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# LA REFORMA DEL SISTEMA DE MARCAS EN LA EU. EL REGLAMENTO DE LA MARCA DE LA UE



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**agesorpi**

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# LA REFORMA DEL SISTEMA DE MARCAS EN LA EU. EL REGLAMENTO DE LA MARCA DE LA UE



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# 1 Antecedentes

- Los excedentes presupuestarios de la Oficina: Los Fondos de Cooperación, el Plan de Convergencia y las Herramientas informáticas.
- 16/07/2008. Comunicación de la Comisión relativa a la Estrategia de los Derechos de Propiedad Industrial: Ha llegado el momento de proceder a la evaluación global del sistema de marcas en Europa
- 15/02/2011. Presentación del Informe Max Plank relativo al Funcionamiento global del Sistema Europeo de Marcas
- 27/03/2013. Presentación de las propuestas de la Comisión: DM y RMUE.
- 04/04/2013. La Comisión somete sus propuestas al Consejo/Parlamento.



# 1 Antecedentes

- 25/02/2014. El Parlamento toma posición en *first reading*.
- 23/07/2014: El Consejo acepta Posición Común y abre negociaciones con el Parlamento.
- 21/04/2015: *Trilogue discussions*. “Acuerdo Provisional sobre el Paquete de Marcas”: Reglamento y Directiva.
- 16/12/2015 y 24/12/2015. Adopción del Reglamento. RMUE
- 23/03/2016. Entrada en vigor.



## 2• INSTRUMENTOS AFECTADOS

CÓDIGO CIVIL

Statutes on

ESTUDIOS  
SOBRE  
PROPIEDAD  
INDUSTRIAL

GRUPO ESPAÑOL  
DE LA AIPPI

Grupo Español de la Aippi - La protección jurídica del diseño industrial

LE DROIT FRANÇAIS DES BREVETS D'INVENTION - PAUL MATHÉLY

LA PROTECCION DE LAS MARCAS INTERNACIONALES  
(Con especial referencia a España)

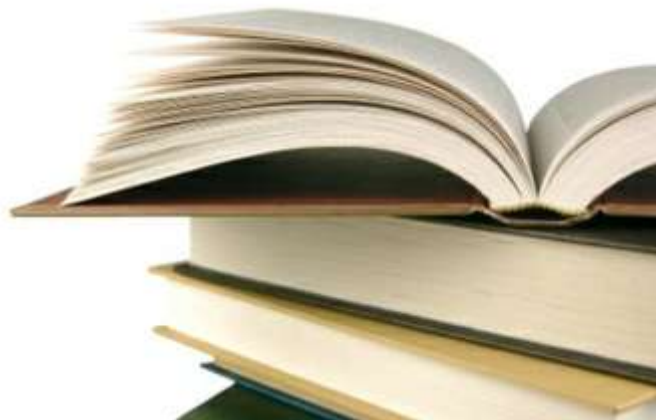
PIA MG Millennium Book

LEY  
DE  
MARCAS

32 / 1984

## 2 Instrumentos afectados

- RMC
- Reglamento de Ejecución. Actos Delegados.
- Reglamento Tasas.
- Reglamento Normas Procedimiento Salas Recurso.



