

THOUGHT LEADERSHIP

LEGAL UPDATES

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Services

Intellectual Property
Trademarks

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New Regulation Limits Protection Offered by Some EU Trademarks

A new regulation that takes effect March 23, 2016, dramatically changes how the European Union Intellectual Property Office (EUIPO) interprets descriptions of goods and services for certain EU trademark registrations (EUTMs, formerly known as CTM registrations). Owners of CTM registrations that were applied for prior to June 22, 2012, and that include entire class headings in their specifications of goods and services have until September 24, 2016, to expand and clarify the existing descriptions. Failure to do so could result in registrations that no longer cover the actual goods and services for which the marks are used.

The Background

Historically, some EU trademark applications were filed with descriptions of goods or services that included the specific language found in Nice class headings. Under former practice, use of a class heading was viewed as expansive protection that covered **all** the goods and services within that specific class.

However, a 2012 decision from the Court of Justice of the European Union turned this interpretation on its head. The Court ruled that if the description of goods or services in a trademark registration recites a Nice class heading, then coverage for that registration extends only to the goods or services specifically recited by the registration (**not** to all goods or services that fall within that heading).

Eligible Registrations May Be Modified

Trademark registration holders have until September 24, 2016, to modify the description of goods or services in existing EU registrations to conform to the EUIPO's new interpretation. This opportunity is available only to registrations

for which applications were filed before June 22, 2012, and for which the description of goods or services includes the entire Nice class heading in use on the filing date of the application.

For example, the Nice class heading for Class 35 is “advertising; business management; business administration; office functions.” An EUTM with a description of services that recites that class heading or that class heading plus additional services in Class 35 would be eligible for the Article 28 filing opportunity. But an EUTM covering only “advertising” would not be eligible for amendment.

After September 24, 2016, the EUIPO will interpret EUTMs with Nice class headings as covering only the specific literal goods or services recited in the registration.

What This Means to You

Failure to amend the descriptions of affected registrations by September 24, 2016, could result in a loss of trademark coverage and protection. Thus companies are encouraged to evaluate their descriptions to ensure that under the new interpretation, they will cover the actual goods and services for which the marks are used.

Contact Us

For more information on how the new EU trademark regulation may impact your business, or for assistance with your trademark portfolio, contact Daan Erikson at 402.964.5160, Alan Nemes at 314.345.6461 or Kathleen Rheintgen at 312.526.1599.