

## The Reform of European Trade Mark Law was adopted!

On 16 December 2015, the reform of the trade mark law in the European Union was eventually adopted. The reform concerns both the Community trade mark system and the national trade mark systems (i.e. both the Regulation and the Harmonization Directive).

The new Regulation will enter into force progressively, as of 23rd March 2016. The national legislations will have to be adapted progressively to the new Directive as of the end of 2018.

The reform aims at modernizing the administration of trade marks, at incorporating 20 years of case law of the Court of Justice into substantive law, and to further approximate the laws and practices of the 28 member States.

The innovations are numerous, and are mostly technical. We draw your attention, in particular, to the following modifications:

- The initial OHIM is substituted by **EUIPO**, which stands for **European Union Intellectual Property Office**. This opens the path to wider competencies for this agency, including for example a future mediation centre. The Community trade mark will be renamed **European union trade mark (EUTM)**;
- The official fees relating to European union trade marks are modified: **each class designated will be subject to a specific fee** (this is the end of the system of « three classes for the price of one »), in order to discourage applicants from seeking too broad specifications. Besides, **the renewal fee will be substantially lowered**;
- The requirement of « **graphic representation** » is removed;
- A system of **European union certification trade mark** will be introduced, as of 2017;
- The protection of **Geographical Indications** is reinforced;
- **The deadline to oppose international trade marks designating the European union is shortened**: oppositions will be lodged between the 2<sup>nd</sup> and 4<sup>th</sup> month following the publication by the EUIPO (previously between the 6<sup>th</sup> and the 9<sup>th</sup> month);
- In opposition proceedings, **the date of reference for the calculation of the obligation of use of the earlier trade marks will be the date of application of the contested EUTM** (previously, the publication date);
- The owners of EUTMs will be allowed to claim the **acquisition of a distinctive character through use** until the date of introduction of a cancellation action by a third party, and not simply at the application date. In other words, the acquisition of a distinctive character through use, after the registration of a trade mark, will be taken into account;
- **The Trade mark offices of the member States of the European union will be competent for actions of invalidity and revocation of trade marks**. It will no longer be necessary to seize a court of law for these proceedings. This will lead presumably to cheaper and quicker invalidity and revocation proceedings;
- The owner of a European union trade mark will not be subject to counterfeiting actions for the use of the sign subject to the registration. **The existence of a registration will therefore provide immunity to the owner for the use of the sign as registered**. Therefore, it will be necessary to obtain the cancellation of the EUTM in parallel, or in advance, of a counterfeiting action;

- The case law of the Court of Justice on **families of trade marks** is incorporated in the law: the owner of a EUTM can therefore prove its use in an altered form, even if said form is also registered as a trade mark;

- **The practice regarding classification of goods and services is clarified**, and even corrected. We will get back to you on this issue in a specific notice.

**Our firm remains at your full disposal for additional information concerning this reform and its legal and practical impacts.**

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