

THE DESCRIPTIVENESS ASSESSMENT WITHIN THE MEANING OF ARTICLE 7(1)(C) EUTMR BEFORE AND AFTER T-423/18 (VITA)

Titel: Vurderingen af deskriptive mærker ifølge
varemærkeforordningens artikel 7(1)(c) før og efter

T-423/18 (vita)

Subject: Intellectual Property Law

Topic: Trade mark law

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Resumé

Nærværende kandidatspeciale omhandler den absolutte registreringshindring i artikel 7(1)(c) i Europa-Parlamentets og Rådets forordning (EU) 2017/1001 af 14. juni 2017 om EU-varemærker, nemlig ikke-registrerbarheden af deskriptive mærker. Specialets fokus er at undersøge, hvorvidt der kan opstilles nye kriterier for vurderingen af deskriptive mærker efter dommen af 7. maj 2019, Fissler GmbH v. EUIPO, T-423/18 (*vita*), afsagt af den Europæiske Unions Ret – dette specifikt i forhold til mærker bestående af navne på farver, men også for mærker i en mere generel forstand. Dette undersøges ved brugen af den juridiske metode. Indledningsvist analyseres tidligere retspraksis på området for at skabe overblik over allerede veletablerede kriterier for vurderingen af deskriptive mærker. Dertil foretages en analyse af dommen T-423/18 (*vita*) for at vurdere, hvorvidt denne skaber nye kriterier for vurderingen af deskriptive mærker. I analyserne vil der skeles til de administrative retningslinjer, som er vedtaget for Den Europæiske Unions Kontor for Intellectuel Ejendomsret (EUIPO) vedrørende eksaminering af varemærker.

Dommen T-423/18 (*vita*) fastlægger afgørende momenter for, hvornår et varemærke bestående af navnet på en farve kan anses som værende beskrivende. Grundet den generelle formulering i dommens præmisser, kan der ligeledes udledes mere generelle kriterier for vurderingen af deskriptive mærker. De nye kriterier relaterer sig specifikt til, hvornår egenskaber er tilstrækkeligt tilknyttet de relevante varer eller serviceydelser førend de kan betragtes som egenskaber ifølge artikel 7(1)(c) i Europa-Parlamentets og Rådets forordning (EU) 2017/1001 af 14. juni 2017 om EU-varemærker. Således skal en egenskab være ”objektiv og i varen [eller tjenesteydelsen] iboende” samt ”iboende og permanent” for den relevante vare eller tjenesteydelse for at være omfattet af registreringshindringen i artikel 7(1)(c) i forordningen.

Med konkretiseringen af, hvornår en egenskab kan anses som værende omfattet af artikel 7(1)(c) i Europa-Parlamentets og Rådets forordning (EU) 2017/1001 af 14. juni 2017 om EU-varemærker, synes en ny retning at tage form. Dommen formodes at give anledning til en genovervejelse af den tidligere fortolkning og anvendelse af særligt dommen af 23. oktober 2003, OHIM v Wrigley, C191/01 P, (*DOUBLEMINT*), hvorefter et ordmærke kan udelukkes fra registrering, såfremt én af dets mulige betydninger betegner en egenskab ved de pågældende varer eller tjenesteydelser.

De materielle bestemmelser i Europa-Parlamentets og Rådets direktiv (EU) 2015/2436 af 16. december 2015 om indbyrdes tilnærmelse af medlemsstaternes lovgivning om varemærker og Europa-Parlamentets og Rådets forordning (EU) 2017/1001 af 14. juni 2017 om EU-varemærker er stort set identiske. Som følge af dette, og det store fokus på harmonisering af praksis vedrørende vurdering og registrering af varemærker,

formodes dommens principper at være anvendelige på nationale varemærker inden for den Europæiske Unions medlemslande samt lande, der er en del af EØS-aftalen.

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1. Introduction

Given the increased importance of branding and the tangible economic value of a brand (brand equity) in today's experience economy, trade mark law is more important than ever before. As consumers build loyalty to particular brands and make purchasing decisions based on their ability to identify a product or service by use of a logo, slogan, etc., these marks serve as a point of differentiation and competitive advantage. Consequently, trade mark law is important to enable the trade mark proprietor to develop goodwill for the product or service and prevent other parties from exploiting the brand.

The most fundamental way for a brand to catch the attention of consumers is through words. Nothing is more important than a strong word mark to stand out from the crowd of competing brands. However, the companies must show meticulous care when composing their word mark and walk a fine line between efficiently communicating their brand to consumers and keeping the all-important distinctive character of their brand. For administrative authorities, this entails a great focus on the assessment of whether or not a sign must be considered descriptive. This requires an increasingly comprehensive theoretical understanding of how the relevant public will associate specific terms with the relevant goods and services.

If a trade mark lacks distinctive character or serves in trade to designate the characteristics of the goods or services for which registration is sought, the trade mark cannot be registered pursuant Article 7(1) (b) and (c) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (also mentioned as: EUTMR).

Following the footsteps of judgments of 23 October 2003, *Office for Harmonisation in the Internal Market (EU) (hereafter: OHIM) v Wrigley, C191/01 P (DOUBLEMINT)* (hereafter: *C191/01 P (DOUBLEMINT)*) it has been widely believed that the name of a colour is inherently descriptive of the goods if they are more or less available in that colour – thus erasing any chance of registration as a trade mark. When examining word mark applications consisting of names of colours, it becomes apparent that they in large are refused by the European Union Intellectual Property Office (hereafter: EUIPO) if the products are not colourless by nature.

However, the General Court has had a chance to weigh in on this interpretation in judgement of 7 May 2019, *Fissler GmbH v. EUIPO, T-423/18 (vita)* (hereafter: *T-423/18 (vita)*)¹. Concerning the specific application for the word mark “vita” (which translates to the adjective “white” in English), the Court has found that the term is not descriptive of a characteristic of the goods concerned pursuant Article 7(1)(c) EUTMR. Thus, overturning the judgement made by the EUIPO and The Fifth Board of Appeal of EUIPO.

¹ Appendix 1.

European Union trade mark law consists to a large extent of legal standards found in European Union case law. As such, this thesis will examine the interpretation of Article 7(1)(c) EUTMR and how it should be utilised when assessing trade mark applications in which the signs consist of names of colours. This is achieved by analysing case law, the underlying interests of EUTMR and the EUIPO Guidelines for examination. This master thesis aims to provide a list of criteria for when signs consisting of names of colours may be registered as trade marks. Furthermore, it seeks to analyse whether this change in direction also applies in a broader sense regarding the general interpretation of Article 7(1)(c) EUTMR. The EUIPO Guidelines for Examination 2021 is included in order to determine which criteria are used by the EUIPO's examiners and how they are applied.

2. Problem statement

Derived from the considerations above, this thesis is built around the following problem statement;

An examination of the interpretation and application of Article 7(1)(c) of Regulation 2017/1001 – the main focus being the General Courts' interpretation expressed in judgement of 7 Maj 2019, Fissler GmbH v. EUIPO, T-423/18 (vita).

3. Delimitation

The focus of this master thesis is to examine the interpretation of descriptiveness as an absolute ground for refusal pursuant Article 7(1)(c) EUTMR, in particular the General Courts assessment thereof in T-423/18 (vita). The focus first and foremost being the assessment of the descriptiveness when a trade mark consists of the name of a colour. Secondary, the focus will be broadened thus examining whether the interpretation set out in T-423/18 (vita) can also be applied to a more general interpretation of Article 7(1)(c) EUTMR.

Introductory, it is made clear that this master thesis is based on European Union trade mark law, specifically focused on the unitary trade mark system which grants protection for trade marks throughout the Union. Therefore, this master thesis solely accounts for the European Union Trade Mark Regulation 2017/1001. However, it is recognised that the principles within the Regulation are largely transferable to national trade marks – and vice versa – due to the fact that the main provisions of substantive law within the Trade Mark Directive 2015/2436 and the European Union Trade Mark Regulation 2017/1001 are identical. Despite Member States not being directly bound by Community case law, or case law from other Member States, there is a great motivation to harmonise practices regarding assessing and registering trade marks. As a result, one of the focuses of The European Union Intellectual Property Network (hereafter: EUIPN) is to promote the development of common examination standards and practices for trade marks in cooperation

with national and regional Intellectual Property Offices in the European Union. “Common Communications” are used as a tool to harmonise practices across Member States, both on national levels and on a community level. Consequently, it is recognised that the interpretations originating from Community case law are applicable to national trade mark regulations to some extent and vice versa.

As mentioned above, the main focus of this master thesis is the absolute ground of refusal pursuant Article 7(1)(c) EUTMR, which prohibits descriptive signs from being registered as trade marks. In order to maintain a cohesive and coherent narrative, this master thesis will not account for all absolute grounds for refusal found in Article 7 EUTMR. Although the distinctiveness and descriptiveness assessments may be intertwined to some degree, this master thesis does not focus on the distinctiveness assessment. Instead, in chapter 6.5.1 “Absolute grounds for refusal”, the thesis briefly accounts for the absolute ground of refusal pursuant Article 7(1)(b) EUTMR which hinders the registration of signs that are devoid of any distinctive character. In chapter 6.5.3 “Intertwinement of the distinctiveness and descriptiveness assessments” it is explained how the distinctiveness and descriptiveness assessments are intertwined while explaining why it is possible – and a requirement – to keep the two assessments separated.

It is important to note that the courts interpret the descriptiveness assessment in a vast number of judgements. Thereto, the assessment may slightly differ depending on the category of characteristics the sign can be used to designate, since different considerations must be taken into account. This master thesis namely examines the interpretation of Article 7(1)(c) EUTMR as expressed in T-423/18 (*vita*) in which the assessment specifically concerns signs which consist of names of colours. Virtually, this master thesis seeks to determine whether the General Court is expressing a change in direction contrary to the one seen in judgment C191/01 P (*DOUBLEMINT*). These changes concerns most notably the descriptiveness assessment regarding signs consisting of names of colours but also the judgement’s applicability in a broader sense. The thesis does not focus on some of the more specific criteria that can be found regarding other categories of characteristics such as those laid down regarding, e.g., geographical indications.

4. Method

4.1 The legal dogmatic method

This master thesis is based on the legal dogmatic method. The focus is to describe and work with applicable law – *de lege lata* - to provide the most current and complete answer to the problem statement.²

² *Munk-Hansen, Carsten*, Retsvidenskabsteori, pp. 64-67 and pp. 204-225 and *Blume, Peter*, Retssystemet og Juridisk Metode, pp. 32-33.

The legal dogmatic method is used to describe, analyse and interpret applicable law. The legal basis includes European Union legislation and preambles, as well as relevant case law in which legislation is applied and interpreted in specific contexts. European Union legislation and case law are considered the primary sources of law for this project, whereby these form the overall framework for the project. European Union legislation is the primary source of law and its wording will be held above all.

In terms of this project, the preamble constitutes a significant interpretative contribution to the legislation, as these provide insight as to the legislator's intention and the underlying interests of the provisions.

However, European Union trade mark law is ordinarily sparse in words and elaborations. By its very nature, European Union trade mark law consists to a large extent of legal standards found in European Union case law. As such, European Union case law constitutes a primary source of law in this master thesis. The observations and reasonings found in judgements are an expression of the courts interpreting and applying legislation in practice thus justifying using case law as a primary source of law. Through case law, a standardised interpretation of legislation is developed. Courts and administrations alike refer to previous interpretations when deciding on a case. Naturally, it is not all interpretations that will set a precedent and the validity of an interpretation will increase the higher the court.

This master thesis focuses on the interpretation of descriptiveness as an absolute ground for refusal described in Article 7(1)(c) EUTMR. When analysing the interpretation of descriptiveness, the focus is the underlying purposes of the European Union Trade Mark Regulation and how the courts have decided to interpret and apply Article 7(1)(c) EUTMR through time. This is to a large extent an expression of the fact that in particular European legislation can seldomly stand alone. Legislation requires additional interpretation in the form of preambles and case law, in order to be fully understood and applied in practice.

Administrative practices and guidelines, and to a lesser extent legal literature, is used to shed further light upon the subject. However, the validity of these sources is lesser than legislation and case law, and for this reason, it will only be used to illustrate and support the points expressed in the primary sources of law.

4.2 The legal policy method

Although this thesis is designed to describe and analyse applicable law, there are chapters in which an assessment is given of the current and future legal situation on the area based on previous analyses. This assessment can be said to be an expression of the application of the legal policy method, *de lege ferenda*.³ The assessment is, however, solely made on the basis of a description, analysis, and assessment of *de lege*

³ *Munk-Hansen, Carsten, Retsvidenskabsteori*, pp. 73-75 and *Blume, Peter, Retssystemet og Juridisk Metode* p. 52.

lata and is not to be regarded as essential to the conclusion of the problem statement which purpose is to describe and analyse applicable law based on the legal dogmatic method.

4.3 The legal method

The following chapters are composed corresponding to the legal method, which is clearly expressed in chapters 5 to 10 making up the material substance of this master thesis. In short, this master thesis aims to determine applicable law concerning the descriptiveness assessment of European Union trade marks from the relevant sources of law by using interpretation and legal subsumption.⁴ In the following, it is detailed how the legal method constitutes the framework of this master thesis is found in the following.

Chapter 5 and 6 contain a relevant presentation and description of fact and law. Fact namely being the account for the purpose of trade marks in chapter 5. Law primarily being the account for trade mark law in the European Union in chapter 6 where the formal requirements and substantive examination pursuant EUTMR is accounted for. Moreover, the reasoning behind the European Union Trade Mark System, as expressed in both the preamble of the Lisbon Treaty and the preamble to EUTMR in Recitals 3 and 4, is accounted for.

In chapter 7 and 8 the understanding of fact and law is applied as a tool for an analysis of the assessment of descriptive marks exemplified in both previous case law and judgement T-423/18 (*vita*).

Subsequently, in chapters 9, 10 and 11, fact and law are compared in the form of a final assessment and perspectivation of the problem statement. The chapter should be seen as a junction of the previous chapters, thus bridging the thesis and answering the problem statement.

The final conclusion of this master thesis is found in chapter 10.

5. The purpose of trade marks

In order to properly understand the importance of trade mark regulation, and in particular the statutory absolute grounds for refusal, one must understand the underlying purposes of a trade mark.

Throughout the history of commerce, signs have served to indicate origination of products. Said signs thus enables the identification and distinguishing of goods originating from one source from those of a different source. With time and the liberalisation of markets, these signs have become a way of communication

⁴ *Munk-Hansen, Carsten, Retsvidenskabsteori*, pp. 193-204 and *Blume, Peter, Retssystemet og Juridisk Metode* pp. 175-181.

between producers and consumers. Allowing said consumers to repeat satisfactory purchases and avoid those that have been unsatisfactory.⁵

The purpose of protecting these signs is found in their capacity to enable consumers to make informed choices regarding their purchases. In turn, the protection given for such signs, provides an incentive for producers to invest in the quality of the goods or services they provide and to develop a larger variety of commodities.⁵ In doing so, producers can ensure that consumers will continue to purchase their goods or services and so the protection ensures that innovation is worthwhile.

Furthermore, trade marks can become much more than just a communication of origin of goods or services. In some instances, and when used alongside sophisticated marketing efforts, a trade mark can become a symbol of a certain lifestyle, prestige, or attitude. It goes without saying, that trade marks possessing this ability, are business assets and their value is more or less independent from the goods and services itself for which it is – or was originally – used.⁶

All things considered, trade marks are an important tool in enabling fair competition and consumer protection. However, it is detrimental to the function of trade marks that the acquisition of trade marks remains competition neutral. As such, a trade mark should not award its holder with a competitive advantage from which others are excluded. It complies with the underlying interests that new trade marks should be an infinite supply which allows new market entrants to choose a suitable sign unhindered. Consequentially, a protection of signs which are only available in limited stock e.g., colours and shapes, would entail obstacles for free competition.⁶ These underlying considerations of a trade mark system is further expanded on in 6.5.2 “The underlying interests of the absolute grounds for refusal within article 7(1)(c) EUTMR”, which evolves around the regulation of hindrances for protection of trade marks within the European Union.

In conclusion, it can be observed that the overall purpose of trade marks is to enable free and fair competition while to some extent also functioning as consumer protection.

6. Trade Mark law in the European Union

6.1 Legal basis of trade mark law in the European Union

The European Union trade mark law consists of two structures. First, the Trade Mark Directive 2015/2436 (also referred to as: TMD) which obligates the Member States to harmonise their national laws with the

⁵ Kur, Annette, Thomas Dreier and Stefan Luginbuehl, *European Intellectual Property Law*, p. 182.

⁶ Kur, Annette et al., *European Intellectual Property Law*, p. 183.

provisions set out in the Directive. Second, the European Union Trade Mark Regulation 2017/1001 which establishes a unitary right extending throughout the Union, thus creating intellectual property that defies the principle of territoriality.⁷

The European Union trade mark system is meant to coexist with the national trade mark systems, cf. Recital 8 of EUTMR. Due to this principle of coexistence, a number of interfaces exist between the two structures. First and foremost, the national trade marks and the European Union trade marks are equal rights. As such, they are mutually exclusive in case of conflict. In other words, a European Union trade mark cannot be registered if a prior national mark exists within the Union and vice versa. It is possible, for the same holder, to register the same sign within both the European Union trade mark system and a national trade mark system. However, Article 136 EUTMR imposes restrictions against proprietors bringing double actions for infringement based on a European Union trade mark and an identical national trade mark in different fora. Moreover, it is possible to convert a European Union trade mark application to a national trade mark application, cf. Articles 139 et seq. EUTMR. This is relevant in the case of existing obstacles for protection in one or more Member States. A conversion like this allows for the applicant to keep the earlier priority date from the European application. Lastly, the EUTMR provides the possibility of claiming seniority for a prior national trade mark, cf. Articles 39 et seq. EUTMR.⁸

The main provisions of substantive law within EUTMR and TMD are identical.⁹ As such, this includes the absolute grounds for refusal. Although the Member States are not directly bound by Community case law, or case law from other Member States pursuant the principle of territoriality, the identical substantive provisions within EUTMR and TMD entails that case law from the Court of First Instance, the General Court, and the Court of Justice of the European Union (hereafter: ECJ) regarding EUTMR has a corresponding effect on the understanding of TMD. Thereto, there is a great motivation to harmonise practices regarding the examination and registration of trade marks. As a result, The European Union Intellectual Property Network (EUIPN) has been created in order to bring together the national and regional Intellectual Property Offices in the European Union, the European Union Intellectual Property Office (also referred to as: EUIPO) and international partners to build a stronger Intellectual Property Network. One of their projects are the ECP4: Convergence of practises. The project focuses on promoting the development of common examination standards and practices. This includes the development and use of so-called “Common Practices”. Three of these Common Practices address areas of trade mark practice.¹⁰

⁷ Kur, Annette et al., *European Intellectual Property Law*, pp. 184-185.

