

Provisional text

ADDITIONAL OPINION OF ADVOCATE GENERAL  
SZPUNAR  
delivered on 6 February 2018 (1)

**Case C-163/16**

**Christian Louboutin,  
Christian Louboutin SAS**  
v  
**Van Haren Schoenen BV**

(Request for a preliminary ruling from the Rechtbank Den Haag (District Court, The Hague, Netherlands))

(Reopening of the oral procedure — Reference for a preliminary ruling — Trade marks — Refusal of registration or invalidity — Shape — Concept — Three-dimensional properties of the goods — Colour)

## **I. Introduction**

1. In this case, the Rechtbank Den Haag (District Court, The Hague, Netherlands) asks the Court to rule on the interpretation of Article 3(1)(e)(iii) of Directive 2008/95/EC. (2)
2. On 28 February 2017, the Court decided to refer the case to the Ninth Chamber. A hearing was held on 6 April 2017. I delivered my first Opinion in this case on 22 June 2017.
3. On 13 September 2017, pursuant to Article 60(3) of the Court's Rules of Procedure, the Ninth Chamber decided to refer the case to the Court for the purposes of its reassignment to a formation composed of a greater number of judges. The Court then reassigned the case to the Grand Chamber.
4. By order of 12 October 2017, *Louboutin and Christian Louboutin* (C-163/16, not published, EU:C:2017:765), the Court decided to reopen the oral procedure and requested the interested parties to attend a new hearing.

## **II. Legal context**

### **A. EU law**

5. Article 3 of Directive 2008/95, entitled ‘Grounds for refusal or invalidity’, provides in paragraph (1) (b) and (e)(iii):

‘1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

...

(b) trade marks which are devoid of any distinctive character;

...

(e) signs which consist exclusively of:

...

(iii) the shape which gives substantial value to the goods;

...’

### ***B. The Benelux Convention***

6. Trade mark law in the Netherlands is governed by the Benelux Convention on intellectual property (trade marks and designs), signed in the Hague on 25 February 2005 by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands (‘the Benelux Convention’).

7. Article 2.1 of the Benelux Convention, headed ‘Signs capable of constituting a Benelux trade mark’, provides inter alia that, ‘nevertheless, signs consisting exclusively of the shape which results from the nature of the goods themselves, which gives substantial value to the goods, or which is necessary to obtain a technical result shall not be regarded as trade marks’.

### **III. Procedure before the Court**

8. In response to the request made to the interested parties mentioned in Article 23 of the Statute of the Court of Justice of the European Union, Mr Christian Louboutin and Christian Louboutin SAS (together, ‘Louboutin’), Van Haren Schoenen BV (‘Van Haren’), the German, French and United Kingdom Governments, and the European Commission presented their observations at the hearing held on 14 November 2017. (3) At this stage of the procedure, the interested parties had a second opportunity to present oral argument on the question referred for a preliminary ruling, which reads as follows: ‘Is the notion of “shape” within the meaning of Article 3(1)(e)(iii) of Directive 2008/95 ... limited to the three-dimensional properties of the goods, such as their contours, measurements and volume (expressed three-dimensionally), or does it include other (non-three dimensional) properties of the goods, such as their colour?’

### **IV. Analysis**

#### ***A. Summary of the interpretation proposed in my first Opinion and the subject matter of this Opinion***

9. In my first Opinion, I conducted an analysis which led me to take the view that a sign combining colour and shape is potentially caught by the prohibition contained in Article 3(1)(e)(iii) of Directive 2008/95. (4)

10. I therefore suggested that the Court should answer the question referred by the national court for a preliminary ruling to the effect that Article 3(1)(e)(iii) of Directive 2008/95 is to be interpreted as being

capable of applying to a sign consisting of the shape of a product and seeking protection for a certain colour.

11. In the alternative, in points 28 to 41 of my first Opinion, I set out my thoughts on the classification of the mark at issue. I found that the mark at issue should be equated with a sign consisting of the shape of the goods and seeking protection for a colour in relation to that shape, rather than one consisting of a colour per se.

