



# Recent case law on the protection of atypical signs and works. Red Bull colour trademarks are null and Levola copyright on the taste of food is improbable. Red colour applied to Louboutin soles deserves protection

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📖 INTELLECTUAL PROPERTY, FASHION AND LUXURY, CONSUMER GOODS

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## **C** JEU on colour trademarks: the Red Bull cases

In the *Red Bull vs. EUIPO* joined cases T-101/15 and T-102/15, the General Court found that both colour trademarks were null. The graphic representation of the two marks, each accompanied by a different description, consisted of the vertical juxtaposition of blue and silver colours, in the proportion of 50% to 50%.

The General Court recalled the previous case law whereby, in order to be eligible

for trademark protection, colours or combinations of colours must satisfy three conditions. First, they must be a sign; second, that sign must be capable of being represented (graphically); third, the sign must be capable of distinguishing the goods or services of an undertaking from those of other undertakings (*Heidelberger Bauchemie*, 24.06.2004, Case C-49/02).

As specifically concerns trademarks consisting of a combination of two or more colours *per se*, the case law made it clear that their graphic representation consisting of the colours, designated in



the abstract and without contours, must be systematically arranged by associating the colours in a predetermined and uniform way. The mere juxtaposition of colours, or a reference to colours in every conceivable form, does not exhibit the elements of precision and uniformity required by EU law for affording trademark registration.

In the Red Bull cases, the graphic representation in fact consisted of a mere juxtaposition of colours without shape or contours, allowing several different combinations, whilst the description was confined to indicating a certain proportion between the two colours, without associating them in a predetermined and uniform way.

The General Court upheld the decision of the EUIPO Board of Appeal, based on the combined analysis of the graphic representation and the description accompanying each contested mark. The graphic representation supplied, accompanied by the relevant description, was not considered sufficiently precise, contrary to Article 7(1)(a) of Regulation No. 207/2009 as interpreted by the case law.

#### **AG of CJEU on copyright covering the taste of food: the Levola case**

Life is not easier for atypical works in the field of copyright. In the *Levola Hengelo vs. Smilde Foods* judgement (C-310/17) pending before the Court of Justice, Advocate General Wathelet delivered a negative opinion on the preliminary question of whether the taste of food is protectable as a copyright work. The case regards the savour of a cheese cream with fresh herbs (named “*Heksenkaas*”), whose IP rights (including the patent on the manufacturing process and the HEKSENKAAS word trademark) are held by the Dutch company Levola Hengelo BV (Levola).

According to the opinion, although pursuant to Article 2, para. 1, of the Berne Convention “*the expression «literary and artistic works» includes every production in the literary, scientific*

*and artistic domain, whatever may be the mode or form of its expression*”, this provision would only refer to works that can be perceived through visual or audible means, like books and musical compositions, and does not mention works that can be perceived through other senses, such as taste, smell or touch. Besides, neither the WIPO Copyright Treaty (which deals with the protection of works and the rights of their authors in the digital environment), nor any other existing provisions of international law, protect the taste of a food product through copyright.

Furthermore, several critical issues specified by AG Wathelet seem to head in the same direction.

□ Directive 2001/29/EC (*InfoSoc Directive*) neither defines the notion of “work” protected by copyright, nor refers to national legal systems for the purpose of such definition. The term “work” corresponds to an autonomous notion of EU law and its meaning must be uniform in all Member States. Therefore, it is not possible for national law to provide a special definition that, outside the framework of EU legislation, expressly includes taste.

□ If the process of elaborating a taste requires any creative activity or know-how, such element is capable of being protected under copyright law only inasmuch as it is original. Nor would it be feasible to protect a taste itself as enshrined in a recipe. Indeed, copyright cannot protect the idea of a recipe as such; it can only cover the external (original) form or embodiment in which the recipe is expressed.

□ An original expression must be capable of identifying with sufficient precision and objectiveness. This is an indispensable requirement in order to respect the principle of legal certainty, in the interests of both the rightholder and third parties. The AG recalls the criteria laid down by the case law on atypical trademarks (*Sieckmann*, 12.12.2002, Case C-273/00), now mirrored by the recent EU Trademark Reform (in the Recitals of Regulation (EU) No. 2015/2424 and Directive 2015/2436/UE),

whereby the relevant representation must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”. The problem here is that, at the present state of technology, any accurate and objective identification of a taste does not seem possible. Nor the subjective character of the assessment can be reduced by assigning the identification of a taste to a court.

□ On the other hand, in the AG’s opinion, the argument whereby food is potentially unstable does not seem per se conclusive, because the *InfoSoc* Directive does not impose any obligation to “fix” a work. The subject matter of copyright is not the support on which the work is fixed, but rather the work itself. However, the real obstacle is that a savour is ephemeral and volatile, hence, unstable, thus precluding the precise and objective identification of the work, and ultimately, the possibility for a taste to constitute a copyrightable “work”.

#### **CJEU on the application of a colour to a specific part of a product: the Louboutin case**

In 2013 the renowned French stylist Christian Louboutin filed an action before the District Court of the Hague, claiming that the Dutch company Van Haren, by retailing high-heeled women’s shoes with red soles, infringed its trademark. The latter consisted of the red colour, of a specified Pantone grade, applied to the sole of a shoe. According to the trademark application, the contour of the shoe was not part of the trademark, being rather intended to show the positioning of the trademark itself. As to the goods covered, the registration was then limited to high-heeled shoes, other than orthopaedic shoes. Van Haren, on its part, objected that the mark – recategorized as a two-dimensional figurative trademark consisting of a red coloured surface – was null.

The Dutch District Court looked at the graphic representation and description of the mark, and maintained that the latter could not be considered a two-dimensional figurative mark, because the

red colour was inextricably linked to the shoe sole. The contour of the shoe, as illustrated in the graphic representation of the mark, was not intended to reduce the sign to a two-dimensional mark, but rather to show the positioning of the mark itself. Also according to the referring Court, a significant proportion of consumers of women’s high-heeled shoes in the Benelux was able to identify Louboutin shoes as goods originating from that manufacturer; moreover, the red sole gave substantial value to the shoes, since that colour formed part of their appearance and image, playing an important role in a consumer’s decision to purchase them.

Against this background, the Court of Justice was asked whether a sign consisting of a colour applied to the sole of a high-heeled shoe consisted exclusively of a “shape” within the meaning of Article 3(1)(e)(iii) of Directive 2008/95/EC. Such Article provides for a ground of invalidity: if a sign consists exclusively of a shape that gives substantial value to goods, it cannot be registered as a trademark.

By the *Louboutin* judgment, 12.06.2018, Case C-163/16, the CJEU gave a negative answer to the question. That ground of invalidity relative to shape trademarks does not apply to a colour applied to the sole of a high-heeled shoe. Therefore, the Louboutin trademark should be held valid.

More particularly, according to the CJEU, the *Louboutin* trademark does not relate to a specific shape of sole, because its description explicitly states that the contour of the shoe does not form part of the mark and is purely intended to show the positioning of the red colour covered by the registration. Indeed, “*it must be noted that, while it is true that the shape of the product or of a part of the product plays a role in creating an outline for the colour, it cannot, however, be held that a sign consists of that shape in the case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product.*” (para. 24 *Louboutin* judgement).





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