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# Impact of the EU Trademark Reform

*14 April 2016*

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## ■ **Dual trademark system in Europe:**

- National level: trademark rights granted by the office of one Member State limited to the territory of that Member State
- European level: trademark rights granted by the European office covering the 28 Member States of the EU

## ■ **New trademark legislation (adopted in December 2015):**

- A Directive which approximates the laws of the Member States relating to national trademarks (“NTMs”)
- A Regulation relating to European Union trademarks (“EUTM”)

## ■ **Entry into force:**

- Directive: most provisions must be implemented by Member States by January 2019
- Regulation: most provisions entered into force on 23 March 2016

- ✓ New Naming
- ✓ New Fee Scheme
- ✓ New Proceedings Before National Offices
- ✓ New Observation System
- ✓ Goods and Services Identification Requirements
- ✓ Broader Protection For Non-Traditional Marks
- ✓ Creation of Certification Marks
- ✓ Strengthening the fight against counterfeiting



OFFICE FOR HARMONIZATION  
IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)



**EUIPO**  
EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE

Community Trade Mark  
(CTM)



European Union Trade Mark  
(EUTM)

- One-fee-per-class system
- Renewal fee substantially lower (by approximately 30%)

	Old Fee	New Fee
<b>EUTM Registration</b>		
For 1 class	€ 900	€ 850
For 2 classes	€ 900	€ 900
For 3 classes	€ 900	€1,050
Additional fee for subsequent class	€ 150	€ 150
<b>EUTM Renewal</b>		
For 1 class	€1,350	€850
For 2 classes	€1,350	€900
For 2 classes	€1,350	€1,050
Additional fee for subsequent class	€400	€150

- Member States must put in place:
  - Administrative opposition proceedings within 3 years
  - Administrative cancellation proceedings within 7 years
  
- Consequences for trademark owners:
  - Positive: lower costs
  - Negative: increased number of actions and risk of revocation

- Interested Third Parties can comment as soon as an application is filed, but before the end of the opposition period or before the final decision on the opposition.
  - Similar to the Letter of Protest system in the U.S.



- The new rules:
  - Specifications have to be clear and precise
  - Classification has no impact on the assessment of similarity
- Time frame:
  - New applications:
    - ✓ for EUTMs : new rules are already effective
    - ✓ for NTMs : they implemented by each Member State within 3 years
  - Existing EUTM: 6 month window of opportunity (until 24 September 2016) to amend the specifications of EUTM registered for a Nice class heading

- Non-Traditional Marks: shape of goods or packaging, tactile, sound, scent, taste
- Until now, difficulties to get a non-traditional mark registered because of the “graphical representation” requirement. Representation must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective.”

- **Example of a tactile mark**

Procter & Gamble EUTM application for goods in class 3 including:

a picture



and

a description

*“The applied mark consists in the tactile feeling constituted by the imprinted embossed pattern on the smooth bottle surface”*

EUIPO 27 May 2015: not represented graphically

## ■ Examples of olfactory marks

1. Smell of Methyl Cinnamate  
 $C_6H_5 - CH = CH COOCH_3$   
EU Court 12 Dec 2002
2. Smell of ripe strawberries



EU Court 27 Oct. 2005

- **Example of a sound mark**

First nine notes of the musical composition “Für Elise” by Ludwig van Beethoven.

EU Court 27 Nov. 2003

- **Removal of the “graphical representation“ requirement**

*A trade mark may consist of any signs which are capable of:*

- (a) distinguishing the goods or services from those of other undertakings*
- (b) being **represented in a manner which enables to determine the clear and precise subject matter of the protection afforded to its proprietor***

- Will it be easier to obtain a registration for non-traditional marks?

*Not so sure...*

- 2 main obstacles to overcome:
  - Find a “*clear, precise, self-contained, easily accessible, intelligible, durable and objective way*” to represent the mark
  - Make sure the mark is distinctive

- Definition: marks which allow a certifying institution or organization to permit adherents to use the mark as a sign for goods or services complying with the certification requirements
- Key features of certification EUTM:
  - ✓ Regulations governing the use of the certification mark
  - ✓ Only the proprietor of the mark is entitled to bring an action for infringement.
- Member States have the possibility to create certification NTM and have some flexibility to set out the rules governing them.



## ■ New infringing acts

- ✓ Use of a protected mark as a trade or company name
- ✓ Use of a protected mark in certain comparative advertising
- ✓ Preparatory acts in relation to the use of packaging or other means

## ■ **Infringing Goods in transit**

- ✓ Trade mark owners can stop infringing goods in transit even if they are not intended to the EU market
- ✓ During subsequent proceedings, the importer to recover the goods has to prove that trade mark owner has no right at final destination



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