

World Trademark Review Daily

**Colour combination registered based on acquired distinctiveness
European Union - McDermott Will & Emery UK LLP**

**Examination/opposition
International procedures**

February 18 2010

In *Andreas Stihl AG & Co KG* (Case R 355/2007-4, November 30 2009), the Board of Appeal of the [Office for Harmonization in the Internal Market](#) has confirmed the examiner's decision that *Andreas Stihl AG & Co KG*'s colour mark was not inherently distinctive, but held that the mark had acquired distinctive character under Article 7(3) of the [Community Trademark Regulation](#) (207/2009).

The mark applied for consisted of the combination of the colour orange, applied to the top of the housing of power-operated cut-off machines (chainsaws), and the colour grey, applied to the bottom of the housing. The application covered "power tools, namely power-operated cut-off machines" in Class 7 of the [Nice Classification](#).

In 2007 OHIM refused protection of the mark for all the goods in question on the grounds that the mark was devoid of any distinctive character within the meaning of Article 7(1)(b) of the regulation. Stihl appealed the decision and submitted various arguments supported by evidence, including the following:

- The mark did not claim protection for the colours orange and grey *per se*, but for the colours as applied to the housing of the goods in question. This could clearly be seen from the description of the claimed colours.
- Even a colour *per se* can be inherently distinctive if the category of goods or services is restricted and the market is very specific (ie, not the general public).
- The colours orange and grey are not common warning colours.
- Alternatively, the mark had acquired distinctiveness through extensive use since 1972 throughout all the member states of the European Union. Evidence of turnover, advertising spend and distribution throughout the European Union was provided.

Stihl also submitted:

- statements from the Austrian Forestry Association, the German Federal Association of Power-Operated Tools and various Spanish companies stating that the colour combination was associated with Stihl; and
- two market surveys in Germany and France showing that the relevant consumers associated the colour combination with Stihl.

The Board of Appeal first considered the inherent distinctiveness of the mark. If the mark was granted protection, it would, under Article 7(1), confer on the owner rights over the colours *per se*, irrespective of which parts of the goods the colours were applied.

Distinctive character must be assessed by reference to the goods or services in question, as well as the perception of the relevant public. The board accepted that the goods for which protection was sought were specific and specialized. As for the relevant public, it accepted that it consisted of a professional public, such as skilled forestry workers and professional gardeners.

However, the board pointed out that perception by this category of consumers is not the same for colour marks as it is for word or device marks. With colour marks, the public will not instantly perceive the colours as an indicator of their commercial origin. Although colours are capable of conveying ideas, they do not necessarily communicate specific information. Further, there is a public interest in keeping colours available for other competitors.

According to the board, the orange part of the housing could serve to draw the attention of users to the dangerous parts of the machine and would not, therefore, be perceived as an indicator of origin. Further, orange is used as a warning or safety colour, for example, on traffic cones. The shade of orange used was also irrelevant. Even if the shades were different, such difference was not perceptible to the relevant public. Consumers, even specialists, do not retain a perfect image of a mark in their mind and would not differentiate between various nuances or shades of orange. Further, grey is commonly associated with metallic or plastic materials.

The board thus concluded that the combination of orange and grey itself could not perform the function of a trademark. Such distinctiveness would have to have been acquired and the relevant public would have to have become accustomed to the colours as a result of intense use.

World Trademark Review *Daily*

The board noted that under Article 7(3) of the regulation (acquired distinctiveness), intensive use must render the mark capable of functioning as an indicator of origin. The advertising evidence, sales figures, market share evidence and statements from various companies and associations in Austria, Germany and Spain demonstrated clearly that:

- Stihl was the market leader in the specific market of power-driven cut-off saws; and
- the colours were consistently used on the goods in question throughout the European Union.

However, mere use did not mean that the relevant public perceived the mark as an indicator of commercial origin.

Nevertheless, the surveys showed that a significant number of the relevant public did, in fact, perceive the orange and grey colour combination as identifying the trademark owner's company. In the German survey, 72% of interviewees stated that the colour combination indicated a specific company when they were shown a card of the colour combination and asked the following question:

"[Do you] think, in conjunction with petrol-engine-driven cut-off saws, that the colour combination is from a specific company, various companies or no company at all?"

Moreover, 68.4% of the interviewees went on to name the company correctly. These figures were confirmed by the French survey and, due to the intense use already proved across the whole of the European Union, the figures from the surveys could be extrapolated to the other member states.

The board decided that the surveys had all been done in line with scientifically proven principles. Therefore, Stihl was a market leader in the specialized field concerned and was instantly recognized by the relevant public by reference to the orange and grey colour combination. The board thus concluded that the mark had acquired distinctiveness within the meaning of Article 7(3).

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