

Glaxo Wellcome UK Ltd (t

Case No: HC-2015-005005

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
INTELLECTUAL PROPERTY

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL
28/06/2016

Before:

HIS HONOUR JUDGE HACON
(SITTING AS A JUDGE OF THE HIGH COURT)

Between:

GLAXO WELLCOME UK LIMITED (t/a ALLEN & HANBURY'S) GLAXO GROUP LIMITED	Claimants
- and -	
SANDOZ LIMITED	Defendant

Daniel Alexander QC and Simon Malynicz QC (instructed by Stephenson Harwood LLP) for the
Second Claimant

Martin Howe QC and Iona Berkeley (instructed by White & Case LLP) for the Defendant
Hearing date: 15 June 2016

HTML VERSION OF JUDGMENT

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Judge Hacon :

Introduction

1. This is an application by the defendant ("Sandoz") for summary judgment in its counterclaim for a declaration that EU Trade Mark No. 3890126 ("the Trade Mark") is invalid. The Trade Mark is owned by the second claimant ("Glaxo"). By extension the application also seeks summary judgment dismissing Glaxo's claim against Sandoz for infringement of the Trade Mark.
2. The ground of invalidity relied on is that the Trade Mark does not conform to the requirements of art.4 of Council Regulation (EC) 207/2009 ("the Trade Mark Regulation") in that it is neither a sign nor capable of being represented graphically, within the meaning of that article.
3. Sandoz seek to invalidate the Trade Mark on further grounds; Glaxo have also brought a claim for passing off against Sandoz. These form no part of the present application.

The Trade Mark

4. The Trade Mark is registered in respect of 'Inhalors' (sic) in Class 10. The visual representation of the mark is this:



5. The description of the Trade Mark in English is:

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

6. The certificate of registration designates the Trade Mark with the INID code number '558'. 'INID' is the acronym for 'Internationally agreed Numbers for the Identification of (bibliographic) Data'. It is part of a coding system developed by the World Intellectual Property Office ("WIPO"). I was shown extracts from WIPO's Handbook on Industrial Property Information and Documentation which reveal that INID code 558 is one of the codes that provides a description of the elements of the mark. 558 means:

"Mark consisting exclusively of one or several colors"

It was common ground that this was the meaning of code 558 at the time the Trade Mark was registered, and indeed it still is.

The arguments in summary

7. Martin Howe QC who, with Iona Berkeley, appeared for Sandoz, pointed out that this was clearly not a figurative mark, so guidance as to what was claimed came from the description. The description showed that the Trade Mark registered was not a single sign but a collection of an

almost limitless number of signs. Each of the signs had to consist of dark and light purple sections, of the correct Pantone shades, and dark purple has to be applied to a significant proportion of the inhaler. Otherwise there was complete freedom. The sign could be overwhelmingly dark or light purple or anything in between. The light purple section did not even have to be a significant part of the inhaler. Furthermore, there could be any kind of pattern created by shapes of dark purple on a light purple background (or vice versa) – stripes, dots, stars, or anything else.

8. Mr Howe referred me to authority, to which I will return, and submitted that in consequence of the wide variety of signs encompassed by the Trade Mark as registered, the Trade Mark was neither a sign nor capable of being represented graphically. The registration was therefore invalid.
9. Daniel Alexander QC who, with Simon Malynicz QC represented Glaxo, accepted that if Mr Howe was right about the interpretation of the Trade Mark, it was invalidly registered. But, Mr Alexander submitted, Mr Howe had wrongly construed the registration. He said that the visual representation of the Trade Mark was the starting point. It was apparent from the registration that this was not a figurative mark, so plainly the sign being claimed was an abstraction of that visual representation. The abstraction looks like this:

It comes from the written submissions on behalf of Glaxo in litigation involving the Trade Mark in a number of EU countries and before the EU Intellectual Property Office ("EUIPO"). A witness statement of Dr Anke Nordemann-Schiffel, partner in the Berlin law firm Boehmert & Boehmert, reproduced sections of these written submissions. (I asked why so many related actions were running in parallel given the provisions of art.104 of the Trade Mark Regulation. I was told that the matter has been given consideration in the High Court of Ireland at least, where it was concluded that there are 'special grounds' within the meaning of that article: see *Glaxo Group Ltd v Rowex Ltd* [2015] IEHC 368, Barrett J).

10. Mr Alexander's point in summary was that on a correct interpretation of the registration, a single sign had been validly registered. By way of an alternative argument, to the extent that it might be said that the Trade Mark encompassed more than one sign, the variants within the registration formed a much narrower group than suggested by Mr Howe. These were variants of a single sign and such variants were permitted as a matter of EU trade mark law.

The approach to an application for summary judgment

11. Mr Alexander's skeleton referred me to the well-known passage in the judgment of Lewison J (as he then was) in *Easyair Ltd v Opal Telecom Ltd* [2009] EWHC 339(Ch) at [15] summarising the correct approach to an application for summary judgment. As Lewison J stated in that summary, where the application gives rise to a short point of law or construction and the court has all the evidence necessary and the benefit of all argument required for a proper determination of the question, the court should grasp the nettle and decide it. In some instances it may be appropriate to resolve an issue of law or construction which is not so short, provided that its resolution did not depend on evidence to be given at trial, see *Nampak Plastics Europe Ltd v Alpla UK Ltd* [2014] EWCA Civ 1293; [2015] F.S.R. 11. Neither Mr Howe nor Mr Alexander contended that there was any issue of fact in contention which prevented my deciding both applications now.

The Regulations

The Trade Mark Regulation

12. Regulation (EU) No. 2015/2424 of the European Parliament and of the Council, now in force, sets out a number of amendments to the Trade Mark Regulation. The substantive amendments to art.4 will not apply until 1 October 2017 – see art.4 of Regulation 2015/2424.
13. The absolute grounds of invalidity of an EU trade mark are set out in art.52 as amended, of which the relevant part is this:

Absolute grounds for invalidity

1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where the EU trade mark has been registered contrary to the provisions of Article 7; ...

14. Art.7 provides in relevant part:

Absolute grounds for refusal

1. The following shall not be registered:

(a) signs which do not conform to the requirements of Article 4; ...

15. Art.4 provides:

Signs of which an EU trade mark may consist

An EU 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.

16. Leaving aside the substitution of 'EU trade mark' for 'Community trade mark', art.4 is identical to art.2 of Directive 2008/95/EC ("the Trade Mark Directive"). I mention this because the discussion of the law in the cases considered below frequently concerns the Trade Mark Directive rather than the Regulation, so there is reference to art.2 rather than art.4.

17. Art.4 of the Regulation and art.2 of the Directive both require, among other things, that for a sign to qualify as a trade mark it must be "capable of being represented graphically". All trade mark applications and registrations contain a representation of the mark. However, just because there is such an image it does not follow that the sign must therefore be capable of being represented graphically. For that reason and to avoid confusion, I will refer to the image in a trade mark application or registration as the 'visual representation', not the graphic representation.

The Implementing Regulation

18. Commission Regulation (EC) No. 2868/95, now as amended by Regulation 2015/2424, sets out the rules necessary for implementing the Trade Mark Regulation. I set out the amended version. The version in force when Cadbury applied for the Trade Mark was the same except 'EU Trade Marks' were 'Community Trade Marks'. Rule 1 includes this:

Rule 1: Content of the application

(1) The application for an EU trade mark shall contain:

...

(d) a representation of the mark in accordance with Rule 3;

19. Rule 3 paragraph 1 sets out requirements of the application where there is no wish to claim any special graphic feature or colour. Paragraph 2 deals with all other types of application, including

applications for marks which are registered in colour rather than monochrome. Paragraph 3 says:

Rule 3: Representation of the mark

...

(3) In cases to which paragraph 2 applies, the application shall contain an indication to that effect. The application may contain a description of the mark.

20. Paragraph 5 deals specifically with applications for marks, including figurative marks, to be registered in colour:

(5) Where registration in colour is applied for, the application shall contain an indication to that effect. The colours making up the mark shall also be indicated. The reproduction under paragraph 2 shall consist of the colour reproduction of the mark.

The case law

21. The most relevant judgment of the Court of Justice is Case C-49/02 *Heidelberger Bauchemie GmbH* [2004] E.C.R. I-6152. Heidelberger Bauchemie had applied to the German Patent and Trade Mark Office to register the colours blue and yellow as a trade mark. The section headed 'reproduction of the mark' comprised a rectangular piece of paper, the upper part of which was blue and the lower half yellow. The description of the mark was (candidly):

"The trade mark applied for consists of the applicant's corporate colours which are used in every conceivable form, in particular on packaging and labels."

Registration was applied for in relation to various products used in the building trade, including adhesives, solvents and paints. The application was rejected by the German Office. There was an appeal to the *Bundespatentgericht* which made a reference to the ECJ.

22. The ECJ began by considering whether it was possible for a combination of colours to be registered as a trade mark. The answer was yes, subject to three conditions which had been established in Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] E.C.R. I-3793:

"[21] It should therefore be established whether Article 2 of the Directive can be interpreted as meaning that 'combinations of colours' are capable of constituting a trade mark.

