

GENERAL COURT  
OF THE EUROPEAN UNION  
First Chamber

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**STATEMENT IN INTERVENTION**  
**in case T-38/24**

Pursuant to Article 40 of the Statute of the Court of Justice and Article 145 of the Rules of Procedure, filed in the name of

**International Trademark Association (“INTA”)**

Established at 675 Third Avenue, 3<sup>rd</sup> Floor, New York, NY 10017-5646, United States of America

Represented by Ms. Noemi Parrotta, lawyer, Spheriens, piazza della Libertà No. 13 - viale Don Minzoni No. 1, Florence, Italy;  
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Mr. Tanguy de Haan, lawyer, NautaDutilh, Chaussée de La Hulpe No. 120, 1000 Brussels, Belgium

**- Intervener -**

We are authorized to practice before the courts of a Member State. Pursuant to Article 51(2) of the Rules of Procedure of the General Court (hereinafter the “**Rules of Procedure**”), we have produced certificates attesting to this fact. We hereby declare that we represent and are acting on behalf of INTA, pursuant to valid powers of attorney.

\* \* \*

The main parties being:

**OMV AG,**

Established at: Trabrennstraße 6-8, 1020 Vienna, Austria

Represented by: Mr. C. Schumacher and Ms. B. Kapeller-Hirsch, lawyers (Schoenherr Rechtsanwälte GmbH, Schottenring 19, 1010 Vienna, Austria)

**- Applicant -**

**European Union Intellectual Property Office (“EUIPO”)**, 4 Avenida de Europa, E - 03008 Alicante, Spain, represented by Ms. Elena Nicolás Gómez, acting as agent,

**- Defendant -**

In the action for annulment of the decision of the Fifth Board of Appeal of EUIPO (the “**Board of Appeal**” or “**Board**”) of 8 November 2023, in case R 0798/2023-5 (the “**Contested Decision**”), regarding the European Union designation of International Registration No. 1593116.

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This statement is filed by the deadline set forth in this Court’s order of 6 June 2024 authorizing INTA’s intervention.

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**1. RELIEF SOUGHT**

1. In support of the Applicant’s appeal, INTA requests that this honorable Court:
  - annul the decision of the Fifth Board of Appeal of EUIPO of 8 November 2023, in case R

0798/2023-5; and  
- order INTA to bear its own costs.

## 2. SUMMARY OF THE DISPUTE

2. The case concerns a partial refusal of protection to a trademark consisting of a combination of shades of blue and green in the systematic arrangement shown below, described as gentian blue (RAL 5010) and yellow green (RAL 6018) (hereinafter referred to as the “**Contested Mark**”).



3. Protection was refused for goods and services in classes 1, 4, 35 and 37, all relating to fuel or energy and services relating to such goods. Protection was granted for the rest of the services in classes 35 and 37 and for all services in classes 39, 40, 42, 43 and 44.
4. For the sake of conciseness, INTA refers to the Applicant’s summary of facts in paragraphs 6 to 14 of the Application.

## 3. INTA SUPPORTS THE APPLICANT’S APPEAL

5. INTA believes that this case is significant to the development of trademark law in the European Union. The case law regarding colour combination trademarks is not fully developed, and there exists a number of decisions in different cases which in sum do not give clear answers to questions of the threshold for distinctiveness for such trademarks. In the past years, there have been several infringement cases before national courts about registered or unregistered colour trademarks, highlighting the importance of such trademarks for trademark proprietors and, more in general, for market operators. The Contested Decision is based on insufficient grounds and **does not properly take the market situation and the systematic arrangement of colours in the Contested Mark into account**. In assessing the distinctiveness of the Contested Mark, the decision applies the **high threshold** set forth by the case law with respect to **single-colour marks**. There is no reason for such a strict approach in the case of colour combination trademarks. Allowing a practice whereby in the assessment of colour combination trademarks a stricter approach is taken than with respect to other kinds of trademarks is to the detriment of the legitimate interests of the trademark holders and market operators.
6. Over the decades, INTA has consistently held that colour trademarks in general and colour combination trademarks should be allowed to be registered. It is generally in the interest of trademark proprietors that distinctive signs that are used and perceived as trademarks are also granted protection as such. INTA considers that, while single colour marks are in a special position when it comes to distinctiveness, **the issue that there is a limited number of colours available should not be exaggerated**. As INTA has pointed out in its Resolution of 20 November 1996 on Protectability of Color Trademarks, there is a huge range of different hues that can be distinguished by the consumer. As further pointed out in the Resolution, issues of hues confusion do not pose more difficult questions than other assessments of confusion of trademarks. It follows that, when a trademark registration is limited to certain **specific colours in a systematic arrangement**, no special issues arise that do not also arise

for traditional word or figurative trademarks. The possibilities for variation in hues and arrangement of colours are enormous.