12. However, as I had already observed in point 31 of my first Opinion, I take the view that the classification of the mark at issue is a factual assessment to be made, in the present case, by the referring court.

13. The same goes for the answer to be given to the question whether the red colour of the sole gives substantial value to the goods. It appears to me that the referring court's position is clear on that point, and that it is proceeding on the assumption that that question must be answered in the affirmative.

14. Nevertheless, in points 70 to 72 of my first Opinion, I stated in my proposed answer to the question referred for a preliminary ruling that the analysis which seeks to establish whether the shape in question gives substantial value to the goods within the meaning of Article 3(1)(e)(iii) of Directive 2008/95 — and, therefore, whether or not that provision applies in the present case — relates exclusively to the intrinsic value of the shape and must take no account of the attractiveness of the goods flowing from the reputation of the trade mark or its proprietor. Taking that as my starting point, the second part of my proposed answer to the question referred for a preliminary ruling reads as follows: ‘The concept of a shape which “gives substantial value” to the goods, within the meaning of that provision, relates only to the intrinsic value of the shape, and does not permit the reputation of the mark or its proprietor to be taken into account.’

15. In this Opinion, I will address the matters raised at the hearing held on 14 November 2017, so that the analysis contained in my first Opinion will be supplemented by considerations on the various points of view of the interested parties.

16. With that in mind, I will begin by expanding upon my considerations concerning the classification of the mark at issue in the light of the views expressed by the interested parties at the hearing on 14 November 2017. I will then consider the impact of Implementing Regulation (EU) 2017/1431, (5) which concerns inter alia the concept of a ‘position mark’, on the analysis contained in my first Opinion regarding the classification of the mark at issue. I will go on to make some supplementary remarks on the interpretation of Article 3(1)(e)(iii) of Directive 2008/95 in the context, first, of the relationship between that directive and Directive (EU) 2015/2436 (6) and, second, of the rationale of Article 3(3)(e)(iii) of Directive 2008/95. Finally, I will consider the consequences of the solution with which I had disagreed in my first Opinion, but which was advocated by several interested parties at the most recent hearing, namely that the interest in keeping certain characteristics of goods in the public domain be taken into account as part of the examination of distinctive character.

### ***B. Additional considerations concerning the classification of the mark at issue***

17. As I have just briefly summarised above, in my first Opinion I was inclined to classify the mark at issue as a sign consisting of the shape of the goods and seeking protection for a colour in relation to that shape, rather than as a colour mark. (7)

18. Having heard the submissions of the interested parties at the hearing on 14 November 2017, I am even less inclined to classify the mark at issue as one consisting of a colour per se.

19. In response to a question put by the Court at the hearing on 14 November 2017, Louboutin expressed that view, arguing that the mark at issue is a sign which could be described as follows: first, the sole is spatially delimited by lines which allow it to be drawn and that is delimited by the colour red, and, secondly, the shape of the sole matches the spatial delimitation of the colour red. Thus, according to the

proprietor of the mark at issue, the colour delimits the shape and — in what appears to me to be a natural consequence of that first finding — that shape matches the spatial delimitation of the colour.

20. It therefore appears to me that, in the present case, the shape is not wholly abstract or of negligible importance, which could justify the finding that the mark at issue seeks protection for a certain colour per se, without any spatial delimitation. It does not matter that the shape of the sole may vary depending on the different shoe designs. The focus remains a particular shape of the sole, not a different part of the shoe. In this context, regard must be had, first, to the principle that a trade mark must be considered as a whole and, second, to the fact that the protection enjoyed by the trade mark proprietor covers not only those signs which are identical to the sign for which registration is sought but also those which are similar to that sign.

21. In addition, I doubt that the colour red can perform the essential function of a trade mark and identify its proprietor where that colour is used out of context, that is to say separately from the shape of the sole. In any event, I do not believe that that was the effect sought by the proprietor in filing the application for registration of the mark at issue.

22. In conclusion, in the light of the considerations contained in points 29 to 41 of my first Opinion and the foregoing considerations, it is my view that the mark at issue should be equated with a sign consisting of the shape of the goods and seeking protection for a colour in relation to that shape, rather than as a trade mark consisting of a colour per se.

### ***C. Additional considerations concerning the applicability of Article 3(1)(e) of Directive 2008/95 to signs consisting of the shape of the goods and a certain colour***

#### ***1. Impact of the classification of a trade mark as a ‘position mark’ within the meaning of Implementing Regulation 2017/1431 on the applicability of Article 3(1)(e)(iii) of Directive 2008/95***

23. In point 32 of my first Opinion, I noted that Directive 2008/95 and the case-law of the Court do not attach any legal consequences to the classification of a trade mark as a ‘position mark’. The German Government shared that view at the hearing on 14 November 2017. In addition, as I also stated in point 32 of my first Opinion, classification as a ‘position mark’ does not, of itself, prevent the same trade mark from consisting of the shape of the goods and, therefore, from being potentially caught by the prohibition contained in Article 3(1)(e)(iii) of Directive 2008/95, given that the latter category — namely trade marks consisting of the shape of the goods — also encompasses signs representing a part or an element of the goods in question.

24. At the hearing on 14 November 2017, Louboutin submitted that Article 3(3)(d) of Implementing Regulation 2017/1431 defines a position mark by setting out the way in which it must be represented on the goods. In Louboutin’s view, the mark at issue satisfies the criteria laid down in that definition.

25. In the same vein, mirroring the view taken by several interested parties before the reopening of the oral procedure, the German, French and United Kingdom Governments and the Commission argued at the hearing on 14 November 2017 that the mark at issue must be classified as a position mark. Only the French Government made explicit reference to Implementing Regulation 2017/1431.

26. However, the arguments based on Implementing Regulation 2017/1431 are, in my view, incapable of calling into question the considerations reproduced in point 23 of this Opinion. (8)

27. Implementing Regulation 2017/1431 applies with effect from 1 October 2017 and supplements the EU trade mark system based on Regulation (EC) No 207/2009, (9) which was replaced with effect from 1 October 2017 by Regulation (EU) 2017/1001. (10) In the meantime, Regulation No 207/2009 has been amended by Regulation (EU) No 2015/2424, (11) which entered into force on 23 March 2016. Article 7(1)(e)(iii) of that first regulation, which reproduces the wording of Article 3(1)(e)(iii) of Directive 2008/95, was amended to the effect that signs which consist exclusively of the ‘shape, or another characteristic, which gives substantial value to the goods’ (12) are not to be registered. (13)

28. It follows that Article 3(3)(d) of Implementing Regulation 2017/1431, which relates to ‘position marks’, was incorporated into the EU trade mark system that previously accepted that there is no need for the sign to consist of the ‘shape’ to be caught by the ground for refusal or invalidity corresponding to the ground laid down in Article 3(1)(e)(iii) of Directive 2008/95.

29. Accordingly, Article 3(3)(d) of Implementing Regulation 2017/1431 was not conceived as a ‘definition’ of the type of trade mark which, in any case, is incapable of being caught by the ground for refusal or invalidity corresponding to the ground laid down in Article 3(1)(e)(iii) of Directive 2008/95. It is now clear that, under the EU trade mark system, the distinction between the ‘shape’ and the ‘other characteristics’ is not relevant in the context of that ground for refusal or invalidity.

30. For the same reason, it cannot be submitted on the basis of Article 3(3)(d) of Implementing Regulation 2017/1431 that, in any event, a position mark is entirely independent of the shape of the goods, particularly in the case of a sign representing a part or an element of the goods in question.

31. It is true that Implementing Regulation 2017/1431 distinguishes between, on the one hand, a ‘position mark’, to which reference is made in Article 3(3)(d), and, on the other, a ‘shape mark’ and a ‘colour mark’, which are mentioned, respectively, in Article 3(3)(c) and (f) of that regulation.

32. That said, I note that Article 3(3)(e)(iii) of Directive 2008/95 refers not to ‘shape marks’ but to signs which consist exclusively of the shape which gives substantial value to the goods. (14)

33. Furthermore, Article 3(3) of Implementing Regulation 2017/1431 contains neither an exhaustive list of the types of trade marks that may be registered nor definitions of the trade mark types to which that provision refers. First, Article 3(4) of that regulation provides for the possibility of filing an application for registration concerning a trade mark which ‘is not covered by any of the types listed in paragraph 3’ of that article. Second, the latter paragraph describes merely how a trade mark must be represented ‘where the application concerns any of the trade mark types listed in points (a) to (j)’ of Article 3(3) of Implementing Regulation 2017/1431. It appears to me that Article 3(3) of that regulation simply specifies how the most commonly used trade mark types are to be represented as part of the registration procedure. Thus, signs which are hybrids of several trade mark types mentioned in Article 3(3) of Implementing Regulation 2017/1431 are compatible with the EU trade mark system. In this context, I would point out that the fact that the mark at issue was registered as a figurative mark does not prevent its classification as a ‘trade mark which consists of the shape of the goods’.

34. In the light of the foregoing and the considerations contained in point 32 of my first Opinion, I take the view that the introduction of the concept of a ‘position’ mark in Article 3(3)(d) of Implementing Regulation 2017/1431 into the EU legal system is not such as to qualify my considerations concerning the applicability of Article 3(1)(e)(iii) of Directive 2008/95 to a sign consisting of the shape of the goods and seeking protection for a certain colour.

## **2. *Scope of Article 3(1)(e)(iii) of Directive 2008/95 as compared with Article 4(1)(e)(iii) of Directive 2015/2436***

35. Directive 2008/95 will be replaced by Directive 2015/2436; the deadline for transposition of the latter directive is 14 January 2019. Article 4(1)(e)(iii) of Directive 2015/2436, which corresponds to the ground for refusal or invalidity laid down in Article 3(1)(e)(iii) of Directive 2008/95, refers to signs which consist exclusively of ‘the shape, or another characteristic, [of the goods] which gives substantial value to the goods’.

36. In my first Opinion, I considered whether the fact that the legislature had not deemed it necessary to lay down any transitional provisions to settle potential conflicts between the two successive directives could indicate that it had considered the law relating to such signs to be the same under both of those directives. (15)

37. In the view of the United Kingdom Government, that lack of transitional provisions cannot form the basis for any conclusion relating to retroactive effect. That government observed that there were no transitional provisions relating to the provisions amending other aspects of trade mark law, inter alia Article 14 of Directive 2015/2436, which limits to natural persons the ‘own name’ defence and allows a person to use his name and address without infringing a trade mark, whereas — pursuant to Article 6 of Directive 2008/95 — that defence is also open to legal persons.

38. However, it does not appear to me to be entirely justified to place the amendments made to Article 3(1)(e) of Directive 2008/95 on a par with those relating to the ‘own name’ defence which is covered by Article 6 of that directive and Article 14 of Directive 2015/2436.

39. The ‘own name’ defence is a limitation on the exclusive rights of the trade mark proprietor, who is entitled to prohibit any third party from using a sign identical to the trade mark. The amendments introduced by Directive 2015/2436 do not in fact limit the trade mark proprietor’s rights. On the contrary, that directive strengthens the trade mark proprietor’s monopoly and, at the same time, restricts the rights of third parties, with the result that undertakings and companies can now no longer rely on the ‘own name’ defence.

40. In any event, that fluctuation in the effects of the trade mark cannot interfere with the validity of the trade mark itself. The body of trade marks constituted by those which have already been registered and those which can still be registered therefore remains intact under both the former system and the new system. It does not matter under which system a trade mark is registered; the new system will change only the position of third parties who are not natural persons.

41. However, that logic could be difficult to apply having regard to the grounds for refusal or invalidity contained in Article 3(1)(e) of Directive 2008/95. It is within that context that consideration must be given to the impact of the amendment of the scope of the ground for refusal or invalidity on EU trade mark law upon expiry of the deadline for transposition of Directive 2015/2436. Could the multitude of applications for the declaration of the invalidity of trade marks be anticipated once the deadline for transposition of the new directive has passed? Furthermore, if the view is taken that trade marks registered under the former system cannot be caught by the prohibitions laid down in the article of Directive 2015/2436 corresponding to Article 3(1)(e) of Directive 2008/95, could this prompt the mass filing of trade mark applications prior to that date?

