

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**CANCELLATION DECISION**  
**N° 3000495**  
**of 23 August 2024**

**Claimant:** **Lebara B.V.**  
Entrada 100, Kantoor 111  
1114 AA Amsterdam-Duivendrecht  
Netherlands

**Representative:** **AC&R**  
Keizersgracht 212  
1016 DX Amsterdam  
Netherlands

*against*

**Defendant:** **Deutsche Telekom AG**  
Friedrich-Ebert-Allee 140  
53113 Bonn  
Germany

**Representative:** **Hogan Lovells International LLP**  
Atrium - North Tower / Strawinskylaan 4129  
1077 ZX Amsterdam  
Netherlands

**Contested trademark: Benelux registration 589410**



## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 17 October 2022, the claimant filed an application for cancellation with the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") in accordance with Article 2.30bis(1)(a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP"), invoking the following grounds for invalidity or revocation:

- I. The contested sign cannot constitute a trademark (Article 2.2bis(1)(a) BCIP)
- II. The contested trademark is devoid of distinctive character (Article 2.2bis(1)(b) BCIP)
- III. No genuine use was made of the contested trademark (Article 2.27(2) BCIP)

2. The application for cancellation is aimed at Benelux registration 589410, filed on 22 December 1995, of the following mark:



The contested trademark is registered as a figurative mark, and the registration contains the following colour description:

"Red"<sup>1</sup>

3. The cancellation claim is directed against all goods and services of the contested trademark, namely:

Class 9: Electrical and electronic apparatus and instruments not included in other classes, optical, measuring, signalling, control (inspection) and educational apparatus and instruments; apparatus for the recording, transmission and reproduction of sound, images or data; magnetic or optical data media; vending machines and mechanisms for prepayment apparatus; data processing equipment; computers.

Class 16: Printed matter; teaching and learning materials (excluding apparatus); stationery; envelopes.

Class 36: Financial affairs; real estate brokerage and trading.

Class 37: Construction; maintenance and repairs; installation work.

Class 38: Telecommunications; rental of telecommunications equipment.

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<sup>1</sup> The contested trademark is registered in Dutch. Original NL version: "Rood".

Class 41: Education; entertainment; organising sports and cultural activities; publishing and publishing of printed matter.

Class 42: Computer programming; rental of computer database access time; rental of computers, including data processing equipment; design of telecommunications equipment; technical planning related to the installation of telecommunications equipment and networks.<sup>2</sup>

4. The language of the proceedings is English.

## **B. Course of the proceedings**

5. The application for cancellation is admissible and was notified by the Office to the parties on 15 November 2022. During the administrative phase of the proceedings both parties filed arguments and documents in support. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 28 September 2023.

## **II. ARGUMENTS**

### **A. Claimant's arguments**

6. The claimant firstly points out that it is not clear what the trademark proprietor intended to protect: a colour *per se* or a figurative sign of a rectangle in a particular colour (red?). In the former case, it cannot constitute a trademark as it is unclear and imprecise (lacks the inclusion of an internationally recognised colour code, and contains multiple inconsistencies, such as the classification as a figurative mark, the qualification 'Red' which is not the colour as depicted, and the fact that the colour is defined by lines as it does not entirely fill out the square), lacks distinctive character and is liable to revocation due to lack of genuine use thereof. In the latter case, it cannot constitute a trademark as it is unclear and imprecise (the qualification 'Red' which is not the colour as depicted), lacks distinctive character and is liable to revocation due to lack of genuine use thereof. The fact alone that it is not sufficiently clear whether the trademark aims to protect a colour *per se*, or a figurative sign of a rectangle in a particular colour should lead to the conclusion that it cannot constitute a trademark.