⁸ Kur, Annette et al., *European Intellectual Property Law*, pp. 187-188.

⁹ Kur, Annette et al., *European Intellectual Property Law*, p. 188.

¹⁰ Tmdn.org, *European Cooperation in the EUIPN*.

Accordingly, it is assumed that the conclusions derived in this master thesis will be largely applicable to national trade marks as well.

6.2 Reasoning behind the European Union Trade Mark System

Initially, it is important to understand the purposes and goals for the establishment of the European Union in order to fully understand the reasoning behind adapting a European Union Trade Mark System. The purpose is found in the preamble of the Treaty on the Functioning of the European Union. One of the main focuses being to ensure the economic and social progress of the Member States by common action in order to eliminate the barriers which divide Europe. This involves recognising that the removal of existing obstacles calls for united action in order to guarantee a steady expansion, balanced trade and fair competition.¹¹ Consequentially, the Union has been given exclusive competence in the establishing of the competition rules necessary for the functioning of the internal market, cf. article 3 of the Lisbon Treaty.

This main purpose of the European Union is reiterated in the reasoning behind the European Union trade mark system as expressed in the preamble to the EUTMR in Recitals 3 and 4.

Recital 3 expresses a desire to promote a harmonious development of economic activities throughout the European Union. Furthermore, the European Parliament and the Council of the European Union express a desire to promote a continuous and balanced expansion of the internal market which functions properly and offers conditions that are similar to those that can be obtained within a national market. In order to establish such a market, the European Parliament and the Council of the European Union has found it necessary to establish legal conditions that enables undertakings to adapt their activities to the scale of the European Union, whether this be manufacturing and distributing goods or providing services. As such, trade marks that can enable goods and services of undertakings to be distinguished by identical measures are deemed desirable in order to pursue the aforementioned development of the internal market.

Recital 4 expresses the necessity of having a single procedural system to obtain such a European Union trade mark to which uniform protection is given in order to pursue the abovementioned purposes.

In recital 5, it is submitted that the barrier of territoriality of trade marks pursuant the laws of the Member States cannot be removed by approximation of laws. In order to open up unrestricted economic activity in the whole of the internal market for the benefit of undertakings, the European Parliament and the Council

of the European Union find that it should be possible to register trade marks which are governed by a uniform Union law directly applicable in all Member States.

All in all, the European Union Trade Mark System is the result of a desire to promote a harmonious development of economic activities throughout the European Union as well as a continuous and balanced expansion of the internal market. Since the establishment, the European Union trade mark system has proven very successful.¹²

6.3 Obtaining a European Union Trade Mark

The European Union trade mark system is administrated by the European Union Intellectual Property Office. The EUIPO are responsible for, inter alia, granting European Union trade marks.¹³ They carry out examination, registration, opposition and cancellation procedures for European Union trade marks. The regulation of the registration proceedings is found in the Commission Implementing Regulation 2018/626 and the Commission Delegated Regulation 2018/625.

A decision made by the EUIPO can be appealed to the Boards of Appeal of the Office. Decisions of the Boards of Appeal can be appealed to the General Court – or to the ECJ in cases regarding points of law.¹⁴

6.3.1 Introductory on the EUIPO Guidelines on descriptive marks

The EUIPO's current trade mark practice is reflected in a series of Guidelines which are revised yearly. These Guidelines are intended to be of practical use to the EUIPO's staff who are in charge of the examination, registration, opposition, and cancellation procedures for trade marks – while also being helpful for the users of the EUIPO's services. The guidelines are merely an expression of self-imposed rules of conduct adopted by an administrative decision. The current guidelines on European Union trade marks have been adopted by the Executive Director on 8 February 2021 and has entered into force on 1 March 2021.¹⁵

6.5 Formal requirements and substantive examination

In order to obtain a European Union trade mark, the application must meet the formal requirements pursuant Article 31 EUTMR. The article sets out the minimum requirements of which an application for a European Union trade mark must meet:

¹² Preamble to Recital 6 of the European Union Trade Mark Regulation 2017/1001 and *Kur, Annette et al.*, European Intellectual Property Law, pp. 184-185.

¹³ euipo.europa.eu, *Who we are*.

¹⁴ *Kur, Annette et al.*, European Intellectual Property Law, pp. 190-191.

¹⁵ Introduction to Guidelines for Examination in the Office 2021.

1. An application for an EU trade mark shall contain:
 - (a) a request for the registration of an EU trade mark;
 - (b) information identifying the applicant;
 - (c) a list of the goods or services in respect of which the registration is requested;
 - (d) a representation of the mark, which satisfies the requirements set out in Article 4(b).

In order for the application to be considered complete, the application fees must naturally be paid, cf. Article 31(2) EUTMR.

When all formal requirements are met, the EUIPO commences an examination of eligibility for registration pursuant Article 4 EUTMR and of absolute grounds for refusal pursuant Article 7 EUTMR. The office carries out the examination ex officio, cf. Article 42(1) EUTMR. Third parties are also allowed to file observations as to why a mark should not be registered due to the grounds for refusal pursuant Article 4 and 7 EUTMR, cf. Article 45 EUTMR. Should the examiner find that absolute grounds for refusal exist for some or all of the goods or services for which registration is sought, the application is to be refused as regards those goods or services, cf. Article 42(1) EUTMR. However, the applicant must be given the opportunity to withdraw or amend the application or submit his own observations regarding the grounds for refusal, cf. Article 42(2) EUTMR.

If no absolute grounds for refusal are found to exist, the application is published in the Official Gazette of the EUIPO, cf. Article 44(1) EUTMR. However, should such absolute grounds for refusal de facto exist the Office is to publish the refusal instead, cf. Article 44(2) EUTMR.

6.5.1. Absolute grounds for refusal

The absolute grounds for refusal are found in Article 7 EUTMR which lists the grounds for when an application must be refused registration ex officio.

First and foremost, a sign is not to be registered if it does not conform to the requirements of article 4 EUTMR, cf. Article 7(1)(a) EUTMR. The article determines which signs a European Union trade mark may consist of while determining the requirements for representation of the mark within the application.

A European Union trade mark may consist of any sign that is capable of:

- (a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- (b) being represented on the Register, in a manner which enables the authorities and the public to determine the clear and precise subject matter of the protection claimed by the proprietor.

In addition, the so-called “Sieckmann test”, originating from the Judgment of 12 December 2002, C-273/00 (*Sieckmann*) (hereafter: C-273/00 (*Sieckmann*)), lists a number of criteria that the representation of the mark must meet. It must be noted that the judgment originates from before the new regulation 2017/1001, where “clear and precise” has been introduced in the wording of Article 4(b). The criteria within the Sieckmann test are assumed to be continuously applicable since it is still referenced in the EUIPO Guidelines for Examination of 1 March 2021 regarding the requirements for representation in the register.¹⁶

Following C-273/00 (*Sieckmann*) a sign can only be considered registrable if it can be represented in a manner which is:

- 1) Clear and precise, cf. paragraph 50 and 51.
- 2) Self-contained, easily accessible and intelligible, cf. paragraph 52.
- 3) Durable and objective, cf. paragraph 53 and 54.

A sign which does not meet the abovementioned cumulative criteria is not eligible for registration as a trade mark. In addition, the two essential reasons for refusal in practice are Article 7(1)(b) EUTMR regarding the requirement of distinctiveness and Article 7(1)(c) EUTMR regarding descriptiveness.¹⁷

The focus of this master thesis is the ground for refusal pursuant Article 7(1)(c) EUTMR, which is the non-registrability of trade marks that are descriptive of the goods or services for which protection is sought. The wording of the article entails that a mark is to be considered descriptive when it contains conceptual content that indicates a characteristic of the goods or services for which protection is claimed.¹⁸ The reference base as to when a sign designates a characteristic pursuant the provision, is the ordinary understanding of the relevant public of said sign in relation to the goods or services in question. During the examination of descriptiveness, this reference base is typically corroborated by dictionary entries, examples of the use of the term in a descriptive manner found on internet websites, or it may just clearly follow from the ordinary understanding of the term.¹⁹

The article lists examples of characteristics that are caught by the provision, but it is important to note that the list is not to be considered exhaustive, cf. the wording “or other characteristics”. The examples mentioned in the article are “*kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service*”. However, a sign is only non-registrable if the

¹⁶ Guidelines for Examination in the Office 2021, Part B Examination, p 342.

¹⁷ Analogous *Wallberg Mikael, Knud and Francke Ravn*, Varemærkeloven med kommentarer, p 84.

¹⁸ Analogous *Wallberg Mikael, Knud et al.*, Varemærkeloven med kommentarer, p 321.

¹⁹ Guidelines for Examination in the Office 2021, Part B Examination, p. 428.

entirety of the mark is descriptive as emphasised by the wording “*trade marks which consist exclusively of [...]*” in the provision.²⁰

Since the assessment of descriptiveness is naturally intertwined with the assessment of distinctiveness, the ground for refusal pursuant Article 7(1)(b) EUTMR must be briefly mentioned. Article 7(1)(b) EUTMR concerns the non-registrability of marks that are devoid of any distinctive character. The intertwining of the two assessments will be further accounted for in section 6.5.3 below.

It is important to observe that the absolute grounds for refusal apply even though the grounds for non-registrability only exist in parts of the European Union, cf. Article 7(2) EUTMR. For example, it suffices for a refusal of registration that a trade mark is descriptive, or lacks distinctive character, in any one of the official languages of the European Union, cf. judgement of 3 July 2013, *Airbus SAS v. OHIM, T-236/12 (NEO)*, paragraph 57.

Lastly, a trade mark can acquire distinctiveness for some goods or services through use. In such a scenario, the trade mark cannot be refused registration on the grounds of being devoid of distinctive character or being descriptive, cf. Article 7(3) EUTMR.

6.5.2 The underlying interests of the absolute ground of refusal pursuant article 7(1)(c) EUTMR

As illustrated above, in chapter 5 “The purpose of trade marks” and chapter 6.2 “Reasoning behind the European Union Trade Mark System”, the main underlying interests of the trade mark regulation, are to ensure free and fair competition. A number of considerations arise from these main interests. One of them being to prevent trade marks from being protected, if they confer a competitive advantage on its holder.²¹ In the preamble to EUTMR recital 21, the European Parliament and the Council of the European Union expresses that the exclusive rights conferred by a European Union trade mark should not entitle the proprietor to prohibit the use of signs or indications by third parties which are used fairly and thus in accordance with honest practices in industrial and commercial matters. As such, the European Parliament and the Council of the European Union submits that the regulation should permit the use of descriptive or non-distinctive signs, in order to ensure equal conditions. In accordance with these considerations, it must be considered an unfair advantage, should one producer hold the exclusive right to a descriptive term that is able to describe characteristics of certain goods or services. Such terms must therefore be excluded from

²⁰ Analogous *Wallberg Mikael, Knud et al.*, *Varemærkeloven med kommentarer*, p 320-321.

²¹ Kur, Annette et al., *European Intellectual Property Law*, pp. 183.

protection to remain freely available to all undertakings in order to ensure that competition is not distorted, cf. the preamble to EUTMR, recital 3.

Consequently, it is specifically stated in Article 14(1)(b) EUTMR that *“An EU trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade [...] signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services”*. It is however a requirement that the third party uses the sign in accordance with honest practices when used in industrial or commercial matters, cf. Article 14(2) EUTMR.

These interests are further expressed in settled case law. In joined cases of 4 May 1999, C-108/97 and C-109/97 (*Windsurfing Chiemsee*) (also mentioned as: C-108/97 and C-109/97 (*Windsurfing Chiemsee*)), paragraph 25, the Court submits that Article 3(1)(c) of the previous Trade Mark Directive (identical to Article 7(1)(c) EUTMR) pursues an aim which is in the public interest. This interest namely being *“ [...] that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all [...]. Article 3(1)(c) TMD therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks”*. This has been reiterated in many rulings since e.g., joined cases of 8 April 2003, C-53/01 to C-55/01 (*Linde and Others*), paragraph 73, judgement of 6 May 2003, C-104/01 (*Libertel*), paragraph 52 and judgement of 12 February 2004, C-363/99 (*PostKantoor*), paragraph 55.

6.5.3 Intertwinement of the distinctiveness and descriptiveness assessments

As mentioned above, the distinctiveness and descriptiveness assessments are intertwined to some degree. It is observed in EUIPO Guidelines for examination 2020 and 2021 that should a word mark be descriptive of characteristics of goods or services pursuant Article 7(1)(c) EUTMR, it would as a result thereof necessarily be devoid of any distinctive character pursuant Article 7(1)(b) EUTMR regarding those same goods or services.²² This is also observed in settled case law. Similar to that logic, a term which is not necessarily considered descriptive within the meaning of Article 7(1)(c) EUTMR, might be considered void of any distinctive character due to it being perceived by the relevant public as merely informative of the nature of the goods or services concerned. As such, the mark will be considered void of any distinctive character due to it not being perceived as an indication of origin of commerce by the relevant public.²³

²² Guidelines for Examination in the Office 2020, Part B Examination, p 317 and Guidelines for Examination in the Office 2021, Part B Examination, p 367, cf. T-190/05, *Twist & Pour*, paragraph 39.

²³ Guidelines for Examination in the Office 2020, Part B Examination, p 317 and Guidelines for Examination in the Office 2021, Part B Examination, p 367, cf. T-470/09, *Medi*, paragraph 22.

Finally, a mark could also be considered non-registrable within the scope of Article 7(1)(b) EUTMR in cases where the lexical structure employed can be considered common within advertising and the commercial context in question – despite the lexical structure not being grammatically correct.

Notwithstanding the abovementioned correlation between the two assessments, it is important to maintain that each of the absolute grounds for refusal listed in Article 7(1) EUTMR are independent of the others, cf. joined cases of 8 April 2003, C-53/01 to C-55/01 (*Linde and Others*), paragraph 67, joined Cases of 29 April 2004, *Henkel v OHIM*, C-456/01 P and C-457/01 P (*Henkel*), paragraph 45. As such, they require separate examination even though there is an obvious degree of overlap between their respective scopes.²⁴ As a result hereof and in order to maintain a coherent narrative, the analysis of T-423/18 (*vita*) will focus solely on the General Courts remarks in relation to the descriptiveness assessment.

7. European Union case law on descriptive marks prior to T-423/18 (*vita*)

In every European Member State, it is a common truth that regulation and case law go hand in hand. This holds especially true for trade marks. While the former creates a general sense of the framework which all companies, administrative offices and courts has to abide by, it is more often than not the latter that are looked towards when interpreting applicable law. As mentioned in chapter 6.1. “Legal basis of trade mark law in the European Union”, the absolute grounds for refusal in TMD and EUTMR are identical, thus making principles regarding the assessment of National Trade Marks largely applicable to European Union Trade Marks as well. As such, the following presentation of relevant case law also includes judgements interpreting Article 4(1)(c) TMD (identical to the former Article 3(1)(c) from Directive 89/104/EEC).

Throughout the years, the Court of First Instance, the General Court, and the ECJ have had several chances to weigh in on the interpretation of the descriptiveness assessment. Many of these cases have formed our current understanding of European Union trade mark regulation and how it should be interpreted. This practise is also reflected in the EUIPO Guidelines, which is renewed yearly to incorporate new relevant case law.

In the following, this master thesis aims to analyse a list of selected case law and trade mark applications that is considered to describe the most important criteria used in the assessment of Article 7(1)(c) EUTMR. Some of which has shaped the interpretation of Article 7(1)(c) EUTMR in general while other are included because they have directly impacted the “traditional” view of signs consisting of names of colours. The purpose of this list is to illustrate the often conflicting interpretation of the provision and how it has evolved throughout

²⁴ T-133/19 (*OFF-WHITE*), paragraph 50.

the years. These short analyses will primarily focus on the courts' findings as regards the interpretation of Article 7(1)(c) EUTMR and how the EUIPO has, on the basis of these judgements, adapted their examination of trade mark applications accordingly.

When comparing the 2021 version of the EUIPO Guidelines to the 2020 version of the guidelines, it is evident that notable changes have been made to the examination of signs consisting of names of colours subsequent to judgement T-423/18 (*vita*).²⁵ A further examination of this change is carried out in chapter 8.2.3 "Precedent value of T-423/18 (*vita*)" of this master thesis. Both versions of the guidelines provide a list of real-life examples of refused and accepted applications for signs consisting of names of colours. This list of examples has changed in the most recent version, which was implemented after T-423/18 (*vita*). To further illustrate the previous practice of examining signs consisting of names of colours, this chapter will examine the cases mentioned within the EUIPO Guidelines from 2020 as well as the reasoning behind the given refusal or acceptance. How these examples could have been examined differently is explored in chapter 10 "A comparison of the interpretation of descriptiveness – A change in direction".

