



Neutral Citation Number: [2017] EWCA Civ 335

Case No: A3/2016/2941

IN THE COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE
CHANCERY DIVISION (INTELLECTUAL PROPERTY)
HIS HONOUR JUDGE HACON
[2016] EWHC 1537 (Ch)

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: 10/05/2017

Before:

THE CHANCELLOR OF THE HIGH COURT
LORD JUSTICE KITCHIN
and
LORD JUSTICE FLOYD

Between:

(1) Glaxo Wellcome UK Ltd (t/a Allen & Hanburys)
(2) Glaxo Group Ltd

**Claimants/
Appellants**

- and -
Sandoz Ltd

**Defendant/
Respondent**

Simon Malynicz QC and Alaina Newnes (instructed by Stephenson Harwood LLP)
for the Appellants
Martin Howe QC and Iona Berkeley (instructed by White & Case LLP)
for the Respondent

Hearing date: 9 March 2017

Approved Judgment

Lord Justice Kitchen:

Introduction

1. This appeal concerns the validity of EU trade mark 3890126 (“the Trade Mark”) and, specifically, whether it is invalid on the ground that the subject matter of the registration is not clear or precise and is not such that it will be perceived unambiguously and uniformly and so contravenes Article 4 of Council Regulation (EC) 207/2009 on the EU trade mark (the “EUTMR”).
2. The Trade Mark is registered in respect of inhalers. The certificate bears the INID code 558. INID is an acronym for “Internationally agreed Numbers for the Identification of (bibliographic) Data”. The INID system was developed by the World Intellectual Property Organisation and has been adopted by the European Intellectual Property Office (“EUIPO”), formerly the Office for Harmonization in the Internal Market (“OHIM”). It provides a series of codes which allow proprietors more easily to specify various characteristics of trade marks and third parties more easily to understand them. If the code 558 is used in relation to a trade mark registration it denotes that the mark consists exclusively of one or more colours.
3. The certificate also bears the following pictorial representation of the Trade Mark:



4. Underneath this representation there appears a description of the Trade Mark in different languages. The description in English reads:

“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.”
5. The Trade Mark is owned by the second claimant and it and the first claimant (collectively “Glaxo”) are part of the well-known GlaxoSmithKline group of companies (“GSK”) which have their headquarters in Brentford in Middlesex.
6. For very many years GSK have made and sold throughout the world a pharmaceutical product comprising fluticasone propionate and salmeterol for the treatment of asthma and chronic obstructive pulmonary disease. There can be no doubt that this product has been very successful indeed. The value of sales made globally since launch amounts to in excess of \$61 billion. In the UK the product is sold by Glaxo under the brand name Seretide and it has achieved sales with a value in excess of £4.3 billion.

7. Seretide is sold by Glaxo in the UK in two product forms. One is a dry powder or disc inhaler which is sold under the brand names Seretide and Accuhaler. This has the same appearance as the pictorial representation of the Trade Mark save that it also bears a largely white circular sticker in the centre of the disc bearing the words ‘Seretide’ and ‘Accuhaler’ and various product details. The other is a metered dose inhaler which has a ‘boot shape’ and is sold under the brand names Seretide and Evohaler. It looks like this:



8. On 7 December 2015 Glaxo issued these proceedings against the defendant (“Sandoz”) asserting, inter alia, that it had infringed the Trade Mark by selling a generic version of Seretide called AirFluSal. Glaxo’s complaint was directed at the appearance of AirFluSal which is shown below:



9. Sandoz responded in its defence and counterclaim that the Trade Mark was invalid because it covered a multitude of different forms and so was not capable of being represented graphically as required by Article 4 of the EUTMR. It asserted that this was confirmed by the various allegations of infringement made by the second claimant in other jurisdictions and by the contentions advanced by the second claimant in ongoing proceedings in the EUIPO.
10. On 19 February 2016 Sandoz applied for summary judgment on its claim that the Trade Mark was invalid. That application came on for hearing on 15 June 2016 before HH Judge Hacon sitting as a judge of the High Court. On 28 June 2016 he acceded to the application and held and declared that the Trade Mark was indeed invalid. He considered that the Trade Mark did not satisfy Article 4 of the EUTMR because it was not sufficiently precise and uniform; nor was it sufficiently clear and unambiguous. He refused Glaxo’s application for permission to appeal.
11. Glaxo now appeal to this court with permission granted by Floyd LJ on the papers by order dated 11 November 2016. In broad outline, they contend that the judge failed properly to interpret the Trade Mark and that, had he done so, he would or ought to have found that it has only one possible meaning, namely that it comprises the dark and light purple colours in the specific proportions and arrangement shown in the pictorial

representation of the mark on the certificate. Further, Glaxo continue, the wording on the certificate merely describes the mark in general terms and specifies the shades of the purple colours which it comprises. It does not broaden the scope of the mark or render it uncertain in any way.

The legal framework

12. Article 4 of the EUTMR as amended by Regulation (EU) 2015/2424 corresponds to Article 2 of Directive 2008/95/EC (“the Directive”) and presently reads as follows:

“Signs of which an EU trade mark may consist

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.”

13. As I shall explain, one of the requirements of Article 4 as interpreted by the Court of Justice of the European Union (“the CJEU” or “the Court”) is that the sign sought to be registered as an EU trade mark is capable of being represented on the register of EU trade marks (“the Register”) in a clear and precise way which enables the relevant authorities and the public to determine the precise subject matter of the protection afforded to its proprietor. This is reflected in the replacement of Article 4 which will apply from 1 October 2017. It will read:

“Signs of which an EU trade mark may consist

An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the Register of European Union trade marks, (“the Register”), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”

14. Article 7 of the EUTMR addresses the absolute grounds for refusal of an application to register a sign as an EU trade mark and provides in material part:

“1. The following shall not be registered:

(a) signs which do not conform to the requirements of Article 4;”

15. Article 52 deals with the absolute grounds for invalidity and reads in material part:

“1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where the EU trade mark has been registered contrary to the provisions of Article 7;”

16. I must also refer to the relevant rules implementing the EUTMR. These are contained in Commission Regulation (EC) 2868/95 as amended by Regulation (EU) 2015/2424 (as so amended, “the Implementing Regulation”). Rule 1(1)(d) says that an application for an EU trade mark must contain a representation of the mark in accordance with Rule 3.