7. As a first ground, the claimant argues that the contested sign cannot constitute a trademark. According to the claimant, Article 2.1 BCIP entails that there are several conditions that a colour *per se* must meet, namely the 'graphical representation requirement', the 'specificity requirement', and the 'context requirement', the latter two being sub-requirements of the 'sign requirement'. The contested

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<sup>2</sup> Machine translation. Original NL version: "KI 9 Elektrische en elektronische apparaten en instrumenten voor zover niet begrepen in andere klassen, optische, meet-, sein-, controle- (inspectie-) en onderwijstoestellen en instrumenten; apparaten voor het opnemen, het overbrengen en het weergeven van geluid, beeld of gegevens; magnetische of optische gegevensdragers; verkoopautomaten en mechanismen voor apparaten met vooruitbetaling; apparatuur voor het verwerken van gegevens; computers. KI 16 Drukwerken; leermiddelen en onderwijsmateriaal (uitgezonderd toestellen); brief- en postpapier; enveloppen. KI 36 Financiële zaken; makelaardij en handel in onroerende goederen. KI 37 Bouw; onderhoud en reparaties; installatiewerkzaamheden. KI 38 Telecommunicatie; verhuur van telecommunicatie-apparatuur. KI 41 Opleiding; ontspanning; het organiseren van sportieve en culturele activiteiten; het publiceren en uitgeven van drukwerken. KI 42 Computerprogrammering; verhuur van toegangstijd tot een computer-database; verhuur van computers, m.i.v. apparatuur voor gegevensverwerking; ontwerp van telecommunicatie-apparatuur; technische planning m.b.t. het installeren van telecommunicatie-apparatuur en -netwerken."

trademark registration does not meet the graphical representation requirement, since it does not contain an internationally recognized colour code, and therefore the representation is not clear, precise, self-contained, easily accessible, intelligible, durable and objective, as required by the *Libertel* judgement.

8. According to the claimant, the other conditions have also not been met. A colour *per se* is normally a simple property of things and cannot be presumed to constitute a sign. Only when used in a certain context, which should follow from the register, a colour can appear as a sign. Further, a colour sample, when looked up by anyone in the trademark register, does not convey any meaning because it has no manifestation, yet. Only when applied to another object, will it be able to express meaning. The colour can be used in a multitude of configurations, especially since it is registered for services. Since the registration does not contain any information about how and on what object(s) the colour will be used, it fails to meet the context and specificity requirements.

9. As a second ground, the claimant argues that the mark is devoid of distinctive character. He recalls that the ratio of the requirement of distinctive character is to ensure that trademarks are capable of fulfilling their essential function, to guarantee to the consumer the commercial origin of goods or services. A trademark must serve to identify goods or services as originating from a particular undertaking and to distinguish them from goods or services of other undertakings. For trademarks relating to colours *per se*, there is an additional ratio, namely the general interest in not unduly restricting the availability of colours for other traders. The claimant indicates in this context that the defendant holds multiple trademark registrations for colours *per se* and colour combinations.

10. According to the claimant, the trademark *ab initio* lacks distinctive character in the Benelux. It does not meet the very high threshold of 'exceptional circumstances' as defined by the CJEU in the *Libertel* case. The use of colours such as red, pink, purple or magenta is not at all unusual for the telecommunication (related) services for which it has been registered. Colours own a certain capacity of attracting the attention of consumers and are commonly being used in the telecommunications sector in the Benelux, as follows from several examples submitted by the claimant and is mentioned in BOIP's Guidelines on Examination of Absolute grounds<sup>3</sup>. The claimant further refers to the fact that the magenta mark has been refused protection as an EU trademark for inter alia the same services and on the same grounds by OHIM (currently EUIPO). It is, therefore, for the defendant to substantiate that its mark has acquired and retained distinctive character for the relevant public in the Benelux, for the services for which it has registered its trademark.

11. According to the claimant, the trademark has not acquired distinctive character on the date of initiating the present cancellation action. In addition to a lack of use of the actual colour for which registration has been sought, the defendant and its subsidiaries have made insufficient use of the colour for the registered goods and services to have acquired (and retained) distinctive character for these services among a significant part of the relevant public in the Benelux. Due to the low intensity of use in the Benelux the relevant public – the general public – cannot (any longer) distinguish the origin of the services in question based on the colour *per se*. The claimant recalls that the possibility to establish distinctiveness acquired through use constitutes a major exception to the rule laid down in Article 2.2bis(1)(b) BCIP, which should be applied narrowly. It must be shown with certainty that the defendant has established the mark as an indication of origin for the goods or services designated by it. Such change in meaning – from an

