

## Entry into force of the new EUTM Regulations (formerly CTM Regulation)

The long awaited reforms to the European Union trademark system were passed at the end of December 2015. The **new CTM Amending Regulation** ("**Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)**") (hereinafter referred to as the "EUReg") was published on December 24, 2015. The **Trademark Directive (EU) 2015/2436** was published on December 23, 2015.

The principal changes introduced by the EUReg will enter into force in 90 days from its publication, i.e. on 23 March 2016.

The Directive entered into force on January 12, 2016. The EU Member States will have three years to amend their national trademark laws to comply with the majority of the new provisions of the Directive. They will have seven years, however, to implement the administrative revocation and invalidity proceedings before the national trademarks offices.

A summary of the principal changes is set forth below.

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### Change in name for the Office and CTMs

The OHIM will now be called the European Union Intellectual Property Office (**EUIPO**). Community trade marks will now be called European Union Trade Marks (**EUTMs**).

### Change in fee structure

The "three classes for the price of one" fee structure has been changed for both the filing and the renewal fees. Instead, the fees will be calculated on a per class basis.

The new basic official fees will be:

Type of fee	Application	Renewal
1 <sup>st</sup> class	€850	€850
2 <sup>nd</sup> class	€50	€50
3 <sup>rd</sup> and further classes	€150	€150

This will result in a slight decrease for one class filings versus a more significant increase for filings in 3 classes and above as demonstrated below. For renewals, it will result in decreases all across the board demonstrated below.

<b>Number of classes</b>	<b>Current Fees</b>	<b>New Fees</b>
Filing in 1 class	€900	€850
Filing in 2 classes	€900	€900
Filing in 3 classes	€900	€1050
Filing in 4 classes	€1050	€1200
Renewal in 1 classes	€1350	€850
Renewal in 2 classes	€1350	€900
Renewal in 3 classes	€1350	€1050
Renewal in 4 classes	€1750	€1200

**Practical advice – if you typically file in 3 or more classes, you may want to review your filing strategy for 2016 to accelerate as many filings as possible prior to the March 23, 2016 implementation of the new fee structure.**

**To the contrary, to the extent possible, it is advantageous to wait until March 23, 2016 to proceed with renewals regardless of the number of Classes.**

### **Change in renewal fee due date**

Renewal fees must be paid by the renewal date rather than at the end of the month.

### **Scope of protection in light of IP Translator decision; New EUREg Article 28**

One of the most important Court of Justice of the European Union decisions of the last few years, IP TRANSLATOR, held that the protection provided by a trademark covering the general class headings of the Nice Classification should be limited to the literal meaning of the terms.

Prior to this decision, the protection afforded by the OHIM included all of the products/services included in the alphabetical list of that class in the edition in force at the time when the filing was made.

Although the scope of protection is therefore clear with respect to EUTMs filed and registered after June 21, 2012, it is less clear with respect to EUTMs filed and registered prior to this date that claim protection for the general class headings.

The solution provided in Article 28(8) of the EUREg is to create a sunrise period of six months, from March 23, 2016 through September 24, 2016, during which owners of EUTMs filed before 22 June 2012 that cover entire class headings may file a declaration to amend the goods and services to specify those that

they intended to cover in addition to the literal interpretation of the class heading. At the end of this six-month period, the EUTMs will be interpreted as being protected exclusively for the literal meaning of the terms included.

## EUTMs affected

Community trade mark registrations filed before 22 June 2012 and International Registrations designating the EU before 22 June 2012 that continue to be registered for the entire class heading of a Nice Classification.

## EUTMs filed on or before 22 June 2012 but not yet been registered?

Article 28(8) Declarations cannot be filed. It may be possible to amend the class heading terms included in such applications by the partial withdrawal procedure to specifically set out the applicable terms from the alphabetical list. If you would like assistance on this, please contact us and we can advise you further.

## Can I amend my registration to cover anything in that class?

You can amend your registration to include any terms in the alphabetical list for that class of the edition of the Nice Classification in force at the date of filing which are not already clearly covered by the literal meaning of the class heading terms. If you are unsure as to what was included in the alphabetical list at the date of filing, please contact us and we can provide you with a list.

