

**DECISION  
of the Second Board of Appeal  
of 23 January 2018**

In Case R 200/2017-2

**Giro Travel Company**

7 Stefan cel Mare street, ground floor  
Roman, Neamt county  
Rumania

Cancellation Applicant / Appellant

represented by Crina Frisch, 54 Carol I Boulevard, B entry, 3rd floor, suite 5,  
020915 Bucharest, Rumania

v

**Andreas Stihl AG & Co. KG**

Badstr. 115  
71336 Waiblingen  
Germany

EUTM Proprietor / Defendant

represented by Gleiss Lutz, Lautenschlagerstraße 21, 70173 Stuttgart, Germany

APPEAL relating to Cancellation Proceedings No 11 122 C (European Union trade  
mark registration No 7 472 723)

THE SECOND BOARD OF APPEAL

composed of S. Stürmann (Chairperson), H. Salmi (Rapporteur) and  
C. Negro (Member)

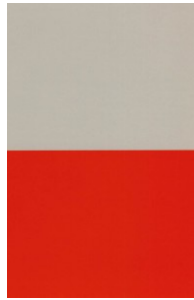
Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 19 December 2008, Andreas Stihl AG & Co. KG (hereinafter ‘the EUTM proprietor’) sought to register the colour mark



for the following goods:

Class 7 - Chain saws.

The EUTM proprietor claimed the colours orange (RAL 2010) and grey (RAL 7035) and described the mark as follows:

‘The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw.’

- 2 The application was published on 3 May 2011 and the mark was registered on 10 August 2011.
- 3 On 24 June 2015, the Giro Travel Company (hereinafter ‘the cancellation applicant’) filed a request for a declaration of invalidity of the registered mark for the registered goods.
- 4 The grounds of the request for a declaration of invalidity were those laid down in Article 59(1)(a) EUTMR in conjunction with Articles 7(1)(a)(b) and (d) EUTMR. In addition, the cancellation applicant claims that the contested EUTM was filed in bad faith in breach of Article 59(1)(b) EUTMR.
- 5 The cancellation applicant provided the following background information on the parties’ activities and on disputes between the parties before the Bucharest Tribunal:
  - The cancellation applicant is a Romanian company, which was established in 2003. Among its activities it imports and trades chainsaws for forestry in the Romanian market. The EUTM proprietor is a German company that produces, distributes and markets a variety of goods such as chainsaws and other similar power tools.
  - The EUTM proprietor took legal action against the cancellation applicant before the Bucharest Tribunal claiming infringement of its rights to the

contested EUTM. As a consequence, the cancellation applicant filed a counterclaim requesting the invalidity of the EUTM on the basis of lack of distinctiveness and bad faith. Upon motion made by the EUTM proprietor, the Bucharest Tribunal requested the cancellation applicant to submit an invalidity application to the Office pursuant to Article 100(7) EUTMR.

*Regarding the claims under Article 59(1)(a) EUTMR in conjunction with Article 7(1) EUTMR and Article 59(1)(b) EUTMR,*

- The EUTM proprietor has already filed an EUTM application for a colour mark consisting of a combination of orange and grey (EUTM application No 338 194). However, the Office considered that the sign was non-distinctive pursuant to Article 7(1)(b) EUTMR.
- Since the contested EUTM is a colour mark comprising the same colours, the findings of the Office should also apply in the present case. The EUTM is indeed non-distinctive as it merely consists of the depiction of two colours, orange and grey, which are widely used in the relevant market, as shown below:



- In particular, the colour orange serves to draw the attention of the users to the dangerous parts of the power tools, while the colour grey is typically associated with the materials, metallic or plastic, of which the goods at issue are comprised. Therefore, the mark consists of colours that are common in the field of forest tools and are the get-up of the majority of chainsaws available in the market. Such colour combination in connection with the contested goods in Class 7 is not perceived as a trade mark within the meaning of Article 7(1)(b) EUTMR.
- Moreover, the EUTM application was filed in bad faith. At the moment of the filing of the EUTM, the EUTM proprietor was aware that a number of its competitors were using the colours at issue to indicate the dangerous parts of their products. Despite being fully aware that the orange and grey combination is widely used for chainsaws and that its previous EUTM application was refused by the Office, the EUTM proprietor applied for the contested EUTM.
- The EUTM proprietor's aim was to prevent third parties from marketing chainsaws or similar power tools bearing the same colours.
- In support of its observations, the cancellation applicant filed the following evidence:

- **Appendix 1:** Extracts from EUIPO's 'eSearch plus' database showing details of the contested EUTM.
- **Appendixes 2a and 2b:** Extracts from the Romanian Patent and Trade Mark Office (OSIM) showing details of the cancellation applicant's figurative marks 'SPARTAK' and 'TOTEM Powerful Tools' for goods and services in Classes 7 and 35.
- **Appendix 2c:** Extracts from the websites www.dedeman.ro and www.leroymerlin.ro showing images of two chainsaws under the signs 'TOTEM' and 'MOTOFERASTRAU BENZINA'.
- **Appendix 3:** An extract featuring images of the EUTM proprietor's chainsaws.
- **Appendix 4:** An extract featuring images of forest tools and gear in orange and grey including, *inter alia*, the following products:



6 In response, the EUTM proprietor argues as follows:

- The company Andreas Stihl AG & Co. KG (the EUTM proprietor) is the world's leading producer of chainsaws. 'STIHL' has been the world's best-selling chainsaw brand since 1971. The company's general revenue in 2014 exceeded EUR 2.9 billion.
- In August 2014, the cancellation applicant imported 2 030 counterfeit chainsaws into Romania, which copied the characteristics and colour scheme of the 'STIHL' chainsaws. The EUTM proprietor has brought a civil law suit against the cancellation applicant before the Bucharest Tribunal (in case No 28443 March 2014) because of the infringement of the contested EUTM.
- Contrary to the cancellation applicant's claim, the contested EUTM fulfils the requirements set out by Article 4 EUTMR in conjunction with Article 7(1)(a) EUTMR: the mark's protection is granted for the colours orange (Pantone RAL 2010) and grey (Pantone RAL 7035) applied to the goods at issue as indicated in the description of the mark.
- The cancellation applicant's arguments regarding Articles 7(1)(b) and (d) EUTMR are irrelevant since the application for the contested EUTM was accepted on the basis of Article 7(3) EUTMR. The same applied to the International Registration No 872 542 – designating the EU - for the figurative sign hereunder:



