



Resolution of the Executive Committee, Barcelona, Spain, 2 to 5 November 2014

“Trade Marks in Black and White”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Barcelona, Spain, 2 to 5 November 2014, passed the following Resolution:

Noting that the European Trade Mark and Design Network (“European tmdn”) issued on 15 April 2014 a Common Communication on the Common Practice (“CP4”) of the Scope of Protection of Black & White (“B&W”) Marks, to be implemented at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) and at certain National IP Offices and the Benelux Office (“the Implementing Offices”);

Further Noting that the subject of the Common Practice CP4 is the convergence of the different handlings of trade marks in black and white and/or greyscale as regards priority, relative grounds of refusal and genuine use;

Considering that in many countries, including a significant number in Europe, a trade mark registered with a representation in black and white is protected in respect of all colours;

Observing that in an updated version of the Frequently Asked Questions (FAQ) on the Common Practice CP4, the European tmdn has stated: “The Common Practice has clarified that an application in B&W does not cover all colours”;

Further observing that the Patent and Trade Mark Office in Germany has issued a Notice stating that the common principles concern priority and double identity but not the similarity between marks under the law on likelihood of confusion, for which the following still applies: “Protection of a black-and-white registration extends to all coloured representations. Exception: if it is the colour that leads to a special effect of the image”;

Firmly supporting the principle that protection of a trade mark registered with a representation in black and white extends to all colours;

Urges OHIM and the Implementing Offices to reopen discussions about the principles of the Common Practice, recognising the detrimental effect of the current Common Practice on trade mark owners,

And Further Urges that in the short term, pending the outcome of such discussions, OHIM and the other Implementing Offices should declare that they agree with the German interpretation of the common principles and are adopting that interpretation in their practice.