



April 2016

## Renewed European Trademark Regulation Entered Into Effect

In December 2015 the European Parliament approved the [proposal](#) of the European Commission to introduce a ‘Trademark Reform Package’ (Reform Package). This Reform Package aims to make European Trademark law more efficient, user friendly, and lower in cost. The Reform Package contains a new Trade Mark Directive and a renewed Community Trade Mark Regulation. The new Trade Mark Directive entered into force on Jan. 13, 2015. Member states have until January 2019 to transpose the Directive into national legislation. The dual system of national and European trademarks will remain, although the Reform Package aims to streamline both systems. The same trademark can still be registered at European and/or national level.

Contrary to the Trade Mark Directive, the renewed Community Trade Mark Regulation, now referred to as European Union Trade Mark Regulation (EUTMR), entered into force on March 23, 2016, and is immediately applicable in all member states. The EUTMR introduces important changes to the current EU framework for trademark protection. The most important changes of the EUTMR are briefly discussed in this Alert.

### **New Terminology**

Under the new Directive, the *Office for Harmonization in the Internal Market* (OHIM) will now be referred to as: *European Union Intellectual Property Office* (EUIPO). Additionally, the Community Trade Mark will now be referred to as the European Union Trade Mark (EUTM).

### **New “one-fee-per-class” System**

The EUTMR changes the fee system and applies a new “one-fee-per-class” system. The old Community Trademark Regulation applied a system whereby an applicant was able to register a trademark for three different classes at a fixed price. The EUTMR, however, introduces a system whereby applicants have to pay a fee for each individual class.

## Graphical Requirement

The requirement that a sign must be capable of being represented graphically in order to be registered as a trademark has been removed. This means that sounds and smells can now also be registered as trademarks.

## Class Headings

The Nice Classification contains 45 Classes and each class is designated by one or more general indications, commonly referred to as “class headings.” Regarding these class headings, the EUTMR applies a so-called “it means what it says principle.” This means that if a trademark registration contains the entire class heading, only the goods and services that fall under the literal meaning of the class heading are protected. This is in accordance with European case law. In June 2012 the Court of Justice of the European Union decided “goods and services for which protection of the trademark is sought should be identified by the applicant with sufficient clarity and precision to determine the extent of the protection sought.”<sup>1</sup> If a trademark registration contains the entire class heading, it does not meet this requirement.

It is likely that trademark holders who applied for a trademark before June 2012 used the entire class heading to describe the goods and services for which they sought protection. To compensate these trademark holders the EUTMR offers redress. Proprietors of EUTM applied for before June 22, 2012, who used the entire class heading, may declare “that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class.”<sup>2</sup> Trademark holders that meet this requirement are given a six-month period (the deadline is Sept. 24, 2016) to make this declaration. This declaration is free of charge. The changed identification of the goods or services in the classes is not subject to opposition again.

Trademark holders, especially those who applied for registration before June 22, 2012, should consult with their counsel to check whether their trademarks are registered with sufficient clarity and precision. In case their registration contains the entire heading of a Nice class, trademark holders must make a declaration before Sept. 24, 2016, as stated above, in order to prevent their trademark protection being scaled back to the literal meaning of the class heading.

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<sup>1</sup> Court of Justice of the European Union 19 June 2012, C-307/10 (*IP-Translator*), par. 49 and 62.

<sup>2</sup> Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable.

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