17. Rule 3(1) deals with applications for the registration of conventional word marks and says, so far as material:

“(1) If the applicant does not wish to claim any special graphic feature or colour, the mark shall be reproduced in normal script as for example, by typing the letters, numerals and signs in the application ”

18. Rule 3(2) addresses applications for the registration of marks other than those referred to in paragraph (1). It therefore applies to applications for the registration of marks such as the Trade Mark and lays down certain requirements that the representation of the mark must satisfy. It says, so far as relevant:

“(2) In cases other than those referred to in paragraph 1 and save where the application is filed by electronic means, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears.... Where it is not obvious, the correct position of the mark shall be indicated by adding the word ‘top’ to each reproduction”

19. Rule 3(3) reads:

“(3) In cases to which paragraph 2 applies, the application shall contain an indication to that effect. The application may contain a description of the mark.”

20. Rule 3(4) deals with applications for registration of three-dimensional marks and Rule 3(5) deals with applications for registration of marks in colour. It says:

“(5) Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a reference to a recognized colour code may be added.”

21. A convenient starting point for any consideration of the registrability as a trade mark of a sign comprising one or more colours is the decision of the CJEU in Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793, [2004] Ch 83. The case concerned an application by Libertel to register the colour orange as a trade mark

in respect of various telecommunications goods and services. In the space for reproducing the trade mark, the application form contained an orange rectangle and, in the space for describing the trade mark, the word “orange”, without reference to any colour code. The defendant refused the application. An appeal to the Regional Court of Appeal in The Hague was dismissed. On further appeal, the Hoge Raad referred a number of questions to the CJEU relating to whether, and if so in what circumstances, a colour *per se*, not spatially defined, was capable of possessing distinctive character. In order to answer the first of those questions the Court considered it necessary to determine whether a colour *per se* was capable of constituting a trade mark for the purposes of Article 2 of the Directive. It explained (at [23]) that in order to do so it must satisfy three conditions. First, it must be a sign. Secondly, it must be capable of graphical representation. Thirdly, it must be capable of distinguishing the goods or services of one undertaking from those of another. As for the second requirement, the Court emphasised that the graphic representation must enable the sign to be represented visually so that it is clear and can be identified precisely:

“28 Furthermore, as the court has held, a graphic representation within the meaning of article 2 of the Directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified: *Sieckmann v Deutsches Patent-und Markenamt* (Case C-273/00) [2003] Ch 487, 509, para 46.

29 In order to fulfil its function, the graphic representation within the meaning of article 2 of the Directive must be clear, precise, self-contained, easily accessible, intelligible, durable and objective: *Sieckmann*, paras 47-55.

30 In this case, the query referred to the court relates to an application to register a colour *per se*, represented by a sample of the colour on a flat surface, a description in words of the colour and/or an internationally recognised colour identification code.

31 A mere sample of a colour does not satisfy the requirements set out in paras 28 and 29 of this judgment.

32 In particular, a sample of a colour may deteriorate with time. There may be certain media on which it is possible to reproduce a colour in permanent form. However with other media, including paper, the exact shade of the colour cannot be protected from the effects of the passage of time. In those cases, the filing of a sample of a colour does not possess the durability required by article 2 of the Directive: see *Sieckmann*, para 53.

33 It follows that filing a sample of a colour does not *per se* constitute a graphic representation within the meaning of article 2 of the Directive.

34 On the other hand, a verbal description of a colour, in so far as it is composed of words which themselves are made up of

letters, does constitute a graphic representation of the colour: see *Sieckmann*, p 511, para 70.

35 A description in words of the colour will not necessarily satisfy the conditions set out in paras 28 and 29 of this judgment in every instance. That is a question which must be evaluated in the light of the circumstances of each individual case.

36 A sample of a colour, combined with a description in words of that colour, may therefore constitute a graphic representation within the meaning of article 2 of the Directive, provided that the description is clear, precise, self-contained, easily accessible, intelligible, and objective.

37 For the same reasons as those set out at para 34 of this judgment, the designation of a colour using an internationally recognised identification code may be considered to constitute a graphic representation. Such codes are deemed to be precise and stable.

38 Where a sample of a colour, together with a description in words, does not satisfy the conditions laid down in article 2 of the Directive in order for it to constitute a graphic representation because, inter alia, it lacks precision or durability, that deficiency may, depending on the facts, be remedied by adding a colour designation from an internationally recognised identification code.”

22. The Court therefore answered the first of the referred questions in these terms:

“68 The reply to the first question referred must therefore be that a colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of article 3(1)(b) and article 3(3) of the Directive, provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.”

23. Just over one year later, the CJEU developed this reasoning further in Case C-49/02 *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, [2004] ETMR 99 in connection with a dispute concerning the registrability as a trade mark of the colours blue and yellow. Heidelberg, the applicant, provided, in the section of the application headed “reproduction of the mark”, a rectangular piece of paper, the upper part of which was blue and the lower part yellow. It was accompanied by the following description:

“The trade mark applied for consists of the applicant's corporate colours which are used in every conceivable form, in particular on packaging and labels.

The specification of the colours is:

RAL 5015/HKS 47 — blue

RAL 1016/HKS 3 — yellow.”

24. The German Patent Office rejected the application on the ground that the trade mark applied for lacked any distinctive character. On appeal, the Bundespatentgericht referred a series of questions to the CJEU asking, in substance, whether, and if so under what conditions, colours or combinations of colours designated in the abstract and without contours were capable of constituting a trade mark.
25. In answering these questions, the Court explained (at [24]) that it was first necessary to establish whether, in the context in which they were used, the colours or combinations of colours the subject of the application in fact represented a sign within the meaning of Article 2 of the Directive. This was necessary to prevent the abuse of trade mark law by a trader in order to obtain an unfair advantage. The Court then reiterated (at [25]) that a graphic representation in terms of Article 2 must enable the sign to be represented visually, particularly by images, lines or characters, so that it can be precisely identified. There followed an exposition of why this interpretation was necessary for the proper working of the trade mark system:

“27 The function of the requirement of graphic representation is in particular to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor.

28 The entry of the mark in a public register has the aim of making it accessible to the competent authorities and to the public, particularly to economic operators.

29 On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and the publication and maintenance of an appropriate and precise register of trade marks.

30 On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties.

31 In those circumstances, in order to fulfil its role as a registered trade mark, a sign must always be perceived unambiguously and uniformly, so that the function of the mark as an indication of origin is guaranteed. In the light of the duration of a mark's registration and the fact that, as the Directive provides, it can be renewed for varying periods, the representation must also be durable.

