

COMMON COMMUNICATION
SCOPE OF PROTECTION OF BLACK AND
WHITE (“B&W”) MARKS

15 APRIL 2014

1 BACKGROUND

The trade mark offices of the European Union in their commitment to continue to collaborate in the context of the Convergence Programme through the European Union Intellectual Property Network have agreed on a common practice with regard to trade marks in B&W and/or greyscale. The common practice is made public through a Common Communication with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

The subject of this Common Communication is the convergence of the different handlings of trade marks in B&W and/or greyscale as regards priority, relative grounds, and genuine use.

2 THE COMMON PRACTICE

The common practice consists of three parts:

PRIORITY

Objective	<i>Is a trade mark in B&W and/or greyscale from which priority is claimed identical to the same mark in colour?</i>
Common Practice	<ul style="list-style-type: none"> • A trade mark in B&W from which priority is claimed is not identical to the same mark in colour unless the differences in colour are insignificant*. • A trade mark in greyscale from which priority is claimed is not identical to the same mark in colour or in B&W unless the differences in the colours or in the contrast of shades are insignificant*. <p>*An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon side by side examination of the marks.</p>
Provisions	Article 4A(2) Paris Convention Article 29(1) CTMR

RELATIVE GROUNDS

Objective	<i>Is an earlier trade mark in B&W and/or greyscale identical to the same mark in colour?</i>
Common Practice	<ul style="list-style-type: none"> • An earlier trade mark in B&W is not identical to the same mark in colour unless the differences in colour are insignificant*. • An earlier trade mark in greyscale is not identical to the same mark in colour, or in B&W, unless the differences in the colours or in the contrast of shades are insignificant*. <p>*An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon side by side examination of the marks.</p>
Provisions	Article 4(1) TMD Article 8(1) CTMR

GENUINE USE

Objective	<i>Is the use of a colour version of a trade mark registered in B&W/greyscale (or vice-versa) acceptable for the purpose of establishing genuine use?</i>
Common Practice	<ul style="list-style-type: none"> • A change only in colour does not alter the distinctive character of the trade mark, as long as the following requirements are met: <ul style="list-style-type: none"> a) the word/figurative elements coincide and are the main distinctive elements; b) the contrast of shades is respected; c) 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. <p>For establishing genuine use, the principles applicable to trade marks in B&W also apply to greyscale trade marks.</p>
Provisions	<p>Article 10(1)(a) TMD Article 15(1)(a) CTMR</p>

2.1 OUT OF SCOPE

The following issues were out of the scope of the project:

