

**CONTENTS**

- o *New adherence to the "international" trade mark system*
- e *Main provisions of the European Trade Mark Regulation*

**"International" trade mark system**  
**New adherences: Thailand and Cambodia**  
**To come: Indonesia**

The "international" trade mark system (**otherwise called "agreement and protocol system of Madrid"**) shall cover in the near future 116 countries, ensuring more than 80% of the global trade.

Regularly, new members join this system due to its very attractive nature. Thus, this month, **Thailand** and **Cambodia** adhered to the Madrid Union and **Indonesia** shall become, next January, the member number 100.

From then on, it is possible to designate these territories within an "international" trade mark, thanks to a registration or a prior designation at the World Intellectual Property Organization (WIPO).

The adherence of these territories is favorably welcomed by the trade mark holders who might, from now on, obtain local protection in exchange of lower costs compared with national trade mark registration at competent national offices.

It must be reminded that the Madrid System allows the trade mark holder to extend his/her protection in one or several member countries, under particularly interesting pricing conditions and in accordance with a unique registration procedure characterized by:

- . one registration of the trade mark designating one or several member countries,
- . a sole interlocutor,
- . a sole procedure language (choice of French, for example),
- . a sole request for designating several classes (multi-class registration),
- . a sole registration certificate,
- . a sole renewal request,
- . a sole registration request in case of change of name, address or holder.

With the implementation of such a system, a trade mark holder who would like to extend his/her rights, for example, in Germany, in China, in Australia and in the United States of America, should have registered his/her trade mark in each of these countries. The Madrid System helps avoiding such an inconvenience, by lessening the often complex related processes and allowing for a legal protection identical to a national trade mark registration.

The registration of an international trade mark is however conditioned by the prior existence of a basic trade mark (submitted or registered) in a state or a member organization of the Madrid System.

It is thus worth considering the use of the Madrid System after having submitted for registration or obtained the registration of a French mark or an identical mark of the European Union.

Each designated territory has at its disposal a maximum deadline ranging from twelve to eighteen months, starting with the international registration notification date, for examining the mark according to its own legislation. In a majority of countries, only the local council is authorized to intervene at its competent Office for answering to an objection. In this respect, the IPSIDE Cabinet shall refer to its privileged fellows network for helping you in these processes.

In case of exploitation of the trade mark on the European market, it could be strategically suitable to head directly towards the registration of a trade mark of the European Union, designating the 28 State Members of the European Union.



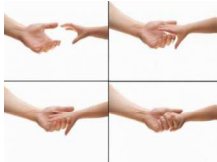


## The legislative reform package for the European Union trade mark



The second wave of modifications generated by the amended **European Trade Mark Regulation (EMR)** applies starting with October 1, 2017. In addition to the changes relative to the procedure rules in relation with the contradictions, the cancellations and the appeals, the main amendments for the deponents are the following:

- (i) introduction of the UE certification marks;
- (ii) elimination of the graphic representation requirement for the European trade marks.

In this respect, pursuant to Article 3 of the **European Trade Mark Regulation (EMR)**, [...]the mark should be permitted to be represented in any appropriate form using **generally available technology**, as long as the representation is **clear, precise, self-contained, easily accessible, intelligible, durable and objective** [...].

We are talking about a major evolution in terms of what shall be facilitated or accepted from now on with regard to the registration of the following types of trade marks next to the verbal and figurative trade marks:

*of form:	Previously called tridimensional mark, this mark consists in or extends to a tridimensional form, including the containers, the packaging, the product itself or its appearance.	
*sonorous:	by attaching an audio file reproducing the sound or by a reliable representation of the sound by musical score;	
*of movement:	mark that consists in or extends into a movement or change of positions of the mark elements. A video file or [...] a series of sequential fixed images indicating the movement or the change of position that could be numbered and supplied;	
* hologram:	mark composed of elements having holographic characteristics and the supply of a video file or a graphic or photographic reproduction containing the views necessary for the sufficient identification of the complete holographic effect shall be requested.	
* of position:	mark characterized by the specific way it is placed or affixed on a product.... We are talking about communicating a reproduction duly identifying the mark position and its dimension or proportion in relation to the concerned products. The elements that are not subject to the registration are "visually ignored,	

	preferably by the presence of discontinuous or dotted lines".	
<b>*de pattern:</b>	mark that consists exclusively in regularly repeated elements. The representation requires "a reproduction indicating the pattern repetition".	
<b>*of colors:</b>	mark formed of a sole color or a combination of colors without contour. A code of color is thus mandatory, such as Pantone, Hex, RAL, RGB or CMYK.	
<b>* multi media:</b>	mark consisting in or extending to a combination of image and sound and an audiovisual file including the image and sound combination must be supplied. For the moment, there is no registration of this type of the indexed trade marks, this is a novelty brought by the amended regulation.	

With regard to the olfactory trade marks, if the state of the art equipment allows registering odors with the help of "generally available technology" and by using category "Other" for this type of marks, the elimination of the graphic representation has no major impact on these requests.

Our legal experts are at your disposal for bringing you additional information that you need and we will certainly keep you informed with regard to the disputes that might appear pursuant to the application of these new provisions.

**B r n ce AUBERT**  
Consultant in Industrial Property



6 impasse Michel Labrousse  
31100 TOULOUSE  
Tel : 05 31 50 00 22

29 rue de Lisbonne  
75008 PARIS  
Tel : 01 80 40 08 02

7-9 All es Haussmann  
33300 BORDEAUX  
Tel : 05 33 10 00 20

4 rue du K rogan  
29330 QUIMPER  
Tel : 02 98 10 24 00

Business Center ACTIVA  
4 all e Catherine Bourbon  
64000 Pau  
Tel : 05 31 50 00 22

39 rue Grange Galand  
37554 St AVERTIN Cedex  
Tel : 02 40 80 49 15

14, rue Raoul Perp re  
Le Forum  
64100 Bayonne  
Tel : 05 59 15 29 25

Business Center SIAM  
81 rue de SIAM  
29200 BREST  
tel : 02 98 05 08 07