



FINAL DEADLINE 24 SEPTEMBER 2016

*To ALL owners of Community trademarks filed
before 22 June 2012*

On 23 March 2016 OHIM became EUIPO, European Union Intellectual Property Office, and the old Community trademark was substituted by the European Union trademark.

We kindly ask you to take note of the following important changes that influence in a relevant way your trademarks, which **must be updated**.

How did it work so far?

Before the IP Translator decision (22.06.2012) anyone who filed a Community trademark could simply indicate the class of reference and its title to include in the protection all the goods or services comprised in that class. From 2012, however, it is necessary to specify in a precise way the goods or the services for which protection is sought, even if a poor specification as regards precision or clarity was not a reason for the refusal of a trademark application.

Furthermore, the trademarks filed before 2012 were excluded from this regime, so anyone who filed a trademark application before that date indicating the title of the class in a generic way was always entitled to the protection extended to all goods or services.

Why do I have to update my trademark?

Art. 28 of the new Regulation (Reg. 2015/2424), however, provides for the fact that if the goods and the services are not indicated in a precise and rigorous way the trademark application may be refused.

This concerns the future and therefore it will be necessary to pay the utmost attention during the filing phase, but it influences also the past because the title of the class will no more be considered as comprising all goods or services of the class, even if the trademark was filed before 2012.

Art. 28 comma 8, provides for the fact that the owners of trademarks filed before 22.06.2016 can *«declare that on the date of filing the intention thereof was to obtain the protection of other goods or services in addition to those covered by the literal meaning of the title of the class, on condition that the goods or the services designated in such a way appear in the alphabetical list of the class of the Nice classification, in the edition in force to the date of filing»*.

What happens if I do not do so?

If no declaration is filed, the list of goods or services will be considered including *«solely the goods or the products clearly covered by the literal meaning of the indications that appear in the title of the pertinent class»*, which may imply a significant reduction of the protection or even the complete elimination of the protection.



Can we make an example?

If John used his own trademark for washing machines, he could file a trademark application indicating in a generic way the class 7, which has the following title:

Class 7: Machines and machine tools; motors and engines (except those for land vehicles); machine coupling and transmission components (except those for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.

Until today, having John indicated the title, he was protected also for washing machines.

Now, if by 24 September 2016 he does not declare his intention to claim the use of the trademark for washing machines, after 24 September his trademark will no more be protected for washing machines but only for machine tools, for incubators for eggs and for the sole products that are quoted in the title of the class.

Am I obliged to proceed?

It is not mandatory to proceed with the declaration but it is evident that in many cases the missing declaration will have devastating effects.

What shall I do so as not to lose my rights?

We invite all owners of trademarks filed on a date before 22.06.2012 to contact **with the utmost urgency** our law firm to evaluate concretely if it is necessary to proceed with such a declaration, so as to update your trademark and not to lose the desired protection.

We remain at your disposal for any further explanation.

Kind regards,

Studio Legale Turini