

The new EU Trade Mark Regulation since October of 2017

CRA – Coelho Ribeiro e Associados, SCARL

Nuno Almeida Ribeiro

Ana Carolina Santos



6 November 2017

Portugal



The reform of the European Union trademark system has moved a step forward with the publication of (i) the Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96, and (ii) Commission Implementing Regulation (EU) 2017/1431 of 18 May 2017 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark. These new regulations mainly address procedural issues.

In the meantime, on 14 June 2017, the European Parliament and the Council of the European Union adopted Regulation (EU) 2017/1001 on the European Union Trade Mark, published in the Official Journal of the European Union on 16 June 2017. The new Regulation replaces Regulation (EC) N.º. 207/2009 of 26 February 2009 and came into force on 1 October 2017. This Regulation does not provide substantive amendments to the European trade mark system, but simply codifies the various amendments to Regulation (EC) N.º 207/2009 of 26 February 2009 on the Community trade mark, which was repealed, with its successive amendments.



As a reminder, the reform of the European Union trademark system began with the publication of the Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015, and **Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015**.

Even though Regulation (EU) N.º 2015/2424 came into force on 23 March 2016, some of the changes were established to start only on October 1st 2017. Among these, we highlight the following:

1. A graphical representation of the trade mark is no longer required.

In the scope of this new system, called “what you see is what you get”, as long as the trade mark representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective, it can be represented in any form using generally available technology. Therefore, the graphical representation requirement was revoked.

This amendment allows to register non-traditional trademarks, such as multimedia, sound or olfactive trademarks. For instance, within this new scheme, it is now possible to file a sound or motion trade mark through a jpg or mp3 file without a description; the same applies to multimedia trade mark that can be filed through a mp4 file without a description.

2. Implementation of EU certification marks.

With the implementation of the European Union Certification Mark, it is now possible to register a mark in order to distinguish goods or services which are certified by the proprietor of the trade mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.

The goal is to certify goods and services according to a certain standard of characteristics applicable across the EU.

However, there are two important things to note:

- i) The certification mark cannot be owned by the person who is supplying the goods or providing the services;



ii) The geographical origin of the goods or services cannot be considered for certification purposes.

3. There were also some **procedural changes**, from which we can highlight the following:

i) From now on priority claims must be filed together with the European Union Trade mark application – the priority is now considered a ‘mere’ claim until it is relied upon and it is necessary to validate it in proceedings. The documentation in support of the claim must be filed within three months of the filing date.

ii) Acquired distinctiveness (secondary meaning) can be invoked as a subsidiary or alternative claimed, either when filing the application or in response to a first objection. The applicant can preserve the acquired distinctiveness as a subsidiary claim if the final decision on inherent distinctiveness is a negative one, therefore it allows the applicant to exhaust its right of appeal on inherent distinctiveness before it is required to prove acquired distinctiveness.

iii) If an agent or some representative registers a European Union Trade Mark without authorisation, its proprietor can now require its assignment, as opposed to its invalidation;

iv) Regarding the communications with the office, hand delivery and deposit in a post box at the Office do not exist anymore; plus, from January 1st, 2018, to fill a European Union Trade Mark application or a renewal, fax will no longer be available.

The changes imposed by the Regulation (EU) n.º 2015/2424 were aligned with the new Trade Mark Directive of the European Union. Notwithstanding, Directive (EU) 2015/2436 gave all EU Member States until January 2019 to implement it into their respective national trade mark legislation. Therefore, it will take a few more years to have the reform of the European Union trademark system fully in place in all EU countries.

For the time being, the changes covered by the Regulation already provide for a European Union Trade Mark System that is more straightforward and suited to the current times.