7.1 C-108/97 and C-109/97 (*Windsurfing Chiemsee*)

The *Landgericht München I* (Regional Court, Munich I) refers to the ECJ the question of whether all registrations for geographically descriptive marks must be refused under the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States (hereafter: Directive 89/104/EEC).

The case is centred around the mark "Chiemsee". Chiemsee is the name of the largest lake in Bavaria, Germany. The company *Windsurfing Chiemsee* is located near the shores of the lake and sells sports goods, clothing and shoes. Between 1992 and 1994, *Windsurfing Chiemsee* registered the trademark "Chiemsee" as a picture trade mark in the form of various graphic designs under German law.

Since 1995 *Segelzubehör Walter Huber* has been selling sportswear in a town near Chiemsee. Their clothing also bears the name of the lake, but it is portrayed in a different graphic form than the *Windsurfing Chiemsee* trade mark.

In their judgement the ECJ notes that "[...] Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex

²⁵ Guidelines for Examination in the Office 2021, Part B Examination, p 455 ff. and Guidelines for Examination in the Office 2020, Part B Examination, p 395 ff.

or graphic marks.”²⁶ As a result, Article 3(1)(c) TMD prevents such signs and indications from being monopolised by one brand alone through trade mark registration.

It is in the public’s interest that signs or indications which may serve to designate the geographical origin of the goods remain available. The ECJ reasons that especially geographical names may be “[...] *an indication of the quality and other characteristics of the categories of goods concerned* [...]”²⁷, which in turn may influence the consumer by associating the goods with a place that leads to a more favourable response.²⁷

The Court concludes that Article 3(1)(c) of Directive 89/104/EEC is to be interpreted as meaning that it does not only prohibit the registration of geographical names as trade marks when the relevant public *currently* associates the designated place with the category of goods for which registration is sought, it also “[...] *applies to geographical names which are liable to be used in future* [emphasis added] *by the undertakings concerned as an indication of the geographical origin of that category of goods* [...]”²⁸.

If there is no *current* association between the designated place and the goods for which registration is sought in the minds of the relevant public, the competent authority must look at the application on a case-to-case basis and assess whether or not it is reasonable to *assume* that the geographical name, in the mind of the relevant public, has the capability of designating the geographical origin of the goods.²⁹

This case illustrates how narrow the interpretation of descriptiveness can be, in the interest of keeping descriptive terms free to use for all traders. If there is no current association between the descriptive term for which registration is sought and the goods in question, the Court concludes that a secondary assessment must be made. This is to determine whether or not it can be assumed that the word mark applied for has the capability of designating *the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service*³⁰ – in the future. According to the dictionary, the word “assume” is used in situations when a person is making a guess based on little or no evidence.³¹ The use of the word “assume” might be considered harmful to applicants for whom it will be difficult to decipher the legal status.

Such a characteristic as mentioned above could, for many classes of goods, be the name of a colour.

²⁶ C-108/97 and C-109/97 (*Windsurfing Chiemsee*), paragraph 25.

²⁷ C-108/97 and C-109/97 (*Windsurfing Chiemsee*), paragraph 26.

²⁸ C-108/97 and C-109/97 (*Windsurfing Chiemsee*), paragraph 55(1).

²⁹ C-108/97 and C-109/97 (*Windsurfing Chiemsee*), paragraph 55.

³⁰ Article 7(1)(c) EUTMR.

³¹ Merriam-webster.com, *Dictionary on “assume”*.

In the EUIPO Guidelines from 2021 under chapter 5.2 “Need to keep free” it is mentioned that applicants often argue that other traders do not need the term which the application concerns, that other traders still have other terms which are more direct and straightforward at their disposal or that there are plenty of synonyms which works all the same. According to the EUIPO Guidelines, this argumentation must be dismissed by the examiner and deemed irrelevant for the examination of the possible descriptiveness of the sign in question.

With reference to joined cases C-108/97 and C-109/97 (*Windsurfing Chiemsee*) the chapter concludes that the underlying public interest of Article 7(1)(c) EUTMR is to protect the marked from the registration of descriptive terms so they may remain freely available to all competitors, and when the Office refuses an application on these grounds, it is not necessary for them to make evident, on the part of third parties, that there are any present or future need to use, or even possible interest in using, the descriptive term for which registration is sought.³²

7.2 T-135/99 (*CINE ACTION*)

In judgement of 31 January 2001, Taurus-Film GmbH & Co v. OHIM, T-135/99 (*CINE ACTION*) (hereafter: T-135/99 (*CINE ACTION*)), Taurus-Film GmbH & Co brings an application to annul the refusal of registration of “Cine Action”. Registration is sought in relation to wireless or networked broadcast of radio and television transmission/programs, production, reproduction, showing and rental of film, allocation and transfer of rights of access for users of various communication networks and more.³³

In their refusal, the Board of Appeal notes that the term “Cine Action” may serve as descriptors of certain characteristics of the goods – mainly action films as a movie genre. The Board also observes that “Cine” signifies cinematography, cinema, cinema film and film in several European languages, and so the mere combination of the two words may serve to describe the characteristics of certain goods – namely action films.³⁴

The Court notes that the purpose of the sign “Cine Action” is to enable the target demographic “[...] to establish immediately and without further reflection a concrete and direct relationship with the majority of the services in question, particularly those which may concretely and directly concern the product “action film” or the production or transmission of the latter.”³⁵ However, this is not the case for all categories of services for which registration is sought – such as technical, legal, management or organisational

³² Guidelines for Examination in the Office 2021, Part B Examination, p 335.

³³ T-135/99 (*Cine Action*), paragraph 1-10.

³⁴ T-135/99 (*Cine Action*), paragraph 26.

³⁵ T-135/99 (*Cine Action*), paragraph 27.

services.³⁶ The Court thus concludes that the term “Cine Action” does not enable the target demographic to “[...] discern immediately and without further reflection the description of one of their characteristics for the purposes of Article 7(1)(c) of Regulation No 40/94.”³⁷ As such the relation between the sign “Cine Action” and the technical, legal, management or organisational services is too vague to characterise the term “Cine Action” as being descriptive in regards to those services specifically.³⁷

This judgement illustrates that a term may allude to certain characteristics of the goods or services in question and not be refused registration, as long as the relationship between the trade mark and the goods or services is sufficiently vague or indirect. This distinction is now incorporated in the EUIPO’s practice as detailed in the EUIPO Guidelines from 2021 under chapter 1.1 “The notion of descriptiveness”.³⁸

7.3 C-383/99 P (*BABY-DRY*)

In judgement of 20 September 2001, Procter & Gamble Company v. OHIM, C-383/99 P (*BABY-DRY*) (hereafter: C-383/99 P (*BABY-DRY*)), Procter & Gamble Company brings an appeal against the refusal to register “BABY-DRY” as a trade mark in respect of disposable diapers made out of paper or cellulose and diapers made out of textile.³⁹

Registration is refused by OHIM – a decision later confirmed by the Court of First Instance.

The ECJ notes that the purpose of Article 7 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (now Article 7 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark) is to prevent registration of signs or indications which cannot serve to help consumers identify the undertaking of the goods or services, because they are too similar to the usual signs or indications which is used to designate the relevant goods or services or their characteristics. Such a sign or indication is devoid of the distinctive character needed for that particular function and cannot be registered.

According to the ECJ, one must look to the goods concerned when assessing the degree of descriptiveness for a given mark. In relation to composite marks made up of two separate words, one should focus on whether or not the word combination in question is the normal way of referring to the goods or services or of their essential characteristic.⁴⁰

³⁶ T-135/99 (*Cine Action*), paragraph 28.

³⁷ T-135/99 (*Cine Action*), paragraph 29.

³⁸ Guidelines for Examination in the Office 2021, Part B Examination, p 428.

³⁹ C-383/99 P (*BABY-DRY*), paragraph 1.

⁴⁰ C-383/99 P (*BABY-DRY*), paragraph 40.

In the overall assessment of the word combination “BABY-DRY” the ECJ looked to the English-speaking consumer, to determine whether or not “BABY-DRY” is a normal way of referring to the goods for which registration is sought or their essential characteristics in everyday speech.⁴¹

In this specific case, the ECJ concluded that *“Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics.”*⁴²

Thus, it is found by the ECJ that the combination of the words “BABY” and “DRY” does not display descriptive character. The ECJ considers “BABY-DRY” to consist of “[...] *lexical inventions bestowing distinctive power on the mark so formed* [...]”⁴³. As such, it is concluded by the ECJ that the mark cannot be refused registration under Article 7(1)(c) of Regulation No 40/94.

Despite the clear connection between the words “BABY” and “DRY” and the essential characteristics of nappies the ECJ still carries out an in-depth analysis of the word combination as a whole and with consideration to the English-speaking public. In this case, the ECJ therefore displays a substantially more lenient interpretation of Article 7(1)(c) – as opposed to C-108/97 (*Chiemsee*) which is examined in chapter 7.1 “C-108/97 and C-109/97 (*Windsurfing Chiemsee*)” and C-363/99 (*Postkantoor*) which is examined in chapter 7.6 “C-363/99 (*Postkantoor*)”.

In subsequent case law, e.g., T-135/99 (*CINE ACTION*), it has been derived from C-383/99 P (*BABY-DRY*) “[...] *that the absolute grounds for refusal set out in Article 7(1)(b) and (c) of Regulation No 40/94 can be assessed only in relation to the goods or services in respect of which registration of the sign is applied for* [...]”.⁴⁴

Consequently, the judgement illustrates that the conjunction of several descriptive terms is not automatically considered descriptive. If the conjunction of the terms forms a lexical invention that enables the consumer to identify it as a sign communicating origin of commerce, the sign is registrable. It further illustrates that a case-by-case assessment is to be made specifically in relation to the goods or services for which registration is sought.

⁴¹ C-383/99 P (*BABY-DRY*), paragraph 42.

⁴² C-383/99 P (*BABY-DRY*), paragraph 43.

⁴³ C-383/99 P (*BABY-DRY*), paragraph 44.

⁴⁴ T-135/99 (*CINE ACTION*), paragraph 25.

7.4 C-191/01 P (*DOUBLEMINT*)

The OHIM brings an appeal against the judgment of the Court of First Instance in which the Court of First Instance annuls the dismissal of Wm. Wrigley Jr. Company's appeal against the refusal to register the word "DOUBLEMINT". The trade mark has been sought registered for various classes of goods – most notably chewing gum.⁴⁵

In their appeal, the OHIM argues that a term such as "DOUBLEMINT" "[...] *does not cease to be descriptive simply because it can have several meanings and is therefore ambiguous. In the mind of the average consumer, DOUBLEMINT is spontaneously associated with certain potential characteristics of the goods in question, namely their mint-based composition and their mint flavour [...]*".⁴⁶ The OHIM concludes that the term "DOUBLEMINT" is indeed descriptive of the goods for which registration is sought, and as such, cannot be allowed registration as a trade mark cf. Article 7(1)(c) of Regulation No 40/94.⁴⁶

The ECJ concludes that a refusal citing Article 7(1)(c) of Regulation No 40/94 does not require the sign applied for and its indications to actually be used in a descriptive manner regarding the goods or services for which registration is sought or even its characteristics at the time of the application. It is stated by the ECJ that the wording of Article 7(1)(c) of Regulation No 40/94 indicates that the mere possibility of the sign and its indications being used as such designators of characteristics is enough for the application to be refused registration.⁴⁷

In regard to the contested judgement, the Court of First Instance concludes that "DOUBLEMINT" "*cannot be characterised as exclusively descriptive*"⁴⁸ and that "[...] *signs and indications whose meaning goes beyond the merely descriptive [...]*"⁴⁸ are qualified for registration. The ECJ notes that by using this argumentation, the Court of First Instance is interpreting the provision as precluding registration if the sign is exclusively descriptive of the goods or services for which registration is sought, or of its characteristics.⁴⁸ The ECJ finds that in doing so, the Court of First Instance applies a test based on whether the term "DOUBLEMINT" is exclusively descriptive. The ECJ concludes that this is not in fact the test laid down by the provision.⁴⁹ The Court of First Instance thus fails to determine whether or not the sign is capable of being used by other traders to designate characteristics of their goods or services, as listed in the provision⁵⁰, and consequently

⁴⁵ C-191/01 P (*DOUBLEMINT*), paragraph 1.

⁴⁶ C-191/01 P (*DOUBLEMINT*), paragraph 20.

⁴⁷ C-191/01 P (*DOUBLEMINT*), paragraph 32.

⁴⁸ C-191/01 P (*DOUBLEMINT*), paragraph 33.

⁴⁹ C-191/01 P (*DOUBLEMINT*), paragraph 34.

⁵⁰ C-191/01 P (*DOUBLEMINT*), paragraph 35.

“[...] erred as to the scope of Article 7(1)(c) of Regulation No 40/94.”⁵¹ The ECJ thus concludes that the appeal is well founded under those circumstances.⁵² The ECJ annuls the contested judgement, and the case is referred back to the Court of First Instance.⁵³

In the EUIPO Guidelines from 2021 under chapter 5.1 “Term not used” it is explained that it is irrelevant for the examination of the sign, whether or not a descriptive use of the sign in question can be ascertained. According to the wording of Article 7(1)(c) EUTMR the mere possibility of the sign being used to designate characteristics of the goods and services will suffice.⁵⁴ It is also explained in the EUIPO Guidelines from 2021 under chapter 5.4 “Double meaning” that should the sign concerned have two or more meanings at least one of the possible meanings being descriptive will suffice for a refusal.⁵⁵ Both chapters cite Case C-191/01 P (*DOUBLEMINT*).

The EUIPO Guidelines clearly demonstrate that C-191/01 P (*DOUBLEMINT*) is paving the way for an extensive interpretation of Article 7(1)(c) EUTMR and for when a sign can be refused registration on the grounds of being descriptive as described in the provision. A vast number of subsequent refusals have been justified by referring to C-191/01 P (*DOUBLEMINT*).

Concluding on the above, C-191/01 P (*DOUBLEMINT*) can be said to have had a considerable impact on the descriptiveness assessment, seemingly allowing examiners to refuse to register signs of which at least one of its possible meanings designates a characteristic of the goods or services concerned. The possible future impact that T-423/18 (*vita*) will have on this broad interpretation and usage of C-191/01 P (*DOUBLEMINT*) is further examined in chapter 10 “A comparison of the interpretation of descriptiveness – A change in direction”.

7.5 C-265/00 (*BIOMILD*)

In judgment of 12 February 2004, *Campina Melkunie BV v. Benelux-Merkenbureau* (Benelux Trade Mark Office), C-265/00 (*BIOMILD*) (hereafter: C-265/00 (*BIOMILD*)), Benelux-Gerechtshof (Benelux Court of Justice) refers to the court for a preliminary ruling on, i.a., the interpretation of Articles 3(1) of Directive 89/104/EEC (identical to Article 7(1)(c) EUTMR). The questions are raised in relation to Campina Melkunie BV’s wish to register the sign “BIOMILD” and the Benelux Trade Mark Office’s refusal hereof. The Benelux Trade Mark

⁵¹ C-191/01 P (*DOUBLEMINT*), paragraph 36.

⁵² C-191/01 P (*DOUBLEMINT*), paragraph 37.

⁵³ C-191/01 P (*DOUBLEMINT*), paragraph 39.

⁵⁴ Guidelines for Examination in the Office 2021, Part B Examination, p 335.

⁵⁵ Guidelines for Examination in the Office 2021, Part B Examination, p 336.

Office finds that the neologism “BIOMILD” conveys to the consumer that the goods in question are both “biological” and “mild”⁵⁶.

The Court however finds that a sign which consists of a neologism formed by a combination of elements such as “BIOMILD”, does not automatically classify as a descriptive mark when each element of which the neologism consists of is descriptive. The sign for which registration is sought must be found descriptive in and of itself.⁵⁷

The Court reiterates, referring to C-191/01 (*DOUBLEMINT*), that it is not necessary that the sign and its indications at the time of the application are used in a way which makes it descriptive of the categories of goods or services for which registration is sought or their characteristics. According to the wording of Article 3(1)(c) of the Directive, it is sufficient that the possibility of using the sign and its indications for such purposes even exists. As a result, a sign must be refused registration pursuant Article 3(1)(c) of the Directive “[...] *if at least one of its possible meanings designates a characteristic of the goods or services concerned* [...]”.⁵⁸

The Court thus notes that, as a general rule, the mere combination of elements will remain descriptive within the meaning of Article 3(1)(c) of the Directive, if each element, by itself, is descriptive of characteristics of the goods or services for which registration is sought. This holds true even if a neologism is created, as long as no unusual variations in the meaning or otherwise is introduced.⁵⁹ An exception to this general rule, is if the word combination creates an impression which is sufficiently far removed from the impression that is created by the mere sum of its elements. This concerns both the aural and the visual impression created by the sign.⁶⁰

Finally, the court concludes that the answer to the question referred to them by the Benelux Court of Justice must be, that a sign consisting of a neologism composed of elements which are descriptive of the goods or services for which registration is sought or its characteristics, will be deemed descriptive, unless there is a distinctive difference between the neologism and the mere sum of its elements.⁶¹ Consequently, “BIOMILD” is refused registration.

This judgement establishes that a trade mark may compose of descriptive elements without being automatically refused registration. Despite the descriptive elements, one should still make a case-by-case

⁵⁶ C-265/00 (*BIOMILD*), paragraph 16.

⁵⁷ C-265/00 (*BIOMILD*), paragraph 37.

⁵⁸ C-265/00 (*BIOMILD*), paragraph 38.

⁵⁹ C-265/00 (*BIOMILD*), paragraph 39.

⁶⁰ C-265/00 (*BIOMILD*), paragraph 40.

