

European Trade Mark Reform – Further changes which came into force on 1 October 2017

In March 2016 we reported on the various changes to the European Union Trade Mark Regulation, many of which came into force on 23 March 2016. On 1 October 2017, further changes were brought in, and new secondary legislation has also come into force, in the form of a European Union Trade Mark Delegated Regulation and a European Trade Mark Implementing Regulation. Many of the changes simply codify or modernise the EUIPO's previous practice and procedures. A summary of the main areas affected is set out below:



Rebecca Atkins
Associate, London
Rebecca.atkins@abelimray.com

Types of trade mark

The list of specific types of mark has been extended and now includes word, figurative, shape (including appearance), colour, sound, position, pattern, motion, multimedia, and hologram.

Graphical Representation

The requirement to file a graphical representation of the mark has been removed and marks can now be represented in any appropriate format using generally available technology. This removes one of the hurdles for non-traditional trade marks such as position, sound, motion, multimedia and hologram marks which can now be represented by a JPEG, MP3 or MP4 file alone, as appropriate, provided that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. Of course, such non-traditional trade marks must still satisfy the requirement for distinctiveness and so it is still likely to be difficult to protect many of these types of trade marks. It still does not appear possible in practice to register smell, taste and tactile/texture marks, as they cannot adequately be represented using currently available technology (specimens are not acceptable).

Descriptions are no longer permitted for most types of mark and are optional for colour combination, position and

movement marks. It is also no longer possible to include colour claims, other than for single and combination colour marks, although marks filed in colour will be deemed to be protected in that particular colour format. For colour marks, an indication of the colour code is now a formal requirement.

EU Certification Marks

This is a new type of EU trade mark, although certification marks already exist at a national level in some EU member states, including the United Kingdom.

The purpose of a European Union certification mark is to indicate/guarantee that the goods and services bearing the mark comply with a particular standard (e.g. material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics) set out in the regulations for use. The registered proprietor of the certification mark is responsible for ensuring compliance with the regulations. The role of the proprietor is to act as an independent body and, as such, it is precluded from carrying out a business involving the supply of the goods and services of the kind certified or using the mark itself for the certified goods or services.

An application for an EU certification mark must include regulations

governing the use of the mark. The regulations can be filed up to two months after the initial application (Article 17 EUTMIR details the information that must be included in them). The application fees for EU certification marks are higher than those for normal EUTM applications, and the registration process is likely to take longer due to the requirement that regulations are examined and accepted.

Procedural changes

Claim of acquired distinctiveness

Acquired distinctiveness can now be claimed on a subsidiary basis, either at the start of the application process or in reply to the first objection. If a subsidiary claim is made, it would only become necessary to submit evidence of acquired distinctiveness after a final decision has issued on inherent distinctiveness. This means that evidence of acquired distinctiveness will only have to be compiled and relied on once inherent distinctiveness arguments have been exhausted, which might avoid the expense of gathering and presenting evidence of use.

A claim of acquired distinctiveness cannot be made for the first time before the Board of Appeal.

Priority claims

Priority claims must be filed at the same time as the application but will now only be examined as to formalities (i.e. date, country, registration number). The validity of priority claims will only be examined in the course of opposition or cancellation proceedings.

Assignment of an EUTM as a remedy in principal/agent disputes

Instead of a declaration of invalidity, proprietors of a trade mark registered by an agent or representative without their consent (Article 6 septies of the Paris Convention) can now request an assignment of the EUTM in cancellation proceedings, in order to reclaim a trade mark from an agent or distributor.

Substantiation of earlier rights from online sources

When relying on registered rights or provisions of national law, which are accessible from an online source recognised by the Office, the opponent or cancellation applicant may provide such evidence by simply making reference to that source.

Evidence

Various changes have been made to the structure and presentation of evidence. In particular, a detailed index of appendices must be attached and all pages must be numbered.

The Office now has some discretion to accept belated evidence provided it is supplementary to the evidence already filed.

Suspensions

Now limited to a maximum of two years and will be granted for periods of 6 months (the previous practice allowing three year-long suspensions).

Languages and Translations

It will now only be necessary to translate evidence of substantiation (other than certificates of filing,

registration, renewal and provisions of national law) into the language of proceedings where requested by the Office or the other party. This includes evidence of use, reputation and acquired distinctiveness.

However, certificates of filing, registration and renewal or provisions of relevant law must still be submitted in the language of the proceedings (or translated into this language) within the time limit set for substantiation.

Communication with the Office

Hand delivery and post-box deposits are no longer permitted as a means of filing.

Applications for marks where the representation has a colour component (including figurative marks) can no longer be filed by fax because there are no legal provisions that facilitate the subsequent filing of a representation in colour.

From 1 January 2018, fax will no longer be accepted for filing EUTM applications or renewals except as a backup system if technical malfunctions prevent e-filing.

Please do not hesitate to contact us if you have any questions on the above changes.

London
20 St. Andrew Street
EC4A 3AG, UK
T +44(0)20 7242 9984
F +44(0)20 7242 9989

Cardiff
3 Assembly Square
Britannia Quay
CF10 4PL, UK
T +44(0)29 2089 4200
F +44(0)29 2089 4201

Bath
Westpoint Building
James Street West
BA1 2DA, UK
T +44(0)1225 469 914
F +44(0)1225 338 098