7. Article 4 of Regulation (EU) 2017/1001 (hereinafter “EUTMR”) states that “*An EU trade mark may consist of any signs, in particular [...], colours [...]*” subject to the general registrability conditions. At the outset, it is clear that the EUTMR provides for the protection of colours, save for circumstances where the colour does not meet the requirements for registration, such as when the colour is devoid of distinctive character.
8. The EU is a party to the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS). Providing for the registration of colour combination is a specific requirement of TRIPS, see Article 15(1), which states that: “*Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular [...] combinations of colours [...] shall be eligible for registration as trade marks*”.
9. It follows from the CJEU case law on the registration of a colour *per se* that, for a single colour without any further elements, inherent “*distinctiveness without any prior use is inconceivable save in exceptional circumstances*” (CJEU, 6 May 2003, C-104/01, *Libertel*, EU:C:2003:244, paragraph 66). It should be noted that this statement is based on the reasoning that “[w]hile the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the look of the goods in respect of which registration of the sign as a trade mark is sought. Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour *per se* is not, in current commercial practice, used as a means of identification” (paragraph 65).
10. However, this does not mean that colours *per se* are excluded from registration, on the contrary, the CJEU has confirmed that “*colours per se may be capable of distinguishing the goods or services of one undertaking from those of other undertakings, within the meaning of Article 2 of the Directive*” (*Libertel*, paragraph 41). This decision is clearly directed specifically at single colour trademarks, and the reasoning cannot be directly applied to a situation where a trademark consisting of a **combination of colours in a specific arrangement** is to be assessed. In any case, if colours *per se* may be registrable, according to the law and the case law, this would be even more true for colour combinations.
11. The CJEU has further opined on the situation for colour combinations in its judgment of 24 June 2004, C-49/02, *Heidelberger Bauchemie*, EU:C:2004:384. The Court referenced the decision in the *Libertel* case and ruled that “*colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for the purposes of Article 2 of the Directive where:– it has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and – the application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way*” (paragraph 42). While this decision concerned a trademark consisting of a combination of colours, protection was claimed in the abstract, *i.e.* without specification of the specific arrangement of colours. Under this circumstance it is relevant to recall the statements made in the *Libertel* decision concerning single colours. Indeed, the statements in *Libertel* are not applicable when addressing a trademark in which colours are not claimed in the abstract but

in a specific arrangement, because that specific arrangement lastly and decisively influences the consumer's perception.

12. What follows from these decisions is that the context in which the trademark use occurs is of crucial importance to the assessment of whether a colour trademark has inherent distinctiveness. The cases both answered general questions on the registrability without a specific assessment of the context and circumstances which would lead to a colour trademark having inherent distinctiveness. Both decisions highlight that all relevant circumstances must be taken into account in the assessment.
13. Article 7(1)(b) EUTMR prohibits the registration of trademarks that are devoid of distinctive character. In the present case, the trademark has been granted protection for a large number of services, and only refused for goods and services directly related to fuel and energy. It is clear therefore that the Office has considered the trademark to be inherently distinctive for goods and services in general, and that the lack of distinctiveness only relates (allegedly) to fuel and energy goods and services.
14. The Applicant has referenced the EUIPO Trademark guidelines on colour combinations. EUIPO has correctly pointed out that the Guidelines are not a binding legal document. It is not necessary to rely on the trademark guidelines to assess this question. The fact that an applicant is entitled to registration of a trademark unless there is a specific reason to oppose the registration is a fundamental principle of the EU trademark system; the grant of a trademark is not a discretionary decision. As outlined above, **there is no reason to treat colour combinations differently than other trademarks** in that respect. It is however clear that there might be cases where a colour combination will not be perceived as an indicator of origin, *e.g.* because the connotations of the colours in a specific market will be understood as decoration or have descriptive connotations (*e.g.* the green and white colours found in the cross used as the international pharmacy symbol). Conversely, in cases where it cannot be established that a colour combination will be understood as a decoration or have descriptive connotations, registration must be accepted unless another ground of refusal is present.
15. It is consistent with the CJEU case law that trademarks shall in general be assessed under the same criteria. This is established for non-traditional trademarks, *i.e.* in judgement of 10 July 2014, C-421/13, *Apple*, EU:C:2014:2070, where the Court states that: “*the representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store, may be registered as a trade mark for services consisting in services relating to those goods but which do not form an integral part of the offer for sale thereof, provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings and that registration is not precluded by any of the grounds for refusal set out in that directive*”.
16. The Board of Appeal's decision is based on the contention that first the colours blue and green, in general and without specifying any specific hues, are associated with environmental friendliness and other characteristics, and second, that these colours are commonly used in the fuel industry. While it is permissible, and often necessary, to consider each element of a trademark in isolation, the final assessment of a trademark must be based on the trademark **as a whole**. In the Contested Decision, at paragraph 40, the Board effectively reduces the mark to a mere combination of two basic colours, without taking into account the specific hues used or the specific arrangement of the colours. The assessment that there is “*nothing that indicates that the combination is more than the sum of their elements*” is inconsistent with the obvious fact that the combination of two colours and the use of a specific arrangement introduce a **multitude of possible variations** which would not be present for a

single colour or for a colour combination without a specific arrangement. Furthermore, given that the case concerns a specific colour combination and not *e.g.* a word combination, the question of whether the colour combination is “more than the sum of its [colour] elements” does not appear relevant. The question is not whether the colour combination is more than the sum of its elements (colours) but whether such combination can indicate trade origin.

17. The combination of the two specific colours in their specific shades immediately communicates more than a single colour would, because of the relative difference between the colours. While the individual colours may be associated with environmental friendliness, there is nothing to indicate that the colour combination has such an association. The specific arrangement also introduces a separate origin designation element that the consumer perceives. This is easily demonstrated by the fact that, if the trademark was in black and white, the colour arrangement could still be observed and associated to a particular undertaking. **INTA therefore agrees with the Applicant that the Board did not take the specific arrangement and shades of the trademark into account.** If future practice should follow the approach taken in the decision, it is difficult to imagine which colour combination trademarks would be registerable. For any colour combination trademark, it is conceivable that descriptive meaning could be assigned to each individual colour. It is unclear from the decision what could lead to the combination being more than the “sum of its elements”, as the elements outlined above were evidently not sufficient.
18. Furthermore, the assessment that the colours green and blue may individually indicate environmental friendliness is irrelevant given that the mark was not rejected on the basis of descriptiveness but on the basis of non-distinctiveness.
19. In addition, the finding that the colours blue and green are descriptive of these qualities is contradictory to the Contested Decision finding that blue and green colour combinations are used by filling stations to distinguish their services (paragraph 41 of the Contested Decision, where it is stated that competitors such as BAVARIA petrol, Carrefour Gasolinera, and La Asociación de Gasolineras Libres de Andalucía (AGLA) use these colours to distinguish their filling stations).
20. The assessment of whether the colour combination is in use in the fuel industry is based on the reduction of the trademark to its constituent elements without regard for the added information (hue and arrangement). The examples shown at paragraphs 4 and 42 of the Contested Decision all show **clearly different hues in different arrangements** than in the Applicant’s trademark. When the examples found differ from the mark under consideration to this degree, further evidence that the colours are used in the specific combination should be required for a finding that the trademark lacks inherent distinctiveness. These examples do not prove that the mark at hand lacks inherent distinctiveness. On the contrary, they prove a) that colour combinations are typically used in the field of filling stations to designate origin and consumers are familiar with and may well rely on this trade origin function of the filling station colours; and b) that the specific colours, blue and green, combined together in various types of combinations, do function in this market as designators of origin.
21. When considering the inherent distinctiveness of a trademark, due account should be taken of the **established market practice** in a field. In that regard, it may be relevant to the assessment that colour combinations are commonly used to differentiate goods and services in the field. The expert declaration from Prof. Dr. Arnd Florack submitted by the Applicant as Exhibit G goes further than to establish that the consumer may rely on a colour combination as a designation of origin if they have learned to associate a combination with a specific undertaking, as the Office claims. Read as a whole, the report clearly states that,

based on survey evidence, colours are capable of functioning as a designation of origin, and furthermore that colours will be particularly important in the case of fuel stations, where the consumer at the point of making the decision to pull up to a given station has only a limited ability to perceive other elements.













