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2009 - 2014

Committee on Legal Affairs

2013/0089(COD)

30.10.2013

AMENDMENTS

41 - 106

Draft report
Cecilia Wikström
(PE516.713v01-00)

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)

(Recast – Rule 87 of the Rules of Procedure)

Proposal for a directive
(COM(2013)0162 – C7-0088/2013 – 2013/0089(COD))

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Amendment 41
Sajjad Karim

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 guarantees to that effect.

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 is capable of being represented in a manner which ***is clear, precise, self-contained, easily accessible, durable and objective***. 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 guarantees to that effect.

Or. en

Justification

The intention of the change is to reflect the jurisprudence of the Court, following the Sieckmann judgement.

Amendment 42
Marielle Gallo

Proposal for a directive
Recital 13

Text proposed by the Commission

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Amendment

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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 ***uses freely available technology and*** offers satisfactory guarantees to that effect.

Or. en

Amendment 43
Marielle Gallo

Proposal for a directive
Recital 19

Text proposed by the Commission

(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.

Amendment

deleted

Or. en

Amendment 44
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a directive
Recital 19

Text proposed by the Commission

(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.

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. ***When determining whether a trade mark is adversely affected, it is necessary to interpret this provision in the light of Article 11 of the Charter of Fundamental Rights of the European Union and Article 10 of the European Convention on Human Rights in order to guarantee the fundamental right of freedom of expression.***

Or. en

Amendment 45
Pier Antonio Panzeri, Bernhard Rapkay

Proposal for a directive
Recital 19

Text proposed by the Commission

(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.

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 is adversely affected.

Or. en

Amendment 46

Pier Antonio Panzeri, Bernhard Rapkay

Proposal for a directive

Recital 19 a (new)

Text proposed by the Commission

Amendment

(19a) The main function of a trademark is to guarantee the origin of the product to the consumer or final user by enabling him or her to distinguish without any possibility of confusion between that product and products which have another origin.

Or. en

Amendment 47

Pier Antonio Panzeri

Proposal for a directive

Recital 19 b (new)

Text proposed by the Commission

Amendment

(19b) When determining whether the main function of a trade mark is adversely affected, it is necessary to interpret this provision in the light of Article 11 of the Charter of Fundamental Rights of the European Union and Article 10 of the European Convention on Human Rights in order to guarantee the fundamental right of freedom of expression.

Or. en

Amendment 48

Christian Engström

on behalf of the Greens/EFA Group

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 combatting counterfeiting more effectively, the proprietor of a registered **European** 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 **Union** without being released for free circulation there, where such goods, **including packaging**, come from **a** third **country** and bear without authorization a trade mark which is essentially identical to the **European** trade mark **validly** registered in respect of such goods **and which cannot be distinguished in its essential aspects from that trade mark. In order not to hamper the production, circulation and distribution of legitimate goods, this rule should only apply if the proprietor of the trade mark is able to demonstrate clear and documented evidence of a substantial risk of fraudulent diversion of the allegedly counterfeit goods into a Member State. The European Commission shall develop and implement guidelines for national customs authorities with clear indicators on how to establish such substantial risk of fraudulent diversion. The list of clear indicators shall reflect the importance of unrestricted trade in, inter alia, generic medicines, and shall be in line with prevailing CJEU case law.**

Or. en

Amendment 49
Bernhard Rapkay

Proposal for a directive
Recital 22

Text proposed by the Commission

(22) Um den Markenschutz zu stärken und wirksamer gegen Produktpiraterie vorzugehen, sollte der Inhaber einer eingetragenen Marke Dritten verbieten können, aus Drittstaaten stammende Waren, auf denen ohne Zustimmung des Markeninhabers eine Marke angebracht ist, die im Wesentlichen mit der für derartige Waren eingetragenen Marke identisch ist, in das Zollgebiet der Mitgliedstaaten zu verbringen, auch wenn sie dort nicht in den zollrechtlich freien Verkehr übergeführt werden.

Amendment

(22) Um den Markenschutz zu stärken und wirksamer gegen Produktpiraterie vorzugehen, sollte der Inhaber einer eingetragenen Marke Dritten verbieten können, aus Drittstaaten stammende Waren, auf denen ohne Zustimmung des Markeninhabers eine Marke angebracht ist, die im Wesentlichen mit der für derartige Waren eingetragenen Marke identisch ist, in das Zollgebiet der Mitgliedstaaten zu verbringen, auch wenn sie dort nicht in den zollrechtlich freien Verkehr übergeführt werden. ***Die Einhaltung der WTO-Regeln durch die Union, insbesondere von Artikel V des GATT zur Freiheit der Durchfuhr, bleiben hiervon unberührt.***

Or. de

Amendment 50

Christian Engström

on behalf of the Greens/EFA Group

Proposal for a directive

Recital 22 a (new)

Text proposed by the Commission

Amendment

(22a) Recognising that the main public health concern lies with the quality of the medicines and not with trade mark or other intellectual property enforcement and should be addressed by other measures, including regulation aimed at improving quality standards.

