



Convergence

Frequently Asked Questions (FAQ) on Common Practice
CP4 Scope of Protection of B&W Marks

1. If the marks are not identical, can they still be similar thus leading to likelihood of confusion?

The common practice only defines when a B&W or greyscale mark is identical to the same mark in colour. There can still be likelihood of confusion if the marks are similar.

2. Is the common practice different to the previously existing practice?

Analysis of the changes between the previous practice and the common practice for the following implementing offices: AT, BG, BOIP, CY, CZ, DE, EE, ES, GR, HU, IE, LV, LT, MT, OHIM, PL, PT, RO, SI, SK, TR, UK, has shown the following results:

Priority

There are 13 Offices that are changing their practice with regards to priorities.

- Previous practice more lenient than the common practice: 3 (CY, IE, PT)
- Previous practice more strict than the common practice: 10 (BG, EE, ES, GR, HU, LT, LV, OHIM, SK, TR)
- No change from the previous practice: 9 Offices (AT, BOIP, CZ, DE, MT, PL, RO, SI, UK)

Identity, relative grounds

There are 5 Offices that are changing their practice with regards to a finding of identity between the signs for relative grounds.

- Previous practice more lenient than the common practice: 2 (CY, GR)
- Previous practice more strict than the common practice: 3 (BG, EE, LT)
- In 17 Offices the new common practice doesn't change the previous practice. (AT, BOIP, CZ, DE, ES, HU, IE, LV, MT, OHIM, PL, PT, RO, SI, SK, TR, UK)

Use

No Office will change its already existing practice with regards to use.

3. Will the trade mark offices provide information about the impact of the common principles on the previous national practice?

Yes, when considered appropriate by the trade mark offices, they can provide detailed information on the impact of the common practice on the previous national practice, its consequences and implications for the national users. The Common Communication on the Common Practice on the Scope of protection of B&W Marks also includes useful information on the implementing offices, the non-implementing offices, and the non-participating offices.

4. Are the conclusions for priority and for relative grounds the same?

Yes, in both contexts the definition of identity between a mark in B&W and/or greyscale and a later mark in colour coincides.

5. On page 10 of the Common Practice the following is stated: “A priority mark filed in B&W can contain a colour claim or not. The following possibilities exist:

- No colour claim whatsoever is present
- Specific colours (other than B&W and greyscales) are claimed
- The colour claim expressly states the colours black and white only
- The colour claim expressly states black, white and grey (the mark is in greyscale)
- The colour claim states that the mark is intended to cover all colours”

Is the above mentioned formulation summary of all possible options that can occur in the Member States (which means not necessarily all options in every state)?

Or does it mean that we have to offer all above mentioned possibilities to the applicants?”

The common practice does not define which types of colour claims are acceptable in each office. The reason for referring to colour claims is to define that sometimes a trade mark filed in B&W might actually be a colour mark. This is especially important in the case of International Trade Marks, and that is the reason why the document deals with colour claims.

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