### 3• OBJETIVOS

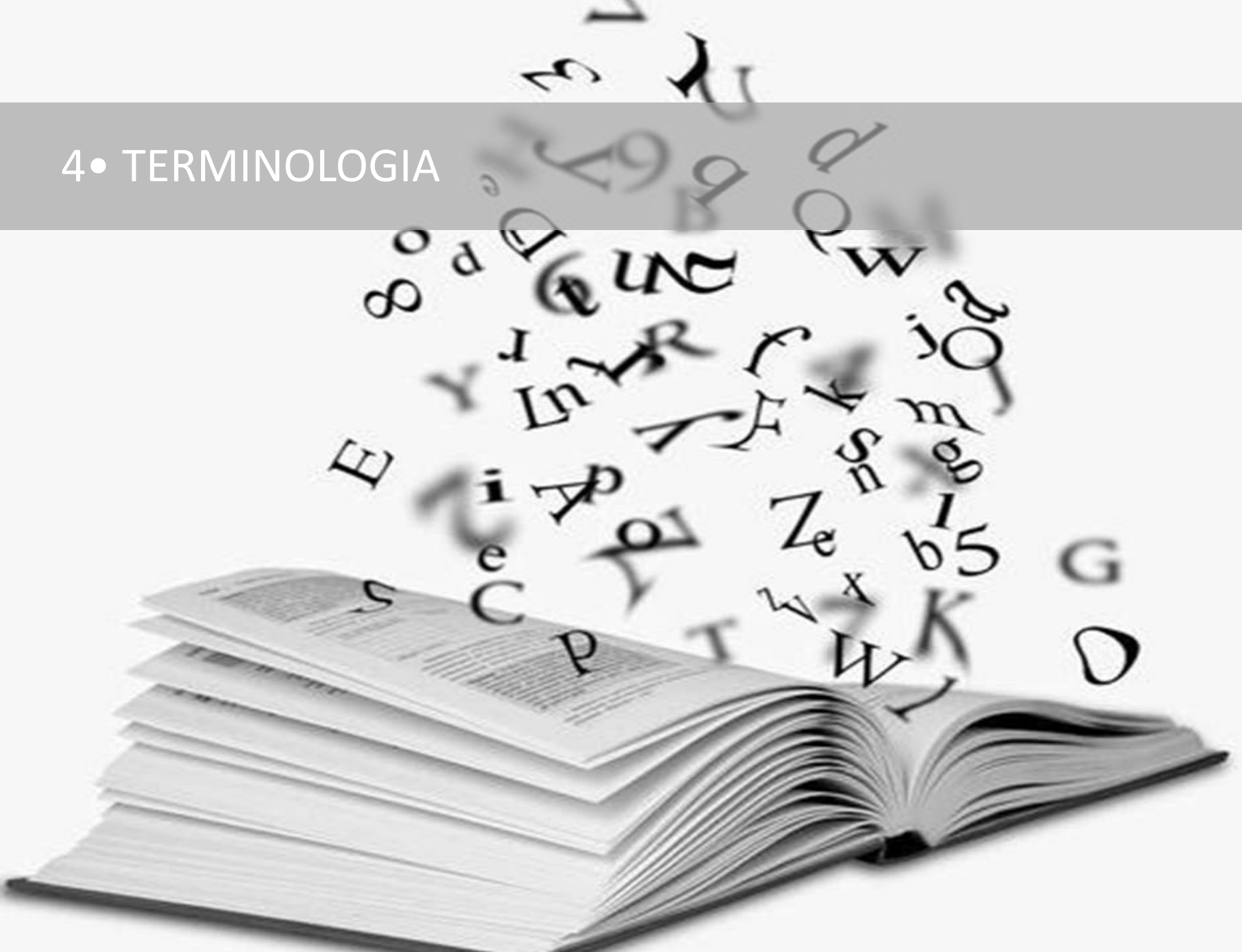


## 3 Objetivos

- Promover innovación y crecimiento económico haciendo los sistemas de registro de marcas en la UE más accesibles y eficientes en términos de reducción de gastos y complejidad, mejorando la rapidez, incrementando la predictibilidad.
- Modernización y perfeccionamiento de disposiciones y codificación de la jurisprudencia.
- Incrementar seguridad jurídica mediante la clarificación de los derechos de marca y sus limitaciones.
- Mayor armonización entre los sistemas nacionales y el europeo mediante una mayor aproximación de los primeros al segundo.
- Favorecer el incremento de cooperación entre la Oficina y las oficinas nacionales



## 4• TERMINOLOGIA



## 4 Terminología

- Comunidad/UE
- Marca de la Unión Europea
- Oficina de Propiedad Intelectual de la Unión
- Director Ejecutivo
- Tribunales de Marcas de la Unión



## 5• CODIFICACION DE LA JURISPRUDENCIA

Signos que pueden constituir marca: Sieckmann

Prohibiciones absolutas: Matratzen Concord

Prohibiciones relativas / Derechos conferidos: Davidoff/Durffee. L'Oréal/Bellure. Céline.  
Blomquist/Rolex. Philips/Nokia

Limitación de efectos: Anheuser Busch. BMW/Deenik

Uso: Rintisch/Eder

Clasificación: IP Translator/ Babilu/Babidu

The Nokia logo is a solid blue square with the word "NOKIA" in white, uppercase, sans-serif font centered within it.

NOKIA

The L'Oréal logo is a solid black square with the word "L'ORÉAL" in white, uppercase, sans-serif font centered within it.

L'ORÉAL

**PHILIPS**

## 6• PUNTOS ESENCIALES DE LA REFORMA.

Entrada en vigor: 23/03/2016, excepto lo indicado en Art.166



## 6 Puntos esenciales de la reforma

- Art. 4. El requisito de representación gráfica y las marcas no tradicionales.

...tales signos sean apropiados para:

a) ser representados en el Registro de Marcas de la Unión Europea (el “Registro”) de manera que permita a las autoridades competentes y al público en general determinar el objeto claro y preciso de la protección otorgada a su titular.».





- Art. 7(1)(e). Prohibiciones absolutas: signos que consisten exclusivamente en formas u **otra característica** impuesta por la naturaleza del producto, que son necesarias para obtener un resultado técnico o que afecte al valor intrínseco del producto.

e) signos constituidos exclusivamente por:

- i) la forma u **otra característica** impuesta por la naturaleza del propio producto,
- ii) la forma u **otra característica** de los productos necesaria para obtener un resultado técnico,
- iii) la forma u **otra característica** que aporte un valor sustancial a los mismos

## 6 Puntos esenciales de la reforma

- Art 7(1)(j), (k), (l). Denominaciones de origen e indicaciones geográficas, denominaciones tradicionales de vinos, especialidades tradicionales garantizadas, denominaciones de obtención vegetal y variedades vegetales.



