

New European Trademark Regulation

Summary of the most important changes:

New regulations	Comment by Schorr IP
Application fee is reduced by covering one class. For second class and further classes additional fee is due.	For those planning a European Union Trademark application with three classes or more: ' Hurry to file application before March 23, 2016! With the new regulation the application for three classes and subsequent classes will be 150 € more.
The requirement of graphic representability will be deleted.	Functional signs (e.g. colour or sound) will now be subject to the same prohibitions applied to shape marks.
It has been clarified that the exclusive right of a proprietor of a trade Mark also comprise to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign, even when the sign is a packaging or a company name.	Confusion as to the commercial source from which the goods or services emanate may occur when a company uses the same or a similar sign as a trade name in a way such that a link is established between the company bearing the name and the goods or services coming from that company. Infringement of an EU trade mark should therefore also comprise the use of the sign as a trade name or similar designation as long as the use is made for the purposes of distinguishing goods or services.
Proprietors can prevent the entry of infringing goods and their placement in all customs situations, including transit, transshipment, warehousing, free zones, temporary storage, inward processing or temporary admission, also when such goods are not intended to be placed on the market of the Union.	Until now, it was possible to transport infringing goods through the EU, in case the transporter was not opened within the EU. Now, even a drive-through the EU can be prevented.
The day on which a proof of use is to be submitted and the corresponding periods of use to be determined, depend the future of the filing or priority date.	Prior to the calculation of the periods of use established by the date of publication of the registration. An earlier use of future brands is advised.

Detailed explanation of the Changes:

Motivation

On **23 March 2016** the new regulation (EU) No 2015/2424 will enter into force and will replace regulation (EU) No 2008/95/. To put it simply, the Community trade mark regulation (CTMR) will be replaced by the EU trade mark regulation (EUTMR).

The Amending Regulation, in particular, seeks to:

- streamline proceedings and increase legal certainty;
- define clearly all the Office's tasks;
- revise the fees payable to the Office, including an overall reduction in their amounts.

Visible Changes – New Names

Old	New
Office for Harmonization in the internal Market (OHIM)	European Union Intellectual Property Office (EUIPO)
Community trade mark (CTM)	European Union trade mark (EUTM)
Community Trade Mark Regulation (CTMR)	European Union Trade Mark Regulation (EUTMR)

Member states of the EU: http://europa.eu/about-eu/countries/member-countries/index_de.htm).

Essential changes

Fees:

Old	New
Application fee covered three classes (900 €) For fourth and subsequent classes (150 €)	Application fee covers one class (850 €) For second class (50€) For third and subsequent classes (150 €)
Renewal fee for three classes (1350 €) For fourth and subsequent classes (400 €)	Renewal fee for first class (850 €) For second class (50€) For third and subsequent classes (150 €)
Opposition (350 €) Cancellation (700 €) Appeal (800 €)	Opposition (320 €) Cancellation (630 €) Appeal (720 €)

Advice:

If you presently plan to file a Trademark in the European Union with at least three classes, file it before March 23, 2016 to save application fees!

Examination, new regulations:

- No possibility of filing EU trade mark applications through national offices.
- Users can choose whether they want to receive EU search reports and surveillance letters.
- The Amending Regulation clarifies the impact of the revocation of an earlier mark on which a seniority claim is based, which will now depend on the date of effect of the revocation.
- Third-party observations should be submitted before the end of the opposition period or, where an opposition against the trade mark has been filed, before final decision on the opposition.
- Office has the right to re-open the examination of absolute grounds on its own initiative at any time before registration.

Absolute grounds, new regulations:

- The requirement of graphic representability will be deleted. Functional signs (e.g. colour or sound) will now be subject to the same prohibitions applied to shape marks.
- The Amending Regulation clarifies the prohibitions related to Protected Designations of Origin (PDO), Protected Geographical Indications (PGI) and other intellectual property titles.
- The possibility of making a declaration disclaiming exclusive rights to non-distinctive elements of trade marks in order to avoid doubts as to the scope of protection has been eliminated.
- The Amending Regulation codifies the current practice as regards invalidity proceedings based on absolute grounds, limiting its examination to the arguments and the grounds provided by the parties.

Opposition and cancellation, new regulations:

- Opposition period against international registrations designating the EU will now start one month after the date of publication.
- EU trade mark courts will not proceed with the examination of counterclaims until either the interested party or the court have informed the Office of the date on which the counterclaim was filed.
- The Amending Regulation imposes on the Office the obligation to inform the EU trade mark court in question of any previous application for revocation or for a declaration of invalidity filed before the Office.

Relative Grounds, new regulations:

- Introduction of a separate specific ground of opposition and cancellation on the basis of Protected Designations of Origin (PDO) and Protected Geographical Indications (PGI).
- Changes in one of the dates for determining the obligation to submit proof of use and determining the relevant period. The relevant date will now be the date of filing or priority date of the contested EU trade mark application rather than the date of its publication.
- A series of clarifications in line with existing practice and case law.