- The cancellation applicant has presented no arguments or evidence questioning the fact that the contested mark acquired distinctive character through use when it was filed in 2008.
- As already submitted during the examination proceedings, the EUTM proprietor has been using this colour combination since 1972. In particular, the EUTM proprietor operates through several subsidiary companies and has also built up a network of distributors and licensed dealers in all the EU Member States.
- For many years the EUTM proprietor was – and still is – the EU market leader in the field of gasoline chainsaws, with a correspondingly high market share and correspondingly high number of units sold and turnover achieved. Reference is made to the evidence filed during the examination proceedings.
- As to the advertising figures, a considerable amount of money has been invested in promoting power tools in all the EU Member States. The colours orange and grey have been used in advertising material, both in the depiction of the products as well as in other parts of the advertising. The colour combination is also used in all the ‘STIHL’ outlets operated by the EUTM proprietor’s dealers. The chainsaws have been advertised in catalogues, newspapers, magazines and trade journals. The EUTM proprietor has also sponsored international competitions that are broadcasted throughout the EU.
- Besides the market surveys already presented during the examination proceedings, a further survey for Croatia concerning the awareness of the colour combination orange/grey in November 2013 was conducted.
- The cancellation applicant’s reference to the refusal of the EUTM application No 338 194 is irrelevant since in such case no claim of acquired distinctiveness was raised and, therefore, no evidence related thereto was furnished.
- The high reputation of the EUTM proprietor’s colour combination has been recognised by national courts in Germany, Czech Republic, Slovakia, China and Russia.
- As to the images depicting third parties’ chainsaws in orange submitted by the cancellation applicant, there is no indication that these products have been marketed in the any of the EU Member States or that, in particular, they were available before the filing of the EUTM within the EU. In any case, the following is noted the ‘HUSQVARNA’ product entered into the market in 2011 and its colour scheme, as a whole, is different to that of the ‘STIHL’ chainsaws; the same applies to the chainsaws under the signs ‘PARKLANDER’ and ‘DAC’; the chainsaws ‘RURIS’ and ‘CYCLONE’ were confiscated as being counterfeit goods by the German and Italian customs.
- Regarding the cancellation applicant’s claim on bad faith, at the time of the filing the EUTM proprietor had no knowledge of any third party using an identical or similar sign for an identical or similar product. The EUTM proprietor is the only company using the colour combination orange/grey for the goods at issue. It is therefore a legitimate interest to seek protection for

these colours. In addition, in 2008 the EUTM proprietor was already the owner of the IR No 872 542 designating the EU.

- In support of its observations, the EUTM proprietor - which was granted a request for continuation of proceedings pursuant to Article 82 EUTMR – filed extensive evidence referring to the period preceding the application for invalidity. It also included the documentation submitted on 19 December 2008 during the examination proceedings and made reference to the pieces of evidence filed in relation to examination of the International Registration No 872 542 designating the EU. All such material is duly listed and assessed in the section dedicated to Article 7(3) EUTMR.
- 7 In reply, the cancellation applicant reiterates its previous allegations and maintains that:
- The contested EUTM is solely represented by a combination of colours that needs to be available for causes of public interest, as also confirmed by the Court in the judgement of 09/07/2003, T-234/01, Orange und Grau, EU:T:2003:202.
  - In spite of the above, the EUTM proprietor is still seeking to monopolize such colour combination and filed an opposition proceedings against the cancellation applicant's Romanian trade mark application No M 2014 05856 on the basis of the contested EUTM.
  - Contrary to the EUTM proprietor's arguments, the goods imported by the cancellation applicant in Romania are not counterfeits and they bear the cancellation applicant's marks 'TOTEM Powerful Tools' and 'SPARTAK'.
  - As to the claim under Article 7(1)(a) EUTM, it is noted that the contested EUTM is not clear, precise, self-contained, durable and objective as required by case-law (12/12/2002, C-273/00, Methylcinnamat, EU:C:2002:748). The sign consists of the colours grey and orange in a 50:50 ratio, one on the top of the other. This colours combination is widely used in the relevant market and the EUTM proprietor is attempting to monopolise a colour scheme which should be available to any other company.
  - In the decision of 02/12/2014, R 2036/2013-1, Blue and Silver (colour mark), § 44) it was ruled as follows:
 

‘the mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours ‘in every conceivable form’, as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive.’
  - The same findings can apply to the present case, since the graphical representation of the contested EUTM is analogous to the colour mark rejected by the First Board of Appeal (consisting of the colour blue depicted on the left hand side and the colour silver on the right hand side).
  - As to the evidence filed by the cancellation applicant in respect of Article 7(3) EUTMR, it mainly refers to the brand 'STIHL' and not to the contested

EUTM. Although such documentation shows that the EUTM proprietor's goods have been marketed in different countries, it does not indicate whether the EUTM acquired distinctive character.

- The market surveys were ordered by the EUTM proprietor itself and their importance is debatable. They do not show the reality of the market, with multiple producers using the same chromatic range of colours for identical goods.
  - Regarding the claim of bad faith, the EUTM proprietor uses the mark to prevent competitors from using other shades of the colours protected by the mark. This demonstrates that it abuses of dominant position based on a chromatic registration. In addition, the bad faith is supported by the fact that the proprietor re-filed a EUTM application which was already rejected by the General Court.
  - In support of its observations, the cancellation applicant filed the following evidence:
    - **Appendix 5:** Extracts from the online registry of the Romanian Patent and Trademark Office (OSIM) providing details of the Romanian trade mark application No M 2014 05856.
    - **Appendix 6:** A copy of the resolution taken by the Bucharest Tribunal, 5<sup>th</sup> Civil Circuit, on 24 April 2015 in case No 28443 March 2014, which requested the defendant (the invalidity cancellation applicant) to submit an application for a declaration of invalidity to the Office in accordance with Article 100(7) EUTMR.
    - **Appendix 7:** Extracts providing general information regarding the national dispute between the parties before the Bucharest Tribunal.
    - **Appendix 8:** Extracts from the Romanian Patent and Trademark Office providing details of the opposition action filed by the EUTM proprietor against the cancellation applicant's mark No M 2014 05856 on the basis of several earlier trade marks, including the contested EUTM.
- 8 In its rejoinder, the EUTM proprietor reiterates its previous arguments, contests the cancellation applicant's claims and points out that:
- When applying for the EUTM, the EUTM proprietor submitted a colour sample as well as a description in words with reference to an internationally recognised colour system and a specification of the arrangement of both colours.
  - Furthermore, as already proved, the mark has acquired distinctiveness through use pursuant to Article 7(3) EUTMR.
  - The cancellation applicant's arguments on the alleged bad faith on the part of the EUTM proprietor is unfounded. The EUTM proprietor had the right to oppose the cancellation applicant's Romanian application as well as to file the application for the contested EUTM, since its aim is to protect its trade mark rights. In the case at hand, the EUTM proprietor has built a network of distributors across the EU and the EUTM filing follows a commercial logic.

- The evidence shows that the relevant public perceives the contested EUTM as a badge of origin of the relevant goods. In particular, in some countries the market surveys show that the EUTM enjoys a degree of association of 72% among the relevant public. Therefore, even if the mark is used in conjunction with the sign ‘STIHL’, it is clearly recognised as an indication of origin.
  - In support of its observations, the EUTM proprietor filed a copy of the invalidity cancellation applicant’s observations regarding the counterclaim action filed before the Bucharest Tribunal requesting the invalidity of the EUTM proprietor’s trade mark registrations EUTM No 9 388 877, EUTM No 7 472 723 and IR No 872 542.
- 9 By decision of 29 November 2016 (hereinafter ‘the contested decision’), the Cancellation Division rejected the request for a declaration of invalidity. It gave, in particular, the following grounds for its decision:

*Preliminary remark on the arguments on the national dispute between the parties*

- As a preliminary remark, the Cancellation Division would like to clarify that the parties’ arguments relating to the alleged cancellation applicant’s infringement of the EUTM proprietor’s rights to the contested mark in the Romanian territory are not relevant for the assessment of the distinctive character of the contested EUTM or for establishing whether the mark was filed in bad faith.
- The issue concerning whether or not the chainsaws bearing the marks ‘TOTEM Powerful Tools’ and ‘SPARTAK’ are counterfeit goods is outside the scope of the present proceedings.
- As for the cancellation applicant’s claim that EUTM proprietor’s request to the Bucharest Tribunal to stay the counterclaim proceedings was made in bad faith, it is noted that such request appears to be in line with the provisions set out in Article 100(7) EUTMR and cannot be addressed as an unfair behaviour on the part of the EUTM proprietor for the purpose of the present proceedings.