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<sup>3</sup> <https://www.boip.int/en/ip-professionals/regulations-policy/refusals/guidelines>, point 71.

indistinctive colour to a trademark – will only occur if the sign is used as a mark, that is, as an indication of the commercial source on which consumers can rely when choosing between competing offers. According to the claimant, the use of magenta in the telecom sector is commonplace in the Benelux, so the colour alone does not enable the consumer in a reliable way to distinguish between competing offers. The claimant further submits that the evidence filed by the defendant falls short, since it mostly pertains to the Netherlands or countries outside the Benelux that are completely irrelevant, but virtually no evidence pertains to (the public perception in) Belgium and Luxembourg, whereas according to the case-law, (acquired) distinctiveness must be proven in the entire Benelux. Also, the evidence in no way concerns all registered goods and services, only telecommunications (class 38). The evidence filed shows use of a different colour, in various configurations, with different contours, shapes, and colour combinations, that alter the distinctive character. The claimant emphasises that all evidence should be assessed with exclusion of the T-Mobile or Deutsche Telekom name and logo. Finally, the claimant criticises the market surveys that were submitted by the defendant. All respondents for the first survey are located in the Netherlands (and for other surveys outside of the EU), so the surveys are not representative for the Benelux. The respondents in the Netherlands are likely to have been influenced by the T-Mobile logo (same square with a white T), and the question “wat komt er in u op als u deze kleur ziet bij telecomdiensten of -producten?” (“what comes to mind when you see this colour on telecom services or products?”) is phrased in such a way that it nudges the respondents to guess a commercial origin. The results of the survey are therefore, according to the claimant, not reliable.

12. As a third ground, the claimant contends that the trademark is liable to revocation due to lack of genuine use. Pursuant to Article 2.30nonies(4) BCIP, he requests that the date of revocation of the trademark be set at the date located five years after the trademark registration procedure was completed, alternatively on the earliest appropriate date to be determined by BOIP. According to the claimant, the evidence presented does not show genuine use of the contested trademark as an indication of origin, but merely ornamental and decorative use, often in combination with or as part of the T-Mobile and T-Marks. The annexes relating to brand value are irrelevant as they concern the trademark Deutsche Telekom instead of the red mark or the colour as an additional asset instead of a trademark (and indication of origin). Furthermore, the evidence does not show use by the defendant but by a third party (T-Mobile), does not relate to the majority of the goods and services and is largely outside scope of the relevant period and territory, whereby the claimant notes that the defendant is not active at all on the telecommunications market in Belgium and Luxembourg.

13. The claimant concludes that the contested trademark should be declared invalid, for all services, as the sign as registered cannot constitute a trademark pursuant to Article 2.2bis(1)(a) BCIP and is devoid of distinctive character pursuant to Article 2.2bis(1)(b) BCIP. Furthermore, the trademark should be revoked since the defendant failed to prove genuine use in accordance with Article 2.23bis BCIP, at least with regard to classes 9, 16, 36, 37, 41 and 42, and ‘rental of telecommunications equipment’ (sub-category of class 38).

## **B. Arguments of the defendant**

14. According to the defendant, the wording of Article 2.1 BCIP, which implements Article 3 of the Trademark Directive (2015/2436), makes clear that there are three requirements that need to be met in order to qualify as a trademark:

- (i) The trademark must consist of 'a sign';
- (ii) which must be capable of distinguishing the goods or services of one undertaking from those of other undertakings;
- (iii) which must be capable of being represented on 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.

