

The all-new EU trade mark system

NEW Regulation
(EU) 2015/2424
effective March 23 2016

NEW Directive
(EU) 2015/2436
member states must implement
by January 15 2019

Name changes

~~OHIM~~

~~CTM~~

EUIPO

EUTM

No change to
territorial scope

No change (yet)
to RCD

Management Board

New fees

Application



Renewal



Article 28(8) Declarations

- *IP TRANSLATOR* case
- Affects applications filed up to June 22 2012 and registered in respect of entire heading of a Nice class
- Deadline to file declarations is September 24 2016
- Dedicated form
- No fee. One of five official languages must be used
- Declarations will be reviewed by EUIPO and there is an extendible two-month deadline to remedy deficiencies

New absolute and relative grounds

- Article 7(1)(e) of the Regulation: new absolute grounds
- Functional exclusion extended to non-shape marks
- Prior rights now include designations of origin, geographical indications and plant variety rights
- Article 8(4)(a) and 51(1)(d): new relative grounds
- Opposition and cancellation actions based on PDOs & GIs

Anti-counterfeiting

- Goods in transit: *Nokia* and *Philips* cases
- Trade mark owners can seize goods in transit through the EU that are suspected to infringe
- Onus is on holder of goods to show they do not infringe in country of final destination
- New prohibition against preparatory acts, such as printing of packaging

Further changes on October 1 2017

- Abolition of graphical representation requirement (Article 4)
- Expected to make it easier to file non-traditional marks (such as smells)
- Introduction of EU certification marks (Article 74)

Changes in the Directive

- Affects all trade mark offices in EU member states – namely national IP offices and the Benelux IP Office
- Offices must provide administrative trade mark cancellation proceedings
- Deadline to introduce these is January 2023
- Affects about 25% of national trade marks in Europe
- Offices need time for staffing, training & IT systems

Thank you

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