Or. en

Amendment 51

Christian Engström

on behalf of the Greens/EFA Group

Proposal for a directive
Recital 23

Text proposed by the Commission

Amendment

(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. **deleted**

Or. en

Justification

Through clever wording and the doctrine of regional exhaustion, this text, together with its article, tries to restrict parallel imports. It may make it impossible for private individuals to buy completely legitimate goods, if they do this over the internet and from third countries. This affects not only counterfeits but completely legitimate originals as well: EU citizens would be forbidden to buy certain things over the internet, simply because they do this from, for example, a web shop in the US. Putting up such artificial barriers to trade through trade marks makes no economic sense.

Amendment 52
Evelyn Regner

Proposal for a directive
Recital 23

Text proposed by the Commission

Amendment

(23) Um der Einfuhr rechtsverletzender Waren, insbesondere bei Internetverkäufen, wirksamer begegnen zu können, sollte der Markeninhaber die Einfuhr solcher Waren in die Union auch dann untersagen können, wenn nur der Versender der Waren aus kommerziellen Beweggründen handelt. **entfällt**

Or. de

Amendment 53
Tadeusz Zwiefka

Proposal for a directive
Recital 24

Text proposed by the Commission

(24) In order to enable proprietors of registered trade marks to fight counterfeiting more effectively, they should be entitled to prohibit the affixing of an infringing trade mark to goods and **certain** preparatory acts prior to the affixing.

Amendment

(24) In order to enable proprietors of registered trade marks to fight counterfeiting more effectively, they should be entitled to prohibit the affixing of an infringing trade mark to goods and preparatory acts prior to the affixing.

Or. en

Amendment 54
Antonio Masip Hidalgo

Proposal for a directive
Recital 24

Text proposed by the Commission

(24) Afin que les titulaires de marques enregistrées puissent lutter plus efficacement contre la contrefaçon, il convient de leur permettre d'interdire l'apposition d'une marque contrefaite sur des produits, ainsi que les actes préparatoires préalables à cette apposition.

Amendment

(24) Afin que les titulaires de marques enregistrées puissent lutter plus efficacement contre la contrefaçon, il convient de leur permettre d'interdire l'apposition d'une marque contrefaite sur des produits, ainsi que **tous** les actes préparatoires préalables à cette apposition.

Or. fr

Justification

Il s'agit ici d'une précision afin de donner la possibilité aux titulaires de marque d'interdire l'apposition d'une marque sur les produits mais également sur l'ensemble des actes préparatoires pour une meilleure sécurité juridique. En effet, dans le texte anglais, il existe une différence avec le texte français puisque le considérant parle de « and certain preparatory acts prior to the affixing ».

Amendment 55

Pier Antonio Panzeri, Bernhard Rapkay

Proposal for a directive

Recital 25 a (new)

Text proposed by the Commission

Amendment

(25a) The exclusive rights conferred by a trade mark should not entitle the proprietor to prohibit the use of signs or indications which are used for a due cause in order to allow consumers to make comparisons, to express opinions or where there is no commercial use of the mark.

Or. en

Amendment 56

Evelyn Regner

Proposal for a directive

Recital 29

Text proposed by the Commission

Amendment

(29) Marken erfüllen nur dann ihren Zweck, Waren oder Dienstleistungen voneinander zu unterscheiden und Verbrauchern zu sachkundigen Entscheidungen zu verhelfen, wenn sie tatsächlich im Markt benutzt werden. Das Benutzungserfordernis ist auch notwendig, um die Gesamtzahl der in der Union eingetragenen und geschützten Marken und damit die Zahl der zwischen ihnen möglichen Konflikte zu verringern. Es ist daher unbedingt zu fordern, dass eingetragene Marken tatsächlich für die Waren oder Dienstleistungen, für die sie eingetragen sind, benutzt werden oder andernfalls für verfallen zu erklären sind.

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zu erklären sind.

