OHIM adopts new common practice on black and white trade marks

The Office for Harmonisation in the Internal Market (OHIM) has adopted a new common practice regarding the scope of protection of black and white trade marks. Under the new practice black and white marks will no longer automatically cover all colours.

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As announced in the latest edition of the Alicante News (November 2013), the Office for Harmonisation in the Internal Market (OHIM) has adopted a new common practice regarding the scope of protection of black and white trade marks. Under the new practice black and white marks will no longer automatically cover all colours.

Up till now, the practices of the various national offices with respect to black and white trade marks have differed. Where some offices apply the “black and white covers all colours” approach, the other offices apply the “what you see is what you get” approach. As a consequence, the scope of protection of the trade mark varies, and is uncertain for trade mark owners. A proposal for a new harmonized common practice has been endorsed by OHIM’s Administrative Board and Budget Committee in November.

As indicated by OHIM, the project focuses on whether a trade mark filed in black and white and/or greyscale is identical to the same trade mark in colour with respect to priority claims and relative grounds for refusal. Moreover, the project analyses whether the use of a colour version of a trade mark filed in black and white (and vice versa) is acceptable for the purposes of establishing genuine use. Outside the scope of the project remain matters like the assessment of similarities between colours, use of black and white trade marks in colour for the purpose of acquired distinctiveness, colour marks per se, as well as infringement issues.

**What is going to change?**

Under the new basic approach, identity between a trade mark filed in black and white and/or greyscale and a sign in colour exists only when the signs are the same in all respects, or the differences are so insignificant that they may go unnoticed by the average consumer. For a difference to be insignificant, it should be noticed by the average consumer only upon side by side examination.

**What does this mean in practice?**

**Priority claims**
Article 29 of Regulation 207/2009 on the Community Trade Mark (CTMR) provides that the applicant of a trade mark shall enjoy priority for the purpose of filing a Community Trade Mark application for “the same trade mark”. For priority claims, the new practice means that in case of insignificant colour differences between the first application and the subsequent CTM application, OHIM will allow the priority claim, where such claim would under the previous practice have been refused. However, this does not change the previous practice at OHIM that a trade mark registered in black and white cannot be used as a basis for a priority claim for a trade mark application in a coloured version, because this is not considered identical and will normally be noticed by the average consumer.

Relative grounds for refusal

The same approach applies as regards relative grounds for refusal. The differences between a black and white trade mark and one in colour will be noticed by the average consumer (and thus the trade marks will not be considered identical), unless they are insignificant, negligible and hardly noticeable.

Use

Article 15(1)(a) CTMR provides that the use of a Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, is considered as trade mark use. For the purpose of genuine use, according to OHIM, a change only in colour does not alter the distinctive character of the trade mark, as long as several requirements are met: the word/figurative elements coincide and are the most distinctive, the contrast of shades is respected, the colour or combination of colours does not have distinctive character in itself, and colour is not one of the main contributors to the overall distinctiveness.

The latter is in conformity with the judgment of The Court of Justice of the European Union (CJEU) dated 24 May 2012 (T-152/11, paras 41, 45) in the MAD case. In that case, the Court considered that use of a mark in a different form is acceptable, as long as the arrangement of the verbal/figurative elements stays the same, the word/figurative elements coincide, are the main distinctive elements and the contrast of shades is respected.

Conclusion

According to OHIM, the new common practice will have to be implemented in the next update of the OHIM Guidelines on trade mark practice. OHIM expects that the new practice will especially have a major impact on priority, as the Office will now accept priority claims that it previously would have objected to.

However, it still remains to be seen whether the new common practice will indeed be implemented in its current form and also in the Member States where the national offices (are currently bound by law to) adopt the “black and white covers all colours” approach. In its recent ruling in the Specsavers case of 18 July 2013, the CJEU did not anticipate any issues with the practice of black and white trade marks covering all colours. Rather to the contrary, the CJEU considered that “At the very least where there is a trade mark which is not registered in a particular colour or characteristic, but in black and white, the colour or combination of colours in which the trade mark is later used affects how the average consumer of the goods at issue perceives that trade mark, and it is, therefore, liable to increase the likelihood of confusion or association between the earlier trade mark and the sign alleged to infringe it.”

It is unclear whether the recent Specsavers ruling was taken into account by OHIM. If not, it remains to be seen whether the proposed common new practice will indeed be implemented as currently announced by OHIM. We will of course keep you updated on any new developments regarding the scope of protection of black and white trade marks.