We are happy to check items against the alphabetical lists and supply entire alphabetical lists without charge for any Community trademarks for which we are the OHIM representative. If we are not the OHIM representative for your Community trademark, we will be happy to provide these services for a nominal fee of 200 euros per mark.

If you wish to replace the class heading terms with more precise terms which are included in their scope, we would suggest use of the partial surrender procedure. If you would like assistance on this, please let us know.

## Community trademarks including other goods in the class along with the class heading?

Additional goods and services in the class do not prevent you from filing an Article 28(8) Declaration, provided that the language used does not limit or disclaim the class heading.

## Community trademarks containing some but not all of the terms from a class heading

In that case, you cannot file an Article 28(8) Declaration for your Community trade mark. If you are concerned that your Community trade mark registration may not cover your goods and services of interest, please contact us for further advice.

## How to know if my Community trademark contains the entire of a Nice Classification class heading

Please contact us. We are happy to review any Community trademarks for which we are the OHIM representative without charge. If we are not the OHIM / EUIPO representative for your Community trade mark, we will be happy to review that trade mark for a nominal fee of 200 euros.

## Can my Article 28(8) Declaration or the amended registration be opposed by a third party?

No, but the Article 28(8) Declaration will be examined by OHIM for compliance with the requirements and the amended registration is still subject to proof of use requirements.

## Will there be a possibility of opposition or cancellation proceedings against the goods and services included in an Article 28(8) EUTMR Declaration?

The goods or services added by the Article 28(8) Declaration will not give you the right to prevent the use by third parties of those goods or services, provided that use commenced before the Article 28(8) Declaration and did not infringe your rights on the basis of the literal meaning of the goods and services contained in your registration at that time. Similarly, you cannot oppose an application for that trademark or seek invalidity of its registration on the basis of the goods included in the Declaration.

Further information on the Declaration under Article 28 may be found on the [Communication of the President of the Office](#).

## **No graphical representation requirement as of September 2017**

You will no longer have to file a graphical representation of the trademark. It will therefore be easier to file non-traditional trademarks such as sound marks and movement marks. It will still be necessary to properly indicate what is to be protected by the trademark and we will be happy to advise you on this respect. This change comes into effect on 24 September 2017 (21 months after the publication of the Regulation).

## **Change in proof of use period for oppositions**

Currently an opponent who owns a trademark registration which is over 5 years old can be required to file proof of use of that trade mark for the 5-year period ending on the publication date of the opposed trade mark. This period for which proof of use can be required will change to the 5-year period ending on the filing or priority date of the opposed trademark. If an opposition is filed before the changes come into effect on 23 March 2016, the old rules will continue to apply, however.

## **Shorter waiting time for International Registration opposition periods**

The start date of the opposition period for CTM designations of International Registrations will be reduced from six months to one month from the date of publication.

## **Certification trademarks can be filed as EUTMs from 2017**

A third category of trademark, certification trademarks, has been introduced, effective as of September 2017.

## Oppositions can be based on PDOs and PGIs

Protected designations of origin and protected geographical indications can be used as the basis for filing an opposition. They can also still be used in cancellation (invalidity) actions, as was the case up until now.

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## Contact us:

For any question you may have in connection with the amendments or their implementation, please do not hesitate to contact our team.



**Cristina Bercial-Chaumier**  
Alicante Office  
Partner  
Attorney at Law



**Karina Dimidjian-Lecomte**  
Paris Office  
Partner  
Attorney at Law



**Zheng Duan**  
Chinese Desk  
Legal Counsel

**PARIS OFFICE:** 5/7 & 8 avenue Percier, 75008 Paris, France

Tel: +33 (0)1 45 61 94 64 - Fax: +33 (0)1 45 63 94 21 - [E-Mail: paris@casalonga.com](mailto:paris@casalonga.com)

**ALICANTE OFFICE:** Avenida Maisonnave 41, 03003 Alicante, Spain

Tel: +34 96 513 17 95 - Fax: +34 96 513 16 89 - [E-Mail: alicante@casalonga.com](mailto:alicante@casalonga.com)