

# The EU Trademark Reform Package discussed at the AIPPI Congress

**Kluwer Trademark Blog**

September 30, 2016

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*Please refer to this post as: Bartosz Krakowiak, 'The EU Trademark Reform Package discussed at the AIPPI Congress', Kluwer Trademark Blog, September 30 2016,*

*<http://trademarkblog.kluweriplaw.com/2016/09/30/eu-trademark-reform-package-discussed-aippi-congress/>*

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There was not much about trademarks during this year's **AIPPI Congress**, which was held from September 16 to 20 in Milan (see Panel Sessions and Study Questions). Most of the discussions were focused on such hot topics as the Unified Patent Court or Brexit (the latter of course involving some important trademark-related aspects) and one of a few exceptions was the Panel Session X "Unwrapping the European Trademark Reform Package". The panelists were: Luis Berenguer (Head of the Communication Service at EUIPO), Jan Vleck (Reddie & Grose, UK) and prof. Marco Ricolfi (University of Turin and Tosetto, Weigmann & Associates, IT). The author of this post had an unquestionable pleasure of moderating the session. The panel session considered the major changes in relation to some of the key issues wrapped within **the EU Trademark Reform Package** (the new Trademark Directive and the revised EU Trademark Regulation), such as the abolishment of the requirement for graphic representation of a mark, the extension of some absolute grounds of refusal previously reserved to shape marks (regarding, in short, the nature of the goods, essential value and functionality) to all trademarks, the specification of goods and services covered by a trademark, the new limitations of exclusive trademark rights and the new rules on counterfeit goods in transit.

Luis Berenguer (who was apparently holding a printed draft of the new EU

Trademark Implementing Regulation, which had already been shared by the EU Commission with EUIPO and Member States but not yet with the public – unfortunately, the author’s hands were too short to catch it...) provided, inter alia, an update on **declarations under Article 28(8)** of the EU Trademark Regulation. This was just a few days before expiration of the deadline for submitting them to EUIPO if one wanted to declare his intention, on the date of a EUTM filing made before June 22, 2012, to seek protection in respect of goods or services beyond those covered by the literal meaning of the class heading but included in the alphabetical list for that class (under the new rules the class headings must be interpreted literally in determining the scope of trademark protection). Jan Vleck reminded that, according to Article 28(2) of the EU Trademark Regulation, the goods and services for which the protection is sought shall be identified with **sufficient clarity and precision**, and – with a dose of criticism – he presented a 44-page long specification of a freshly registered trademark listing all goods from the alphabetical list for just 6 classes.

An interesting question, which appeared during Marco Ricolfi’s presentation of the changes related to the scope of trademark protection (new exclusive rights and new limitations), was **the role of recitals** of both the Regulation and the Directive in the application of the respective laws (not only in their interpretation). It was raised by the author of this post that, while the respective recitals relating to the new rules on goods in transit only explain how to properly apply the corresponding provisions (with a quite clear message: be careful, especially when it comes to medicines – as subsequently extended by the EU Commission in its [Transit Guidelines](#)), in the recitals relating to the limitations of exclusive trademark rights there can be found some additional limitations which are not reflected whatsoever in the corresponding provisions of the Regulation and the Directive. Those are quite important limitations based on **the principle of freedom of expression**, in particular use of a trademark for the purpose of artistic expression. Prof. Ricolfi, making a reference to some non-trademark EU case law, expressed his opinion that the recitals can be directly applicable, even in lack of their explicit equivalents in the main part of a given EU legislative act.

All the panelists, including the author, agreed that – besides a few exceptions – the EU Trademark Reform Package brought no revolutionary changes, though there are still several elements of the reform to be unwrapped (such as the implementing and delegated acts to the EU Trademark Regulation, as well as

legislative acts transposing the new Trademark Directive into national laws). And, as it clearly resulted from the panel discussion, there are at least a few issues that are likely to end up being considered by the EU Court of Justice.