



Next Step For EU Trade Mark Regulation: Further Reforms Coming Into Force

With the publication of Regulation No. 2017/1001 in the EU Official Journal on 16 June 2017, we are reminded that several significant reforms will enter into force on 1 October 2017.

What has already changed?

Many will already be familiar with the changes in terminology that have been in place since March 2016, with the Office for Harmonisation in the Internal Market becoming the European Union Intellectual Property Office (EUIPO), and the Community Trade Mark becoming the European Union Trade Mark (EUTM).

The “3 classes for the price of 1” system was also replaced by a fee-per-class system, and the new Regulation clarified the EU position regarding use of class headings.

The new Regulation limited the “own name” defence to trade mark infringement, which now applies only to the names of natural persons, and not to company names.

Another important amendment in March 2016 was the change to the opposition period for EU designations of International Registrations. Whereas previously the opposition period ran between 6 and 9 months after publication of the EU designation, it now runs between 1 and 4 months after publication.

What will change on 1 October 2017?

1. Removal of graphical representation requirement

From 1 October 2017, it will (in theory) become easier to register non-traditional trade marks, since the requirement to

represent a mark graphically will no longer apply. Instead, marks will need to be represented “in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded”. In practice, this amendment will be of most benefit to those seeking to register sound or motion marks, since the EUIPO will accept sound or video files as a valid means of representation. Those seeking to register other non-traditional marks, such as smells, are likely to still face inherent objections.

2. New EU Certification Mark

A new EU Certification Mark will also be introduced in October, allowing certifying institutions to apply for EU-wide certification marks and submit regulations governing their use.

3. Priority claims

Applicants seeking to take advantage of the priority system currently have until 2 months after filing to submit their priority claim. From 1 October, priority claims must be included in the application at the time of filing.

4. Disclaimers

Applicants will no longer be able to disclaim elements of a trade mark in order to overcome objections.

What is still to come?

Member States still have until 15 January 2019 to implement the new EU Trade Mark Directive into their national laws, and until 15 January 2023 to introduce administrative cancellation proceedings.

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