42. Leaving aside such considerations, I am of the view that the lack of any transitional provisions in Directive 2015/2436 is merely an indication arguing in favour of Article 3(1)(e)(iii) of Directive 2008/95 being interpreted to the effect that that provision applies to signs consisting of the shape of the goods which seek protection for a certain colour. It is first and foremost the rationale underlying that provision which forms the central argument of my analysis. (16)

### ***3. Rationale underlying Article 3(1)(e)(iii) of Directive 2008/95***

43. At the hearing, a number of interested parties considered the rationale underlying the ground for refusal or invalidity laid down in Article 3(1)(e)(iii) of Directive 2008/95.

44. The German and United Kingdom Governments and Van Haren submitted that that provision prevents the misuse of trade marks which may lead to the creation of anticompetitive monopolies.

45. Thus, the German Government favours the view that Article 3(1)(e) of Directive 2008/95 prevents the creation of a monopoly over the shapes of goods which — on account of their characteristics — must be kept within the public domain on a lasting basis so that they may be used freely by all market participants. In addition, that government appears to take the view that the aesthetic characteristics referred to in Article 3(1)(e)(iii) of Directive 2008/95 have their own dynamic in that their appeal is likely to vary in line with fashion trends.

46. Along the same lines, Louboutin appears to argue that, within the aesthetic field, there is no need to keep the essential characteristics of goods available on a lasting basis under trade mark law because such characteristics do not have a sufficiently long economic lifetime to justify such protection.

47. I am sympathetic to the view put forward at the hearing by Louboutin and the German Government that the appeal of aesthetic characteristics has its own dynamic, and that the characteristics sought and valued by the public may vary in line with fashion trends. That inherent dynamic of the characteristics which give substantial value to goods does not, in my view, prevent Article 3(1)(e)(iii) of Directive 2008/95 being interpreted as meaning that it applies in the case of a sign consisting of the shape of the goods and which seeks protection for a certain colour.

48. In my Opinion in *Hauck*, (17) I stated that the assessment to determine whether the shape at issue ‘gives substantial value to the goods’ by virtue, for example, of its aesthetic characteristics necessarily involves account being taken of the average consumer’s perspective. However, the way in which the consumer perceives the shape in question is not a decisive element in that assessment. In order to achieve the objective laid down in Article 3(1)(e)(iii) of Directive 2008/95, that is to ensure that shapes which are attractive to the public remain available to market participants, account must be taken both of the perception of the sign at issue by the relevant public and the economic effects which will result from reserving that sign to a single undertaking.

49. In the alternative, I wonder whether — contrary to Louboutin’s submission — the importance of the public’s perception in the context of applying Article 3(1)(e)(iii) of Directive 2008/95 would argue in favour of a teleological interpretation of that provision. In that case, the more flexible interpretation of the concept of ‘shape’ within the meaning of that article would prevail over its literal interpretation.

50. Article 3(1)(e)(i) and (ii) of Directive 2008/95 relates to characteristics which have been pre-determined with lasting effect, namely those which exist by virtue of the goods themselves because, respectively, they ‘result from the nature of the goods themselves’ or are ‘necessary to obtain a technical result’. Accordingly, with regard — for example — to the latter characteristics, I note that the public’s perception of the goods is incapable of altering that state of affairs, even if a technical result can be achieved by other shapes. (18)

51. A trade mark can be refused or declared invalid on the basis of Article 3(1)(e)(iii) of Directive 2008/95 where its characteristics give substantial value to the goods. That provision therefore allows a characteristic to remain available for all market participants over the period during which that characteristic has a particular effect on the value of the goods. From the point at which that is no longer the case — inter alia, as certain interested parties allege, because the public’s preferences have changed and that characteristic is no longer sought and valued by the public —, the trade mark at issue would no longer potentially be caught by the prohibition laid down in Article 3(1)(e)(iii) of Directive 2008/95.