*Absolute grounds for invalidity – Article 59(1)(a) EUTMR in conjunction with Article 7 EUTMR*

- The question to be decided on is whether the mark has been graphically represented within the meaning of Article 4 and Article 7(1)(a) EUTMR.
- In its submissions, the cancellation applicant essentially argues that the EUTM is not capable of distinguishing the goods at issue of one undertaking from those of other undertakings, since it is not clear, precise, self-contained, durable and objective.
- The contested mark is represented as consisting of two colours, grey (RAL 7035) and orange (RAL 2010), depicted pictorially by two coloured squares of equal size, one grey coloured, positioned on top of the other, orange coloured. In addition, a textual description is given, consisting of the following text:



*‘The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw’.*

- In the observations attached to the application form submitted at the moment of the filing of the EUTM, the EUTM proprietor showed the arrangement of those colours, making also reference to the International Registration No 872 542 designating the EU of 4 November 2005, for the sign below:



- It appears from the above that the graphic representation and the verbal description of the sign are perfectly compatible and complementary.
- The function of the requirement of graphic representation is in particular to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor, so that economic operators are able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties.
- It seems to the Cancellation Division that this function is performed in the present case for the reasons set out above. The verbal description specifying that *‘the colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw’*, together with the attached colour scheme representation and other elements furnished at the moment of filing the EUTM, enables a systematic arrangement to be identified in which colours are used in a predetermined and uniform way. It may be understood by both relevant consumers and potential competitors from the foregoing that the chainsaws claimed in Class 7 will be orange in the top part of the housing and grey in the lower part of the housing.
- Therefore, the Cancellation Division concludes that the EUTM application satisfied the requirements under Article 4 EUTMR in conjunction with Article 7(1)(a) EUTMR.
- For the sake of completeness, the cancellation applicant’s reference to the decision of 02/12/2014, R 2036/2013-1, Blue and Silver (col.) has no impact on the present case, since in that case it was established that the registration did not define a precise subject of protection and its description did not specify the position of the colours in relation to each other in a way which could define one particular combination or juxtaposition. However, as seen above, this is not the case as far as the contested EUTM is concerned.
- Finally, the cancellation applicant’s allegation that the combination of grey and orange is widely used in connection with chainsaws – and, consequently, it should be available to any other company – concerns the distinctive character of the mark with regard to the specific contested goods and will be assessed in the following sections.

- To constitute a trade mark, colours or combinations of colours must satisfy three conditions. First, they must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings (12/11/2010, T-404/09 and T-405/09, *Grau/Rot*, EU:T:2010:466, § 15).
- The goods for which the mark is registered, namely ‘chain saws’ in Class 7, are targeted at a specialised public, namely skilled forestry workers and professional gardeners and employees of companies or public bodies specialised in construction or landscaping. Furthermore, as the contested EUTM is a colour mark with no legible word elements on it, the examination of its distinctive character must be based on the perception of consumers throughout the European Union.
- During the examination proceedings the EUTM was found to be non-distinctive pursuant of Article 7(1)(b) EUTMR. In the letter sent to the EUTM proprietor on 2 April 2009, the examiner found that the combination of colours orange (RAL 2010) and grey (RAL 7035) were commonly used for *chain saws* and considered that they were ‘not likely to be noticed and committed to memory as an indication of commercial origin’.
- The cancellation applicant claims that the EUTM is non-distinctive as it merely consists of the depiction of two colours, orange and grey, which are widely used in the in the field of forest tools. It points out that the colour orange serves to draw the attention of the users to the dangerous parts of the power tools, while the colour grey is typically associated with the materials, metallic or plastic, of which the goods at issue are comprised.
- The cancellation applicant further refers to 09/07/2003, T-234/01, *Orange und Grau*, EU:T:2003:202, § 42, in which the Court refused the EUTM application No 338 194, filed on 9 July 1996 by the EUTM proprietor, for the colour mark below:





- In its submissions the EUTM proprietor has not presented any argument as to the inherent distinctive character of the mark and has relied on its distinctiveness as a result of the use which had been made of it in accordance with Article 7(3) EUTMR.
- Therefore, it is undisputed by the parties that the colour combination grey/orange as appearing in the mark in question is inherently devoid of distinctive character in respect of the categories of goods for which the sign is registered in Class 7.
- Although the cancellation applicant has furnished scarce evidence to show that the colours grey and orange are widely used in the relevant sector, in light of the foregoing it can be confirmed that the relevant consumer will perceive the combination of grey and orange as applied to the housing of the goods at hand as a usual characteristic thereof and not as a badge of origin.

- The EUTM is therefore incapable, in respect of the goods in question, of serving as an indication of origin from the perspective of the consumers of the goods, and is therefore devoid of any (inherent) distinctive character pursuant to Article 7(1)(b) EUTMR.
- Since the contested EUTM falls foul of the prohibition laid down by Article 7(1)(b) EUTMR, for reasons of economy of proceedings, before considering the cancellation applicant’s arguments alleging breach of Article 7(1)(d) EUTMR, the Cancellation Division will firstly assess the EUTM proprietor’s claim to acquired distinctiveness, pursuant to Article 59(2) EUTMR in conjunction with Article 7(3) EUTMR.

#### *Acquired distinctiveness*

- In the case at hand, the relevant dates for the application of Articles 7(3) EUTMR and 59(2) EUTMR are the filing date of the contested EUTM (19 December 2008) and its registration date (10 August 2011), respectively, and also the date of filing of the application for invalidity (24 June 2015).
- Thus, it must be established either that the contested EUTM had acquired distinctive character on account of the use which has been made of it in the Member States of the European Union at the time of the filing date or that it has acquired such distinctive character on account of the use which has been made of it (14/12/2011, T-237/10, Clasp lock, EU:T:2011:741, § 90).
- Considering the foregoing, the proof of acquired distinctiveness submitted must show that the EUTM had become distinctive for at least a significant proportion of the relevant public in the European Union, in relation to the goods concerned, as a consequence of the extensive use which was made of it.
- Preliminarily, it is noted that, besides the contested registration, the EUTM proprietor is also the holder of EUTM No 9 388 877 and of International Registration No 872 542 designating the EU, for the marks below:

	
EUTM No 9 388 877	IR No 872 542

- The core features of the EUTM proprietor’s marks – which are all registered as colour marks – are practically identical. These registrations were all granted on the basis of acquired distinctiveness pursuant to Article 7(3) EUTMR. The evidence submitted in order to demonstrate acquired distinctiveness were essentially the same in respect of all the marks.
- The EUTM proprietor presented the documentation already filed at the examination stage and submitted further evidence, including:

- **Annex 1:** Official annual report regarding the EUTM proprietor's business activities in 2014. Images of STIHL chainsaws in orange and grey are displayed.
- **Annex 2:** An affidavit of 20 November 2015 signed by Mr Gunther Stoll, as a Senior Function Manager of the EUTM proprietor, claiming that their chainsaw has been repeatedly counterfeited by several companies, including the cancellation applicant. The affidavit is accompanied by images of counterfeited goods.
- **Annex 2a:** Copy of the application form, observations and evidence filed by the EUTM proprietor before the Office during the examination proceedings on 19 December 2008. The documentation includes the following:
  - Attachment 1: Copy of internal instructions dated 11 April 1972 concerning the use of the colours grey (RAL 7035) and orange (RAL 2004) for the visible parts of power tools.
  - Attachments 2 and 3: Catalogues in German, for the period 1988-2008, and in English, for the period 1994-2008, displaying, *inter alia*, different models of STIHL chainsaws in orange and grey.
  - Attachment 4: List of the EUTM proprietor's subsidiaries in Austria, Belgium, Bulgaria, Czech Republic, Denmark, France, Hungary, Italy, Netherlands, Poland, Portugal, Romania, Spain, Sweden and the UK.
  - Attachment 5: A table showing the number of licensed dealers of the EUTM proprietor in the EU Member States between 2000 and 2007.
  - Attachment 6: A list of EUTM proprietor's licensed dealers in Austria, Belgium, Czech Republic, Denmark, France, Germany, Greece, Hungary, Italy, Netherlands, Poland, Portugal, Romania, Spain, Sweden and the UK.
  - Attachment 7: Press release of McDonald's Europe dated 14 September 2006.
  - Attachments 8 Advertising samples from catalogues and magazines in Bulgarian, Danish, Dutch, French, German, Greek, English, Hungarian, Italian, Polish, Romanian and Swedish.
  - Attachment 8a: A list of TV-commercials for 'STIHL' products broadcasted in Germany and samples marketing campaigns in Austria, Belgium, Germany, France, Hungary, Italy, Poland, Romania, Spain, Sweden and the UK between February and March 2008.
  - Attachment 9: Extracts from the EUTM proprietor's website in different language versions.
  - Attachment 10: Extracts from an article dated March 2006 and from a press release published by Thomson Reuters on 26 June 2008 about the World Cup of Forestry Professional and the 'STIHL Timbersports Series'.
  - Attachment 11: Extracts from the EUTM proprietor's website providing information on the 'STIHL Timbersports Series' in different languages.

- Attachment 12: Press release of the EUTM proprietor dated 29 February 2008 including extracts from [www.fiacwtcc.com](http://www.fiacwtcc.com) concerning the sponsorship partner's.
  - Attachments 13 and 14: Advertising expenses of EUTM proprietor and its subsidiaries in the period 2003-2007 and only those related to chainsaws in the period 2003-2007 in Austria, Belgium, Bulgaria, Czech Republic, Denmark, France, Germany, Greece, Hungary, Italy, Netherlands, Poland, Portugal, Romania, Spain, Sweden and the UK.
  - Attachments 15 and 16: Sales numbers and market share figures generated by the sale of chainsaws in the period 2000-2007 in all the Member States (excluding Malta).
  - Attachment 17: Turnover figures related to the sale of chainsaws in the period 2000-2007 in all the Member States (excluding Malta).
  - Attachments 18 and 19: Annual reports for the period 1996-2007.
  - Attachments 20 and 21: Images of counterfeited products.
  - Attachments from 22 to 24: Market surveys in Germany and Poland – accompanied by a translation into English – issued by the company GfK Marktforschung GmbH in 2007.
  - Attachment 25: Various statements provided by Trade and Professional Associations from Austria, Belgium, Denmark, Germany, Hungary, Netherland and Spain.
  - Attachment 26: Copy of the letter of 21 April 2008 by which the Office notified the acceptance of the International Registration No 872 542 designating the EU, accompanied by extracts from the WIPO database showing details of the mark. Reference is also made to the decision of 30/11/2009, R 355/2007-4, Orange & Grey (col.), stating that the IR No 872 542 acquired distinctiveness in the EU within the meaning of Article 7(3) EUTMR.
- **Annex 3:** Copy of the decision of the Office dated 1 April 2011 notifying the acceptance of the contested EUTM on the basis of the evidence of acquired distinctiveness pursuant to Article 7(3) EUTMR.
  - **Annex 4:** Copy of the EUTM proprietor's catalogue dated 2015.
  - **Annex 5:** A diagram illustrating the corporate structure of the STIHL Group in Europe.
  - **Annex 6:** An affidavit signed by Mr Joachim Burandt on 23 November 2015, as a Sale Director of the EUTM proprietor, claiming that there are *'12 728 official STIHL dealers (including their branch outlets) and 5 520 sub-distributors who are supplied by the official STIHL dealers'* in the EU.
  - **Annexes from 7 to 13:** Copy of official annual company reports indicating the following worldwide turnover for the period 2008-2014. The reports also display a list of subsidiary companies included in the consolidated financial statements that are located in Austria, Belgium, Czech Republic, France, Germany, Greece, Hungary, Italy, Poland, Portugal, Romania, Spain, Sweden and the UK.

- **Annexes 14 and 15:** Images depicting a ‘STIHL’ outlet in orange and grey and samples of packaging of a range of the EUTM proprietor’s goods.
  - **Annexes from 16 to 22:** Copy of the EUTM proprietor’s catalogues dated between 2008 and 2015.
  - **Annex 23:** Extracts showing the EUTM proprietor’s website targeting users in almost all the EU Member States.
  - **Annex 24:** Extracts from the EUTM proprietor’s website regarding the ‘Stihl Timbersport Series’. From the evidence it appears that ‘STIHL Timbersports® is established worldwide as the major league of lumberjack sports’.
  - **Annex 25:** Advertising material and a TV report with a list of countries where the event was broadcasted in 2013, 2014. The list includes: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Latvia, Poland, Romania, Spain and the UK.
  - **Annex 26:** A survey report conducted in Croatia in November 2013.
  - **Annexes from 27 to 36:** Copy of decisions issued by national courts – in China, Czech Republic, Germany, Russia and Slovakia in 2011, 2012 and 2013 – holding that third parties infringed the EUTM proprietor’s rights to the contested mark.
  - **Annex 37:** Images of third parties’ chainsaws in orange and grey that were seized at the Italian customs.
- Since the EUTM proprietor requested data incorporated in the probative material to remain confidential, the figures provided will be analysed in general terms.
  - In the present case, the evidence shows that the EUTM proprietor used the mark in a significant proportion of the European Union and that it is one of the most important players in the specific, definable market segment of chainsaws. The data concerning the advertising expenses, the sales numbers and the market shares are supported by documents attesting an extensive presence of EUTM proprietor’s goods in Austria, Belgium, Bulgaria, Czech Republic, Denmark, France, Germany, Greece, Hungary, Italy, Poland, Portugal, Romania, Spain, Sweden and the UK. These goods as well as the promotional material always appear in the grey/orange colour combination.
  - Moreover, the high number of the EUTM proprietor’s branches is, in particular, to be noted. That factor, taken into consideration with the nature of the goods marketed by the EUTM proprietor – which are addressed to a specialised public – is ground for considering that these goods had been highly visible and widespread in the vast majority of the EU.
  - In its submissions, the cancellation applicant does not dispute the fact that the EUTM proprietor has marketed its goods within the EU, but it basically

contests that they are recognised by their name and not by their colour scheme. In other words, the cancellation applicant argues that the evidence fails to demonstrate that the EUTM had been used and had become distinctive, since the documentation mainly refers to the use of the mark ‘STIHL’.