[22] To constitute a trade mark under Article 2 of the Directive, 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 (see, to that effect, *Libertel*, paragraph 23).

[23] As the Court has already held, colours are normally a simple property of things (*Libertel*, paragraph 27). Even in the particular field of trade,

colours and combinations of colours are generally used for their attractive or decorative powers, and do not convey any meaning. However, it is possible that colours or combinations of colours may be capable, when used in relation to a product or a service, of being a sign.

[24] For the purposes of the application of Article 2 of the Directive, it is necessary to establish that in the context in which they are used colours or combinations of colours which it is sought to register in fact represent a sign. The purpose of that requirement is in particular to prevent the abuse of trademark law in order to obtain an unfair competitive advantage.

[25] Moreover, it is clear from the Court's case-law (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraphs 46 to 55, and *Libertel*, paragraphs 28 and 29) that a graphic representation in terms of Article 2 of the Directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified."

The requirement that there should be a graphic representation, which allowed the mark to be precisely identified, was underlined:

"[27] 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.

[28] The entry of the mark in a public register has the aim of making it accessible to the competent authorities and to the public, particularly to economic operators.

[29] 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 applications for registration and the publication and maintenance of an appropriate and precise register of trade marks.

[30] On the other hand, economic operators must be 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.

[31] In those circumstances, in order to fulfil its role as a registered trade mark, a sign must always be perceived unambiguously and uniformly, so that the function of mark as an indication of origin is guaranteed. In the light of the duration of a mark's registration and the fact that, as the Directive provides, it can be renewed for varying periods, the representation must also be durable.

[32] It follows from the above that a graphic representation for the purpose of Article 2 of the Directive must be, in particular, precise and durable.

[33] Accordingly, 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."

23. The ECJ then turned to the registration sought by Heidelberger Bauchemie and whether it conformed to the requirements that a trade mark must be precise, unambiguous and uniform in order to satisfy art.2 of the Trade Mark Directive. It did not:

"[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. The Court went on to indicate that if a sign did exhibit the qualities of precision and uniformity required by art.2, colours or combinations of colours may be capable of serving as a badge of origin and thus may satisfy this separate requirement of art.2 (not in issue here), see [37] to [40], concluding:

"[40] Subject to the above, it must be accepted that for the purposes of Art.2 of the Directive colours and combinations of colours, designated in the abstract and without contours, may be capable of distinguishing the goods or services of one undertaking from those of other undertakings."

25. *Heidelberger Bauchemie*, along with other cases, was considered by the Court of Appeal in *Société des Produits Nestlé SA v Cadbury UK Ltd* [2013] EWCA Civ 1174; [2014] RPC 7.

26. Cadbury applied for a trade mark in respect of chocolate in various forms in Class 30. The representation of the sign in the application was a rectangular purple block:

27. The description was:

"The colour purple (Pantone 2685C), as shown on the form of the application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods."

28. The application was opposed by Nestlé in the UK Intellectual Property Office. The hearing officer dismissed the opposition but narrowed the specification of goods. On an appeal to the High Court, the evidence that the colour had become distinctive of Cadbury's goods was left unchallenged. The argument turned on whether the mark applied for was registerable as a matter of law on various grounds, including whether (i) it was a 'sign' and (ii) it satisfied the relevant criteria for graphical representation, within the meaning of art.2 of the Trade Mark

Directive. The appeal was dismissed. Before the Court of Appeal the argument narrowed further, to the two issues just mentioned.

29. Sir John Mummery reviewed the judgments of ECJ in *Libertel*, Case C-273/00 *Sieckmann v Deutsche Patent und Markenamt* [2002] E.C.R. I-11754, *Heidelberger Bauchemie* and Case C-321/03 *Dyson v Registrar of Trade Marks* [2007] ECR I-687. He set out a number of principles to be derived from those cases:

"[15] Some general points relating to the requirements of art.2 of the directive, which are relevant to this case, can be picked out of the judgments:

The conditions

(1) An application to register a trade mark must satisfy three conditions for the purposes of Article 2:

- (i) there must be a sign;
- (ii) it must be capable of graphical representation;
- (iii) it must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Purpose

(2) The purpose of the requirements is to prevent abuse of trade mark law in order to obtain an unfair competitive advantage.

Identification

(3) Identification requirements for entry of a trade mark on the public register of trade marks include clarity, intelligibility, specificity, precision, accessibility, uniformity, self-containment and objectivity.

