

Now that the *Glaxo Group Ltd v EUIPO* has been decided, what are the unresolved issues over colour marks? Where will the challenges come from?

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The 2 big issues for colour marks

1. Graphical representation
2. Distinctiveness

Glaxo: Graphical representation



“The trade mark consists of the colour dark purple (Pantone code 2587C) applied to a significant proportion of an inhaler, and the colour light purple (Pantone code 2567C) applied to the remainder of the inhaler.”

Glaxo: Distinctiveness



'Purple – Pantone: 2587C'

Inherent distinctiveness (1)

- For a colour mark *per se*, distinctive character without any prior use is inconceivable save in exceptional circumstances
- On the relevant market, colours can be used to convey to the public information relating to the characteristics of the goods

Inherent distinctiveness (2)

- It is not in the public interest for the availability of a colour to be restricted
- Novelty or originality are not relevant criteria in the assessment of whether a mark has distinctive character

Acquired distinctiveness (1)

- The function of a trade mark is just as important for the end user as it is for intermediaries involved in its marketing
- Acquired distinctiveness must be demonstrated in the part of the EU where it was devoid of inherent distinctiveness
- Sales figures and advertising material can only be considered as secondary evidence

Acquired distinctiveness (2)

The probative value of survey evidence depends on:

- The method used and whether there is evidence to show that it is reliable
- Whether it is carried out in the objective circumstances in which the mark at issue is present
- Whether the interviewees have been shown several images
- The accuracy/specificity of the colour shade(s) used
- The number of persons surveyed
- How representative the chosen sample of interviewees are

'Niche' issues

- Descriptiveness
- Formal/Informal colour conventions
- The impact of having a monopoly

Wider issues – acquired distinctiveness

- Public policy
- Proof across the EU
- Survey evidence
 - ❖ Size
 - ❖ Questions
 - ❖ Responses
 - ❖ Accompanying evidence

Unresolved issues - substantial value to the goods?

Article 7(1)(e)(iii) Regulation 2017/1001

&

Section 3(2)(c) Trade Marks Act 1994

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