



EUROPEAN PARLIAMENT

2009 - 2014

Committee on Legal Affairs

2013/0089(COD)

31.7.2013

*****I**

DRAFT REPORT

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))

Committee on Legal Affairs

Rapporteur: Cecilia Wikström

(Recast – Rule 87 of the Rules of Procedure)

PR\944364EN.doc

PE516.713v01-00

EN

United in diversity

EN

Symbols for procedures

- * Consultation procedure
- *** Consent procedure
- ***I Ordinary legislative procedure (first reading)
- ***II Ordinary legislative procedure (second reading)
- ***III Ordinary legislative procedure (third reading)

(The type of procedure depends on the legal basis proposed by the draft act.)

Amendments to a draft act

In amendments by Parliament, amendments to draft acts are highlighted in ***bold italics***. Highlighting in *normal italics* is an indication for the relevant departments showing parts of the draft act which may require correction when the final text is prepared – for instance, obvious errors or omissions in a language version. Suggested corrections of this kind are subject to the agreement of the departments concerned.

The heading for any amendment to an existing act that the draft act seeks to amend includes a third line identifying the existing act and a fourth line identifying the provision in that act that Parliament wishes to amend. Passages in an existing act that Parliament wishes to amend, but that the draft act has left unchanged, are highlighted in **bold**. Any deletions that Parliament wishes to make in such passages are indicated thus: [...].

CONTENTS

	Page
DRAFT EUROPEAN PARLIAMENT LEGISLATIVE RESOLUTION.....	5
EXPLANATORY STATEMENT.....	32

DRAFT EUROPEAN PARLIAMENT LEGISLATIVE RESOLUTION

**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))**

(Ordinary legislative procedure – recast)

The European Parliament,

- having regard to the Commission proposal to Parliament and the Council (COM(2013)0162),
 - having regard to Article 294(2) and Article 114 of the Treaty on the Functioning of the European Union, pursuant to which the Commission submitted the proposal to Parliament (C7-0088/2013),
 - having regard to Article 294(3) of the Treaty on the Functioning of the European Union,
 - having regard to the opinion of the European Economic and Social Committee of 11 July 2013¹,
 - having regard to the opinion of the European Data Protection Supervisor of 11 July 2013,
 - having regard to the Interinstitutional Agreement of 28 November 2001 on a more structured use of the recasting technique for legal acts²,
 - having regard to Rules 87 and 55 of its Rules of Procedure,
 - having regard to the report of the Committee on Legal Affairs and the opinions of the Committee on International Trade and the Committee on the Internal Market and Consumer Protection (A7-0000/2013),
- A. whereas, according to the Consultative Working Party of the legal services of the European Parliament, the Council and the Commission, the proposal in question does not include any substantive amendments other than those identified as such in the proposal and whereas, as regards the codification of the unchanged provisions of the earlier acts together with those amendments, the proposal contains a straightforward codification of the existing texts, without any change in their substance;
1. Adopts its position at first reading hereinafter set out, taking into account the recommendations of the Consultative Working Party of the legal services of the European Parliament, the Council and the Commission;
 2. Calls on the Commission to refer the matter to Parliament again if it intends to amend the proposal substantially or replace it with another text;

¹ Not yet published in the Official Journal.

² OJ C 77, 28.3.2002, p. 1.

3. Instructs its President to forward its position to the Council, the Commission and the national parliaments.

Amendment 1

Proposal for a directive

Recital 5

Text proposed by the Commission

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union, the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC. In doing so, the revision of the latter should include measures to make it more consistent with Regulation (EC) No 207/2009 and would thus reduce the areas of divergence within the trade mark system in Europe as a whole.

Amendment

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union, the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC. In doing so, the revision of the latter should include measures to make it more consistent with Regulation (EC) No 207/2009 and would thus reduce the areas of divergence within the trade mark system in Europe as a whole, ***while maintaining national trade mark protection as an attractive option for applicants. In this context, the complementary relationship between the European Union trade mark system and national trade mark systems should be ensured.***

Or. en

Justification

It is important to note the complementary nature of the national and Union protection of trade marks.