- Art. 8(5). Prohibiciones relativas: marcas con reputación.

... con **independencia de que los productos o servicios por los que se solicite sean idénticos** o sean o no similares a aquellos para los que se haya registrado la marca anterior...



## 6 Puntos esenciales de la reforma

- Art. 9(2). Derechos conferidos “sin perjuicio de los derechos anteriores de terceros”. Principio de prioridad

2. Sin perjuicio de los derechos de los titulares adquiridos antes de la fecha de presentación de la solicitud o la fecha de prioridad de la marca de la Unión, el titular de esta **estará facultado para prohibir a cualquier tercero**, sin su consentimiento, el uso en el tráfico económico de cualquier signo en relación con productos o servicios cuando:



## 6 Puntos esenciales de la reforma

- Art. 9(3)(d). El uso a título de nombre comercial o denominación social

... podrá prohibirse,

d) utilizar el signo como nombre comercial o denominación social, o como parte de un nombre comercial o una denominación social;



## 6 Puntos esenciales de la reforma

- Art. 9(3)(f). Publicidad comparativa. Directiva 2006/114/CE.

f) utilizar el signo en publicidad comparativa, de una manera contraria a la Directiva 2006/114/CE del Parlamento Europeo y del Consejo.



- Art. 9(4). Mercancías en tránsito



.... impedir que, en el tráfico económico, **terceros introduzcan productos en la Unión, sin que sean despachados a libre práctica en dicho territorio**, cuando se trate de productos, incluido su embalaje, que provengan de terceros países y que lleven sin autorización una marca idéntica a la marca de la Unión registrada respecto de los mismos tipos de productos, o que no pueda distinguirse en sus aspectos esenciales de dicha marca.

- Art. 9 bis. La prohibición de actos preparatorios en embalajes y otros soportes

... **riesgo** de que el embalaje, las etiquetas, los marbetes, los elementos de seguridad o dispositivos de autenticidad u otros soportes en los que se coloca la marca puedan ser utilizados en relación con determinados productos o servicios y ese uso **constituya una violación de los derechos...**

- a) la colocación de un signo idéntico o similar a la marca de la Unión en el **embalaje, las etiquetas, los marbetes, los elementos de seguridad o dispositivos de autenticidad** u otros soportes en los que pueda colocarse la marca;
- b) **la oferta o comercialización, o el almacenamiento a tales fines, o bien la importación o exportación de embalajes,** etiquetas, marbetes, elementos de seguridad o dispositivos de autenticidad, u otros soportes en los que esté colocada la marca.

- Art. 12. Limitación de efectos: nombre de persona física, signos o indicaciones no distintivas, uso a efectos de designar P&S [recambios]
  1. Una marca de la Unión no permitirá a su titular prohibir a un tercero hacer uso, en el tráfico económico:
    - a) de **su nombre o su dirección**, cuando el tercero sea una persona física;
    - b) de la marca de la Unión, a efectos de designar productos o servicios como correspondientes al titular de esa marca o de hacer referencia a los mismos, en particular cuando el **uso** de esa marca sea **necesario para indicar el destino** de un **producto o de un servicio**, en particular como accesorios o piezas de recambio.
    - c) de la marca de la Unión, a efectos de designar productos o servicios como correspondientes al titular de esa marca o de hacer referencia a los mismos, en particular cuando el **uso** de esa marca sea **necesario para indicar el destino** de un **producto o de un servicio**, en particular como accesorios o piezas de recambio.
  2. El apartado 1 solo se aplicará si la utilización por el tercero es conforme a las prácticas leales en materia industrial o comercial.».

## 6 Puntos esenciales de la reforma

- Art. 13 bis. Derecho de intervención del titular de la marca posterior como defensa en acciones por violación.

1. En las acciones por violación de marca, el titular de una marca de la Unión no estará facultado para prohibir la utilización de una marca registrada de la Unión posterior si esta última no puede declararse nula con arreglo al artículo 53, apartados 1, 3 o 4, al artículo 54, apartados 1 o 2, o al artículo 57, apartado 2, del presente Reglamento.

2. En las acciones por violación de marca, el titular de una marca de la Unión no estará facultado para prohibir la utilización de una marca registrada nacional posterior si esta última no puede declararse nula con arreglo al artículo 8, o al artículo 9, apartados 1 o 2, o al artículo 46, apartado 3, de la Directiva (UE) 2015/2436 del Parlamento Europeo y del Consejo (\*).

3. Cuando el titular de una marca de la Unión no esté facultado para prohibir la utilización de una marca registrada posterior en virtud de los apartados 1 o 2, el titular de esta última no podrá prohibir la utilización de dicha marca de la Unión anterior en las acciones por violación que ejerza.

