

Colour or not Colour? That is the question!

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We observe every day that much IP expenses are done with no preliminary legal strategy, in particular regarding trademark applications, and often inappropriately so.

The first question in fact is always “**do I have to file a trademark?**” and the reply is not as easy as “yes, if I want to be protected”.

This question can seem elementary but opens a lot of other issues if we want to give an answer that would be really conform to the company’s ambitions, targets, position and to its needs in the matter of operational safety.

For instance, what is my goal if I file a trademark application? Do I have the right to file this name/device? Will I use it for a long time? Would my trademark application be legally valid? Am I sure that I will not be taken to courts if I file a trademark application?

In any case, the important point is to think about the expense and know whether it is really useful and balanced.

The second question is obviously « **what sign do I have to file as a trademark?** » and there again, the reply is rarely obvious.

The choice has to be made on a case-by-case basis, according to the project and to the IP policy of the company. It also often depends of the prior existing rights revealed in the availability search.

When the question is the protection of a device, the issue is again more complicated!

A device is quite often in colours and sometimes also declined in several colours in the concerned graphic charter and according to the different Medias on which it will be affixed.





In this kind of cases, what we are used to see in practice is:

- One and only trademark application with the whole graphic chart (such as shown above...). So, a global persistent legal weakness ... as far as the protection is given on the sign as filed, i-e as a whole, and not to each of its separated components. Consequently, the protection is weak (or ineffective in practice, in case of infringement); the graphic chart as a whole is obviously not used with the elements all together and the conservation of the trademark will be questionable in terms of forfeiture on the ground of non-use. → **Useless expenses...**
- A multiplicity of trademarks applications, with one application for each declination of colours. → **Multipled expenses...**
- A trademark application black and white, often decided on the principle of this skewed idea: I will thereby be protected for my device in every colours and declinations. → **Then again: no, the legal situation of a black and white trademark is not that simple.**

It is to be known and understood that the legal effects of a black and white trademark device are not harmonized in practice, even in Europe!

Moreover, that is why OHIM, joined by most of the European countries (but not France!), has provided during the last month of April a Communication on the common practice regarding the protection field for black and white trademarks, after a 2 years' work.

In essence, it is to be considered that a trademark filed in black and white is not identical to the same device in colours, unless the differences are not significant i-e that they will not be perceived by the reasonably observant average consumer, if he does not have the two trademarks under his eyes.





In practice, which general conclusion can I draw from this, in case I have a black and white device trademark?

- ✓ I will be able to fight against a device identical to mine but in colours, filed and/or used by one of my competitors, but I will have to evidence a likelihood of confusion;
- ✓ It will be difficult for me to win on the ground of infringement against an application or a use by a competitor of a device similar to mine (close but not identical), even if the same colours are used;
- ✓ In case I have updated my device (word/figurative parts and/or contrasts in the palette of colours), with my exploitation in colour, I will not be able to evidence that I use my black and white trademark. My risk is there to lose my trademark, so my monopoly and my anteriority, when it will be mandatory to use it (usually after 5 years);
- ✓ I should check with my IP law firm whether the colours differences would be considered as significant or not and think about filing maybe a new trademark application in colours.

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