



Reform of the Community Trademark Regulation

The long debated reform of the European Union Trademark System has finally led to a new Regulation on the Community Trademark as well as new Directive for the EU member states concerning the national trademarks. Whereas the member states have basically three years to implement the Directive into their national trademark law, most of the provisions of the new Regulation on European Union Trademark will enter into force on March 23, 2016. From a practical point of view, the following changes of the Regulation are most relevant.

1. New terminology

The current Community Trademark (CTM) will be renamed as “**European Union Trademark**” (EUTM). The name “Office for Harmonization in the Internal Market” (OHIM) will be replaced by “**European Union Intellectual Property Office**” (EUIPO).

2. New fee structure

A “**pay-per-class**” system will provide for a new structure for the application fees: Today, an applicant pays a flat fee for covering up to three classes. Under the amended Regulation, one fee per class will apply. While this will make single-class applications more cost-efficient, the fees for applications covering more than two classes will increase.

In regard to **renewal fees**, the very same fee-per-class system will be introduced which means a **significant reduction** of fees for the trademark owners compared to the current fees regime. The new, lower renewal fees will apply to any EUTMs due to expire on or after March 23, 2016. The office will refund any excess fees already paid.

3. Clarification of specification of “old” CTMs

Prior to the *IP Translator* decision of the ECJ in the year 2012, it had been the practice of OHIM to interpret the claim of all class headings of the Nice Classification as covering all goods or services listed in the alphabetic list of the Nice Classification for such respective class (“catch-all”). *IP Translator* ended such practice by underlining that specifications must be sufficiently clear and precise to enable the public to determine the extent of the protection (“means what it says”). If an applicant seeks to cover goods or services

beyond the literal meaning of the class headings, he must therefore specify whether its application covers all or any specific goods or services included in the alphabetical list of that class.

Against this background, the amended Regulation, codifying the ruling of *IP Translator*, **provides for a transitional period ending on September 24, 2016**, during which owners of EU trade marks filed before 22 June 2012 (the date of the *IP Translator* decision), and still registered in respect of the entire heading, may declare that their intention on the date of filing had been to seek protection in respect of goods and services beyond those covered by the literal meaning of that heading (e.g. “vehicle tires” are not covered by the literal meaning of the class headings in class 12 “vehicles; apparatus for locomotion by land, air or water”), provided that such goods or services are contained in the alphabetical list of the Nice classification for the relevant class which was valid at the date of filing. Such declaration shall indicate clearly and precisely the goods and services, other than those covered by the literal meaning of the class headings, originally covered by the owners intentions. After September 24, 2016, all trademarks containing class headings will be interpreted according to their literal meaning.

4. Counterfeit goods in transit

Under the current regime, counterfeit goods in transit which are destined for countries out-side of the EU, may not infringe EU trademarks. The amended Regulation will drastically change this concept: It is now considered an infringement where goods in transit bear a mark that is either identical or “cannot be distinguished in its essential aspects” from the respective EUTM, unless evidence is provided by the

importer of the goods that the owner of the EUTM is not entitled to prohibit the placing of the goods on the market in the final destination. Overall, this amendment has strengthened the position of trademark holders to prevent – by means of customs enforcement - accordingly labeled goods from passing through the EU.

5. Further changes

Concerning the registration procedure, the requirement of **graphic representation** is removed. The EUTM will have to have a representation on the Register in a manner which enables to determine the clear and precise subject matter of the protection sought. This

might open the registry to more non-traditional trademarks, i.e. signs that cannot be seen (such as sounds or smells).

The **opposition period for EU designations** of International Registrations will – instead of currently six months – already start one month after publication.

As clarification, the scope of protection of an EUTM will extend to **trade names or company names**. The **“own name” defense** is explicitly restricted to the honest use of a natural person’s name and not any longer for the use of a company name.

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