

Court of Justice of the European Union (CJEU) ruling clarifies “genuine use” in relation to wordless logos and colour...

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01 August 2013 by Kate Cruse

Black and white decision: Court of Justice of the European Union (CJEU) ruling clarifies "genuine use" in relation to wordless logos and colour...

Specsavers v Asda. Case C-252/12 - Judgement 18 July 2013

In February 2012 we published an article regarding the referral of this case to the Court of Justice of the European Union by the Court of Appeal (England and Wales) (CoA). See [here](#).

The Decision concerning that Referral was published on 18 July 2013; see [here](#).

The Referral

The CoA referred questions to the CJEU; in particular

1. Is a proprietor considered to be using the graphic mark, if the proprietor has separate Community trade mark registrations for a graphic device mark and a word mark, and uses the two together?
2. How should the Court assess that use in relation to a number of specific factors, such as if the proprietor has separately registered the combined mark as a Community trade mark, and whether the average consumer considers the graphic device and the words to be separate or independent marks?

In other words, does use of the following two marks (referred to below as the "shaded logo marks"):



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constitute use of the graphic mark (referred to below as the "wordless logo") as shown below?:



CJEU's Answer: YES.

Conclusion: The CJEU considers use of the shaded logo marks to constitute genuine use of the wordless logo mark, since use has been made "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered".

Reasoning Provided: "The condition of genuine use may be fulfilled where a Community figurative mark is used only in conjunction with a Community word mark which is superimposed over it and the combination of those two marks is, furthermore, itself registered as a Community trade mark, to the extent that the differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of the trade mark that was registered."

This reflects the earlier decision of Colloseum Holding (Case C-12/12) in which the CJEU held that use of the Levi's tab in the seam of a jean's pocket, including the word LEVI'S, (a composite mark) constituted genuine use of the registered trade mark - the famous Levi's tab in the seam of jean pockets, registered without the word LEVI'S incorporated into it.

1. The CoA requested guidance of the importance played by the commercial use of colour for a mark, registered in black and white, when considering the use of that mark. In particular: Can the enhanced reputation of the device in the colour green be taken into account, despite the fact that the trade mark was registered in black and white?

CJEU's Answer: YES

Conclusion: If you use your trade mark in one colour, only that can be taken into account when assessing whether or not there is a likelihood of confusion, and whether use of the later mark without due cause would be seen to take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

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Reasoning Provided: "Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours, the colour or colours which a third party used in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision."

"The fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision."

What does this decision mean to trade mark owners?

1. When applying to register a trade mark, if you are not sure of the colour you will apply to a device, it is best to file in black and white. Any use of the device mark in a colour scheme other than (and as well as) black and white should be deemed genuine use of the trade mark as registered. Thus, when the trade mark becomes sufficiently old to be attacked on the basis of non-use, any application for revocation should not prevail.
2. When applying to register a trade mark, if you are concerned that copycats will not use a similar word mark to yours, but use a similar background together with their word mark, through applying to register a wordless mark you may be able to prevent third parties from using the background mark, even if they incorporate a word mark in the foreground. This however does depend upon a global assessment of whether or not there is a likelihood of confusion bearing in mind the aural, visual and conceptual components of the marks.
3. If, once filed, a decision is made by the owner of a trade mark to only use a trade mark in one particular colour (in the case of Specsavers - in green) the trade mark owner is entitled to enhanced reputation through use of the mark in that colour. This is despite the fact the trade mark was registered in black and white. Thus, there should be no need to file a further trade mark application in the colour used, since the black and white mark affords broad protection.