



Convergence

Frequently Asked Questions (FAQ) on Common Practice, version 2
CP4 Scope of Protection of B&W Marks

1. Is the Common Practice different from the previous practice?

The Common Practice means that some Offices will not change their previous practice at all, and some will only change it in part. Looking at the implementing Offices (AT, BG, BOIP, CY, CZ, DE, EE, ES, GR, HU, IE, LV, LT, MT, OHIM, PL, PT, RO, SI, SK, TR, UK) we can see the effects of the new Common Practice, as opposed to the previous practices:

Priority

There are thirteen Offices that are changing their practice with regard to priorities:

- previous practice more lenient than the Common Practice: 3 (CY, IE, PT)
- previous practice stricter than the Common Practice: 10 (BG, EE, ES, GR, HU, LT, LV, OHIM, SK, TR)
- no change from the previous practice: 9 Offices (AT, BOIP, CZ, DE, MT, PL, RO, SI, UK).

Identity, relative grounds

There are five Offices that are changing their practice with regard to a finding of identity between the marks for relative grounds:

- previous practice more lenient than the Common Practice: 2 (CY, GR)
- previous practice stricter than the Common Practice: 3 (BG, EE, LT)
- in 17 Offices the Common Practice doesn't change the previous practice (AT, BOIP, CZ, DE, ES, HU, IE, LV, MT, OHIM, PL, PT, RO, SI, SK, TR, UK).

Use

No Office will change its already existing practice with regard to use.

2. Will the trade mark Offices provide information about the impact of the Common Practice on the previous national practice?

This is up to individual Offices to decide. If they think it's appropriate, they can provide detailed information on the impact of the Common Practice on the previous national practice, its consequences and implications for the national users. The Common Communication on the Common Practice on the Scope of protection of B&W Marks also includes useful information on the implementing Offices, the non-implementing Offices, and the non-participating Offices.

3. How will the implementation of the Common Practice on the Scope of Protection of B&W marks help enhance legal certainty in this area?

Legal certainty depends on the clarity, quality and usability of the practice and its communication. Before this Convergence Project started, there was very little clarity in this area, which made it difficult for users. Only three Offices had firm guidelines on the scope of protection of B&W marks. The Common Practice will change this situation, for the benefit of

users. It will enhance legal certainty in respect of the following three specific aspects related to the handling of trade marks in black and white (B&W) and/or greyscale.

- Is a trade mark in B&W and/or greyscale from which priority is claimed identical to the same mark in colour?
- Is an earlier trade mark in B&W and/or greyscale identical to the same mark in colour when assessing relative grounds for refusal?
- 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 use?

When the working group began its meetings in February 2012 the replies to each of these questions were not clear, and varied from office to office. At the end of the project a clear Common Practice was approved, which is the same for all 23 implementing Offices.

4. Is there any recent case-law which supports the findings of the Common Practice?

Yes, there is the judgment of 09/04/2014, Case T-623/11 ‘Milanówek Cream Fudge’, which supports the findings of the Common Practice regarding B&W marks. Some of the most relevant findings are in paragraphs 37 et seq.:

37. (...) ‘it is necessary to reject the applicant’s arguments that the registration of a mark “in black and white” covers “all colour combinations which are enclosed within the graphic representation” and that, “[t]herefore, the [applicant] can claim protection for any combination of vertical stripes consisting of white and colour stripes, regarding whether the colour stripes are black, orange or yellow”’.

The judgment explicitly states that the registration of a mark in B&W does not cover all colours, and that a registration in B&W and in colour is not the same.

5. Common Practices are not legally binding, so what is the impact of the Common Practice for trade mark owners?

Even if the Common Practices are not legally binding, a number of Offices have agreed to implement them in their practice. As a consequence, users would be prudent to take this Common Practice into account because trade mark examiners are required to apply it when applying their Office practice. Trade mark owners can best prepare by referring to the updated Guidelines in the respective Offices, if available, and by following the subsequent judgments of the Court with regard to B&W marks.

The aim is to make users aware of what the Offices have agreed to do – jointly. It provides clarity for users – they have the reassurance of being able to easily access the new practice via the

participating Offices' websites – and of knowing that all participating Offices share the same practice. It gives users more predictability.

The Common Communication takes the relevant recent case-law into account. The Common Practice is based on a solid legal ground, taken from the case-law of the Court. Explicit reference is made to the following Cases: C-291/00 'LTJ Diffusion', T-103/11 'Justing', T-378/11 'Medinet', T-152/11 'MAD'.

6. Why did Italy, France and Finland not take part in this Common Practice?

Participation is completely voluntary – this is very much at the heart of the Convergence Programme's ethos. So, if an Office doesn't want to participate in a particular programme, for whatever reason, it doesn't preclude the rest of the Offices from taking part – or from joining at a later date.

