

Continuing EU Trade Mark Reform – Codification & Detailed Procedures

The biggest reform in European Union trade mark law in more than twenty years (“EUTM Reform”) is almost here. As you might recall, EUTM Reform began back in 2009 and has already resulted in several new European acts modernizing and harmonizing the laws of EU and Member States. However, some of the adopted legislative amendments were to enter into force at a later stage, or required subsequent transposition into the local laws of Member States, or even provided for the adoption of secondary legislation in the near future.

Within the last couple of months, three new European regulations covering the topic were adopted, and will enter into force in just a few days – on 1 October 2017. On the same date, certain legislative amendments will also become applicable, that although adopted earlier were “pushed back” till a later stage. Therefore, we will briefly focus on the new legislative acts and on those of the postponed amendments which in our opinion are among the ones having the most significant practical effects.

A brief background

The first European acts introducing EUTM Reform were adopted back in 2015, namely Regulation (EU) 2015/2424¹ and Directive (EU) 2015/2436² aiming to harmonize the Member States trade mark laws. Most of the provisions of Directive (EU) 2015/2436 have to be transposed into the local laws of Member States by 14 January 2019, except for the provisions on proceedings for the revocation and declaration of invalidity for trade marks which shall be transposed by 14 January 2023.

On the other hand, the provisions of Regulation (EU) 2015/2424 that entered into force on the 23 March 2016 are directly applicable in all Member States. Therefore, some of the legislative amendments introduced by the said Regulation already resulted in, among others, (i) change in the name of the organization managing trade marks and industrial designs on a European Union level – from the Office for Harmonization in the Internal Market to the European Union Intellectual Property Office (“Office”), and (ii) change in the name of the trade marks protected throughout the European Union – from a Community trade mark to a European Union trade mark (“EUTM”). However, Regulation (EU) 2015/2424 explicitly stipulated that some of its provisions shall enter into force at a later stage – on 1 October 2017, and also provided for some secondary legislation that had to be subsequently adopted.

New European acts

In the second quarter of 2017, three new regulations were adopted, continuing EUTM Reform, that will be applicable from 1 October 2017 subject to certain exceptions explicitly indicated thereof.

Two of the said acts are, namely, the secondary legislation mentioned in Regulation 2015/2424 – Commission Delegated Regulation (EU) 2017/1430³ and Commission Implementing Regulation (EU)

¹ 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 to the Office for Harmonization in the Internal Market (Trade Marks and Designs)

² Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

³ 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

2017/1431⁴. In a nutshell, the Implementing Regulation sets rules for, among others, the registration process for a EUTM, for maintenance of such registration and for the procedure for international registration of trade marks (e.g., what the application for registration shall contain, how a trade mark shall be represented, etc.). The Delegated Regulation, on the other hand, provides details mainly on the opposition, revocation and invalidity of EUTM procedures (e.g., what the notice of opposition and the application for revocation shall contain, etc.).

The third new regulation is simply aimed at making the lives of the persons/entities dealing with EUTMs easier. This new Regulation (EU) 2017/1001⁵ does not introduce new legislative amendments but rather codifies/brings together in a single legislative act the amendments made thus far to the old EU Trade Mark Regulation (EC) 207/2009⁶ and repeals it.

The most significant changes

Below you can find some brief thoughts on seven of the “postponed” amendments entering into force on the 1 October 2017, that in our opinion are among the most significant ones from a practical point of view:

- **No graphical representation needed** – thus far, when applying to register a sign for a EUTM registration, the sign had to be “capable of being presented graphically⁷” or the registration was to be refused. This requirement has now been abolished and signs applying for a EUTM registration only need to be capable of being represented “in a manner which enables [...] to determine the clear and precise subject matter of the protection afforded⁸”. This new rule will facilitate the EUTM application and registration process and will provide more options for applicants in regards to what their EUTMs should look like.
It is worth mentioning that pursuant to Directive (EU) 2015/2436, all Member States also should, in the future, exclude from their local laws any requirement for a graphical representation of signs applying for registration as national trade marks, if any (e.g., the current Bulgarian law sets such a requirement).
- **Colours and sounds now easily possible** – the list of signs capable of being registered as EUTMs is supplemented and now explicitly provides that colours and sounds can be applied for as EUTMs. This legislative amendment, together with the abovementioned abolishment of the requirement for graphical representation, will facilitate the registration of non-traditional signs.
- **Transfer of multiple EUTM registrations and applications through a single application** – now it is possible to register the transfer of several EUTMs, or EUTM applications, at once and through a single application. This option, however, shall be available only if the proprietor, or the

⁴ 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

⁵ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

⁶ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark

⁷ Art. 4 of Council Regulation (EC) No 2007/2009 of 26 February 2009 on the Community trade mark

⁸ Art. 4, letter (b) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

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applicant “and the successor in title are the same in each case⁹”. This shall apply also to applications for changes of the name or address of both the proprietor and the registered representative. It could be expected that this legislative amendment will facilitate, among others, the completion process for M&A deals involving large amount of IP assets, such as trade mark portfolios.

- **Entries “shall be cancelled or modified at the request of one of the parties¹⁰”** – now it is explicitly stipulated that the cancellation or modification of entries with respect to (i) transfers of trade marks, (ii) encumbrances on trade marks (e.g., trade marks given as securities), (iii) trade marks levied in execution and (iv) the grant or transfer of a licence in respect of a trade mark shall be done at the request of one of the parties involved.
- **Priority claims – supporting documents at a later stage** – now it is explicitly specified that “priority claims shall be filed together with¹¹” the application for registration of a EUTM while the supporting documents “shall be filed within three months of the filing date¹²”.
- **Seniority claims now have a precise timing** – the new EU trade mark law still provides for the possibility of a proprietor of an earlier trade mark to claim seniority of the trade mark either (i) before/together with the registration of the EUTM or (ii) after its registration. The new feature here is that now the terms for claiming seniority prior to EUTM registration are explicitly set. There are two options for claiming seniority before/together with EUTM registration – either together with the EUTM application or within two months of the filing date of the application. In the first case, the seniority claim supporting documentation shall be filed within three months of the filing date, while in the second case – within three months of the receipt of the seniority claim.
- **EU certification marks** – the new EU trade mark law introduces the EU certification mark as a sign certifying the “material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin¹³” of the goods and services bearing an EU certification mark. Thus, the EU certification marks shall not be used by their proprietors (as is the case with “regular” trade marks) but by authorized persons/entities that are involved in, for example, the production of goods of the same quality or material and comply with regulations governing the EU certification mark’s use that are set by its proprietor.

⁹ Art. 20, Paragraphs 8 and 9 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

¹⁰ Art. 22, Paragraph 3, Art. 23, Paragraph 4, Art. 25, Paragraph 6, Art. 29, Paragraph 1 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

¹¹ Art. 35, Paragraph 1, 1st sentence of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

¹² Art. 35, Paragraph 1, 2nd sentence of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

¹³ Art. 83, paragraph 1 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark

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Therefore, anyone, as long as he/she does not “carry on a business involving the supply of goods or services of the kind certified¹⁴” can apply for the registration of an EU certification mark.

It is worth noting that Directive (EU) 2015/2436 lets Member States decide whether to introduce certification marks in their local trade mark law or not (e.g., certification marks were introduced into Bulgarian law almost twenty years ago).

In view of the above, it could be concluded that the legislative amendments already in force and those to be applied from 1 October 2017 are indeed important and will have a noticeable effect on the way EUTMs are being applied, used, maintained, treated and protected in the future. Thus, this modernization and harmonization of the EU and Member States trade mark laws might result in, among other things, changes in the practice of the Office, in the practice of the local intellectual property offices of Member States and in the local trade mark legislation of Member States.

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¹⁴ Art. 83, paragraph 2 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark