

Group Briefing

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The new European Trade Mark Regulation: what you need to know

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If you or your business owns Community trade marks then take note: on 23 March 2016 the new European Trade Mark Regulation will come into force. Given how valuable and important trade marks are to many businesses, now is the time to review your trade mark portfolio to assess whether the Regulation affects your trade marks.

We set out below some of the most important features of the Regulation, show you how you can potentially strengthen your trade mark rights and how filing a Community trade mark application now may save you money.

NEW TERMINOLOGY

First, trade mark owners should familiarise themselves with some new terminology: from 23 March on, Community trade marks (or “CTMs”) will be called European Union trade marks (or “EU trade marks” or “EUTMs”) and the Office for Harmonisation in the Internal Market (or “OHIM”) will be called the European Union Intellectual Property Office (or “EU IP Office” or “EUIPO”).

CLASS HEADINGS: WHY YOU SHOULD ACT NOW

All trade marks are registered in classes for specified goods and services (e.g. BMW is registered in Class 12 for “Vehicles and parts therefor...”

and DHL is registered in Class 39 for “Transportation by land, sea and air of documents and parcels...”). Formerly it was common practice to use broad class headings when applying to register trade marks, as some trade mark offices, including OHIM, took the view that by using a class heading, the applicant intended that all the goods and services included in that class were to be protected by the registration. Examples of broad class headings include “Clothing” (Class 25), “Telecommunications” (Class 38) and “Education” (Class 41).

In an important case decided in June 2012, the European Courts said that this “class headings covers all” approach was contrary to European law, as it did not allow the rights conferred by a registered trade mark to be specified with sufficient clarity and precision. So, from June 2012 on, trade mark applicants could no longer rely on imprecise class headings when applying to register trade marks. Instead, they have to clearly specify the goods and services in the particular class that they want to cover. This means, however, that the scope of protection afforded to trade marks registered in respect of classing headings before June 2012 is unclear.

The Regulation proposes a solution to this problem. If your CTM was applied for before 22 June 2012 and is registered in respect of an entire class heading, then the

Regulation gives you a six month period (i.e. until 24 September 2016) to file a declaration with the European Union Intellectual Property Office clarifying the scope of your registration. So, if your intention at the date of filing had been to obtain protection in respect of goods and services beyond those covered by the “literal meaning of the heading of that class”, then you have the chance to make your intention clear on the register.

Alternatively, you can avoid the inevitable rush to file these declarations and amend your registration now by using the partial surrender procedure which allows you to replace a class heading with clearly specified goods and services within that class. Either way, you should review your trade mark portfolio to make sure that the description of goods and services clearly and precisely describes all the products and services sold under the trade mark in question.

CHANGE IN FEES: FILE MULTIPLE CLASS APPLICATIONS BEFORE 23 MARCH

Under the Regulation, the official filing and renewal fees for EU trade marks are reduced, as are the fees associated with filing oppositions, cancellations and appeals. The biggest change is that the “three classes for the price of one” application fee has been scrapped to discourage applicants filing trade marks in three classes for the sake of it. From 23 March on, filing fees will be charged on a class by class basis, so filing in three classes after 23 March will be slightly more expensive than filing in three classes before that date.

WHAT YOU NEED TO DO NOW

- » Review your trade mark portfolio to assess whether the Regulation affects your marks.
- » Make sure that the description of goods and services for any Community trade marks clearly and precisely describes all the products and services sold under that mark. If it does not then prepare a declaration or avail of the partial surrender procedure.
- » If you are thinking about filing a multiple-class Community trade mark application then do so before 23 March 2016 to make a saving in filing fees.

OUR TEAM

This briefing is intended as a general overview and is not intended to constitute legal advice. If you require legal advice to fit your particular circumstances, please contact any member of our Technology & Innovation team:



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