

## What is the latest on EU trade mark reforms?

27/06/2017

**IP analysis: Guy Wilmot, partner at Russell-Cooke, reports on the impact of the changes introduced to the EU Trade Mark Regulation and outlines steps that practitioners should take to get ready for the next stage**

### What were the principal amendments to the EU Trade Mark Regulation which were introduced by Regulation (EU) 2015/2424 in March 2016?

The Regulation introduced into the EU trade mark system certain changes required by [Directive \(EU\) 2015/2436](#). The Directive aims to further harmonise trade mark law in Member States and also codified some Court of Justice case law and tidied up some other ambiguities. The Directive requires changes to be made to national trade mark law by most Member States.

In terms of the Regulation and the changes to the EU trade mark system, the most significant changes which came into effect in March 2016 were:

- the most noticeable change (the one noticeable to everyone working in the EU trade mark system) was the logical change in name from Community Trade Mark to European Union Trade Mark and changing the name of the office from OHIM to the EUIPO
- the fee structure was also changed—the new fee structure does not include three classes with the basic fee and instead additional fees are added for each additional class
- rules on classification were changed to require that goods and services were defined more narrowly and specifically
- a change to what is permitted as a trade mark—excluding signs which consist of characteristics which arise from the nature of the goods, or are necessary to obtain a technical result or give value to the goods. This is likely to make non-standard marks (smells, sounds etc) more difficult to obtain
- rules on invalidity have changed and it is now necessary for a party seeking to invalidate a mark to show that they had the necessary reputation or distinctive character on the filing date of the later mark (ie, a party cannot build up reputation after the filing date of an earlier mark and later on seek to invalidate that earlier mark)
- there has been some tightening of what constitutes infringement. Under the new rules use of a registered mark as a company name is expressly referred to as an infringing act, as is bringing infringing counterfeit goods into the EU, even if those goods are not to be sold in the EU
- preparatory acts prior to sale (eg, placing packaging on goods) may also now amount to infringement
- marks with reputation can now be used as a basis of opposition to later marks for similar goods or services (previously a reputation claim was essentially treated as a 'back-up' option for dissimilar goods or services)
- the use of the 'own name' defence—under which a trade mark cannot be used to prevent a party from using their name is limited to natural persons
- a similar registered mark can now be used to demonstrate that an earlier mark is in 'use' provided that the distinctive character of the earlier mark is not affected

### What impact have these amendments had on brand owners?

It is fair to say the changes have not been earth-shattering. There have been numerous changes, but none of them, on their own, significantly shift the emphasis of the trade mark rules.

The weight of these changes shifts the balance slightly in favour of larger brand owners who hold marks with reputation, but again not significantly.

There is further tightening of the definition of what constitutes a trade mark and these changes together with recent case law developments increase the difficulty of obtaining non-standard marks.

### What changes will come into force in October 2017 and what steps can IP lawyers take to ensure their clients are prepared for them?

Most of the changes coming into force in October 2017 clarify and codify some of the rules of procedure for proceedings (including opposition, invalidity and revocation proceedings). One of the more welcome changes is to make the use of electronic evidence and electronic communication more widespread in the EU trade mark system.

Guy Wilmot

Partner

+44 (0)20 8394 6531

[Guy.Wilmot@russell-cooke.co.uk](mailto:Guy.Wilmot@russell-cooke.co.uk)

[russell-cooke.co.uk](http://russell-cooke.co.uk)