Multitude of forms

(4) The identification requirements are not satisfied, if the mark could take on a multitude of different appearances, which would create problems for registration of the mark and give an unfair competitive advantage over competitors.

Colour without a message

(5) Colours are normally a simple property of things, or a means of decorating things. They are not normally capable of being a sign. A sign conveys a message. The sign is capable of being registered as a trade mark, if the message is about the source of goods or services.

Colour as a sign conveying a message

(6) Depending on the facts and circumstances of the case, colours, or combinations of colours, designated in the abstract and without contours and used in relation to a product or service are capable of being 'a sign'.

Graphic representation of colour

(7) As for the second condition of graphical representation, in a mark consisting of two or more colours designated in the abstract and without contours, qualities of precision and uniformity are required. The colours must be arranged by associating them in a predetermined and uniform way.

Colour without form/in a multitude of forms

(8) Those requirements are not met by the mere juxtaposition of colours without shape or contours, or by reference to colours in every conceivable form, so that the consumer would not be able to recall or repeat with certainty the experience of a purchase. The scope of protection afforded by such a mark would be unknown both to the competent authorities responsible for maintaining the register and to economic competitors. Registration would confer unfair competitive advantages on the proprietor of the mark."

30. Sir John took the view that the appeal turned on the correct interpretation of the word 'predominant' as used in the description of the mark applied for. A predominant part of the mark had to be purple, but the rest could be anything. The range of possibilities this opened up had the consequence that the mark was neither a 'sign' nor capable of being 'graphically represented':

"[49] At the end of all the argument below and in this court the outcome of the appeal turns on quite a narrow point on which the hearing officer and the judge erred in principle.

[50] The crucial point stems from the misinterpretation of the verbal description of the graphic representation of the mark for which application is made. The description refers not only to the colour purple as applied to the whole visible surface of the packaging of the goods, but also to an alternative i.e. 'or being the predominant colour applied to the whole visible surface ... '. The use of the word 'predominant' opens the door to a multitude of different visual forms as a result of its implied reference to other colours and other visual material not displayed or described in the application and over which the colour purple may predominate. It is an application for the registration of a shade of colour 'plus' other material, not of just of an unchanging application of a single colour, as in *Libertel*.

[51] In my judgment, that description, properly interpreted, does not constitute 'a sign' that is 'graphically represented' within art.2. If the colour purple is less than total, as would be the case if the colour is only 'predominant', the application would cover other matter in combination with the colour, but not graphically represented or verbally described in the specific, certain, self-contained and precise manner required. The result would not be an application to register 'a sign', in the accepted sense of a single sign conveying a message, but to register multiple signs with

different permutations, presentations and appearances, which are neither graphically represented nor described with any certainty or precision, or at all.

[52] The appearance and number of such other signs would be unknown both to the registrar, who is responsible for the proper functioning of the registration system and is faced with the decision whether or not to register it on a public register, and to competitors, who would not be able to tell from inspecting the register the full scope and extent of the registration. To allow a registration so lacking in specificity, clarity and precision of visual appearance would offend against the principle of certainty. It would also offend against the principle of fairness by giving a competitive advantage to Cadbury and by putting Nestlé and its other competitors at a disadvantage."

31. Sir Timothy Lloyd agreed with Sir John Mummery and added further concerns generated by use of the word 'predominant':

"[62] As this case shows, there are considerable potential problems in seeking to show that a pure colour mark is properly registrable. The tests referred to in [68] of the *Libertel* judgment are aimed, among other things, at ensuring that both registration authorities and actual or potential competitors know the scope of the mark which is applied for or has been registered. Such persons must be able to tell not only whether a given mark is within the scope of the registration applied for or effected, but also whether it is *not* within that scope.

[63] Cadbury's formulation, with its use of the words 'or being the predominant colour applied to the whole visible surface, of the packaging of the goods' seems to me to fall far short of satisfying these tests. What is meant by 'predominant' in this context? Miss Himsworth's primary contention was that a colour was predominant, in this context, if it covered more than 50% of the surface area in question. If this is right, and if that is what was intended, then it might be possible to achieve certainty by spelling that out in the registration application. It could have read: 'applied to the whole visible surface, or to more than 50% of the area of the visible surface, of the packaging of the goods'. But it is not difficult to imagine other tests which might be applied to determine predominance in respect of colour. If the contrast is between two different colours, one which is stronger or more eye-catching, or is applied to a more prominent part of the packaging, might be seen as predominant even if it was applied to a smaller area than another colour (including white). The evidence for Cadbury, to which Sir John Mummery has referred at [17] above, shows that Cadbury itself regarded other factors than the measured surface area as being relevant. In my judgment the use of the word 'predominant' in this context, makes the description of the mark too subjective, too imprecise, and inadequately clear and intelligible, to be capable of registration."

