

**Combination of colours in box shape refused registration**  
**Israel - Gilat, Bareket & Co, Reinhold Cohn Group**  
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Examination/Opposition  
National procedures

The registrar of trademarks has refused to register four three-dimensional marks consisting of the combination of the colours yellow and green in the shape of a box on the grounds that the marks were abstract and lacked distinctiveness (August 19 2008).

**Mann + Hummel GmbH** filed two applications (Applications 182676 and 182677) for the registration of a three-dimensional **trademark** "consisting of the combination of the colours yellow and green divided by a white line in any form whatsoever" for goods in Classes 7 and 11 of the **Nice Classification** (filters, filtration systems and other related goods). In the applications, the mark was represented in the shape of a box.

Mann also filed two applications (Applications 182679 and 182680) for the registration of a three-dimensional **trademark** consisting of the combination of the colours yellow and green divided by a white line in the shape of a box viewed in perspective from the side. The application covered the same goods in Classes 7 and 11.

Relying on the Trademarks Office circular that was in effect at the time, the examiner refused to register the marks on the grounds that they consisted of three-dimensional images of the packaging of the goods covered by the application, which should be protected as industrial designs.

The registrar noted that Mann had already registered several two-dimensional marks in Israel, including a mark that was similar to the first mark applied for in the present proceedings. This two-dimensional mark included the word 'Mann filter' in the green part and provided a disclaimer that "the shape of the packaging is not part of the mark".

The registrar stressed that the marks at issue raised the following legal issues:

- whether the marks were sufficiently defined and fixed in form to be eligible for registration; and
- if so, whether they were eligible for registration as three-dimensional marks.

The registrar reviewed the definition of a 'trademark' in the **Trademarks Ordinance 1972** and reiterated that trademark law aims to prevent consumer confusion as to the source of goods, while protecting trademark owners from unfair competition.

The registrar held that the marks were too broadly and generally defined, leaving room for a large number of possibilities. Therefore, the marks did not qualify as trademarks, but rather as a marketing concept. The registrar relied on the general principle that IP laws do not protect ideas, but their fixed embodiment. The registrar also referred to the decisions of the European Court of Justice (ECJ) in **Heidelberger Bauchemie GmbH** (Case C-49/02), in which the ECJ considered whether a combination of colours used on packaging or labels was sufficiently precise and durable to constitute a mark, and **Dyson Ltd v Registrar of**

*Trademarks* (Case C-321/03), in which the ECJ refused to allow the registration of a concept which could have several physical manifestations.

The registrar held that the registration of the marks at issue would prevent competitors from using the colours yellow and green on any box, which would be overbroad and create uncertainty. Therefore, the registrar held that the marks were ineligible for registration because they were abstract and lacked precision.

In addition, the registrar held that even if the representations at issue constituted marks, rather than mere design concepts, they lacked distinctiveness because, apart from the colours yellow and green and a standard box shape, they presented no other design component that might be perceived by consumers easily. The registrar cited the test set forth by the Supreme Court in *August Storck KG v Intuit Food Products Ltd* (Case CA 11487/03), in which the court held that a product configuration may be registered, but only if the mark has acquired distinctiveness and does not serve a functional or aesthetic role (for further details please see "[Product configuration cannot be registered based on inherent distinctiveness](#)"). The registrar also relied on case law of the ECJ to support his position that the distinctiveness of three-dimensional marks is more difficult to establish.

The registrar also noted that Mann's evidence of use of the marks related to use made in combination with the words 'Mann filter', which, in his opinion, were the dominant feature of the packaging. Therefore, the registrar held that Mann had failed to show that:

- the public identified the packaging of the goods as originating from Mann merely through the colours yellow and green; and
- the marks had acquired distinctiveness.

Finally, the registrar held that, under Section 16 of the Ordinance, the fact that the mark had been registered in another country was irrelevant (regardless of the fact that the foreign registration defined the proportion of the colours yellow and green).

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