



European Union Trademark Reform —Further Changes Have Arrived

IN SHORT

The Situation: Alterations to the European Union's trademark laws came into force on October 1, 2017.

The Result: The changes address matters relating to certification marks and will also introduce a number of procedural changes.

Looking Ahead: The modifications should streamline trademark proceedings and define the tasks of the European Union Intellectual Property Office, while also fostering cooperation between the Office and the intellectual property offices of individual Member States.

On October 1, 2017, important changes to EU trademark legislation came into force. The changes arise from Regulation (EU) No. 2015/2424 of the European Parliament and the Council amending the [Community Trade Mark Regulation](#) ("Amending Regulation").

The Amending Regulation's objectives are to streamline proceedings and increase legal certainty, as well as to clearly define all tasks of the European Union Intellectual Property Office ("Office"), including providing a framework for cooperation and consistency among the Office and the Member States' intellectual property offices.

The Amending Regulation also introduced a number of provisions that will come into force 21 months after its publication, as they have been developed by secondary legislation that consists of:

1. The Implementing Regulation, which covers matters such as the contents of an EU trademark application, its representation, language and translation issues, questions of priority and seniority, transfers and surrenders, EU collective and certification marks, and certain procedures concerning international registration; and
2. The Delegated Regulation, which covers procedural rules relating to oppositions, revocation and invalidity actions, appeals to the Board of Appeal, the organization of the Boards of Appeal, notifications from the Office and communications with the Office, and time limits and suspensions.

On August 8, 2017, these two acts of secondary legislation were published and came into force on October 1, 2017. The practical impact that these significant changes are likely to have on brand owners is discussed below.



One of the most significant changes under the new legislation is that EU trademarks no longer must be represented graphically.



Certification Marks

While certification marks have been acknowledged by trademark laws of certain Member States for some time, such marks are a new kind of EU-wide trademark. Article 17 of the new Implementing Regulation governs the procedural issues relating to certification marks.

A "certification mark" is defined as a mark that is "capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performances of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified."

An EU certification mark relates to the guarantee of specific characteristics of certain goods and services. It indicates that the goods and services bearing the mark comply with a given standard set out in the "regulations of use" and controlled under the responsibility of the certification mark owner, irrespective of who actually produces or provides the goods and services at issue and actually uses the certification mark.

These regulations of use constitute the essence of the certification mark. They must be filed within two months of the application and must contain:

- The characteristics of the goods or services to be certified;
- The conditions governing the use of the certification mark; and
- The testing and supervision measures to be applied by the certification mark owner.

There are two important limitations for an EU certification mark: (i) the owner of a certification mark is precluded from using the mark for the certified goods or services covered; and (ii) it cannot be filed for the purpose of distinguishing goods or services certified based on geographical origin.

A certification mark application should be submitted for the goods and services that will be certified by the mark's owner, and a list of goods and services covered by the certification mark must be included in the regulations of use. An application fee of €1,500 applies to certification marks submitted by electronic means.

Graphical Representation

One of the most significant changes under the new legislation is that EU trademarks no longer must be represented graphically. Rather, applicants may utilize any generally available technology in order to represent the mark applied for, provided it is done in a clear and precise way.

This opens the way to registering nontraditional trademarks by nongraphical means, such as MP3 files of sound marks (as opposed to a graphical music notation, as required under the former system) and video files of multimedia or motion trademarks. Thus, applications for nontraditional EU trademarks are now expected to increase.

Procedural Changes

The new legislation will also result in a number of procedural changes.

For example, the new legislation establishes a procedural ability to invoke acquired distinctiveness as a subsidiary or alternative claim. Applicants can therefore wait until a final decision is made on inherent distinctiveness before claiming acquired distinctiveness, and they will not have to incur the expense of gathering and presenting evidence of use unless it becomes necessary.

Priority claims must now be made at the time of filing the EU trademark application, since the ability to claim priority subsequent to the actual filing has been abolished. Consequently, the three-month period to file documentation in support of the claim now starts from the date of filing the application. Additionally, the Office will no longer review a claim for priority in substance; instead, the claim must be validated in the proceedings.

Additionally, two amendments address changes caused by developments in information technology. The legislation introduces online substantiation to applications for oppositions or cancellations. These applications can now be substantiated by providing evidence or content through the following online sources, among others: (i) all of the databases of the national and regional European IP offices; (ii) TMview; and (iii) EU databases (E-Bacchus, E-Spirits, and E-Door).

Also, communication by and with the Office has been changed. Hand delivery and deposit in a post box at the Office are no longer available options, while the ability to communicate with the Office by mail was explicitly extended to include transmission via courier.

While facsimile is considered an "electronic means"—making an application submitted by facsimile eligible for the discounted fee—starting January 1, 2018, facsimile will no longer be accepted for filing EU trademark applications or renewals. Submitting an application via facsimile will be available only as a backup system for online applications (e-filing); if technical malfunctions prevent e-filing, the applicant can secure a filing date by facsimile.

TWO KEY TAKEAWAYS

1. The reforms introduce the Implementing Regulation, which covers matters such as the certification mark as a new kind of EU trademark, as well as the contents of an EU trademark application, and the Delegated Regulation, which covers procedural rules relating to oppositions, revocation and invalidity actions, and appeals
2. Procedural changes include a procedural ability to invoke acquired distinctiveness as a subsidiary or alternative claim, a requirement that priority claims must be made at the time of filing the EU trademark application, and the introduction of online substantiation to applications for oppositions or cancellations.

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