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Committee on the Internal Market and Consumer Protection

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DRAFT OPINION

of the Committee on the Internal Market and Consumer Protection

for the Committee on Legal Affairs

on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Recast) (COM(2013)0162 – C7-0088/2013 – 2013/0089(COD))

Rapporteur: Regina Bastos

PA_Legam

SHORT JUSTIFICATION

In the EU a trade mark can be registered either at national level, at a Member State's industrial property office (the Member States' laws on trade marks were partially harmonised by Council Directive 89/104/EEC of 21 December 1988, codified as Directive 2008/95/EC), or at EU level, as a Community trade mark (under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, codified as Regulation (EC) No 207/2009). The regulation also established the Office for Harmonization in the Internal Market (OHIM) to register and administer Community trade marks. This body of trade mark law has not undergone any major changes, whereas the business environment has been transformed.

Aim of the proposal

Given that the directive is based on Article 114 of the Treaty on the Functioning of the European Union (TFEU) – employed in order to adopt ‘measures for the approximation of the provisions laid down by law, regulation or administrative action in Member States which have as their object the establishment and functioning of the internal market’ – it deals with national trade mark systems, which continue to be necessary for those businesses that do not wish their trade marks to be protected at EU level.

The Commission's impact assessment has demonstrated the need to harmonise certain aspects of national procedures and lay down a system for cooperation between national offices and the OHIM.

In general terms, the review proposal submitted by the Commission on 27 March 2013 is designed to:

- modernise the trade mark system in Europe,
- reduce the inconsistencies within the existing regulatory framework, and
- improve cooperation among trade mark offices.

The idea is to help EU businesses become more competitive. To that end:

- trade mark protection systems are to be made cheaper, faster, more predictable, and hence more accessible to businesses;
- legal security is to be enhanced; and
- the EU system and national systems are to coexist within a complementary relationship.

As far as the recast directive is concerned, the Commission is seeking to:

- modernise and improve the existing provisions in order to provide greater legal certainty and clarify trade mark rights in terms of their scope and limitations;

- achieve greater approximation of national trade mark laws and procedures so as to make them more consistent with the Community trade mark system established under the regulation; and
- facilitate cooperation – on a legal basis to be established to that end – between the Member States' national offices and the OHIM with a view to promoting convergence of practices and developing common tools.

Internal market aspects

The Community trade mark and national trade marks have to exist alongside each other if the internal market is to function smoothly. A trade mark serves to distinguish the products and services offered by a company, which can consequently maintain its competitive position on the market by attracting customers and generating growth. The number of Community trade mark applications filed with the OHIM has continued to rise, reaching over 107 900 in 2012. Parallel to this trend, stakeholders have raised their expectations regarding the rationalisation and quality of trade mark registration systems, which they wish to be more coherent, accessible to the public, and technologically up to date.

On a more specific point, the new legislative package contains a number of provisions falling within the remit of the Committee on the Internal Market and Consumer Protection:

- a trade mark owner may prevent the use of its trade mark in any comparative advertising failing to satisfy the requirements of Article 4 of Directive 2006/114/EC of 12 December 2006 concerning misleading and comparative advertising;
- imports of goods into the EU may be prohibited even when the consignor alone is acting for commercial purposes (the object of this clarification is to discourage online orders and sales of counterfeit goods);
- right holders may prevent third parties from bringing goods from non-EU countries into Union customs territory, whether released for free circulation or otherwise, if these, without authorisation, bear a trade mark essentially identical to one registered in respect of goods of the same type.

The rapporteur's view

All in all, the rapporteur is satisfied with the Commission proposal, including the provisions directly relevant to the Committee on the Internal Market and Consumer Protection. The amendments tabled in the draft opinion

- strengthen the role of national authorities in the trade mark protection system and in combating counterfeiting;
- make a clarification regarding the signs of which a European trade mark may consist;
- address the absolute grounds for refusal or invalidity; and

- do away with the Commission proposal whereby the offices, when examining ex officio whether a trade mark application was eligible for registration, would in every case be called upon only to ascertain that there were no absolute grounds for refusal.

AMENDMENTS

The Committee on the Internal Market and Consumer Protection calls on the Committee on Legal Affairs, as the committee responsible, to incorporate the following amendments in its report:

Amendment 1

Proposal for a directive Recital 22

Text proposed by the Commission

(22) With the aim of strengthening trade mark protection and *combatting* counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is essentially identical to the trade mark registered in respect of such goods.