⁶¹ C-265/00 (*BIOMILD*), paragraph 43.

assessment of the overall impression of the sign as a whole in relation to the goods and services concerned and its characteristics. This seems to elaborate on the criterion established by C-383/99 P (*BABY-DRY*) which focuses on whether the consumer will be able to understand the sign as communicating origin of commerce.

The EUIPO Guidelines from 2021 also references this case under chapter 2.2 “Combinations of words” and concludes that the expressions “unusual nature of the combination”, “impression sufficiently far removed” and “more than the sum of its parts” should be interpreted as meaning that a mark will not be refused registration on the grounds of descriptiveness, so long as the neologism itself is “fanciful”.⁶²

7.6 C-363/99 (*Postkantoor*)

In judgement of 21 December 2004, Koninklijke KPN Nederland NV v. Benelux-Merkenbureau (Benelux Trade Mark Office), C-363/99 (*Postkantoor*) (hereafter: C-363/99 (*Postkantoor*), the Gerechtshofte's-Gravenhage (Regional Court of Appeal, The Hague) refers to the ECJ for a preliminary ruling pursuant to, i.a., the interpretation of Articles 3(1)(c) of Directive 89/104/EEC.⁶³

The question has been raised in proceedings concerning the registration of “Postkantoor” applied for by KPN for various goods and services, and Benelux Trade Mark Office’s refusal of said registration.⁶⁴

As in C-265/00 (*BIOMILD*), the Court concludes that Article 3(1)(c) of Directive 89/104/EEC must be interpreted as meaning that a mark which consist of signs that are descriptive of characteristics of the goods or services for which registration is sought, “[...] *is itself descriptive of the characteristics of those goods or services for the purposes of that provision, unless there is a perceptible difference between the word and the mere sum of its parts [...]*”.⁶⁵

As such, the Court finds that a sign consisting of elements which are descriptive of characteristics of the good or services may not be refused on the ground of Article 3(1)(c), if the combination of the elements in relation to the goods or services are sufficiently far removed from each other in the mind of the consumer.⁶⁶ This would be the situation where the combination of the elements removes the meaning of the individual words when used independently. It would also be the case where a word combination becomes a part of the day-to-day language and acquires a new meaning on its own. If the latter is the case, an individual assessment of

⁶² Guidelines for Examination in the Office 2021, Part B Examination, p 434.

⁶³ C-363/99 (*Postkantoor*), paragraph 1.

⁶⁴ C-363/99 (*Postkantoor*), paragraph 2.

⁶⁵ C-363/99 (*Postkantoor*), paragraph 127(5).

⁶⁶ C-363/99 (*Postkantoor*), paragraph 99.

the elements must be made, to ensure that its new meaning is not in and of itself descriptive of the goods or services for which registration is sought.⁶⁵

Furthermore, the Court states that it is irrelevant whether or not the designated characteristics are “[...] *commercially essential or merely ancillary*.”⁶⁷ According to the wording of the provision, no distinction should be made between the characteristics designated by the sign or its elements. In fact, considering the underlying public interest of Article 3(1)(c) of the Directive, “[...] *any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially*.”⁶⁷

As illustrated in C-191/01 P (*DOUBLEMINT*), in which the Court determines that the mere possibility of the sign being used to designate characteristics of the good or services would lead to refusal pursuant Article 7(1)(c) EUTMR, the Court once again interprets the scope of the provision in a broad sense, in the name of the underlying public interest, by concluding that any characteristics of the goods or services, essential or otherwise, will be caught by the prohibition within Article 7(1)(c) EUTMR.

From these judgements, a kind of no tolerance policy in regard to descriptiveness is observed, which leaves almost no room for a case-by-case interpretation of the actual descriptiveness under the given circumstances, namely the specific goods or services in question.

7.7 T-19/04 (*PAPERLAB*)

In judgement of 22 June 2005, *Metso Paper Automation Oy v. OHIM, T-19/04 (PAPERLAB)* (hereafter: T-19/04 (*PAPERLAB*)), *Metso Paper Automation Oy* brings action against the decision to refuse registration of the word mark “PAPERLAB” for goods such as computer equipment and measuring installations for surveying and testing of paper.⁶⁸

The court finds that for a sign to be refused registration pursuant Article 7(1)(c) of Regulation No 40/94, “[...] *there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics* [...]”⁶⁹

⁶⁷ C-363/99 (*Postkantoor*), paragraph 102.

⁶⁸ T-19/04 (*PAPERLAB*), paragraph 1-3.

⁶⁹ T-19/04 (*PAPERLAB*), paragraph 25.

As in C-265/00 (*BIOMILD*), it is reiterated that for a neologism to be perceived as descriptive within the meaning of the provision, the neologism itself has to be found descriptive. As such, it is not sufficient for the application of the provision that the elements of which the neologism is composed of are found descriptive.⁷⁰

In regard to the relevant public, the court finds that the goods for which registration is sought concerns specialised equipment, which must be reflected in the relevant public. Therefore, the relevant public must consist of professionals and non-professionals who are experienced in the sector of computer equipment in relation to the surveying and testing of paper specifically. The relevant public must also have a command of English.⁷¹

The applicant contends that there is no direct link between the word mark for which registration is sought and the goods in question. The Court notes that the word “lab” is commonly used to refer to a laboratory, which is a place, not a product or function. However, the Court observes that the meaning of the word must not only be regarded in relation to the common use of the word. The possible meanings and indications should instead be analysed in relation to the goods for which registration is sought. A “lab” or a laboratory refers to a room or a building equipped with instruments for the purpose of conducting scientific experiments, research and more. When the word “lab” is analysed from this point of view, the sign is indeed capable of describing equipment designed to survey and test paper.⁷²

The Court concludes that the individual elements and the neologism itself are perfectly capable of describing the goods for which registration is sought.⁷³ Furthermore, it is found that the structure of the word “PAPERLAB” is not unusual and it does not create an impression that is sufficiently far removed from the mere sum of its parts.⁷⁴ From the word mark, the relevant specialised public is able to designate the characteristics of the goods in question, as the neologism is simple and straightforward in its description and indications.⁷⁵

The applicant argues that the words “paper”, “lab” and “laboratory” may still be used individually by third parties. However, this argument is dismissed by the court.⁷⁶

In the end, the action brought by Metso Paper Automation Oy is dismissed by the Court.⁷⁷

⁷⁰ T-19/04 (*PAPERLAB*), paragraph 26.

⁷¹ T-19/04 (*PAPERLAB*), paragraph 28.

⁷² T-19/04 (*PAPERLAB*), paragraph 29.

⁷³ T-19/04 (*PAPERLAB*), paragraph 31.

⁷⁴ T-19/04 (*PAPERLAB*), paragraph 32.

⁷⁵ T-19/04 (*PAPERLAB*), paragraph 33.

⁷⁶ T-19/04 (*PAPERLAB*), paragraph 35.

⁷⁷ T-19/04 (*PAPERLAB*), paragraph 41.

The wording used by the Court in paragraph 25 implies that the interpretation of descriptiveness pursuant Article 7(1)(c) EUTMR is dependent on the consumers perception of the sign in relation to the goods or services. A sign may be refused registration, if it “immediately” and “without further thought” may designate the goods and services or one of their characteristics – in the mind of the relevant public. This argument is often used when a sign consisting of the name of a colour is refused registration. An example of this is case no. R 2588/2015-5 (CYAN) which is also mentioned below.

7.8 T-87/10 (PIPELINE)

In judgement of 11 October 2011, Chestnut Medical Technologies, Inc. v. OHIM, T-87/10 (PIPELINE) (hereafter: T-87/10 (PIPELINE)), Chestnut Medical Technologies, Inc. brings action against the Second Board of Appeal of OHIM in regard to their application for registration of the word mark “PIPELINE” concerning medical devices, namely, devices used in the treatment of aneurysms.

As mentioned in chapter 6.5.1 “Absolute grounds for refusal”, the reference base as to when something is considered descriptive, is the ordinary understanding of the relevant public. The present case is an example of the courts’ assessment of what can be considered to be the relevant public. In the present case, instead of just limiting the relevant public to the English-speaking public, as the Court does in case T-355/00 (TELE AID), which is examined below, the relevant public is described as “[...] *highly specialised English-speaking professionals who are particularly well informed and attentive.*”⁷⁸ It is highlighted that “PIPELINE” does not evoke the image of the medical device in the mind of the average English-speaker. However, a medical professional specialising in the kind of treatment which the goods concerned is intended for, will in the context of their medical specialisation immediately make the connection between the word “PIPELINE” and the characteristics of the goods in question.⁷⁹

This judgment demonstrates how “the relevant public” used when assessing the descriptiveness of a sign does not only depend on the language of the sign for which registration is sought, but also specifications such as the education of the target demographic, and if the goods are intended to be used in a professional field. Should it be concluded that the goods in question are targeted towards a narrow and specific group of consumers such as professionals in a specialised field, the courts may adjust the parameters for the assessment accordingly. This will more often than not heighten the chances of association, and by extension, the descriptiveness of the sign – as was the result in Case T-87/10 (PIPELINE).

⁷⁸ T-87/10 (PIPELINE), paragraph 23.

⁷⁹ T-87/10 (PIPELINE), paragraph 27.

7.9 T-355/00 (*TELE AID*)

In judgement of 20 March 2020, DaimlerChrysler AG v. OHIM, Case T-355/00 (*TELE AID*) (hereafter: T-355/00 (*TELE AID*)), DaimlerChrysler AG brings an appeal against the refusal to register “TELE AID” as a trade mark in respect of services such as repair services for automobiles, vehicle repair, operation of a communications network and more.

While assessing the potential descriptiveness of the sign, the Court notes that “[...] *a sign's distinctiveness can be assessed only by reference first to the goods and services in respect of which registration is sought and secondly to the understanding which the relevant public has of that sign.*”⁸⁰

In assessing what is understood by “the relevant public” in this particular case, the Board of Appeal finds that the sign “TELE AID” is composed of English words and therefore the relevant public is the English-speaking public.

In conclusion, one has to assess descriptiveness from the point of view of the relevant class of persons and assess whether a sufficiently direct and concrete association between the sign and the goods and services for which registration is sought exists in their minds.

7.10 European Union case law on signs consisting of names of colours

In the following a list of examples of refused and registered trade mark applications is examined. The examples are listed in the EUIPO Guidelines from 2020 under chapter 2.9 “Names of colours”. These examples have subsequently been replaced in the EUIPO Guidelines from 2021, where a new list of examples has been added along with the incorporation of Case T-423/18 (*Vita*).

7.10.1 R 2588/2015-5 (*CYAN*)

On 26 May 2016 the Fifth Board of Appeal decides on the appeal brought by Calico nr 9080 Aktiebolag, in relation to their application filed on 10 July 2015, seeking registration for the word mark “CYAN” for goods such as cars, jewellery, stationery, handbags and clothing.⁸¹

The Fifth Board of Appeal finds that the possible descriptiveness of a sign must first and foremost be assessed in relation to the understanding of the relevant public, and then in relation to the goods or services.⁸²

⁸⁰ T-355/00 (*TELE AID*), paragraph 51.

⁸¹ R 2588/2015-5 (*CYAN*), paragraph 1.

⁸² R 2588/2015-5 (*CYAN*), paragraph 10.

In this case, the relevant public is found to be the English-speaking consumers due to “cyan” being an English word.⁸³

The Board observes that the goods in question are primarily aimed towards consumers in general, but also professionals. The professional consumers are expected to be more observant of possible relations between the sign and goods in question.⁸⁴

In the English language, “cyan” is used as the name of a colour and the Board does not believe the word to be an unknown term for the colour blue. It bears no significance whether or not there are other more common alternative designations of said colour. The Board added that “[...] *the fact that the word exists in the dictionary gives further support to the claim that it is understood by the relevant public [...] and not only among experts [...]*”.⁸⁵

The applicant argues that “CYAN” does not reference an essential or distinctive characteristic of the goods thus not being within the meaning Article 7(1)(c) EUTMR. In addition to that, the applicant highlights that the goods are available in a ray of colour, of which “cyan” is not a common or typical option.⁸⁶ The applicant also argues that the colour in question is actually better recognised and identified by different names such as aqua, turquoise or turquoise-blue.⁸⁷

The Board dismisses this argument with reference to C-363/99 (*Postkantoor*) which concludes that it is irrelevant whether or not the description is essential or distinctive for the goods in question, any undertaking must be able to use such signs and indications to describe their goods and its characteristics, no matter how significant or indeed insignificant the characteristics may be commercially or otherwise.⁸⁸

The Board finds that the colour of the goods is a characteristic which are important to the consumers and can often dictate whether or not they choose to purchase said goods – particularly in regard to the categories of goods for which registration of “CYAN” is sought. As such, the colour *must* be an essential characteristic of the goods in question.⁸⁹

⁸³ R 2588/2015-5 (CYAN), paragraph 11.

⁸⁴ R 2588/2015-5 (CYAN), paragraph 12.

⁸⁵ R 2588/2015-5 (CYAN), paragraph 13.

⁸⁶ R 2588/2015-5 (CYAN), paragraph 14.

⁸⁷ R 2588/2015-5 (CYAN), paragraph 20.

⁸⁸ R 2588/2015-5 (CYAN), paragraph 15.

⁸⁹ R 2588/2015-5 (CYAN), paragraph 16.

For a sign or indication to be prohibited registration by the provision, it is not a requirement that the sign or indication in question is the only way to designate a certain characteristic. As such, it is of no importance whether the colour “cyan” can be identified, or is more identifiable, by other names.⁹⁰

The Board concludes that “CYAN” “[...] has the sort of direct and concrete link with the goods in question by which the relevant public can immediately and without further reflection perceive the mark as a description of a characteristic of the goods [...]”.⁹¹

The applicant also argues that the registration of a mark does not prevent third parties from using the sign for identical or similar goods. The Board agrees with this statement but dismisses its relevance to the Article 7(1)(c) EUTMR assessment.⁹²

Finally, the Board concludes that the word mark in question is descriptive of the goods for which registration is sought within the meaning of the provision.⁹³

The appeal is dismissed and “CYAN” is refused registration.

7.10.2 EUTM No 14 497 986 (*Ceramic White*)

On 13 November 2015, an objection to the registration of the word mark “Ceramic White” is raised by the OHIM pursuant Article 7(1) (b), (c) and 7(2) Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark.

The word mark “Ceramic White” is sought registered in relation to smartphones, PDAs, TV receivers, etc.⁹⁴The applicant’s argument is summarised as follows; “*The term does not have a clear meaning; Ceramic White does not give a proper indication of a colour; The term is merely suggestive*”.⁹⁵

The OHIM states that the arguments presented by the applicant does not play a role in the context of the goods in question, as the OHIM believes that the consumer will interpret “Ceramic White” as nothing other than a clear descriptive message, meant to designate the characteristics of the goods. The OHIM finds that the term “Ceramic White” would, in the mind of the relevant public, indicate that the product has a ceramic

⁹⁰ R 2588/2015-5 (CYAN), paragraph 20.

⁹¹ R 2588/2015-5 (CYAN), paragraph 19.

⁹² R 2588/2015-5 (CYAN), paragraph 22(1).

⁹³ R 2588/2015-5 (CYAN), paragraph 21.

⁹⁴ Guidelines for Examination in the Office 2020, Part B Examination, p 396.

⁹⁵ EUTM No 14 497 986 (*Ceramic White*), page 1.

finish and is of the colour white. Regardless of the words being separate or combined, the OHIM does not believe that the sign could possibly convey any other meaning.⁹⁶

The OHIM notes that “*All colour, without exception, are perceived subjectively [...]*”⁹⁶, as such, it is of no importance whether or not “Ceramic White” is perceived differently from consumer to consumer. A sign can still be descriptive despite the lack of universal understanding of the term within the barriers of the given language.

In conclusion the OHIM finds the term “Ceramic White” to be descriptive of the goods for which registration is sought, and for this reason, the application is rejected.

7.10.3 R 664/2016-4 (*Opal Blue*)

On 31 August 2016 the Fourth Board of Appeal decides on the appeal brought by LG ELECTRONICS INC., in relation to their application which has been rejected by the examiner on 5 February 2016. The application seeks to register the word mark “Opal Blue” for goods such as software.⁹⁷

The examiner contends that the expression “Opal Blue” is internationally recognised as the name of a colour and is understood as meaning very light blue/green colour. As such, the examiner finds that the sign in question immediately informs the consumer of a characteristic of the goods, therefore the sign is clearly descriptive and devoid of any distinctive character.⁹⁸

On 8 April 2016, the applicant requests the decision be annulled in regard to goods in class 9 and argues that the name of a colour cannot be descriptive of software, as software has no colour.⁹⁹

The Board states that for a sign to fall within the scope of Article 7(1)(c), it must convey a direct relation between the goods or service in question (or its characteristics) and the sign for which registration is sought.¹⁰⁰

The sign “Opal Blue” is an expression in English, and so the relevant public is found to be the English-speaking public. The goods in question are targeted towards the general public, as such the Board does not express any considerations towards professional consumers.¹⁰¹

⁹⁶ EUTM No 14 497 986 (*Ceramic White*), page 2.

⁹⁷ R 664/2016-4 (*Opal Blue*), paragraph 1.

⁹⁸ R 664/2016-4 (*Opal Blue*), paragraph 2.

⁹⁹ R 664/2016-4 (*Opal Blue*), paragraph 3-4.

¹⁰⁰ R 664/2016-4 (*Opal Blue*), paragraph 7.

¹⁰¹ R 664/2016-4 (*Opal Blue*), paragraph 8.

