

## THG IP Solutions - IP News – March 2016

### Keyword EU: reform of the Community trademark system and trademark directive

Just delivered under the Christmas tree, the EU Parliament adopted two texts that initiate the reform of the European and national trademark law. Directive No. 2015/2436 on the approximation of the laws of the Member States relating to trademarks as well as Regulation No. 2015/2424 amending Regulation No. 207/2009 on the Community trademark; both of December 16, 2015 and published respectively in the Official Journal of the European Union on December 23, 2015 and December 24, 2015.

The recast of the harmonization Directive on the national trademark law of the Member States entered into force on 12 January 2016. The national legislators have to transpose the new provisions into national law, in principle, within a period of three years. The existing Directive will be repealed on January 15, 2019.

According to the sixth recital of the new Directive, the aim of the reform is to adapt the European trademark system "to the age of the Internet, to meet the rising expectations of users for faster, better, more efficient and more rational registration procedures, which are also better coordinated, user-friendly technologically up to date and available to the public. "

The majority of the provisions of the new Regulation enter already into force on March 23, 2016. We take this opportunity in order to summarize the most important changes and adjustments.

- ® A first amendment is terminological. On March 23, 2016, the Office for the Harmonization in the Internal Market (OHIM) will be called European Union Intellectual Property Office (EUIPO), the Community Trade Mark Regulation (CTMR) European Union Trade Mark Regulation (UETMR) and the Community trademark (CTM) European Union trademark (EUTM).
- ® The definition of the trademark will be adjusted and the requirement of graphical representation deleted from the definition of the European Union trademark. A sign may be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. This adjustment should simplify the registration of alternative brands such as noise and smell marks.
- ® Confusion as to the commercial source from which the goods or services emanate may occur when a company uses the same or a similar sign as a trade name in a way such that a link is established between the company bearing the name and the goods or services coming from that company. Following the earlier *Celine* decision of the EUCJ, infringement of a European Union trademark should therefore also comprise the use of the sign as a trade name or similar designation as long as the use is made for the purposes of distinguishing goods or services.

® The rights of the trademark owners in relation to goods in *transit* will be strengthened. The proprietor of a European Union trademark will be entitled to prevent third parties from bringing goods in the course of trade where such goods come from third countries and bear without authorization a trademark, which is identical or essentially identical with the European Union trademark registered in respect of such goods, also when such goods are not intended to be placed on the market of the Union.

® When filing a trademark application, the goods and services for which trademark protection is sought have to be classified in conformity with the International Classification of Nice. According to OHIM's previous practice, it was possible to opt for the class headings in order to protect the entire list of goods or services of the relevant class.

According to the *IP Translator* decision of the EUCJ from 2012, the goods and services for which the protection of the trademark is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.

The new regulation provides that the use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services, which cannot be so understood.

Holders of European Union trademarks applied for before June 22, 2012 which are registered in respect of the entire heading of a Nice class may declare until September 24, 2016 that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class in the edition of the Nice Classification in force at the date of filing.

® The most relevant change for right holders relates to the adjustment of the cost structure. Until now, for a flat fee, the Community trademark application includes protection for up to three classes.

The new European Union trademark is based on a "one fee per class" system. The applicant thus pays a lower fee for a registration including one class, the same fee for two classes and a higher fee for applications with three or more classes.

Right holders who are desirable to register European Union trademarks in 2016 with at least three Nice classes should submit any application prior to March 23, 2016.

The renewal fees also know a significant reduction. This change may result in a difference between 350€ and 500€. Possible renewals of European Union trademarks should be postponed after March 23, 2016, if possible.

- ® Within 21 month, European Union certification marks will be created. Such a mark provides certification by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin.

The new EU trademark directive will lead to an even greater harmonization of national trademark law in the Member States and thus also to a modification of the Benelux Convention on Intellectual Property.

- ® With regard to the Directive, Member States will have to establish administrative procedures concerning the revocation and cancellation of national trademarks within a period of seven years. Right holders will welcome this change since such proceedings imply currently time-consuming and costly proceedings before the ordinary courts. A quicker implementation of this provision would have been welcomed.

**Interested in this topic? Need further information? Contact us.**



**Raymond Bindels**

Conseil en propriété intellectuelle  
Senior European and Benelux Trade mark and Design Attorney  
[raymond.bindels@thg-ip.solutions](mailto:raymond.bindels@thg-ip.solutions)

**THG IP Solutions Sàrl**

61, Gruuss-Strooss, L-9991 Weiswampach  
[www.thg-ip.solutions](http://www.thg-ip.solutions)

Member of  group