7. Does the Common Practice apply to marks filed in colour?

The Common Practice only applies:

- for the purposes of priority, to marks in B&W from which priority is claimed;
- for the purposes of relative grounds, to earlier trade marks in B&W;
- with respect to proof of use, to both marks filed in B&W/greyscale marks, as well as to marks filed in colour.

For the sake of clarity, it is to be stressed that colour marks per se are expressly out of the scope of the Common Practice.

8. Does the Common Practice apply only to figurative marks?

The Common Practice deals with the interaction between B&W/greyscale and colour versions of the same mark. The Common Practice does not apply to word marks, but it is principally concerned with figurative marks with or without additional word elements. It is up to the participating trade mark Offices to consider whether the practice will also be relevant for other types of marks and to what extent.

9. In section 5.2 of the Common Practice the following is stated: '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'**

Is the above mentioned formulation summary of all possible options that can occur in the Member States (which means not necessarily all options in every state)?

Or does it mean that the Offices have to offer all above mentioned possibilities to the applicants?

The Common Practice does not define which types of colour claims are acceptable in each Office, or even if colour claims should be acceptable or not. In fact, some Offices do not accept colour claims in their national trade mark procedures at all. The Common Practice merely refers to colour claims in order to point out that sometimes a trade mark filed in B&W might actually be a colour mark, because of the colour claim. This is especially important in the case of filing international trade marks, and for that reason the document contains a reference to international trade mark application forms.

10. Did the working group take into consideration the relevant provisions of the Paris Convention for the creation of the Common Practice?

Yes, Article 4(a)(2) of the Paris Convention has also been taken into account when considering the concept of identity with regard to priority, as is reflected in section 5.2 Priority, of the Principles of the Common Practice.

11. Is the Common Practice compatible with the international applications of the Madrid system with respect to priorities?

Yes, it is fully compatible with the Madrid system.

In general, when an international application is filed, the Office of origin certifies that the application includes a reproduction of the mark that is the same as the mark in the basic application and/or registration. As this is the responsibility of the Office of origin, WIPO does not check this again when it receives the international application.

A trade mark filed through the Madrid System gives the mark the same protection in each of the designated Contracting Parties as if the mark had been the subject of an application for registration filed directly with the Office of the Contracting Party. This means that the scope of protection of the trade marks will be decided by the designated Office and/or the national courts of the designated contracting party.

The working group concluded that the Common Practice does not create any new consequences that do not already occur. However, having a converged solution will greatly enhance the legal security and consistency of international applications where the Office of origin and the destination Office both implement the Common Practice.

The Common Practice document, in section 5.2 on priority, refers to WIPO's application for international registration form, and clarifies that if priority is claimed from a B&W mark containing a colour claim, a colour reproduction of the mark must also be filed.

12. Even if the marks are not identical, can there still be likelihood of confusion between a B&W/greyscale mark and a colour mark?

Yes, the Common Practice indicates that the B&W/greyscale and colour figurative marks will be considered identical, if the differences between them are insignificant. However, even if there is no identity, this does not exclude that Article 8(1)(b) CTMR or national provisions transposing Article 4(1)(b) TMD could still be applicable in these cases. That is, there could still be likelihood of confusion if the marks are considered similar and the other necessary factors are present.

13. Is the conclusion regarding priority, relative grounds and use always the same when comparing B&W/greyscale and colour figurative marks?

In the context of priorities and relative grounds the definition of identity between a mark in B&W and/or greyscale and a later mark in colour coincides. Therefore the conclusion is the same and the main factor to take into account is whether the colour mark has differences that are **insignificant** compared to the B&W/greyscale mark. If significant differences exist between the marks, the colour mark is considered not identical to the sign in B&W/greyscale. If the differences are insignificant, the marks are considered identical.

With respect to use, a change only in colour **does not alter the distinctive character** of the trade mark as long as the four requirements reflected in section 5.4 of the Principles of the Common Practice document are met.

14. Does an application in B&W cover all colours?

No, it does not. According to the Common Practice, B&W marks do not have an unlimited scope of protection. However, this does not mean that, with the Common Practice, trade mark owners are required to register their trade marks in one or more colours to obtain the protection that they had before the Common Practice. This is because the Common Practice does not change the practice in the vast majority of cases.

15. Does a proprietor have to prompt multiple filings as a result of the Common Practice?

If a proprietor was under the impression that by filing a B&W mark all colours were covered, then he may wish to re-consider his filing strategy. The Common Practice has clarified that an application in B&W does not cover all colours.

According to the Common Practice, for priorities and relative grounds a trade mark in B&W or greyscale is not identical to the same mark in colour unless the differences in colour are insignificant.