The Board concludes that there is no link between the colour “opal-blue” and the goods in question, being computer application software. The Boards find that computer software is by its very nature colourless and that there is no evidence that colours are used to indicate any feature of the computer software. Given that “Opal Blue” does not designate a characteristic of the goods for which registration is sought, the Board finds that the sign does not fall within the scope of the prohibition pursuant Article 7(1)(c) EUTMR.¹⁰²

The word mark is thus allowed registration as regards class 9 goods.¹⁰³

8. T-423/18 (*vita*)

The following chapter centres around the judgement of 7 May 2019, Fissler GmbH v. EUIPO, T-423/18 (*vita*) in which the General Court decides on the absolute grounds for refusal, including the descriptiveness regarding signs consisting of names of colours, in regard to the sign “vita”. The General Court further specifies the scope of characteristics that are to be considered within the meaning of Article 7(1)(c) EUTMR. The chapter is initiated with a summary of the judgment after which the justification and result is used to assess the precedent value of the judgment. The precedent value will be considered both specifically regarding signs consisting of names of colours and from a more general perspective. Furthermore, the analysis in this chapter seeks to assess whether the judgement can be seen as an expression of a new test consisting of cumulative criteria which must be met in order for a characteristic to be considered within the meaning of Article 7(1)(c) EUTMR and thus having the ability to render the sign unregistrable. Finally, the analysis aims to examine if the judgement is an expression of a change in direction, particularly considering prior case law such as C191/01 P (*DOUBLEMINT*).

8.1 Summary of T-423/18 (*vita*)

8.1.1 Background to the dispute

The applicant, Fissler GmbH, files an application for the registration of a European Union trade mark with the EUIPO on 27 September 2016. The applicant seeks to register the word mark “vita” for the following list of goods:

Class 7: Food processors, electric; parts and accessories for the aforesaid goods;

¹⁰² R 664/2016-4 (*Opal Blue*), paragraph 10.

¹⁰³ R 664/2016-4 (*Opal Blue*), paragraph 5.

Class 11: Pressure cookers, electric; parts and accessories for the aforesaid goods;

Class 21: Household or kitchen utensils and containers; cooking pot sets; pressure cookers, non-electric; parts and accessories for the aforesaid goods.

On 28 April 2017, the examiner refuses the application for registration, finding the mark to be descriptive for some of the related goods for which protection is sought, cf. Article 7(1) (b) and (c) of Regulation No 207/2009 (now Article 7(1)(b) and (c) in conjunction with Article 7(2) of Regulations 2017/1001).

The applicant subsequently files a notice of appeal with the EUIPO on 20 June 2017. The appeal is filed pursuant Articles 58 to 64 of Regulation No 207/2009 (now Article 66 to 71 of Regulation 2017/110).

The Fifth Board of Appeal of EUIPO dismisses the appeal as regards most of the contested goods in the decision of 28 March 2018. The appeal is dismissed on the grounds that the sign is descriptive in the Swedish language for the goods concerned and therefore devoid of any distinctive character.

The main reasoning behind the Board dismissing the appeal is firstly, that since the mark is a Swedish term, it is necessary to take into account the Swedish-speaking public within the European Union. The Board concludes that the term “vita” is the definite plural form of the word “vit” which means “white” in Swedish. Moreover, the Board contends that in order for Article 7(1)(c) EUTMR to apply, it is sufficient that the goods in question may exist in white and that the sign can be descriptive of said goods. Despite the colour white not being found by the Board to be the most common colour of said goods, it is found to be at least a fairly usual colour of the goods in question. The Board finds that this is sufficient for the average consumer to associate the goods concerned with the colour white, thus making the mark descriptive. In addition, the Board argues that some kitchen utensils and household appliances are often referred to as “white goods” in English and Swedish (“vitvaror”) and although this term is most frequently used for large household appliances, the term suffices in clearly demonstrating the association between the colour white and the household utensils for which protection is sought.

Finally, the Board concludes that the sign will be understood by the relevant public as a simple statement of fact in the sense that the goods in question are available in the colour white. As such, the Board finds the mark to be purely descriptive and, consequently, devoid of any distinctive character. It is the view of the Board that any manufacturer of food processors and cooking pot sets can manufacture goods in white and subsequently the mark is not capable of distinguishing the applicant’s goods from those of other undertakings.

On 6 July 2018, Fissler GmbH brings action against the decision of the Fifth Board of Appeal of EUIPO. The applicant seeks annulment of the contested decision of 28 March 2018 alleging infringement of Article 7(1)(c) of Regulation 2017/1001 and infringement of Article 7(1)(b) of that regulation respectively. The applicant submits that the sign in question is not descriptive of the goods concerned and thus has the requisite distinctive character.

8.1.2 Arguments of the applicant and the EUIPO

In the first plea in law, alleging infringement of Article 7(1)(c) of Regulation 2017/1001, the applicant first and foremost argues that when “vita” is used on its own, it does not have any clearly descriptive content. Following this logic, the applicant contends that it seems unlikely that the word “vita” will be understood by the Swedish-speaking public as a reference to the colour “white”. The applicant submits that the EUIPO did not sufficiently take into account that the sign is not consisted of the adjective “vit” in the basic form in which it appears in dictionaries. The applicant maintains that the term is never used on its own in Swedish. On the contrary, it is always used in relation to a noun. Moreover, the applicant argues that the meaning of “vita” is not clear and requires interpretation since the word can relate to various circumstances and have various meanings in a number of languages.¹⁰⁴

Secondly, the applicant submits that even if the term “vita” is assumed to be associated with an indication of colour by the Swedish-speaking consumer, there is no sufficiently direct and specific link between the term “vita” and the goods concerned. Accordingly, the applicant contends that it is not true that the indication of the colour “white” has a purely descriptive meaning. Moreover, the applicant contends that it is irrelevant that the goods concerned can be found in the colour “white” since the public does not associate any particular colour with cooking appliances. On this ground the applicant maintains that the decisive factor is whether the sign can be used for a descriptive purpose and whether, in the perception of the relevant public, it can be understood as describing the characteristic of those goods.¹⁰⁵

Thirdly, referring to settled case law, the applicant argues that the Court and the EUIPO has repeatedly held that the term “vita” has no descriptive meaning as regards the goods for which protection is sought.¹⁰⁶

¹⁰⁴ T-423/18 (*vita*), Paragraph 18.

¹⁰⁵ T-423/18 (*vita*), paragraph 19-20.

¹⁰⁶ T-423/18 (*vita*), paragraph 21.

The applicant concludes that the mere fact that an element is capable of indicating a characteristic, in the abstract, is not sufficient to justify a requirement of availability in accordance with the underlying interests of Article 7(1)(c) of Regulation 2017/1001.¹⁰⁷

In response, the EUIPO submits that the examination of a sign must be carried out specifically in relation to the goods for which protection is sought, and that consumers are faced with a European Union trade mark in direct connection with the goods to which it is affixed. The EUIPO disputes the applicants claim that a thought process involving a number of steps is necessary to attribute a sensible meaning to the mark – this since the word “vita” is used adjectivally in the Swedish language as a form of “white” and the message of the sign is not indeterminate or vague. In so far as the goods are white, the EUIPO further disputes that the characteristics of the goods are not easily recognisable for the Swedish-speaking consumers.¹⁰⁸

The EUIPO maintains that “vita” translates to the adjective “white” and submits that the fact that “vita” has different meanings in other languages, does not change the fact that Swedish native speakers will recognise and understand the word as the adjective “white”. To support the fact that the Swedish native speakers will understand the word “vita” as the adjective “white”, even though it is not usually used on its own, the EUIPO contends that the relevant public will perceive the goods in question and add them mentally to the word “vita”, i.e., understanding it as for example “white electric food processors”.¹⁰⁹

Furthermore, the EUIPO submits that white is also used for kitchen related goods made of steel - as such, a white pressure cooker would not be unusual or striking. It is the view of the EUIPO that colours may be a key purchasing criterion and is therefore to be considered an essential characteristic.¹¹⁰

The EUIPO reiterates that it is not the current use of the sign that is relevant in relation to Article 7(1)(c) EUTMR but rather that the sign can be used to describe the goods in question. The EUIPO continues, stating that it is not necessary for the characteristic to be the main element or the purchasing criterion in order for Article 7(1)(c) EUTMR to apply. On the contrary, the EUIPO contends that according to case law, the ground for refusal set out in Article 7 (1)(c) EUTMR, applies regardless of whether the sign describes an essential or ancillary characteristic or indeed ‘any characteristic whatsoever’ of the goods for which protection is sought.¹¹¹

¹⁰⁷ T-423/18 (*vita*), paragraph 22.

¹⁰⁸ T-423/18 (*vita*), paragraph 23.

¹⁰⁹ T-423/18 (*vita*), paragraph 24.

¹¹⁰ T-423/18 (*vita*), paragraph 25.

¹¹¹ T-423/18 (*vita*), paragraph 26.

8.1.3 Findings of the General Court - Justification and result

In paragraphs 27 to 31, the General Court initially stipulates the relevant basis for assessing whether or not a sign is to be considered descriptive within the meaning of Article 7(1)(c) EUTMR. The General Court then examines the meaning of the term “vita” in the Swedish language and the link between said meaning and the goods for which protection is sought.

Regarding the meaning of the term “vita”, the General Court finds that the term is capable of immediately being recognised by the relevant public i.e., the Swedish-speaking consumer, as meaning the adjective “white” in its plural form and its definite singular form. This conclusion is made notwithstanding that the common indefinite form of the word “white” in Swedish is “vit” and not “vita”. The Court rationalises that an adjective as common as the one meaning “white” will be recognised as such even though it is not used in its common form i.e., followed by a noun. The General Court also states that the meaning of “vita” in other languages has no relevance in this case. The questions which have arisen relate only to the meaning of the term “vita” for the Swedish-speaking and Finnish-speaking public.¹¹²

Subsequently the General Court examines the link between the meaning of the term “vita”, as established above, and the goods for which protection is sought. In relation thereto, the General Court examines whether a more or less common use of the colour white in the manufacturing of the goods concerned can be categorised as a “characteristic” of those goods.

Referring to the wording of Article 7(1)(c) EUTMR, the General Court accentuates the fact that the European Union legislature has chosen to use the word “characteristic”. The General Court finds that this highlights that the signs referred to within the article, are merely those which serve to designate a property, easily recognisable by the relevant public. From this, the General Court derives that “*Consequently, a sign can be refused registration on the basis of that provision only [emphasis added] if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics [...]*”.¹¹³

The General Court continues, stating that even though it is irrelevant whether such a characteristic is commercially essential or ancillary, cf. judgment of 16 October 2014, *Larrañaga Otaño v OHIM*, T458/13 (*GRAPHENE*) (hereafter: T458/13 (*GRAPHENE*)), paragraph 20 and by analogy, judgment of 12 February 2004, C363/99 (*Koninklijke KPN Nederland*) (hereafter: C363/99 (*Koninklijke KPN Nederland*)), paragraph 102, a

¹¹² T-423/18 (*vita*), paragraphs 35-37.

¹¹³ T-423/18, (*vita*), paragraph 43.

characteristic must nevertheless be “objective” and “inherent to the nature of” the goods or services concerned in order to fall within the meaning of Article 7(1)(c) EUTMR.¹¹⁴ Additionally, the General Court finds that a characteristic must also be “intrinsic and permanent” with regard to said goods or services to fall within the meaning for Article 7(1)(c) EUTMR.¹¹⁵

Specifically, and in relation to the case in question, the General Court states “[...] *that the colour white does not constitute an ‘intrinsic’ characteristic which is ‘inherent to the nature’ of the goods concerned [...]*”¹¹⁶. The General Court continues, stating that the colour white is merely a random and incidental aspect which only some of the products possess. Even products which may bear the colour white is not found by the General Court, to be a characteristic that has any direct and immediate link with the nature of those goods. Emphasising that the goods in question are available in a multitude of colours, white being one of them, the colour white is not found to be more common than the others.¹¹⁶

The General Court finds that it is not sufficient in and of itself that the goods concerned are more or less usually available in white for it to be reasonable to believe that the colour white will actually be recognised by the relevant public as a description of an intrinsic characteristic which is inherent to those goods.¹¹⁷

The General Court establishes that the present case must be distinguished from judgment of 9 December 2008, Colgate-Palmolive Co. v. OHIM, T136/07 (*VISIBLE WHITE*) (hereafter: T136/07 (*VISIBLE WHITE*)) and judgment of 7 July 2011, Cree, Inc. v. OHIM, T208/10 (*TRUEWHITE*) (hereafter: T208/10 (*TRUEWHITE*)).¹¹⁸ The distinction made by the Court in relation to these judgements, will be further examined in chapter 8.2.2 “A comparison of T136/07 (*VISIBLE WHITE*), T208/10 (*TRUEWHITE*) and T322/03 (*WEISSE SEITEN*) v. T-423/18 (*vita*)”.

Moreover, the General Court rejects that there is a direct and immediate link between the adjective “vita” for the goods in question, being small household electrical appliances, and the term “vitvaror” which refers to large household electrical appliances. Conclusively, the General Courts finds that “*The evocation of the goods concerned, or of one of their characteristics, which the term ‘vita’ might convey to the relevant public, through the association, first, with the Swedish term ‘vitvaror’ or with ‘large household electrical appliances’ and then, secondly, with ‘small household electrical appliances’, is at most doubly indirect and does not enable*

¹¹⁴ cf. judgment of 6 September 2018, Bundesverband Souvenir — Geschenke — Ehrenpreise v. EUIPO, C488/16 P (*Souvenir*), paragraph 44.

¹¹⁵ T-423/18, (*vita*), paragraph 44, cf. T822/14 (*Cottonfeet*), paragraph 32, T167/15 (*NEUSCHWANSTEIN*), paragraph 30 and T120/17 (*FLUO*), paragraph 40.

¹¹⁶ T-423/18, (*vita*), paragraph 45.

¹¹⁷ T-423/18, (*vita*), paragraph 46.

¹¹⁸ T-423/18 (*vita*), paragraph 49

*that public immediately, and without further thought, to perceive a description of the goods in question or of one of their characteristics.”*¹²⁰ The link is found by the Court to be “too vague and indeterminate”.¹¹⁹

Lastly, the General Court states that the case at hand must also be distinguished from judgment of 16 March 2006, *Telefon & Buch Verlagsgesellschaft mbH v. OHIM*, T322/03 (*WEISSE SEITEN*) (hereafter: T322/03 (*WEISSE SEITEN*)) paragraphs 95 to 99.¹²⁰ The distinction made by the Court, will be further examined in chapter 8.2.2 “A comparison of T136/07 (*VISIBLE WHITE*), T208/10 (*TRUEWHITE*) and T322/03 (*WEISSE SEITEN*) v. T-423/18 (*vita*)”.

In conclusion, the General Court finds that the term “vita” is not descriptive of a characteristic of the goods concerned and therefore not covered by the absolute ground of refusal within Article 7(1)(c) EUTMR.¹²¹

8.2 Analysis of T-423/18 (*vita*)

Preliminary, it is important to bear in mind that the General Court refers to already settled case law in its judgement, reiterating some of the already well-known objective criteria for assessing descriptiveness of a sign. Thus, indicating that previously settled case law, which is already used when assessing descriptiveness, continues to apply even though the judgement might seem to indicate a change in direction – particularly the direction seen post the judgment of C191/01 P (*DOUBLEMINT*).

The General Court initiates the judgement by restating that “[...] *there must be a sufficiently direct and specific link between the sign and the goods or services in question to enable the relevant public immediately to perceive, without further thought, a description of those goods or services or of one of their characteristics* [...]”¹²³ in order for a sign to be encompassed by the absolute ground for refusal pursuant Article 7(1)(c) EUTMR, cf. T19/04 (*PAPERLAB*), paragraph 25 et al.¹²²

The Court continues – referencing, among others, judgment of 27 February 2002, *Ellos v OHIM*, T219/00 (*ELLOS*), paragraph 29 - that the descriptive character of a sign must be assessed “[...] *first, by reference to the goods or services in respect of which registration has been sought and, secondly, by reference to the*

¹¹⁹ T-423/18 (*vita*), paragraph 54.

¹²⁰ T-423/18 (*vita*), paragraph 55.

¹²¹ T-423/18 (*vita*), paragraph 57.

¹²² T-423/18 (*vita*), Paragraph 28.

perception that the relevant public, which consists of the consumers of those goods or services, has of that sign [...]".¹²³

The Court then references C191/01 P (*DOUBLEMINT*), reiterating that a word sign must be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned, cf. paragraph 32 in the judgment.¹²⁴

The General Court further reiterates that it is irrelevant whether a characteristic is commercially essential or merely ancillary, cf. T458/13 (*GRAPHENE*), paragraph 20 and by analogy C363/99 (*Koninklijke KPN Nederland*), paragraph 102.¹²⁵

Lastly the General Court emphasises the underlying interests of Article 7(1)(c) EUTMR, mainly being to ensure that signs which can describe characteristics of the goods and services concerned may be freely used by all tradesmen offering such goods or services – thus preventing the monopolisation of certain descriptive terms.¹²⁶ In doing so, the General Court emphasises the importance of carrying out the descriptiveness assessment in the light of these interests.¹²⁷ Consequently, the Court must bear these underlying interests in mind when creating new criteria for the assessment of descriptiveness.

These preliminary observations are aligned with the previous general conditions required for a sign to be perceived as descriptive within the meaning of Article 7(1)(C) EUTMR, as also previously described in chapter 7 "European Union case law on descriptive marks prior to T-423/18 (*vita*)". However, the General Court continues their justification of the ruling in paragraph 43 and 44. Firstly submitting that "*the EU legislators' choice to use the word "characteristic" highlights the fact that the signs referred to in Article 7(1)(c) of Regulation 2017/1001 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought*". Concluding on this, the General Court expresses that "[...] *a sign can be refused registration on the basis of that provision only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics [...]*". Following this rationale, the General Court finds that a characteristic within the meaning of Article 7(1)(c) EUTMR must be "objective" and "inherent to the nature of" said goods or services, cf. judgment of 6 September 2018, C488/16 P (*Souvenir*) (hereafter: C488/16 P

¹²³ T-423/18 (*vita*), Paragraph 29.

