



TM Directive (EU) 2015/2436 - Cornerstones and transposition -

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**ECTA Workshop
Larnaca, 6 December 2018**



Overview

- A. Adoption of TM reform
- B. Cornerstones of the Directive
- C. Transposition by Member States
- D. Takeaway



A. Adoption of TM reform

- COM package proposals presented on 27/03/2013.
- Reform package approved by the EP on 15/12/2015.
- Directive (EU) 2015/2436 (repealing Directive 2008/95/EC with effect from 15/01/2019) entered into force on 12/01/2016.
- Amendment of EUTMR (EC) 207/2009 by Reg. 2015/2424 led to codification as EUTMR (EU) 2017/1001, applicable since 1/10/2017 together with new secondary legislation (Implementing Reg. 2018/626 & Delegated Reg. 2018/625).



B. Cornerstones of the Directive (I)

- **Modernized TM definition** through removal of graphic representability requirement (Art 3)
 - Signs to be representable on register in manner enabling to determine clear & precise subject matter of protection.
 - Need for all TM types to comply with C-273/00 *Sieckmann* criteria (recital 13!) to fulfil objectives of registration system.
 - Parallel Art 4 EUTMR implemented by Art 3 IR 2018/626.
 - Common Communication on representation of new TM types.



B. Cornerstones of the Directive (II)

- **Common rules on designation & classification** of g/s (Art 39)
 - Codification of C-307/10 *IP Translator* principles.
 - “Means what it says approach”: mere inclusion of g/s clearly covered by literal meaning of class heading/general term.
 - No harmonization for the past (no article similar to Art 33(8) EUTMR); C-501/15 *Cactus* clarifying that requisite standards & principles established in *IP Translator* did not apply to TMs registered before that latter judgement.



B. Cornerstones of the Directive (III)

- **New right to prevent goods being placed in a customs situation (transit, trans-shipment, warehousing, free zones etc.) when not intended for EU market (Art 10(4))**
 - Sole condition: goods to bear without authorization TM which is (essentially) identical to TM registered in a MS.
 - Peremptory defence available but only before competent judicial authority: entitlement shall lapse if declarant/holder of goods can prove that TM owner cannot prohibit their placing on the market in the country of final destination.
 - COM notice on IPR customs enforcement (2016/C 244/03).



B. Cornerstones of the Directive (IV)

- **Office-based opposition procedure** (Art 43)
 - Offices allowed to keep ex-officio examination of RG in Art 5.
 - Obligation to make available before offices for filing oppositions based on grounds in Art 5 (i.e. no AG!).
 - Minimum harmonization of legal standing (para 2).
- **Mandatory non-use defence** for that procedure (Art 44)
 - Now five-year period preceding filing/priority date of later TM which is relevant (para 1).



B. Cornerstones of the Directive (V)

- **Office-based revocation/invalidity procedure** (Art 45)
 - Grounds: Art 19 & 20 (rev.), Art 4 & 5(1)-(3)(min. invalidity).
 - Para 4: Minimum harmonization of legal standing.
- **(Double) Non-use defence** (Art 46): need to prove use
 - during 5-year period preceding date of application for declaration of invalidity, and (where applicable)
 - during 5-year period preceding filing/priority date of later TM.



C. Transposition by Member States

- Directive to be transposed into national law **by 14 January 2019** (exception: Art 45 on cancellation by 14/01/2023 only).
- **Date of entry into force only relevant** for meeting deadline.
- **Current state of play** of transposition in the Member States.
- **Infringement procedures** to be launched 'by default' in the event of failing to communicate transposition measures!



D. Takeaway

- Directive 2015/2436 is an **important step in modernising and further harmonizing** Member States' TM laws.
- Its success will obviously depend on a **timely and accurate transposition.**
- Member States are encouraged to **use all the means at their disposal to ensure its full implementation by 14 January 2019** and avoid infringement proceedings being launched.



**Thank you very much for
your attention!**

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