

Are you using your black and white trademarks correctly?

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17 IP-Offices of the European Trademark and Design Network, including OHIM, have agreed on a Common Practise regarding the scope of protection of black and white (hereafter B&W) marks. See Common Practise CP4. This Common Practise is not applicable in e.g. Denmark, as Denmark, Sweden and Norway have opted out of the implementation of the common practise due to legal constraints in national law that imply that B&W marks cannot be interpreted as simply consisting of the colours black and white, and as the practice described in the “common practice” will have retroactive effect, the DKPTO is not at present in a position to implement this practice.”.

On several occasions the Danish courts have expressed the view that a registration for a mark in B&W covers all colours, see e.g. UfR.2007.1941S PR vs RR ROLLS ROYCE.

In general terms, Article 10(1)(a) of the Directive 2008/95/EC of The European Parliament and of The Council of 22 October 2008 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”.

The Common Practise has clarified that for purposes of proving genuine use of a mark, a change only in colour does not alter the distinctive character of the trade mark as long as:

- 1) The word/figurative elements coincide and are the main distinctive elements.
- 2) The contrast of shades is respected.
- 3) The colour or combination of colours does not have distinctive character in itself.
- 4) Colour is not one of the main contributors to the overall distinctiveness of the mark.

For a better understanding of the freedom of action allowed by the above 4 requirements here are some examples of what not to do. To comply with the first requirement, it is not possible to show use of the mark if not all elements are included. The second requirement can be illustrated by means of a registration for XX as a figurative mark where the letters are written in black. In this case evidence showing use of the letters in a light colour on a dark background will not be acceptable. An example of the third requirement is when the actual use shows several colours added to a simple pattern. The fourth requirement deals with the revised situation where the trademark is being used in B&W but registered in colours (a blue strawberry for *ice cream* and *fruits*). In this case the blue colour is the only distinctive element in the registration and therefore use in B&W is not used as registered.

It still remains to be seen what the National or European Courts will rule when faced with a case concerning proof of use of B&W marks, especially considering the potential fatal consequence for the trademark registration.

Because of the risk presented by the Common Practise for B&W marks, trademark owners could consider securing national registrations in Denmark and Sweden. Doing so will secure double protection in those territories and will increase trademark owners' freedom of action because a B&W registration is still considered to cover all colours in Denmark and Sweden (and Norway).