¹²⁴ T-423/18 (*vita*), Paragraph 30.

¹²⁵ T-423/18 (*vita*), paragraph 44.

¹²⁶ See inter alia C51/10 P (*Technopol*), paragraph 37, C191/01 P (*DOUBLEMINT*), paragraph 31, T458/13 (*GRAPHENE*), paragraph 13 and the judgements referenced therein.

¹²⁷ T-423/18 (*vita*), Paragraph 31.

(Souvenir)), paragraph 44, while also being “intrinsic and permanent” with regard to that product or service, cf. T822/14 (*Cottonfeel*), paragraph 32, T167/15 (*NEUSCHWANSTEIN*), paragraph 30 and T120/17 (*FLUO*), paragraph 40. Thus, seemingly creating new criteria that are to be considered when assessing descriptiveness of a sign.

Following the abovementioned criteria, the General Court continues in paragraphs 45-46, examining whether the specific term “vita” must be considered descriptive in relation to the goods for which protection is sought pursuant Article 7(1)(c) EUTMR. The General Court emphasises that the colour white merely constitutes a purely random and incidental aspect in relation to the goods in question. Stating that only some of the products may possess this characteristic which does not, in any event, have any direct and immediate link with their nature. The General Court adds that the relevant goods are available in a multitude of colours, among them is the colour white, which is not, however, more prevalent than the others. Based on these reasonings, the General Court finds that the colour white does not in fact constitute an “intrinsic” characteristic which is “inherent to the nature” of the goods concerned. A general criterion concerning when the name of a colour is at least *not* to be considered descriptive, can be derived from the General Court’s specific justifications. A sign consisting of the name of a colour is not to be considered descriptive of the relevant goods within the meaning of Article 7(1)(c) EUTMR, if said colour is a purely random and incidental aspect of the product. The fact that a product may be more or less available in a colour is not sufficient for the colour to be considered a descriptive characteristic of the goods in question.¹²⁸ From this it may be derived that in order for the name of a colour to be considered descriptive, the colour must be an essential characteristic of the goods for which protection is sought. Following this rationale, some of the more obvious examples of descriptive names of colours would be “blue” for blue cheese, “green” for green tea and “red” for red wine.¹²⁹

In paragraph 56 of the judgement, the General Court concludes on the above justifications, stating that the two grounds relied upon by the Board of Appeal, is insufficient to establish a sufficient and specific link between the Swedish term “vita” and the goods in question within the meaning of relevant case law. Concluding the judgement in this manner indicates that the main condition for a sign to be descriptive continues to be that a sufficient and specific link exists between the sign and the goods for which registration is sought. Seen in correlation to the General Court’s mentioning of the need for a characteristic to be “objective” and “inherent to the nature of” the goods or services concerned while also being “intrinsic and permanent” with regard to said goods or services, the conclusion may indicate that these factors are to be

¹²⁸ See also T-423/18 (*vita*), paragraph 46.

¹²⁹ Guidelines for Examination in the Office 2021, Part B Examination, p 456.

seen as a list of criteria which must be met in order for a sufficient and specific link to exist between the sign and the goods or services in question. However, it would seem more correct to derive from the conclusion that the mentioned factors should be seen more specifically as a list of criteria which must be met in order for a characteristic to even fall within the meaning of Article 7(1)(c) EUTMR. Thus, determining which type of characteristics can enable a sufficient and specific link between the sign and the goods in question.

The question then arises, if the mentioned criteria can be perceived as a test in which the exhaustive list of factors must be met, thus being cumulative criteria. In this regard, it is imperative to consider how the General Court uses the criteria in the present case. In its conclusions, the General Court finds that the colour white in relation to the relevant goods, does not incur the relevant public to recognise it “[...] *as a description of an intrinsic characteristic which is inherent to the nature of those goods* [...]”¹³⁰. As such, the General Court does not in fact mention all four criteria in their conclusion. This might indicate that the criteria are not meant to be seen as a test consisting of four cumulative criteria. Instead, it may be inferred that the mentioned criteria merely serve as a guideline for the administrative authorities and Boards of Appeals when assessing descriptiveness. When considering the characteristic in question – a colour – it may be inferred that the Courts omission of mentioning the criteria “permanent” and “objective” follows from it being implied. It might be stated that the colour of a product is always perceived objectively by the relevant public while also being a permanent characteristic of said products.

In conclusion, it can be said that the General Court largely follows already settled case law. The judgement does however seem to form a general criterion concerning when the name of a colour is *not* to be considered descriptive. As such, a sign consisting of the name of a colour is not to be considered descriptive of the relevant goods pursuant Article 7(1)(c) EUTMR, if said colour is a purely random and incidental aspect of the product. The fact that a product may be more or less available in a colour, is not sufficient for the colour to be considered a descriptive characteristic of the goods in question. The judgement further seems to offer new criteria to the already well-established assessment of when a sign can be considered descriptive within the meaning of Article 7(1)(c) EUTMR in general. Essentially, the General Court sets the tone for when a characteristic is to be considered within the meaning of Article 7(1)(c) EUTMR, thus enabling the sign to be descriptive of the goods or services for which protection is sought. According to the judgement, a characteristic must be “objective” and “inherent to the nature of” the goods or services concerned and

¹³⁰ T-423/18 (*vita*), paragraph 46.

“intrinsic and permanent” with regard to said products or services in order to be considered within the meaning of Article 7(1)(c) EUTMR.

8.2.1 Literal interpretation of the new criteria

In the following, this master thesis further analyses the meaning of the now established criteria, being that a characteristic must be objective and inherent to the nature of the goods or services as well as being intrinsic and permanent with regard to said goods or services. In doing so, a literal interpretation is made in order to fully understand the aforementioned criteria.

8.2.1.1 Literal interpretation of the criterion: “objective”

Merriam-Webster defines the term “objective” i.a., as “*expressing or dealing with facts or conditions as perceived without distortion by personal feelings, prejudices, or interpretations*”. It is further defined as “*of, relating to, or being an object, phenomenon, or condition in the realm of sensible experience independent of individual thought and perceptible by all observers : having reality independent of the mind*”.¹³¹

As such, a characteristic within the meaning of Article 7(1)(c) EUTMR must be able to be perceived by the relevant public in its entirety, i.e., by all observers, as a factual description of the goods or services concerned or of one of its characteristics. By its very nature, the assessment of whether or not a characteristic is to be considered descriptive pursuant Article 7(1)(c) EUTMR, must not be subject to personal feelings, prejudices or interpretations of the examiner or the individual buyer. It is also specifically stated in C-488/16 P (*Souvenir*), paragraph 44, that the buyer’s intention and ability to use a product in a certain way, does not convey to an objective characteristic of said product.

8.2.1.2 Literal interpretation of the criterion: “inherent to the nature”

Merriam-Webster defines the term “inherent” as “involved in the constitution or essential character of something” or as “belonging by nature or habit”.¹³²

Fundamentally it can be said that a characteristic within the meaning of Article 7(1)(c) EUTMR must be an essential character of the goods or services in question and thus not secondary to said goods or services, in order to be perceived as being descriptive. In other words, a secondary or purely random characteristic of

¹³¹ Merriam-webster.com, *Dictionary on “objective”*.

¹³² Merriam-webster.com, *Dictionary on “inherent”*.

the goods and services in question, is not sufficient for it to be considered descriptive pursuant Article 7(1)(c) EUTMR.

This criterion must be considered to follow the mindset of T-19/04 (*PAPERLAB*) (among others). In this judgement, the Court of First Instance considers that there must be a sufficiently direct and specific link between the sign and the goods or services in question to enable the relevant public to immediately perceive, without further thought, a description of those goods or services, or of one of their characteristics, in order for a sign to be encompassed by the absolute ground for refusal pursuant Article 7(1)(c) EUTMR.¹³³ It may even be said that the relevant public being able to immediately perceive the sign as a description of the goods or services in question, or of one of their characteristics, without further thought, is a great indicator of when a characteristic is in fact inherent to the goods or services at hand.

8.2.1.3 Wording interpretation of the criterion: “intrinsic”

Merriam-Webster defines, i.a., the term “intrinsic” as “belonging to the essential nature or constitution of a thing”.¹³⁴

In its literal meaning, this criterion does not seem to differentiate from the above described criterion “inherent to the nature”. This is further emphasised by the fact that the two adjectives are used as synonyms.¹³⁵ The two adjectives both convey the idea of an inborn, essential aspect of something, i.e., an element that exists within a person or a thing due to its very nature.¹³⁶

“Inherent” stems from the Latin verb “inhaerentem”, meaning “to stick in” or “adhere to”.¹³⁷ In essence, “inherent” refers to something that is “stuck in” something else so firmly that they can't be separated.¹³⁸ It can be said that an inherent characteristic is one that is embedded in the thing that possesses it.¹³⁹

“Intrinsic” stems from the Latin adjective “intrinsecus”, meaning “inwardly, on the inside”.¹⁴⁰ As such, an intrinsic characteristic is something that belongs to the thing itself.¹⁴¹

¹³³ Paragraph 25 of the judgement.

¹³⁴ Merriam-webster.com, *Dictionary on “intrinsic”*.

¹³⁵ Merriam-webster.com, *Thesaurus on “inherent”*.

¹³⁶ Dailywritingtips.com, Maeve Maddox, *Intrinsic vs. inherent*.

¹³⁷ Etymonline.com, *Etymology Dictionary on “inherent”*.

¹³⁸ Merriam-webster.com, *Dictionary on “inherent” note 1*.

¹³⁹ Dailywritingtips.com, Maeve Maddox, *Intrinsic vs. inherent*.

¹⁴⁰ Etymonline.com, *Etymology Dictionary on “intrinsic”*.

¹⁴¹ Dailywritingtips.com, Maeve Maddox, *Intrinsic vs. inherent*.

Virtually, a subtle difference between these two adjectives might be said to exist. However, it does not seem to be possible to presume a clear distinction between the two in this particular context. On the contrary, the adjectives seem to be able to be used interchangeably. Due to the two criteria originating from different judgements, it might be inferred that a clear distinction between the two cannot actually be determined.

However, the General Court does not seem to use the adjectives interchangeably, cf. the wording in paragraph 49: “[...] *described an intrinsic characteristic that is inherent to the nature of the goods concerned, namely the point of using them or their intended purpose.*” The particular usage of the two adjectives in this manner, could suggest that the General Courts views the terms as separate and differing from each other. It might indicate or allow for different aspects of time – meaning that a characteristic must not necessarily be innate to the goods or services in question but can also be a characteristic that is added.

8.2.1.4 Wording interpretation of the criterion: “permanent”:

Merriam-Webster defines the term “permanent” as “*continuing or enduring without fundamental or marked change*”.¹⁴² In essence, a characteristic within the meaning of Article 7(1)(c) EUTMR must not be subject to change over time.

8.2.2 A comparison of T136/07 (*VISIBLE WHITE*), T208/10 (*TRUEWHITE*) and T322/03 (*WEISSE SEITEN*) v. T-423/18 (*vita*)

In the following, a comparative analysis will be made of the circumstances within T136/07 (*VISIBLE WHITE*) and T-208/10 (*TRUEWHITE*) versus the circumstances in T423/18 (*vita*). The analysis is carried out to ensure a better understanding of when a sufficiently direct and specific link between a sign and the goods or services concerned, in fact do exist – and by extension, when a characteristic is to be recognised as objective and inherent to the nature of the goods or services concerned while also being intrinsic and permanent with regard to said goods or services.

In paragraph 49 of T-423/18 (*vita*), the General Court chooses to specifically distinguish the case in question from judgment of 9 December 2008, T-136/07 (*VISIBLE WHITE*) and judgment of 7 July 2011 T-208/10 (*TRUEWHITE*). This is particularly interesting, since neither the EUIPO nor the applicant refers to these judgements in their arguments. As such, it would seem that the General Court has chosen to highlight these

¹⁴² Merriam-webster.com, *Dictionary on “permanent”*.

judgements to illustrate why the colour white (vita) in this particular case, cannot be seen as descriptive within the meaning of Article 7(1)(c) EUTMR.

Regarding T-136/07 (*VISIBLE WHITE*), the General Court emphasises paragraph 42 and 43 in which the terms “visible” and “white” is found to enable the relevant public to “[...] *detect immediately and without further reflection the description of a fundamental characteristic of the goods concerned, namely ‘toothpaste and mouthwash’, in the sense that their use makes the white colour of teeth visible.*” Commenting on this, the General Court finds that the term “visible white” describes an intrinsic characteristic that is inherent to the nature of the goods concerned, namely the point of using them or their intended purpose. From this can be derived, that a point in using a good or service as well as an intended purpose of a good or service can be considered a descriptive characteristic within the meaning of Article 7(1)(c) EUTMR. The inclusion of both the phrasing “the point in using” as well as “the intended purpose” seems to suggest that, it is not only the producer’s intention behind a product that is decisive for the assessment, but also a more general perception of the benefits of using said products.

Regarding T-208/10 (*TRUEWHITE*), the General Court emphasises paragraph 23 in which the term, is considered by the Court to possibly be “[...] *regarded as referring to a true white and that, applied to light-emitting diodes (LED), that mark merely described an essential characteristic of those goods, namely their ability to reproduce light of such whiteness that it could be considered to be similar to natural light.*” Commenting on this, the General Court finds that the term “truewhite”, in being comparable to that of natural light, describes an intrinsic characteristic inherent to the nature of the goods concerned, namely the quality of those goods. From this can be concluded that the quality of the goods or services concerned, can be considered a descriptive characteristic within the meaning of Article 7(1)(c) EUTMR.

The General Court further compares T-423/18 (*vita*) with T-322/03 (*WEISSE SEITEN*), despite it not being referenced by the applicant or the EUIPO in their arguments. The General Court emphasises paragraphs 95 to 99 in which it is pointed out that “[...] *the term ‘weie Seiten’ (meaning ‘white pages’) had become synonymous, in the German language, with ‘telephone directories for private individuals’ and could therefore be considered to be descriptive of the goods for which it was a common term, as a synonym for such a directory and not due to the white-coloured pages of that directory [...]*”. The General Court emphasises that in the referred case, the sign itself constitutes a common term. This is contrary to the present case, where the EUIPO contends that the term “vita” translates to the term “vitvaror” although the goods concerned does not actually fall within the category “vitvaror”, which is a term used to describe large household electrical appliances. From the mentioning of this judgment, it may be inferred that in order for a sign to be considered descriptive pursuant Article 7(1)(c) EUTMR due to it being constituted of a generic term, this generic term

must directly refer to the specific goods or services for which protection is sought. It is however not entirely clear if the determining factor is that the sign does not actually consist of the generic term “vitvaror” but merely a term that could be perceived as referring to this when seen in connection with large household electrical appliances and that the goods in the present case are actually a different type of goods i.e., small household electrical appliances. As such, it may be inferred that it is sufficient for a sign to be considered descriptive pursuant Article 7(1)(c) EUTMR, if it consists of a term which can be easily recognised as a generic term typically used for a specific category of goods or services, if the goods or services for which protection is sought, does in fact fall within that specific category.

Overall, it can be concluded, that the General Court considers the following to be intrinsic characteristics inherent to the nature of the goods or services concerned:

- a) The point of using a good or service,
- b) The intended purpose of a goods or service, and
- c) The quality of the goods or services concerned.

Furthermore, it may be inferred from the mentioning of T-322/03 (WEISSE SEITEN), that a sign might be considered descriptive within the meaning of Article 7(1)(c) EUTMR, if it consists of a term which can be easily recognised as a generic term used for a specific category of goods or services, if the goods or services for which protection is sought, in fact falls within that specific category.

8.2.3 Precedent value of T-423/18 (*vita*)

In the following, an examination of the precedent value of the judgement is made, taking into consideration administrative rulings and decisions of the Boards of Appeals which refer to T-423/18 (*vita*).

In T-423/18 (*vita*), the General Court specifically takes a position on the descriptive character of signs consisting of names of colours, namely being the sign “vita” meaning white. As presented in chapter 8.2 “Analysis of T-423/18 (*vita*)” of this master thesis, the General Court sets forth that a characteristic within the meaning of Article 7(1)(c) EUTMR must be objective and inherent to the nature of those goods or services, cf. C488/16 P (*Souvenir*), paragraph 44, while also being intrinsic and permanent with regard to said goods or services, cf. T822/14 (*Cottonfeel*), paragraph 32, T167/15 (*NEUSCHWANSTEIN*), paragraph 30 and T120/17 (*FLUO*), paragraph 40. The justification of the decision found in paragraphs 45 to 47 is specific to the case in question and whether the term “vita” must be considered descriptive in regard to the specific goods for which protection is sought. Nonetheless, some general criteria regarding signs consisting of names of colours may be inferred from said specific justification. As mentioned above in chapter 8.2 “Analysis of T-423/18 (*vita*)”, a sign consisting of the name of a colour is not to be considered descriptive of the relevant goods

within the meaning of Article 7(1)(c) EUTMR, if said colour is a purely random and incidental aspect of the product. Thus, the fact that a product may be more or less available in a colour, is not sufficient for the colour to be considered a descriptive characteristic of the goods in question.¹⁴³ This is also repeated in judgement of 25 June 2020, *Off-White LLC v. EUIPO, T-133/19 (OFF-WHITE)* (hereafter: *T-133/19 (OFF-WHITE)*) paragraph 45 in which the General Court also adds that “[...] *although off-white corresponds [...] to one of the possible colour variations which those goods may have, it does not, however, constitute the sole or even predominant colour.*” This indicates, that in order for the name of a colour to be considered descriptive pursuant Article 7(1)(c) EUTMR, it must be the sole or predominant colour of a certain type of product.

