

Germany: BGH rules on Blue – Market recognition and survey tuning for single colour marks

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The German Federal Supreme Court (BGH) handed down its ruling last week on an invalidity action brought against a blue colour mark of German beauty care giant Beiersdorf. Beiersdorf uses its blue colour (Pantone 280 C, to be precise) for its well-known NIVEA skin-care products, on packaging and in advertising. The mark had been registered in 2007 on the basis of acquired distinctiveness.



The claimant, another beauty care company, applied for cancellation of the mark for lack of inherent and acquired distinctiveness. Inter alia, the claimant maintained that Beiersdorf only ever used its blue colour in combination with white and with the well-known house mark NIVEA. The claimant further said that consumers would not perceive said use as trademark use of the colour blue per se.

The German PTO and Federal Patent Court (BPatG) in the previous instances had granted the cancellation request. They deemed the survey evidence submitted by Beiersdorf to not demonstrate a sufficiently high recognition of the blue colour in relation to the relevant body care and skin care products. The Patent Court held that a recognition value of less than 55% was not sufficient and decided that in this particular case, where the validity of a monochrome colour mark was at stake, a recognition of 75% or more of the relevant public was called for.

The Supreme Court disagrees. It holds that a recognition value of 50% or more can be sufficient for acquired distinctiveness, even where a monochrome colour mark is concerned. The court therefore remands the case to the Patent Court for retrial. In doing so, the Supreme Court gives guidance on the survey evidence presented so far, which it found lacking in two respects: First of all, the survey participants should have been presented with a sample showing only the blue colour in question and not – as was the case – a blue card framed in white. This white frame was particularly problematic since the NIVEA trade dress typically consists of the combination of white elements and writing on a blue background. The court's second objection concerned the relevant goods. The colour mark claims protection for "body care and skin care products", and the survey had made reference to these product groups. However, the court deems it necessary that a new survey be conducted which differentiates more closely between the individual types of products that fall under these two categories. The market perception may very well vary between, say, a moisturizing body cream and a facial cleanser.

German trademark lawyers are awaiting the results of the new survey and the following decision of the Patent Court with keen interest and we will keep you posted.

Case Reference: BGH, I ZB 65/13 – Nivea Blau, decision of 9 July 2015 (previous instance: BPatG, 24 W (pat) 75/10, decision of 13 March 2013).

The BGH's German language press release is available [here](#).

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Anthonia regularly publishes on current case-law as member of the Marques "Class 46" team of trademark experts. She is a member of INTA and of the European legal network of the Free Software Foundation Europe.