Or. de

Amendment 57

Antonio Masip Hidalgo

Proposal for a directive

Recital 29

Text proposed by the Commission

(29) Les marques ne remplissent leur fonction consistant à distinguer les produits ou services et à permettre aux consommateurs de faire des choix éclairés que lorsqu'elles sont effectivement utilisées sur le marché. Une exigence d'usage est par ailleurs nécessaire pour réduire le nombre total de marques enregistrées et protégées dans l'Union et, partant, le nombre de conflits entre ces marques. Il est donc essentiel d'imposer que les marques soient effectivement utilisées pour les produits ou services pour lesquels elles ont été enregistrées, sous peine de déchéance.

Amendment

(29) Les marques ne remplissent leur fonction consistant à distinguer les produits ou services et à permettre aux consommateurs de faire des choix éclairés que lorsqu'elles sont effectivement utilisées sur le marché. Une exigence d'usage est par ailleurs nécessaire pour réduire le nombre total de marques enregistrées et protégées dans l'Union et, partant, le nombre de conflits entre ces marques. Il est donc essentiel d'imposer que les marques soient effectivement utilisées pour les produits ou services pour lesquels elles ont été enregistrées, sous peine de déchéance, ***dans un délai de 5 ans à compter de la date d'enregistrement.***

Or. fr

Justification

Cet ajout permet un alignement du considérant au paragraphe 1 de l'Article 16 de la Directive sur le rapprochement des législations des Etats membres sur les marques. Par ailleurs, cet amendement permet d'ancrer la vision européenne de la protection de la créativité des petites et moyennes entreprises, en leur laissant le temps de se développer pour protéger leur marque.

Amendment 58

Pier Antonio Panzeri

Proposal for a directive

Recital 36 a (new)

Text proposed by the Commission

Amendment

(36a) Notice of opposition to registration of the trade mark may also be given by any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers furnishing proof that a trade mark is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.

Or. en

Amendment 59
Cecilia Wikström

Proposal for a directive
Recital 41 a (new)

Text proposed by the Commission

Amendment

(41a) In accordance with the Joint Political Declaration of Member States and the Commission on explanatory documents of 28 September 2011, Member States have undertaken to accompany, in justified cases, the notification of their transposition measures with one or more documents explaining the relationship between the components of a directive and the corresponding parts of national transposition instruments. With regard to this Directive, the legislator considers the transmission of such documents to be justified.

Or. en

Amendment 60
Marielle Gallo

Proposal for a directive
Article 2 – paragraph 1 – 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

Amendment 61
Evelyn Regner

Proposal for a directive
Article 3 – paragraph 1 – introductory part

Text proposed by the Commission

Marken können Zeichen aller Art sein, insbesondere Wörter einschließlich Personennamen, Abbildungen, Buchstaben, Zahlen , Farben als solche, die Form oder Aufmachung der Ware oder Klangbilder , soweit solche Zeichen geeignet sind,

Amendment

Marken können Zeichen aller Art sein, insbesondere Wörter einschließlich Personennamen, Abbildungen, Buchstaben, **Muster, Firmenemblem**, Zahlen , Farben als solche, die Form oder Aufmachung der Ware oder Klangbilder , soweit solche Zeichen geeignet sind,

Or. de

Amendment 62
Antonio Masip Hidalgo

Proposal for a directive
Article 3 – paragraph 1 – introductory part
Directive 2008/95/EC
Article 2

Text proposed by the Commission

Peuvent constituer des marques tous les signes, notamment les mots, y compris les noms de personnes, les dessins, les lettres, les chiffres, les couleurs en tant que telles, la forme d'un produit ou de son conditionnement ou les sons, à condition que ces signes soient propres

Amendment

Peuvent constituer des marques tous les signes, notamment les mots, y compris les noms de personnes, les dessins, les **modèles, motifs, dispositifs et logos, les** lettres, les chiffres, les couleurs en tant que telles, la forme d'un produit ou de son conditionnement ou les sons, à condition que ces signes soient propres

Or. fr

Justification

Les modèles, motifs, dispositifs et logos sont très souvent des caractéristiques qui entrent dans la fabrication d'un signe utilisé comme marque.

Amendment 63
Bernhard Rapkay

Proposal for a directive
Article 3 – paragraph 1 – introductory part

Text proposed by the Commission

Marken können Zeichen aller Art sein, insbesondere Wörter einschließlich Personennamen, Abbildungen, Buchstaben, Zahlen , Farben als solche, die Form oder Aufmachung der Ware oder Klangbilder , soweit solche Zeichen geeignet sind,

Amendment

Marken können Zeichen aller Art sein, insbesondere Wörter einschließlich Personennamen, Abbildungen, Buchstaben, Zahlen , Farben als solche, die Form oder Aufmachung der Ware oder Klangbilder, soweit solche Zeichen geeignet sind **und eine allgemein zugängliche Technologien verwendet wird,**

Or. de

Amendment 64
Giuseppe Gargani, Raffaele Baldassarre

Proposal for a directive
Article 3 – paragraph 1 – introductory part

Text proposed by the Commission

Possono costituire marchi d'impresa tutti i segni , in particolare le parole, compresi i nomi di persone, i disegni, le lettere, le cifre, i colori in quanto tali, la forma del prodotto o del suo confezionamento, oppure suoni, a condizione che tali segni siano adatti a:

Amendment

Possono costituire marchi d'impresa tutti i segni , in particolare le parole, compresi i nomi di persone, i disegni, ***i modelli, i motivi, i dispositivi, i logo***, le lettere, le cifre, i colori in quanto tali, la forma del prodotto o del suo confezionamento, oppure suoni, a condizione che tali segni siano adatti a:

Or. it

Amendment 65

Antonio López-Istúriz White

Proposal for a directive

Article 3 – paragraph 1 – point b

Text proposed by the Commission

b) ser representados de manera tal que permita a las autoridades competentes y al público en general determinar el objeto preciso de la protección otorgada a su titular.

Amendment

b) ser representados ***tanto en su publicación como en su inscripción registral*** de manera tal que permita a las autoridades competentes y al público en general determinar el objeto preciso de la protección otorgada a su titular.

Or. es

Justification

Debe incluirse una mención a la publicación que ha de efectuarse de toda marca para garantía de los terceros.

Amendment 66

Tadeusz Zwiefka

Proposal for a directive

Article 4 – paragraph 1 – point j

Text proposed by the Commission

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine and traditional specialities guaranteed.

Amendment

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of ***spirit drinks***, traditional terms for wine and traditional specialities guaranteed.

Or. en

Justification

Undoubtedly, the provision is beneficial for the owners of GIs. However, the reason to identify spirit drinks in this provision results from the GIs covered by Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008. It is necessary to distinguish them from other geographical indications and designations of origin for agricultural products and foodstuffs included in Council Regulation (EC) No 510/2006 or No 509/2006 of 20 March 2006.

Amendment 67
Tadeusz Zwiefka

Proposal for a directive
Article 4 – paragraph 5

Text proposed by the Commission

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.

Amendment

5. A trade mark shall not be refused registration in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration ***following use which has been made of it, it has acquired a distinctive character. A trade mark shall not be declared invalid for the same reasons if, before*** the date of ***application for invalidity***, following use which has been made of it, it has acquired a distinctive character.

Or. en

Amendment 68
Antonio Masip Hidalgo

Proposal for a directive
Article 4 – paragraph 6

Text proposed by the Commission

6. ***Les États membres peuvent prévoir que*** le paragraphe 5 s'applique également lorsque le caractère distinctif a été acquis après la demande d'enregistrement et avant l'enregistrement.

Amendment

6. Le paragraphe 5 s'applique également lorsque le caractère distinctif a été acquis après la demande d'enregistrement et avant l'enregistrement.

Or. fr

Justification

Dans un souci de sécurité juridique et afin de reconnaître et valoriser les investissements faits par les entreprises et notamment des PME, il semble important de rendre obligatoire pour les États membres le droit de démontrer que le caractère distinctif est acquis à tout moment.

Amendment 69
Marielle Gallo

Proposal for a directive
Article 5 – paragraph 1 – point a

Text proposed by the Commission

(a) if it is identical with an earlier trade mark, ***and*** the goods or services for which ***the trade mark*** is applied ***for or is*** registered are identical with ***the goods or services*** for which the earlier trade mark is ***protected***;

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 of registration 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

Amendment 70

Antonio Masip Hidalgo

Proposal for a directive

Article 5 – paragraph 3 – point a

Text proposed by the Commission

a) si elle est identique ou similaire à une marque antérieure, indépendamment du fait que les produits ou les services pour lesquels elle est demandée ou enregistrée sont identiques ou similaires, ou ne sont pas similaires, à ceux pour lesquels la marque antérieure est enregistrée, lorsque la marque antérieure jouit d'une renommée dans un État membre ou, dans le cas d'une marque européenne, d'une renommée dans l'Union et que l'usage de la marque postérieure sans juste motif tirerait indûment profit du caractère distinctif ou de la renommée de la marque antérieure ou qu'il leur porterait préjudice;

Amendment

a) si elle est identique ou similaire à une marque antérieure, indépendamment du fait que les produits ou les services pour lesquels elle est demandée ou enregistrée sont identiques ou similaires, ou ne sont pas similaires, à ceux pour lesquels la marque antérieure est enregistrée, lorsque la marque antérieure jouit d'une renommée dans ***une partie substantielle du territoire de l'Union, même si ce n'est que dans*** un État membre ou, dans le cas d'une marque européenne, d'une renommée dans l'Union et que l'usage de la marque postérieure sans juste motif tirerait indûment profit du caractère distinctif ou de la renommée de la marque antérieure ou qu'il leur porterait préjudice;

Or. fr

Justification

Il est important de clairement préciser que la renommée dans l'Union européenne ne repose pas sur la preuve d'une telle renommée dans chaque Etat membre.