Lewison LJ agreed with both Sir John Mummery and Sir Timothy Lloyd.

32. The appeal in *Cadbury* was heard at the same time as the appeal in *JW Spear & Sons Ltd v Zynga Inc* [2013] EWCA Civ 1175; [2014] E.T.M.R. 5. The judgment of Arnold J at first instance was upheld in which Zynga successfully counterclaimed to revoke Mattel's UK registered trade mark. The mark consisted of an ivory-coloured scrabble tile having, on its top surface, any letter of the alphabet or any numeral from 1 to 10. Applying reasoning similar to that in the *Cadbury* appeal, the Court ruled that the tile mark was neither a sign nor capable of being graphically represented.
33. The Court of Appeal declined Cadbury's invitation to make a reference to the CJEU. Later the Supreme Court refused Cadbury permission to appeal further, indicating that in the view of their Lordships the result in the case was not dependent on any arguable point of law which required a reference to the CJEU.
34. Case R 2037/2013-1 *Red Bull GmbH v Optimum Mark Sp. z.o.o.* is a decision of the Board of Appeal of the Office for Harmonization in the Internal Market (OHIM), now the European Union Intellectual Property Office (EUIPO). It was the only authority to which I was directed in which the interplay between the visual representation of a mark and the description of the mark has been expressly discussed.
35. Red Bull sought to register a colour mark for energy drinks in Class 32. This was the visual representation:

The description of the mark read:

"Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%"

The Board of Appeal considered *Libertel*, *Sieckmann* and *Heidelberger Bauchemie* and commented on the role of the description of a sign in a trade mark application:

"[43] It also follows from the *Libertel* decision that a description of a sign may be required to fulfil the requirements of Article 4 CTMR, contrary to the CTM proprietor's argument that a description is not obligatory pursuant to Rule 3(3) CTMIR [the Implementing Regulation]. 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."

36. This paragraph is not completely clear. On the one hand the description (likely to be essential in the case of a colour mark in order to comply with art.4 of the Trade Mark Regulation) forms an integral part of the sign's visual representation and serves to define its scope of protection. On the other hand, the description may *not* be used to broaden the scope of protection as derived from the visual representation itself. The latter assertion suggests that the description must be kept in its place.
37. On the facts of the case the Board of Appeal was in no doubt that the mark applied for could take a wide variety of forms and therefore did not satisfy the requirement of precision imposed by art.4 as stated in *Libertel* and *Heidelberger Bauchemie*. In this part of the Decision the Board said that the visual representation and description are to be taken together, without implying any precedence:

"[48] ... 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 a certain ratio of them. Evidently, the mere indication of such a ratio allows for the arrangement of the two colours in numerous different combinations, thus not in a predetermined and uniform way. Depending on the arrangement of colours on different parts of 'energy drinks' or other objects related thereto, the overall impression of two colours arranged in numerous manners may be very distinct. The cancellation applicant has given various examples of possible arrangements which would fit the sign's description. The average consumer could thus not repeat with certainty the experience of a purchase. This applies in particular for the category of marks at hand since colours possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message [ref to *Liberte*]."

38. The Board rejected an argument advanced by Red Bull, apparently styled as a 'what you see is what you get' argument, in which Red Bull contended that the visual representation served to limit the freedom of variation in the form the mark could take, a freedom which otherwise would have been permitted within the terms of the description:

"[50] The CTM proprietor argues that the reproduction of the sign defines the mark as consisting of the colour blue depicted on the left and the colour silver on the right hand side, ('what you see is what you get'), and therefore limits possible arrangements to a degree which renders the signs sufficiently precise. However, as follows from above, in the case of a combination of colours *per se*, the description of the sign forms an integral part of the sign. Given the scope of protection which the choice of this category of mark encompasses, an explicit description to this effect would have been required in the present case. Furthermore, if the subject matter was to be restricted 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 blue on the left and silver on the right hand side. However, a sign may not be re-categorized following its registration [ref to authority]." [ogw: det menes med dette "søknadsdato" !]

Questions of principle arising in this case

39. Two questions of principle arise. The first is how a trade mark application or registration should be construed where there is no strict congruence between the visual representation and the description, particularly in the context of a trade mark consisting exclusively of one or several colours. (These are sometimes referred to as 'colour *per se*' marks. For reasons of brevity I will refer them as 'colour marks'.)
40. The second question is whether a colour mark may encompass more than one form – whether there can be variants, as proposed by Mr Alexander, without contravening art.4 of the Trade Mark Regulation. If so, how much freedom of variation is possible?