Further, in practical terms, the agreed Common Practice regarding identity of a trade mark in relative grounds is without prejudice to a possible finding of similarity between the signs which could lead to likelihood of confusion.

Regarding genuine use, the agreed Common Practice will not in itself require a trade mark proprietor to prompt multiple filings. In accordance with the Common Practice, use in colour does not normally alter the distinctive character of a mark registered in B&W (or vice-versa) and therefore serves to maintain the registration. In certain circumstances, the colour or colour combinations possess distinctive character in themselves, or the colour is one of the main contributors to the distinctiveness of the sign. In such cases, a change in colour would alter the distinctive character of the registered trade mark, and would not be acceptable for the purpose of establishing genuine use.

This practice on use is not new as it confirms the already existing practice of all implementing Offices. However, it serves to establish clear guidance for users and Offices alike.

16. Why does the Principles of Common Practice document, in the section which describes the Common Practice on use, include the first requirement which states: ‘The word/figurative elements coincide and are the main distinctive elements’ ? Doesn’t this requirement refer to use in general and not in particular to B&W marks?

This is true. That the word/figurative elements coincide and are the main distinctive elements is a requirement that refers to use in general. However, only when this first requirement is met should one start to analyse the colour issue present in the three other requirements. So it is of practical use to keep all four requirements.

17. What do the third and fourth requirements regarding use actually mean in practice?

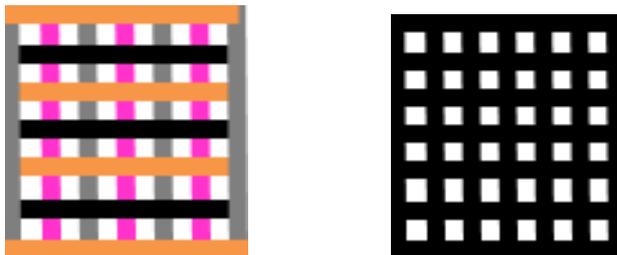
The Common Practice will not in itself require a trade mark proprietor to prompt multiple filings. The implementing Offices do not consider that the Common Practice is different from

the already existing practice on proof of use. It is mostly exceptionally, if any of the four requirements of the Common Practice are not met, that the use of a B&W trade mark in colour (or vice-versa) will not be considered sufficient to fulfil one of the general preconditions for establishing genuine use.

The Common Practice emphasises the fact that the distinctive character of the registered mark should not be altered. A change only in colour does not alter the distinctive character of the trade mark, as long as four requirements are met. The last two requirements are:

- colour or combination of colours does not possess distinctive character in itself and;
- colour is not one of the main contributors to the overall distinctiveness of the mark.

With respect to the colour (or combination of colours) of the registered trade mark possessing or not distinctive character in themselves, the underlying idea is that on occasions, it is actually the colour or colour combination that possesses the distinctive character. For example, refer to the signs below, where the distinctiveness of the sign on the left could be considered to come from its colours or colour combinations, thus making it difficult for the owner to prove use if the mark is only used in black and white.



On other occasions, the colour can be the main contributor to the distinctiveness of the sign, for instance if the following sign would be registered in the colour blue for 'fruit' or 'ice cream', the colour blue could be seen a main contributor to the distinctiveness of the sign, thus making it difficult for the owner to prove use if the mark is only used in B&W:



18. What is the implication on priority claims in those Offices where absolute and relative grounds are examined together and there is a relative ground proceeding pending for decision?

The Offices that have already taken a decision at an earlier stage on whether a priority claim is acceptable will not revisit such decisions.

19. Is the Common Practice in line with Case C-252/12, ‘Specsavers’?

Although infringement cases and acquired distinctiveness through use are expressly out of the scope of the CP4 project, the Specsavers judgement was carefully assessed.

In Specsavers, the Court considered the extensive use of a B&W trade mark in a specific colour or colour combination, and that this use can become associated in the mind of the consumer to the registered sign. For the Court this may be an additional factor to consider when assessing likelihood of confusion. However, this finding does not equate, neither directly or indirectly, to a confirmation that a B&W mark merits protection in any and all colours and regardless of the circumstances.

The possibility of a B&W trade mark being used in colour is described in the Common Practice document, and is in line with the Specsavers judgment. Therefore, the principles agreed upon with the working group and described in the Common Practice remain unaffected by the Specsavers judgment.

The General Court in Case T-623/11, ‘Milanówek Cream Fudge’, in paragraphs 38 and 39, makes reference to the ‘Specsavers’ judgment. In paragraph 39 it is stated that a mark registered in B&W can in fact be used in colour and even become associated in the mind of the consumer with the earlier mark, further stating that:

39. (...) “That does not, however, mean, contrary to what the applicant maintains in its written pleadings, that the registration of a mark which does not designate any specific colour covers ‘all colour combinations which are enclosed within the graphic representation’”.

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