



GARVEY SCHUBERT BARER LEGAL UPDATE

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INTELLECTUAL PROPERTY – TRADEMARKS

BLACK / WHITE AND COLOR TRADEMARKS: COMMON PRACTICE CHANGES

A question we often receive when discussing trademark applications with a client is whether to register a design element with a trademark, and what colors to use for such filings. In the U.S. and in many foreign countries, a black and white (or grayscale) registration for marks with design elements provides rights to all color combinations for that design. In the U.S., then, the default has been to initially seek registration of a mark in black and white rather than color, which is then able to protect the mark in a strong and broad manner. This idea is similar to the practice of registering a mark in “standard font” and having it broadly cover use in any font – a flexibility trademark owners appreciate and value. The strength and scope of the black and white registration is, however, undergoing a change in the European Union.

Unifying a Patchwork of Standards.

As electronic filing of trademarks has increased worldwide, and with better technology for displaying marks in specific colors, a growing number of countries in Europe have differentiated between trademarks registered in black and white and those registered in color. Similar to the dwindling practice for International Class headings (that a specification that covers the ‘class heading’ in fact covers all goods or services in the class), since it is then unclear what the scope of the registration is, as EU countries seek greater precision and predictability, there is now a patchwork of standards across European Union. To remedy this situation, and reflecting the growing importance of consistent laws and practices, most of the European Union countries have recently agreed upon a new common practice for handling the design trademarks. By mid-July 2014, black and white marks will be considered identical to the same mark in color only where the differences between the designs are so

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insignificant that they may go unnoticed. An “insignificant” difference is one that a reasonably observant consumer will only see in a side by side examination of the mark.

Identical vs. Likely to Be Confused.

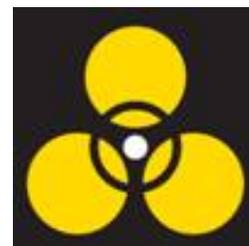
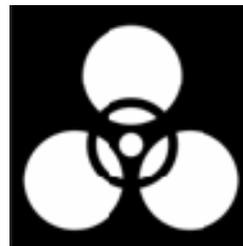
These standards are currently only applicable to opposition proceedings with the Community Trade Mark Office, and to date not directly pertinent to infringement issues. For oppositions, examples of whether or not a change from black and white to color would be significant are demonstrated in the April 15, 2014 publication from OHIM on the *Common Communication on the Common Practice of the Scope of Protection of Black and White (B&W) Marks*.

Examples.

The following marks, according to the OHIM publication, would be deemed identical, i.e., depicting insignificant differences:



On the other hand, these next marks *would not be deemed identical*, i.e., depicting significant differences:



See *Common Communication on the Common Practice of the Scope of Protection of Black and White (B&W) Marks*: <https://www.tmdn.org/network/documents/89965/a408d6eb-1b38-418e-b6aa-728d34f45b30>.

Likelihood of Confusion Issues.

These examples depict what the Community Trade Mark Office has determined to be differences that are either hardly noticeable by an average consumer (negligible), or, on the other hand, significant. If the marks are not identical, then there may still be a finding of similarity sufficient to lead to a likelihood of confusion, but this change in practice will result in a narrower scope of protection for black and white marks, at least before the trade mark registries.

Adoption of a rule where black and white registrations are no longer equivalent to color registrations for most trademarks may impact disputes outside the Community Trade Mark Office as well, though a determination that a mark is not "identical" does not mean that infringement or likelihood of confusion can not be prevented or halted. Preventing the use of an identical mark in relation to identical

goods or services in the European Union does not require a likelihood of confusion, since the marks are deemed identical, so the burden on the plaintiff is less than if the marks are seen as having significant differences. However, should an infringer use a trademark owner's mark in a different color, such use would still likely constitute use of a 'similar' mark, and the trademark owner would then need to show that there is a likelihood of confusion to prevail in a claim of infringement.

Priority, Use, and Renewal Issues.

Although the unification of these standards primarily applies to trademark oppositions or disputes, these standards have an effect on the continuation of trademark rights. When filing new applications to update existing registrations, and claiming priority based on the earlier registrations, the issue of color must be considered. If the marks are deemed non-identical based on significant differences in the colors (i.e., an earlier registration in black and white, a later application in color), the applicant may not be able to claim priority based on the earlier registration. The question also arises whether a mark registered in black and white but used in color is considered "in use," and there is uncertainty as to whether use of such a mark in color will satisfy the use and renewal requirements. Although this more uniform standard is one adopted by the Community Trade Mark Office and the national offices, ultimately, it will be a court that has the final say.

File in Color AND Black and White?

As a result of these common practice guidelines, to offer full protection for design marks, registration in both the black and white (or grayscale) version and the color version may be prudent. While these specific common practice guidelines are only applicable so far only to most of the European Union countries (Denmark, Sweden, and Italy cannot implement the new common practice as they are at present legally bound to the opposite – the 'black-and-white-covers-all' approach), it will impact trademark filings starting in the U.S. because of the extension of U.S. registration rights through priority filings.

Conclusion.

Based on this, we recommend that both existing registrations and future applications for design marks be reviewed in light of the European Union policy changes, and additional applications be considered in the U.S. and Europe based on the color version(s).

For further information:

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