



EU Trade Mark Reform: Update on the final stages

**Tomás Lorenzo Eichenberg
Intellectual Property Unit
European Commission, DG GROWTH**

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I. Context: Complex reform nearing completion





II. New secondary legislation

1. Draft Commission Implementing Regulation

- Scope: specifying details to be contained in EUTM applications/ other requests (e.g. transfer, alteration, surrender, conversion).
- Initial draft IR sent to MS on 13/09/16 for consideration;
- 3 meetings of Committee on IRs on 27/09, 4/11 & 12/12/16;
- Draft IR available at the BRP from 4/10/16 to 1/11/16, valuable feedback received from 7 user organisations, incl. ECTA;
- Constructive talks allowed to get to stable text already at last Committee meeting, incl. new Art 3 (representation of EUTM).



- Main element of draft Implementing Regulation: new requirements for the representation of the EUTM (Art 3)
 - Ensuring proper balance between legal certainty and flexibility;
 - Codification of the Sieckmann criteria as overarching principle applying to all types of trade marks (para 1 and 4);
 - Representation decisive for defining subject matter (para 2);
 - Specific rules for word, figurative, shape, position, pattern, colour, sound, motion, multimedia and hologram marks (para 3);
 - Shape/sound/motion/hologram marks: still choice between electronic *or* traditional means of representation.



2. Draft Commission Delegated Regulation

- Scope: specifying details of certain EUIPO procedures (e.g. opposition, cancellation and appeal) and of BoA organisation.
- Initial draft DR sent to MS on 10/10/2016 for consideration;
- 2 meetings of TM Expert Sub-group on 18/10 and 29/11/2016;
- Draft DR available at the BRP from 10/10/2016 to 7/11/2016, valuable feedback received from 9 associations, incl. ECTA;
- Constructive discussions allowed to get to a stabilised text already at the last Expert Group meeting.



- Main elements of draft Delegated Regulation:
 - More consistency by **aligned rules** on revocation/invalidity & opposition;
 - Less red tape by allowing **substantiation** of earlier rights through reference to online sources recognised by the Office (Art. 7(3));
 - Framework rules on Office discretion regarding **belated evidence** (opposition, Art. 8(5)/10(7); cancellation, Art. 19);
 - Simplified **translation requirements** (Art 7(4), Art 10(6), Art 13(1), with cross-ref. to Art 24 IR – transl. only if Office so requires = rules for PoU);
 - Streamlined rules on presenting **written evidence** (Art. 55, evidence may be discarded if not possible to link it to specific ground/argument);
 - Consolidated **rules on appeal procedures**, incl. cross appeals;
 - Comprehensive **rules on BoA organisation and functions of its organs**.



3) Next steps

- One more half-day meeting in each of the two expert bodies scheduled for 10 March to consider remaining points (i.e. recitals, provisions on temporal application and last changes).
- Draft IR/DR still in need of being aligned with codified text of EUTMR (for pending parallel procedure see next slide);
- Required formal vote on draft IR to take place end of March;
- Formal adoption of both draft Regulations by COM in written procedure planned for end of April.



III. Codification of EUTMR

- Proposal COM(2016) 702 – 2016/0345 (COD) of 31/10/16;
- Combining original act & amendments without any further substantive changes; codified EUTMR consisting of 212 articles;
- Full co-legislative process under accelerated procedure;
- JURI/8/08341 Draft Report unanimously adopted on 28/02/16;
- Foreseen final adoption by mid March EP Plenary;
- Codified EUTMR applicable as from 1 October 2016 together with new secondary legislation.



Thank you for your attention!

Tomas.Eichenberg@ec.europa.eu