

A new chapter in EU trademark reform: Changes from October 1, 2017

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European trademark law is currently undergoing its biggest reform since the introduction of the Community trademark system in 1996. On December 15, 2015, the European Parliament approved a reform package consisting of an amended European Union Trademark Regulation (Regulation [EU] 2015/2424) and a new Trademarks Directive (Directive [EU] 2015/2436). This bundle of new laws, referred to as the EU Trademark Reform Package, brings changes not only to EU trademarks but also to owners of national trademarks in the EU.

The approved reform package is the result of almost three years of interinstitutional debate. The revised laws aim to make EU trademark law fit for the business challenges of the 21st century. One of the goals is to make the registration of trademarks cheaper, quicker and more reliable for firms. Unsurprisingly, the reform package contained a wide range of innovations. Some changes are primarily technical but others can have a huge impact on trademark owners.

Parts of the reform came into force shortly after the approval of the new laws

and have already been implemented. Among these are amendments to the previous fee structure for EU trademarks and changes to the seizure of counterfeit goods in transit through the EU. The second set of changes brought about by the EU Trademark Reform Package will come into force on October 1, 2017. The main areas of change include the abolishment of the graphical representation requirement for trademarks, the introduction of a certification mark at the EU level and a number of procedural changes that aim to streamline proceedings within the EU.

Abolishment of graphical representation

The upcoming abolishment of the requirement for graphical representation for EU trademarks is among the most relevant changes contained in the reform package. This long-awaited amendment will make it far easier to register non-traditional trademarks. As of October 1, 2017, the requirement to represent a mark graphically will no longer apply. This will enable brand owners to obtain registrations for trademarks protecting sound, color, shapes and movements far more easily. To give an example: Under the current system, sound marks were reg-

istered only when musical notation was provided. As of October 1, 2017, this will no longer be required so that sounds not representable by notes may be registered.

The change will make it possible to register any sign as an EU trademark as long as it can be represented in an appropriate form using generally available technology and as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. Secondary legislation specifies the details and the European Commission has meanwhile adopted an accompanying Implementing Regulation and Delegated Regulation. The provisions of both regulations will enter into force on October 1, 2017.

Article 3 of the EU Trademark Implementing Regulation (EUTMIR) lays down specific rules and requirements for the representation of different kinds of trademarks, including some technical requirements. It also specifies whether a description is required to obtain an EU trademark and outlines the format accepted by EUIPO when filing a trademark on or after October 1, 2017. For sound, a digital sound file (MP3) will be acceptable and the same applies to motion marks,



Facilitating the registration of nontraditional marks is a central element of the ongoing reform.

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where a video file may be submitted (MP4). A description can be submitted for motion marks but this is optional and no longer mandatory. The Regulation also specifies the format requirements for multimedia marks (MP4) and hologram marks (JPEG or MP4).

Although this upcoming change will provide far more flexibility to brand owners, some nontraditional marks, such as smell marks, will remain problematic un- →

der the new rules. However, the way has been paved for a more liberal registration of nontraditional marks as identifiers of origin. As the changes only become effective on October 1, 2017, it leaves time for brand owners to consider whether new filings should be made based on these changes. The liberalization will also apply for national trademark applications in EU Member States as soon as the changes have been implemented in national law and brand owners should keep an eye on their relevant jurisdictions.

EU certification mark

In addition to the changes applying for EU trademarks, an EU certification mark will be introduced as of October 1, 2017. This new type of trademark at the EU level will enable certifying institutions to permit the use of the mark as a sign for goods or services complying with the applicable certification requirements. Certification marks can attest to the nature of the goods or services for which they are used. This may include, for example, construction materials, a method or mode of manufacture of goods or provision of services, accuracy of the goods or services, and any definable characteristic of the goods or services but not the origin of a product since this is covered by geographical indications (GIs).

The introduction of EU certification marks will remedy the current inconsistency between national systems and the EU trademark system as not all EU Member States allow for certification marks under their national systems. At present, there are a number of territories among the EU Member States where national laws do not contain provisions for certification marks. Hence, it is simply not possible to obtain protection for certification marks in those territories. In contrast, there are EU Member States, such as the UK, France, Spain and Sweden, that have existing legal frameworks for certification marks. Other jurisdictions, such as Germany, have not implemented certification marks although they provide for signs serving a similar function. Collective marks have been used to denote a certain quality in relation to a brand in Germany.

The new EU certification mark will allow for one certification mark covering all EU Member States. As in other jurisdictions that are familiar with such marks, EU certification marks will not be owned by the supplier of the goods and services but by a body responsible for certifying and monitoring the qualities or characteristics of the products. Once an EU certification mark has been granted, the certifying institution will be able to permit adherents to the certification system to

use the mark as long as they comply with the certification requirements.

Certification marks can be registered by any natural or legal person. In order to ensure the independence and neutrality of the certifying body, the trademark owner may not be a supplier of the goods and services of the kind certified. This procedure allows a certification or guarantee mark to act as an independent quality label that helps consumers to identify certain characteristics of a product controlled by the trademark owner. An applicant for an EU certification mark will also be required to submit regulations governing its use. These regulations must be submitted to the EU Intellectual Property Office (EUIPO) within two months of filing the application. The regulations must specify

- the conditions for membership,
- the characteristics to be certified by the mark,
- how the certifying body will test those characteristics and supervise the use of the mark and
- the conditions of the use of the mark, including sanctions.

The drafting of such regulations will clearly be a challenge in the application process and an application for an EU certification mark therefore requires

careful planning and preparation by the applicant.

Procedural changes

The upcoming changes will also bring a number of procedural amendments. These changes are mostly technical and relate inter alia to the filing of priority claims and the enforcement of acquired distinctiveness within the registration process of an EU trademark. The changes also cover admissibility and substantiation for relative grounds and now take into account the separate grounds on geographical indications introduced by article 8 (6) EUTMR. In addition, provisions Applicable to cancellation proceedings are aligned with opposition proceedings; rules applicable to communication by and with the Office and on the Boards of Appeal will be changed. ←



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