



What Canadian Companies Need to Know about Upcoming Changes to The European Trademark System

Mar 11, 2016

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On March 23, 2016, a new European Trademark Regulation will come into force. Along with a change of name of the Office for Harmonisation in the Internal Market (OHIM) to European Union Intellectual Property Office (EUIPO), Community trademarks (CTM) will become European Union trademarks (EUTM). There are also some substantive changes which are discussed below.

This is a chance for Canadians to review their European rights and to identify whether they should be seeking protection for additional marks, further specify goods/services or add new classes for existing marks.

Specification of Goods and Services

Specification of goods and services must be identified with “sufficient clarity and precision” such that it is possible to determine the scope of the goods/services granted by the registration. Applications filed before June 2, 2012 which include an entire class heading, as opposed to specific goods and services will have a six month transitional period, expiring September 24, 2016, to file a declaration stating the specific goods and services intended to be covered by the registration. Most goods/services will fall within the literal meanings of the class headings. For example, where a registration covers the class heading description for class 25, namely “clothing, footwear and headgear”, and the mark is used in association with various items of clothing, this would fall within the literal meaning of the class heading. Where this may be an issue is where the class heading is very broad, for example, class 9. Most Canadian companies have not used class headings in their EUTM applications, since the applications have generally followed Canadian goods/services descriptions, with detailed lists of goods/services. If you would like us to review your specific registrations, please let us know and we would be happy to do so.

Application Fees and Renewal

The current “three classes for the price of one” is replaced by a “one class per fee” system. The current rate of €900 for up to three classes, will change to €850 for one class, €900 for two classes, and €1050 for three classes. There is an additional fee of €150 for each class after that. Accordingly, for applicants interested in filing applications for marks of up to 3 classes, there is a cost advantage in doing so prior to March 23, 2016. For applicants interested in filing an application for one class only, there is a cost advantage in waiting until after March 23 to apply.

Renewal fees have dropped more significantly. The current renewal fee of €1350 for up to three classes, will change to € 850 for one class, € 900 for two classes and €1050 for three classes. For registrations covering four or more classes, the fee will be €1200 plus €150 for each additional class.

Other Key Changes

- designations of origin and geographic indications will not be registrable
- registration of scent, sound, taste and colour marks, and potentially hologram and motion marks, will be permitted
- certification marks will be registrable
- owners of EUTMs will have the ability to obtain seizure of counterfeit goods being transported through Europe, even if the goods are ultimately intended for shipment outside the EU
- non-use revocation proceedings will be able to be brought before national IP offices
- using a mark as a whole, or part of, a company name is now specifically cited as an act that may infringe an EUTM
- the introduction of a new defense to permit alleged infringers to defend against any claim of infringing use that predates an amendment to add further specification to the goods/services, if the original goods/services description did not clearly cover the allegedly infringing use

With respect to the March 23, 2016 implementation date, the most important issues for Canadian companies to identify is (1) whether a review of current EUTM registration is required for any registrations that may identify the goods/services using class heading descriptions and (2) whether applications for any multi-class marks should be filed prior to March 23, 2016.

If you have any questions, please contact any member of Bereskin & Parr's [Trademarks Practice Group](#) or send an email to communications@bereskinparr.com.