- In this regard, it is true that since the contested EUTM comprises a colour combination, the mere use of the sign, no matter how extensive it would have been, would not allow for itself the conclusion that the relevant public perceives it as an indication of commercial origin. The EUTM proprietor’s evidence regarding sales figures and the turnover for the relevant goods is in need of being accompanied and supported by evidence regarding the recognition of the claimed colour combination as a mark, i.e. by documents relating to the perception of the sign by the relevant public as an indication of commercial origin.
- However, it must be recalled that the distinctive character of a mark may be acquired in consequence of the use of that mark as part of or in conjunction with another trade mark (07/07/2005, C-353/03, *Have a break*, EU:C:2005:432, § 32). Therefore, the fact that the colour combination orange and grey has been used in combination with the verbal element ‘STIHL’ does not exclude that the EUTM has acquired distinctive character through use. According to the Court, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark, as originating from a given undertaking (07/07/2005, C-353/03, *Have a break*, EU:C:2005:432, § 30).
- In this respect, the EUTM proprietor presented several independent statements emanating from seven different Member States: Austria (from the *Österreichische Bundesforste*, the *Municipal Horticultural Office*, *Österreichische Maschinenring*, *Fire Service of the City of Vienna*); Belgium (*IPC Groene Ruimte BV*, the *Royal Forestry Society of Belgium*, *Hooghouten-Camille BVBA*, the *Municipalities of Brussels, Beveren and Lokeren*); Germany (from the *German Test Centre for Agricultural and Forestry Machinery (DPLF)*, the *Federal Specialist Group for Power Tools (BuFa-MOT)*, the *German Association of Construction Machinery Engineers and Technicians (VDBUM)*, the *Educational Institute for Forestry*); Denmark (*Banedanmark*, *Enterprise Forestry*); Hungary (the *Hungarian Forestry Association (OEE)*, *Federation of Hungarian Private Forest Owners (MEGOSZ)*); Netherlands (*Licom Groen*); and Spain (*National Association of Agricultural Machinery, Forestry and Green Spaces (ANSEMAT)*).
- In all these statements it is recognized that the colour combination grey/orange applied to chainsaws is in forestry circles associated with the EUTM proprietor’s company.
- The EUTM proprietor further submitted market surveys conducted in Germany and Poland in 2007 and in Croatia in 2013 by GfK Marktforschung, an independent market research organisation.

- The cancellation applicant contests the probative value of these surveys arguing that they do not show the reality of the market, with multiple producers using the same chromatic range of colours for identical goods.
- The Cancellation Division however disagrees with the cancellation applicant's allegation.
- As far as the reports of GfK Marktforschung are concerned, it must be emphasised that with the right questions, surveys by renowned, independent market research institutes can constitute valuable evidence for examining market acceptance, since demoscology does not involve arbitrary empiricism, but rather the use of scientific findings and because in principle such institutes guarantee that those questioned were representatively chosen and the surveys properly carried out, so that the opinion of the relevant public can be inferred from the findings of the representative survey (see, to this effect, decision of 11/01/2006, R 1/2005-4, Hilti-Koffer, § 32).
- The market surveys submitted for Germany and Poland were conducted in 2007 among a representative cross-section population amounting to approx. 3 000 persons in Germany and 4 000 persons in Poland.
- As for the German public, the reports display that 29% of all interviewees (general public over the age of 14) and 71% of those in the narrower section of the public (persons who have already purchased or at least used a chainsaw) were of the opinion that the 'orange/grey' colour combination in relation to chainsaws pointed to a specific company. In addition, 22% of all interviewees and 61% of those in the narrower section of the public identified the 'orange/grey' colour combination with the EUTM proprietor.
- The numbers concerning the Polish public are similar. Indeed, the reports indicate that 29% of all respondents and 58% of those in the closer section of the relevant public were of the opinion that the shown 'orange/grey' colour combination in conjunction with chainsaws is an indication of a specific company. Moreover, 23% of all interviewees and 47% of those in the closer relevant public identified the 'orange/grey' colour combination with the EUTM proprietor.
- These figures are confirmed and even increased by the survey undertaken by GfK Marktforschung in Croatia in 2013. The respective figures are 47% of all respondents and 77% of those in the closer relevant public were of the opinion that the shown 'orange/grey' colour combination in conjunction with petrol chainsaws is an indication of a specific company. Moreover, 41% of all interviewees and 69% of those in the closer relevant public associate the 'orange/grey' colour combination with the EUTM proprietor.
- These reports therefore demonstrate the extraordinarily high recognition and acceptance of the object of the mark among, in particular, the relevant specialist public in Germany and Poland in 2007 and in Croatia in 2013. Furthermore, the low difference between the percentage of knowledge as a trade mark and knowledge of the name of the producer shows that the majority of the relevant public not only recognises the colours and sees them as a trade mark, but also has a strong affinity to the producer.



- Such levels of acceptance have not come about abstractly, but are the result of many years’ presence on the market, a significant market share and considerable investment in advertising and marketing.
- The information provided by the EUTM proprietor regarding the market share, sales figures and advertising expenditure show that homogenous values were achieved in – at least – 17 EU Member States, whereby it is obvious that use cannot and will not be equally intensive in all the Member States of the Union.
- It follows that, taking into account the statements provided by public and private trade associations from seven Member States and the results of the surveys attesting levels of recognition of the mark among the vast majority of the specialised public interviewed in Germany, Poland and Croatia, it is quite acceptable and proper to infer analogous high levels of recognition of the mark with reasonably comparable sales, market shares and advertising expenditure in the other Member States.
- The same findings were achieved by the Office’s examiners and the Board of Appeal, in case R 355/2007-4, which held that the documentation provided by the EUTM proprietor – almost identical to evidence filed in the present proceedings – was sufficient to prove the acquired distinctiveness of the EUTM No 9 388 877 and International Registration No 872 542.
- In case R 355/2007-4, the EUTM proprietor furnished a further survey conducted in France showing figures slightly below the values for Germany but still showing a trade mark recognition for the majority of the target public. Following that, the Fourth Board held that *‘the results from the GfK surveys show acquired distinctiveness in Germany and also in France. They can be extrapolated to the other Member States of the Community under the proviso that the amount of use is comparable so that it can be expected that the same amount of use triggers the same consumer recognition’* (30/11/2009, R 355/2007-4, Orange & Grey, § 45).
- Therefore, the evidence filed by the EUTM proprietor on 19 December 2008 at the examination stage and re-submitted before the Cancellation Division on 25 November 2015 indicates that chainsaws in orange and grey had been extensively used in a significant proportion of the European Union. The additional evidence referring to the use of the mark in the period preceding the filing of the application for invalidity further confirms and reinforces this conclusion, since it proves that the EUTM had been constantly exposed to the relevant public over the years.
- As the submitted documents have to be considered as a whole, it can be reasonably concluded that the EUTM proprietor is both a market leader and recognised by the specialised public by reference to the registered colour combination, even when it is confronted with those products without the word mark ‘STIHL’.
- In light of the foregoing, the EUTM proprietor was successful in demonstrating that at the time of the filing date of the EUTM, it had acquired distinctiveness in the EU within the meaning of Article 7(3) EUTMR.