In the EUIPO Guidelines 2020 regarding signs consisting of names of colours, it is set forth that “*Where colour is a typical feature of the goods and relevant for consumer choice, such as clothing and motor cars, colour names such as CYAN, EMERALD or APRICOT, which, despite having alternative meanings, are recognised as having a strong connotation with definite colours, should be objected to.*”¹⁴⁴ However, the Guidelines has been changed since the judgements *T-423/18 (vita)* and *T-133/19 (OFF-WHITE)*. The EUIPO Guidelines 2021 now details that “*A sign consisting exclusively of the name of a colour must be objected to under Article 7(1)(c) EUTMR when the application claims any goods and services for which the colour constitutes an objective characteristic, inherent to the nature of that product or service and intrinsic and permanent with regard to that product or service [...]. For the ground of refusal to apply, a direct and specific link is necessary in the mind of the relevant public, not just an indirect association [...]*”.¹⁴⁵ These new guidelines refer to *T-423/18 (vita)*. In regard to the assessment of the descriptiveness of a sign consisting of names of colours, *T-423/18 (vita)* must therefore be considered ground-breaking. However, the judgment does not seem to solely relate to signs consisting of names of colours.

T-423/18 (vita) also seems to establish criteria regarding the general assessment of descriptive marks, since part of the justification and result does not specifically and solely aim at the possible descriptiveness of signs consisting of names of colours. The criteria introduced in paragraph 44 of the judgement are phrased as generic criteria applicable to all types of characteristics. As mentioned in chapter 8.2 “Analysis of *T-423/18 (vita)*”, the conclusion made by the General Court in paragraph 56, may indicate a list of criteria, or even a test, which must be met in order for a sufficient and specific link to exist between the sign and the goods in question. The criteria being that a characteristic must be objective and inherent to the nature of the goods or services while also being intrinsic and permanent with regard to said goods or services.¹⁴⁶ The question

¹⁴³ *T-423/18 (vita)*, paragraph 46.

¹⁴⁴ Guidelines for Examination in the Office 2020, Chapter 4 on descriptive marks, page 395-397.

¹⁴⁵ Guidelines for Examination in the Office 2021, Chapter 4 on descriptive marks, page 455-456.

¹⁴⁶ *T-423/18 (vita)*, paragraph 44 and the case law cited therein.

then arises whether these criteria, introduced by the Court, can be considered a test consisting of cumulative criteria. As stated above, it is imperative to consider how the General Court uses the criteria in the present case.

In its conclusions, the General Court finds that the colour white in relation to the relevant goods, does not incur the relevant public to recognise it “[...] *as a description of an intrinsic characteristic which is inherent to the nature of those goods.*”¹⁴⁷. As such, the General Court does not in fact mention all four criteria in their conclusion. This might indicate that the criteria are not meant to be seen as a test consisting of four cumulative criteria. Instead, it may be inferred that the mentioned criteria merely serve as a guideline for the administrative authorities and Boards of Appeals when assessing descriptiveness. When considering the characteristic in question – a colour – it may be inferred that the Court’s omission of mentioning the criteria permanent and objective follows from it being implied. The colour of a product must have the ability to be perceived objectively by the relevant public while also being a permanent characteristic of the majority of products.

This observation may be supported by the justification and result set forth in T-133/19 (*OFF-WHITE*). In paragraph 43, the General Court concludes that “[...] *it does not follow from the considerations on which the Board of Appeal based its conclusion [...] that the colour designated by the word element ‘off-white’, namely off-white, or even the shades of white which are commonly understood by the relevant public as corresponding to the colour off-white, constitute a characteristic which is objective and inherent to the nature of the goods in question, as well as being intrinsic and permanent for those goods [...]*”.¹⁵⁷ All four criteria are mentioned in regard to the specific case. Furthermore, the Board of Appeal argues that the elegant and discreet character of the colour off-white and the improved visual impression which that colour creates in relation to certain goods, are perceived by consumers as significant characteristics of said goods.¹⁴⁸ The General Court however finds that the considerations set out by the Board of Appeal, does not make it possible to establish that the colour off-white constitutes a characteristic which is objective and inherent to the nature of the goods in questions. On the contrary, the General Court finds that “[...] *those considerations, in so far as they refer to the aesthetic value and contribution of that colour, involve an element of subjective assessment, that is to say an element which, by definition, is likely to vary greatly according to the individual preferences of each consumer. However, personal assessments of individuals comprising the relevant public*

¹⁴⁷ T-423/18 (*vita*), paragraph 46.

¹⁴⁸ T-133/19 (*OFF-WHITE*), paragraph 39.

*cannot be used to determine how a sign may be perceived by the public as a whole*¹⁴⁹. As such, the General Court elaborates on the criteria “objective”, while omitting the criteria “permanent”.

Finally, the General Court concludes in the same manner as the Court does in T-423/18 (*vita*), by finding that the considerations relied upon by the Board of Appeal does not in fact constitute a sufficiently direct and concrete relationship with the goods concerned in such a manner that results in it being descriptive of said goods.¹⁵⁰

The above justifications made by the General Court in T-133/19 (*OFF-WHITE*) further substantiates the assumption that T-423/18 (*vita*) indicates a list of criteria which must be met in order for a characteristic to fall within the meaning of Article 7(1)(c) EUTMR and thus being able to create a sufficient and specific link to exist between the sign and the goods in question.

As discussed above, the significant precedent value of judgement T-423/18 (*vita*), is emphasised by the usage of the principles derived from the judgement in subsequent administrative practice as well as decisions from the Board of Appeals and the General Court. Of relevance in this regard is the refusal of application for the European Union trade mark “BLUE BLACK THREADS” with application number 018238826 from 14 September 2020. Regarding the application for registration of “BLUE BLACK THREADS”, the EUIPO has found the sign to be clearly descriptive for all the goods for which registration is sought. The EUIPO justifies the result by submitting that “[...] *the link between the goods and the mark is clear and straightforward. The mark clearly constitutes an inherent and objective characteristic of the goods [...]. All these are clothing items in general and can be of a colour between blue and black, contrary to the applicant’s arguments. The mark thus does not pass the test mentioned in the judgement 25/06/2020, T-133/19, ‘Off-white’ [...]*”.¹⁵¹ The EUIPO then continues by referring to the wording within T-423/18 (*vita*). Of particular interest is the way in which the EUIPO phrases the criteria as a *test*. Thus, indicating that the EUIPO considers the criteria set out in T-423/18 (*vita*) a test.

Also worth mentioning, are the decisions of the Fifth Board of Appeal of both 22 January 2021, R 499/2020-5 (*INSIDE*) and of 18 February 2021, R 206/2021-5 (*FEEDER-ROBOT*). In both decisions the Board of Appeal refers to the criteria mentioned in T-423/18 (*vita*), paragraphs 43-44 and T-133/19 (*OFF-WHITE*), paragraphs

¹⁴⁹ T-133/19 (*OFF-WHITE*), paragraph 44.

¹⁵⁰ T-133/19 (*OFF-WHITE*), paragraph 46.

¹⁵¹ Refusal of application number 018238826 (*BLUE BLACK THREADS*), page 3

36-37. The criteria are however not mentioned as a test by the Board of Appeal in either decision. Hence, T-423/18 (*vita*) seems to be well integrated in more recent case law.

The precedent value of the logic derived from T-423/18 (*vita*) and the criteria's applicability in a more general sense is further highlighted by the revisions made to the EUIPO Guidelines 2021 following T-423/18 (*vita*). In the revised Guidelines, T-423/18 (*vita*) is quoted in relation to the explanation of which characteristics are mentioned under Article 7(1)(c) EUTMR. It is emphasised that a characteristic within the meaning of Article 7(1)(c) EUTMR must be objective and inherent to the nature of the goods or services concerned as well as intrinsic and permanent with regard to said goods or services, cf. paragraph 44.

On the basis of the above, the following can be deduced about the precedent value of T-423/18 (*vita*). General criteria concerning when the name of a colour is *not* to be considered descriptive, can be derived from the justifications in paragraph 46. A sign consisting of the name of a colour is not to be considered descriptive of the relevant goods within pursuant Article 7(1)(c) EUTMR, if said colour is a purely random and incidental aspect of the product. The fact that a product may be more or less available in a colour, is thus not sufficient for the colour to be considered a descriptive characteristic of the goods in question. Considering the general phrasing in paragraph 44, the judgement's precedent value must be considered to go beyond the assessment of descriptiveness regarding signs consisting of names of colours. As such, a characteristic must be objective and inherent to the nature of the goods or services for which protection is sought while also being intrinsic and permanent with regard to said goods or services to be within the meaning of Article 7(1)(c) EUTMR. These conclusions are further substantiated by the adoption of the judgment within the EUIPO Guidelines 2021.

9. The applicability of T-423/18 (*vita*), in other Member States within the European Union and members of EUIPN

As mentioned in chapter 6.1 "Legal basis of trade mark law in the European Union", the Member States are not directly bound by Community case law, or case law from other Member States cf. the principle of territoriality. It is however assumed in this master thesis that the principals introduced by T-423/18 (*vita*) is in fact applicable to some extent.

This follows partly from the fact that the provisions regarding absolute grounds for refusal are corresponding within Article 7(1) EUTMR and Article 4(1) TMD and partly from the great motivation to harmonise practices regarding assessing and registering trade marks within the Union and other countries. As such, one of the focuses of The European Union Intellectual Property Network (EUIPN) is to promote the development of

common examination standards and practices in cooperation with national and regional Intellectual Property Offices in the European Union.¹⁵²

Accordingly, the principals set forth within T-423/18 (*vita*) are assumed to be applicable to some extent within European Member States and states that are members of the Agreement on the European Economic Area (also referred to as the EEA Agreements), i.e. Iceland, Liechtenstein and Norway.

A recent judgment from the Norwegian Borgarting Lagmannsrett (the Norwegian Court of Appeal) of 2 March 2020 is highlighted to substantiate this assumption. On page 14, the Norwegian Court of Appeal refers to paragraph 43 and 44 from T-423/18 (*vita*) within their justification. Thus, pointing out that a characteristic must be objective and inherent to the nature of the goods or services concerned, and intrinsic and permanent with regard to said goods or services in order to be considered a characteristic pursuant Article 7(1)(c) EUTMR. This judgement further substantiates that the principles derived from T-423/18 (*vita*) is indeed applicable to some extent.

10. A comparison of the interpretation of descriptiveness – A change in direction

In the analysis found in chapter 8.2 “Analysis of T-423/18 (*vita*)”, it is mentioned that T-423/18 (*vita*) might be considered to indicate a change in direction regarding the assessment of the descriptive character of a sign within the meaning of Article 7(1)(c) EUTMR. In this regard, this master thesis particularly refers to and focuses on the interpretation of descriptiveness following C191/01 P (*DOUBLEMINT*). In this judgement, the Court finds that it is not necessary for the signs and indications composing the mark to actually be used in a descriptive manner at the time of the application for registration. Instead, the Court states that it is sufficient that such signs and indications *could* be used for descriptive purposes. Thus concluding, that a sign must be refused registration pursuant Article 7(1)(c) EUTMR if at least one of its possible meanings designates a characteristic of the goods or services in question.¹⁵³

As mentioned in the analysis of chapter 8.2 “Analysis of T-423/18 (*vita*)”, it is important to bear in mind that the General Court refers to already settled case law in its judgement, reiterating some of the already well-known criteria for assessing descriptiveness of a sign, including beforementioned principles derived from C191/01 P (*DOUBLEMINT*). As such, the General Court makes it clear that the present case does not seek to completely alter the former point of view on when a sign should be considered descriptive. The present case

¹⁵² Tmdn.org, *European Cooperation in the EUIPN*.

¹⁵³ C191/01 P (*DOUBLEMINT*), paragraph 32.

may instead seek to elaborate on this standpoint formerly taken by the Court and further specify when such a possible meaning does in fact designate a characteristic within the meaning of Article 7(1)(c) EUTMR. This is inferred by the phrasing chosen by the General Court's justification of the judgement in which the main focus seems to be on which types of characteristics can be considered to fall within the scope of Article 7(1)(c) EUTMR. Firstly, the General Court comments on the European Union legislators' choice of using the word "characteristic" within Article 7(1)(c) EUTMR. The Court finds that this choice in wording highlights the fact that the signs referred to in Article 7(1)(c) EUTMR are merely those which serve to designate a property of the goods or services concerned which is easily recognisable by the relevant class of persons.¹⁵⁴ Following this rationale, the General Court concludes that "[...] *a sign can be refused registration on the basis of that provision only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics [...]*". Expanding on this, the General Court further concludes that a characteristic within the meaning of Article 7(1)(c) EUTMR must be objective and inherent to the nature of the goods or services concerned, while also being intrinsic and permanent with regard to said goods or services.¹⁵⁵ It would thus seem that the Court aims to establish a minimum requirement for when a characteristic is sufficiently significant in relation to the goods and services in question, to actually prohibit a sign from being registered due to descriptiveness. In doing so, it would seem that the Court does not in fact seek to change the previous state of law created by C191/01 P (*DOUBLEMINT*) but rather specify the correct usage of the principles derived from the judgment.

Moreover, it is concluded in the analysis of chapter 8.2 "Analysis of T-423/18 (*vita*)" that a general criterion concerning when the name of a colour is at least *not* to be considered descriptive, can be derived from the General Courts specific justifications. The general criterion being that a sign consisting of the name of a colour cannot be considered descriptive of the relevant goods pursuant Article 7(1)(c) EUTMR, if said colour is a purely random and incidental aspect of the product.¹⁵⁶ The conclusion made by the General Court in this regard, must be perceived to be in line with the underlying interest of Article 7(1)(c) EUTMR, namely being to prevent the monopolisation of certain descriptive terms. This especially when considering that article 14(1)(b) and 14(2) EUTMR allows for a third party to use signs or indications which concern the characteristics of the goods or services in the course of trade in accordance with honest practises in industrial or commercial matters. As a result, the registration of a trade mark consisting of the name of a colour would not actually hinder others from describing the colour of a particular product.

¹⁵⁴ T-423/18 (*vita*), paragraph 43.

¹⁵⁵ Cf. C488/16 P (*Souvenir*), paragraph 44 as well as T822/14 (*Cottonfeel*), paragraph 32, T167/15 (*NEUSCHWANSTEIN*), paragraph 30 and T120/17 (*FLUO*), paragraph 40.

¹⁵⁶ See also T-423/18 (*vita*), paragraph 46.

The logic set forth in T-423/18 (*vita*) and T-133/19 (*OFF-WHITE*) can be seen practiced in varying degrees in subsequent judgements. A more recent refusal of application for the European Union trade mark “BLUE BLACK THREADS”¹⁵⁷, also mentioned in chapter 8.2.3 “Precedent value of T-423/18 (*vita*)”, does not seem to fully embrace that same logic. In the refusal, the EUIPO concludes that the mark is clearly descriptive for all the goods for which registration is sought. The EUIPO justifies this result by submitting that *“the link between the goods and the mark is clear and straightforward. The mark clearly constitutes an inherent and objective characteristic of the goods, which are in the present case Clothing; footwear; headgear. All these are clothing items in general and can be of a colour between blue and black, contrary to the applicant’s arguments. The mark thus does not pass the test mentioned in the judgement 25/06/2020, T-133/19, ‘Off-white’ [...]”*.¹⁵⁸ The EUIPO then continues by referring to the wording within T-423/18 (*vita*). It seems unclear how these circumstances differ from the circumstances in T-423/18 (*vita*), and thus justifying the conclusion made by the EUIPO. Particularly when contemplating the wording “[...] can be of a colour between blue and black [emphasis added] [...]”, thus highlighting that the sign does not actually describe an objective and inherent characteristic. The conclusion seems erroneous when particularly considering the wording of T-423/18 (*vita*), paragraph 46: *“The mere fact that the goods concerned are more or less usually available in white, among other colours [...] is irrelevant, since it is not ‘reasonable’ [...], to believe that for that reason alone the colour white will actually be recognised by the relevant public as a description of an intrinsic characteristic which is inherent to the nature of those goods.”* A good reason as to why the availability of certain colours of clothes should be considered or assessed differently than of the goods concerned in T-423/18 (*vita*), does not seem to exist.

In the more recent decision of the Fourth Board of Appeal of 7 November 2019, R 1246/2019-4 (*RED*), which is highlighted in the EUIPO Guidelines 2021, the Board concludes that *“The sole fact that the goods claimed can be offered in red does not mean that ‘RED’ is understood as descriptive by the consumer. Colours play no role as product characteristics in the sector of the goods in question [...]. But even if [such] goods [...] may have a colour, this colour does not describe an essential characteristic of those goods.”*¹⁵⁹ Although the judgement does not refer to T-423/18 (*vita*), the conclusion seems to follow the same logic to some extent however phrasing the justification differently. In R 1246/2019-4 (*RED*), the Board focuses on whether the colour of the goods is an essential characteristic instead of whether the characteristics are objective and inherent to the nature of the goods, as well as being intrinsic and permanent for said goods. It might however be argued that R 1246/2019-4 (*RED*) does not actually make use of the same logic as seen in T-423/18 (*vita*).

¹⁵⁷ Refusal of application number 018238826 (*BLUE BLACK THREADS*)

¹⁵⁸ Refusal of application number 018238826 (*BLUE BLACK THREADS*), page 3

¹⁵⁹ R 1246/2019-4 (*RED*), paragraph 14.

R 1246/2019-4 (*RED*) does not establish an absolute delamination but instead the Board rejects the sign being descriptive based on the specific sector of goods in question. As such, one might question whether the conclusion would have been the same if the associated goods belonged to a different sector of goods such as clothing or cars of which the colours of said goods are arguable an *essential* characteristic due to it being relevant for the consumers' choice.

