



The rise of the colour trademark has created new issues for legislators and commercial firms across Europe. Nicoleta Tarchila of *Cabinet Enpora* explains how Romanian trademark law has moved with the trend.



Nicoleta Tarchila  
Cabinet Enpora

It is always a challenge for trademark owners to register non-traditional trademarks. Colours, sounds, smells, 3D marks and holograms are appealing to companies which are always in search of different and innovative ways to attract their customers. While smells and holograms are still on moving ground, sounds and shapes are closer and closer to being generally accepted, as for single colours a rule has been established by the general practice: registration with acquired distinctiveness.

In Romania, the amended Trademark Law no. 84/1998 (which has been in force since May 2010), expressly mentions that “colours and combination of colours” between the signs of a trademark may coexist. The prior Romanian Trademark legislation Law no. 84/1998 only mentioned a “combination of colours” as signs suitable for trademark registration (TM). However the latest TM legislation does not impose an entirely new provision since the old

Romanian Trademark Law no. 28/1967 also expressly mentioned the registration as trademark of “a colour or a combination of colours”.

In spite of the existing legislation, the practice of the Romanian Trademark Office is to consider single colour trademarks as unsuitable for registration on a prima facie basis because single colours are generally deemed to be non-distinctive ‘per se’. The easiest way to obtain protection for your single colour trademark in Romania is to prove the acquired distinctiveness through constant and intense use.

The practice of the Romanian Office is in compliance with OHIM. The Romanian Trademark legislation transposes the provisions of the Directive 2008/95/EC, however, it is worth mentioning that Article 2 of the Directive does not specifically mention colours or the combination among the signs whereof a trademark may consist.

The Council of the European Union and the Commission

made a joint declaration, entered in the minutes of the Council meeting on the adoption of the Directive, that they “consider that Article 2 does not exclude the possibility of registering as a trademark a combination of colours or a single colour provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings” [OHIM OJ No 5/96, p. 607]

Taking into consideration that such declaration may not be interpreted as a legal provision, it was for the European Court of Justice to determine whether Article 2 of the Directive is to be interpreted as meaning that a colour ‘per se’ is capable of constituting a trademark. This is what happened at the preliminary ruling in the case C104/01 *LibertelGroep BV vs. Benelux-Merkenbureau* in relation to the registration of the colour orange for classes 09 and 38.

The Court found that a single colour may be considered a sign in relation to certain goods and services, a verbal description of the colour together with a sample of colour and/or supported by the designation of the colour using an internationally recognised identification code may constitute a valid graphical representation of a single colour and that colours are capable of conveying specific information as to the origin of a product or service and are thus capable of distinguishing the goods or services of one undertaking from those of other undertakings.

However because “consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour ‘per se’ is not, in current commercial practice, used as means of identification. A colour ‘per se’ is not normally inherently capable of distinguishing the goods of a particular undertaking. In the case of a colour ‘per se’, distinctiveness without any prior use is inconceivable except in exceptional circumstances, particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific.” [C104/01 *LibertelGroep BV vs. Benelux-Merkenbureau*, par. 65 and 66]

An important rule to be taken into account in the analysis of single colour trademark applications is that “in assessing the potential distinctiveness of a given colour as a trademark,

*“Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging.”*

regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought”. [C104/01 *LibertelGroep BV vs. Benelux-Merkenbureau*, par. 67]

### Romanian practice

Having in view the very clear interpretation given by the ECJ the approach of the national offices towards single colour trademark applications may be considered as entirely justified.

In Romania the number of national trademark applications consisting of single colours is far from being a large one, however, there are enough registrations to display a unitary practice.

The German company Xella Deutschland GmbH is the owner of the colour yellow registered since May 23, 1997 for goods in classes 7 and 19. UPS owns the colour brown registered since January 14, 1999 for services in class 39. The telecommunication services provider Orange has been the owner of the colour orange pantone 151 since April 3, 2003 for classes 9 and 38. Meggle AG owns the colour blue pantone 293 which was registered on February 17, 2006 for goods in classes 29, 30 and 32. A Romanian travel company, SC Perfect Tour SRL, owns exclusive rights on the colour move pantone 258 C registered on August 10, 2007 for services in classes 39, 41 and 43. The colour dark green pantone 553 C is registered since April 6, 2009 on behalf of the company Intersnack Group GmbH & Co. KG for goods in classes 29, 30 and 31.

All these marks were registered based on the proofs provided by their owners that they acquired distinctiveness on the Romanian market with respect to the required goods and services.

