

Seminar

Harmonization of the Law on Trademarks of the Republic of Serbia with the Directive (EU) of the European Parliament and Council 2015/2436 of 16 December 2015 on the approximation of the laws of the EU member states relating to trademarks

Belgrade (RS), 22-23 May 2019

organised for



Republic of Serbia
MINISTRY OF EUROPEAN INTEGRATION

Luxembourg Technical Assistance Programme for Serbia
“Strengthening Capacities to Implement EU Law”

This training is implemented with the support of the Luxembourg Government

Seminar Venue

Palace of Serbia, Bulevar Mihaila Pupina 2, Novi Beograd, room 470, RS-11000 Belgrade

Introduction

Target group

National public officials, lawyers and non-lawyers, legal profession practitioners and EU accession experts.

Description

This training aims at providing useful insight on the Directive (EU) of the European Parliament and Council 2015/2436, focusing on the substantial and procedural novelties introduced by this Directive. This training shall also deal with the opposition pursuant to the Directive, including substantive and procedural matters. At the end of this training, the participants shall gain an understanding of the novelties of the Directive. Furthermore, participants will be provided with the tools to deepen their knowledge outside the classroom. Finally, participants will gain an understanding of current issues in this area of law.

Method

The seminar is based on presentations introducing the key issues, complemented with practical case studies, maintaining an interactive environment and encouraging the active involvement of the participants.

Experts

Ms Océane Phan-Tan-Luu, Attorney-at-Law at the Marseille Bar Association (FR) Associate Lawyer ALPHALEX (EU)

Eirini Zaglanika, Attorney-at-Law at the Athens Bar Association (GR), Associate Lawyer at Potamitis Vekris, Athens

EIPA – European Centre for Judges and Lawyers

Dr. Roberta Ribeiro Oertel, Programme Leader, Lawyer, Researcher and Lecturer, r.oertel@eipa.eu

Juliette Mollicone-Boussuge, Programme Organiser, j.boussuge@eipa.eu

Programme

WEDNESDAY 22 MAY 2019

SUBSTANTIVE MATTERS

08.15 **Welcome and introduction to the programme**

Roberta Ribeiro Oertel

08.45 **Introduction to the trademark protection in the EU and to the Directive (EU) 2015/2436**

This session shall provide basic information regarding the dual system of protection in the EU and to the EU Trademark Reform Package, which led to the Directive (EU) 2015/2436. This session will also provide an overview of the amendments introduced by the Directive (EU) 2015/2436 and the objectives pursued by the Recast of the Directive 2008/95/EC.

Océane Phan-Tan-Luu

10.00 Coffee break

10.15 **Trademark Registration requirements & grounds for refusal**

This session aims to clarify the definition of a trademark under Directive (EU) 2015/2436. Special focus shall be given to the removal of the graphical representation requirement and to the introduction of new trademark types. This session shall deal with the absolute and relative grounds for refusal under the new trademark Directive.

Océane Phan-Tan-Luu

12.00 Lunch

13.00 **Rights conferred by a trademark; infringement and infringement defences**

This session shall analyze the rights conferred by a trademark, in light of the Directive (EU) 2015/2436. Special focus shall be given to the rights of a trademark holder to request detention of potentially infringing goods *in transit* as well as to the infringement acts under the new trademark Directive, including preparatory acts. This session shall also deal with the limitation of the effects of a trademark and infringement defences, including “own name defences” as well as exhaustion of the rights conferred by a trademark.

Océane Phan-Tan-Luu

14.45 Coffee break

15.00 **The requirement of Use throughout the Directive (EU) 2015/2436**

This session shall provide an in depth analysis of the requirement for “*use of trademarks*” throughout the Directive (EU) 2015/2436; it shall deal with the notion of “*substantive use*” and the “*non – use defences*” in infringement and invalidity proceedings.

Océane Phan-Tan-Luu

15.45 **End of the first day of the seminar**
Roberta Ribeiro Oertel

THURSDAY 23 MAY 2019

PROCEDURAL MATTERS

08.30 **Filing for a trademark under the Directive (EU) 2015/2436 and other procedural aspects: duration and renewal**

This session shall provide an analysis of the steps from filing towards registration of a trademark. Special focus shall be given to designation and classification of goods and services under Directive (EU) 2015/2436. In addition it shall also deal with the content of an application, division of applications and registration, the timing and formalities for renewals and the possibility to restore a trademark in case of failure to renew in due time.

Eirini Zaglanika

09.45 **Trademark as objects of property, licensing, transfer and rights in rem**

Directive (EU) 2015/2436 sets out rules applicable to trademarks as objects of property, including rules on assignment and transfer, licensing, rights in rem, and levy of execution. This session shall provide an analysis of the Trademark Directive rules in that respect. Special focus shall also be given to licensing, including legal action against the licensee in case of Infringement as well as taking action as a licensee.

Eirini Zaglanika

11.00 Coffee break

11.15 **Opposition pursuant to Directive (EU) 2015/2436 – Grounds of opposition**

This session shall focus on the substantive aspects and grounds of opposition under Directive (EU) 2015/2436. Special focus will be given to the new grounds of opposition introduced by the Directive.

Eirini Zaglanika

12.45 Lunch

13.30 **Opposition procedure pursuant to Directive (EU) 2015/2436 – Procedural Aspects**

This session shall focus on the opposition procedure. In particular, this session shall deal with procedural aspects of the opposition laid down in Directive (EU) 2015/2436. An analogy shall be drawn with the opposition procedure before EUIPO as laid down in Regulation (EU) 2017/1001 on the European Union trademark. This session shall also discuss and propose tools and solutions from other EU member States, which may render the opposition procedure efficient.

Océane Phan-Tan-Luu

15.00 Coffee break



15.15 **Revocation and declaration of invalidity**

This session shall focus on the procedures for revocation and invalidity. It will deal with matters such as the grounds for revocation and the grounds for invalidity, the persons entitled to request the revocation or the declaration of invalidity for a trademark. Special focus shall be given to the defences in proceedings seeking a declaration of invalidity and the results of revocation and invalidity.

Eirini Zaglanika

15.45 **End of the seminar**

Roberta Ribeiro Oertel