52. Under those circumstances, it would follow that — unlike the grounds for refusal or invalidity laid down in Article 3(1)(e)(i) and (ii) of Directive 2008/95 — Article 3(1)(e)(iii) of that directive would relate to characteristics which are dependent on external factors.

53. Thus, if the answer to the question of which characteristics give ‘substantial value to the goods’ were to depend on external factors, inter alia the perception of the public, it would be inconsistent — in the case of a sign which attracts the particular attention of the public — to rule out the applicability of that provision to a sign consisting of the shape of the goods and which seeks protection for a certain colour. Indeed, the deciding factor with regard to the public’s perception is not the distinction between shape, colour or position marks but rather the identification of the origin of the goods based on the overall impression of a sign.

54. In addition, the fact that the characteristics giving substantial value to the goods are, in part, determined by the public’s perception does not, in my view, mean that account may be taken of the reputation of the trade mark or its proprietor as part of the assessment to determine whether the shape at

issue ‘gives substantial value to the goods’ within the meaning of Article 3(1)(e)(iii) of Directive 2008/95. (19) Indeed, if the concept of a ‘shape [giving] substantial value to the goods’ were to be acknowledged as being, even in part, determined by characteristics which are perceived as attractive by the public, it would then be necessary to exclude the characteristics linked to the reputation of the trade mark or its proprietor, in order to prevent the appeal created by that reputation being attributed to a shape which, taken on its own, would not be attractive. Otherwise, the ground for refusal or invalidity laid down in Article 3(1)(e)(iii) of Directive 2008/95 could be interpreted very broadly and improperly having regard to its objective, which I have noted in point 48 of this Opinion.

55. In the light of the foregoing, I take the view that the reference to the public’s perception as a factor which, among others, determines the characteristics giving substantial value to the goods argues in favour of Article 3(1)(e)(iii) of Directive 2008/95 being interpreted as meaning that that provision applies to signs consisting of the shape of the goods and seeking protection for a colour in relation to that shape.

#### ***D. Classification of the mark at issue with reference to Article 3(1)(b) of Directive 2008/95***

56. In my first Opinion, I envisaged two approaches within the context of this request for a preliminary ruling.

57. The first approach consists in taking the view that Article 3(1)(e) of Directive 2008/95 could be interpreted broadly. The second is to take account of the interest in keeping certain signs within the public domain, when considering whether a sign has distinctive character within the meaning of Article 3(1)(b) of that directive, in relation to all signs which are indissociable from an aspect of the goods in question, or indeed in relation to other categories of signs with limited availability.

58. Whilst, in my first Opinion, I expressed my preference for the first approach, at the hearing the German, French and United Kingdom Governments and the Commission appeared to support that second approach. I note that those parties unanimously proceeded on the assumption that the mark at issue must be regarded as a position mark which is not covered by Article 3(1)(e)(iii) of Directive 2008/95.

59. It is in that context that I will expand upon my first Opinion. These supplementary observations could prove useful for the referring court in the event that the Court were to take the view in its future judgment that, in the present case, Article 3(1)(e)(iii) of Directive 2008/95 cannot be applied. In any event, I am convinced that an in-depth consideration may enable the Court to analyse the question at issue in these proceedings in all its facets.

60. In points 45 and 46 of my first Opinion, I stated in that regard that it is apparent from the case-law of the Court, inter alia the judgment in *Libertel*, (20) that, in analysing the distinctive character of a sign consisting of a colour per se, it is necessary to assess whether the registration of that sign would run counter to the general interest that the availability of colours should not be unduly restricted for the other operators who offer for sale goods or services of the same type. Taking that as my starting point, I concluded that, in the case of signs which are indissociable from the appearance of the goods, their registration must be considered in the light of the same factors as underpin Article 3(1)(e) of Directive 2008/95.

