"It don't matter if you're black or white" – or does it?

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This article is not an analysis of a song by Michael Jackson, but rather a review of the current scope of protection for device marks registered in black and white as Community trademarks. Below, 'device marks' are defined as trademarks that contain one or more device elements, as opposed to pure word marks.

Imagine that your client's marketing department has created a brilliant new device mark and it is your task to ensure that this device mark obtains the best and broadest scope of protection within the European Union. The device mark will be used on different types of product where the colours of the mark may vary. Should you file a trademark application for each variation or would a black and white version suffice?

The short answer is that you should file for all variations, as well as the black and white version, if the applicant can afford it. Since this is rarely the case in this age of budget restrictions, you need to know the consequences of filing only a black and white version of the mark.

In the majority of national trademarks offices in Europe, filing a device mark in black and white will give the rights holder maximum protection for the mark. In Denmark and Sweden for instance, a black and white device mark registration will provide protection in any range of colours.

However, since obtaining a Community trademark registration through the Office for Harmonisation in the Internal Market (OHIM) an easier and much more cost-effective way of securing protection for the mark in the 28 EU countries, you will naturally choose this filing route rather than file 28 national trademark applications, pay 28 national application fees and deal with examination from 28 national offices.

Under OHIM's current registration practice, however, a device mark filed in black and white will not grant the owner the broadest scope of protection for the mark. A Community device mark (or an application for a device mark in black and white designating the European Union under the Madrid Protocol) is considered to protect the mark in black and white only. This has some interesting consequences.

EYE OF THE TIGER

Let us look first at the scope of protection in proceedings before OHIM. Since OHIM considers that the device mark is protected in black and white only, this may influence

OHIM's assessment of the likelihood of confusion in opposition or cancellation proceedings. Imagine that you have become aware that a third party has filed a Community device mark in colour that appears to be similar to your client's Community device mark registered in black and white. You file an opposition and OHIM's Opposition Division examines the case. Obviously, the Opposition Division will examine the similarity of the marks, including any visual similarities; here the earlier choice of registering in colour or not may have a decisive impact.

In a decision of October 30 2012 in Opposition B 1 620 650, for instance, OHIM's Opposition Division concluded that there were no visual similarities between the two marks



Earlier mark (EU designation)



Contested mark (Community trademark)

below, which, to some extent, covered identical services – namely, financial services.

Both marks show the eye of a tiger, but while the earlier mark is in black and white, the contested mark is in colour. However, despite the fact that such device elements do not appear to be commonly used in connection with financial services, OHIM's Opposition Division found that there was no risk of confusion on the following grounds:

> *It is the opinion of the Opposition Division that the mere common association between two images in semantic terms is, therefore, not enough. The signs must, in the first instance, represent visual (graphical) similarities. This means that clearly visible differences in the graphic representation of common elements and symbols will usually (and in the absence of reputation of the earlier marks) suffice to exclude a likelihood of confusion, even if the underlying concept is not altered. In the present case the signs are all visually dissimilar, since all of their individual elements are different in shape, size and colour. Nor did the opponent submit evidence in order to prove that its trade marks enjoy reputation or enhanced distinctiveness.*

Below is how the opponent's trademark is used online.



It seems likely that had the opponent filed its Community device mark in colour, it would probably have had a better chance of convincing OHIM that there was a likelihood of confusion between its mark and the contested mark. This is an example of where protection of the Community trademark in black and white did not provide the owner with the broadest scope of protection.

SPECSAVERS

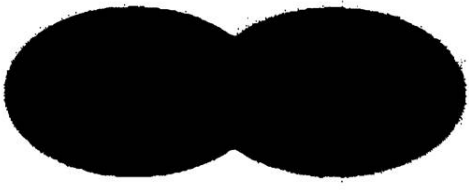
A July 2013 decision of the European Court of Justice (ECJ) has led to some confusion as to whether the scope of protection of a Community trademark in black and white

does after all provide protection of the mark in colour. The case (*Specsavers International Healthcare v Asda Stores Ltd*, Case C-252/12) involved a dispute between two UK-based companies. The ECJ was asked by the Court of Appeal of England and Wales to clarify the following question:

> *Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour..., is the colour which a third party uses the sign complained of relevant in the global assessment of likelihood of confusion or unfair advantage?*

The ECJ answered that where a trademark has not been registered in colour, but the rights holder has used it extensively in a particular colour, such that it has become associated in the mind of the public with that colour, the colour of the contested mark as used is relevant to the global assessment of both likelihood of confusion and unfair advantage.

