



New EU Trade Mark Regulation

BACKGROUND

The new EU Trade Mark Regulation No. 2015/2424 has now been passed by the European Parliament and the Council amending the original Community Trade Mark Regulation. The Amending Regulation will come into force on **23 March 2016**.

Most of the amendments will take effect immediately from that date, although some provisions will require secondary legislation within 21 months after the publication of the Amending Regulation.

There is also a corresponding Harmonization Directive No. 2015/2436 which further harmonizes national trade mark law in the individual EU member states.

KEY CHANGES

1. Name Change

The Community Trade Marks Office and Community Trade marks will be re-named 'The European Union Intellectual Property Office' and 'European Union Trade Marks'.

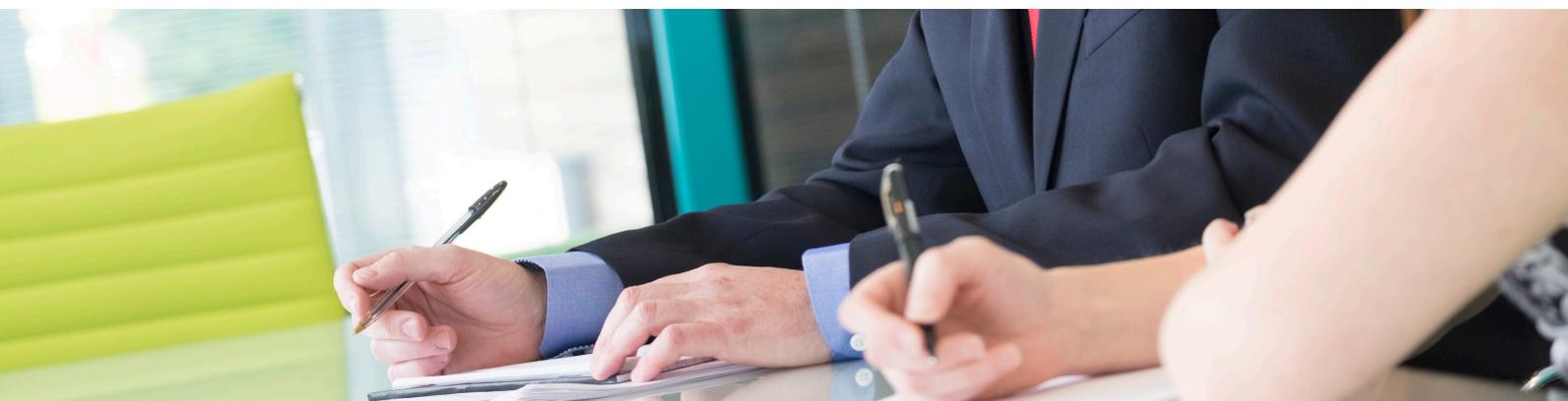
2. Official fees

There is a significant change to official filing fees to encourage the filing of CTMs in less than 3 classes: The proposed changes to official application and renewal fees are

Official fee	Current fee	New fee
Application fee	€900 (<i>three classes</i>)	€850 (one class)
Second class	–	€50
Third class	–	€150
Fourth and subsequent classes	€150	€150
Total Amount		
Application fee – One class	€900	€850
Application fee – Two classes	€900	€900
Application fee – Three classes	€900	€1,050
Renewal fees	€1,350 (<i>three classes</i>)	€850 (<i>one class</i>)
Second class	–	€50
Third class	–	€150
Fourth and subsequent classes	€400	€300
Total Amount		
Renewal fee – One class	€1,350	€850
Renewal fee – Two classes	€1,350	€900
Renewal fee – Three classes	€1,350	€1,050

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A number of other official fees will be reduced. The most significant include:

Activity	Current fee	New fee
Opposition	€350	€320
Cancellation	€700	€630
Appeal	€800	€720

3. Class Heading

There has been for some time uncertainty in the EU as to the effect of the use of a class heading under the Nice classification system in relation to an application. OHIM's original practice was that if an applicant filed a CTM application using a class heading, that application was deemed to cover all goods or services within that class. This will now change and any specification will be deemed to cover only those goods and services listed.