32 It follows from the above that a graphic representation for the purpose of Art.2 of the Directive must be, in particular, precise and durable.”

26. Against that background the Court offered this guidance as to the requirements of the graphic representation:

“33 Accordingly, a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way.

34 The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours “in every conceivable form”, as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Art.2 of the Directive, as construed in paras [25] to [32] of this judgment.

35 Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.

36 As regards the manner in which each of the colours concerned is represented, it is clear from paras [33], [34], [37], [38] and [68] of *Libertel* that a sample of the colour concerned, accompanied by a designation using an internationally recognised identification code, may constitute a graphic representation for the purposes of Art.2 of the Directive.”

27. The Court therefore answered the questions in these terms, so far as relevant:

“42 In light of the above, the answer to the questions must be 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 Art.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. ...”

28. The need for specificity to prevent a trade mark proprietor gaining an unfair advantage was emphasised by the CJEU in Case C-321/03 *Dyson v Registrar of Trade Marks* [2007] ECR I-687, [2007] RPC 27. The case concerned an application by Dyson to register two trade marks, each of which was described in these terms: “[t]he mark consists of a transparent bin ... forming part of the external surface of a vacuum cleaner as shown in the representation”. A picture of one or other of the two bagless vacuum cleaners manufactured by Dyson was attached to each description. The application was refused by the Registrar and subsequently that refusal was upheld by a hearing officer. On appeal, the High Court sought a preliminary ruling from the CJEU on two questions asking, in substance, under what conditions a sign could acquire distinctive character where the applicant had had a de facto monopoly in the product bearing the sign.
29. The Court considered that in order to answer these questions it needed first to consider whether the subject matter of the application constituted a sign within the meaning of Article 2 of the Directive. It was a matter of common ground that the subject matter of the application was not a particular collecting bin but rather all of the conceivable shapes of such a collecting bin. The representations were merely examples of the subject matter of the application. The Court then reasoned:

“38 Given the exclusivity inherent in trade mark right, the holder of a trade mark relating to such a non-specific subject matter would obtain an unfair competitive advantage, contrary to the purpose pursued by Art.2 of the Directive, since it would be entitled to prevent its competitors from marketing vacuum cleaners having any kind of transparent collecting bin on their external surface, irrespective of its shape. ”

39 It follows that the subject matter of the application at issue in the main proceedings is, in actual fact, a mere property of the product concerned and does not therefore constitute a “sign” within the meaning of Art.2 of the Directive (see, to that effect, *Libertel* at [27]).

40 Accordingly, the answer to be given to the national court must be that Art.2 of the Directive is to be interpreted as meaning that the subject matter of an application for trade mark registration, such as that lodged in the main proceedings, which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, is not a “sign” within the meaning of that provision and therefore is not capable of constituting a trade mark within the meaning thereof.”
30. Each of these three decisions, together with the decision of the CJEU in case C-273/00 *Sieckmann v Deutsches Patent- und Markenamt* [2002] ECR I-11754, [2003] RPC 38, were considered by the Court of Appeal in *Société des Produits Nestlé SA v Cadbury UK Ltd* [2014] RPC 7. This appeal arose from an application by Cadbury to register as

a trade mark the colour purple in respect of various goods in Class 30. There appeared on the form of application a purple block of rectangular shape and this description:

“The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods.”

31. The one question for the Court of Appeal was whether the subject matter of the application was a sign and was graphically represented within the meaning of Article 2 of the Directive. The hearing officer and Birss J on appeal answered this question in the affirmative. The Court of Appeal took the contrary view. Sir John Mummery, with whom Sir Timothy Lloyd and Lewison LJ agreed, first set out some principles which he considered relevant to the issue before him and which he derived from the decisions of the CJEU to which I have referred:

“15 Some general points relating to the requirements of art.2 of the directive, which are relevant to this case, can be picked out of the judgments:

The conditions

(1) An application to register a trade mark must satisfy three conditions for the purposes of Article 2:

- (i) there must be a sign;
- (ii) it must be capable of graphical representation;
- (iii) it must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Purpose

(2) The purpose of the requirements is to prevent abuse of trade mark law in order to obtain an unfair competitive advantage.

Identification

(3) Identification requirements for entry of a trade mark on the public register of trade marks include clarity, intelligibility, specificity, precision, accessibility, uniformity, self-containment and objectivity.

Multitude of forms

(4) The identification requirements are not satisfied, if the mark could take on a multitude of different appearances, which would create problems for registration of the mark and give an unfair competitive advantage over competitors.

Colour without a message

(5) Colours are normally a simple property of things, or a means of decorating things. They are not normally capable of being a sign. A sign conveys a message. The sign is capable of being registered as a trade mark, if the message is about the source of goods or services.

Colour as a sign conveying a message

(6) Depending on the facts and circumstances of the case, colours, or combinations of colours, designated in the abstract and without contours and used in relation to a product or service are capable of being “a sign.”

Graphic representation of colour

(7) As for the second condition of graphical representation, in a mark consisting of two or more colours designated in the abstract and without contours, qualities of precision and uniformity are required. The colours must be arranged by associating them in a predetermined and uniform way.

Colour without form/in a multitude of forms

(8) Those requirements are not met by the mere juxtaposition of colours without shape or contours, or by reference to colours in every conceivable form, so that the consumer would not be able to recall or repeat with certainty the experience of a purchase. The scope of protection afforded by such a mark would be unknown both to the competent authorities responsible for maintaining the register and to economic competitors. Registration would confer unfair competitive advantages on the proprietor of the mark.”

32. Sir John Mummery later addressed the subject matter of the application. He considered that the hearing officer and Birss J had failed properly to understand the verbal description which accompanied the graphic representation of the subject matter of the application. The description referred not only to the colour purple applied to the whole visible surface of the packaging of the goods but also to an alternative, namely “or being the predominant colour applied to the whole visible surface ...”. This implied reference to other colours and other visual material opened the door to a multitude of different visual forms which were not displayed or described in the application. He continued:

“51 In my judgment, that description, properly interpreted, does not constitute “a sign” that is “graphically represented” within art.2. If the colour purple is less than total, as would be the case if the colour is only “predominant”, the application would cover other matter in combination with the colour, but not graphically represented or verbally described in the specific, certain, self-contained and precise manner required. The result would not be an application to register “a sign”, in the accepted sense of a single sign conveying a message, but to register multiple signs

with different permutations, presentations and appearances, which are neither graphically represented nor described with any certainty or precision, or at all.

