

The Trademark Lawyer

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GLOBAL REACH, LOCAL KNOWLEDGE

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Welcome to Orlando

The Trademark Lawyer celebrates the 138th INTA annual meeting with a special bumper issue



CTC Legal Media

PLUS

An interview with INTA's president, Ronald van Tuijl, discussing the association, the annual meeting, and more

- Brand protection evolution
- Chinese trademark law
- Business development strategies
- Turkish law revisions
- Trademark squatting
- International litigation cases
- Crowdfunding



Dr. Emanuele Lunati

Community trademark regulation amendment in the EU

Dr. Emanuele Lunati explores the amendments of the 'Community Trademark' (CTM) regulation - which is now classed as the 'European Union Trademark' (EUTM) regulation – and pinpoints a selection of the most noteworthy adaptations.

Regulation 2015/2424 amending the Community trademark regulation, came into force on 23 March 2016. The term 'Community trademark' has been replaced by 'European Union trademark', thus amending the acronym CTM, which has been replaced by EUTM (European Union Trademark). The OHIM in Alicante has also been renamed the EUIPO, in line with the changes.

But, what are the most important changes that the transition from the old system to the new one will entail? Let us examine some of the most noteworthy points.

Article 4

Trademark applications will no longer need to represent marks graphically (Article 4). In other words, it will be possible to register non-traditional trademarks, provided the clear and precise subject matter of the protection may be determined.

It will therefore be easier to register marks such as smells or flavors, for example, allowing applicants to use instruments that take advantage of available technologies. This will present new challenges for the creativity of entrepreneurs.

Article 9

The rights conferred by an EU trademark have also been extended (Article 9). The proprietor may now prevent third parties from using the sign as a trade or company

name, and from using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC of the European Parliament and of the Council.

Another interesting development regards the new right to prohibit preparatory acts in relation to the use of packaging, labels and tags to which the mark is affixed. If there is a risk that these could constitute an infringement of the rights of the proprietor of an EU trademark, such acts are carried out in the course of trade (Article 9b).

Articles 7 & 8

The protection of geographical indications has been strengthened, with new prohibitions on the registration of new trademarks, in order to further reduce the possibility of conflicts between such geographical indications (Article 7). It will now be possible to file oppositions to new trademarks on the basis of geographical indications (Article 8). Particular care will be required when filing trademarks that include geographical names.

“ *The protection of geographical indications has been strengthened, with new prohibitions on the registration of new trademarks.* **”**

Résumé

Dr. Emanuele Lunati

Dr. Emanuele Lunati has a degree in Political Science at 'Università degli Studi' in Milan, and he is trademark and design attorney before the UIBM and EUIPO. He has been closely working with trademarks throughout the last eight years, in consence for the filing of new trademarks and about opposition matters



Article 74

The new provisions introduce EU certification marks, capable of distinguishing specific characteristics of goods or services, such as the material, method of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin (Article 74b).

Application fees

The application fee structure has also changed: instead of covering three basic classes, the new fee covers one class (slightly lower than the current fee), and increases for each subsequent class.

This will limit the tendency to file trademark applications for products and services of secondary importance, and benefit proprietors applying for "targeted" trademarks, linked to specific, delimited products only. This should substantially reduce the risk of future conflicts, since under the previous system, applicants could choose to include additional classes simply because they were included in the fee.

Meanwhile, owners of trademarks applied for before 22 June 2012 (IP Translator decision) have been granted a six-month grace period in which to provide their specification of goods and services registered in respect of general class headings. In short, whereas general terms were used under the previous system, applicants must now specify exactly what they intended to cover.

Customs

Lastly, trademark protection has been strengthened in customs situations. EU trademark proprietors will be able to prevent the entry of infringing goods, also when such goods are only in transit and not intended for the EU market. This amendment will certainly make it easier for trademark owners to protect their rights.

Proprietors have until 23 September in which to take action: where no declaration is filed, their trademarks will remain in force, but after that date will be deemed to cover only the goods covered by the literal

meaning. It is therefore important to seek professional advice on how best to proceed.

In any case, the direction of change in the future appears clear: anyone intending to file a new trademark must have a very clear and defined idea about which goods it will cover.

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