

BLACK AND WHITE OR GREYSCALE: QUID IURIS?

This Article summarizes an article written by the same author in the Italian Journal "Rivista dell'Ordine dei Consulenti in Proprietà Industriale" year MMXVIII - N° 1/03/2018"



Author: **Claudio Balboni**
Trademark and Design Attorney
Bugnion s.p.a.
cbalboni@bugnion.it

"A trade mark may consist of any signs, [...] capable of [...] being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor" (provision of Article 3 of Directive 2015/2436 and Article 4 of Regulation 2017/1001).

This is the provision from which EUIPO has drawn its "WYSIWYG" (What You See Is What You Get) principle that sums up the European stand: you can only protect what is on the register.

Even though this principle seems clear, it causes some interpretational problems with figurative trade marks filed in black and white or greyscale.

In fact, while Article 3.2 of the Implementing Regulation N. 2017/1431 states that "the representation of the trade mark shall define the subject matter of the registration", Article 3.1 affirms that the parameter for the interpretation of the "subject-matter of the protection" are "the competent authorities and the public."

The problem with figurative trade marks could be outlined as follows: does a trade mark filed in greyscale or black and white grant protection to the same trade mark reproduced in any other color, or is its protection only limited to the colors that have explicitly been filed?

The opening quotation shows how the provision requires that this dilemma be solved by using both the "authorities" and the "public" to whom the trade mark is addressed as a benchmark. National IP agencies certainly fall into the former category; however, other public bodies such as national Courts, Customs authorities, and any other public individual whose job requires understanding the scope of protection of a trade mark, have to be included in this category. As for the "public", the category refers to the consumer of the product or service on which the mark is used.

So far, only a few authorities have taken a public stand, which partially provides an answer to the question at issue. This happened through the EUIPO Convergence Program about the "Scope of protection of B&W marks" (commonly known as CP4) which was implemented on 15 April 2014. The program involved 21 European Trade mark Offices, the EUIPO, some non-EU offices (mostly as observers), and three User Associations.

While the first two questions the participants were requested to answer are only partially relevant within this context, the third question CP4 aimed to answer is of greater interest and concerns the use of the mark. The question focused on whether the use of a color mark could be sufficient in order to prove the use of a black and white or greyscale trade mark registration, and the answer was that..."it depends". As a matter of fact, it showed that such use *can* be deemed valid, but only as long as it does not alter the distinctiveness of the mark, namely if the chromatic contrasts are respected, and the color has no distinctiveness of its own or isn't part of those elements which substantially contribute to the distinctiveness of the mark.

As already mentioned, CP4 only involved a few Offices, which represent only some of the "authorities" mentioned in the Regulation. Furthermore, we would also like to stress that, in determining the "subject matter of the protection afforded to its proprietor", both the Directive and the Regulation demand that the "public" interpretation must also be taken into account.

Since the public is an essential, integral part of the new rules, it is therefore unacceptable to dismiss its perception of the mark.

To try to understand how this problem is being approached, a survey among some Europeans and non-European colleagues was conducted. Of course, this survey does not pretend to provide solid and indisputable solutions, but rather to simply offer an overview of how this issue is perceived in each country. Two colleagues from each country were surveyed; in case the answers offered were conflicting, a third, additional colleague was polled.