Amendment 2

Proposal for a directive

Recital 10

Text proposed by the Commission

(10) It is fundamental to ensure that

Amendment

(10) It is fundamental to ensure that

registered trade marks enjoy the same protection under the legal systems of all the Member States, and that the protection of trade marks at the national level is the same as the protection of European trade marks. In line with the extensive protection granted to European trade marks which have a reputation in the Union, extensive protection should also be granted at national level to all registered trade marks which have a reputation in the Member State concerned.

registered trade marks enjoy the same protection under the legal systems of all the Member States, and that the protection of trade marks at the national level is the same as the protection of European **Union** trade marks. In line with the extensive protection granted to European **Union** trade marks which have a reputation in the Union, extensive protection should also be granted at national level to all registered trade marks which have a reputation in the Member State concerned.

(This amendment applies throughout the text. Adopting it will necessitate corresponding changes throughout.)

Or. en

Justification

Change to reflect the amended designation suggested in the framework of the Regulation.

Amendment 3

Proposal for a directive Recital 13

Text proposed by the Commission

(13) To this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfil the objectives of the registration system for trade marks, which are to ensure legal certainty and sound administration, it is also essential to require that the sign **is** capable of being represented in a manner which allows for a precise determination of the subject of protection. A sign should therefore be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the representation offers satisfactory

Amendment

(13) To this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfil the objectives of the registration system for trade marks, which are to ensure legal certainty and sound administration, it is also essential to require that the sign **be** capable of being represented **in the register** in a manner which allows for a precise determination of the subject of protection. A sign should therefore be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the representation **uses generally**

guarantees to that effect.

available technology and offers
satisfactory guarantees to that effect.

Or. en

Justification

It should be specified that the representation can be in any form so long as it uses generally available technology.

Amendment 4

Proposal for a directive
Recital 19

Text proposed by the Commission

Amendment

(19) In order to ensure legal certainty and clarity, it is necessary to clarify that not only in the case of similarity but also in case of an identical sign being used for identical goods or services, protection should be granted to a trade mark only if and to the extent that the main function of the trade mark, which is to guarantee the commercial origin of the goods or services, is adversely affected.

deleted

Or. en

Justification

Deletion due to deletion in Article 10

Amendment 5

Proposal for a directive
Recital 22

Text proposed by the Commission

Amendment

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should

(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.

be entitled to prevent third parties from bringing **counterfeit** 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 **authorisation** a trade mark which is essentially identical to the trade mark registered in respect of such goods. ***In order not to hamper legitimate flows of goods, this rule should only apply if the proprietor of a trade mark is able to show that the trade mark is validly registered also in the country of destination. This rule should be without prejudice to the Union's right to promote access to medicines for third countries.***

Or. en

Justification

The change is needed to align with the amendment on Article 10 (5)

Amendment 6

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 **counterfeit** 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 **counterfeit** goods who acts for commercial purposes.

Or. en

Justification

The change is needed to align with the amendment on Article 10 (4)

Amendment 7

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 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.

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. With a view to achieving a consistent and balanced trade mark system *at* both 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 *not*, however, prejudice the right of those offices to provide, *ex officio or upon request*, searches for earlier rights *as well as notifications to proprietors of 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. en

Justification

This proposal includes a clarification as well as a substantial change and should be read together with Article 41. Although the ex officio examination on relative grounds should be abolished it would be reasonable to allow offices to provide applicants with searches and proprietors of earlier rights with notifications, also ex officio and not only upon request. These searches and notifications should however be purely informative and without effect on the registration process.

Amendment 8

Proposal for a directive Citation 1

Text proposed by the Commission

Having regard to the Treaty on the Functioning of the European Union, and in particular Article 114 thereof,

Amendment

Having regard to the Treaty on the Functioning of the European Union, and in particular Article 114(**I**) thereof,

Or. en

Justification

The full legal basis should be referred to.

Amendment 9

Proposal for a directive Article 1

Text proposed by the Commission

This Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application ***in a Member State*** for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.

Amendment

This Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application for registration ***in a Member State*** as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.

Or. en

Justification

In order to clarify that the terms "in a Member State" refer to both registration and application for registration, they need to be moved.

Amendment 10

Proposal for a directive Article 2 – point b

Text proposed by the Commission

(b) ‘Agency’ means the European Union **Trade Marks and Designs** Agency established in accordance with Article 2 of Regulation (EC) No 207/2009;

Amendment

(b) ‘Agency’ means the European Union **Intellectual Property** Agency established in accordance with Article 2 of Regulation (EC) No 207/2009;

(This amendment applies throughout the text. Adopting it will necessitate corresponding changes throughout.)

Or. en

Justification

Change to reflect the amended name of the Agency.

Amendment 11

Proposal for a directive Article 2 – point ca

(ca) ‘earlier trade marks’ means:

(i) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

– European Union trade marks;

– trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Office for Intellectual Property;

– trade marks registered under international arrangements which have effect in the Member State;

(ii) European trade marks which validly claim seniority, in accordance with Regulation (EC) No 207/2009, from a trade mark referred to in the second and third indents of point (i), even when the latter trade mark has been surrendered or allowed to lapse;

(iii) applications for the trade marks referred to in points (i) and (ii), subject to their registration;

(iv) trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well known in a Member State, in the sense in which the words ‘well known’ are used in Article 6 bis of the Paris Convention.

Or. en

Justification

This is a technical change. In the interest of a well-structured text, the definition contained in the proposed Article 5(2) is moved to Article 2 on definitions.

Amendment 12

Proposal for a directive Article 2 – point cb (new)

Text proposed by the Commission

Amendment

(cb) ‘guarantee or certification mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of geographical origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods and services which are not so certified;

Or. en

Justification

This is a technical change. In the interest of a well-structured text, the definitions contained in the proposed Article 28 are moved to Article 2 on definitions.

Amendment 13

Proposal for a directive Article 2 – point cc (new)

Text proposed by the Commission

Amendment

cc) ‘collective mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of an association which is the proprietor of the mark from the goods or services of other undertakings.

Justification

This is a technical change. In the interest of a well-structured text, the definitions contained in the proposed Article 28 are moved to Article 2 on definitions.

Amendment 14

Proposal for a directive
Article 3 – point a

Text proposed by the Commission

(a) distinguishing the goods or services of one undertaking from those of other undertakings;

Amendment

(a) distinguishing the goods or services of one undertaking from those of other undertakings; **and**

Or. en

Justification

It should be made clear that both of the conditions in points a and b have to be fulfilled.

Amendment 15

Proposal for a directive
Article 3 – paragraph 1 – 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 **the register in** a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.

Or. en

Justification

A trade mark should be able to be represented not just in general but in a register that is accessible to others in order to provide legal clarity.

Amendment 16

Proposal for a directive

Article 4 – paragraph 1 – point j a (new)

Text proposed by the Commission

Amendment

(ja) trade marks which contain or consist of an earlier variety denomination registered in accordance with Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights¹ with respect to the same type of product.

¹ OJ L 227, 1.9.1994, p. 1.

Or. en

Justification

The proposed amendment to the trade mark regulation now stipulates in Article 7(1)(l) that plant variety rights are absolute grounds for refusal. This rule is not included in the Directive but it would seem appropriate to mirror the Regulation..

Amendment 17

Proposal for a directive

Article 4 – paragraph 2

Text proposed by the Commission

Amendment

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain:

deleted

(a) in other Member States than those where the application for registration was filed;

(b) only where a trade mark in a foreign language is translated or transcribed in any script or official language of the Member States.

Or. en

Justification

It would be disproportionate and practically unworkable to require national offices to examine absolute grounds for refusal in all national jurisdictions and languages of the Union. It would further run contrary to the principle of territoriality of rights. For users there would be little or no added value to have the application examined for obstacles to registration in other territories than the one for which it would be valid for.