The defendant, therefore, refutes the claimant's contention that a 'specificity requirement' and a 'context requirement' would exist. These additional requirements are *contra legem*, since 'colours (*per se*)' are explicitly mentioned in the legislation as examples of signs. The defendant also finds that the claimant misinterprets the case-law, and wrongly refers to the Dyson-case, which relates to a different subject matter, namely an 'undefined multitude of configurations' for the shape of goods, whereas the subject matter of the contested trademark is the colour magenta itself for services, so any (auxiliary) goods on which the trademark is used are not subject of the registration. The fact that the magenta mark is classified as a 'colour mark' provides all the information needed to determine the subject matter of the registration, namely a colour *per se*, without shape or contours. According to the defendant, there is no need (nor possibility) to mention the context of use in the registration. If the actual use is trademark use, as a means of identification, a colour can constitute a trademark (and thus also a sign). The market survey clearly evidences that the factual use indeed leads to use as a trademark.

15. According to the defendant, the magenta mark is inherently distinctive. The examination must be carried out by reference to the actual situation, taking account of all the circumstances. The relevant public in the Benelux has become accustomed to recognizing colours as an indication of origin where it concerns telecommunication services. The defendant further states that the alleged lack of distinctive character must be rejected, since this was insufficiently substantiated by the claimant. The decision of EUIPO, to which the claimant refers (*supra*, point 10) is not relevant since it concerns another market (EU vs. Benelux) and refers to a period of twenty years ago. The colour magenta has been hugely successful and has more than proven its capacity to distinguish services during the last twenty years, which is further substantiated by an overview of registrations for the colour magenta in EU countries and an overview of registrations worldwide. The defendant submits a large number of examples of how the mark is used, and states that the actual use is not as a 'property of things' or 'used for its appeal' (decorative nature), but clearly use as a trademark. The possible appeal is not inherent to the colour, but stems from the appeal created by the reputation of the trademark and its proprietor.

16. The defendant explains that the telecom market is very specific and clearly defined. It is, since the liberalization of the market in the late 1980s, characterized by the existence of only a few providers. This can be explained by the barriers for entry in the market, in terms of infrastructure and investment. In the Netherlands, there are only three telecom providers with their own physical network: KPN, T-Mobile and VodafoneZiggo. These providers each use a unique colour to represent their brand identity: KPN uses the colour green, T-Mobile the colour magenta, Vodafone the colour red and Ziggo the colour orange. Besides, there are some virtual network providers that use the infrastructure of one of the physical networks. Examples are Lebara (the claimant), Simyo and Youfone that operate under KPN's physical network, Hollandsnieuwe utilizes the physical network of VodafoneZiggo, and Simpel, Ben and Tele2 use T-Mobile's physical network. An equivalent situation exists in Belgium and Luxembourg, with only respectively four and three telecommunication providers with a physical network, and a limited number of virtual network providers. Due to the very specific relevant market with only a limited number of telecommunication providers, the telecommunications market is particularly well suited for the use of colours as trademarks. Individual colours can be immediately assigned to the individual suppliers, and the public is used to

recognizing telecommunication providers by the colours they use. Given the specific nature of the market and the exceptional nature of the colour magenta, the defendant contends that there is a need for a balanced view in relation to the *Freihaltebedürfnis*. The defendant further argues that the magenta mark falls within the 'exceptional circumstances' in which distinctiveness without any prior use is conceivable, referred to in the *Libertel* case, although it is established beyond a shadow of a doubt that the magenta mark has already been used, so that these 'exceptional circumstances' do not need to be met: the number of services for which the mark is claimed is very restricted, the relevant market is very specific, the use of the colour for certain goods or services is unusual and this colour is not normally used for the services to be protected. In this respect, the defendant refers to the example of the colour 'pink; RAL 4003' for armoured tanks or submarines, as mentioned in point 71 of BOIP's Guidelines on Examination of Absolute grounds.

17. The defendant further argues, in case the trademark is not found to be inherently distinctive, that it has acquired distinctiveness. In this regard, he first emphasizes that the evidencing of acquired distinctiveness must not by any means be considered to be an implicit admission that the magenta trademark is not inherently distinctive. Furthermore, the defendant states that the claimant's arguments against acquired distinctiveness are not substantiated and should already for that reason be rejected. The lack of substantiation is all the more relevant since – as the evidence shows – it should be deemed a fact of common knowledge that the magenta trademark has not only acquired distinctiveness, but even has obtained enhanced distinctiveness. The intensity of use or actual presence on the market is not the only factor, as a trademark may be found to have acquired distinctiveness after an overall assessment of the evidence that the trademark has come to identify the goods or services concerned as originating from a particular undertaking, and thus to distinguish that product from goods or services of other undertakings.

