

# European Trade Mark Reform – Summary of Changes for Professionals

## Key Changes

- **Reduced fees** - one class per fee provision, so applications covering 1 Class will now incur lower official fees. The proposed official fees are:

Basic fee for one Class (electronic):  
€850

Second Class: €50

Each additional Class: €150

Renewal fees will now also be as above

- OHIM will be called **“The European Union Intellectual Property Office”**. Community Trade Marks will become known as **European Union Trade Marks**.

- **Use of a company or trading name** will no longer be a defence to trade mark infringement.



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## Background

The long awaited changes to the European Community trade mark system have now been published and will come into effect on 23 March 2016.

### **More efficient protection; cheaper and quicker registration**

While preserving the dual system of national and EU trade mark, the updated trade mark legislation will further harmonise national and European trade mark application procedures and the rights guaranteed by a trade mark.

The agreed measures will make trade mark registration systems all over the EU more accessible and efficient for businesses in terms of lower costs, increased speed, more predictability and greater legal certainty. The reform will improve conditions for businesses to innovate and to benefit from more effective trade mark protection against counterfeits, including non-authentic goods in transit through the EU's territory.

**The following are the principal proposed amendments to the Directive and Regulation:**

## Definition of a Trade Mark

The requirement for ‘graphical representation’ is to be removed and replaced with “represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject of the protection afforded to its proprietor”. This will allow for more unusual trade marks such as sound, movement and hologram marks to be represented, although evidence of acquired distinctiveness is still likely to be required in practice.

### **Amendments to scope of protection and limitations/defences**

- Trade name use of a protected trademark shall be treated as an infringing act, if the requirements of use for goods or services are met. The own name defence will now only apply to the use of a personal name or address, rather than a corporate name.

- Trade mark owners may prevent the use of their trade marks in comparative advertising where the requirements of Article 4 of Directive 2006/114/EC are not satisfied. This simply codifies what the case law has stated.

- Rightholders will be entitled to prevent preparatory acts in relation to the use of packaging, where there is a risk that the packaging, labels, tags to

which the trade mark is affixed will be used to infringe.

## Combating counterfeit products

While ensuring that legitimate trade interests are not affected, the new rules will provide better means to fight against counterfeit goods in transit through the territory of the EU.

Proprietors will be entitled to prevent third parties from bringing infringing goods from third countries into the customs territory of The European Union, regardless of whether they are released for free circulation, provided that they are entitled to prohibit the placing of the goods on the market in the country of final destination.

## Classification of goods and services

Following IP translator, common rules will be put in place for designation and classification of goods and services. CTM owners whose marks:

1. were filed before 22 June 2012; and
2. cover the Nice class headings,

will have a 6 month sunset period from the entry into force of the Regulation in which to file a declaration indicating that their intentions were to seek protection for goods or services beyond the literal meaning of the class headings, provided that those goods or services claimed were included in the version of the Nice alphabetical list in place when the CTM was filed. If no such declaration is filed within the sunset period, CTMs covering the class

headings will be deemed to extend only to goods or services clearly covered by the literal meaning of the Nice indications.

Significantly, the draft Regulation also provides that CTM owners with such amended specifications will not be able to prevent any third party from continuing to use a trade mark in relation to goods or services where and to the extent that:

1. the use of the trade mark for those goods or services commenced before the register was amended, and
2. the use of the trade mark in relation to those goods or services did not infringe the proprietor's rights based on the literal meaning of the goods and services in the register at that time.

CTM owners will also face similar limitations in case they wish to oppose or cancel a later trade mark.

## Harmonisation by way of new mandatory provisions:

- Mandatory protection in all member states for trade marks with a reputation. This will affect one or two member states who have not implemented the optional provisions.
- Member States will be obliged to provide for an administrative procedure for opposition, revocation or declaration of invalidity of a trade mark.

## Opposition period for International registrations

The current 6 month period before the commencement of the opposition period will be shortened to 1 month.

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