61. In the judgment in *Libertel*, (21) the Court based its view concerning the assessment of the distinctive character of colour marks on the assumption that the public is capable of distinguishing only a limited number of colours because it is rarely in a position directly to compare products in various shades of colour. (22)

62. This is a fortiori the case with trade marks classified as position marks in relation to which trade mark protection is sought for a certain colour. It even seems to me that the number of colours that could in fact be applied to the sole of a shoe in order to identify its origin is even more restricted, since shades of black, grey and brown are, in practice, systematically devoid of distinctive character by virtue of their frequent use by market operators.

63. In this context, I note that, when assessing the distinctive character of a sign, account should also be taken of the case-law on three-dimensional signs, in accordance with which such signs are distinctive solely where they depart significantly from the norm or customs of the sector, since average consumers are not in the habit of making assumptions about the commercial origin of goods on the basis of signs which are indissociable from the appearance of those same goods. (23)

64. In this connection, I would point out that, in the order made in *X Technology Swiss v OHIM*, (24) the Court of Justice did not uphold one part of a ground of appeal relied on by the applicant, who took the view that, in the context of the appeal proceedings concerning the registration of a trade mark characterised by an orange colouration in the form of a hood covering the toe of each article of hosiery, the General Court incorrectly failed to distinguish between three-dimensional marks and position marks when assessing the distinctive character of the trade mark. It is in that context that the Court of Justice did not reject the General Court's findings to the effect that the decisive factor to establish whether or not a sign has distinctive character is not its classification as a figurative, three-dimensional or other mark but whether or not the sign is indistinguishable from the appearance of the goods in question. It follows that a sign seeking protection for a colour, which is indistinguishable from the appearance of the goods in question, is distinctive solely where that sign departs significantly from the norm or customs of the sector at issue.

65. Finally, I note that, unlike the ground for refusal or invalidity laid down in Article 3(1)(e)(iii) of Directive 2008/95, the ground provided for in Article 3(1)(b) of that directive, read in conjunction with Article 3(3) of the directive, is open to derogation where the sign has acquired a distinctive character following a normal process of familiarisation of the public concerned. The general interest that the availability of a characteristic sought and favoured by the public should not be restricted for other market operators, which underpins Article 3(1)(e)(iii) of Directive 2008/95, cannot therefore be ensured on a lasting basis under Article 3(1)(b) of that directive.

66. In the light of those considerations, it follows that, when analysing the distinctive character of a sign which is indissociable from the appearance of the goods in question, it is necessary to assess whether the registration of that sign would run counter to the general interest that the availability of the characteristics represented by that sign should not be unduly restricted for other operators offering for sale goods or services of the same type. However, Article 3(1)(b) of Directive 2008/95 cannot fully assume the role of Article 3(1)(e)(iii) of that directive, since it is possible to derogate from that first provision in accordance with the detailed rules laid down in Article 3(3) of that directive.

## V. Conclusion

67. In the light of the foregoing considerations and the analysis conducted in my first Opinion, I maintain my proposed answer to the question referred for a preliminary ruling by the Rechtbank Den Haag (District Court, The Hague, Netherlands), which read as follows:

Article 3(1)(e)(iii) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks is to be interpreted as being capable of applying to a sign consisting of the shape of a product and seeking protection for a certain colour. The concept of a shape which 'gives substantial value' to the goods, within the meaning of that provision, relates only to the intrinsic value of the shape, and does not permit the reputation of the mark or its proprietor to be taken into account.

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<sup>1</sup> Original language: French.

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<sup>2</sup> Directive of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

[3](#) I note that, unlike the other interested parties, the French and United Kingdom Governments did not attend the first hearing, which was held on 6 April 2017.