18. To demonstrate acquired distinctiveness, the defendant explains that the colour Magenta has been in use as a trademark since the '90ties of last century. Due to the extensive, intensive, frequent, regular, and longtime use, which has taken (and still is taking) place via many different outlets and with broad territorial coverage (extending well beyond the territory of the Benelux) by defendant Deutsche Telekom AG ("DTAG") itself or economically related entities such as T-Mobile, T-Systems, or Hotspotdrive, the public in the Benelux has become familiar with and recognizes the Magenta Trademark as an indication of origin for telecommunication services. The defendant provides a comprehensive overview and supporting documents regarding its commercial activities and the use made of the contested trademark.

19. With regard to the third ground, lack of genuine use, the defendant notes that the claimant does not substantiate it and merely states that the use would be 'insufficient', whereas, according to case-law, the use of a trademark need not always be quantitatively significant for it to be deemed genuine. Even minimal use could be sufficient to qualify as genuine use, provided that it is deemed to be justified in the economic sector concerned to maintain or create market share for the goods or services protected by the trademark. The defendant has not only tried to create an outlet for the services for which the magenta trademark is registered, it has also been highly successful in doing so. There cannot be a shadow of a doubt and it should even be considered a fact of common knowledge that the trademark has been genuinely used in the Benelux. The defendant refers to all the evidence he provided to prove acquired distinctiveness, and states that this also evidences genuine use. Concerning the 'rental of telecommunications equipment' and 'design of telecommunications installations and equipment', the defendant explains that he offers for rent equipment to provide customers (b2b and b2c) access to its network, and that he designs and builds installations and equipment, such as a connectivity tool, ICT solutions and installation of a fiber optic network. Furthermore, the defendant, without assuming an unobligated burden of proof, offers to provide the Office with further evidence.

### III. GROUNDS FOR THE DECISION

#### A.1 Legal framework – grounds for invalidity – general

20. Pursuant to Article 2.30bis(1)(a) BCIP, an application for invalidation of the registration of a trademark may be filed with the Office based on the absolute grounds for invalidity set out in Article 2.2bis BCIP.

21. It follows from case-law that in the context of an application for a declaration of invalidity based on Article 2.30bis(1)(a) BCIP, the relevant date for the purposes of examining the conformity of the trademark with Article 2.2bis BCIP is that of the filing of the application for registration<sup>4</sup>. In this case the relevant date is 22 December 1995.

22. In invalidity proceedings on absolute grounds, the contested trademark enjoys a presumption of validity, and it is up to the claimant to raise before the Office the concrete elements which call into question its validity. The Office will therefore limit its examination to the grounds, arguments and evidence submitted by the parties<sup>5</sup>.

#### A.2 Ground I: Article 2.2bis(1)(a) BCIP

23. The first ground for invalidity that has been invoked by the claimant is that the contested sign cannot constitute a trademark (Article 2.2bis(1)(a) BCIP). According to the claimant, there are several conditions that a colour mark must meet, namely the 'graphical representation requirement', the 'specificity requirement', and the 'context requirement', the latter two being sub-requirements of the 'sign requirement' (supra, point 7). As for the 'specificity requirement', and the 'context requirement', the defendant disputes that these would constitute separate conditions for registration (supra, point 14).

24. In relation to the 'sign requirement', the CJEU considered<sup>6</sup>:

*"26. Accordingly, it is for the Court to determine whether Article 2 of the Directive is to be interpreted as meaning that a colour per se is capable of constituting a trade mark.*

*27. In that regard it must be pointed out that a colour per se cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used. None the less, a colour per se is capable, in relation to a product or service, of constituting a sign."*

And:

*"39. As to the question whether a colour per se is capable of distinguishing the goods or services of one undertaking from those of other undertakings, within the meaning of Article 2 of the Directive, it is necessary to determine whether or not colours per se are capable of conveying specific information, in particular as to the origin of a product or service."*

25. So although a colour *per se* normally does not constitute a sign, it may constitute a sign, depending on the context in which it is used. Contrary to the claimant's view, there is no requirement that this context be stated in the registration. After all, a colour mark concerns a colour *per se*, without any shape or

<sup>4</sup> See by analogy: CJEU 23 April 2010, C-332/09 P, ECLI:EU:C:2010:225 (Flugbörse).

