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NEW EU TRADEMARK LAW LEADS TO NUMEROUS CHANGES

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In December 2015, the European Parliament and the Council of the European Union decided on an extensive reform package which has effects both on European and national trademark law.

The directive relating to national trademark law has to be implemented by the member states only within the three years to come. The changes of European trademark law, however, will enter into force on **23 March 2016**.

NEW TERMINOLOGY

It will at first be necessary to get used to new terms in European trademark law: the Community trademark will in future be called EU trademark, and accordingly, the underlying regulation will be called EU Trademark Regulation (EUTMR).

The Office for Harmonization in the Internal Market (OHIM) in Alicante which is responsible for the examination, the registration and the administration of EU trademarks will have its name changed to European Union Intellectual Property Office (EUIPO) to better reflect the actual work of the office.

CHANGES OF THE OFFICIAL FEES

For the calculation of the official application and renewal fees for EU trademarks, there will be in future a further differentiation according to the number of classes of

goods and services covered by the trademark. The following comparison of the previous and new fee rates shows that the costs for the application of EU trademarks with more than two classes slightly increase while the renewal fee respectively payable after a protection period of ten years becomes significantly more cost-effective.

	Application Fee		Renewal Fee	
	old	new	old	new
1 class	EUR 900	EUR 850	EUR 1500	EUR 850
2 classes		EUR 900		EUR 900
3 classes		EUR 1050		EUR 1050
each additional class	EUR 150	EUR 150	EUR 400	EUR 150

In case the application of a EU trademark for three classes or more is intended, the application should be filed for cost reasons prior to 23 March 2016 if possible, as long as the former schedule of fees is still valid.

The official procedural fees are also reduced. Accordingly, EUR 320 will be payable in future for an opposition procedure (instead of previously EUR 350), and EUR 720 (instead of previously EUR 800) for an appeal procedure.

NEW DUE DATE FOR TRADEMARK RENEWAL

In future, the due date for the renewal of a EU trademark will no longer be the last day of the month in which the protection period of the trademark ends, but the exact date of the expiration of protection. The request for renewal is to be submitted and the renewal fee is to be paid within six months before this date. The reduced renewal fees will apply to EU trademarks expiring on or after 23 March 2016, regardless of the date the renewal is requested and paid for.

EXPLANATION FOR THE INTERPRETATION OF CLASS HEADINGS

One of the main issues of the reform package relates to the interpretation of general indications included in the class headings of the Nice Classification. The reason therefore is the decision "IP-Translator" of the CJEU of 19 June 2012 (Case no. C-307/10). Prior to this decision, a Community trademark specifying all general indication of a class heading was deemed to be protected for all goods or services as listed under this general indication, irrespective of whether these are also covered by the literal meaning of the general indication.

Example

According to the 9th edition of the Nice Classification (NCL9) which was valid for trademark applications between 1st January 2007 and 31st December 2011, an application designating the general indications "data processing equipment and computers" of the class heading of Class 9 also comprised "software".

In its judgment "IP-Translator", the CJEU decided that the use of general terms, including the general indications of the class headings of the Nice Classification, is to be interpreted such that they include only such goods or services which are unambiguously covered by the literal meaning of the terms. In the example mentioned above, in accordance with the new reading, the trademark may thus seek protection for equipment such as personal computers or laptops, however not for software. This modified interpretation does not only apply to new but also to earlier trademarks for which an application has been filed before the decision "IP-Translator".

The new trademark regulation therefore gives the proprietors of earlier trademarks applied for before 22 June 2012 and registered in respect of the *entire* heading of a Nice class the single opportunity to declare before the office **by 24 September 2016** how the general indications of the class heading are to be interpreted. Trademark proprietors also have the choice whether they seek protection for all goods or services included in the class or merely for those goods or services which are clearly covered by the literal meaning of the general indication. The latter is assumed in case the trademark proprietor does not file any declaration within the mentioned term.

DESIGNATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS EXCLUDED FROM REGISTRATION

The wording of the new EU trademark regulation furthermore clarifies that designations of origin, geographic indications, traditional terms for wines, traditional specialties guaranteed and registered variety denominations are also excluded from registration as a trademark, provided that they are protected by Union legislation, an international agreement or national law of a EU Member State.

EXTENDED RIGHTS CONFERRED BY THE EU TRADEMARK

Pursuant to the new regulation, third parties are also expressly prohibited from inadmissibly using a European Union trademark as a trade name or company name or as part of a trade name or company name. The proprietor of a trademark may furthermore prohibit the use of the sign in the context of unfair comparative advertising.

QUESTIONS?

In addition to the arrangements mentioned above, the new EU trademark regulation will also lead to some further changes. If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Adrian Kleinheyer at (a.kleinheyer@prinz.eu).

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