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[4](#) See points 49 to 66 of my first Opinion. Incidentally, I do not believe that that interpretation can be called into question by the reasoning contained in paragraph 24 of the judgment of 10 July 2014, *Apple* (C-421/13, EU:C:2014:2070), which concerns the application for registration of a sign representing the layout of a retail space. The grounds for refusal or invalidity laid down in Article 3(1)(e)(iii) of Directive 2008/95 relate to signs which consist of a shape and — in accordance with the interpretation proposed in my first Opinion — of other characteristics ‘of the goods’ (with regard to the link between the shape and the goods, see judgment of 8 April 2003, *Linde and Others* (C-53/01 to C-55/01, EU:C:2003:206, paragraph 43)). The layout of a retail space does not constitute the goods themselves but — in accordance with the considerations set out in point 107 of my Opinion in *Hauck* (C-205/13, EU:C:2014:322) — is rather a sign which physically reflects the circumstances in which a service is provided. Accordingly, it appears to me that — in the words of the judgment of 10 July 2014, *Apple* (C-421/13, EU:C:2014:2070) — Article 3(1)(e) of Directive 2008/95 was, in the present case, irrelevant because it concerned not a sign consisting of a shape or another characteristic of the goods but rather a sign reflecting those circumstances.

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[5](#) Commission Implementing Regulation of 18 May 2017 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark (OJ 2017 L 205, p. 39).

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[6](#) Directive of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ 2015 L 336, p. 1).

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[7](#) See points 29 to 41 of my first Opinion.

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[8](#) Implementing Regulation 2017/1431 concerns EU trade marks and, therefore, is not directly applicable in the present case. However, since the EU legislature is at pains to ensure complementarity between the EU trade mark system and national trade mark systems, that regulation could indicate the way in which the provisions of the directives relating to such national systems should be interpreted.

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[9](#) Council Regulation of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).

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[10](#) Regulation of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).

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[11](#) Regulation of the European Parliament and of the Council of 16 December 2015 amending Council Regulation No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

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[12](#) Emphasis added.

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[13](#) An identical provision is also contained in Regulation 2017/1001 and in Article 4(1)(e)(iii) of Directive 2015/2436, which will replace Directive 2008/95. See points 5 and 61 to 64 of my first Opinion.

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- [14](#) With regard to the applicability of Article 3(1)(e)(iii) of Directive 2008/95 to trade marks matching that description, see points 57 to 60 of my first Opinion.
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- [15](#) See point 64 of my first Opinion.
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- [16](#) See points 53 to 58 of my first Opinion.
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- [17](#) C-205/13, EU:C:2014:322, points 89 to 92.
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- [18](#) See judgment of 18 June 2002, *Philips* (C-299/99, EU:C:2002:377, paragraph 83).
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- [19](#) See points 70 to 72 of my first Opinion. See also, to that effect, Trade Mark Practice Guidelines, European Union Intellectual Property Office, Part B: Examination, Section 4: Absolute grounds for refusal, version of 23 March 2016, which may be downloaded from the page [https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/decisions\\_president/ex16-1\\_fr.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/decisions_president/ex16-1_fr.pdf), p. 86 [2.5.4 Shape or other characteristic that gives substantial value to the goods: ‘... The concept of “value” should not be interpreted as meaning “reputation”, since application of this absolute ground for refusal is justified exclusively by the effect on the value added to the goods by the shape or other characteristic and not by other factors, such as the reputation of the word mark that is also used to identify the goods in question (see, in this regard, decision of 16 January 2013, R 2520/2011-5, § 19)’. See also Kur, A., *Too Pretty to Protect? Trade Mark Law and the Enigma of Aesthetic Functionality*, Drexl, J., Hilty, R.M., Godt, L., et al., Larcier, Brussels, 2009, p. 153.
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- [20](#) Judgment of 6 May 2003 (C-104/01, EU:C:2003:244, paragraphs 53 and 54).
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- [21](#) Judgment of 6 May 2003 (C-104/01, EU:C:2003:244, paragraph 47).
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- [22](#) See judgment of 6 May 2003, *Libertel* (C-104/01, EU:C:2003:244, paragraph 47).
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- [23](#) See judgments of 7 October 2004, *Mag Instrument v OHIM* (C-136/02 P, EU:C:2004:592, paragraphs 30 and 31), and of 12 January 2006, *Deutsche SiSi-Werke v OHIM* (C-173/04 P, EU:C:2006:20, paragraphs 28 and 31).
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- [24](#) Order of 16 May 2011 (C-429/10 P, not published, EU:C:2011:307).