

The International Trademark Association (INTA) has prepared this letter for the purpose of assisting the European Court of Justice (ECJ) in reviewing an Article 234 reference by the Dutch Supreme Court in the proceedings referred to above ("the Libertel Case"). We comment below on the first and second questions put by the Supreme Court of the Netherlands.

As we understand them, the questions are whether a single color can be distinctive in relation to specific goods or services within the meaning of Article 3 (1) (b) of the Trade Marks Harmonization Directive, and if so, under what circumstances.

INTA has not attempted to intervene directly before the ECJ because of the procedural difficulties associated with joinder to the national proceedings. INTA would be grateful, therefore, if Libertel would file this letter before the ECJ.

The International Trademark Association

INTA is a 123 year-old not-for-profit organization of trademark owners and practitioners from 145 nations throughout the world. INTA is dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of commerce.

Its current membership of over 4000 trademark owners and practitioners crosses all industry lines, including manufacturers and retailers, in industries ranging from aerospace to consumer goods. INTA's membership includes close to 700 trademark owners and practitioners from European Union countries.

An important objective of INTA is to protect the interests of the public in the proper use of trademarks. In this regard, INTA strives to advance the development of trademark and unfair competition laws and treaties throughout the world, based on the universal public interest in avoiding deception and confusion.

INTA has been an official non-governmental observer to the World Intellectual Property Organization ("WIPO") since 1979, and actively participates in all trademark related WIPO proposals. INTA has influenced WIPO trademark initiatives such as the Madrid Protocol and is active in other international arenas including APEC, FTAA, WTO, NAFTA, and GATT. INTA's international character brings a global approach to the issues at stake in this case.

Since 1916, INTA has acted in the capacity of advisor and has appeared as *amicus curiae* ("friend of the court") in the US[1] and in other jurisdictions[2]. INTA presents itself as a "friend of the court" in this matter. It is not a party to the instant case, but believes this case is significant to the international development of trademark law.

The International Trademark Association respectfully submits this letter in the hope that it may assist the Court in reaching a decision that is in the public interest.

[1] INTA has filed the following amicus briefs before the United States Supreme Court and other Federal Courts: *Playboy Enterprises Inc. v. Netscape Communications Corporation S.Ct. Case No 00-56648 and Playboy Enterprises Inc. v Excite Inc. S.Ct. Case No 00-56662; TrafFix Devices, Inc. v. Marketing Displays, Inc*., S.Ct. Case No. 99-1571*; Major League Baseball Players Association v. Cardtoons, L.C*., S.Ct. Case No. 00-39*; Wal-Mart Stores, Inc. v. Samara Brothers, Inc*., S.Ct. Case No. 99-150 (March 22, 2000*); College Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd*., 119 S. Ct. 2219 (1999); *Dickinson v. Zurko*, 119 S. Ct. 1816 (1999); *Qualitex Co. v. Jacobson Prods. Co*., 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc*., 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc*., 486 U.S. 281 (1988); *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc*., 101 F.3d 259 (2d Cir. 1996); *Conopco, Inc. v. May Dep't Stores Co*., 46 F.3d 1556 (Fed. Cir. 1994); *Ralston Purina Co. v. On-Cor Frozen Foods, Inc*., 746 F.2d 801 (Fed. Cir. 1984); *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc*., 684 F.2d 1316 (9th Cir. 1982; *Redd v. Shell Oil Co*., 524 F.2d 1054 (10th Cir. 1975); *Century 21 Real Estate Corp. v Nevada Real Estate Advisory Comm'n*, 448 F. Supp. 1237 (D. Nev. 1978), *aff'd*, 440 U.S. 941 (1979).

[2] Cases outside of the US in which INTA has filed affidavits include: *McDonald's Corporation v. DAX Properties CC and JoBurgers Drive Inn Restaurants (PTY) Limited, Supreme Court of South Africa (Durban and Coast Local Division);* and *Heublein Inc. v. Appeals Chamber of Rospatent, Moscow City Court, Russia; Glaxo Welcome Limited v. Dowelhurst Limited and Swingward Limited, European Court of Justice; and Ikea Inter-Systems Inc. v. Beijing Cinet co Ltd., Beijing High Court.*

The Libertel Case

INTA's purpose in filing this letter is to suggest that a single color, under appropriate circumstances, can have the capacity to function as a trademark. Whether or not a specific color has this capacity is a question of fact in each case, but it is inconsistent with fundamental principles of trademark law to deny protection to a single color trademark merely because it is such.