52 The appearance and number of such other signs would be unknown both to the registrar, who is responsible for the proper functioning of the registration system and is faced with the decision whether or not to register it on a public register, and to competitors, who would not be able to tell from inspecting the register the full scope and extent of the registration. To allow a registration so lacking in specificity, clarity and precision of visual appearance would offend against the principle of certainty. It would also offend against the principle of fairness by giving a competitive advantage to Cadbury and by putting Nestlé and its other competitors at a disadvantage.”

33. Sir Timothy Lloyd, in agreeing with Sir John Mummery, added that there were considerable potential problems in establishing that a pure colour mark was properly registrable, and that the requirements to which the CJEU referred in *Libertel* were aimed, in part, at ensuring that the registration authorities and competitors knew the scope of the mark. He continued:

“63 Cadbury's formulation, with its use of the words “or being the predominant colour applied to the whole visible surface, of the packaging of the goods” seems to me to fall far short of satisfying these tests. What is meant by “predominant” in this context? Miss Himsworth's primary contention was that a colour was predominant, in this context, if it covered more than 50% of the surface area in question. If this is right, and if that is what was intended, then it might be possible to achieve certainty by spelling that out in the registration application. It could have read: “applied to the whole visible surface, or to more than 50% of the area of the visible surface, of the packaging of the goods”. But it is not difficult to imagine other tests which might be applied to determine predominance in respect of colour. If the contrast is between two different colours, one which is stronger or more eye-catching, or is applied to a more prominent part of the packaging, might be seen as predominant even if it was applied to a smaller area than another colour (including white). The evidence for Cadbury ... shows that Cadbury itself regarded other factors than the measured surface area as being relevant. In my judgment the use of the word “predominant” in this context, makes the description of the mark too subjective, too imprecise, and inadequately clear and intelligible, to be capable of registration.”

34. All of the principles identified by Sir John Mummery are relevant to this appeal. It seems to me, however, that two further points emerge from the decisions of the CJEU to which I have referred which also have a bearing on the issues before us. The first concerns the constituent elements of the graphic representation of a sign consisting of one or more colours *per se* and for which a registration is sought. The INID code of


course tells the authorities and the public the nature of the mark. That aside, it is, I believe, clear from *Libertel* at [30] to [38] and [68] that, in the case of an application to register a single colour *per se* as a trade mark, the filing of a sample of the colour alone does not, of itself, constitute a graphic representation within the meaning of Article 4 of the EUTMR. The filing of a sample of the colour together with a verbal description of the colour may, however, do so, provided the description is clear, precise, self-contained, easily accessible, intelligible and objective. Similarly and as the CJEU explained in *Heidelberger* at [32] to [36] and [42], in the case of an application to register two colours *per se* as a trade mark, samples of the two colours together with a verbal description of those colours may constitute a graphic representation provided that the application for registration includes a systematic arrangement associating the colours in a predetermined and uniform way. The graphic representation therefore encompasses both the visual representation and any verbal description.

35. Secondly, the function of the graphic representation is, in particular, to define the sign so that the subject matter for which protection is sought or has been secured can be clearly and precisely identified by the competent authorities and the public. Moreover and importantly, in order to fulfil its role as a trade mark and meet the requirements of precision and clarity, the sign must always be perceived unambiguously and uniformly. In my judgment it follows that if the authorities and the public are left in a state of confusion as to the nature of the sign then these requirements will not be satisfied.
36. The reasons for these requirements are plain to see. A mark must always be perceived unambiguously if it is to fulfil its function as an indication of origin. Moreover, the authorities must refuse to register the sign if, upon opposition by the proprietor of an earlier trade mark, the sign is found to be identical to the earlier mark and if the products or services for which registration is sought are identical with those for which the earlier mark is protected. So also, upon opposition by the proprietor of an earlier trade mark, the authorities must refuse to register the sign where, by virtue of its identity or similarity with an earlier mark and the identity or similarity of the relevant goods or services, there exists a likelihood of confusion. Similarly, the owner of a registered trade mark is entitled to prevent a third party from using a sign which is identical to his mark for goods or services which are identical to those for which the mark is protected. He can also prohibit the use of a sign where, by virtue of its identity or similarity with the mark and the identity or similarity of the relevant goods or services, there exists a likelihood of confusion. As Advocate General Philippe Leger explained in his opinion in *Heidelberger* at [56], assessment of notions of “identity” and “risk of confusion” necessarily implies a precise knowledge of the sign and mark in question, as they are or as they may be seen by the public concerned.
37. We were also taken to two further decisions which have a bearing on the issues before us and which do, in my judgment, provide confirmation of the additional points I have identified immediately above. The first is the decision of the General Court in Case T-293/10 *Seven Towns Ltd v OHIM* given on 14 June 2012. This concerned an application by Seven Towns to register a colour *per se* mark in respect of various goods in Class 28. It provided under the heading ‘Indication of colours’ a representation of seven blocks, each of a different colour and (save for the black block) each with a black border. This representation was accompanied by details of each colour and the following description:


“Six surfaces being geometrically arranged in three pairs of parallel surfaces, with each pair being arranged perpendicularly to the other two pairs characterised by: (i) any two adjacent surfaces having different colours and (ii) each such surface having a grid structure formed by black borders dividing the surface into nine equal segments.”