Amendment 18

Proposal for a directive

Article 5 – paragraph 2

Text proposed by the Commission

Amendment

2. ‘Earlier trade marks’ within the meaning of paragraph 1 means: **deleted**

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;

(i) European trade marks;

(ii) trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Office for Intellectual Property;

(iii) trade marks registered under international arrangements which have effect in the Member State;

(b) European trade marks which validly claim seniority, in accordance with Regulation (EC) No 207/2009, from a trade mark referred to in points (a)(ii) and (iii), even when the latter trade mark has been surrendered or allowed to lapse;

(c) applications for the trade marks referred to in points (a) and (b), subject to their registration;

(d) trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the

priority claimed in respect of the application for registration of the trade mark, are well known in a Member State, in the sense in which the words ‘well known’ are used in Article 6 bis of the Paris Convention.

Or. en

Justification

This is a technical change. In the interest of a well-structured text, the definition contained in the proposed Article 5(2) is moved to Article 2 on definitions.

Amendment 19

Proposal for a directive

Article 5 – paragraph 3 – point a

Text proposed by the Commission

(a) if it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in *a* Member State or, in case of a European trade mark, has a reputation in the Union and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

Amendment

(a) if it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in **the** Member State ***in respect of which registration is applied for or in which the trade mark is registered*** or, in **the** case of a European **Union** trade mark, has a reputation in the Union and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

Or. en

Justification

There seems to be a drafting error as the provision is not compatible with the provision in Art. 10(2)(c). The drafting would have implied that a mark with a reputation in another Member State would have been an obstacle for a mark in the Member State in respect of

which registration is applied for (even if this mark did not have a reputation in that Member State). This amendment clarifies that there is only an obstacle due to reputation of national marks within the same Member State.

Amendment 20

Proposal for a directive Article 5 – paragraph 5

Text proposed by the Commission

5. The Member States **may** permit that in appropriate circumstances registration need not be refused or the trade mark need not be declared invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.

Amendment

5. The Member States **shall** permit that in appropriate circumstances registration need not be refused or the trade mark need not be declared invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.

Or. en

Justification

It would seem reasonable to allow for a registration based on the lack of a relative ground for refusal if the proprietor of an earlier right consents to the registration of the mark. It would not seem necessary for this provision to be optional for member states.

Amendment 21

Proposal for a directive Article 8 – point c

Text proposed by the Commission

(c) where the application for a declaration of invalidity is based on Article 5(3) and the earlier trade mark did not have a reputation within the meaning of Article 5(3) at the filing date or the priority date of the registered trade mark.

Amendment

(c) where the application for a declaration of invalidity is based on **point (a) of** Article 5(3) and the earlier trade mark did not have a reputation within the meaning of **point (a) of** Article 5(3) at the filing date or the priority date of the registered trade mark.

Or. en

Justification

As this point concerns the reputation of a trade mark, only point (a) of Article 5(3) should be referred to.

Amendment 22

Proposal for a directive Article 9 – paragraph 1

Text proposed by the Commission

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) and (3) has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.

Amendment

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) **and point (a) of Article 5(3)** has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.

Or. en

Justification

Only point (a) of Article 5(3) should be referred to because the earlier trade marks with a reputation are referred to.

Amendment 23

Proposal for a directive Article 10 – paragraph 2 – point a

Text proposed by the Commission

(a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered **and where such use affects or is liable to affect the function of the trade mark to guarantee to**

Amendment

(a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered;

consumers the origin of the goods or services ;

Or. en

Justification

Although the proposal by the Commission intends to create clarity it seems rather to create increased legal uncertainty.

Amendment 24

**Proposal for a directive
Article 10 – paragraph 4**

Text proposed by the Commission

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing of goods ***pursuant to paragraph 3(c)*** where only the consignor of the goods acts for commercial purposes.

Amendment

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing of goods where only the consignor of the goods acts for commercial purposes ***and where such goods, including packaging, bear without authorisation 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. en

Justification

Although counterfeiting should be opposed the proposed provision goes to far as it also covers the importation by individual citizens of goods that have been legitimately placed on the market outside of the EU. The provision should be limited to counterfeit goods.

Amendment 25

**Proposal for a directive
Article 10 – paragraph 5**

Text proposed by the Commission

5. The proprietor of a registered trade mark shall also be entitled to prevent all third

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 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.

parties from bringing goods, in the context 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 **a** third **country** and bear without **authorisation** a trade mark which is identical to the trade mark **validly** registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark, **on condition that the proprietor proves that the trade mark is also validly registered in the country of destination.**

Or. en

Justification

Although it is important to take measures against counterfeiting the commission proposal on goods in transit goes too far in that it would limit legitimate international trade. It should thus be up to the proprietor of a registered trade mark to provide evidence that the trade mark is also validly registered in the country of destination.

Amendment 26

Proposal for a directive Article 11 – point a

Text proposed by the Commission

(a) affixing in the course of trade a sign identical with or similar to the trade mark on **get-up, packaging or** other means on which the mark may be affixed;

Amendment

(a) affixing in the course of trade a sign identical with or similar to the trade mark on **packaging, labels, tags, security features, authenticity devices or any** other means on which the mark may be affixed.

Or. en

Justification

The term "get-up" used in this provision is a legal term of art not applicable in all EU jurisdictions. In order to increase the effectiveness of the provision, the wording used to describe the labels, packaging and other items should be clarified to ensure that the more

common packaging elements and components used by counterfeiters are comprised in the provision.

Amendment 27

Proposal for a directive Article 11 – point b

Text proposed by the Commission

(b) offering or placing on the market, or stocking for those purposes, or importing or exporting ***get-up, packaging or*** other means on which the mark is affixed.

Amendment

(b) offering or placing on the market, or stocking for those purposes, or importing or exporting, ***packaging, labels, tags, security features, authenticity devices or any*** other means on which the mark is affixed.

Or. en

Justification

The term "get-up" used in this provision is a legal term of art not applicable in all EU jurisdictions. In order to increase the effectiveness of the provision, the wording used to describe the labels, packaging and other items should be clarified to ensure that the more common packaging elements and components used by counterfeiters are comprised in the provision.

Amendment 28

Proposal for a directive Article 16 – paragraph 3 a (new)

Text proposed by the Commission

Amendment

3a. The date of commencement of the period of five years referred to in paragraphs 1, 2 and 3 shall be entered in the register.

Or. en

Justification

The different ways of calculating the start date for the five year period imply a problem for other users to determine the duration of this period. Entering the starting date into the

register would give users easy access to this information.

Amendment 29

Proposal for a directive Article 22 – paragraph 3

Text proposed by the Commission

Amendment

3. Without prejudice to paragraph 2, an assignment of the trade mark shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

deleted

Or. en

Justification

There is no need or added value from having a requirement regarding the form of the assignment of the trade mark. It would intrude on the liberty of parties to freely choose the form in which they wish to conclude these arrangements. Even though in practice this will likely be the common way to proceed it could notably imply an unnecessary impediment in electronic commerce. Detailed form requirements for property transfers are also very uncommon in many member states national legislation.

Amendment 30

Proposal for a directive Article 22 – paragraph 4

Text proposed by the Commission

Amendment

4. On request of one of the parties a transfer shall be entered in the register and published.

4. On request of one of the parties a transfer shall be entered in the register and published, *if the requesting party has provided documentary evidence of the transfer to the office.*

Or. en

Justification

It would seem reasonable to allow the office to demand some type of documentation.

Amendment 31

Proposal for a directive Article 22 – paragraph 5

Text proposed by the Commission

5. As long as the transfer has not been ***entered in the register***, the successor in title may not invoke the rights arising from the registration of the trade mark against third parties.

Amendment

5. As long as the ***application for registration of the*** transfer has not been ***received by the office***, the successor in title may not invoke the rights arising from the registration of the trade mark against third parties.

Or. en

Justification

It would not seem appropriate that the new proprietor of the trade mark becomes dependant on the speed at which the trade mark office will enter the transfer in the register. Following the acquisition of the trade mark rights and the filing of a corresponding application with the trade mark office, the new proprietor of the trade mark should be able to assert its rights against third parties as well.

Amendment 32

Proposal for a directive Article 28 – point c

Text proposed by the Commission

Amendment

Article 28

deleted

Definitions

For the purposes of this section, the following shall apply:

(1) ‘Guarantee or certification mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of geographical origin, material, mode of manufacture of goods or performance of

services, quality, accuracy or other characteristics from goods and services which are not so certified;

(2) ‘Collective mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of an association which is the proprietor of the mark from the goods or services of other undertakings.

Or. en

Justification

This is a technical change. In the interest of a well-structured text, the definitions contained in the proposed Article 28 are moved to Article 2 on definitions.

Amendment 33

Proposal for a directive Article 40 – paragraph 6

Text proposed by the Commission

6. Where the applicant requests registration for more than one class, the ***goods and services shall be grouped*** according to the classes of the Nice classification, each group being preceded by the number of the class to which that group of goods or services belongs and ***presented*** in the order of the classes.

Amendment

6. Where the applicant requests registration for more than one class, the ***applicant shall group the goods and services*** according to the classes of the Nice classification, each group being preceded by the number of the class to which that group of goods or services belongs, and ***shall present them*** in the order of the classes.

Or. en

Justification

Clarification that it is up to the applicant and not the office to group the goods and services according to classes.

Amendment 34

Proposal for a directive Article 41

Text proposed by the Commission

The offices shall limit their examination ex officio of whether a trade mark application is eligible for registration to the absence of the absolute grounds for refusal provided for in Article 4.

Amendment

The offices shall limit their examination ex officio of whether a trade mark application is eligible for registration to the absence of the absolute grounds for refusal provided for in Article 4. ***This provision shall be without prejudice to the possibility for offices to provide searches and notifications with regard to earlier rights on a purely informative basis and provided that such searches and notifications have no binding effect on the further registration process, including on subsequent opposition proceedings.***

Or. en

Justification

This proposal includes a clarification as well as a substantial change and should be read together with Recital 34. Although the ex officio examination on relative grounds should be abolished it would be reasonable to allow offices to provide applicants with searches and proprietors of earlier rights with notifications, also ex officio and not only upon request. These searches and notifications should however be purely informative and without effect on the registration process.

Amendment 35

Proposal for a directive Article 45 – paragraph 2

Text proposed by the Commission

2. The administrative procedure referred to in paragraph 1 shall provide that at least the proprietor of an earlier right referred to in Article 5(2) and (3) shall be able to file a notice of opposition.

Amendment

2. The administrative procedure referred to in paragraph 1 shall provide that at least the proprietor of an earlier right referred to in Article 5(2) and ***point (a) of Article 5(3)*** shall be able to file a notice of opposition. ***A notice of opposition may be filed on the basis of one or more earlier rights, provided they all belong to the same***

proprietor, and on the basis of part or the totality of the goods or services in respect of which the earlier right is registered or applied for, and may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.

Or. en

Justification

There is a need to harmonise national opposition procedures due to the fact that some Member States allow oppositions based on several earlier marks while others request oppositions based on only one earlier mark. Similarly, in certain Member States oppositions may be based on only one of the classes for which the earlier mark is registered, while in others an opposition may be based on all classes covered by the earlier mark(s) and directed against all the classes covered by the contested mark. This forces the opponent to file several oppositions, with increased fees, costs and administrative burden. Furthermore, when oppositions directed against the same mark and/or based on several earlier marks are assigned to different examiners, the risk exists that contradictory decisions are taken. The harmonisation would have the further advantage of having one and the same procedure both at national and European level, thus facilitating the comprehension of the different systems by owners and representatives disseminated throughout Europe. As regards the reference, only point (a) of Article 5(3) should be referred to because the earlier trade marks with a reputation are referred to.

Amendment 36

Proposal for a directive Article 47 – paragraph 1

Text proposed by the Commission

1. Member States shall provide for an administrative procedure before their offices for revocation or declaration of invalidity of a trade mark.

Amendment

1. Member States shall provide for an ***efficient and expeditious*** administrative procedure before their offices for revocation or declaration of invalidity of a trade mark.

Or. en

Justification

This small change mirrors the provision in article 45 that calls for "efficient and expeditious

administrative procedures..."

Amendment 37

Proposal for a directive

Article 47 – paragraph 4 a (new)

Text proposed by the Commission

Amendment

4a. An application for revocation or for a declaration of invalidity may be directed against part or the totality of the goods or services in respect of which the contested mark is registered.

Or. en

Justification

The proposal of the Commission obliges Member States to provide for an administrative procedure to challenge the validity of a trade mark registration before their offices. In order to increase effectiveness of national cancellation procedures, to align them with European cancellation procedures, reduce fees, costs and administrative burden, it is proposed that an application for revocation may be directed against part or the totality of the goods or services covered by the contested mark. This way, Member States will not be allowed to make cancellation administrative actions conditional upon the fact that they are directed only against one class of the contested mark.

Amendment 38

Proposal for a directive

Article 47 – paragraph 4 b (new)

Text proposed by the Commission

Amendment

4b. An application for a declaration of invalidity may be filed on the basis of one or more earlier rights, provided they all belong to the same proprietor.

Or. en

Justification

The proposal of the Commission obliges Member States to provide for an administrative

procedure to challenge the validity of a trade mark registration before their offices. In order to increase effectiveness of national cancellation procedures, to align them with European cancellation procedures, reduce fees, costs and administrative burden, it is proposed that an application for revocation may be directed against one or more earlier right, as well as on part or the totality of the goods or services covered by the earlier right. This way, Member States will not be allowed to make cancellation administrative actions conditional upon the fact that they are based only on one earlier right.

Amendment 39

Proposal for a directive Article 48 – paragraph 1

Text proposed by the Commission

1. In **administrative** proceedings for a declaration of invalidity based on a registered trade mark with an earlier filing date or priority date, if the proprietor of the later trade mark so requests, the proprietor of the earlier trade mark shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use as provided for in Article 16 in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided that the period of five years within which the earlier trade mark must have been put to genuine use has expired at the date of the application for a declaration of invalidity.

Amendment

1. In proceedings for a declaration of invalidity based on a registered trade mark with an earlier filing date or priority date, if the proprietor of the later trade mark so requests, the proprietor of the earlier trade mark shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use as provided for in Article 16 in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided that the period of five years within which the earlier trade mark must have been put to genuine use has expired at the date of the application for a declaration of invalidity.

Or. en

Justification

The amendment seeks to clarify that the grounds of non-use of a trade mark can be applied either in an administrative procedure or in a court proceeding.

Amendment 40

Proposal for a directive

Chapter 3 – section 3 a (new) – Article 51 a (new)

Text proposed by the Commission

Amendment

SECTION 3a

COMMUNICATION WITH THE OFFICE

Article 51 a

Communication with the office

***Parties to the proceedings or, where
appointed, their representatives, shall
designate an official address within one of
the Member States for all official
communication with the office***

Or. en

Justification

The practice of some Member States to require an address of service in their country for notifications from the office is an unnecessary source of delays and costs, consequent to the need to identify, appoint and pay a local representative. Such a cumbersome practice may be a deterrent to filing national trade marks and work against a balance between the unitary and national tiers of the global European trade mark system.

