

## Revision of the European Trademark Law – Part 1

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On December 16, 2015, the EU-legislator adopted far-reaching amendments to the previous Community trademark regulation that governs the law of the EU-trademarks and to the European trademark directive which approximates the trademark systems on national levels throughout the EU. Both acts, the amendment regulation (EU) 2015/2424 and the amendment directive (EU) 2015/2436 can be seen here: <https://euipo.europa.eu/ohimportal/en/eu-trade-mark-legal-texts>.

The amendment regulation entered into force on March 23, 2016, and is since then directly applicable law. The amendment directive came into force on December 16, 2015, and the legislators in the EU-member states have – with certain exemptions regarding procedural changes – until January 15, 2019, for its implementation into their national trademark systems.

This post, which will be continued in the next edition of the bugle, gives an insight in the new terminology and outlines the main changes of substance. In light of these changes, proprietors of EU-trademarks and trademarks in the EU-member states should have their position evaluated and, if necessary, adapt to the new legal situation. In detail:

### Terminology

The "Community trademark" was renamed into "European Union trademark" ("EU-trademark"), and accordingly the amended "Community trademark regulation" (CTMR) is now called "European Union trademark regulation" (EUTMR). "The Office for Harmonization in the Internal Market" that grants and administers EU-trademarks was renamed into "European Union Intellectual Property Office" (EUIPO), and the "President" of the Office now has the title "Executive Director".

### Goods and services of EU-trademarks with entire class headings

Following the ECJ's "IP Translator"-judgement of June 19, 2012 (case C-308/10), the new law establishes a need for action for proprietors of EU-trademarks covering the entire class headings of at least one class of the Nice Classification of Goods and Services and that were filed before June 22, 2012.

Proprietors of such registrations may now declare, within a deadline by **September 24, 2016**, that they intended to cover with their application all goods or services included in the alphabetical list for the respective class in the edition of the Nice Classification in force at the date of filing. The declaration shall indicate, in a clear, precise and specific manner, the goods and services which the proprietor intended to cover beyond the class headings' literal meaning. Upon such declaration, the Office shall take "appropriate measures" to amend the register, i. e. add the additional indications specified by the trademark proprietor to the list of goods and/or services. EU-trademarks for which no declaration is filed within the prescribed period shall, as from September 25, 2016, be deemed to extend only to goods or services clearly covered by the literal meaning of the heading of the relevant class.

In light of such drastic consequences, it is essential for proprietors of EU-trademarks filed before June 22, 2012 to check if the lists of goods and/or services of their marks cover entire class headings of one or several Nice classes. If this is

the case, it is necessary to file applications for specification of the goods or services with EUIPO within the prescribed deadline. Should trademark proprietors fail to meet this deadline, the scope of protection of their trademarks might shrink considerably. Trademark proprietors and their representatives should therefore duly note the date September 24, 2016, and have the necessary steps taken sufficiently early.

### **Clear and precise instead of graphical representation**

The European trademark law does no longer provide for a requirement for graphical representation of a mark. Instead, each representation of a sign shall be accepted "which enables the competent authorities and the public to determine the clear and precise subject matter of the protection". The elimination of the requirement for graphical representation reinforces the position of non-traditional trademarks such as auditive, tactile, olfactory and gustatory signs since it improves their future chances for registration.

### **Absolute grounds of refusal for features of products per se**

The application area of the absolute grounds of refusal specifically adapted to shapes of products per se was extended to all signs exclusively consisting of – any – characteristic of goods. The extension was necessary due to the elimination of the requirement for graphical representation and the enhanced future registrability chances for unconventional trademarks.

### **Earlier rights establishing absolute grounds for refusal**

The revised law broadens the range of earlier rights that are to be assessed ex officio in application proceedings before the EUIPO and obliges the national trademark offices as well to ex officio examine such rights in their national application proceedings. These earlier rights, which now are regarded absolute grounds of refusal, are:

- designations of origin and geographical indications, irrespective of the products they refer to and irrespective of whether protected by provisions of EU-law, national law or international agreements that the EU or a EU-member state is party;
- traditional terms for wine, protected by Union legislation or international agreements to which the Union is party;
- traditional specialties guaranteed, protected by Union legislation or international agreements to which the Union is party;
- plant variety denominations registered in accordance with Union legislation or national law, or international agreements to which the Union or an EU- Member State is party.

These rights give also relative grounds of refusal which can be invoked in opposition and/or nullity proceedings by the legitimate persons and entities.