It is evident that trademark owners, including members of INTA, will be directly affected by the judgment of the ECJ on the questions referred to it under Article 234 of the EC Treaty. The Board of Directors of INTA in its meeting of 20 November 1996 adopted the following resolution with respect to the protection of color as a trademark:

> *"**Whereas**, businesses increasingly are relying on color as a means of distinguishing goods and services in the marketplace; and*
>
> ***Whereas**, while it is widely recognized internationally that devices which comprise a combination of colors can serve as trademarks and are entitled to protection through registration, the same is not true regarding single colors;*
>
> ***Be it resolved**, that the International Trademark Association is of the position that color, whether a combination of colors or a single color, may serve as a trademark and, therefore, in appropriate circumstances, should be entitled to trademark recognition, protection and registration."*

For many years colors, including single colors, have been registered and protected as trademarks in many jurisdictions (see below). It is clear that color is an important element in branding and corporate identification. That color is so used and relied upon by the public is beyond doubt.

Consumers can distinguish a particular service or product from the color such as the case of the color *blue* for fuel canisters and *violet* of the MILKA chocolate products. Whether a specific, single color has the ability to function as a trademark, is a question of fact in each case.

In many jurisdictions it has been decided that a single color or combination of colors can be protected as trademarks.

In the *Benelux*, the Benelux Court of Justice decided in two decisions that a single color can serve to distinguish the products of a company.[3] In a few other cases single colors were accepted as trademarks. Mention is made of the color *yellow* of shampoo bottles of Zwitsal[4], the color *light green* for the pharmaceutical product Cimetidine[5] and the color *turquoise* for telecommunication services of Belgacom.[6]

In Germany the Federal Supreme Court (BGH) decided in 1998 that colors per se essentially are capable of constituting trademarks.[7] This decision was taken under Article 3 (1) of the German Trademark Act (GTMA), which is the equivalent of Article 2 of the Harmonization Directive.

However, other than the Directive, the wording of Article 3 (1) German Trademark Act specifically mentions colors and color combinations ("All signs are capable of protection as trademarks which are capable of distinguishing ... etc., ...or of their packaging as well as other get-ups including colors and color combinations...").

The Federal Supreme Court decided that according to the wording of Article 3 (1) GTMA trademarks consisting of colors and color combinations must not be subjected to stricter standards than other types of trademarks like word, device or sound marks with regard to their capability of serving as trademarks.

Finally, the Board of Appeal of OHIM decided that a color *per se* may be generally protectable as a Community trademark under article 4 of the Community Trademark Regulation (CTMR).[8]

---

[3] Benelux Court of Justice 9 February 1977, Nederlandse Jurisprudentie 1978, 415, *Centrafarm/Beecham* and 9 March 1977, Nederlandse Jurisprudentie 1978, 416, *Camping Gaz.*

[4] District Court Arnhem 13 July 1989, Intellectuele Eigendom en Reclamerecht 1989, 94.

[5] President District Court The Hague 3 October 1994, Intellectuele Eigendom en Reclamerecht 1995, 67, Bijblad Industriele Eigendom 1996, 17.

[6] Court of Appeal Brussels 28 September 1999, Intellectuele Eigendom en Reclamerecht 2000, 18.

[7] Federal Supreme Court 10 December 1998, Gewerbliche Rechtschutz und Urheberrecht 1999, 491, *Gelb/Schwarz.*

[8] Board of Appeal OHIM 12 February 1998, OJ OHIM no. 5/98, 641, case R 7/1997-3, *Orange.*

Conclusion

The International Trademark Association believes that the requirements for distinctiveness of single colors should be the same as those of other signs. The text of both article 2 of the Trade Marks Harmonization Directive and article 4 of the Community Trademark Regulation give a very broad definition of signs that are capable of being protected as a trademark. A single color, under appropriate circumstances, can have the capacity to function as a trademark. Whether or not a specific color has this capacity is a question of fact in each case. Nowhere is there any indication that any sign, which is not specifically excluded from protection, should be treated differently from any other sign and INTA urges the Court to decide that a single color can be protected as a trademark.

Very truly yours,

Alan Drewsen, Executive Director
International Trademark Association