Interpreting a colour mark

41. I asked counsel through whose eyes a trade mark application or registration should be interpreted. Mr Howe suggested that it was purely a matter for the court. Mr Alexander submitted that the court should consider the issue through the eyes of the average consumer.
42. I think Mr Howe is right. Some trade mark specifications are broad and liable to require different average consumers when it comes to assessing such matters as the likelihood of confusion under art.9(2)(b) of the Trade Mark Regulation (as amended), depending on the goods or services in question. There can only be one correct interpretation of a trade mark registration or application. Therefore I believe that it must always be a matter for the court without reference to the average consumer. That said, in the present case I think it makes no difference.
43. I take the view that there is no automatic precedence as between the visual representation and the description. If an application or registration is designated with INID code 558, that provides an inflexible starting point: the mark must be construed as consisting exclusively of one or several colours. Thereafter the court must do its best to reconcile the visual representation and the description if there is no strict congruence between them.

Whether a sign may include variants

44. Notwithstanding the wording of art.4 of the Regulation, which states that an EU trade mark may consist of any signs (plural), it is clear from the judgments of the CJEU that in order to satisfy art.4 a colour mark must be a sign (singular), see *Libertel* at [23]. Glaxo did not submit otherwise.
45. However, Mr Alexander relied on two authorities for the proposition that a sign need not be delimited with absolute precision in an application or registration and that therefore there was possible variation in the form that the sign could take.
46. The first was paragraph [40] of *Heidelberger Bauchemie* (quoted above). I can see nothing in that paragraph in support of the proposition. As I read it, the ECJ was merely making the general point that it was possible for a colour mark, whether for a single colour or a combination of colours, to be capable of distinguishing the goods or services of one undertaking from those of another, and thus to satisfy that requirement of art.2 of the Directive.
47. The second authority was Case C-421/13 *Apple Inc v Deutsches Patent- und Markenamt* EU:C:2014:2070. Apple's application was for a three-dimensional trade mark for specified retail store services in Class 35. The description was "the distinctive design and layout of a retail store". This was the visual representation (in metallic grey and light brown):
48. The application was refused and there was an appeal to the *Bundespatentgericht* which referred a number of questions to the CJEU. These included whether the requirement that the mark must consist of a sign capable of graphic representation was satisfied by the visual representation above, or whether it also required additions such as a description of the layout, or indications of the absolute dimensions in metres, or of relative dimensions with indications as to proportions.
49. In paragraph 17 of its judgment the CJEU repeated the three basic requirements imposed by art.2 of the Trade Mark Directive set out in *Libertel* at [23] and repeated in *Heidelberger Bauchemie* at [22] (see above). It went on:

"[18] It is absolutely plain from the wording of Article 2 of Directive 2008/95 that designs are among the categories of signs capable of graphic representation.

[19] It follows that a representation, such as that at issue in the main proceedings, which depicts the layout of a retail store by means of an

integral collection of lines, curves and shapes, may constitute a trade mark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings. Consequently, such a representation satisfies the first and second conditions referred to at paragraph 17 of this judgment, without it being necessary either, on the one hand, to attribute any relevance to the fact that the design does not contain any indication as to the size and proportions of the retail store that it depicts, or, on the other hand, to examine whether such a design could equally, as a 'presentation of the establishment in which a service is provided', be treated in the same way as 'packaging' within the meaning of Article 2 of Directive 2008/95."

50. Mr Alexander submitted that the Court of Justice here held that in the absence of specific dimensions or defined proportions, the sign was to be interpreted as including variations: the tables could be taller or wider, the windows could be deeper, or more shallow, etc. Variations on a single sign were thus permitted.
51. Mr Howe argued that the CJEU had neither been asked nor decided anything with regard to the permissibility variations of sign. All the Court had been asked was whether this particular three-dimensional mark was both a sign and capable of being graphically represented without the addition of specified dimensions, proportions or the like. It was, and that was it. I agree with Mr Howe. I can see no support in *Apple* for the idea that a trade mark may consists of variations on a single sign.
52. Among the requirements imposed by art.4 of the Trade Mark Regulation and art.2 of the Trade Mark Directive is that in order to consist of an EU Trade Mark a sign must be clear, precise, unambiguous and uniform, see *Heidelberger Bauchemie* at [30]-[31]. No doubt it is always possible to say that within this narrow ambit very minor variations could exist. If so, they will be insignificant and go unnoticed by the average consumer.
53. In an action for infringement of an EU Trade Mark pursuant to art.9(2)(a) of the Trade Mark Regulation as amended, one of the criteria for infringement is that the defendant's sign is identical to the Mark. The ECJ has held that this is only the case if it

"reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

See Case 291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] E.C.R. I-02799, concerning a device mark, at [54].