38. The General Court agreed with the conclusion of the Board of Appeal that persons consulting the register and seeing the information provided would have to expend “a huge amount of intellectual energy and imagination” in order to understand with the necessary degree of certainty what sign Seven Towns were seeking to protect. As the Board of Appeal put it, “it is highly likely that [persons consulting the register and seeing the information provided] would, like the examiner, be confused and see a contradiction between the reference to six surfaces and the claim of seven colours” and that “most people would be left scratching their heads and wondering what exactly this strange and mysterious trade mark was”. Moreover, on one interpretation, Seven Towns was, in substance, seeking protection for a cube covered in squares with a particular arrangement of colours and that, had this been clear, it would have created an inherent contradiction for a sign so defined would not have been a colour *per se* mark but rather a figurative or three-dimensional mark.
39. The second is the decision of the First Board of Appeal of OHIM given on 2 December 2014 in Case R 2037/2013-1 *Red Bull GmbH v Optimum Mark Sp. z.o.o.* This case concerned an application by Optimum Mark for a declaration of invalidity of an EU trade mark owned by Red Bull in respect of various goods in class 32. The entry of the mark in the public register contained a visual representation, the left hand part of which was blue and the right hand part silver. It also contained the following description:
- “Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%.”
40. The Cancellation Division considered that, taking into account all the graphic and verbal information, the registration did not define a precise subject matter of protection and was not clear and objective. It therefore declared the registration invalid. An appeal to the Board of Appeal was dismissed. The Board explained at [43]:
- “43 It also follows from the *Libertel* decision that a description of a sign may be required to fulfil the requirements of Article 4 CTMR, contrary to the CTM proprietor’s argument that a description is not obligatory pursuant to Rule 3(3) CTMIR. In fact, a necessary description forms integral part of the sign’s graphical representation and thus also serves to define its scope of protection. Whilst the sign’s description indeed may not be used to broaden the scope of protection of what may be derived from the sign’s graphical representation itself (‘what you see is what you get’), it may therefore be indispensable to be taken into account when defining the sign’s subject matter.”
41. The Board of Appeal therefore recognised that, in the case of registrations such as that in issue, which consist of a combination of colours *per se*, a description may be

necessary for the sign to fulfil the requirements of certainty imposed by Article 4 EUTMR and that such a description will serve to define its scope of protection. The Board of Appeal elaborated upon this reasoning a little later in its decision at [48] in explaining first, that the representation and the description must be read together in defining the mark's scope of protection, and secondly, that in the case of the mark in issue the colours could still be combined in numerous different ways:

“48. In the present case, the application for the sign  specifies that '[p]rotection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50%'. As follows from above, the graphical representation and description must be evaluated in combination in order to define the sign's scope of protection. Apart from indicating two colours, the sign's description is confined to indicating a certain ratio of them. Evidently, the mere indication of such a ratio allows for the arrangement of the two colours in numerous different combinations, thus not in a predetermined and uniform way. Depending on the arrangement of colours on different parts of 'energy drinks' or other objects related thereto, the overall impression of two colours arranged in numerous manners may be very distinct. The cancellation applicant has given various examples of possible arrangements which would fit the sign's description. The average consumer could thus not repeat with certainty the experience of a purchase. This applies in particular for the category of marks at hand since colours possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message (06.05.2003, C-104/01, *Libertel*, EU:C:2003:244, § 40). ”

42. The Board of Appeal then addressed and rejected the proprietor's argument that the possible arrangement of the combination of colours was limited by the pictorial representation. This would have required an explicit description to this effect and would also have rendered the sign a figurative mark, and such a re-categorisation was not permissible:

“50 The CTM proprietor argues that the reproduction of the sign  defines the mark as consisting of the colour blue depicted on the left and the colour silver on the right hand side, ('what you see is what you get'), and therefore limits possible arrangements to a degree which renders the signs sufficiently precise. However, as follows from above, in the case of a combination of colours *per se*, the description of the sign forms an integral part of the sign. Given the scope of protection which the choice of this category of mark encompasses, an explicit description to this effect would have been required in the present case. Furthermore, if the subject matter was to be restricted to the sign's reproduction (i.e. the image filed), such interpretation would qualify the sign as a figurative mark, namely a coloured

rectangular shape with blue on the left and silver on the right hand side. However, a sign may not be re-categorized following its registration (see, to this effect, 12.11.2013, T-245/12, Green stripes on a pin, EU:T:2013:588).”

43. Accordingly, the Board of Appeal dismissed the appeal. I recognise that this decision is now the subject of an appeal to the General Court and that by order dated 18 November 2015, the General Court gave Marques, the association of European trade mark owners, permission to intervene. I recognise too that in its order the General Court expressed the view that the case raised issues of principle regarding the interaction between the description and the pictorial representation in colour *per se* marks. However, for reasons I shall explain, I do not believe this can have any material impact upon the outcome of this appeal.

The judgment below

44. Judge Hacon began by addressing two points of principle that were argued before him. The first was how a trade mark application or registration should be interpreted where there was, as he put it, no strict congruence between the visual representation of the sign and the description. The second was whether a registered trade mark consisting exclusively of one or more colours might encompass variants of the protected sign.
45. As for the first, the judge took the view that neither the visual representation nor the description takes precedence. One is not superior to the other. However, if an application or registration uses the INID code 558 then this provides an inflexible starting point: the sign consists of one or more colours. Thereafter, the court must do its best to reconcile any difference between the visual representation and the description.
46. As for the second, the judge dismissed a submission advanced by Mr Daniel Alexander QC, who appeared before him with Mr Simon Malynicz QC for Glaxo, that a trade mark consisting exclusively of one or more colours may include and encompass variants of the protected sign. He held that such a trade mark must consist of one and only one sign.
47. The judge turned next to the Trade Mark. He recognised that the use of INID code 558 indicated that the mark consisted exclusively of one or more colours. He then observed that, on one view, the visual representation provided considerable guidance as to the subject matter of the mark for it was a photograph of a specific inhaler. That said, however, a mark consisting exclusively of one or more colours might be applied to goods of any shape. The final element of the registration was the written description. This was unambiguous as to the shades of the dark and light purple colours but cast in very general terms as to the arrangement of those colours. There was therefore a discrepancy between the visual representation of the mark and the description.
48. In the judge’s view, anyone looking at the register and trying to understand precisely what the mark consisted of was therefore presented with a puzzle to which there were three possible solutions. The first was a mark with the outline and arrangement of dark and light purple colours shown in the visual representation, the so called ‘spikes and all’ arrangement. The second was a mark consisting of the dark purple colour applied to a significant portion of an inhaler, and the light purple colour applied to the

remainder, that is to say in any arrangement of colours meeting the written description. The third was a mark having a pattern of dark and light purple colouring taking the form of any one of a number of abstractions said by Glaxo in proceedings in other jurisdictions and before EUIPO to constitute the mark. The round and rectangular abstractions asserted by Glaxo to be examples of the mark are depicted in the judgment and are reproduced below:



49. The judge said and I agree, these abstractions are not the same shape and the relative proportions of the dark purple colour and the light purple colour appear to be different in each. Moreover, the judge continued, the shape matters because the mark must be applied to an inhaler and these inhalers may have very different shapes, as demonstrated by the shapes of the Accuhaler and Evohaler depicted, respectively, at [3] and [7] above.
50. In all these circumstances, the judge held that the Trade Mark did not satisfy Article 4 of the EUTMR. It was not sufficiently precise and uniform; nor was it sufficiently clear and unambiguous. This was so for two reasons. First, it set the reader a puzzle; and secondly, the second and third solutions to the puzzle left the reader uncertain as to the form of the Trade Mark. The judge also decided it was not necessary to refer any question to the CJEU for a preliminary ruling on a matter of EU law. The relevant law was, in his view, *acte clair*.
51. Sandoz was therefore entitled to summary judgment, the Trade Mark was declared invalid and the claim for infringement was dismissed.