In order to ensure protection on a colour trademark in Romania you must first use the mark and then apply for registration.

### OHIM practice

The CTM online database displays approximately 300 applications consisting of single colour trademarks that were filed before OHIM. Nevertheless, only 18 have obtained a registration certificate.

Community trademark registrations for single colours are currently owned by Kraft Foods, the colour lilac/violet pantone E 176-4 and E 176-3 for chocolate products in class 30, Deutsche Telekom for the magenta RAL 410 colour in respect to telecommunication services in class 38 and class

42, UPS, Inc. which is the owner of the colour brown for class 39, Mars Petcare UK which has EU exclusivity for the colour purple pantone 248C for cat foodstuff in class 31, 3M Company which owns the canary yellow colour mark in connection to its self-stick notes (Post-it) trademark for goods in class 16. All these marks were registered based on the acquired distinctiveness for the relevant consumers.

Some of the registered single colour marks obtained protection before OHIM because of the distinctiveness of the colour ‘per se’, thus without proving the acquired distinctiveness. Vanguard Trademark Holdings USA LLC obtained the registration of the colour green pantone 348 for services in class 39, the Spanish company Renova was granted protection for the colour black for toilet paper and napkins in class 16, VALLOUREC & MANNESMANN TUBES is the owner of the colour traffic purple RAL 4006 for pipe end protectors in class 17. For these particular applications OHIM ascertained exceptional circumstances are applicable and the colours ‘per se’ are of the nature to distinguish the goods or services of these undertakings from those of other undertakings.

### Case study: the registration of the colour orange

The telecommunication services provider Orange required the registration of the colour orange pantone code 151 for various goods in class 9 and services in classes 38 and 42 as a CTM and national trademark.

In Romania, a national application for the colour orange for classes 9 and 38 was filed on April 3, 2003 and was registered by the Romanian Trademark Office approximately one year later based on evidence proving the acquired distinctiveness for the Romanian consumers. In 2006, Orange filed through WIPO two other applications consisting of the colour orange for classes 9, 38 and 42. Romania was one of the designated states. A provisional refusal based on the lack of distinctiveness of the application was issued with respect to class 42. The applications were promoted to registration following to the removal of class 42.

A CTM application was filed before OHIM much earlier in 1996 and followed a rough road. The Orange application is the first application for a single colour filed before OHIM as attested by the CTM online database. The application was filed on March 1, 1996 but received a filing date only on May 20, 1997 precisely because the representation of the mark was missing.

“In the application form, the applicant had ticked, under

the heading ‘type of mark’, the box ‘other’ and had specified as the other type of mark ‘colour mark’. For a description of the trade mark, it had referred to an attached sheet on which it stated that the mark consisted of the colour ‘orange’. The applicant had not enclosed a reproduction of the specific colour shade or indicated a code number”. [Decision of the Third Board of Appeal R 7/97-3 par. 1].

On 20 May 1997 the applicant filed a graphical representation of the colour on a separate sheet of paper and received an application date. The applicant appealed the late filing date by arguing that it feared that if it had filed a representation of the colour in a rectangular form this could have given OHIM the impression that it did not wish the colour ‘per se’ but a rectangular colour picture to be registered. [Decision of the Third Board of Appeal R 7/97-3 par. 4].

OHIM dismissed the appeal based on the fact that the applicant had enough means to comply with the provisions of Article 26 (1) (d) CTMR, namely an application for a community trademark must contain a representation of the trademark. It would have been sufficient for the applicant to specify additionally on the application form, under the heading ‘specification of the other type of mark’, or on the attached sheet at the side of the graphical representation, that it did not claim a particular picture but sought registration of the colour as such. [Decision of the Third Board of Appeal R 7/97-3 par. 13].

Orange ended up withdrawing this first application in March 9, 2001 but kept on trying to register its colour by filing a new CTM application in the same year and another one in 2003. Both applications were refused by OHIM. A 2006 application filed through WIPO that designated EM was withdrawn by the applicant.

No registration for the single colour orange pantone 151 has been obtained by Orange before OHIM but the company secured its rights by registering several combined marks which display the word ‘orange’ on a rectangular orange background. And to defend its concept it further registered CTMs consisting on the colours pink, green, blue, yellow, red and black, each displayed on rectangular backgrounds of the same colour.

Single colour national ‘orange’ marks have also been registered on behalf of Orange in several European countries, including France, Italy, Spain, the UK, the Czech Republic, Denmark and Slovakia.

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