The marks at issue are shown below.





Earlier Community trademark contested mark



Earlier mark in use

In other words, if a trademark has been used extensively in a particular colour and thus enjoys enhanced protection because the relevant public now connects the mark with that colour, this is a relevant factor to consider, even if the mark is registered in black and white.

The ECJ stated that:

> *where there is a [Community trademark] registered in [black and white], the colour in which this mark is later used affects how the average consumer of the goods at issue perceives that mark, and it is therefore liable to increase the likelihood of confusion or association between the earlier mark and the sign alleged to infringe it. In those circumstances, it would not be logical to consider that the fact that a third party uses a mark in similar colours cannot be taken into consideration in the global assessment for the sole reason that the earlier mark was registered in [black and white].*

The ECJ's answer was closely connected to the claim that the SPECSAVERS logo in green enjoyed enhanced protection as a well-known mark following extensive use on the market. In such circumstances, it is difficult to see how the ECJ could give any other answer. Had the mark not enjoyed enhanced reputation and therefore not "affected the perception of the average consumer", the ECJ might have come to another conclusion.

OHIM has stated that the *SPECSAVERS* decision does not alter its current practice. Registration of a Community device mark in black and white still affords the mark protection only in black and white. Thus, if in any doubts about whether your client's mark enjoys enhanced protection (and this is rarely the case from day one), you should file the Community trademark in colour.

Returning to the *EYE OF THE TIGER* opposition case, imagine that the earlier mark enjoys a reputation as a result of use in colour in one EU member state. Had this been the case, and had the opponent based the opposition on such reputation and filed sufficient evidence, it seems to follow from *SPECSAVERS* that OHIM would have had to take into account the use in colour of the Community trademark registered in black and white.

If the mark did not enjoy a reputation, but had merely been used in colour, this could also be taken into account in an opposition before

OHIM. This would require, however, that the opponent ticked the box 'non-registered mark or sign used in the course of trade' in the notice of opposition, and provided evidence that pursuant to the national law governing it, the mark confers on its owner the right to prohibit the use of a subsequent mark. If, for instance, the opponent wanted OHIM to consider use of the TIGER mark in colour in, say, Denmark, it would have had to prove that a trademark right can be obtained through use in Denmark, and that its mark had been used in colour. The problem is that:

- only a few EU countries acknowledge that a trademark right can be established through use; and
- it is quite burdensome to base an opposition on such a claim.

Evidently, it is much easier to base an opposition on a Community trademark registration in colour.

Use

Another key aspect to consider is whether use of the Community trademark in colour fulfils the use requirement for the registered Community trademark in black and white. Pursuant to Article 15(1) of the Community Trademark Regulation, a Community trademark becomes vulnerable to cancellation due to non-use five years after registration. The question then arises whether use of the mark in colour constitutes use of the black and white device mark. According to Article 10(1)(a) of the EU Trademarks Directive (2008/95/EC), this will depend on whether the use of the mark in colour "alters the distinctive character of the mark" in the form in which it was registered. If not, it will constitute use of the mark registered in black and white.

According to OHIM's guidelines, for the purposes of use a change only in colour does not alter the distinctive character of a trademark 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; and
- colour is not one of the main contributors to the overall distinctiveness of the sign.

Are you MAD?

In Case T-152/11 the ECJ held that the use requirement for the black and white Community trademark below was fulfilled by use of the mark in colour.





The ECJ stated that the fact that the mark was being used with the letter D in red did not alter the distinctive character of the mark, because the manner in which the letters M, A and D were placed still corresponded with the registered mark. In other words, the ECJ considered that use of the mark in a different form was acceptable, as long as:

- the arrangement of the verbal/figurative elements stays the same;
- the word/figurative elements coincide;
- the word/figurative elements are the main distinctive elements; and
- the contrast of shades is respected.

So far, so good, except that it may not be entirely clear whether the use of your client's device mark in colour "changes the distinctive elements" of the black and white mark. Again, it is advisable to register the mark in both black and white and colour in order to allay such doubts.

Double registration

Considering how inexpensive it is to obtain a Community trademark registration, the clear advice is to file the mark in both black and white and colour. The main reason to file in black and white is that many third parties still file their device marks in black and white, either as Community trademarks or as national marks (where they gain broader protection); therefore, your Community trademark should be registered in black and white as well in order to have a strong basis for oppositions against such marks. WTR

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