- Since it is recognised by the Cancellation Division that the EUTM has acquired distinctive character pursuant to Article 59(2) EUTMR, there is no need to examine the cancellation applicant's claim regarding Article 7(1) (d) EUTMR.

*Bad faith – Article 59(1)(b) EUTMR*

- The cancellation applicant points out that the EUTM proprietor had previously filed a EUTM application for a colour mark almost identical to the contested EUTM for goods in Class 7. As seen above, this application (EUTM No 338 194) was rejected since the mark was found to be non-distinctive pursuant to Article 7(1)(b) EUTMR.
- The cancellation applicant's case in relation to bad faith is essentially based on the claim that the contested EUTM was filed in spite of the fact that the EUTM proprietor knew that the combination of orange and grey was not distinctive and used by the majority of its competitors. Its sole intention, in the opinion of the cancellation applicant, was to monopolise such colour combination and prevent other companies from using colours that should be available to all the operators.
- Notwithstanding the cancellation applicant's arguments, the Cancellation Division is of the opinion that the facts and evidence furnished by the cancellation applicant are insufficient for a declaration of invalidity based on bad faith. The cancellation applicant has not proven that the EUTM proprietor, when filing the application for the contested EUTM, unfairly filed the application for the contested EUTM.
- In this context, it should be noted that it is legitimate for an undertaking to seek registration of a mark even if this mark was previously refused. The EUTM application No 338 194 was finally refused by the General Court. At that time no evidence of acquired distinctiveness was provided by the EUTM proprietor, which fairly waited for a few years to strengthen its business under the mark and, then, file a EUTM application that was supported by evidence of use.
- Moreover, claiming that the colours orange and grey were customary and other companies were already using them in connection with chainsaws does not automatically trigger a presumption of bad faith and, rather, constitutes a matter for absolute grounds pursuant to Article 59(1)(a) EUTMR, as the cancellation applicant indeed invoked. As far as bad faith is concerned, consideration must first be given to the intentions of the EUTM proprietor at the time when it filed the application, as a subjective factor which must be determined by reference to the objective circumstances of the particular case. Then, even assuming that the EUTM proprietor was aware of the existence of the other undertaking using the colours at issue, the cancellation applicant still has to prove the EUTM proprietor's specific unfair intentions.
- In this regard, as to the opposition proceedings filed by the EUTM proprietor against the cancellation applicant's Romanian application No M 2014 05856 on the basis of the contested EUTM, the Cancellation Division notes that after obtaining the registration of a trade mark, the EUTM proprietor's

intention to enforce its EUTM cannot, given the circumstances, be considered as proof of the unfair behaviour of the EUTM proprietor at the time of filing of the application for the contested EUTM.

- In conclusion, the cancellation applicant did not put forward evidence and facts containing sufficient indications about the alleged bad faith. As a consequence, the invalidity ground pursuant to Article 52(1)(b) EUTMR must be dismissed.

### *Conclusion*

- In the light of the above, the Cancellation Division concludes that the invalidity application is rejected.
- 10 On 26 January 2017, cancellation applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 28 March 2017.
  - 11 In its observations in reply received on 7 June 2017, the EUTM proprietor requests that the appeal be dismissed.

### **Submissions and arguments of the parties**

- 12 The cancellation applicant reiterates its arguments raised during the previous proceedings and adds in essence the following:

#### *Article 7(1)(a) EUTMR*

- As the Cancellation Division itself states, the mere representation of two or more colours, depicted in abstract and without specific contours, has to be systematically arranged by a predetermined and uniform colour association. Their mere juxtaposition not being enough to meet the precision and uniform standards which are required.
- Moreover, the explanations used to register a different trade mark cannot be used in order to justify and meet the requirements in relation to another application. In addition, the RAL codes of IR 872 542 are different from those of the EUTM registrations.

#### *Article 7(1)(b) EUTMR*

- The colour combination at stake does not meet the requirements for distinctiveness as it has been explained during the cancellation proceedings. The approach of the contested decision is contradictory and no analysis of the impact on Article 7(1)(d) EUTMR has been done.

*Article 7(3) EUTMR*

- Part of the evidence filed by the EUTM proprietor during the previous proceedings should not have been accepted since it does not fall within the relevant period.
- Proof of acquired distinctiveness cannot be made by the simple filing of sales volume and advertising material.
- The documents submitted concern the use of the challenged EUTM in conjunction with the element ‘STIHL’.

*Bad faith*

- The bad faith of the EUTM proprietor has been clearly established on the basis of the arguments and documents submitted during the previous proceedings. However, the contested decision rebuffed the cancellation applicant’s arguments without a minimal pertinent motivation and a relevant reasoning.
- The cancellation applicant has never infringed the EUTM proprietor’s rights.

## 13 The arguments raised in reply to the appeal may be summarised as follows:

- The arguments and allegations submitted in the statement of grounds are basically the same as those submitted during the previous proceedings, the EUTM proprietor refers to its former observations.
- The cancellation applicant misunderstands that the question of inherent distinctiveness is irrelevant in the present case since the EUTM has acquired distinctiveness through use.
- The contested decision does not rely on the IR 872 542 but only on the documents filed during the application proceedings of the contested EUTM. The contested decision clearly explains that the EUTM satisfied the requirement of Article 4 EUTMR.
- The contested EUTM is an abstract colour mark. The two rectangles merely serve the purpose of depicting the two shades of colour. Their shape and arrangement does not correspond to the way the colours are actually used.
- The Office correctly reviewed all the documentation submitted. The EUTM proprietor has filed a vast amount of documents in particular statements by independent organizations and market surveys to prove the acquired distinctiveness of its trade mark. Those documents indicate that the relevant public recognizes the EUTM proprietor’s colour trade mark irrespective of whether the sign ‘STIHL’ is present or not.
- The EUTM proprietor does not try to prevent registration and/or use of colours in the spectrum orange or grey as such but only instigates proceedings against colour combinations that are confusingly similar to the exact colours RAL 2010 and RAL 7035.

- It should be noted that the Appeal Court in Bucharest recently granted the EUTM proprietor’s law suit against the cancellation applicant and held that the cancellation applicant infringed, inter alia, the contested EUTM.

## **Reasons**

### *Preliminary remark on the applicable Regulations*

- 14 All references made in this decision should be seen as references to the EUTMR 2017/1001 (OJ L 154, 16.6.2017, p. 1), codifying EUTMR 207/2009 as amended, unless specifically stated otherwise in this decision.

### *Admissibility*

- 15 The appeal complies with Articles 66, 67 and 68(1) EUTMR. It is, therefore, admissible.

