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Sweden: turnaround in practice of black and white trade-mark registrations

David Leffler (Cirio Law Firm) · Tuesday, April 30th, 2019

In a judgment of 27 February 2019, the Swedish Patent and Market Court of Appeal (PMÖD) stated that a registration of a trademark in black and white cannot in itself result in protection in relation to all colour combinations. This is a turnaround of the practice established in Sweden since the 1960's.

The PMÖD has, unlike the Patent and Market Court (PMD) and the Patent and Registration Office (PRV), considered that an international registration of a trademark consisting of, inter alia, the letter g enclosed in a square in figure shall apply in Sweden and thus abrogated the decision of the lower court and a practice that had been established through preparatory works and case law since the 1960's. In light of the new practice, the PMÖD found that the red background colour of the earlier mark together with some other elements meant that the similarity of the marks was low, even though both marks were squares comprising the letter "g", and therefore found no likelihood of confusion between the marks.

The main question concerned whether a likelihood confusion existed between the international registration designating Sweden, depicted below, and an earlier EUTM consisting of the same letter in white against a red background, also depicted below.



IR designating Sweden



Earlier EUTM

Interesting enough, in its submission to the court, the PRV stated that according to Swedish case law, the scope of protection for black and white brands cover all colours, while a ruling from the European Court of Justice indicated that EU case law is more nuanced (the PRV made reference to

the Specsavers' judgement by the CJEU (Case C-252/12)). The PRV thus stated that there may be reasons to change the Swedish practice for harmonisation purposes. Apparently, this is something that the PMÖD took note of.

In its ruling, the PMÖD noted that, in terms of similarity, there were some clear differences between the signs which affected the overall impression of the respective sign. A particularly prominent difference between the signs was that the earlier EUTM had a clear red background, while the international registration designating Sweden was depicted in black and white.

As such, the key question in the assessment of the similarity of the signs was if a registration in black and white covers all colours or is limited to black and white only, since if the IR could be seen as also being red would affect the outcome of the assessment. The PMÖD in this case took influence from the Specsavers' case above and considered, by analogy, that the CJEU had concluded that a black and white mark did not include protection for all colours. The PMÖD reasoned that if a black and white mark would have included all colours, the CJEU would not have had to consider that use in a specific colour could influence the scope of protection of a mark registered in black and white as the case was in Specsavers.

This case is not appealable. Therefore, it is now established that black and white marks are no longer considered to cover all colours in Sweden.

Some interesting key points from the decision are that the PMÖD felt compelled to change the Swedish practice on black and white marks in this case. The Specsavers' case does not, in this author's opinion, deal with the scope of protection of black and white marks as registered. Instead, this case deals with infringement of repute and acquired distinctiveness through use. In addition, the PMÖD references the General Court case of 9 April 2014, T-623/11 'Milanówek Cream Fudge' p. 39 in support of its conclusion as the court in this case stated that a registration of a mark which does not designate any specific colour does not mean that it covers all colour combinations which are enclosed within the graphic representation. Nevertheless, in the case of 16 January 2018, T-398/16 'Starbucks' p. 53-54, the General Court stated that "...the trade mark application seeks protection in respect of a composite figurative sign which does not refer to any colour in particular. That sign's user could therefore, as EUIPO acknowledged at the hearing, use it in the colour of its choice, including in the black, green and white shades of the earlier EU trade marks...".

Considering the above, it could be argued that the practice in Luxembourg might not be coherent enough to change an established national practice. It could further be questioned whether the colour actually is pivotal for the likelihood of confusion assessment (this author thinks not!). The practice change is, nevertheless, most welcomed from a harmonisation perspective and will facilitate trademarks assessments within the EU. Still, certain trademark owners who have felt comfortable with large B&W portfolios may have to consider refiling certain marks in colour.

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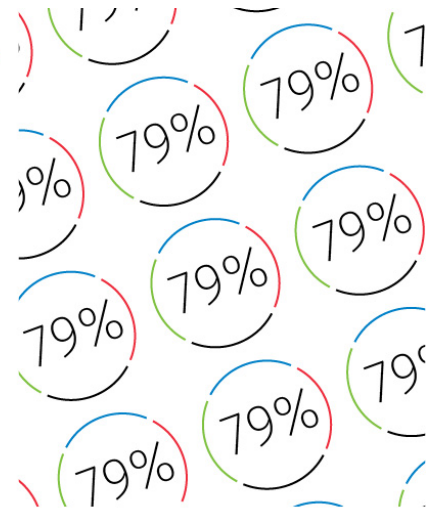
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