The appeal

52. Upon this appeal, Mr Simon Malynicz QC, who has appeared with Ms Alaina Newnes on behalf of Glaxo, submits that the central question for the court concerns the interaction between the verbal description and the pictorial representation of an EU trade mark for a combination of colours *per se*. Further, he continues, this issue is currently pending before the General Court in the *Red Bull* case and this is, in and of itself, a very good reason why the judge should not have granted summary judgment. Moreover, the issue is certainly not *acte clair* and so the judge ought either to have dismissed the summary judgment application or made a reference to the CJEU for a preliminary ruling.
53. What is more, says Mr Malynicz, the judge made a number of significant errors in the way he interpreted the Trade Mark. First, he was wrong to hold that one possible way of interpreting it was that the pictorial representation was merely an exemplar of the practically limitless number of ways of configuring the colours identified in the verbal description.

54. Secondly, he was wrong to find that another possible interpretation of the mark was that the sign of which it consists was something abstracted from and not actually shown in the pictorial representation. Here the judge also fell into error in referring to and relying upon submissions made by Glaxo in other jurisdictions. He ought instead to have made up his own mind about the meaning of the mark and identified for himself the sign the subject of its protection.
55. Thirdly, he ought to have found that the mark had only one possible meaning and that it comprised the dark and light purple colours specified in the verbal description in the particular proportions and arrangement shown in the pictorial representation. The verbal description played only a secondary role and did not in any way broaden or extend the scope of the mark beyond the pictorial representation.
56. Mr Malynicz also submits that the judge confused the issue of whether the mark was sufficiently clear and precise with the much broader issue of what, once registered, the scope of the mark might be. He continues that the judge fell into error in considering what might or might not constitute an infringement of the mark and ought rather to have focused on the critical question whether the mark was represented on the register with sufficient clarity and precision.
57. Mr Martin Howe QC, who has appeared with Ms Iona Berkeley for Sandoz, takes issue with each of the points made by Mr Malynicz and submits that the judge came to the right conclusion and that he did so for the right reasons.
58. Mr Malynicz elaborates what he describes as the central question on the appeal the following way. He points first to the EUTMR rules and submits that these suggest that for marks such as the Trade Mark, the pictorial representation is paramount and the verbal description is secondary. Hence, Rule 3(2), in using the words "... the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears...", makes the provision of a pictorial representation *mandatory* whereas Rule 3(3), in using the words "... the application may contain a description of the mark ...", makes the provision of a verbal description *optional*.
59. We were also referred by Mr Malynicz to the Guidelines for examination of EU trade marks issued by EUIPO at about the time the application for the Trade Mark was filed and prosecuted, and the various revisions of the Guidelines which have been issued over the years that have followed. In that regard the 2006 Guidelines stated at 8.6.4:
- "Where a combination of colours per se is applied for, the graphic representation as filed will determine the mark, including the proportion and position of the various colours, which must be clear from the representation ("WYSIWYG" what you see is what you get). This is required under para 33 of the judgment of the ECJ C-49/02 of 24.6.2004 "Heidelberger"."
[original underlining]
60. By 2008 that wording had disappeared from the Guidelines, however. In the latest version, issued in 2017, it is said, at 10.5:
- "Colour per se means that trade mark protection is sought for one or several colours, regardless of any specific shape or

configuration. What is protected is the shade of colour(s) and, in the case of more than one colour, the ratio and position of the various colours, which must be systematically arranged by associating them in a predetermined and uniform way ... The representation of a colour per se mark must consist of a representation of the colour or colours without contours. Where there is more than one colour, the proportion of each colour must be specified in the mark description field....

When applying for a colour per se mark, the provision of a mere sample of the colour on its own is not sufficient; the colour or colours that are the subject of the mark must be described in words in the 'Indication of Colour(s)' field. Furthermore, it is highly recommended also to provide internationally recognised colour codes ...

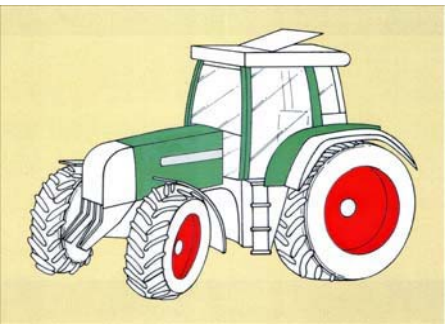
Pursuant to Rule 3(3) EUTMIR, an application for a colour per se mark may be represented by showing the colour or colours as they will be applied to the goods and services concerned. In such cases, a mark description is required in order to clarify the nature of the mark.”

61. Unfortunately, says Mr Malynicz, the judge made no reference either to the Guidelines or to the evidence before him of filing practice and in consequence he failed to appreciate that EUIPO properly considers a mark for one or more colours *per se* as being defined by the pictorial representation which shows how the colour or colours are to be applied in relation to the goods in respect of which it is registered.
62. In assessing these submissions, I think one must begin, not with the Rules or the Guidelines, but with Article 4 of the EUTMR (or Article 2 of the Directive). As we have seen, an EU trade mark may consist of any sign capable of being represented graphically and which is capable of distinguishing the goods or services of one undertaking from those of another. In order to fulfil its function, the graphical representation (or, from the 1 October 2017, the representation) must be such that the authorities and the public, including the actual and potential competitors of the proprietor, can identify the sign clearly and precisely.
63. Secondly and as I have explained, the graphical representation encompasses not just the pictorial representation of the sign but also any description which accompanies it. In the case of a sign consisting of one or more colours *per se*, the description is very important. Thus in *Libertel*, in the context of the application to register the colour orange *per se* as a trade mark, the CJEU said that the filing of a sample of the colour sought to be protected did not of itself constitute a graphical representation within the meaning of Article 2 of the Directive but a description of the colour might do, as might a sample of the colour combined with a description of it. In *Heidelberger*, in the context of an application to register the colours blue and yellow *per se* as a trade mark, the CJEU explained that a graphical representation consisting of two or more colours and designated in the abstract and without contours must be systematically arranged by associating the colours in a predetermined and uniform way. Not surprisingly, the Court was of the view that the accompanying description that the mark applied for consisted

of the applicant's corporate colours "which are used in every conceivable form" did not satisfy that requirement.

