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Legal Bulletin



Intellectual Property

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1. Amendments brought by Regulation No. 2015/2424 on community trade marks

EU Novelties Regarding Community Trade Marks

Regulation No. 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) (“Regulation 2015/2424”) was published in the Official Journal of the European Union L341/94 and came into force as of 23 March 2016. Certain amendments will become effective as of 1 October 2017, as provided herein below.

The main amendments/supplementations brought by Regulation No. 2015/2424 are the following:

1. General matters

As regards the terminology, Regulation No. 2015/2424 replaces the name of “community trade mark” with the name “European Union trade mark” - abbreviated “EU trade mark”. Also, the name of the European office, i.e. the “Office for Harmonization in the Internal Market”, shall be replaced by the “European Union Intellectual Property Office” (hereinafter referred to as the “EUIPO”).

The Regulation expands the scope of the elements that may be registered as EU trade mark, by including colours and sounds¹; these may be registered as EU trade mark provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings. Also, texts are inserted to synchronize the EU trade mark legislation with the European legislation for the protection of designations of origin, geographical indications, traditional specialities guaranteed, traditional terms for wines and plant varieties; therefore,

¹ Such expansion shall apply as of 1 October 2017.

the registration of the EU trade marks which conflict with the rights over such protected elements is refused.

Regulation 2015/2424 regulates the conflict between the EU trade mark and the trade names. The proprietor of an EU trade mark can prohibit the use of a trade name insofar as the same is used to distinguish goods or services.

An important amendment is brought by insertion of Article 13a, providing that in infringement proceedings, the proprietor of an earlier EU trade mark shall not be entitled to obtain a judgment prohibiting the use of a later registered EU trade mark, which is in conflict with its earlier trade mark, until that later trade mark is declared invalid.

2. Classification of goods and services

Regulation 2015/2424 brings several distinctions as regards the classification of goods and services in respect of which the trade mark registration is applied for.

Thus, in describing the classes of goods and services, applicants may also include general terms (including the general terms provided by Nice Classification). Nevertheless, the use of such terms shall be interpreted as including all the goods or services clearly covered by the literal meaning of the respective indication or term (the goods or services which cannot be so understood shall not be taken into account).

Also, proprietors of EU trade marks applied for before 12 June 2012 which are registered in respect of the entire heading of a Nice class may declare by 24 September 2016 that their intention had been to also apply for registration in respect of other goods beyond those covered by the literal meaning of the heading of that class. In such a case however, the goods / services so designated must be included in the (detailed) alphabetical list for that class in the Nice Classification.

3. Observations by third parties in the EU trade mark registration procedure

An element of novelty brought by Regulation 2015/2424 concerns the purpose of the observations submitted by third parties in the EU trade mark registration procedure. So far, any third party could, without becoming a party in the procedure, submit observations in support of the ungrounded nature of the EU trade mark registration by reference to the absolute grounds for refusal. From the perspective of the new regulation, the interested parties no longer submit observations in support of the rejection of the trade mark registration, but in support of the grounds for which the trade mark should not be rejected for registration *ex officio* by EUIPO.

4. Certification marks²

Regulation 2015/2424 regulates the concept of “EU certification mark” defined as an EU trade mark which is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services,

² The new provisions on certification marks shall apply as of 1 October 2017.

quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.

The EU certification marks have several distinct features, including *inter alia* the following:

- The proprietor of such mark may be any natural or legal person, provided that such person does not carry on a business involving the supply of goods or services of the kind certified, therefore it may be transferred only to a person satisfying these requirements;
- The EU certification mark registration is conditioned by the submission of regulations governing the use of the certification mark, specifying, *inter alia*, the persons authorised to use the certification mark, the characteristics to be certified by the mark, etc.;
- In addition to the standard grounds, the regulation also provides several specific reasons for refusal of a registration, such as: (i) failure to meet the criteria indicated in the definition of an EU certification mark, (ii) the applicant for registration carries on a business involving the supply of goods or services of the kind certified, (iii) failure to meet the conditions regarding the regulations governing the use of the EU certification mark, (iv) if the public is liable to be misled as regards the character or the significance of the EU certification mark;
- Also, the regulation provides for several specific grounds for revocation, such as: (i) the proprietor of an EU certification mark starts carrying on business involving the provision of goods or services of the kind certified, (ii) the proprietor does not take reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in the regulations governing the use, (iii) the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public as regards its character or significance.

5. Mediation services offered by EUIPO

Regulation 2015/2424 introduces a new task of EUIPO, respectively the possibility to ensure mediation services for the parties in conflict regarding an EU trade mark.

Thus, according to Regulation 2015/2424, EUIPO may establish a mediation centre. The interested parties may have recourse to mediation before the Mediation Centre by means of a joint request, subject to payment of the corresponding charges.

Among the procedural issues, we mention the following:

- In case of disputes subject to the proceedings pending before EUIPO, a request for mediation may be presented at any time and shall result in suspension of proceedings;

- EUIPO shall establish a list of persons who possess relevant skills and experience and may be designated as mediators;
- The parties shall agree together with the mediator on the detailed arrangements for the mediation in a mediation agreement;
- The discussions and negotiations conducted within the framework of mediation shall be confidential for all persons involved;
- The mediation proceedings is concluded as soon as the parties reach a settlement agreement, or one of the parties declares that it wishes to end the mediation or the mediator establishes that the parties have failed to reach such an agreement.

6. Amendments to the fees to be charged by EUIPO

Regulation 2015/2424 brings a series of amendments to the amount of the fees for the services provided by EUIPO. The effect of the new provisions is, in general, the decrease of the applied fees. For instance, the fee for the registration of an individual EU trade mark is decreased from EUR 1,050 to EUR 1,000 (in standard form) and from EUR 900 to EUR 850 (for applications submitted by electronic means), and the fee for the registration of a collective mark is decreased from EUR 1,800 to EUR 1,500.

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The **Intellectual Property** practice group at Țuca Zbârcea & Asociații consists of dedicated lawyers and certified intellectual property counsellors with a significant experience in advising leading national and multinational companies on the protection of their IP portfolios. An important part of our work in this area relates to complex anti-counterfeiting issues, including product contraband and illegal use of trademarks, especially in the mass market products industries such as cigarettes, beverages, food and clothing. In addition, our team has accrued extensive expertise in advising on franchising, as well as trademark and patent court protection in pharma and software industries. Our intellectual property experts are constantly providing support to high-profile privatisations and private equity deals, as well as complex business takeovers within insolvency procedures. The firm is an active member of INTA, WTO and ECTA organisations.



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