



Zeus has thrown his lightning bolt

1st Session: Status of implementation of the Trade Mark Directive (EU) No. 2015/2436 - The most significant changes in national laws

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Abstract

Given the ongoing nature of the transposition process, as well as the different levels of progress made by the Member States in drafting national legislation, a comprehensive overview of the most significant changes is, at present, impracticable. A selection of topics is therefore necessary both as far as the subject matter covered by the Directive is concerned and the jurisdictions where implementation is taking place. The limited information does not however prevent a reflection on the implementation process as a whole, nor a discussion on various approaches adopted by the Member States in shaping the national provisions, which is the goal of this presentation.

Status of implementation

I intend to begin by an overview of advancement in the implementation process across the EU by pointing out in which Member States proposed amendments are already available ahead of the transposition deadline. I will also briefly discuss a positive example of public consultation procedure on the proposed amendments, which has been run by the UK Intellectual Property Office.

The most significant changes

As opposed to the new EU trademark regulation identifying the most significant changes at the national level is a less straightforward task: a key change in one Member State, such as administrative procedures for revocation or declaration of invalidity, may amount to no change at all in another Member State that already has identical or similar provisions in place. I will discuss how the Harmonization Committee addressed this issue by “mapping” the provisions of the new Directive against existing national legislation and decided to focus on seven areas i.e. new trademark definition, new absolute grounds for refusal, new relative grounds for refusal, guarantee or certification marks and collective marks, administrative opposition proceedings, non-use as a defence in opposition proceedings, as well as administrative procedures for revocation or declaration of invalidity.

For the purpose of the presentation I will discuss the following three areas in order to exemplify the diversity of approaches adopted by the national IPOs, as well as the EUIPO's involvement in the transposition process.

New trademark definition (Art. 3)

One of the key changes introduced by the new Directive in all Member States is the elimination of the graphic representation requirement. It opened the possibility of accepting new types of signs, filed in formats which, in some cases, were not previously accepted for by national IPOs. The new Directive does not contain detailed definitions of trademark types,

nor means of representation thereof, which could lead to a misalignment of practices between various national offices and the EUIPO. To address this risk a “*Common Communication on the representation of new types of trademarks*” has been issued and offers an interesting example of pre-legislative convergence that will be briefly discussed.

Guarantee or certification marks and collective marks (Art. 27-36)

Implementation of collective marks is a mandatory provision under the new Directive, while guarantee or certification marks remain optional and their harmonisation only extends to definition, ownership (partially) and use, leaving ample room for the Member States to shape their national provisions. Of particular importance is the question whether geographical origin may be designated by such marks, as well as the issue of conversion of EU certification marks under Art. 93 of Regulation No. 2017/1001, both of which will be discussed.

Administrative procedures for the revocation or declaration of invalidity (Art. 45)

The new Directive made the availability of administrative procedures for the revocation or declaration of invalidity mandatory in all Member States, an area which is currently vastly unharmonized. Certain provisions of substantive law have been harmonized under the Directive, while others remain optional. Also, the procedural rules have been left for the Member States to determine, as long as the proceedings are “*efficient and expeditious*”. I will discuss experiences from Member States where administrative proceedings are already available and briefly analyze draft proposals for amendment on this issue.

Conclusions