64. Thirdly, I do not detect in the guidance given by the CJEU any suggestion that, in the case of applications to register marks consisting of one or more colours *per se*, the pictorial representation is paramount and the verbal description is secondary. To the contrary, the Court has focused on the graphical representation as a whole and emphasised that its function is to define the mark in the public register in such a way as to make it accessible to the authorities and to the public and to ensure that its scope is clear and precise. Indeed and as I have explained, the Court said expressly in its judgment in *Heidelberger* that the mere juxtaposition of two colours, without shape or contours, or a reference to two or more colours "in every conceivable form" does not meet the requirements of precision and uniformity required by Article 2 of the Directive.
65. Fourthly, I do not accept that the Rules support the position for which Mr Malynicz contends. As Mr Howe points out, Rule 3(2) applies to all marks to which Rule 3(1) does not apply. In other words, it applies to figurative marks, colour *per se* marks and other special categories of marks such as three dimensional marks. In accordance with Rule 3(3), the applicant must, in cases to which Rule 3(2) applies, give an indication to that effect. This paragraph also says that the application may also contain a description of the mark. This permissive language caters for those applications, for example for the registration of some figurative marks, which do not require any description to render them clear and precise. However, it seems to me quite impossible to infer from its terms that the guidance given by the CJEU as to what is needed to satisfy the requirements of Article 4 of the EUTMR in the case of an application to register as a trade mark one or more colours *per se* should be in any way qualified. Indeed, Rule 3(5) says that where the registration of any mark in colour is applied for, the representation of the mark must consist of a colour reproduction of the mark and the colours making up the mark must also be indicated in words. Moreover and importantly, Rule 3(2) says nothing about precedence between the pictorial representation and the verbal description where both *have* been provided.
66. Fifthly, I cannot accept Mr Malynicz's submissions based upon the Guidelines. As Mr Howe says, these are simply the guidelines issued by EUIPO for the purpose of examining EU trade marks. They change regularly and reflect the understanding of EUIPO of the state of the law, including any relevant decisions. They are not, however, authoritative and they have no legislative force. They are therefore of no assistance in ascertaining what is meant by a graphical representation in the context of an application to register a mark consisting of one or more colours *per se* or what is needed to render the subject matter of the protection clear and precise. What is more, if more were needed, it can be seen from the latest version of the Guidelines that the 'WYSIWYG' formulation upon which Mr Malynicz relies has been removed.
67. Finally, Mr Malynicz cannot derive support for his submissions from what he describes as common filing practice. That is so for two reasons. First, 'common practice' cannot be a proper basis for interpreting the EUTMR. Secondly, the evidence simply does not establish that there is or was any common practice of the kind for which Mr Malynicz contends. In that connection Mr Morris, a partner in the firm of solicitors acting for Glaxo, said in his first witness statement dated 27 May 2016 at [38] that, at around the time the application for the Trade Mark was filed, it was fairly common to use an image

of the goods to illustrate how the colour or colours the subject of the application would be applied. He then refers, by way of illustration, to a series of applications. It is true that each of the applications does contain a pictorial representation of the colour or colours applied to a sample of the goods. But each also contains a verbal description of how the colour or colours are to be applied to other goods of the same kind. One of the applications which received attention during the course of the hearing is shown below:

Representation	Description	Goods
	<p>The colour green applied to the hood of an agricultural tractor or model agricultural tractor, to the rear wheel mudguards and to the cabin pillars, a silver strip applied to the hood, the colour white applied to the operator's cab roof, and the colour red applied to the wheel centers. Colour: A combination of green, red, silver and white.</p>	<p>Agricultural tractors, model agricultural tractors</p>

68. Here the verbal description, read in conjunction with the pictorial representation, explains how the colours the subject of the application may be used in relation to *any* agricultural tractor.
69. I therefore reject Mr Malynicz's submission that a mark consisting of one or more colours *per se* is defined by the pictorial representation showing how the colour or colours are to be applied. The verbal description of such a mark is also important and must be taken into account together with the pictorial representation. The graphical representation, comprising both the pictorial representation and the verbal description, must be considered as a whole.
70. That brings me to the Trade Mark itself. Mr Malynicz argues that the sign of which it consists is clear, specific and certain. It is, he says, the particular arrangement of colours shown in the pictorial representation, 'spikes and all', and, as such, amply satisfies the requirements laid down in *Heidelberger*. He continues that the pictorial representation constitutes a systematic arrangement associating the colours in a predetermined and uniform way. By contrast, the judge's approach involves an inappropriate use of the verbal description to destroy the mark's specificity.
71. Turning to the two other possible interpretations of the Trade Mark identified by the judge, Mr Malynicz submits that each of these is obviously wrong. Taking first the suggestion that the sign of which it consists might be the dark purple colour applied to a significant portion of the inhaler and the light purple colour applied to the remainder, Mr Malynicz argues that this wrongly relegates the pictorial representation to an inferior position and elevates the text into a dominant position, and is the antithesis of the correct WYSIWYG approach mandated by the Rules and the Guidelines.
72. The further alternative, that the sign might be some kind of abstraction from the pictorial representation, is equally misconceived, submits Mr Malynicz. That is so for the following reasons. First, the judge misunderstood the argument advanced by Mr

Alexander before him. Glaxo have never contended that the sign was some kind of abstraction; their position is and has always been that the sign is what is shown in the pictorial representation. The posited abstractions are simply illustrative of the sign's distinctive and important components and are different from the sign itself. Secondly, the judge fell into error in referring to contentions advanced before EUIPO and proceedings in other territories. There is no basis in law for construing an EU trade mark by reference to what anyone, whether it be the proprietor or a third party, has said about it.