22. Combined with the numerous examples filed by the Applicant in the case (see the Applicant's Exhibits D and F before the Board of Appeal), and the examples that the Board found through Internet searches, it is clear that many (if not all) fuel station providers use the colours of their buildings not as a mere decoration, but **as a trademark** that is applied consistently to all stations in specific hues and combinations. These colours vary. They may be blue and green as in the mark at hand, they may be yellow and red, they may be red and white, they may be green and white, *etc.* (per the examples provided by the Applicant in Exhibits D and F). It is clear that in such a situation, the consumer is and has always been trained to understand the colours used by fuel stations as an indicator of origin, irrespective of whether the specific colour combination he is now faced with is associated by him/her with a specific provider or not. **Evidence that establishes a market practice** such as the evidence presented here should be taken into consideration when assessing inherent distinctiveness.
23. Even evidence that shows that a large number of consumers associate a colour combination with a specific provider, most commonly used when arguing for acquired distinctiveness, may prove to show that the consumer is used to understand and expect the use of colour as a trademark designating the origin of goods or services. This is particularly the case when, as in the current case, it is shown that a unique colour combination is used on specific parts of all fuel stations from a specific undertaking.
24. Any assessment whether colours are commonly used or have a descriptive quality in a specific field must be considered together with evidence whether the use of colours is a common way of communicating origin in the specific field. **The specific practices within a particular market can be an important factor in determining consumer perceptions and can outweigh the general associations that colours may evoke in consumers' minds** (such as environmental friendliness in the case at hand). Even if somewhat similar colours and arrangements can be used by others in the market, the consumer will be more likely to regard a colour combination as a trademark under these circumstances.
25. It is crucial to the use of and trust in the trademark system that signs that are actually used to differentiate products and services from competitors are afforded protection. It is not uncommon that practices emerge in particular sectors, where elements that may at the outset be perceived as a mere decoration, are over time perceived by consumers as a designation of origin. This may occur not only as to a specific manufacturer's goods, but generally apply to all products of a certain kind or to a sector in general.
26. This is the case for instance for **position marks on sneakers** at the EU level. At first, the EUIPO used to rule out the protectability of the relevant signs for lack of inherent distinctiveness, based on the general presumption deriving from case law, whereby consumers will not generally perceive this kind of signs as an indication of source. However, since 2000 the EUIPO has started acknowledging the existence of an established practice in the footwear field to use position marks – usually consisting of lines, stripes, geometric shapes, or combinations thereof, always in the same position on the outside of the shoe – and, as a consequence, holding that thanks to this very practice **consumers have become accustomed** to identifying a particular brand of sneakers based on said marks. And this has in many cases led the Office to *“conclude that the average consumer perceives such patterns as inherently distinctive signs, and that the relevant public for the goods at issue will pay*

*close attention to the shapes placed on the sides of sports shoes. Consequently, when applied to a shoe, such a sign will serve as a trade mark and is capable of fulfilling the main function of a trade mark, namely to distinguish the shoes of one undertaking from those of another”* (see to this extent: EUIPO Board of Appeal, 7 December 2020, R2882/2019-4; and, similarly, EUIPO Board of Appeal, 26 April 2021, R2069/2020-4; EUIPO Board of Appeal, 20 December 2022, R1371/2022-5, R1370/2022-5 and R1369/2022-5, paragraph 43).

27. Another striking example was given very recently by this Court. It ruled that over time, in the **automotive sector**, the **shape of headlights** has in itself become an indication of trade origin in itself. Consumers are now able to recognize the origin of a car, just by seeing the shape of headlights. Indeed, *“car headlights have become over time an essential element of the design of vehicles and for differentiating different existing models on the market made by different producers of these products. As a consequence, they can be inherently useful to visually identify a model, range or all models of a same constructor of vehicles from other models (see, in this sense and by analogy, judgment of 6 March 2003, DaimlerChrysler / OHIM (grille), T-128/01, EU:T:2003:62, paragraph 42). As acknowledged by an expert [...], the conception of headlights is important to stress the commercial origin and the fact that they can be perceived from far away, in the sunlight or in the dark, makes them particularly efficient to convey distinctive signs”* (GC, 26 June 2024, T-260/23, EU:T:2024:421, *Volvo Personsvagnar AB / EUIPO*, paragraphs 37 and 38)<sup>1</sup>.
28. These findings should apply *mutatis mutandis* in the present case: specific colour combinations for fuel related services have become inherently useful to visually identify a trade origin; they can easily be perceived from far away, both in the sunlight or in the dark (almost always with lights), and are clearly particularly efficient to convey distinctive signs. It follows that evidence of such practices should be taken into account and assessed on the same basis as evidence of e.g. use of similar colours or colour arrangements in the market. This is also in line with the CJEU case law, see for instance, judgment of 8 October 2020, C-456/19, *Aktiebolaget Ostgotatrafiken*, EU:C:2020:813 in which it is stated that *“the distinctive character of a sign for which registration as a trade mark in respect of a service is sought, which sign consists of coloured motifs and which is intended to be affixed exclusively and systematically in a specific manner to a large part of the goods used for the provision of that service, must be assessed by taking into account the perception of the relevant public of the affixing of that sign to those goods, without it being necessary to examine whether that sign departs significantly from the norm or customs of the economic sector concerned”* (paragraph 44).
29. Turning to the case at issue, the Applicant had provided evidence showing that **in the fuel station industry** there is an **established practice** in the EU of using signs consisting of colour combinations, also with a systematic arrangement similar to the refused mark, e.g. with two lines of colours, one very thick and the other one very thin, as shown below (the images are part of Exhibits D and F of the Applicant’s file):