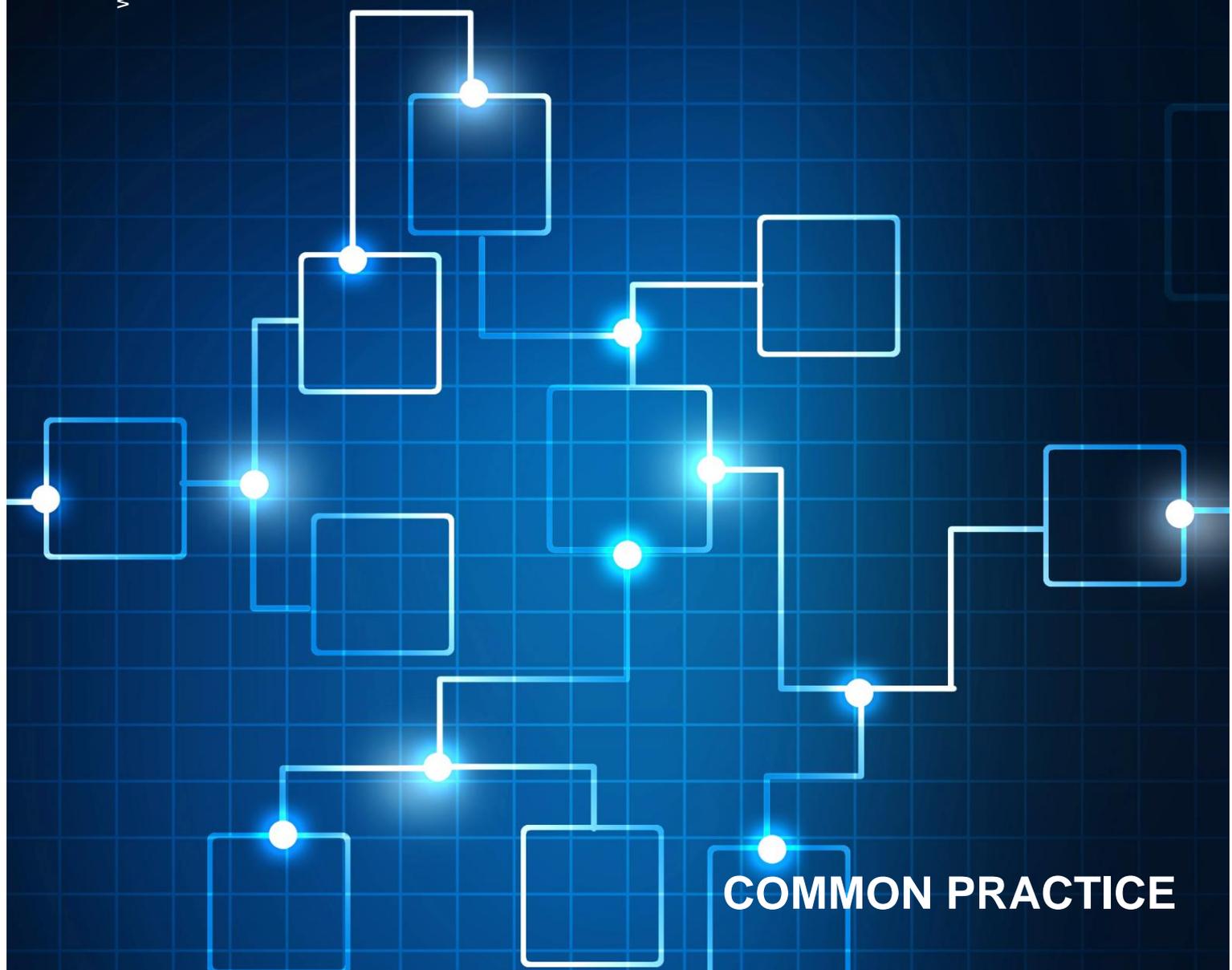
- Similarities between colours, including whether a trade mark filed in B&W and/or greyscale is **similar** to the same trade mark in colour with respect to relative grounds for refusal;
- **Identity** when the earlier trade mark is in **colour** and the later mark in B&W or greyscale (for identity the common practice focuses exclusively on earlier B&W marks);
- Use for the purpose of acquired distinctiveness;
- Colour marks per se;
- Infringement issues.

3 IMPLEMENTATION

As has been the case with previous common practices, the Common Practice will take effect within three months of the date of publication of this Common Communication.

Further details on the implementation of this Common Practice are available in the table below. Implementing offices may choose to publish additional information on their websites.

[List of implementing offices](#)



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1 PROGRAMME BACKGROUND

Despite growth in world wide trade mark and design activity in recent years, efforts to achieve convergence in the way offices around the world operate have only yielded modest results. Within Europe there is still a long way to go to iron out the inconsistencies among the EU IP offices. The EUIPO Strategic Plan identifies this as one of its main challenges to address.

With this in mind, the Convergence Programme was established in June 2011. It reflects the shared determination of national offices, the EUIPO and users, to move towards a new era among EU IP offices with the progressive creation of a European interoperable and collaborative network contributing to a stronger IP environment in Europe.

The vision of this Programme is **“To establish and communicate clarity, legal certainty, quality and usability for both applicant and office.”** This goal will be achieved by working together to harmonise practices and will bring considerable benefits to both users and IP Offices.