4. Existing CTM registrations with specifications covering the class heading – new deadline of 24 September 2016

In the case of EU Mark Registrations applied for before 22 June 2012, which have a specification covering a class heading in a particular class, the registered proprietor will be able to notify OHIM that it wishes to elect that the specification was intended to cover all goods and services within that class.

This Declaration must be filed no later than **24 September 2016**.

If so, the registered proprietor will need to "correct" its list of goods and services to include the full list of goods/services to be claimed.

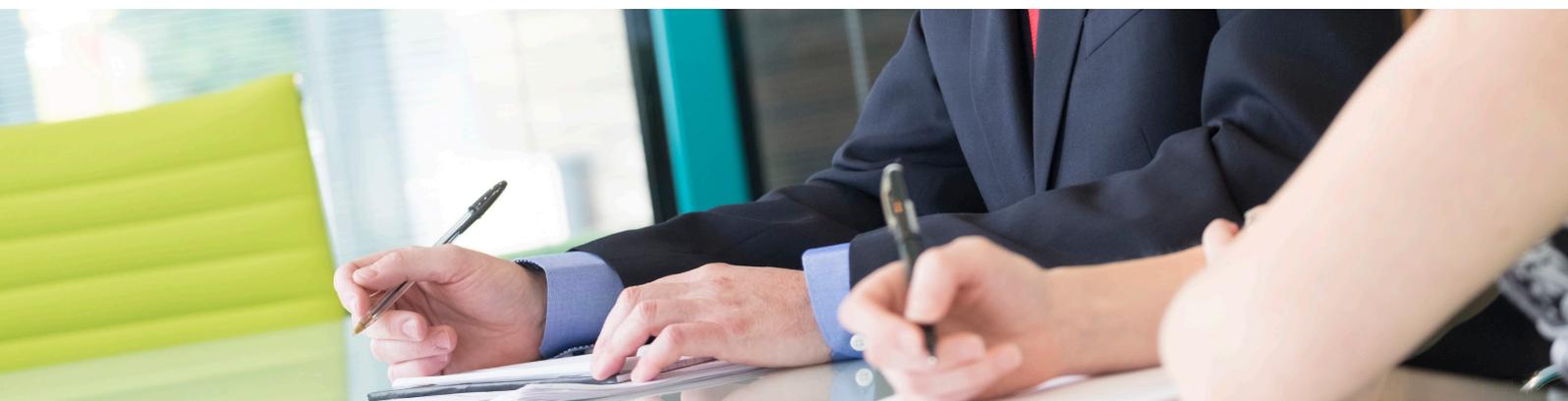
If no such Declaration is filed within this period, the CTM Registration shall be deemed to extend, as from the expiry of that period, to the goods and services covered by the literal meaning.

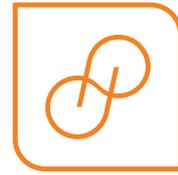
Note that if the registered proprietor does amend the specification, a defence to any infringement action brought based upon that EUTM Registration will be available to a third party who:

- i) commenced use before the register was amended; and provided that

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- ii) his use would not have infringed the proprietor's rights based on a literal interpretation of the goods and services covered by the original specification.

Again, the registered proprietor cannot oppose or invalidate a later filed trade mark where:

- i) the third party's mark was either in use or his application filed before the amendment application was filed and
- ii) use of the third party trade mark would not have infringed the registered proprietor's rights based upon a literal interpretation of the original specification for the earlier EUTM Registration.

We therefore recommend that EUTM proprietors review the specifications for their existing EUTM Registrations and, in the case of any registrations covering the class heading, consider, whether a Declaration should be filed before 24 September 2016.

5. Own Name Defence and the Infringement Proceeding

In the EU, there is a defence to an infringement action based upon the defendant's use of his/her own name. There was uncertainty previously as to whether this extended to use of a company name. The new amendment now makes it clear that the defence only applies to use of an individual's name.

6. Graphic Representation

The definition of what can constitute a trade mark for the purpose of the EUTM Regulation has been tidied up. The requirement that the mark be graphically represented has now been removed. This should make it easier to register more unusual types of trade mark such as moving images, smells, etc. However, it is still likely that any such 'sign' will be required to have acquired a distinctiveness to proceed to registration.

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