<sup>5</sup> See by analogy: General Court EU 19 October 2022, T-486/20, ECLI:EU:T:2022:642 (Swisse).

<sup>6</sup> CJEU 6 May 2003, C-104/01, ECLI:EU:C:2003:244 (Libertel).



contours. The requirements for colour marks are not necessarily the same as those applicable to other types of marks, to which the claimant refers<sup>7</sup>.

26. The Office therefore considers that, as far as register data is concerned, there are no requirements other than a clear and precise representation as referred to in Article 2.1(b) BCIP. If a colour *per se* meets that requirement, it is not necessarily a sign (usually not), but that depends on its use, more specifically whether the colour is capable of conveying specific information, in particular as to the origin of a product or service. This question is obviously narrowly related to the question of whether it possesses distinctive character. It seems logical that when a single colour is perceived as a distinctive trademark, it is thereby also a sign. This will be examined under the second ground, the distinctive character of the (presumed) sign.

27. Pursuant to Article 2.1(b) BCIP, a sign must be capable of being represented on 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. The text of this provision corresponds to Article 3(b) TMD<sup>8</sup>. Preamble 13 of the TMD states in this regard: *"In order to fulfil the objectives of the registration system for trade marks, namely to ensure legal certainty and sound administration, it is also essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective"*. This wording is obviously inspired by the Sieckmann-criterion<sup>9</sup>, which also applies to colours *per se*. In the Libertel judgement<sup>10</sup>, the CJEU ruled:

*"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 First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, 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."*

28. As the claimant rightly points out, the registration does not contain any colour code, the colour description 'red' is questionable and it is not clear if the subject matter of the registration is a colour *per se* or a coloured quadrangle. Thus, the representation of the mark does not comply with Article 2.1(b) BCIP, as it does not enable the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. This is not contested by the defendant. However, the Office does note that the application for the contested trademark dates back to 1995 and the technical possibilities for registration were less developed then than they are today.

29. For reasons of procedural efficiency, the Office will first further examine the second ground invoked, the distinctive character of the (presumed) sign.

### **A.3 Ground II: Article 2.2bis(1)(b) BCIP**

30. The second ground for invalidity that has been invoked by the claimant is that the contested trademark is devoid of distinctive character (Article 2.2bis(1)(b) BCIP). The Office agrees with the claimant

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<sup>7</sup> CJEU 25 January 2007, C-321/03, ECLI:EU:C:2007:51 (Dyson), CJEU 24 June 2004, C-49/02, ECLI:EU:C:2004:384 (Heidelberger Bauchemie).

<sup>8</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

<sup>9</sup> CJEU 12 December 2002, C-273/00, ECLI:EU:C:2002:748 (Sieckmann).

<sup>10</sup> CJEU 6 May 2003, C-104/01, ECLI:EU:C:2003:244 (Libertel).

that the colour magenta is *ab initio* devoid of distinctive character. It is settled case-law that the perception of the public is not necessarily the same in the case of a sign consisting of a colour *per se* as it is in the case of a word or figurative mark, and there is no indication, nor has this been argued by the parties, that this was different at the date of filing of the application than it is today. The public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of goods or services, but consumers are not in the habit of making assumptions about the origin of goods or services based on the colour used on their packaging or advertising, in the absence of any graphic or word element. A colour *per se* is normally not inherently capable of distinguishing the goods or services of a particular undertaking.