In the first wave the following five projects were launched under the umbrella of the Convergence Programme:

- **CP 1. Harmonisation of Classification**
- **CP 2. Convergence of Class Headings**
- **CP 3. Absolute Grounds – Figurative Marks**
- **CP 4. Scope of Protection of B&W Marks**
- **CP 5. Relative Grounds – Likelihood of Confusion**

This document focuses on the common practice of the fourth project: CP 4. Scope of Protection of B&W Marks.

2 PROJECT BACKGROUND

At the moment of initiation of the project, there was a division between the national offices regarding the scope of protection which should be given to trade marks registered in B&W. Some national offices applied the “B&W-covers-all” approach under which trade marks in B&W have protection for all colours and colour combinations, thus maximum protection, colour-wise. Other offices applied the “what you see is what you get” approach which gives protection to the mark as it is registered, meaning that trade marks which are filed in B&W are only protected as such.

The different practices and interpretations as regards B&W trade marks cause confusion for applicants applying for a mark in multiple offices, as it may not be interpreted the same way in all jurisdictions. This can lead to legal unpredictability in cases of priority, opposition decisions and use, where the conflicting trade marks are registered or seek registration in offices with different practices, since it is not clear which of the two interpretations will then be followed. Given that situation, the offices have seen the need for harmonisation concerning the scope of protection of B&W marks and have considered that a common practice would be beneficial for the users and for themselves.

There are four key deliverables in this project and each of them addresses a different issue, namely the following:

- 1) A **common practice including a common approach** described in a document and translated into all EU languages.
- 2) A common **communication strategy** for this practice.

- 3) An **action plan to put in place** the common practice.
- 4) An analysis of the needs to address the **past practice**.

These project deliverables will be created and agreed upon by the national offices and the EUIPO taking into consideration comments from user associations.

The first working group meeting took place on February 2012 in Alicante to determine the general lines of action, the project scope and the project methodology.

3 OBJECTIVE OF THIS DOCUMENT

This document will be the reference for the EUIPO, national offices and BOIP, user associations, applicants, and representatives on the common practice as regards B&W trade marks. It will be widely available and easily accessible, providing a **clear and comprehensive explanation of the principles on which the common practice is based**. In a next step, following the agreed project methodology, these principles will be applied to each particular case. However, there can be exceptions to these principles.

4 THE PROJECT SCOPE

The **scope** of the project is:

*“This project will converge the practice regarding a **trade mark filed in B&W and/or greyscale**, and*

*(a) determine whether the **same mark in colour is considered identical** with respect to:*

*i. **Priority claims***

*ii. **Relative grounds for refusal***

*(b) determine whether **use of the same mark in colour is considered use of the trade mark registered in B&W** (considering also trade marks registered in colour but used in B&W)”*