## 6 Puntos esenciales de la reforma

- Art. 28 (8). Clasificación: IP TRANSLATOR. Las declaraciones bajo el Art. 28(8) para marcas solicitadas antes del 22/06/2012. Consecuencias en procedimientos de violación y oposición. El proyecto de Comunicación del Presidente.

8. Los titulares de **marcas de la Unión solicitadas antes del 22 de junio de 2012** que estén registradas respecto de un título íntegro de una clase de Niza, podrán declarar que su intención en la fecha de presentación de la solicitud era buscar protección para productos o servicios más allá de los comprendidos en el tenor literal del título de la clase considerada, **siempre que los productos o servicios así designados estuvieran comprendidos en la lista alfabética correspondiente** a esa clase de la edición de la clasificación de Niza en vigor en la fecha de presentación de la solicitud.

La **declaración** se presentará a la Oficina a más tardar el **24 de septiembre de 2016**, e indicará, de forma clara, precisa y específica, los productos y servicios, aparte de los claramente comprendidos en el tenor literal de las indicaciones del título de la clase, a los que se extendía inicialmente la intención del titular. La Oficina tomará las medidas adecuadas para modificar el registro en consecuencia. La posibilidad de presentar una declaración conforme al párrafo primero del presente apartado se entenderá sin perjuicio de la aplicación del artículo 15, del artículo 42, apartado 2, del artículo 51, apartado 1, letra a), y del artículo 57, apartado 2.

## 6 Puntos esenciales de la reforma

- Art. 28 (9). Clasificación: IP TRANSLATOR.

9. En caso de que se modifique el registro, los derechos exclusivos conferidos por la marca de la Unión en virtud del artículo 9 **no impedirán que un tercero siga utilizando la marca para** productos o servicios **siempre que el uso** de la marca para dichos productos o servicios:

- a) **haya comenzado antes de que se modificara** el registro, y
- b) **no suponga una vulneración de los derechos** del titular conforme al tenor literal del registro de los productos y servicios en aquel momento.

Asimismo, la modificación de la lista de productos o servicios registrados no **concederá al titular de la marca** de la Unión el derecho **a oponerse o a solicitar la nulidad** de una marca posterior siempre y cuando:

- a) la marca posterior ya esté en uso, o ya se haya solicitado su registro, para productos o servicios antes de que se modificara el registro, y
- b) el uso de la marca para dichos productos o servicios no haya vulnerado, o no habría vulnerado, los derechos del titular conforme al tenor literal del registro de los productos y servicios en aquel momento.».



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

The President

**Communication No X/XX of the President of the Office  
of XX/XX/XXXX**

**concerning the implementation of Article 28 EUTMR**

The President of the Office for Harmonization in the Internal Market (Trade Marks and Designs),

Having regard to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark ('CTMR'),

Having regard to Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark ('CTMIR'),

Having regard to Regulation (EU) No XX/XXXX of XX/XX/XXXX of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2868/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (the 'Amending Regulation'),

Whereas:

- (1) Communication No 2/12 of the President of 20/08/2012 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations established the practice of the Office as regards the scope of protection of class headings in applications and registrations filed before and after the entry into force of that communication in the light of the judgment of the Court of Justice of the European Communities of 19 June 2012 in Case C-307/10, 'IP Translator'.
- (2) Upon entry into force of the Amending Regulation, Article 28(1) to (7) of Council Regulation No 207/2009 as amended ('EUTMR') will lay down the requirements for designating and classifying goods and services, including the conditions for, and the consequences of, the use of class headings.
- (3) Article 28(8) EUTMR allows for a transitional period during which proprietors of EU Trade Marks that are registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods and services beyond those covered by the literal



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meaning of that heading.

- (4) Pursuant to Article 124(2)(a) CTMR, the President of the Office will take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Office.
- (5) In the absence of more detailed implementing rules and in view of the need to give effect to Article 28 EUTMR, it is necessary to lay down the procedure for its implementation, explain the modalities of its application and determine its impact on future and existing registrations,

HAS ADOPTED THE FOLLOWING COMMUNICATION:

#### 1. Scope of Article 28 EUTMR

Article 28(1) to (7) EUTMR lays down the requirements for designating and classifying goods and services, including the conditions for, and the consequences of, the use of the class headings of the Nice Classification.

In accordance with Article 28(3) EUTMR, the Office will accept the use of general indications included in the class headings of the Nice Classification or other general terms, provided that they comply with the requisite standards of clarity and precision. This provision applies directly to the designation of goods and services in all EU trade mark applications filed as from the entry into force of the EUTMR.

In accordance with Article 28(5) EUTMR, the use of class headings and other general terms will be interpreted as including all the goods or services clearly covered by the literal meaning of the general indication or term. This provision applies as from the date of entry into force of the EUTMR and extends to all marks filed after 21/06/2012, as well as to applications that were filed on or before that date but are still not registered.

Further details on the rules governing the designation and classification of goods and services are given in the Guidelines for Examination, Part B, Examination, Section 3, Classification.