31. The Office cannot agree with the defendant's contention that the exceptional circumstances referred to in the Libertel judgment<sup>11</sup> would arise in this case. The colour in this case is certainly not as unusual as that referred to in the example of the colour pink for military vehicles in BOIP's guidelines, to which the defendant refers (*supra*, point 16). It is undoubtedly true that, as the defendant explains, the number of telecom providers is rather limited, particularly due to the large investments required to enter this market. It may also be true that telecom providers commonly use colours as business identifiers, and that the public is accustomed to that. However, the Office does not believe that this entails that a colour *per se* would enable the public *ab initio*, i.e. without any prior use, to distinguish these services by their origin from a particular undertaking. If it were true that colours are by definition perceived as trademarks in this economic sector, it would also mean that a few suppliers could easily monopolise the entire range of colours for their own benefit, to the detriment of possible new operators, which would clearly be contrary to the public interest<sup>12</sup>.

32. The defendant further argues that he uses the colour as a trademark. When assessing *ab initio* distinctiveness, however, the use made of a sign must be disregarded. Indeed, the question here is whether a sign is inherently, i.e. independently of any use, perceived as a trademark. The Office considers that this is not the case. However, the use made of the sign does play a role in assessing whether it has acquired distinctiveness. It does not seem illogical to assume that the factual conditions in a market with few providers, each of which has had to invest heavily to enter that market and is unlikely to survive without a serious market share, are relatively favourable to achieve acquired distinctiveness. However, the onus of proving acquired distinctiveness rests on the defendant<sup>13</sup>.

#### **A.4 Acquired distinctiveness**

33. Article 2.2bis(3) BCIP stipulates: "*A trademark shall not be declared invalid [...] if, before the date of application for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character*". It is therefore for the defendant to prove that, prior to the institution of these proceedings (17 October 2022), the trademark has acquired distinctiveness for the goods and services for which it is registered (*supra*, point 3).

34. This provision is an exception to the rule that signs which are not distinctive, descriptive or which have become customary may not be registered as trademarks. Since it is an exception to the rule, which

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<sup>11</sup> CJEU 6 May 2003, C-104/01, ECLI:EU:C:2003:244, point 66 (Libertel).

<sup>12</sup> CJEU 6 May 2003, C-104/01, ECLI:EU:C:2003:244, points 54 and 55 (Libertel).

<sup>13</sup> CJEU, 19 June 2014, C-217/13 and C-218/13, ECLI:EU:C:2014:2012, points 69-71 (Oberbank); BenCJ (second chamber) 6 February 2024, C-2022/15, point 15 (Yellow stitch).

sets aside the public interest underlying the grounds for exclusion, the bar for acquired distinctiveness is high. Acquired distinctiveness occurs when a significant proportion of the relevant public has come to perceive a sign that was initially (*ab initio*) devoid of distinctive character, as a result of the use made of it, as an indication that the goods or services for which it is registered originate from a particular undertaking. The sign has thus acquired a new 'meaning', so to speak, which is no longer descriptive or non-distinctive (in this case not 'just' a colour but a badge of origin), and has therefore become capable of distinguishing the goods or services in question from those of other undertakings. Acquired distinctiveness is generally the result of (very) long and intensive use.

35. In geographical respects, the bar of acquired distinctiveness is also high. Under the BCIP, the Benelux is an indivisible territory. This means that a sign can only be a valid trademark if it is valid throughout the Benelux. Acquired distinctiveness will therefore have to be demonstrated throughout the Benelux, or in any case there where the trademark was *ab initio* devoid of distinctive character<sup>14</sup>. In case of colour marks (or non-word marks in general<sup>15</sup>), it may be assumed that the assessment of distinctiveness will be the same for the entire Benelux public. Acquired distinctiveness must therefore be proven throughout the territory of the Benelux.

36. To prove acquired distinctiveness, all evidence may be submitted, in particular, concerning the market share held by the mark, how intensive, geographically widespread and long-standing the use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations, as well as opinion polls<sup>16</sup>.