### *Article 59(1)(a) EUTMR in conjunction with Article 7(1)(a) EUTMR*

- 16 According to Article 7(1)(a) EUTMR, signs which do not conform to the requirements of Article 4 EUTMR shall not be registered.
- 17 The question to be decided is whether the mark has been graphically represented within the meaning of Article 4 and Article 7(1)(a) EUTMR. As regards the requirement that a sign be capable of being represented graphically within the meaning of Article 4 EUTMR, it is apparent from the case-law that that graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified. The fulfilment of the requirements laid down in Article 4 EUTMR enable the public to ascertain with certainty what the subject-matter of the trade mark is; to this end, the mark representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (12/12/2002, C-273/00, Methylcinnamat, EU:C:2002:748, § 46-55).
- 18 For the sake of clarity, the applicable Regulation in force at the time when the contested mark was filed on 19 December 2008—the applicable Regulation in these proceedings—namely Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark, provides the following formulation of Article 4 EUTMR:
- ‘[a] Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’
- 19 As follows from Article 7(3) EUTMR, which makes no reference to Article 7(1)(a) EUTMR, an acquired distinctiveness of a sign on account of its use is not suitable to override the requirements set by Article 4 EUTMR.

- 20 The entry of the mark in a public register has the aim of making it accessible to the competent authorities and the public, particularly to economic operators. On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of registration applications and to the publication and maintenance of an appropriate and precise register of trade marks. On the other hand, economic operators must, with clarity and precision, be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties. If the users of that register are to be able to determine the precise nature of a mark on the basis of its registration, its graphic representation in the register must be self-contained, easily accessible and intelligible. Finally, the object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. Consequently, the means of graphic representation must be unequivocal and objective (12/12/2002, C-273/00, *Methylcinnamat*, EU:C:2002:748, § 49-52, 54).
- 21 Whilst colour marks per se, and in particular combination of colours per se, are not specifically listed as signs which may constitute EU trade marks, Article 4 EUTMR does not exclude such marks to be registered since the list of signs is not exhaustive (12/12/2002, C-273/00, *Methylcinnamat*, EU:C:2002:748, § 44).
- 22 In the case of single colour marks per se a sample of the colour together with a verbal description of the colour and an internationally recognised code may constitute a proper graphic representation (06/05/2003, C-104/01, *Libertel*, EU:C:2003:244, § 36, 37).
- 23 It also follows from the *Libertel* decision that a description of a sign may be required to fulfil the requirements of Article 4 EUTMR. In fact, a necessary description forms integral part of the sign's graphical representation and thus also serves to define its scope of protection. Whilst the sign's description indeed may not be used to broaden the scope of protection of what may be derived from the sign's graphical representation itself ('what you see is what you get'), it may therefore be indispensable to be taken into account when defining the sign's subject matter.
- 24 In the present case, the contested EUTM consists of a combination of two colours per se. In order to be precise and durable as required by the case-law (12/12/2002, C-273/00, *Methylcinnamat*, EU:C:2002:748, § 49-52, 54), the following must be taken into consideration:
- '33 [...], a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way.
- 34 The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive, as construed in paragraphs 25 to 32 of this judgment.
- 35 Such representations would allow numerous different combinations, which

would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark' (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33-35).

- 25 As follows from this case-law, the Court of Justice set out a general principle for the interpretation of Article 4 EUTMR in any case of combinations of colours per se according to which two or more colours must be systematically arranged by associating the colours concerned in a predetermined and uniform way (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33). The contested EUTM must adhere to this general principle.
- 26 Next, the Court of Justice addressed two specific situations, namely, first, a mere juxtaposition of two or more colours, without shape or contours, and, second, a reference to two or more colours 'in every conceivable form' (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 34). These two situations concern the national trade mark application which was subject to the preliminary ruling proceedings and which contained the description to be used 'in every conceivable form' (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 10) and the actual question raised by the German Federal Patent Court which referred to trade marks claimed in the abstract and without contours (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 14). Whilst these two specific situations are useful in applying said general principle, possible refusals of registrations under Article 4 EUTMR are not confined to them. The reproduction of two colours on top of one another, as illustrated in the reproduction of the contested EUTM, constitutes a juxtaposition of colours as addressed by the Court of Justice.
- 27 It is clear that, in order to determine precisely the subject matter of the protection afforded by an EU trade mark consisting of a combination of colours per se, those colours must be represented in accordance with a specific arrangement or layout, associating the colours in a predetermined and uniform way, in order to prevent numerous different combinations of those colours which would not permit the consumer to perceive and recall a particular combination (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 35 and 30/11/2017, T-101/15 and T102/15, Blue and Silver (col.), EU:T:2017:852, § 55). That condition is consistent, first, with the need for the mark to be able to fulfil its function as an indication of origin by being perceivable and recognisable by consumers when applied to products, given that colours are normally a simple property of things and are generally used for their attractive or decorative powers, without conveying any meaning; second, with the requirement of legal certainty, in the sense that it allows the competent authorities and economic operators to know with clarity and precision the nature of the signs of which a mark consists and the rights of third parties; and, third, with the requirement that the availability of colours should not be unduly restricted in business practices by the creation of monopolies for a single undertaking (30/11/2017, T-101/15 and T102/15, Blue and Silver (col.), EU:T:2017:852, § 56).
- 28 In addition, Rule 3(3) CTMIR provides that the application for registration 'may contain a description of the mark'. If a description is included in the application for registration, it must be evaluated in combination with the graphic representation. A description of a sign may be required in order to fulfil the requirements of Article 4

EUTMR. That is notably the case where the systematic arrangement associating the colours in a predetermined and uniform way is not apparent from the graphic representation and the latter does not, therefore, enable the subject matter of the protection to be clearly defined. In the case at hand, an explicit description of the systematic arrangement associating the colours in a predetermined and uniform way is required (30/11/2017, T-101/15 and T102/15, Blue and Silver (col.), EU:T:2017:852, § 78-82).

- 29 In the present case, the graphic representation of the contested mark consists of the horizontal positioning of the two colours orange and grey, one on top of the other. This graphic representation is accompanied by a description which specifies that ‘the colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw’.
- 30 As follows from above, the graphical representation and description must be evaluated in combination in order to define the sign’s scope of protection. Apart from indicating two colours, the sign’s description is confined to indicating that one colour is applied to the top of the housing of the chainsaw and the other colour is applied to the bottom of the housing of the chainsaw. Evidently, the graphic representation of the contested mark consists of a mere image of two colours without shape or contours, allowing several different combinations of the two colours. The only exception to this being that the colour orange is always applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw. The description which accompanies the graphic representation of the contested mark does not provide any additional precision with regard to the systematic arrangement associating the colours in a predetermined and uniform way and precluding a number of different combinations of those colours. The positioning of the two colours so that the colour orange is always applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw can take different forms, giving rise to different images or layouts.
- 31 The Board notes that the contested decision seems to have taken further documentation into account when evaluating whether Article 7(1)(a) EUTMR applies to this case. The contested decision stated that:

‘In the observations attached to the application form submitted at the moment of the filing of the EUTM, the EUTM proprietor showed the arrangement of those colours, making also reference to the International Registration No 872 542 of 4 November 2005, designating the EU for the sign below:



It appears from the above that the graphic representation and the verbal description of the sign are perfectly compatible and complementary.’

The contested decision further noted that:

‘The verbal description specifying that ‘the colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of



the housing of the chainsaw’, together with the attached colour scheme representation and other elements furnished at the moment of the EUTM filing, enables a systematic arrangement to be identified in which colours are used in a predetermined and uniform way.’

