

## EXPERT ANALYSIS

### Upcoming Changes to Trademark Prosecution In the European Union

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When seeking international protection for one's trademarks, it can come as welcome news that one can file *one* trademark application to cover all countries in the European Union. Such trademark applications and registrations are governed by the Office of Harmonization in the Internal Market and are referred to as "community trademarks."

As one can imagine, the foregoing names are not intuitive and can cause confusion for those not familiar with the trademark process. Beginning on March 23, 2016, OHIM will be re-named as the European Union Intellectual Property Office and Community trademarks will be referred to as European Union trade marks. This kicks off a series of changes as part of the European Union trademark reform legislative package proposed by the European Parliament and the Council of the European Union.

In addition to the updated terminology mentioned above, which is the most outward change and will better reflect the work carried out by OHIM, there are a number of other changes that will substantially impact the trademark process in the European Union and of which trademark owners and those intending to register their marks in Europe should be aware. Some of these changes are highlighted below.

- Expansion of trademark protection: In order to allow for more flexible trademark protection, the "graphic" requirement is being deleted from the definition of a European Union trade mark. In other words, the European Trademark Office will now consider applications to cover sounds, colors, and holographic marks.
- Certification Marks: The European Union trademark system will now also include provisions for the protection of certification marks, which allow a certifying institution to permit certain members to use the mark as a sign for goods or services that comply with certification requirements.
- Filing/Class Fees: Currently, the filing fee for one community trade mark application is 900 euros for up to three classes of goods or services. The application fee will now cover only one class of goods or services, with additional classes subject to additional fees. The new fees will be 850 euros for the first class, 900 euros for two classes, and an extra 150 euros for each additional class beyond three. The new fee structure endeavors to discourage applicants from needlessly filing marks in 3 classes.
- Renewal Fees: Renewal fees will be reduced significantly. While e-renewals currently cost 1350 euros for registrations consisting of up to three classes, and an additional 400 euros per each additional class, the new fee schedule includes the same fee structure as initial application



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filings, namely, 850 euros for renewals for one class, 900 euros for 2 classes, and an added 150 euros per additional class.

- Identification of Goods/Services: OHIM previously allowed applicants to file applications to cover entire class headings. This will no longer be acceptable. For applications filed before June 22, 2012 and registered before March 23, 2016 which include entire class headings, a declaration must be filed by September 24, 2016 to specify the exact goods and services to be covered by such application or registration. If no declaration is filed, protection of the application or registration will be limited only to the exact goods included in the class heading, and will not be extended to any and all goods or services within that classification. For example, a trademark originally filed with the Class 36 heading of "Insurance; Financial affairs; Monetary affairs; Real estate affairs" will not cover "charitable fundraising" unless expressly specified in a declaration.
- Preliminary Searches: OHIM currently conducts a search for every new application which is filed and provides the applicant with such report, identifying earlier EU marks that could potentially be considered similar to the applied-for mark. These search reports will now only be provided to the Applicant upon request and upon payment of a search fee. However, the EUIPO will continue to notify the owners of the marks in the search reports upon publication of the applied-mark to allow them an opportunity to oppose the marks if necessary.
- Mediation Center: The EUIPO will establish a mediation center for persons aiming to achieve a friendly settlement of disputes relating to EU trademarks by mutual agreement.

The proposed changes have been published in full in the *Official Journal of the European Union*.

In light of the foregoing, entities or persons with Community trade mark registrations should revisit their trademark portfolios to determine whether a Declaration to specify the goods and services should be filed before the September 24, 2016 deadline. In addition, parties considering filing new applications in the European Union with three or more classes of goods or services may wish to take advantage of the lower filing fee before the increase goes into effect. Consulting with an experienced trademark attorney may provide additional insight and protection in forming a trademark strategy.



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