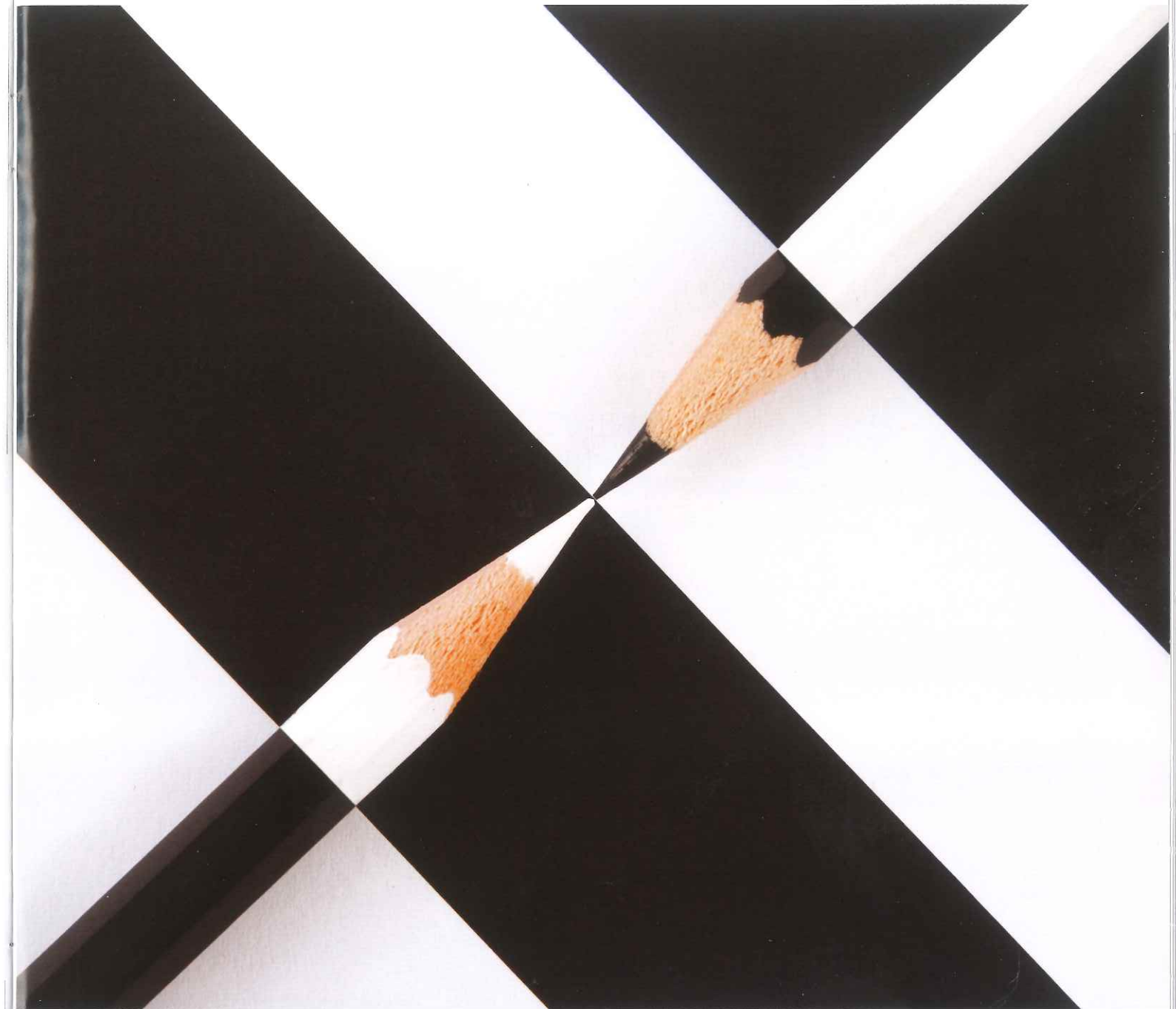
As for the European Union:

- colleagues from 6 countries stated that the black and white or greyscale trade mark grants protection for every color;
- colleagues from 17 countries stated that protection is only granted for the colors that have explicitly been filed;
- colleagues from only one country did not reply to the survey;
- in one country, a third colleague was consulted but did not reply.
- The results reported above show how the trend dictated by CP4 is establishing itself at the European level.

The same survey was also conducted among colleagues from 13 non-European countries. Among these, two provided conflicting answers; one (Turkey, which only acted as an "observer" state in CP4, though) stated that a mark is protected in the color or the combination of colors for which it was filed, while all other 10 agreed that an application filed in black and white or in greyscale offers protection for all kinds of chromatic shades.

As a result, it seems possible to argue that EU and non-EU countries have adopted an opposite approach towards the protection of trade marks in black and white.

It should be noted that in the CP4 only 7 out of the 21 participating countries (excluding EUIPO and the "observers") declared they would have



applied CP4 to procedures pending on the implementation date: this means that, until Mid-2014 the practice in force in most of the participating countries was likely to be diametrically opposed to what was then agreed upon in the CP4.

In my view, if the "public" and the "competent authorities" belonging to these countries have been used to equating the lack of color with a claim for all shades of color for decades, this ought to be considered the way in which they

can "determine the clear and precise subject matter of the protection".

It is therefore worth asking whether the 4 years that have passed since the CP4 was approved can actually be deemed sufficient to change the way the "public" and the "competent authorities" see and understand B&W marks. If not, it would mean that CP4 might not be the right standard through which the new Regulation should be interpreted.



Verifier: **Sergio Rizzo**
Lawyer and IP Attorney
Abogados DAUDÉN
rizzo@abogados-dauden.com