

European Trade Mark Reform – Further changes 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 came into force, which modernise and codify EUIPO practice. We set out below a summary of the three main areas affected:



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Graphical Representation

When submitting a trade mark application, it is no longer a requirement to file a graphical representation of the mark and it can be represented in any appropriate format, provided it is sufficiently clear and precise. 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.

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 is still unlikely to be 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).

EU Certification Marks

This is a new type of EU trade mark, although certification marks have existed at a national level in some EU

member states, including the United Kingdom.

A European Union certification mark indicates 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 owner of the certification mark is responsible for ensuring compliance with the regulations, and is precluded from carrying out a business involving the supply of the goods and services of the kind certified and from 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. 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.

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Procedural changes

Various procedural changes have been implemented, relating to priority claims, translation requirements, evidence and communications with the EUIPO.

One particular change to note is that subsidiary claims for acquired distinctiveness can now be made after inherent distinctiveness has been examined and determined, which means that the burden and expense of gathering and presenting evidence of use can be delayed and might even be avoided.

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