

Is it Really Black & White?

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The Convergence Programme was established in 2011 with the aim of addressing the inconsistencies in the operation of the intellectual property offices within the European Community (“EC”). The stated vision of the Programme is “to establish and communicate clarity, legal certainty, quality and usability for both applicant and office”. One of the first projects addressed by the Programme was the scope of protection of black and white trade marks. Recently, OHIM released a Common Communication on this issue which will be put into common practice by the intellectual property offices within the EC that have taken part in the project such as the United Kingdom IPO. The date of implementation will vary according to the IPO concerned, however, OHIM has implemented the new common practice on 2 June 2014 and the UKIPO will follow suit on 15 July 2014.

Traditionally, in many jurisdictions such as the United Kingdom, the practice has been that a figurative trade mark or composite trade mark (word and logo) in black and white covers all colours and colour combinations and therefore is the strongest form of protection from a colour perspective. Other IPOs in the EC have applied a narrower approach under which a trade mark is limited to the form in which it is registered, hence a trade mark filed in black and white is limited to just that and does not extend to all colours. The convergence of practice on black and white trade marks is limited to consideration of (i) Convention priority claims; (ii) relative grounds for refusal of a trade mark application; and (iii) genuine use of a trade mark. The practice does not extend to acquired distinctiveness, infringement, colour marks per se or the assessment of similarities between colours.

Convention Priority Claims

When looking to obtain registered trade mark rights overseas, businesses often utilise the benefits of Convention priority, that is, the ability to file applications overseas which take the earlier filing date of the first application filed for that trade mark (which for local businesses is usually filed in New Zealand) despite being filed later provided they file overseas within 6 months of the date of filing that first application.

Under the OHIM common practice, an application will only be able to claim the Convention priority date of an earlier filed trade mark where the two trade marks are identical in all respects or they contain differences that are so insignificant that they may go unnoticed. In other words, in the context of black and white trade marks, the trade marks will be viewed as identical where the differences between a black and white trade mark and a colour version of the same trade mark would only be noticed by an average consumer upon a side-by-side comparison, that is, upon close inspection.

Genuine Use

Under European Community trade mark law, use of a trade mark in a form different from the registered form constitutes use of the registered trade mark provided it does not alter the distinctive character of the trade mark. Under the OHIM common practice, use of a trade mark in colour where the registered form is in black and white will not alter the distinctive character of the trade mark provided:

- the word/figurative elements remain the main distinctive elements and coincide;
- shade contrast is respected;
- the colour/combination of colour is not distinctive in itself;
- colour is not one of the main contributors to the distinctiveness of the mark as a whole.

It is important to recognise that this change in practice could mean that trade marks that have been on the European Community Trade Marks Register, UK Trade Marks Register or the register in other EC implementing countries, for the requisite non-use period (generally 5 years) may now be vulnerable to removal from the Register for non-use because use of the trade mark in colour may not be considered to be use of the registered black and white trade mark.

Relative Grounds for Refusal

Under European Community trade mark law, a trade mark shall not be registered if it is identical with an earlier trade mark and the goods/services applied for are identical to the goods/services covered by the earlier trade mark. Under the common practice, the test for determining the similarity or otherwise of a black and white trade mark and a version of that trade mark in colour is whether the difference is negligible and hardly noticeable by the average consumer. Only where the difference is insignificant will the trade marks be considered to be identical. The result of the new common practice will therefore be that black and white trade marks, in the implementing jurisdictions, are afforded narrower protection than they have traditionally enjoyed. In the context of an opposition, the owner of a black and white trade mark opposing a version of that trade mark in colour, will now have to establish, by way of evidence, that there is a likelihood of consumer confusion rather than being able to rely on the absolute protection afforded to identical trade marks because a black and white registration no longer has the reach it once did.

It is important to remember that the Common Practice is just that and is not European Community trade mark law. However, until such time as it is challenged, trade mark owners will need to be careful. Owners of black and white European Community registrations, UK registrations and registrations in other participating EC jurisdictions may wish to review their registrations in light of the way they actually use those trade marks in the marketplace to determine whether they should strengthen their current protection. Furthermore, when considering filing in the EC, trade mark owners should consider the differences in protection afforded by black and white registrations versus colour registrations and perhaps look to file both forms to strengthen their IP.

Baldwins will be closely watching to see whether or not this practice infiltrates other jurisdictions, in particular, New Zealand and Australia. It is something we will take into account when advising on protection strategies in the future.

For more information, please contact:



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