37. The defendant provided a comprehensive overview of its commercial activities and the use made of the contested trademark and submitted a large quantity of supporting evidence. The defendant is obviously one of the largest telecom providers in the world, and has used the colour magenta in a consequent way for decades, either himself or through economically related entities, in many different manners: as part of its logo, in shops, websites, packaging, sim-cards, commercials, sponsoring activities, events, news items, etc... In the Netherlands, the defendant has been active under the name T-Mobile as one of (only) three telecom providers with their own physical network. From a market survey submitted by the defendant, it follows that around 60% of the respondents in the Netherlands, when shown the colour magenta and asked what comes to mind in relation to telecom services or products, reply that they think of the defendant. In Belgium and Luxembourg, the defendant seems not to be active as a telecom provider, at least not in the consumer market. The defendant claims to have been active in Belgium under the name T-Systems, but those activities appear to be more business-to-business and not aimed at the general public, to which the goods and services are (also) directed, and are in any case considerably less intensive than in the Netherlands. As the defendant correctly points out (*supra*, point 17), this does not necessarily preclude acquired distinctiveness, since the public can also become known with a trademark in other ways than by its actual presence on the market or by actually buying or using a product or service. However, it does

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<sup>14</sup> CJEU 7 September 2006, C-108/05, ECLI:EU:C:2006:530 (EUROPOLIS); BenCJ (second chamber) 16 June 2020, C-2019/6 (Pet's Budget); BenCJ (second chamber) 16 June 2020, C-2019/5 (Sports direct). The same logic applies for an EUTM, where distinctiveness must be proven throughout the EU (CJEU 25 July 2018, C-84/17 P, C-85/17 P and C-95/17 P, ECLI:EU:C:2018:596 (SHAPE OF A 4-FINGER CHOCOLATE BAR)).

<sup>15</sup> General Court EU 24 February 2016, T-411/14, ECLI:EU:T:2016:94, point 86 (shape of a bottle).

<sup>16</sup> CJEU 4 May 1999, C-108/97 and 109/97, ECLI:EU:C:1999:230 (Chiemsee).

make acquired distinctiveness less likely. While the defendant has certainly shown that the Benelux public outside the Netherlands has also been or may have been confronted with the sign in a variety of ways, the Office considers that it has not been sufficiently demonstrated that as a result, that part of the public has actually come to recognise it as a trademark. As the circumstances and extent of use in the Netherlands are clearly different from those in Belgium and Luxembourg, the results of the market survey also cannot be extrapolated<sup>17</sup>.

38. The Office concludes that the defendant has failed to prove that the colour magenta (or red) has acquired distinctiveness as a trademark throughout the Benelux.

#### **B. Other factors**

39. The claimant refers to the refusal of the magenta mark by EUIPO and the defendant states that it is registered in several other countries (*supra*, points 10 and 15). In this respect it should be recalled that BOIP has its own responsibility to take a decision on its own merits and based on the facts and circumstances presented and is not bound by decisions of other authorities.

40. To the extent that the defendant offers to submit further evidence (*supra*, point 19), it should be recalled that there is no place for such an offer within the system of Rule 1.31 IR. It is for the parties to decide what arguments they rely on and what evidence they deem useful to submit in support thereof<sup>18</sup>.

#### **C. Conclusion**

41. Based on the above factors, the Office finds that the contested trademark is (*ab initio*) devoid of distinctive character, and that acquired distinctiveness has not been proven.

42. Since the claim is upheld on the second ground for invalidity (Article 2.2bis(1)(b) BCIP), there is no need to further examine the first ground for invalidity (Article 2.2bis(1)(a) BCIP), nor the third ground for revocation (Article 2.27(2) BCIP).

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<sup>17</sup> General Court EU 6 March 2024, T-652/22, ECLI:EU:T:2024:152, point 111 and the case-law cited (*Veuve Clicquot*).

<sup>18</sup> BenCJ (second chamber) 18 October 2019, C-2018/2, point 16 (*NUTRILIFE*).

**IV. DECISION**

43. The application for cancellation is justified.

44. Benelux trademark registration 589410 is invalidated.

45. The defendant shall pay the claimant 1,420 euros in accordance with Article 2.30ter(5) BCIP in conjunction with Rule 1.44(2) IR, as the cancellation application is upheld in its entirety. This decision constitutes an enforceable order pursuant to Article 2.30ter(5) BCIP.

The Hague, 23 August 2024



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