Amendment

(22) With the aim of strengthening trade mark protection and *combating* counterfeiting more effectively, the proprietor of a registered trade mark, ***assisted by the national authorities***, should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is essentially identical to the trade mark registered in respect of such goods.

Or. xm

Justification

The assistance of national authorities is necessary to make the prohibition enforceable.

Amendment 2

Proposal for a directive Recital 23

Text proposed by the Commission

(23) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the goods who acts for commercial purposes.

Amendment

(23) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor, ***assisted by the national authorities***, should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the goods who acts for commercial purposes.

Or. xm

Justification

The assistance of national authorities is necessary to make the prohibition enforceable.

Amendment 3

Proposal for a directive Recital 34

Text proposed by the Commission

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to European trade marks. ***With a view to achieving a consistent and balanced trade mark system both at national and Union level, all the central industrial property offices of the Member States should therefore limit their examination ex officio of whether a trade mark application is eligible for registration to the absence of absolute grounds for refusal only. This should, however, not prejudice the right of those offices to***

Amendment

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to European trade marks.

provide, upon request of applicants, searches for earlier rights on a purely informative basis and without any prejudice to or binding effect on the further registration process, including subsequent opposition proceedings.

Or. xm

Justification

Relative grounds for refusal should, where Member States so decide, continue to be a subject for ex officio examination, bearing in mind the advantages for trade mark applicants and SMEs in particular. At present there are 12 Member States making use of the above option (Bulgaria, the Czech Republic, Cyprus, Estonia, Finland, Greece, Ireland, Malta, Poland, Portugal, Slovakia, and Sweden).

Amendment 4

Proposal for a directive Article 3 – point b

Text proposed by the Commission

(b) being represented in a manner which enables the competent authorities and the public to determine the *precise* subject of the protection afforded to its proprietor.

Amendment

(b) being represented in a manner which enables the competent authorities and the public to determine *clearly and exactly* the subject of the protection afforded to its proprietor.

Or. xm

Justification

The object is to ensure that the constituent signs of a European trade mark are represented clearly and exactly.

Amendment 5

Proposal for a directive Article 4 – paragraph 5

Text proposed by the Commission

5. A trade mark shall not be refused

Amendment

5. A trade mark shall not be refused

registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, *before the date of application for registration or after the date of registration, and following the use which has been made of it*, it has acquired a distinctive character.

registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if it has acquired a distinctive character *at the time of registration*.

Or. xm

Justification

A trade mark has to have a distinctive character on the date of its registration.

Amendment 6

Proposal for a directive Article 4 – paragraph 6

Text proposed by the Commission

Amendment

6. Any Member State may provide that paragraph 5 shall also apply where the distinctive character was acquired after the date of application for registration and before the date of registration.

deleted

Or. xm

Justification

A trade mark has to have a distinctive character on the date of its registration.

Amendment 7

Proposal for a directive Article 10 – paragraph 5

Text proposed by the Commission

Amendment

5. The proprietor of a registered trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs

5. The proprietor of a registered trade mark, *assisted by the national authorities*, shall also be entitled to prevent all third parties from bringing goods, in the context

territory of the Member State where the trade mark is registered without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

of commercial activity, into the customs territory of the Member State where the trade mark is registered without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

Or. xm

Justification

The assistance of national authorities is necessary to make the prohibition enforceable.

Amendment 8

**Proposal for a directive
Article 31 – paragraph 1**

Text proposed by the Commission

1. An applicant for a collective mark shall submit the regulations governing its use.

Amendment

1. An applicant for a collective mark shall submit the regulations governing its use ***to the office.***

Or. xm

Justification

The aim is to clarify the text of the legislation and avert doubts as to where these regulations will have to be submitted.

Amendment 9

**Proposal for a directive
Article 41**

Text proposed by the Commission

The offices shall limit their examination ex officio of whether a trade mark

Amendment

deleted

application is eligible for registration to the absence of the absolute grounds for refusal provided for in Article 4.

Or. xm

Justification

Relative grounds for refusal should, where Member States so decide, continue to be a subject for ex officio examination, bearing in mind the advantages for trade mark applicants and SMEs in particular. At present there are 12 Member States making use of the above option (Bulgaria, the Czech Republic, Cyprus, Estonia, Finland, Greece, Ireland, Malta, Poland, Portugal, Slovakia, and Sweden).