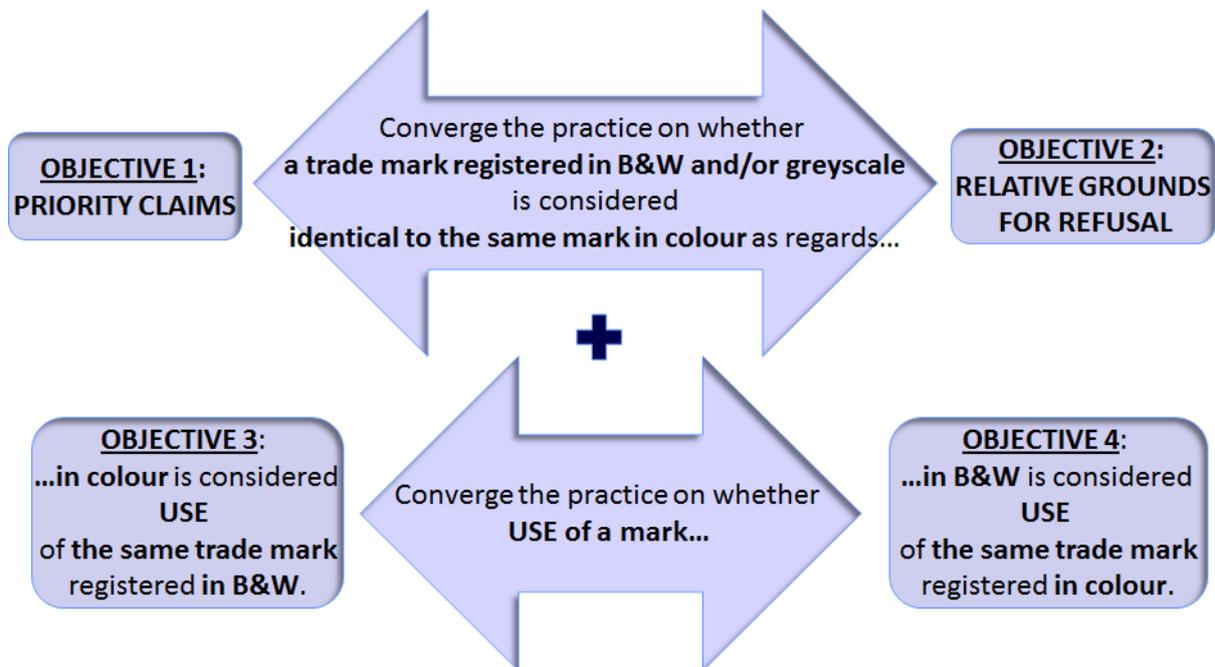
The following items are **out of the scope** of the project:

- Determine whether a mark in B&W is considered identical to a trade mark filed in colour, with respect to priority claims and relative grounds for refusal (reverse question).
- The assessment of similarities between colours.
- Marks registered in B&W that have acquired distinctiveness in a specific colour due to extensive use.
- Colour marks *per se*.

As agreed during the kick-off meeting in February 2012, **the project will not deal with infringement issues**.

By reorganising and giving structure to the project scope it is possible to identify four different objectives:

- To converge the practice on whether a trade mark registered in B&W and/or greyscale is considered identical to the same mark in colour as regards **priority claims**.
- To converge the practice on whether a trade mark registered in B&W and/or greyscale is considered identical to the same mark in colour as regards **relative grounds for refusal**.
- To converge the practice on whether **use of a mark in colour** is considered use of the **same trade mark registered in B&W**.
- To converge the practice on whether **use of a mark in B&W** is considered use of the **same trade mark registered in colour**.



5 THE COMMON PRACTICE

5.1 The concept of identity

In the context of the interpretation of Article 8(1)(a) CTMR (which corresponds to Article 4(1)(a) of the Directive), the Court states in its Judgment C-291/00 ‘LTJ Diffusion’ that **“a sign is identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”** (para. 54)

In the context of seniorities, the Court gives the same definition of identity as in *LTJ Diffusion* in its Judgment T103/11 ‘JUSTING’, (para. 16), indicating that the condition that the signs must be identical must be interpreted restrictively because of the consequences attached to such identity (paras. 17-18).

In addition to that, in its Judgment T 378/11 ‘MEDINET’, the Court also states that **“A concept which is used in different provisions of a legal measure, must, for reasons of coherence and legal certainty, and particularly if it is to be interpreted strictly, be presumed to mean the same thing, irrespective of the provision in which it appears.”**

In view of the above:

- The concept of identity applicable to relative grounds for refusal and to priorities must be interpreted in the same way.
- The criterion of identity between the signs must be interpreted strictly: either the two signs should be the same in all respects or they contain differences so insignificant that they may go unnoticed by an average consumer.
- As a consequence, two signs would be identical if the differences between a B&W and a coloured version of the same sign would only be noticed by an average consumer upon side by side examination.

