

European Trademark Reform

On 23 March 2016, Regulation (EU) No 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trademark (“Regulation”) entered into force¹. The Regulation governs the rules applicable to the formerly known as Community Trademark and the Office for Harmonization in the Internal Market (“OHIM”) itself. The most substantial changes introduced by the Regulation are as follows²:

Name change

On 23 March 2016 OHIM changed its name to the European Union Intellectual Property Office (“**EUIPO**”), while the Community trademark (“CTM”) is now called the European Union trademark (“**EUTM**”).

Filing and Fees

The filing of EUTMs at national offices is abolished: As from 23 March 2016, EUTMs may only be filed at the EUIPO (electronically or in paper).

In addition, the scheme formerly known as “three classes for the price of one” is now replaced by payment of application fees per each class of goods and/or services.

More precisely, as from 23 March 2016, the fee for registration in one class is Euro 850, Euro 50 for a second class and Euro 150 for the third and all subsequent classes.

A new fee regime also applies to renewals. Under the new system, renewal fees became equal to application fees, as described above. An overview table showing application / renewal fees under the old and new system can be found [here](#).

Class headings – Specification of goods and services

As per the practice followed by OHIM until June 2012, if the specification of goods or services on a CTM application included a class heading, then the CTM registration would cover all goods or services falling into that class.

¹ With few exceptions that will take effect on 1 October 2017.

² For detailed information on changes effected by the Regulation please refer to the dedicated [website](#) created by OHIM.

For example, a trademark application in class 25, using only the heading of said class, “*clothing, footwear and headgear*”, was considered to cover all of the goods in the alphabetical list of Nice Classification relevant to class 25.

Following CJEU judgment issued on 19 June 2012 (*IP translator*, Case-307/10), applicants were required to specify precisely the goods /services they sought protection for, otherwise protection would be limited to products / services corresponding to the literal meaning of the words in the class heading.

The Regulation not only formalises this practice but also extends it to all applications filed prior to its implementation. Accordingly, under Article 28(8) of the Regulation, owners of EU trademarks applied for before **22 June 2012**, registered in respect of the entire heading of a Nice class, may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class in the edition of the Nice Classification in force at the date of filing. Such declaration must be filed at the EUIPO **by 24 September 2016**.

Failure to do so automatically limits the registration to the literal meaning of the words in the class heading and thus makes it difficult to prevent competitors from providing other goods included in the alphabetical list of Nice Classification in the same class under the same or a similar mark³.

Goods in transit

Addressing a long standing request of stakeholders, the Regulation entitles the owner of a EUTM to prevent the entry of infringing goods and their placement in any customs situation (including transit, transshipment, warehousing, free zones, temporary storage, inward processing or temporary admission), also when such goods are not intended to be placed on the market of the European Union. However, the above right is subject to the submission of proof by the declarant or the holder of the goods in transit that the EUTM owner is not entitled to prohibit placement of the goods on the market in the country of final destination.

Taking into account that Greece has been traditionally a transit country for counterfeit goods on the way from China and Turkey to third countries, the new rules are expected to be of importance for the enforcement of EUTM rights in relation with infringing products placed in transit through Greek customs.

To be noted that owners of Greek national trademarks were already entitled to prohibit counterfeit products in transit through Greece with destination any third country, by virtue of Article 125(4) of Law 4072/2012.

³ A [Communication](#) and a [FAQs](#) were published by EUIPO to assist EUTM owners who consider amending the specification of goods/services covered by their marks.

Use of EUTM in comparative advertising

The Regulation expressly provides that the owner of a EUTM may prohibit third parties from using a sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC of the European Parliament and of the Council concerning misleading and comparative advertising.

Changes that will enter into force from 1 October 2017

(a) Non-traditional Trademarks

The requirement of graphical representation of a EUTM application will be eliminated. Instead, it will be permitted for a sign to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. This change might prove helpful to those seeking to register non-traditional trademarks, such as olfactory trademarks.

(b) Introduction of certification marks

EU certification shall allow enterprises adhering to an institution or organisation's certification system to use the mark as a sign for goods or services complying with the certification requirements. The registration cost for an EU certification mark will be the same as for an EU collective mark.

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