

Feedback form for comments on the draft Guidelines

User Association/National Office	International Trademark Association – INTA
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Contributor (name & position)	OHIM Subcommittee of Trademark Office Practices Committee
Linguistic version the comments refer to	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Part E, Section 4 – RENEWAL, Chapter 5.4.3 and 5.5.5 (“Transitional arrangements”)
Page of the document	9/10 and 12 [referring to version with track changes]
Issue(s) you wish to comment on	<p>The Office suggests that the “old law” (i.e. the current unamended Regulation 207/2009 and Rule 30(2) CTMIR) applies to all CTMs where the six-month period for renewal started to run before the entry into force of the Amending Regulation. This would mean applying the current higher renewal fees and the “end of the month” renewal rule to all EU trademarks for which the six-month pre-renewal period had commenced before 23 March 2016.</p> <p>INTA considers that there is no legal basis for continuing to apply the old law (Article 47 CTMR and Rules 29, 30 CTMIR) to renewals made after the entry into force of the Amending Regulation. Indeed, in the absence of any transitional provision, the law is meant to enter into force on the day prescribed in it. New provisions on renewals are not covered by any transitional period: Article 1 No. 45 (replacing Article 47 of the Regulation) and Article 2 No. 9 (deleting Title IV, i.e. Rules 29 and 30, from Regulation 2869/95) also enter into force 90 days from publication.</p> <p>The “basic six-month period for renewal” marks the six months prior to the due date for renewal but is not as such the “due time” for the renewal. The due time for the renewal is, under the old law, the end of the month during which the registration expires, and under the new law, the expiry date.</p> <p>There is no need for specific transitional provisions. Below are three examples to illustrate the consequences of the new law on the renewal of EU trademarks:</p> <p style="padding-left: 40px;">1). <u>The CTM expiry date is during Month 2, the CTM has to be renewed by the end of Month 2. The new law enters into force in Month 3.</u></p> <p>The law to be applied is the law in force at the date at which renewal is due, including the fees. Accordingly, the old law applies if the renewal is submitted and the fees are paid before the expiry date. If the EUTM is renewed during the six-month grace period following the due date for renewal (in our example: 29 February 2016), the fees initially owed plus a 25% surcharge are payable. This does not change if the late renewal request is filed after entry into force of the Amending Regulation: INTA considers “the fees” in Article 47(3) 3rd sentence EUTMR as meaning “the fees originally owed”, i.e. the fees under the old law in this example.</p> <p style="padding-left: 40px;">2). <u>The EUTM expiry date is after 23 March 2016</u></p>

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	<p>Here, the new law applies both to the date at which the renewal must be effected and as regards the fees payable. There is no basis in the law for applying the old law to the renewal made in this scenario. At the time the renewal is due, the old law will have been abolished, and the new law will have entered into effect. Renewal must be made by the date of expiry (not the end of the month). There is no legal basis for charging more than the new renewal fees. The only exception is provided in Article 47(3) of the new law: renewal requests made after the date of expiry, and within six months from that, are subject to a late renewal fee calculated on the basis of the fees as laid down in Annex I to the Amending Regulation.</p> <p>The only scenario that requires some adaptation is this one: 3). <u>The CTM expiry date is between 1 and 23 March 2016</u></p> <p>Here, the renewal is in theory due under the old law by the end of March. Under the new law, renewal would have been due at the date of expiry, but at that time, the new law was not yet in force.</p> <p>It is suggested that in this scenario, CTM / EUTM owners should be able to choose whether they wish to renew under the old or under the new law. The new law enters into force on 23 March 2016. So CTM owners are free to renew by submitting the request and paying the (old) fees by this date. After 23 March 2016, they can opt for “late renewal” – as under the new law renewal after the expiry date, even during the same month, is already late, and pay the (new) renewal fees plus a 25% surcharge. Normally, renewal fees will be lower even with the surcharge, so the Office is not to expect significant complaints about that – and the application of the new law would be (a) by the letter of the law and (b) smooth.</p> <p>In this way, the lack of transitional provisions in the Amending Regulation would be addressed in an appropriate, practical and legally compliant manner, rather than creating a cut-off date for which there is no basis in the law, as the current draft of the Guidelines do.</p> <p>If the current draft is put in practice, we anticipate that multiple law suits are likely to happen relating to the renewal charges levied by the Office.</p>
<p>Suggestion for text</p>	<p>None specifically. INTA recommends that the Office reconsider the draft Guidelines.</p>