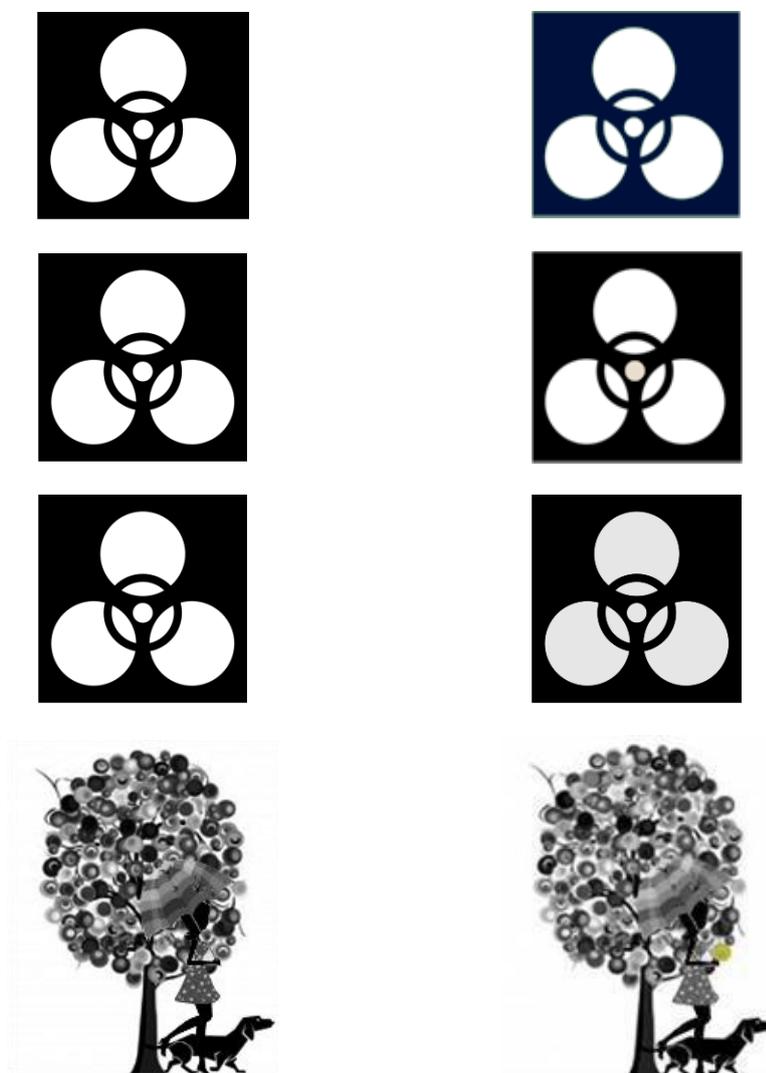
5.1.1 *What are “insignificant differences”?*

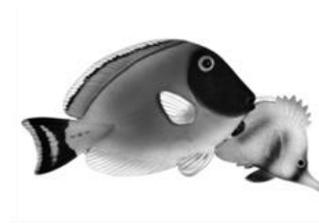
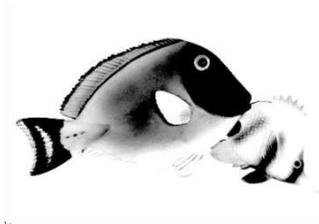
An “insignificant difference” could be defined as follows:

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

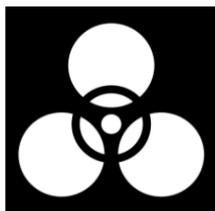
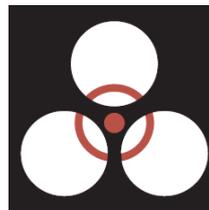
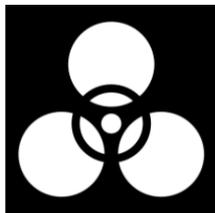
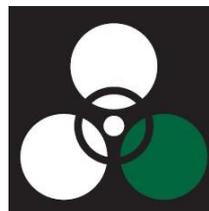
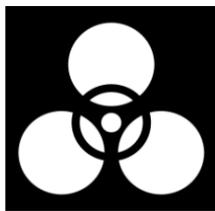
5.1.2 *Practical examples*