R 1246/2019-4 (*RED*) is one of the three decisions which replaced the former examples used in the EUIPO Guidelines 2020. A stark difference can be observed in the reasonings behind the decisions from the EUIPO Guidelines 2021 and 2020.

In the examination of the descriptiveness of the sign concerned in R 2588/2015-5 (*CYAN*), the Board finds that a colour is an essential characteristic when it comes to goods such as cars, jewellery and clothing, because the consumer attaches such importance to the colour of the product that the colour often is the decisive factor when consumers decide whether or not they should purchase a product.¹⁶⁰ On this basis the Board concludes that the sign "CYAN" has a direct and concrete link with the goods for which registration is sought, in the mind of the relevant public.¹⁶¹ Therefore, registration is refused on the basis of descriptiveness pursuant Article 7(1)(c).¹⁶²

If the logic derived from T-423/18 (*vita*) is to be applied in this situation, the relation between the sign and goods in question must be re-examined. It should be assessed whether the colour "cyan" is objective and inherent to the nature of cars, jewellery and clothing – and if "cyan" is an intrinsic and permanent characteristic of said products. The goods in question are all available in a multitude of colours and "cyan" does not designate any singular or inherent characteristics of the goods – colour or otherwise. From a simple evaluation, it is easily deduced that "cyan" is merely a random and incidental aspect of the products. The colour of a product may be of value to the consumer, however, in regard to these goods specifically, "cyan" cannot be said to be descriptive in the same manner that "blue" is descriptive of blue cheese and "green" is descriptive of green tea.¹⁶³

Likewise, the application EUTM No 14 497 986 (*Ceramic White*) has been refused registration because "[...] *in the context of the contested goods, the consumer would see nothing more than a clearly descriptive message, inasmuch as they would be of a ceramic finish and would be white in colour.*"¹⁶⁴ If the interpretation of Article 7(1)(c) EUTMR derived from T-423/18 (*vita*) is to be applied in this situation, the EUIPO would have

¹⁶⁰ R 2588/2015-5 (*CYAN*), paragraph 16.

¹⁶¹ R 2588/2015-5 (*CYAN*), paragraph 19.

¹⁶² R 2588/2015-5 (*CYAN*), paragraph 20.

¹⁶³ Guidelines for Examination in the Office 2021, Part B Examination, p 456.

¹⁶⁴ EUTM No 14 497 986 (*Ceramic White*), page 2.

to conclude that “Ceramic White” is not objective and inherent to the nature of smartphones, PDAs, TV receivers nor is it an intrinsic and permanent characteristic of said goods. As such, “Ceramic White” cannot be refused registration on the basis of descriptiveness.

R 664/2016-4 (*Opal Blue*) is not refused registration on the basis of descriptiveness, however the different result when compared to EUTM No 14 497 986 (*Ceramic White*) and R 1246/2019-4 (*RED*) is simply due to the colourless nature of the goods concerned. Software is colourless, and so, the name of a colour cannot designate a characteristic of said goods. It is important to note the difference between the examination and deduction made in R 1246/2019-4 (*RED*) and R 664/2016-4 (*Opal Blue*). Both decisions are included in the EUIPO Guidelines, 2021 and 2020 respectively, as examples of when the name of a colour may be allowed registration. While R 1246/2019-4 (*RED*) displays an in-depth examination of the relation between the goods and the sign in question, noting that the goods are available in red but concluding that this is ultimately inconsequential for the descriptiveness assessment, the inclusion of R 664/2016-4 (*Opal Blue*) in the EUIPO Guidelines 2020 as the only example of a sign consisting of the name of a colour being accepted by the Office, seems to suggest that the only scenario wherein a sign consisting of the name of a colour would be allowed registration for any goods, is if said goods are inherently colourless.

It can be said that the underlying interest of Article 7(1)(c) EUTMR, is to ensure that the registration of word marks does not give a holder an “unfair” advantage, which can be used to limit free competition. It is illustrated in chapter 7 “European Union case law on descriptive marks prior to T-423/18 (*vita*)”, that in the name of fair competition, the EUIPO and the courts have often interpreted the scope of the provision and the understanding of descriptiveness pursuant Article 7(1)(c) EUTMR as widely as possible. Thus, resulting in a juridical status where an application is more likely to be caught by the prohibition. This holds especially true for signs consisting of names of colours but can also be seen practiced throughout the wide range of word marks in general.

It is clear that most of the case law referenced in this master thesis is not limited to a specific good or service, or category of words. Although neither C-191/01 P (*DOUBLEMINT*), T-19/04 (*PAPERLAB*) nor C-363/99 (*Postkantoor*) make any mention of signs consisting of names of colours, these judgements still serve as reference material for the interpretation of Article 7(1)(c) EUTMR in the examination of applications for signs consisting of names of colours. A parallel is drawn between the cases simply because the provision poses the same criteria notwithstanding the category of words and goods or services. As such, a judgement in which the descriptiveness assessment regards a sign consisting of names of colours is not necessarily limited from being used as a reference base for a descriptiveness assessment regarding other types of signs.

So far, T-423/18 (*vita*) has been added to chapter 2.9 “Names of colours” and chapter 1.3 “Characteristics mentioned under Article 7(1)(c) EUTMR” in the EUIPO Guidelines 2021. The only example of an accepted application for signs consisting of names of colour is R 1246/2019-4 (*RED*) which does not in fact apply the same logic as T-423/18 (*vita*). This raises the question of whether the current inclusion in the guidelines sufficiently protect applications from wrongful refusals. If used more efficiently, the logic derived from T-423/18 (*vita*) may serve as a greater assistance in the interpretation of descriptiveness on a broader scale.

11. Expansion of the utilisation of T-423/18 (*vita*) in the EUIPO Guidelines

As mentioned above, T-423/18 (*vita*) may seek to elaborate on how one should assess whether or not a term does indeed designate a characteristic of the goods or services within the meaning of the provision. This master thesis has observed what seems to be a minimum requirement established by the Court, as to when a characteristic is sufficiently related to the goods or services in question to actually fall within the prohibition pursuant Article 7(1)(c) EUTMR. The criteria derived from T-423/18 (*vita*) seemingly aims to specify some of the already established principles as illustrated in chapter 7 “European Union case law on descriptive marks prior to T-423/18 (*vita*)”.

The EUIPO Guidelines serve as a roadmap for the examination of trade mark applications with the guidance of case law. T-423/18 (*vita*) has already been incorporated in the Guidelines to some extent as illustrated in chapter 1.3 “Characteristics mentioned under Article 7(1)(c) EUTMR” and 2.9 “Names of colours”. The guidelines illustrate the overall consensus on the interpretation of Article 7(1)(c) EUTMR, which is why the following will explore how T-423/18 (*vita*) may be more efficiently incorporated in the guidelines.

The reason why this exploration is important, is because T-423/18 (*vita*) seems to have distinctly changed the direction of the interpretation of descriptiveness pursuant Article 7(1)(c) EUTMR, as illustrated in most importantly C-191/01 P (*DOUBLEMINT*) but also other judgements such as C-363/99 (*Postkantoor*). The zealous protection of the underlying public interest has blocked the way for countless applications, as illustrated by all three examples mentioned in the EUIPO Guidelines 2020 concerning signs consisting of names of colours and chapter 7.10 “European Union case law on signs consisting of names of colours”. This change in direction brought upon Article 7(1)(c) EUTMR by T-423/18 (*vita*) may work in tandem with the already established principles, but the gravity of the change cannot be ignored. This is illustrated by chapter 10 “A comparison of the interpretation of descriptiveness – A change in direction”, in which it is observed that both examples from the EUIPO Guidelines 2020 regarding the refused applications for signs consisting of names of colours would have had different outcomes if T-423/18 (*vita*) had been incorporated.

Since this change in direction is to such a significant degree, a more prominent incorporation may be required to ensure legal certainty for all applicants.

Subsequent to T-423/18 (*vita*) the very understanding of Article 7(1)(c) EUTMR seems to have changed. Particularly concerning applications such as signs consisting of names of colours. To ensure that examiners fully recognize this change in direction, and to make the T-423/18 (*vita*) logic more accessible to applicants, it may be beneficial to incorporate T-423/18 (*vita*) in additional chapters of the guidelines.

An ideal chapter for such an additional incorporation could be chapter 5.1 “Term not used” of the EUIPO Guidelines 2021. Chapter 5 concerns so-called “Irrelevant Criteria”, which contains a list of arguments that have already been rejected and declared irrelevant by the courts. According to the intro to chapter 5, the listed arguments should be rejected.¹⁶⁵ One of these rejected arguments are exemplified in chapter 5.1 in which it is explained that “*The fact that a descriptive use of the term applied for cannot be ascertained is irrelevant [...] It follows clearly from the text of Article 7(1)(c) EUTMR that it suffices if the mark ‘may serve’ to designate characteristics of the goods and services [...]*”.¹⁶⁶ The chapter does not elaborate on this distinction further and appears rather vague and broad in its description of said principle. The lack of specification may result in the wrongful rejection of an applicant’s argumentation, which could lead to more applications being wrongfully rejected simply because the mark “may serve” to designate *any* characteristics of the goods or services in question.

The vague wording of the principle is of no help to applicants who wishes to navigate the provision properly, thus risking limiting competition due to a difference in resources for different sized companies. It may even sow confusion and mislead applicants and examiners alike, who may choose to interpret and apply this chapter of the guidelines independently and without exploring possible exceptions to- or specifications of this vague example of when an argumentation should be refused.

An incorporation of T-423/18 (*vita*) into chapter 5.1 would provide a more detailed description of how the principle derived from C-191/01 P (*DOUBLEMINT*) should be applied. It would not change the fundamental understanding of Article 7(1)(c) EUTMR as described in this chapter, but it would specify that *even if* a descriptive use of the term applied for is irrelevant and *even if* the mere possibility of a mark serving to designate characteristics of the goods or services will suffice, the designated characteristics must be objective and inherent to the nature of the goods or services in question, as well as being intrinsic and permanent for said goods or services. This specification would clarify that the principles may not apply for just any scenario and allow for a more in-depth examination of the relation between the signed applied for and the goods or

¹⁶⁵ Guidelines for Examination in the Office 2021, Part B Examination, p 335.

¹⁶⁶ Guidelines for Examination in the Office 2021, Part B Examination, p 335, cf. C-191/01 P (*DOUBLEMINT*)

services in question. With the addition of the T-423/18 (*vita*) requirements, the C-191/01 P (*DOUBLEMINT*) principles provide what seems to be a more accurate description of the provision, which simultaneously protects the underlying interest of the provision, and prevents “endangerment” of the growth of the market and the rise of new competition. This addition could provide a less ambiguous description of the scope of the provision, which would be easier for applicants to navigate.

The change brought by T-423/18 (*vita*) may be used to clarify the interpretation of Article 7(1)(c) EUTMR and help to provide a more in-depth explanation of the reasoning behind a registration or refusal of an application. A more transparent examination of trade mark applications seems especially relevant for our current consumer centric lifestyles, where globalisation and modernisation has enabled an exponential multiplication of brands of all sizes. While bigger companies will have the resources to ensure a more or less effortless application process, small or midsize companies may be wasting resources time and time again without the correct knowledge.

This also raises the question of whether or not the broad protection of the public formerly seen is necessary. Especially in this day and age where consumers are exposed to a multitude of brands on a daily basis and where marketing is becoming more and more visual thanks to the evolution of social media, one might get the impression that the former zealous protection of certain category of words, such as names of colours, is decreasing.

Ultimately, this change in direction may be a consideration of both the producers’ need for more sophisticated branding in the ever-increasing crowd of competitors and the consumers whom with the development in our society has become better equipped to recognise signs as sources of commerce. As such, it should be contemplated that the consideration of consumers must necessarily change as consumers become more and more aware as a direct result of the constant exposure to brands and advertisement through social media, television, magazines, billboards, etc. Thus, making the average consumer more equipped to recognise brands and differentiate between e.g., the name of a colour being used as a brand as opposed to it being used to describe the colour of a product.

12. Conclusion

The absolute grounds for refusal, including the non-registrability of descriptive signs, are regulated in Article 7(1) EUTMR. Due to European Union trade mark law being sparse in words and elaborations, European Union trade mark law consists to a large extent of legal standards found in European Union case law. From this can be derived some general criteria that is to be considered within the assessment of descriptiveness as well as particular criteria regarding the assessment of descriptiveness of signs consisting of names of colours.

It has been observed in this master thesis, that the interpretation of descriptiveness within the meaning of Article 7(1)(c) EUTMR has a long history of being rigorous across the board and where applications more often than not are refused registration, should there be any uncertainty in regard to the descriptiveness of a sign. A frequently used reference base as to how descriptiveness should be interpreted is C-191/01 P (*DOUBLEMINT*). According to the judgement, it is irrelevant whether or not the word mark in question is used to designate characteristics of the goods or services for which registration is sought. There mere possibility will justify a refusal pursuant Article 7(1)(c) EUTMR. Another example is T-19/04 (*PAPERLAB*) which seems to suggest that the descriptiveness assessment of a sign and the goods or services in question, depends on the perception of the goods or services in the minds of the relevant public, in such a way, that any possible link between the sign and the goods would justify a refusal of the application. Both cases are often referred to when signs consisting of names of colours are refused registration.

The examination of applications of signs consisting of names of colours has in large been very singular. As illustrated in C-191/01 P (*DOUBLEMINT*) and T-19/04 (*PAPERLAB*), it seems that the mere possibility of the goods in question being any colour is enough for the application to be rejected. Based on previous decisions, it can be said that as long a product has a colour, this characteristic will be important in the mind of the relevant consumer, resulting in the sign consisting of the name of a colour being descriptive by its very nature.

New criteria regarding the assessment of descriptiveness can however be derived from T-423/18 (*vita*). The General Court largely follows already settled case law and reiterates many of the aforementioned criteria. The ruling does nonetheless form new general criterion concerning the assessment of descriptiveness.

Specifically, regarding names of colours can be concluded that a sign consisting of the name of a colour is *not* to be considered descriptive of the relevant goods within the meaning of Article 7(1)(c) EUTMR, if said colour is a purely random and incidental aspect of the product. A product being more or less available in a colour, is *not* sufficient for the colour to be considered descriptive. This altogether changes the previous standpoint regarding the assessment of descriptiveness of signs consisting of names of colours. As such, the EUIPO Guidelines has been changed accordingly.

Considering the general phrasing in paragraph 44 of the ruling, the judgement's precedent value must be considered to go beyond the assessment of descriptiveness regarding signs consisting of names of colours. This conclusion is further substantiated by the adoption of the judgment within the EUIPO Guidelines 2021, section 4, chapter 1.3. As such, the judgement offers new general criteria as to when a sign can be considered descriptive within the meaning of Article 7(1)(c) EUTMR. The General Court sets the tone for when a

characteristic is considered to be within the meaning of Article 7(1)(c) EUTMR. Accordingly, a characteristic must be objective and inherent to the nature of the goods or services concerned and intrinsic and permanent with regard to said goods or services. For a characteristic to be objective, it must be perceived as a factual description of the goods or services by the relevant public in its entirety, i.e., by all observers. The assessment of descriptiveness must not be subject to personal feelings, prejudices or interpretations of the examiner or the individual buyer. In order for a characteristic to be intrinsic and inherent to the nature of the goods or services, it must be an essential character of those goods or services. Although, it is difficult to distinguish between the two criteria, it is relevant to consider that the General Court does not seem to use the adjectives interchangeably. This suggests that the General Court views the terms as separate and differing from each other. Lastly, for a characteristic to be considered permanent, it must not be subject to change over time.

From the comparisons made in T-423/18 (*vita*), it can be concluded that the General Court considers the following as being intrinsic characteristics inherent to the nature of the goods or services concerned:

- a) The point of using a good or service,
- b) The intended purpose of a goods or service, and
- c) The quality of the goods or services concerned.

Furthermore, a sign might be considered descriptive within the meaning of Article 7(1)(c) EUTMR, if it consists of a term which can be easily recognised as a generic term used for a specific category of goods or services, if the goods or services for which protection is sought, in fact falls within that specific category.

The principles set forth within T-423/18 (*vita*) is assumed to be applicable to national trade marks within the Union as well as within members of the EEA Agreement, i.e., Iceland, Liechtenstein and Norway.

Altogether, T-423/18 (*vita*) seems to alter previous standpoints as regards the interpretation of descriptiveness within the meaning of Article 7(1)(c) EUTMR. The Court seemingly aims to establish a minimum requirement for when a characteristic is sufficiently significant in relation to the goods and services in question, to actually prohibit a sign from being registered due to descriptiveness. With the specification of when a characteristic can be considered to fall within the scope of Article 7(1)(c) EUTMR, the proper usage of C-191/01 P (*DOUBLEMINT*) must be reconsidered. The assumption that a sign must be refused registration pursuant Article 7(1)(c) EUTMR if at least one of its possible meanings designates a characteristic of the goods or services concerned, must now be considered in relation to the justifications made in T-423/18 (*vita*). Essentially it has been clarified that not *any* sign or indication that has the ability to designate a characteristic of the goods or services in question is sufficient to render the sign descriptive pursuant Article 7(1)(c).

Although T-423/18 (*vita*) has been incorporated in the EUIPO Guidelines of 2021, we have yet to see the logic set forth in the judgement to fully shine through in the more recent case law.

It has been observed that this change in direction would have changed the outcome of several previous trade mark applications, most notably applications regarding signs consisting of names of colours. This may be a consideration of both the producers' need for more sophisticated branding and the consumers whom with the development in our society has become better equipped to recognise signs as sources of commerce. Without undermining the underlying purpose of the protection, this change in direction may allow for an evolution of branding itself. However, the inclusion of T-423/18 (*vita*) in the EUIPO Guidelines may be subject to reconsideration to promote accessibility to this knowledge and to ensure a correct application of the criteria in the examination process.

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