

Colour trade mark protection in Germany

Applications to register colour trade marks in Germany are following the general trend for colour trade mark applications: downwards. At first sight this would appear surprising as a colour is perceived by consumers up to 200 times more quickly than word or figurative marks. All the more reason for businesses to have a particular interest in colour trade marks! However, colour trade marks – compared to figurative marks, for instance – are subject to special requirements for trade mark registration purposes because colour trade marks claim protection for the colour or colour combination per se.

Graphic representation and precision

Right from the start, the initial question was whether colours could be signs that are identifiable and capable of graphic representation at all. Admittedly, a single colour can be clearly denoted in an application using an international classification system (judgment of the European Court of Justice in Case C-104/01). But how are combinations of colour to be graphically represented?

In 1998, the German Federal Court of Justice [*Bundesgerichtshof*, 'BGH'] still took the view that the European Trade mark Directive (now: Directive 2008/95/EC) – which is binding under German trade mark law – did not prescribe any specific external appearance for a trade mark, which was always to apply to goods. It therefore ruled that a black and yellow colour combination for electronic level sensors was eligible for protection and that it was sufficient for the particular colour code to be stated (Bundesgerichtshof, I ZB 20/96). Germany then saw a boom in the number of applications to register colour combination trade marks. Companies seized the opportunity of acquiring a monopoly over certain colours in all conceivable compositions.

In 2004, however, the ECJ stipulated that in the case of applications to register combinations of colour it was essential that the specific colour distribution be given. In an application it is therefore necessary for the colours to be specific and designated and for their spatial correlation with each other to be stated (ECJ Case C-49/02). According to the ECJ, it is these details alone that ensure that such a sign is capable of graphic representation for registration purposes and determine the scope of protection to be afforded to a trade mark in the case of an abstract colour combination.

Following that decision by the European Court of Justice non-specific combinations of colour were immediately rejected in Germany on that ground alone. This meant that protection for colour marks became much more difficult and narrower. Before applying to register a colour mark companies had to closely consider the form in which the colour combinations applied for were to be used on their goods.

Distinctiveness

It is not sufficient, in order to become a trade mark, that a sign has a specific substance. To constitute a trade mark it is necessary for the sign to also possess the characteristic of distinguishing the goods or services of the trade mark applicant from those of other businesses.

Another issue therefore arises: namely, whether the consumer infers any indication of origin. By their very nature, colours are often used on goods and in advertising simply as a design technique – such as containers in a basic yellow colour with lids, buttons and so on in black. This type of colouring can trigger certain associations and feelings. They also serve to distinguish different ranges or have an indicative character. Generally speaking, however, consumers do not infer from colours or colour combinations that any particular company is meant. What is more, their availability to other people in the market must not be unjustifiably restricted.

A colour can therefore only have a distinctive character without the applicant's help in exceptional circumstances. The courts in Germany have not yet been able to precisely define what those circumstances might be. Not even colours for which applications are filed in relation to just a few goods in a narrow market – such as bright yellow for telephone directories – provide the requisite identification of an applicant's business purely on the basis of market conditions. Furthermore, colours must be available to all to describe goods or services. Even the above yellow and black colour combination was refused distinctiveness for that reason, where it was ruled that it had to be freely available for use.

In order for colours to acquire the characteristic of distinguishing the goods or services of a trade mark applicant from those of other businesses and for there to be no public interest in their free availability it is generally necessary for them to have already been extensively used as a mark. It is impossible for this criterion to be met by a lot of companies. Although no specific percentages are demanded, the guiding principle for a colour sign to successfully become a trade mark in Germany is its recognition as a trade mark by more than 50% of the public targeted. In the case of simply descriptive details the BGH requires 'almost unanimous public awareness'; 58% is not enough. In principle, therefore, only well-known colour signs have any prospect of registration.

Scope of protection

The imponderables in the scope of protection afforded to registered colour trade marks are also ultimately responsible for the drop in applications. In one infringement action the BGH has to decide in the foreseeable future whether the basic colour dark blue registered as a trade mark for skin care products (NIVEA-Blau) prevents a competitor from using dark blue as the background colour for its own skin care products (DOVE). In 2008, the Higher Regional Court in Hamburg [*Oberlandesgericht – 'OLG'*] took the view that the degree of awareness of NIVEA-Blau was not sufficient for consumers to construe that colour on the DOVE products as an indication of origin. This is an issue concerning the scope of protection afforded to a colour mark without contours, consisting of a basic colour and protected in respect of everyday commodities (5 U 148/07). Deutsche Telekom was better placed. It had protected the unusual colour magenta and was successful in using that trade mark to ward off a competitor's advertising (Bundesgerichtshof, I ZR 23/01).

Conclusion

Applications to register abstract colour marks in Germany have to be carefully prepared in order to exploit the undeniable advantages of this form of communication as a trade mark.

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