

Welcome EUIPO – EU mark Goodbye OHIM – Community Trademark



In dit nummer

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20 years ago the Community Trademark was born. It was a new type of trademark which allowed protection in all countries of the European Union at once, instead of several national applications per member state. From its inception the Community Trademark was been an overwhelming success. Every silver lining has a cloud, though. Because of the sheer number of registrations, that are sometimes not even used, it is difficult to launch a new trademark. The European Court of Justice has reprimanded the trademark authorities quite a few times on how a trademark should be registered. The law has now been amended to implement all case law on how a trademark should be registered.

After an extensive evaluation (2010) the European Parliament has approved the proposal for a new trademark directive in December 2015. Its aim is to harmonize trademark law in the European Union (minimize differences between national offices). Furthermore, the procedures need to be simplified, faster and more efficient. The national authorities have three years to implement the directive in national legislation. The directive became active on March 23. Apart from a change in names (the Community Trademark is now a European Union mark (EU mark), and OHIM is now called EUIPO) the directive introduces a few important changes. Time for an extra newsletter.

New Fees

Fees per class -lowered fees for EU renewals

As in the Benelux, the fees for an EU mark were the same up to three classes. For this reason many companies have registered their trademark not only for their core business, but also for related goods and services.

The advantage of this is that a broader scope of protection may be claimed for their trademark. The disadvantage of this practice is that trademark owners can block new application, even though they do not use their trademark for the goods and services involved.

At least for the first five years. The consequence of this is that the trademark register is saturated with trademarks that are not being used for everything they have been applied for.

In order to counter this a new fee system is introduced. From now on a fee will be paid per applied class.

This is also the case for renewals! Fees are therefore lower in some cases, and hopefully there will be more room in the trademark



End broad protection scope, recovery use of class headings

The European trademark authorities have always claimed that use of the class heading covers all products of that class. In 2012 the ECJ decided in the IP Translator case that this is not correct. In fact, protection only covers exactly what is written and not any implied goods that may fall under the terms used. This caused a problem since many trademarks had been registered with just a class heading, because companies believed this would give the largest scope of protection. A recovery procedure was created for this.



Until September 24, 2016 trademark owners can file a declaration to indicate which goods were meant to be covered by the class headings. This procedure is only available for trademarks filed before June 22, 2012.

Are only strange, non-existing products involved in this? No, cases for glasses, for example, are in class 9, but are not covered by the class heading. Are only a limited number of products affected? Again no, since the same is true for bottles for babies, cheeseburgers and translation services. The EUIPO has issued a (incomplete) list of over 67 pages of products that need further explanation. However, it is far from complete. Our advice would be to file a declaration in case a class heading has been used.

It is a hard deadline, after September 24th no more amendments are possible. Of course, we are more than happy to assist those who may need to file a declaration, especially considering the obvious problems this brings with it (which Nice classification to use, which form, language etc.) If no declaration is filed the trademark owner will only receive protection for those goods and services that are literally covered by the used words.

End of graphic representation

Up until recently a graphic representation was a prerequisite for a sign to be registered as a trademark. Now it has been dropped. The new criteria is now that a sign should be clear,

precise, objective, accessible, understandable and sustainably objective. With this new criterion an MP3 file can serve to register a sound mark. Other techniques are now also available, such as films, holograms. For example MGM's roaring lion.



Even trademarks that work by touch and smell are possible. There is a problem that the trademark authorities are facing with this change, though. They now have to decide how to organize their register to accommodate these changes and which technologies are necessary for this. For this reason the change will not be completed until October 2017. By that time the registers should be accessible for registration of alternative kinds of trademarks.

New cancellation procedure

In a few European countries it is possible to file a cancellation procedure with the trademark authorities. This is possible in case a trademark is, for example, not in use. In the Benelux, however, as well as a few other European countries, this is not possible yet. In these countries only through a formal court procedure may a trademark be cancelled. These are lengthy and costly procedures, however.



This procedure will now be harmonized as well. All national offices in the EU will have seven years' time to introduce an administrative procedure to accommodate a cancellation action. The consequence of this will be that it is going to be much easier to file a cancellation against a trademark that is not in use. The expectation is that the Benelux authorities will be able to offer this service before the deadline in seven years.

Change in opposition deadlines EU trademarks in International Registration

The introduction of the opposition procedure has led to the early resolution of many conflicts. During the cooling off period, most of the oppositions are settled amicably. In order to streamline these procedures there have been a few changes in the International Registration with regards to the EU as a designated territory.



At this moment the period to file an opposition against an EU within the international registration begins six months after publication. This will be reduced to one month after the publication date. The opposition deadline itself remains three months.

Fighting Counterfeit

In transit

Up until now it was only possible to act against counterfeit products if they were introduced on the European market. The new trademark directive changes this. The trademark owner may in the future act against counterfeit goods that have not been cleared by customs yet. This includes goods that are not meant for the European market at all, but are being shipped through the EU. (in transit).



It will now be possible to act against these transit goods, however only if the trademark used is identical or nearly identical to the registered EU mark. The right to act against

these products stops when the other party can prove that the trademark owner does not have any rights to act against these products in the destination country (because he has no rights there).

Preparatory acts in relation to the use of packaging or other means

In order to improve trademark owners' position against counterfeit articles a new article was added to the Directive. The trademark owner may act against applying infringing signs on: labels, etiquettes and safety labels. Furthermore, the use of this type of materials is not allowed. Offering, stocking, import and export of packaging, labels, etiquettes etc. which depict infringing marks is also not allowed.

New policy EUIPO for refusal of logos

Something that did not find its way into the Directive that should definitely be taken into account is the new policy of the EUIPO with regards to the admissibility of wordmarks and logos. As mentioned before, things have changed over the years on this front. Up to about a year ago semi-descriptive trademarks could still be easily registered by combining the descriptive word with a logo. This is mostly a thing of the past now.



Samples of refused EU trademark logo's

The trademark authorities refuse many figurative trademarks these days, because they believe that the logo describes the goods and services. If the logo is a depiction of the product or indicate its use or value it cannot be registered any more. We offer advice regarding the admissibility of logos and how to best strategize and anticipate on these new developments.

European Trademark Agency Abcor

Abcor is an IP Law firm, located in Europe (the Netherlands). Our specialty is consultation with regards to intellectual property matter, trademarks, designs, copy right and domain names in particular. Our services include the registration of trademarks and designs, searches, infringements and oppositions.

Suggestions for ABCOR's ABCHRONICLE may be sent to info@abcor.eu

Sources:

Adformatie, BIE, BMM, Boek9.nl, Class46.eu, Domjur.nl, Elsevier, GPD, IER, IE-Forum.nl, INTA bulletin, Nu.nl, OHIM.eu, PCM-newspapers, Quote, SIDN, Trademark Reporter and WIPO

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