

## New Common Practice for the Scope of Protection of Black and White Trade Marks

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On 15 April 2014 the European Trade Mark and Design Network (European tmdn) published a Common Communication relating to the convergence of the different way in which black and white and/or greyscale trade marks are handled at the various Trade Marks Offices of the European Union in relation to three areas, being:

- Priority
- Relative Grounds
- Genuine Use

Specifically, this communication does not extend to infringement issues; it only relates to practice followed by Trade Marks Offices.

The adoption of Common Practice in relation to the examination of priority actions answers the question:

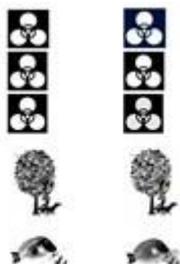
### **Is a black and white and/or greyscale trade mark from which priority is claimed identical to the same mark in colour?**

A trade mark in black and white from which priority is claimed is not identical to the same trade mark in colour unless the differences in colour are insignificant.

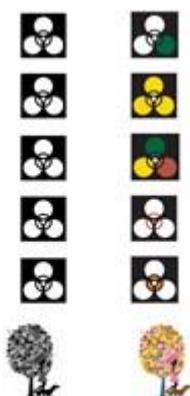
Similarly, a trade mark in greyscale from which priority is claimed is not identical to the same mark in colour or in black and white unless the differences in the colours or the contrast of shades are insignificant.

The term "insignificant difference" is to be interpreted as a difference that a reasonably observant consumer will perceive only upon a side by side examination of the marks.

Below are examples of what would be considered "insignificant differences"; that is the consumer would not perceive the change in colour.



Conversely, below are examples of what would be considered "significant differences"; that is the consumer would perceive the change in colour.



**ADVICE:** The acceptance or refusal of a priority claim may prove pertinent in a case. We recommend always filing a priority claiming application copying exactly the mark from which priority is claimed, thus ensuring the priority claim is deemed valid.

Turning to relative grounds, the following question is answered:

**Is an earlier trade mark in black and white and/or greyscale identical to the same mark in colour?**

The Common Practice stipulates that an earlier trade mark in black and white is not identical to the same mark in colour unless the differences are insignificant.

Similarly, an earlier trade mark in greyscale is not identical to the same mark in colour, or in black and white unless the differences in the colours or in the contrast of shade are insignificant.

Again the interpretation of "insignificant difference" is a difference between two marks that a reasonably observant consumer will perceive only upon a side by side examination of the marks.

**ADVICE:** Identity between an earlier trade mark and later mark is important when deciding an opposition or cancellation action on the basis of relative grounds. This is because if identical goods/services are covered there is no need to show that coexistence will lead to a likelihood of confusion including a likelihood of association. However, in practice, few cases involving figurative or stylised marks relate to identical marks, whether filed in colour or black and white/greyscale. Therefore, this question is unlikely to be of as much significance as the question of priority discussed above and the question of genuine use discussed below.

Lastly, the Common Practice adopted answers the question relating to genuine use:

**Is use of a colour version or a trade mark registered in black and white/greyscale (or vice versa) acceptable for the purposes of establishing genuine use?**

It has been decided that a change only in colour does not alter the distinctive character of the trade mark as long as the following requirements are met:

- a) the word/figurative elements coincide and are the main distinctive elements;
- b) the contrast of shades is respected;
- c) the colour or combination of colours does not possess distinctive character in itself; and
- d) colour is not one of the main contributors to the overall distinctiveness of the mark.

**ADVICE:** If you are unsure as to how your trade mark will be used long term, ideally we should file the application for you in the colours of interest and also in black and white/greyscale to ensure as broad a scope of protection as possible. If this is not a viable option, you may wish us to file one application only, in the colours you believe are going to be used as a first step. Then, once the trade mark has been registered for approximately 4 years, we can review the mark registered and compare it with the mark being used and decide whether or not to file a fresh application to ensure the continuation of rights.

This practice applies retrospectively. Therefore all black and white trade marks that are over 5 years old and only used in colour are potentially vulnerable to cancellation unless the requirements discussed above are met. If you applied to register your trade mark as a black and white trade mark over 5 years ago, we advise filing a fresh application in colour to ensure the continuation of rights.

Some issues were found to be outside the scope of the project set by European tmdn, namely:

- similarities between colours, including whether a trade mark filed in black and white and/or greyscale is similar to the same trade mark in colour with respect to relative grounds;
- identity when the earlier trade mark is in colour and the later mark is in black and white or greyscale (for identity the Common Practice focuses exclusively on black and white marks);
- use for the purpose of acquired distinctiveness;
- colour marks per se and infringement issues.

The Common Practice should have taken effect in all offices within 3 months of the date of publication of the Common Communication, namely by 15 July 2014. In the case of the Community Trade Marks Office (OHIM) the changes took effect from 2 June 2014. The UK Trade Marks Registry (UKTMR) implemented the changes a little later, on the deadline itself.

As regards the OHIM, all applications pending on the implementation date or applications filed after the implementation date, proceedings pending on the implementation date and all proceedings filed after the implementation date will have the new Common Practice applied to them.

The Common Practice applies to all UK applications filed after the implementation date and all proceedings in the UK filed after the implementation date. Thus, in the UK all applications pending on the implementation date and all proceedings in the UK pending on the implementation date will not have the Common Practice applied to them.

For further information relating to the other European member states implementation of the Common Practice please see the European tmdn website or ask your usual trade mark attorney at Forresters who will be happy to advise you thereon.