
United Kingdom: High Court Invalidates Glaxo's Color Mark EU Trademark Registration

Glaxo Wellcome UK Limited (t/a Allen & Hanburys), Glaxo Group Limited v. Sandoz Limited, [2016] EWHC (Ch) 1537.

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The High Court of Justice of England and Wales recently invalidated Glaxo Group Limited's European Union Trade Mark registration for a color combination applied to its Seretide inhaler product. The court considered the validity of the 2008 registration in the context of a counter-claim and summary judgment motion brought by Sandoz Limited ("Sandoz"), that Glaxo Group Limited and Glaxo Wellcome UK Limited ("Glaxo") had sued for infringement of the trademark.

Registration at Issue

Glaxo's registration consisted of both a graphic representation and a verbal description:

"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."

The registration was further designated by the World Intellectual Property Office's "Internationally agreed Number for Identification of (bibliographic) Data" (INID) for a "mark consisting exclusively of one or several colors".

The Parties' Arguments

Sandoz contended that, under Article 4 of the EU Trademark Regulation, the mark was neither a “sign” nor “capable of being represented graphically.” As the trademark was not a figurative mark but rather a color combination, Sandoz claimed that the verbal description of the mark controlled in construing the mark. By this interpretation, the mark was not a “single sign” but rather a “collection of an almost limitless number of signs” as any number of patterns and proportions of dark and light purple could be applied to the inhaler.

Glaxo claimed that the visual representation of the mark should be the starting point in construing it. Glaxo agreed that the registration was not a figurative mark, but that the color mark claimed was an “abstraction” or pattern drawn from the visual representation.

Court's Preliminary Comments on the Application of Article 4 to Color Marks

Under Article 4, the court noted that 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.”

The court further observed that Commission Regulation (EC) No. 2868/95, as amended by Regulation (EU) No. 2014/2424, provides that a registration consisting of a color must contain an indication to this effect, together with the colors making up the mark.

After examining relevant EU case law applying these requirements in the context of marks designating colors or color combinations, the court concluded that a sign must be perceived “unambiguously and uniformly,” thus guaranteeing its function as an indication of origin. The graphic representation of the sign must also be “precise,” allowing the relevant authorities to ascertain with clarity and precision the nature of the sign, as well as other traders to obtain relevant information about the rights of other parties.

The Court's Analysis

As an initial question, the court determined that the interpretation of a color mark falls solely within the purview of the court, and is not (as Glaxo contended) a matter for the average consumer. The court noted that “there can only be one correct interpretation of a trade mark registration or application,” and

that some trademark specifications are “broad” and likely to require the assessment of “different average consumers,” depending on the goods and services in question.

The court then identified two primary issues in the case at hand: (i) whether a color mark can consist of variants without violating Article 4; and (ii) how a registration or application for a mark consisting exclusively of one or several colors should be construed where there is “no strict congruence between the visual representation and the description.”

(i) Whether a color trade mark can consist of variants

Glaxo argued that a sign need not be specified with absolute precision, and that some variation in the form of the sign is permissible. As support for this argument, Glaxo relied on the European Court of Justice’s decision in *Apple Inc v. Deutsches Patent- und Markenamt*, Case C-421/13, in which Apple Inc. applied for and successfully registered a three-dimensional trademark for retail store services. Apple Inc.’s registration consisted of a visual representation of the store layout showing placement of windows, tables, and other features, and the description “the distinctive design and layout of a retail store.” Glaxo argued that, because the store layout did not contain specific dimensions or proportions, it should be interpreted to include variations such as windows that could be deeper or shallower, or tables that might be long or short. Glaxo claimed that variations in the form of a sign are acceptable, and that in the case of *Apple* a single sign had been validly registered notwithstanding these possible variations.

The court rejected Glaxo’s arguments, agreeing with Sandoz that all that had been decided in the *Apple* case was whether the three-dimensional mark was a sign capable of being graphically represented without the inclusion of particular dimensions—not that a trademark may consist of “variations on a single sign.”

The court reiterated that a sign must be “clear, precise, unambiguous and uniform.” Although it is possible that “very minor variations could exist,” the court opined that they would have to be so minor as to be “insignificant and go unnoticed by the average consumer.”

(ii) The correct approach to construing a color trade mark

The court next considered whether the visual representation or the verbal description should be the controlling factor in assessing whether a color mark consists of a single “sign” that is “capable of being represented graphically.”

Sandoz argued that, as the mark was not a figurative mark, one must look to the verbal description to identify the precise mark claimed. Sandoz pointed out that, in this case, the verbal description provided total freedom as to the proportion of dark purple and light purple that could be applied to the inhaler, as well as the type of pattern that could be generated by this application (stripes, dots, etc.). Accordingly, the mark was not a single sign capable of being represented graphically.

In support of its argument that the visual representation of the mark was the starting point for construing the mark, and that the sign claimed was an acceptable “abstraction” of this visual representation, Glaxo submitted the following images from prior litigation matters. Glaxo argued that both images were permissible forms of the mark claimed, demonstrating a uniform pattern abstracted from the visual representation:

The court held that both the visual representation and the verbal description must be considered “without any formal precedence, one over the other” and that the weight to be afforded each will depend on the circumstances. In the present case, the court pointed to the problem that the visual representation of Glaxo’s mark was in fact a photograph of an inhaler, which would be appropriate for a three-dimensional mark, but which was less appropriate for a color mark that is not “confined to any specific shape of goods.” Considering this fact, the court relied on the verbal description in construing the mark. The court agreed with Sandoz that the description, while articulating the Pantone shades of light and dark purple, provided significant freedom for the relative proportions and applications of light and dark.

The court rejected Glaxo’s “abstraction” argument, pointing out that the abstractions Glaxo presented were “self-evidently not the same shape,” and that the relative proportions of light and dark shades appear to be different. The court noted that application of the claimed pattern to yet a third shape, such as an equilateral triangle, would yield a different proportion of light and dark. The court concluded that there could be any number of candidate abstractions, each of which could qualify as a single sign, and that Glaxo had not limited its registration to just one such sign.

As the sign was insufficiently precise, uniform, clear, and unambiguous, it therefore followed that it did not constitute a registrable sign within the meaning of Article 4.

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This decision illustrates the importance and some of the pitfalls in identifying color marks for registration. The court here reinforced the principle that, above all else, the combination of the visual representation and the verbal description of the color mark must result in a claim that is precise, uniform, clear, and unambiguous.

Although the EU trademark law eliminates the graphic representation requirement of Article 4, this change does not go into effect until October 1, 2017. Further, under the new Article 4, a sign must still be capable of clear and precise identification

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