54. In *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, Jacob LJ expressed the view (at [25]) that this guidance from the ECJ was opaque since it both indicated a strict interpretation of identity of mark and sign and yet elsewhere (at [52]) the Court of Justice had allowed for the imperfect recollection of the mark by the average consumer. Opacity aside, Glaxo's concept of variations on a single sign would make matters worse. To my mind, it is not compatible with art.9(2)(a) as interpreted by the Court of Justice. There cannot be a strict interpretation of identity between mark and sign if a trade mark can exist in various forms.
55. During argument the example of word marks was raised. It was suggested that the registration of a word mark in a standard typeface in fact constitutes the registration of a large number of variants, that is to say the same word in all typefaces. This may be better viewed as a long-

standing convention in trade mark law regarding what the proprietor of a word mark claims to be distinctive about his mark. If the word is registered in a standard typeface, for the purposes of both validity and infringement there is no claim of distinctiveness relating to the font or other particular form of presentation of the word; comparisons with earlier marks or with accused signs are made solely by reference to word itself. The word is a single sign.

56. Turning back to the Trade Mark in this case, a colour mark, I reject the contention that it can be validly composed of variants around a single sign.

The correct approach to the interpretation of a trade mark

57. Mr Howe submitted that where the description in a trade mark application or registration states (as in the present case): "the trade mark *consists* of...", there is no room for ambiguity. Irrespective of what the visual representation may look like, the reader is being told that in fact the trade mark is as set out in the words of the description. Mr Howe argued that this is supported by *Heidelberger Bauchemie* in which the description began "The trade mark applied for consists of..." and where the ECJ construed the mark by reference to the description rather than the particular blue and yellow rectangle of the visual representation.
58. I think this amounts to a submission that the words 'consists of' should be elevated to a term of art, indicating that what follows is the definitive description of the mark, with the visual representation being illustrative, no more, where there is no strict congruence between them. I can see no reason for adopting that strict view of those words.
59. As a simple matter of language, both sides are agreed that Glaxo's mark *does* consist of the colour dark purple applied to a significant part of an inhaler, etc. The question is whether the freedom of variation allowed by the description is qualified and narrowed to a single sign by the visual representation. Mr Howe argued that it is not: the description is where the correct interpretation of a trade mark is always to be found.
60. Mr Alexander submitted that the first port of call should be the visual representation. This will serve as the primary indication of the mark claimed. The words of the description may qualify what is shown in the visual representation, for example by disclaiming some aspect of the image or, as in this case, indicating that the proprietor is claiming an abstracted version of what is shown.

Analysis

61. Given my conclusion regarding variants on a single sign, it is only necessary for me to consider the correct (single) interpretation of the Trade Mark.
62. As I have said, where there is no strict congruence between the visual representation and the description, I take the view that both must be considered without any formal precedence, one over the other. The weight to be given to each will depend on the circumstances.
63. Where INID code 558 indicates that this is a colour *per se* mark, the necessary qualities of clarity, precision and uniformity, without which the requirements of art.4 will not be satisfied, become particularly important.
64. By way of examples, in both *Heidelberger Bauchemie* and *Cadbury* the visual representations offered little or nothing by way of an indication of the precise and uniform mark which was being claimed. Attention therefore necessarily focussed on the description in both instances. By contrast, in *Apple* the nature of the three-dimensional mark was primarily conveyed by the visual representation and indeed the Court of Justice held that no additional details in the description, by way of dimensions or proportions, were required.

65. In the present case the 558 code indicates that it is a colour mark. Unlike those in *Heidelberger Bauchemie* and *Cadbury*, the visual representation here on one view provides considerable guidance as to the mark claimed. The difficulty is that the visual representation is a photograph of an inhaler, which would be appropriate for a three-dimensional mark claiming a particular form of packaging, but is less so for a colour mark which may not be confined to any specific shape of goods.
66. The reader must turn to the description. This is unambiguous with regard to the Pantone shades of purple to be used. It is not so clear in relation to the respective proportions and the arrangement of dark and light purple. As has already been discussed, on the words alone there is something close to complete freedom with regard to the relative proportions of light and dark purple and how they are presented (stars, dots, stripes, etc.). In my view the reader is set a puzzle.
67. In broad terms, there are three possible solutions to the puzzle. The first is a mark with the outline of the visual representation (spikes and all) and the precise juxtaposition of light and dark purple zones there shown. The second is Mr Howe's freedom of many alternative marks according to the words of the description. The third is Mr Alexander's solution of a pattern abstracted from the visual representation.
68. Only the first of these is a single sign. The abstraction solution is not. Dr Nordemann-Schiffel's evidence included excerpts from written submissions in the litigation before the EUIPO. There, Glaxo has also proposed an alternative abstraction with a rectangular shape. I reproduce the round and rectangular abstractions here, both said by Glaxo to be forms of the mark claimed:



69. The signs are self-evidently not the same shape. The relative proportions of light and dark purple appear to be different in these two images. It is not clear that the mark claimed is limited to be any specific shape. If one were to imagine an abstraction in yet another shape, that of an equilateral triangle, there would be another relative proportion of light and dark shades. This is not a colour mark such as stripes of equal widths which can be adapted without change to any overall shape. Overall shape matters because the mark must be applied to an inhaler. Glaxo sells inhalers for the treatment of asthma and chronic obstructive pulmonary disease. One is the 'Accuhaler', an example of which is shown in the visual representation of the Trade Mark. The other is the 'Evohaler', which is shown below:
70. It goes further. Glaxo's preferred abstraction is beguiling in that, once seen, it tempts the reader to think that this is the only realistic abstraction possible (leaving overall shape aside). But that is not so. The abstraction could be closer to the visual representation in detail. Alternatively, it could be more free-form – more abstract – than the abstraction suggested. The reader does not know. Any one of the candidate abstractions qualifies as a single sign and any of them, such as either of the two shown above, could in principle have been registered. Glaxo's difficulty is that the registration has not limited itself clearly and unambiguously to just one such sign.
71. I have come to the conclusion that the Trade Mark does not satisfy art.4 of the Trade Mark Regulation. It is not sufficiently precise and uniform. Nor is it sufficiently clear and unambiguous.

There are two levels at which the Trade Mark lacks precision and uniformity. One is that it sets the reader the puzzle I have described above. The other is that the second and third solutions to the puzzle still leave the reader uncertain as to what form the Trade Mark takes.

Whether there should be a reference to the Court of Justice

72. I have identified the points of principle which arise in this application and have stated my view in relation to both of them. Although they concern EU law, subject to one consideration I do not believe that a reference to the CJEU is appropriate.
73. My reason for doubt arises from an intervention in the pending appeal to the General Court from the decision of the Board of Appeal of the EUIPO in *Red Bull*, discussed above. The application to intervene was by Marques, a non-profit organisation which represents the interests of trade mark owners in 80 countries, including 27 of the 28 Members States of the EU.
74. I was shown a copy of Order of the General Court dated 18 November 2015 in response to Marques' application. Marques submitted that the appeal raised a question of principle, namely how a colour *per se* combination mark is to be represented graphically in a trade mark application or registration in order to meet the requirements of the Trade Mark Regulation. The General Court said (at [32]):

"...it must be held that the case raises questions of principle regarding the graphic representation of a mark consisting of colours *per se* in the application for registration and in the registration, at least so far as concerns the interaction between the description of such a mark and that graphic representation in order to satisfy the requirements of Article 4 of Regulation No 207/2009."

Marques' intervention was allowed.

75. The General Court was apparently satisfied that there is an unresolved issue in *Red Bull* regarding the interaction between the description and visual representation of a mark and that it is of some general interest to trade mark owners. I have considered whether it follows that the similar issue arising in the present case requires a reference to the CJEU. In the end I have come to the conclusion that it does not. Each case depends on its particular facts. I take the view that the law as set out by the Court of Justice and as explained by the Court of Appeal in *Cadbury* renders the correct interpretation of the Trade Mark in the present case either *acte clair* or *acte éclairé*. Where a national court reaches such a view in the proceedings before it, even having taken into account the view of another court in different proceedings, no reference should be made.

Conclusion

76. The Trade Mark is invalidly registered pursuant to arts.52(1)(a), 7(1)(a) and 4 of the Trade Mark Regulation. Glaxo's claim for infringement of the Trade Mark is dismissed.

Department	Civil
Instance	First
Country	 United Kingdom
Region	England and Wales

High Court Decision (HC-2015-005005) – Glaxo Wellcome UK Limited (t/a Allen & Hanburys) & Glaxo Group Limited v Sandoz Limited - <https://cases.legal/en/act-uk2-270576.html>

Court **[England and Wales High Court](#)**

Judge **[HIS HONOUR JUDGE HACON](#)**

lawyer **[Daniel Alexander QC](#)**

Date **28.6.2016**

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