- 32 On this point the Board fully agrees with the cancellation applicant that references to images of another mark cannot be used in order to justify that the application meets the requirements of Article 7(1)(a) and to come to the conclusion that the graphic representation and the verbal description of the sign are perfectly compatible and complementary. Any such references, explanations or ‘other elements furnished at the moment of the EUTM filing’ cannot be seen to constitute a part of the representation of the mark. They do not form a part of the information that can be seen in the publication of the mark in the register and are only accessible to third parties if they study the complete file. Therefore, if such elements are seen to form a part of the representation of the mark, such a representation does not fulfil the requirement that the mark’s representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective in order to justify the mark’s compliance with the requirements of Article 7(a) EUTMR.
- 33 The Board further notes that even if such further elements were acceptable and should be taken into account, in the case at hand they actually make the written description provided with the application at hand ambiguous. This is because it is not clear what exactly is meant by referring to the ‘top of the housing of the chainsaw’ and, on the other hand, the ‘bottom of the housing of the chainsaw’. When studying the chainsaw which can be seen in the EUTM proprietor’s earlier International Registration No 872 542



it can be argued that, first of all, the chainsaw actually has at least two, perhaps even three (as the other side cannot be seen in the image), separate pieces of housing. Further, while the top part of the piece of housing on the top of the product is clearly orange, the bottom part cannot be seen at all, as it is hidden under the chainsaw. The sides of the piece of housing on top of the chainsaw are also orange, but the side of the separate piece of housing on the side of the product is grey.

- 34 In addition, while the graphic representation of the contested mark as registered consists of the horizontal positioning of the two colours orange and grey, in what seems to be a ratio of 50:50 in the image of the EUTM proprietor’s earlier International Registration No 872 542 it can be seen that, even from a side view, the colour orange spreads to the left of the grey colour and is therefore not completely on top of the other colour and the ratio of the colours is certainly not 50:50, even though the graphic representation of the contested mark seems to indicate that this would be the case. Therefore, even if it were accepted that the indications ‘top of the housing of the chainsaw’ and, on the other hand, the ‘bottom of the housing of the chainsaw’ actually refer to the fact that one piece of housing is situated somewhat higher up than the ones on the sides, it is clear that the graphic representation of the contested mark as registered does not correspond

to what ‘the applicant’ has wanted to apply for, if what it has wanted to try and explain in the description corresponds to what has been registered in the EUTM proprietor’s earlier international registration No 872 542.

- 35 On the other hand, given the scope of protection which the choice of a combination of colours per se as a category of mark encompasses, if the subject matter was to be restricted only to the sign’s reproduction (i.e. the image filed), such interpretation would qualify the sign as a figurative mark, namely a coloured rectangular shape with grey on top and orange on the bottom. However, a sign may not be re-categorized following its registration (12/11/2013, T-245/12, Green stripes on a pin, EU:T:2013:588, § 32-39) and even the EUTM proprietor itself states that the contested EUTM is an abstract colour mark; the two rectangles merely serve the purpose of depicting the two shades of colour; their shape and arrangement do not correspond to the way the colours are actually used and the way in which the colours are arranged on the product is defined by the additional verbal description contained in the registration.
- 36 Taking all of the above into account, as it is not clear exactly what is meant by the ‘top of the housing of the chainsaw’ and, on the other hand, the ‘bottom of the housing of the chainsaw’, the description of the mark is in itself not clear, precise, self-contained, easily accessible, intelligible, or objective. Further, as there exist numerous different shapes of chainsaws on the market, it is not clear what the scope of protection of the mark actually would be.
- 37 Therefore, the Board comes to the conclusion that, first of all, the graphic representation of the contested mark consists of the horizontal positioning of the two colours orange and grey, one on top of the other, without shape or contours, which allows for several different combinations of the two colours (by analogy, 30/11/2017, T-101/15 and T102/15, Blue and Silver (col.), EU:T:2017:852, § 59). Secondly, the description which accompanies the graphic representation of contested mark does not provide sufficient additional precision with regard to the systematic arrangement associating the colours in a predetermined and uniform way and precluding a number of different combinations of these colours (by analogy, 30/11/2017, T-101/15 and T102/15, Blue and Silver (col.), EU:T:2017:852, § 60 and the case-law therein cited). It is sufficient for the proprietor of the mark to file a graphic representation of the mark corresponding precisely to the subject matter of the protection he wishes to secure. The proprietor may not, however, file a graphic representation while at the same time claiming a broader protection than that afforded by that representation or which does not correspond to it, in direct contradiction of the rule that ‘what you see is what you get’ (30/11/2017, T-101/15 and T102/15, Blue and Silver (col.), EU:T:2017:852, § 71).
- 38 It is true that the combination of colours per se may function as a sign within the meaning of Article 4 EUTMR. On the one hand, the requirements for the graphical representation under Article 4 EUTMR may not be so stringent as to deprive a combination of colours, per se, the abstract nature of this category of sign. On the other hand, a sign has to be clear, precise, self-contained, easily accessible, intelligible, durable and objective, as required by the case-law (12/12/2002, C-273/00, Methylcinnamat, EU:C:2002:748), which has to be individually determined for each category of marks.

- 39 As confirmed by the Court in 30/11/2017, T-101/15 and T102/15, Blue and Silver (col.), EU:T:2017:852, § 96, it follows from the nature of a mark consisting of a combination of colours per se, without contours or shape, that, in order for the precise subject matter of its protection to be clear and perceivable by consumers and economic operators and for it to thus fulfil its essential function of indicating origin while not conferring disproportionate competitive advantages, its graphic representation or the accompanying description must show the precise shades of the colours in question, the ratios and their spatial arrangement. That degree of precision is required because of the intrinsically less precise nature of colour marks per se, which distinguishes such marks from other types of trade mark. In the present case, however, the contested EUTM is not sufficiently precise and it was registered contrary to the provision of Article 7(1)(a) EUTMR.
- 40 In conclusion the appeal is upheld, the contested decision is annulled and the contested trade mark must be declared invalid on the basis of Article 59(1) (a) EUTMR in conjunction with Article 7(1)(a) EUTMR. Therefore there is also no need to further examine the other grounds invoked by the cancellation applicant.

### **Costs**

- 41 Pursuant to Article 109(1) EUTMR, the EUTM proprietor, as the losing party, must bear the costs of the appeal proceedings. Pursuant to Article 109(7) EUTMR, the EUTM proprietor is therefore ordered to reimburse the appeal fee which is fixed at EUR 720 as well as the costs of professional representation for the appeal proceedings at the level laid down in Rule 94(7) (d) EUTMIR (EUR 550). As the decision of the Cancellation Division has been annulled and the result is that the cancellation applicant succeeds on all heads, the Board must also fix the costs of the invalidity proceedings. These are fixed at EUR 700 in respect of the fee for the application for a declaration of invalidity and EUR 450 in respect of the cancellation applicant's representation costs. The total amount is EUR 2 420.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Upholds the appeal and annuls the contested decision;**
- 2. Declares the EUTM No 7 472 723 invalid;**
- 3. Orders the EUTM proprietor to bear the total amount of EUR 2 420 for the cancellation applicant's overall costs in the invalidity and appeal proceedings.**

Signed

S. Stürmann

Signed

H. Salmi

Signed

C. Negro

Registrar:

Signed

H. Dijkema

