



INTELLECTUAL PROPERTY

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# European Court clears the path for staggered renewals of trade marks

by **lk-shields**

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In June 2016, in *Case C-207/15 ? Nissan Jidosha KK v EUIPO*, the Court of Justice of the European Union ("**CJEU**") ruled that partial renewal applications for European Union trade marks ("**EUTM**") may be staggered over time.

In the CJEU's opinion this position is in accordance with the principle of legal certainty and takes into consideration the economic importance of trade marks to their owners. The CJEU's decision makes it clear that where a trade mark owner applies to the European Union Intellectual Property Office ("**EUIPO**") to partially renew a EUTM for some of the classes the EUTM is registered for; the owner may make subsequent applications to the EUIPO to renew remaining classes up to final date allowed for renewals. This renewal window includes the additional six month "grace" period after the "initial" renewal deadline in which an EUTM owner can renew a trade mark for an additional fee.

Article 47 of *Council Regulation (EC) No. 207/2009 on the European Union trade mark* (as amended) ("**EUTMR**") is the legal basis for renewals of EUTMs. To arrive at its decision the CJEU embarked upon an analysis of the linguistic meaning of Article 47 of the EUTMR in several of the EU languages because no one language can take precedence in interpreting EU law. Following this semantic analysis of Article 47, the CJEU concluded that requests for renewal of a EUTM, staggered over time are not prohibited by Article 47 of the EUTMR.

This right is conditional only upon the payment of an additional fee to the EUIPO, which the CJEU ruled is the only distinguishing factor between renewal applications during the "initial" and "grace" periods. Article 47 (3) stipulates that there is an additional fee to the EUIPO's normal renewal fee for renewal applications made within the "grace" period. Currently this is a 25% surcharge in addition to the usual renewal fee of €50 per class for second and subsequent classes renewed.

The EUIPO is under an obligation to register a request for partial renewal of a EUTM during the "initial" period for renewal. Until the end of "grace" period, it may not remove any remaining classes of goods or services covered by the EUTM registration from the EUTM Register.

Overall, the CJEU's interpretation of the meaning of Article 47 of the EUTMR and its clarification of the EUIPO's obligations are to be welcomed. The CJEU's decision means that some owners of EUTMs may choose to stagger the renewal process by renewing some classes, and delay taking decisions on other classes until later in the renewal period.

**If you would like further information on this topic, please contact any member of our Intellectual Property, Technology and Privacy team at +353 1 661 0866.**

**About the Author**