Article 28(8) EUTMR introduces a transitional period during which proprietors of EU trade marks applied for before 22/06/2012 and registered for the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection for goods and services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice Classification in force at the date of filing.

Declarations made pursuant to Article 28(8) EUTMR ('declarations') are subject to the conditions specified in the present Communication.

#### 2. Eligible Registrations

Declarations may only be made for EU trade marks that were filed before 22/06/2012 and continue to be registered in respect of the entire heading of at least one Nice class.



The existence of additional goods and services in the specification either in the same or in another class does not preclude the application of Article 28(8) EUTMR to the class that includes the entire heading, provided that the language used does not limit or in any way disclaim the general indications of the heading.

### 3. Time limit

Declarations must be submitted to the Office within six months of the entry into force of the Amending Regulation, that is to say, between XX/XX/2016 and XX/XX/2016 inclusive.

### 4. Form

In accordance with Rule 79 CTMIR, applications to record a declaration must be filed in writing.

In order to ensure that they are dealt with efficiently and expeditiously, the Office has created a specific online Recordal application form, which can be found in the User Area of the Office's website under 'Online forms — Online Recordal application — Recordal — EUTM Recordal — Declaration under Art. 28(8)' ('the form').

The form contains a text box for indicating the goods and services claimed in accordance with paragraph 8 below.

The text box should be completed by indicating the class number followed by the names of the goods and services to be added. The class number should be indicated at the start and the individual goods and services should be separated by commas (to separate items within a similar category or expression) and/or semicolons (to separate expressions), as necessary. Each different class should be listed on a new line following a paragraph break.

The use of the online form is highly recommended as it may considerably decrease the likelihood of formal deficiencies. Applicants who opt for other means of communication must ensure that their application complies with the requirements established in this Communication.

### 5. Language

In accordance with Rule 95(b) CTMIR, declarations must be filed in one of the five languages of the Office, namely English, French, German, Italian or Spanish.

Any language version of the form identified in paragraph 4 above may be used, provided that it is completed in one of the languages of the Office, in particular the list of goods and services.

### 6. Applicants and Representatives

Declarations must be submitted to the Office by the proprietor(s) of the EU trade mark or their duly appointed representative.

The standard rules on mandatory representation apply (see Article 92(2) EUTMR).

When the proprietor appoints a representative, he or she must indicate the representative's name and ID number. If the representative has not yet been assigned an ID number, the business address must be indicated. The Office may request an authorisation in accordance with Articles 92(3) and 93(1) EUTMR, in particular if the declaration is submitted by an employee representative or by a representative that is not the representative on file.

#### 7. Mandatory Indications

By analogy with Rule 36(1) CTMIR declarations must contain the following information:

- a) the registration number of the EU trade mark concerned;
- b) the proprietor's name and the ID number attributed to the proprietor by the Office;
- c) an indication of each of the goods and services the proprietor wishes to add, in accordance with paragraphs 4 and 8.

Pursuant to Rule 79 CTMIR, the claim must be signed by the EU trade mark proprietor or its duly appointed representative.

In accordance with Rules 80 and 82 CTMIR, if the declaration is submitted by fax or by electronic means, the indication of the sender's name is deemed to be equivalent to a signature.

#### 8. Content of the Declaration

The goods and services designated in accordance with Article 28(8) EUTMR must be indicated in the proprietor's declaration in a clear, precise and specific manner.

The declaration must only include goods and/or services that:

- (a) are contained in the alphabetical list for the class in question of the edition of the Nice Classification in force at the date of filing, and
- (b) go beyond the literal meaning of those covered by the general indications of the corresponding class heading.

The Office will object to the use of unclear, imprecise or unspecific terms, to claims for the entire alphabetical list, to declarations for goods and services that are deemed to be clearly covered by the literal meaning of the class heading or to declarations for goods or services not contained in the alphabetical list in question.

In order to assist proprietors in identifying goods and services that go beyond the literal meaning of the general indications of the class headings, the Office has compiled a list of examples of such goods and services as Annex I to this Communication. Declarations relating to any of the goods or services included in this list for the corresponding class and edition will not be objected to by the Office on the ground of being covered by the literal meaning of the general indications.

## 9. Fees

Declarations are not subject to a fee.

## 10. Examination by the Office

The Office will examine whether the declaration complies with the requirements of Article 28(8) EUTMR and with paragraphs 2 to 8 of the present Communication.

If the declaration does not comply with the above requirements, the Office will issue a deficiency letter stating why the claim is unacceptable and setting a deadline of two months for the proprietor to remedy the deficiency.

In the absence of a response, or if the deficiency is not remedied, the declaration will be rejected.

In accordance with Articles 58 to 60 and 135 EUTMR, the proprietor may file an appeal against this decision.

## 11. Registration and Publication

If the declaration complies with the requirements of Article 28(8) EUTMR and paragraphs 2 to 8 above, the Office will record it in the Register and inform the proprietor accordingly.

The declaration will be published in the EUTM Bulletin in part C.3.2.

The publication will contain the following data:

- the EU trade mark registration number
- the list of goods and services after the Article 28(8) EUTMR declaration
- the date and number of the entry in the Register of the Article 28(8) EUTMR declaration
- the date of publication of the entry in the EUTM Bulletin
- the indication 'Art. 28(8)' under INID code 580.

## 12. Traceability

In the interests of legal certainty, and in order to enable the competent authorities and economic operators to keep track of additions made by virtue of Article 28(8) EUTMR, in particular for the purposes of applying Article 28(9) EUTMR, declarations that are accepted will be entered in the Register and can be searched for/accessed in two ways.

- Using the Office's online database (eSearch plus) under the 'Publications' section for the mark concerned, identified by the description 'Partial Surrender / Declaration under Art.28(8) EUTMR'. Upon clicking, the relevant publication will open in the CTM Bulletin under part C.3.2 'Partial Surrender / Declaration under Art.28(8) EUTMR' with the indication 'Art. 28(8)' under INID code 580.
- Using the Office's online database (eSearch plus) under the 'Records' section



for the mark concerned, identified as recordal type 'Declaration under Art. 28(8) EUTMR'.

### 13. Effect

As from the end of the period referred to in paragraph 3, all the marks referred to in paragraph 2 for which no acceptable declaration has been filed will be deemed to extend only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

During the transitional period referred to in paragraph 3, above, Communication No 2/12 of 20/06/2012 of the President of the Office will continue to apply.

Declarations for EU trade marks filed within the period referred to in paragraph 3 above will take effect from the date of their entry in the Register. Until registration is effected, the previous paragraph will apply.

### 14. Limitations of Rights

Where the declaration is accepted and the Register is amended, Article 28(9) EUTMR will apply.

In consequence, the amendment of the list of goods and services of the earlier EU trade mark pursuant to Article 28(8) EUTMR will not give the proprietor the right to prevent the use by third parties of any of the goods or services so added, provided that use commenced before the Register was amended and did not infringe the proprietor's rights on the basis of the literal meaning of the goods and services in the Register at that time.

Nor will the proprietor have the right to oppose or to apply for a declaration of invalidity of a later trade mark if that later trade mark was in use or had been applied for prior to a declaration being entered in the Register and that the use in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the goods or services recorded in the Register at that time.

Further details on the modalities of application of Article 28(9) EUTMR are given in the Guidelines for Examination, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services.

### 15. Relationship with Other Provisions

Article 28(8) EUTMR is an exceptional, transitional, arrangement, which allows proprietors to amend the wording of their specifications in the interests of legal certainty by expressly identifying goods and services that they originally intended to include in their specifications but were not clearly reflected in the Register as falling outside the natural and usual meaning of the class heading concerned.

Proprietors are advised to consider carefully the declaration they wish to make under Article 28(8) EUTMR, bearing in mind, in particular, that any such addition of goods and services (i) is made without prejudice to Article 15, Article 42(2) and Article 51(1)(a) EUTMR, with regard to the obligation to put said goods and services

to genuine use and (ii) will be subject to the sanctions of Article 28(9) EUTMR.

Declarations made pursuant to Article 28(8) EUTMR should not be confused with, or be considered as an alternative to, partial surrenders within the meaning of Article 50 EUTMR, which are, and will remain, available to proprietors after the end of the transitional period.

In particular, declarations under Article 28(8) EUTMR should not be used to restrict lists containing class headings to specific goods or services covered by their literal meaning or to replace a general indication with more precise terms.

In such cases, proprietors should make use of partial surrenders under Article 50 EUTMR using the 'Online forms — Online Recordal application — Recordal — EUTM Recordal — Partial Surrender'.

Article 154 EUTMR does not contemplate the application of Article 28(8) EUTMR to international registrations designating the EU. Consequently the provisions of this Communication do not apply to international registrations designating the EU.

#### 16. Entry into Force

This Communication enters into force on the date of entry into force of the amending Regulation, that is to say on .../2016. It will be published in the Office's Official Journal.

Communication No 2/12 of the President of 20/06/2012, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations, is repealed

- as of XX/XX/XXXX insofar as it concerns EU trade marks filed after 21/06/2012 and EU trade marks filed before 22/06/2012 but not yet registered at the time of entry into force of the EUTMR;
- as of XX/XX/XXXX for marks filed before 22/06/2012 and registered in respect of an entire Nice class heading at the time of entry into force of the EUTMR for which no declaration is filed;
- as of the date of entry in the Register of the declaration for those marks for which a declaration that is accepted is filed within the period referred to in paragraph 3 above.

António Campinos  
President

## Frequently Asked Questions

### 1. Who can make a declaration under Article 28(8) EUTMR?

Proprietors of EU trade marks filed before 22/06/2012 and registered before the entry into force of Regulation XXXXXX of XXXX/XXXX amending Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark that contain the entire heading of a Nice class.