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<sup>1</sup> Translation from French: *“les phares avant sont devenus un élément essentiel de l’aspect des véhicules et de la différenciation des différents modèles existants sur le marché fabriqués par les divers constructeurs de ces produits. Dès lors, ils sont des éléments qui peuvent être intrinsèquement utiles dans l’individualisation visuelle d’un modèle, d’une gamme, voire de tous les modèles d’un même constructeur de véhicules à moteur par rapport aux autres modèles [voir, en ce sens et par analogie, arrêt du 6 mars 2003, DaimlerChrysler / OHMI (calandre), T-128/01, EU:T:2003:62, point 42]. Comme cela a été mis en avant dans l’avis d’un expert [...], la conception des phares avant est importante pour souligner l’origine commerciale et le fait qu’ils peuvent être perçus à plus grande distance, à la lumière du jour et dans l’obscurité, les rend particulièrement efficaces en tant que porteurs de signes distinctifs.”*

<p>Esso</p>  <p>Source: <a href="https://www.esso.de/de-de/tankstellenpartner-werden">https://www.esso.de/de-de/tankstellenpartner-werden</a></p>	<p>Avia</p>  <p>Source: <a href="https://www.oberoesterreich.at/oesterreich-poi/detail/171543/avia-tankstelle-ried-seifriedsberger-tsb-gmbh.html">https://www.oberoesterreich.at/oesterreich-poi/detail/171543/avia-tankstelle-ried-seifriedsberger-tsb-gmbh.html</a></p>
<p>Turmöl</p>  <p>Source: <a href="https://turmol.at/tanken/">https://turmol.at/tanken/</a></p>	<p>JET</p>  <p>Source: <a href="https://www.jet-tankstellen.at/de/index.php">https://www.jet-tankstellen.at/de/index.php</a></p>
<p>Shell</p>  <p>Source: <a href="https://voecklabruck.news/article/shell-eroeffnet-weitere-tankstelle-der-zukunft-in-regau">https://voecklabruck.news/article/shell-eroeffnet-weitere-tankstelle-der-zukunft-in-regau</a></p>	<p>.AP-Trading</p>  <p>Source: <a href="https://www.austropetrol.com/">https://www.austropetrol.com/</a></p>
<p>SOCAR</p>  <p>Source: <a href="https://www.socarenergy.ch/de-ch/news/socar-eroeffnet-erste-tankstelle-oesterreich.html">https://www.socarenergy.ch/de-ch/news/socar-eroeffnet-erste-tankstelle-oesterreich.html</a></p>	<p>Disk</p>  <p>Source: <a href="https://www.fieberbrunn.com/de/service/info-fieberbrunn/fieberbrunn_von_a_bis_z/DISK-Tankstelle_isd_57410">https://www.fieberbrunn.com/de/service/info-fieberbrunn/fieberbrunn_von_a_bis_z/DISK-Tankstelle_isd_57410</a></p>
<p>Genol</p>  <p>Source: <a href="https://www.genol.at/tanken/">https://www.genol.at/tanken/</a></p>	<p>A1</p>  <p>Source: <a href="https://a1tankstelle-draschwandtner.sta.io/galerie/g/2898/89210/">https://a1tankstelle-draschwandtner.sta.io/galerie/g/2898/89210/</a></p>
<p>LM-Energy</p>  <p>Source: <a href="https://www.lm-energy.at/tankstellen-netz/">https://www.lm-energy.at/tankstellen-netz/</a></p>	 <p>Source: <a href="https://www.troppacher.at/tankstellen/tankstellennetz/gt-troppacher-gries-a-brenner.html">https://www.troppacher.at/tankstellen/tankstellennetz/gt-troppacher-gries-a-brenner.html</a></p>





