

## ALERTS

### Intellectual Property Law Alert - EU Updates The Community Trade Mark System, Warns Of Potential Imposters

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Change isn't always easy, but the EU is giving it a go. The European Community's trademark office, known as the Office for Harmonization in the Internal Market (OHIM), changed its name on March 23, along with many other aspects of the European trademark registration system, known as the Community Trade Mark (CTM). Below are the highlights from the Amending Regulations:

1. Name change. OHIM has been renamed as the European Union Intellectual Property Office (EUIPO) and the Community Trade Mark has become the European Union Trade Mark (EUTM). The website address for EUIPO is <euipo.europa.eu>.

**Be on guard:** EUIPO says it expects rogue organizations to seek bogus official fees from trademark owners by posing as a European trademark "office."

2. Expanding list of goods for some pre-2012 registrations. Many CTM registrants sought to cover all the goods or services in an International Class by listing the class heading. Class headings summarize the goods or services contained in a Class, but are not a complete listing.

As you may know, OHIM previously considered a CTM listing a class heading to cover all the goods in that Class. However, a 2012 decision of the Court of Justice of the European Union (CJEU) known as IP Translator ended the practice. The CJEU held that class headings cover only those goods or services that are "identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark."

As a result, CTMs (now EUTMs) issued after June 19, 2012 – the date of the IP Translator decision – are limited to the list of goods in the registration, and any goods clearly identified within that list. But for CTMs/EUTMs issued before that date, or applications still pending on that date, the EUIPO will allow their owners to file a Declaration listing the specific goods or services they intended to cover under the class heading. The Declaration must be filed by Sept. 23, 2016. There are a number of conditions, most important that the registration or application must list the entire class heading.

CTM/EUTM owners may want to consider reviewing their registrations

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promptly to determine whether *IP Translator* limited their coverage, and if so, whether they are eligible for an expansion Declaration.

3. Broader rights. In three respects, rights in EUTMs have been expanded:

- Seizing goods in transit. EUTM owners can prevent goods in transit from traversing the EU, unless it can be shown that the EUTM owner could not prevent use of the mark in the country of final destination.
- Broader protection for marks with a reputation. Marks that have a reputation in the EU (known as “famous marks” in the U.S.) are now protected against use or registration of an identical mark no matter what goods or services that mark identifies, if it takes unfair advantage of or is detrimental to the registered mark’s reputation.
- Protection beyond an infringing mark’s goods or services. An EUTM owner can prohibit use of confusingly similar marks not only on similar goods or services, but also in trade names, company names, business papers, advertising, and comparative advertising, or offering, stocking, marketing, importing, or exporting infringing goods.

4. Official fees. Trademark filing fees will change from a flat fee for three International Classes to coverage by the class. Where a CTM cost €900 to file in three International Classes, an EUTM costs €850 for one international class and €1000 for three International Classes.

Renewing a CTM previously cost €1350 for three classes, but an EU trademark owner can renew in single classes, with charges of €850 for a single class and €1050 for three classes.

Expanding what qualifies as a trademark. On Oct. 1, 2017, EUIPO will commence registering certification marks. Further, EUTM applications will no longer need a graphic representation of a trademark. Instead, a mark can be “represented ... in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor”. This change will allow the EUIPO to register marks without a graphical component, such as color, sound, scent, or animated marks.

For more information, contact the Barnes & Thornburg attorney with whom you work or a member of the firm’s Intellectual Property Law Department in the following offices: Atlanta (404-846-1693), Chicago (312-357-1313), Columbus (614-628-0096), Dallas (214-258-4200), Delaware (302-300-3434), Elkhart (574-293-0681), Fort Wayne (260-423-9440), Grand Rapids (616-742-3930), Indianapolis (317-236-1313), Los Angeles (310-284-3880), Minneapolis (612-333-2111), South Bend (574-233-1171), Washington, D.C. (202-289-1313).

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