### 2. Do I need to appoint a representative?

The general rules on representation apply (see the Guidelines for Examination, Part A, General Rules, Section 5, Professional Representation).

### 3. When can the declaration be made?

Article 28(8) EUTMR declarations must be made within six months of the entry into force of the Regulation.

### 4. Can the six-month period be extended?

The six-month period for making the declaration cannot be extended. However, if the Office issues a deficiency letter, remedies may be submitted after expiry of the six-month period.

### 5. Will trade mark owners be informed about the need to amend?

Trade mark owners will not be informed individually by the Office about the possibility of filing a declaration under Article 28(8) EUTMR. A communication from the President of the Office will be issued explaining in detail which marks are affected and what steps owners should take if they wish to amend their specifications.

### 6. Does it cover only CTMs or also national trade marks?

Article 28(8) EUTMR applies only to EU trade marks (CTMs).

### 7. What form should I use?

The Office has created a new online recordal application form, under 'EUTM Recordal', type 'Declaration under Art.28(8) EUTMR'.

The form must be completed in one of the five languages of the Office.



**8. Will there be a fee for making an Article 28(8) EUTMR declaration?**

No. These records are free of charge.

**9. Will it be possible to amend any general indication, or only those considered to be unclear or imprecise (i.e. the 11 general indications)?**

Under Article 28(8) EUTMR, it will only be possible to specify the goods and services that go beyond the literal meaning of the class heading of that class, provided that the goods and services are included in the alphabetical list for the class of the edition of the Nice Classification in force at the date of filing.

It will not be possible to amend general indications considered to be too vague under Article 28(8) EUTMR.

Requests to amend the specification of goods or services to those covered by the literal meaning should be filed, as usual, under Article 50 EUTMR using the 'Partial Surrender' recordal type (for more information, see the Guidelines for Examination, Part E, Register Operations, Section 1, Changes in a Registration, paragraph 1.3.5).

**10. What criteria will be applied to determine whether an expression is clear and precise?**

Declarations can only be made for specific goods or services contained within the alphabetical list and not covered by the literal meaning of the class heading for the class of the edition of the Nice Classification in force at the date of filing. Such goods and services are deemed to be sufficiently clear and precise.

**11. Will marks that have been limited as such, or as the result of opposition, or cancellation proceedings, be able to expand their protection under Article 28(8) EUTMR?**

Oppositions resulting in a mark being partially rejected must have been worded in that manner. Examiners will, however, be instructed to ensure that this is not an issue.

**12. Will there be a possibility of opposition or cancellation proceedings against the goods and services included in an Article 28(8) EUTMR declaration?**

Under current practice, as defined in Communication No 2/12 of the President of the Office of 20/06/2012, marks filed on or before 21/06/2012 covering all the general indications of a particular class heading of the Nice Classification are interpreted as covering all the goods and services included in the alphabetical list of the particular class concerned in the edition in force at the time when the filing was made.



The transitional period during which holders can declare that their intention was to cover specific goods and services of the alphabetical list not covered by the literal meaning at the time of filing is an opportunity for holders to clarify the exact scope of their goods and services. It is not considered to be an extension of the scope of goods and services, but rather a clarification based on the assumption that these goods and services already formed part of the scope of the registration, despite the fact that this was not explicitly stated.

The exact wording of Article 28(8) EUTMR makes it clear that the possibility to make such a declaration is without prejudice to use requirements. That provision, however, does not foresee the possibility of filing an opposition or cancellation against the said declaration. Nor does this situation fall under Rule 14 CTMR, which is only applicable to the publication of applications. It is clear, therefore, that the intention of the legislator was that no new opposition period should be opened.

Six months after the entry into force of the new regulation, and where no declaration under Article 28(8) EUTMR has been made, those marks will be deemed to cover only goods and services clearly covered by the literal meaning of the indications included in the relevant class heading.

### 13. Is the list of vague terms considered to be exhaustive?

Declarations can only be made for specific goods or services contained in the alphabetical list that are not covered by the literal meaning of the class heading for the class of the edition of the Nice Classification in force at the date of filing. Such goods and services are deemed to be sufficiently clear and precise.

### 14. If my mark fulfils all the requirements for making an Article 28(8) EUTMR declaration, but I do not make one, what are the consequences?

Six months after the entry into force of the new regulation, and where no declaration under Article 28(8) EUTMR has been made, those marks will be deemed to cover only goods and services clearly covered by the literal meaning of the indications included in the relevant class heading.

### 15. How will the adjustment to the 'IP Translator' judgment be carried out?

Declarations that are accepted under Article 28(8) EUTMR will be recorded in the Register and published in the Bulletin in part C.3.2. These changes will also be reflected in [eSearch plus](#).

### 16. How does the Office deal with oppositions based on a national trade mark registration, when the list of goods contains the class heading of the class?



Table 5 of the Common Communication on the implementation of 'IP Translator' explains how the Office interprets the scope of protection of national trade marks containing general indications of the Nice class headings.

