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**SIPO to start applying common practice on B&W marks from July
Slovenia - ITEM d.o.o**

Registration

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On April 15 2014 the [Slovenian Intellectual Property Office \(SIPO\)](#) published the Slovenian translation of the [Common Communication on the Common Practice of the Scope of Protection of Black and White Marks](#). This document was issued within the framework of the OHIM Convergence Programme with the purpose of harmonising practices among the national trademark offices of the EU member states. SIPO will start to apply the common practice on July 1 2014. The common practice will be implemented by all EU national offices except Italy, France and Finland; the Swedish, Danish and Norwegian national offices have opted out of implementation of the common practice due to legal constraints.

The common communication aims to harmonise the different practices of the national trademark offices regarding trademarks in black and white (B&W) and/or greyscale on the one hand, and colour trademarks on the other, with respect to priority claims, relative grounds for refusal and genuine use. Until now, certain national offices applied the 'maximum protection' approach, meaning that a B&W sign covered all colours and colour combinations, whereas other offices applied the 'what you see is what you get' approach, meaning that a B&W sign was protected only as such.

That is why a majority of national trademark offices in the European Union, OHIM and various user groups agreed on the rules which are reflected in the common communication - namely:

- Priority claims:
 - A trademark in B&W from which priority is claimed is not identical to the same mark in colour, unless the differences in colour are insignificant.
 - A trademark in greyscale from which priority is claimed is not identical to the same mark in colour or in B&W, unless the differences in the colours or in the contrast of shades are insignificant.
- Relative grounds for refusal:
 - An earlier trademark in B&W is not identical to the same mark in colour, unless the differences in colour are insignificant.
 - An earlier trademark in greyscale is not identical to the same mark in colour or in B&W, unless the differences in colours or in the contrast of shades are insignificant
- Genuine use - a change only in colour does not alter the distinctive character of the trademark, as long as the following requirements are met:
 - the word/figurative elements coincide and are the main distinctive elements;
 - the contrast of shades is respected;
 - the colour or combination of colours does not possess distinctive character in itself; and
 - the colour is not one of the main contributors to the overall distinctiveness of the mark.

Beside these rules, the common communication also contains practical examples - for instance, when the difference in colour between two trademarks will be perceived as significant or not.

The common communication will significantly contribute to the harmonisation of the trademark practices - and, consequently, to legal certainty - in those EU states that have decided to implement it.

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