

Practice Paper

Scope of Protection of Black and White Marks

**Ministry of Economic Development
of Montenegro**

Note from the Ministry:

This Practice Paper has been prepared in line with the Common Communication resulting of the Common Practice of Trade Marks developed by the European Union Intellectual Property Network (EUIPN) and aimed to give guidance about the scope of protection of black and white (B&W) trade marks. Once tailor-made to the specificities of the Ministry of Economic Development of Montenegro, it will provide for an overview of the Ministry's quality standards for applications.

This Practice Paper, once adopted at national level, could be made public with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

1. BACKGROUND

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.

This Practice is made public through this Practice Paper with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

The following issues are 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.

2. THE PRACTICE

The following text summarizes the key messages and main statements of the principles of the Practice Paper.

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 4(2) Paris Convention Article 29(1) CTMR

RELATIVE GROUNDS

Objective	<i>Is an <u>earlier</u> 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*. • *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.
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	Article 10(1)(a) TMD Article 15(1)(a) CTMR

A close-up photograph of a person's hands holding three interlocking puzzle pieces. The person is wearing a light-colored suit jacket and a white shirt. The puzzle pieces are light blue and are being held in a way that they appear to be coming together. The background is slightly blurred, focusing attention on the hands and the puzzle pieces.

The Practice

**Scope of protection of
black and white trade marks**

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1. INTRODUCTION

This document is the reference for IP offices, user associations, applicants and representatives on the 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 practice will be based.

2. 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:*

Priority claims

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)”*

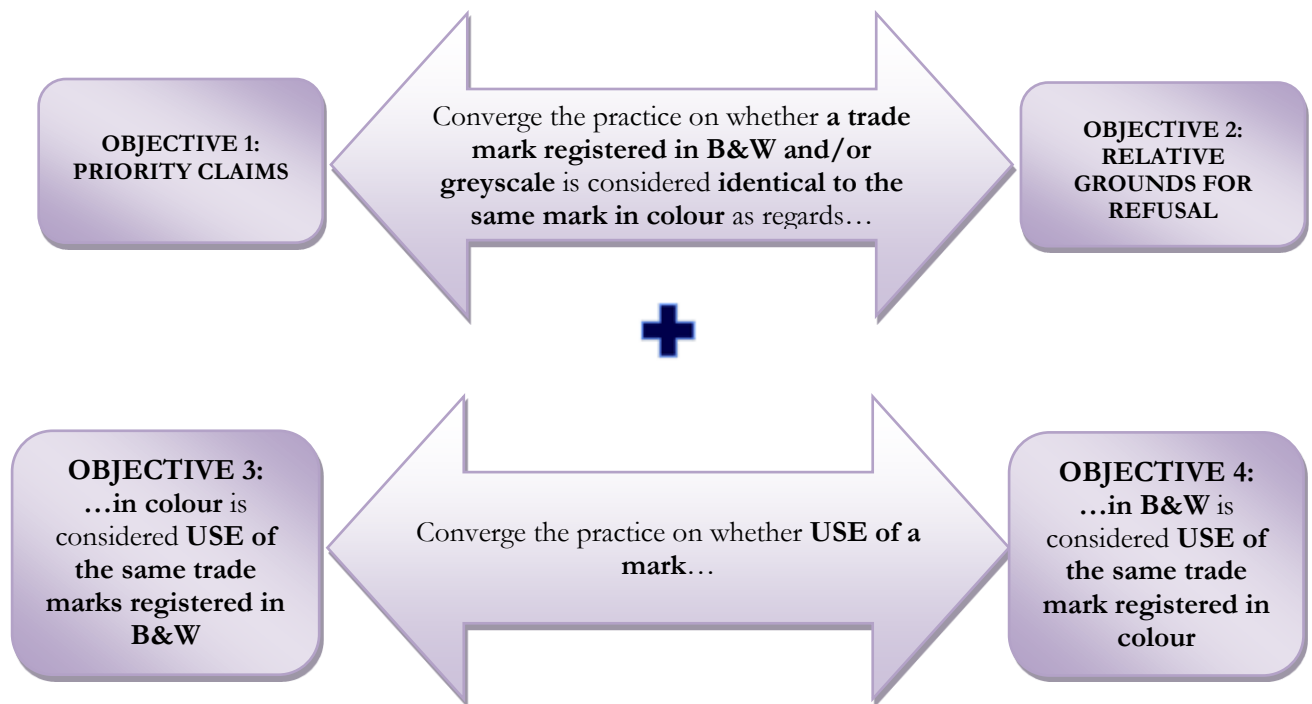
The following items are **out of the scope** of the project:

- 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*.
- 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**.



3. THE PRACTICE

3.1 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 sameway.
- 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.

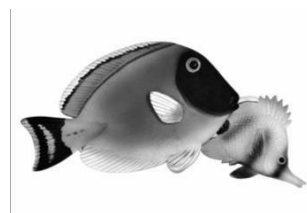
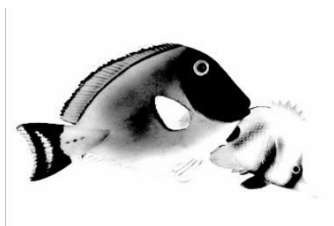
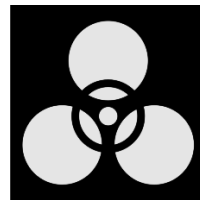
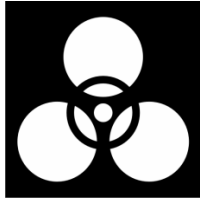
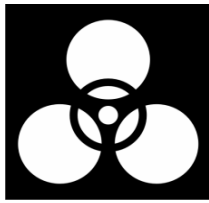
3.1.1 What are “insignificant differences”?

An “insignificant difference” could be defined as follows:

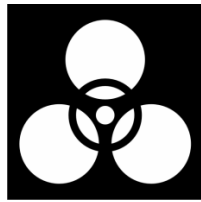
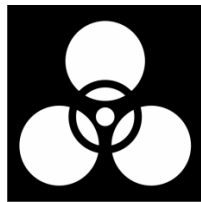
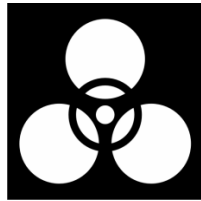
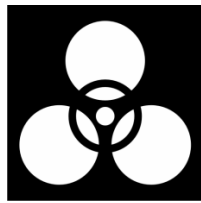
An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon side by side examination of the marks.

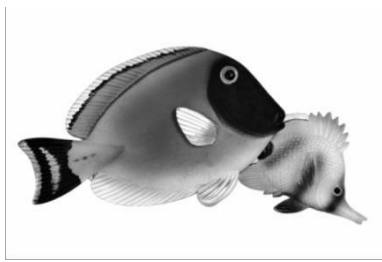
3.1.2 Practical examples

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:





3.2 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*** (*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).

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.

3.3 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 OHIM 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.

3.4 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**’

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.

3.5 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.

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