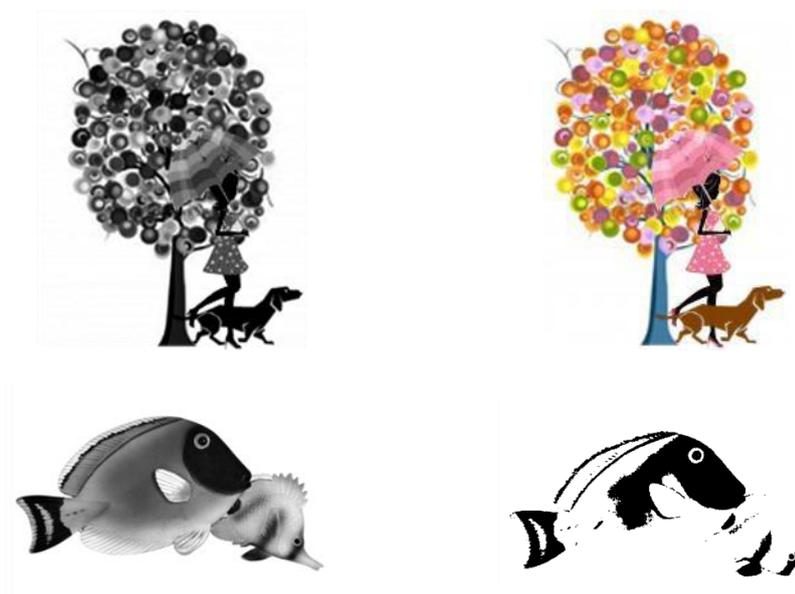
First, as regards what would be considered an “insignificant difference”, applying the above-mentioned definition, the following examples would be seen as **insignificant differences**, and therefore the change in colour would not be perceived by the consumer:





On the other hand, the following examples would be treated as **significant differences** and the change in colour would therefore be perceived by the consumer:





5.2 Priority

The principles of priority were first established in the Paris Convention for the Protection of Industrial Property of March 20, 1883. They have been revised several times and last amended in 1979 and ratified by many Contracting States.

Articles 4 (A)(2) of the Paris Convention states that “Any filing that is equivalent to a regular national filing under the domestic legislation (...) shall be recognized as giving rise to the right of priority”.

The priority right is limited in time. It is triggered by the first filing of a trade mark and may be claimed during six months following the first filing, provided the country of first filing was a party to the Paris Convention or to the WTO, or a country with a reciprocity agreement.

Sometimes the differences in colour that can exist are due to technical reasons (printer, scanner, etc.), since up to some years ago it was only possible to issue a priority document in B&W because colour printers or colour copiers did not exist. The document was therefore received in B&W irrespective of the colour in which the mark was originally registered. As this is not the case anymore, the difference between marks filed in colour and marks filed in B&W acquires more relevance.

A priority mark filed in B&W can contain a colour claim or not. The following possibilities exist:

- No colour claim whatsoever is present
- Specific colours (other than B&W and greyscales) are claimed
- The colour claim expressly states the colours black and white only
- The colour claim expressly states black, white and grey (the mark is in greyscale)
- The colour claim states that the mark is intended to cover all colours

For this reason, with regards to priority the marks need to be the same in the strictest possible meaning, and the examiner will object if there is any difference in the appearance of the marks. Therefore, and notwithstanding the technological differences or the colour claims, **a trade mark registered in B&W is not considered identical to the same sign in colour as regards priority claims. However, if the differences**

in colour are so insignificant that they may go unnoticed by the average consumer, the signs will be considered identical (1).