30. And the Applicant's use of the Contested Mark clearly falls within this established practice, as shown below (the images are part of Exhibits D and F of the Applicant's file):



31. However, the Contested Decision did not give due deference to the above market practice in the assessment of the public perception but limited itself to erroneously stating that consumers viewing a building from afar would not notice the arrangement of the colours.
32. It is worth stressing that whether consumers are confused or not is a different issue and one that presupposes that the colour combinations at hand **do function** as trademarks denoting origin. The particularities of the market at hand, where consumers, as the Applicant stated (paragraph 51 of the Contested Decision), come into contact with the trademark usually from a distance, at speed, driving, without much time to closely examine, make colours suitable as indicators of origin and in particular on the large filling station building facades, per common market practice. The Contested Decision finding that the consumer must see the word or logo mark in order to identify the source is false and therefore not corroborated by any evidence or justification (paragraph 51 of the Contested Decision). Furthermore, the Contested Decision focuses on its finding that the consumer while driving fast shall not be able to tell which filling station it is before they see the word or logo sign ("it is impossible for the driver to safely identify the origin [...] under the colour combination alone [...]") however this finding is irrelevant as the consumer does not need to identify the owner behind the mark, for the mark to fulfil its origin function. It is sufficient that the consumers will believe that the colour combination they see is part of the branding and not a mere decoration or an "eco friendly" signage denoting clean and green products/services.
33. Furthermore, the Applicant has referenced several decisions by the EUIPO where colour combination trademarks have been accepted for registration. The examples are no more or less inherently distinctive than the contested trademark. While it is acknowledged that an applicant should not be able to rely on previous unlawful decisions, the decisions are from the period after the above mentioned CJEU's judgment of 24 June 2004, C-49/02, *Heidelberg Bauchemie*, EU:C:2004:384. In this decision, it is stated that colours as such will seldom have inherent distinctiveness. This is not a statement on the situation where a combination of colours in a specific arrangement is assessed and does not include any statements on the

impact of market practices on the public’s perception of colours as trademarks. It should be recalled that the decision concerned a case about a trademark consisting of the mere juxtaposition of two colours designated in the abstract and arranged “*in any conceivable form*” (paragraph 34). There is nothing in the statements in this decision that would preclude the registration of colour combination trademarks in general. Even in this case, the EUIPO has allowed for the registration of the contested trademarks for a large number of goods and services. The previous practice of the EUIPO after the decision should therefore be seen as a practice implementing these criteria following from the case law of the CJEU on colour combination trademarks, which trademark applicants should be able to rely on to their benefit in cases about similar trademarks.

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34. In view of the aforesaid, INTA’s position regarding the issues raised in the present case can be summarized as follows:
- combinations of colours should be assessed **in the same way as any other trademarks**, without applying a particularly strict test as may be proper for single colour marks;
  - the **systematic arrangement** of a colour trademark should be considered on the basis of the trademark as filed and be part of the assessment of a trademark’s distinctiveness;
  - the **market practice** in a given industry is a relevant factor in the assessment of inherent distinctiveness of trademarks, as it might have an impact on how the public perceives the relevant sign. This is particularly true when it comes to non-traditional marks/colour combination marks, because an established market practice, like in the present case, might serve to demonstrate that the relevant public is actually accustomed to perceiving a specific sign – different from a word or a figurative mark – as a trademark and satisfy the distinctiveness threshold overcoming any general presumption that such signs are not perceived as trademarks.

#### 4. COSTS

35. INTA does not request that a party be ordered to pay costs. INTA agrees to bear its own legal expenses.

With all rights reserved and without prejudice,

**FOR THESE REASONS,**

**MAY IT PLEASE THE GENERAL COURT OF THE EUROPEAN UNION TO**

1. annul the decision of the Fifth Board of Appeal of the EUIPO of 8 November 2023 in case R 0798/2023-5; and
2. order INTA to bear its own costs.

Florence, 17 July 2024  
For INTA, Intervener  
Its counsels,

Noemi Parrotta, Esq.,  
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