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Acquired distinctiveness for non-traditional trademarks in the Benelux: show your true colours

Julius Stobbs, Pieter Van Den Bulck (Stobbs IP) · Tuesday, September 24th, 2024

Deutsche Telekom's Benelux trademark registration for a magenta colour mark was invalidated by the Benelux Office for Intellectual Property (BOIP) because it was unable to prove acquired distinctiveness throughout the Benelux[1].

The decision is an important reminder that non-traditional trademarks are often found to be *ab initio* devoid of distinctive character, and that the bar of acquired distinctiveness is high. It generally requires "(very) long and extensive use" in all three countries of the Benelux.

The colour mark was filed by Deutsche Telekom in 1995 when BOIP did *not* examine applications on absolute grounds yet. Lebara B.V. (Lebara) applied for cancellation in October 2022 and *inter alia* argued that the mark was devoid of distinctive character. BOIP agreed with Lebara that the magenta colour mark (which was somewhat misleadingly described as "red" in the application) was *ab initio* devoid of distinctive character, which required Deutsche Telekom to prove that the mark possessed acquired distinctiveness at the time of filing of the application for cancellation in October 2022.

Deutsche Telekom was able to produce extensive evidence that implied that the magenta colour mark had acquired distinctiveness in The Netherlands, including a survey performed among Dutch consumers which showed that 60% of respondents associated magenta with Deutsche Telekom in the context of telecom services.

However, due to less significant use in Belgium and Luxembourg, BOIP stated that the results of that survey could not be extrapolated, and subsequently concluded that Deutsche Telekom had failed to prove that the colour magenta had acquired distinctiveness as a trademark throughout the Benelux.

Interestingly, while Deutsche Telekom's survey ultimately did not help to prove acquired distinctiveness, the decision reconfirmed that national surveys *can* potentially be extrapolated into other Benelux member-states *if* the other evidence shows that use between all member-states was consistent. The Dutch courts, although adamant that acquired distinctiveness must be proven in all countries of the Benelux, tend to take the same position with respect to single-country surveys.

However, it is also important to point out that BOIP considers surveys to be supportive evidence only, while the European Union Intellectual Property Office (EUIPO) considers surveys to be the

most direct kind of evidence as long as they are conducted properly.

Colour marks and other non-traditional trademark such as shape marks, trade dresses and position marks generally require evidence of acquired distinctiveness at the time of filing.

This is particularly challenging in the Benelux since there can be significant differences in the duration and extent of use between member-states. Performing surveys in all three member-states is expensive but may be recommended if use patterns between The Netherlands, Belgium and Luxembourg are inconsistent. In the end, however, the strongest evidence are materials that prove such extensive use that the relevant public started associating the mark with the goods and/or services of the applicant.

[1] BOIP 23 Aug 2024, IEF 22210; (Lebara vs Deutsche Telekom)

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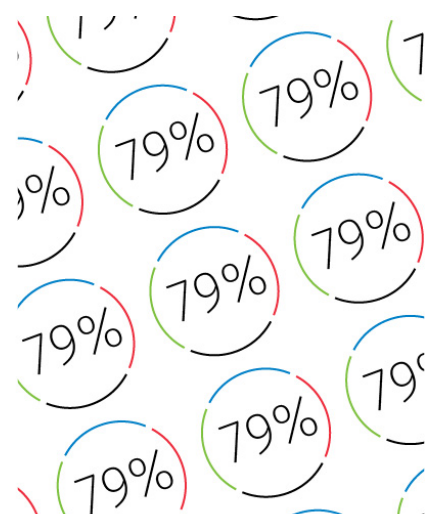
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