EXPLANATORY STATEMENT

The long-awaited proposal for a review of the trade mark system in Europe was presented by the Commission in late March 2013 after having worked on the proposal over a period of several years. Your rapporteur is committed to working hard in order to adopt these proposals during the current legislature but wants to remind that the limited time available will not make this an easy task. The quality of the legislative process can not be compromised with and the opportunity that this revision presents to modernise the trade mark system in Europe should not be lost in order to arrive at an expedient agreement between the institutions. Nevertheless your rapporteur has received broad support in the committee for legal affairs for an ambitious time table. The limited time that has been available to draft this report in the light of this time table will imply that this report covers most of the main issues where your rapporteur finds that there is need to amend the commission proposal. However, your rapporteur reserves the right to come back with additional amendments and proposals on topics that have not been included in this report.

Summary and introduction

The directive harmonising certain aspects of trade mark law of the Member States of the European Union has existed for over 20 years. The present review provides an opportunity to learn from best practices and further strengthen the harmonizing aspects of substantive trade mark law and procedures used by national trade mark offices.

Your rapporteur wants to make clear from the start that this review should have as its foremost guiding principle the preservation and strengthening of the dual-level system of trade mark protection in Europe. The business community in the European Union consists of over 20 million companies with vastly differing needs. The trade mark system should be simple and flexible enough to give the users of the system access to a protection that suits their needs.

Some users want to seek the protection only in one Member State whilst some want to seek unitary protection in the 28 member states of the Union. It should however be noted that there are also many users that depend on using the national system for protection in several different Member States. This could for example be the case for users that are not able to get an EU trade mark because of prior existing rights in one or several Member States. It could also be the very conscious choice of a company active in a small number of countries or in a border region.

In order to assist these users which are relying on the services of multiple national offices for their protection it is reasonable to harmonize procedures so that the users are not forced to deal with completely different procedural approaches in the different Member States where they wish to seek protection. Although the fees, notably at OHIM, make up an important component of the choice of strategy for where a trade mark is registered, there are many other factors at play as well.

The focus on implementing best practices for procedures and substantive law should be to make national trade mark systems more attractive for users. For this reason it would also be reasonable to harmonize a number of additional procedural aspects that would improve the

situation for users protecting their trade marks in multiple national offices.

Whilst having a generally positive outlook on harmonization it also has to be noted that some of the proposals of the Commission go too far in that they disregard the territorial nature of the protection offered. Other proposals need clarifications to ensure that important features, notably to SMEs, are preserved.

Examination of absolute grounds, Article 4(2)

This is the most obvious case where the proposal from the Commission goes too far and your rapporteur suggests deleting this provision in its entirety. The results of keeping this provision would be that the examination before a national office would be no different from the examination before the Agency. As the right awarded by a national office only concerns the territory of that Member State it would not be appropriate to require examination on absolute grounds with respect to territories which will not be covered by the trade mark anyway.

Ex officio examination of relative grounds

A number of national offices in the European Union still perform ex officio examinations of relative grounds. The Commission has presented a good case underlining the complications that this procedure entails for applicants of the system, due for example to considerable delays. It should however be noted that many offices that have abolished the ex officio examination of relative grounds still provide (ex officio) their applicants with searches and search results with regards to earlier rights as well as notifications to proprietors of earlier rights of applications that may conflict with their rights. Your rapporteur considers it perfectly possible to preserve the option for national offices to provide this examination, and combine it with the well founded proposal by the Commission to not let these examinations block the application procedure for the applicant.

Enforcement measures

The Commission has proposed to introduce a provision on imports where only the consignor acts for commercial purposes and where the recipient is for example an individual citizen. Given the need to stop counterfeits the provision is welcome but it should be limited to counterfeit products.

The Commission has further proposed a provision on goods in transit. Although there is a need to stop counterfeit products entering the European internal market the proposal would also hamper legitimate international trade. Your rapporteur would thus suggest a number of changes in order to ensure a more balanced proposal.

Administrative simplification

In the view of your rapporteur there would still be room for additional proposals to strengthen the attractiveness of the national trade mark system by simplifying some procedural rules. Parties to a proceeding before a national office should for instance not be forced to designate an official address within this Member State.