**17. How do I know if I have all the general indications of the class heading?**

WIPO's web page on the [Nice Classification](#) contains all the editions and versions of the Nice Classification since it was established, as well as an indication of the class headings for each edition/version.

The existence of additional goods and services in the specification, either in the same or in another class, does not preclude the application of Article 28(8) EUTMR to the class that includes the entire heading, provided that the language used does not limit or in any way disclaim the general indications of the heading. For example, a limitation in the class heading of Class 25, *Clothing; footwear; headgear* to 'except shirts' would preclude the application of Article 28(8) EUTMR, because the general indication 'clothing' has been limited.

**18. Can I file multiple declarations under Article 28(8) EUTMR for the same mark?**

In principle, a single declaration should be filed for each mark. However, if a deficiency is raised that is not overcome during the period for response, the proprietor may submit a new declaration providing the six-month period is still running.

**19. Where can I find more information?**

Information on the change in practice can be found in Communication No XX/XXXX of the Executive Director of the Office.

## 6 Puntos esenciales de la reforma

- La legislación secundaria y los Actos Delegados.

Art. 34(5) [reivindicación de antigüedad],

Art. 39(5) [publicación solicitud]

Art. 43 [modificación solicitud]

Art. 44(8) y (9) [división solicitud]

Art. 45 [certificado de registro]

Art. 48 [modificación]

Art. 48 bis [cambio de nombre o dirección]

Art. 50 [renuncia]

Art. 57 bis [pormenores en nulidad, caducidad y cesión]

Art. 78 [instrucción]

Art. 79 [notificación]

Art. 79 ter [comunicaciones a la Oficina]

Art. 80 [revocación de decisiones erróneas]

Art. 85 [reparto de gastos]

Art. 93 bis [representación]

Art. 119 (10) [traducciones]



### • Art. 123 quater. Cooperación y Convergencia

1. La Oficina, las oficinas centrales de la propiedad industrial de los Estados miembros y la Oficina de Propiedad Intelectual del Benelux cooperarán entre sí para fomentar la convergencia de prácticas y herramientas en el ámbito de las marcas y los dibujos y modelos.

Sin perjuicio del apartado 3, esta cooperación incluirá, en particular, los siguientes ámbitos de actividad:

- a) desarrollo de **normas comunes de evaluación**;
- b) creación de **bases de datos y portales comunes** o interconectados con fines de consulta, búsqueda y clasificación a escala de la Unión;
- c) suministro e **intercambio continuo de datos e información**, incluso a efectos de alimentación de las bases de datos y portales a que se refiere la letra b);
- d) establecimiento de **normas y prácticas comunes**, a fin de garantizar la interoperabilidad de los procedimientos y sistemas en toda la Unión y mejorar su coherencia, eficiencia y eficacia;
- e) intercambio de **información sobre derechos y procedimientos** en materia de propiedad industrial, así como apoyo mutuo a los servicios de asistencia y centros de información;
- f) intercambio de **conocimientos técnicos y de asistencia** en relación con los ámbitos contemplados en las letras a) a e).

## 6 Puntos esenciales de la reforma

- Art. 139 (5). 5% ingresos para oficinas nacionales. Hasta 10% Fondo de reserva: un año. Si cinco años de excedentes: transferencia al presupuesto de la UE

5. La compensación general de los gastos contemplados en el apartado 4 corresponderá al 5 % de los ingresos anuales de la Oficina. Sin perjuicio del párrafo tercero del presente apartado, a propuesta de la Oficina y previa consulta al Comité presupuestario, el consejo de administración determinará la clave de reparto basándose en los siguientes indicadores justos, equitativos y pertinentes:

7. En el supuesto de que se produzca un excedente presupuestario, y sin perjuicio del apartado 10, a propuesta de la Oficina y previa consulta al Comité presupuestario, el consejo de administración podrá aumentar el porcentaje establecido en el apartado 5 hasta un máximo del 10 % de los ingresos totales de la Oficina.



## 6 Puntos esenciales de la reforma

- Art. 61 Revisión decisiones en procedimientos inter-partes. Suprimido



- Art. 74 bis a 74 duodecies. Marcas de certificación de la Unión. **Nuevo.**



		Actual	Nueva
Tasas solicitud		900 (3 clases)	850 (1 clase)
Tasas Clases	2ª Clase	--	50
	3ª clase	--	150
	4ª clase y sucesivas	150	150
Total	1 clase	900	850
	2 clases	900	900
	3 clases	900	1050

Tasas renovación		1350 (3 clases)	850 (1 clase)
Tasas clases	2ª clase	--	50
	3ª clase	--	150
	4ª clase y sucesivas	400	150
Total	1 clase	1350	850
	2 clases	1350	900
	3 clases	1350	1050



## 7• CONCLUSIONES

 CARLOS POLO & ASOCIADOS



- El futuro del Sistema de Marcas en la UE y de los representantes profesionales.
- El futuro de las oficinas nacionales. Son necesarias?