As a result of the aforementioned, the following practical implications can be drawn with respect to priorities:

- If the priority mark has no colour claim and is depicted in greyscale, it will be identical to the same mark with a colour claim stating “greyscale”, unless it contains “significant differences”
- If the priority mark has no colour claim and is depicted in B&W, it will be identical to the same mark with a colour claim stating “black and white”, unless it contains “significant differences”.

On the contrary,

- If the priority mark contains a colour claim “black and white” and the application is filed in colour (other than the colours black and white) the marks will not be identical and thus the priority claim will not be accepted, unless the differences are insignificant.

5.3 Relative grounds for refusal

According to Article 4(1)(a) of the Directive 2008/95/EC of The European Parliament and of The Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, “A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

- (a) *If it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected.”*

In accordance with Judgment C-291/00 ‘LTJ Diffusion’, the national offices and the EUIPO agreed on the following conclusion:

The differences between a B&W and a coloured version of the same sign will normally be noticed by the average consumer. Only under exceptional circumstances, namely where these differences are so insignificant that they may go unnoticed by an average consumer, will the signs be considered identical.

Therefore, it is not necessary to find a strict conformity between the signs. However, the difference in colour must be negligible and hardly noticeable by an average consumer, for the signs to be considered identical. The fact that the signs are not identical is without prejudice to a possible similarity between the signs which could lead to likelihood of confusion. Similarity, however, is outside the scope of this project.

5.4 Use

In general terms, Art.10.1 (a) of the Directive 2008/95/EC of The European Parliament and of The Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks states that:

“The following shall also constitute **use** within the meaning of the first subparagraph:

- (a) *use of the 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”*

(1) In relation to International Trade Mark Applications, the application form requires that where priority is claimed from a B&W mark containing a colour claim, the later mark be reproduced using the colours as claimed.

According to this article, use of the mark in a form different from the one registered still constitutes use of the trade mark as long as it does not alter the distinctive character of the trade mark. This provision allows the proprietor of the mark to make variations in the sign as long as these variations do not alter its distinctive character.

Therefore, it is not necessary to find a strict conformity between the sign as it is used and the sign as it has been registered.

As regards specifically alterations in colour, the main question that needs to be addressed is whether the mark as used alters this distinctive character of the registered mark, i.e. whether use of the mark in colour, while being registered in B&W (and the reverse question), constitutes an alteration of the registered form. These questions have to be answered on a case-by-case basis using the criteria below.

For the purposes of **USE**, a change only in colour **does not alter the distinctive character of the trade mark** as long as:

- The **word/figurative elements coincide** and are the **main distinctive elements**.
- The **contrast of shades is respected**.
- Colour or combination of colours does **not have distinctive character in itself**.
- Colour is **not one of the main contributors to the overall distinctiveness** of the mark.

This goes in line with the MAD case (Judgment of 24/05/2012, T-152/11, ‘MAD’, paras. 41, 45), where the Court considers 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.

5.5 Greyscale

It would be too difficult to make a distinction between grey consisting of black and white pixels, and the colour grey, making dependent the sort of protection on the type of grey.

a) Priority

A trade mark registered in greyscale is not considered identical to the same mark in colour as regards priority claims.

A trade mark registered in B&W should only be considered identical to the same mark in greyscale if the differences in the contrast of shades are so insignificant that they may go unnoticed by an average consumer.

b) Relative grounds for refusal

The differences between a greyscale and a coloured version of the same mark will normally be noticed by the average consumer.

Only under exceptional circumstances, namely where these differences are so insignificant that they may go unnoticed by an average consumer, will the marks be considered identical.

c) Use

For the purposes of **USE**, a change only in colour **does not alter the distinctive character of the trade mark** as long as:

- The **word/figurative elements coincide** and are the **main distinctive elements**.
- The **contrast of shades is respected**.
- Colour or combination of colours does **not have distinctive character in itself**.
- Colour is **not one of the main contributors to the overall distinctiveness** of the mark.