73. Mr Malynicz concludes his submissions on this aspect of the appeal in the following way. He argues that the judge was wrong to find that the registration is susceptible to different interpretations, and that he should have adopted the WYSIWYG approach and found that the sign it protects is precisely what was shown in the pictorial representation. This representation shows how the sign is to be applied to an inhaler. If and in so far as the sign could or should be regarded as something abstracted from the pictorial representation then it is still sufficiently specific.
74. Finally, argues Mr Malynicz, this case is not suitable for summary judgment and should have been permitted to progress to trial by which time the General Court will have delivered judgment in the *Red Bull* case. Alternatively, the Court of Appeal should make a reference to the CJEU for a preliminary ruling as to, inter alia, the role played by the verbal description in the case of a mark consisting of one or more colours *per se*.
75. It is, I think, notable that Mr Malynicz does not challenge the judge's starting point. The judge held, correctly in my view, that the designation of the Trade Mark with INID code 558 means that it is and would be understood to be a mark which consists exclusively of one or more colours. It is, in short, a colour *per se* mark. It is not a two dimensional figurative mark having the appearance of the pictorial representation; nor is it a three-dimensional mark having a particular shape and coloured in a particular way. Further, anyone inspecting the register would understand that, as a colour *per se* mark, registered in respect of inhalers, it is at least implied that it is not limited to the colours as applied to the particular shape of inhaler depicted in the registration.
76. Against this background, the issue for the public, including economic operators, inspecting the register is how the Trade Mark is to be understood. The judge described this as a puzzle and he was right to do so, as may be demonstrated by a consideration of each of the possible interpretations he considered.
77. I take first the interpretation urged upon us by Mr Malynicz on this appeal, that is to say that the sign of which the mark consists is the precise arrangement of the dark and light purple colours shown in the pictorial representation, spikes and all. A member of the public looking at the register would appreciate that this interpretation faces two major difficulties. First, INID code 558 implies that the sign is not limited to the colours as applied to any particular shape of inhaler. However, it is difficult to understand how this particular arrangement of colours, including its spikey perimeter, could be applied to an inhaler with a different shape. The judge was entitled to consider this problem by reference to Glaxo's boot shaped inhaler, the Evohaler depicted at [7] above. How can the mark be applied to it? In my judgment it is impossible to say with any degree of certainty, and any attempt to do so would likely produce a result which creates a visual impression which is very different from that created by the pictorial representation. As the judge said, this is not a colour mark consisting of, say, stripes of two different

colours of equal widths which could be applied without change to different shapes. Secondly, this interpretation is not consistent with the verbal description which is put in much more general terms. It does not say that the dark purple and the light purple colours should be applied to an inhaler of the shape and in the particular manner illustrated in the pictorial representation. It says instead that the mark *consists* of the dark purple colour applied to a significant proportion of *an* inhaler and the light purple colour is applied to the *remainder* of the inhaler. I think members of the public would therefore doubt whether Mr Malynicz's interpretation of the mark was correct.

78. Turning next to the abstraction interpretation and having reviewed the transcript of the argument before the judge, I can well understand how he gained the impression that this was the case being advanced on behalf of Glaxo. Furthermore, it is the way Glaxo's case has been developed in some other jurisdictions and before EUIPO. For the purposes of this appeal, however, I am prepared to accept Mr Malynicz's point that Glaxo are not bound by submissions they had made in other jurisdictions or before EUIPO. Nevertheless, it seems to me to be perfectly permissible for this court to consider whether the abstractions found in those submissions and reproduced at [48] above represent a possible interpretation of the mark. For my part, I consider that the abstraction interpretation would be thought by the public, including economic operators, to be plausible because it attempts to give some effect to the particular arrangement of colours shown in the pictorial representation while not limiting the mark to use in relation to any particular inhaler shape. However, there are three major problems with it. First, it is far from clear what degree of abstraction should be applied to the pictorial representation or what form the abstraction should take. The particular images shown at [48] above are those which appear in the submissions made by Glaxo before EUIPO but there are undoubtedly other possibilities too. Secondly and as I have already pointed out, the arrangement of the dark and light purple colours is not the same in each of these abstractions and so they are not representations of the same sign. Thirdly, the verbal description is again cast in much more general terms than either of them.
79. So that leaves the third possible interpretation, namely that the mark consists of any proportions of the dark and light purple colours falling within the terms of the verbal description: "... the colour dark purple ... applied to a significant proportion of an inhaler, and the colour light purple ... applied to the remainder of the inhaler", and that the pictorial representation is merely an illustration of one form the mark may take, just as the tractor is in the application referred to at [67] above. As Mr Howe says, the advantage of this interpretation is that it makes perfect sense of the opening words of the verbal description: "The trade mark consists of ...". On the other hand, it gives little weight to the particular arrangement of colours shown in the pictorial representation.
80. Stepping back, I believe that the public, including economic operators, looking at the certificate of the Trade Mark on the register, would be left in a position of complete uncertainty as to what the protected sign actually is. In the words of the Board of Appeal in the *Seven Towns* case, they would be left scratching their heads. Mr Howe submits and I incline to agree, that the third possible interpretation is the best (or at any rate the least bad) of the three for it provides a way of reconciling the INID code, the pictorial representation and the verbal description. However, this is far from clear. In my judgment, the Trade Mark lacks the clarity, intelligibility, precision, specificity and

accessibility that the law demands. Moreover, I have no doubt that it would not be perceived unambiguously and uniformly by the public. It also offends against the principle of fairness because the uncertainty as to what the subject matter of the mark actually is gives Glaxo an unfair competitive advantage. These deficiencies in the Trade Mark are compounded by the range of alternatives that the second and the third possible interpretations encompass. Just as in *Heidelberg*, each of them allows for numerous different combinations of the dark and light purple colours. Consequently, neither of them exhibits the qualities of precision and uniformity required by Article 4 of the EUTMR.

81. In my judgment this case is suitable for summary judgment for neither side has suggested that their case is likely to be affected, still less improved, by any further disclosure or evidence. I have also considered carefully whether this case raises any issue of EU law which is not clear and which should be referred to the CJEU. I have concluded that it does not. The principles of law upon which this judgment is founded have been established by the CJEU in the cases to which I have referred and are now well settled. I am conscious that the *Red Bull* case will now be considered by the General Court but, as Mr Howe points out, the central issue in that case is whether the two colour swatch with side-by-side colours is to be interpreted as defining not only the colours but also the shapes and positions in which they appear. The issues in this appeal are different.
82. In my judgment we can and should decide the issues before us now. For the reasons I have given, I would dismiss the appeal.

Lord Justice Floyd:

83. I agree.

Sir Geoffrey Vos, Chancellor of the High Court:

84. I also agree.