

## More Changes to the EU Trade Mark Regime



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Back on 23 March 2016, the first round of reforms to the Community Trade Mark regime was implemented. Amongst other changes, the Office for Harmonization in the Internal Market (OHIM) became the 'European Union Intellectual Property Office' (EUIPO) and the Community Trade Mark (CTM) was renamed the 'European Union Trade Mark' (EUTM). These changes were introduced by the "[Amending Regulation](#)" which amended the [Community Trade Mark Regulation](#) (now known as the European Union Trade Mark Regulation or 'EUTMR'). For more information on these changes, please see our blog post [here](#).

Not all the provisions of the Amending Regulation came into force last year. The remaining provisions came into force on 1 October 2017, together with the "[Implementing Regulation](#)" and the "[Delegated Regulation](#)". Collectively, these Regulations introduce a second round of reforms to the EU trade mark regime. Some of the key reforms are described below.

### Graphical Representation Requirement

Previously, trade marks had to be capable of graphical representation, whether as plain word marks, images of logos or colour marks. This requirement has now been removed, allowing the possibility for applicants to more readily seek to register non-conventional trade marks, such as multimedia or sound marks, provided that the mark can be represented in any appropriate form using generally available

technology. Applicants may file the former as MP4 files and the latter as MP3s. It should be borne in mind, however, that the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Note, also, that where filed, an accompanying description will not extend the scope of the mark, which is determined entirely by the representation of the mark.

Whether this change will result in applicants filing an array of non-conventional marks remains to be seen, but the change is likely to have implications for clearance searches, with practitioners potentially needing to consider a broader range of earlier marks which may pose a risk.

## **EU Certification Mark**

Applicants may now file EU certification marks, which are defined as marks which are “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, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.” This will allow applicants to register marks which guarantee specific characteristics of certain goods and services, such as the content of food products. It has previously been possible to register such marks in various EU member states, including the UK, with trade associations, government departments and technical institutes often seeking protection.

Applicants must file, within two months of the application, details of the characteristics of the goods or services to be certified, the conditions governing the use of the certification mark and the testing and supervisory measures applied by the applicant. Note that owners of businesses involved in the supply of the goods or services to be certified cannot themselves own an EU certification mark, nor can applicants apply for a certification mark which would be used to distinguish goods or services in respect of a certain geographical origin.

Typically, certification marks are relatively rare in comparison to ‘standard’ trade marks, however, the fact that protection afforded by the EU certification mark will extend to all EU member states may encourage potential applicants to seek protection.

## **Procedural Changes**

As well as the changes above, a number of procedural changes were implemented on 1 October. These include the requirement to make priority claims at the same time as filing a trade mark application, the ability for applicants to claim acquired distinctiveness as a subsidiary claim (and substantiate the claim only once a claim of inherent distinctiveness has been exhausted, thus allowing for potentially significant cost-saving) and the ability for invalidity applicants to have a trade mark registration assigned to them when it has been registered by an unauthorised agent or representative (previously the only remedy was to invalidate the registration).

In summary, whilst the removal of the graphical representation requirement and availability of an EU certification mark are likely to open the door to new applicants,

the procedural changes implemented should lead to a more streamlined process before the EUIPO.

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