Amendment 71

Antonio López-Istúriz White

Proposal for a directive

Article 5 – paragraph 3 – point d

Text proposed by the Commission

(d) if it is excluded from registration and shall not continue to be used pursuant to Union legislation providing for protection

Amendment

deleted

of designations of origin and geographical indications.

Or. en

Justification

Related to amendment to article 45 paragraph 2, it is proposed to delete Article 5 Paragraph 3 (d) since this ground of refusal is already established in article 4 paragraph 1 (i) and right owners of designations of origin and geographical indications are entitled to file an opposition. Technically, this is a more correct solution that reaches the same objective without having to make any amendments to article 9 Paragraph 1 when dealing with invalidity in consequence of acquiescence.

Amendment 72
Marielle Gallo

Proposal for a directive
Article 10 – paragraph 1

Text proposed by the Commission

1. The registration of a trade mark shall confer on the proprietor exclusive rights .

Amendment

1. The registration of a trade mark shall confer on the proprietor exclusive rights ***in particular, the positive right to use it and to prevent any third party not having his consent from using it.***

Or. en

Amendment 73
Marielle Gallo

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

Amendment 74

Pier Antonio Panzeri, Bernhard Rapkay

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 consumers the origin of the goods or services ;

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 and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services *by enabling him or her to distinguish without any possibility of confusion between that product and products which have another origin;*

Or. en

Amendment 75

Marielle Gallo

Proposal for a directive

Article 10 – paragraph 2 – point b

Text proposed by the Commission

(b) the sign is identical , or similar to, the trade mark and is used for goods or services which are identical with or similar to the goods or services for which the trade mark is registered , if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

Amendment

(b) *without prejudice to point a*, the sign is identical , or similar to, the trade mark and is used for goods or services which are identical with or similar to the goods or services for which the trade mark is registered , if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign

and the trade mark;

Or. en

Amendment 76
Marielle Gallo

Proposal for a directive
Article 10 – paragraph 3 – point c

Text proposed by the Commission

(c) *importing or* exporting the goods under *the* sign;

Amendment

(c) *manufacturing or placing under a suspensive procedure, importing, exporting, re* exporting *or transshipping* the goods under *that* sign;

Or. en

Amendment 77
Tadeusz Zwiefka

Proposal for a directive
Article 10 – paragraph 3 – point d

Text proposed by the Commission

(d) using the sign as a trade or company name or part of a trade or company name;

Amendment

(d) using the sign as a trade or company name or part of a trade or company name, *or domain names*;

Or. en

Amendment 78
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a directive
Article 10 – paragraph 4

Text proposed by the Commission

Amendment

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.

deleted

Or. en

Amendment 79
Evelyn Regner

Proposal for a directive
Article 10 – paragraph 4

Text proposed by the Commission

Amendment

4. Der Inhaber einer eingetragenen Marke ist auch berechtigt, die Einfuhr von Waren nach Absatz 3 Buchstabe c zu unterbinden, wenn nur der Versender der Waren aus kommerziellen Beweggründen handelt.

entfällt

Or. de

Amendment 80
Marielle Gallo

Proposal for a directive
Article 10 – paragraph 4

Text proposed by the Commission

Amendment

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**.

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 **in the context of a commercial activity**.

Or. en

Amendment 81
Christian Engström
on behalf of the Greens/EFA Group

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 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.

Amendment

5. The proprietor of a registered ***European*** 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 ***Union*** without being released for free circulation there, where such goods, including packaging, come from ***a*** third ***country*** and bear without authorization a trade mark which is ***essentially*** identical to the ***European*** trade mark ***validly*** registered in respect of such goods ***and*** which cannot be distinguished in its essential aspects from that trade mark.

In order not to hamper the production, circulation and distribution of legitimate goods, this rule should only apply if the proprietor of the trade mark is able to demonstrate clear and documented evidence of a substantial risk of fraudulent diversion of the allegedly counterfeit goods into a Member State.

The European Commission shall develop and implement guidelines for national customs authorities with clear indicators on how to establish such substantial risk of fraudulent diversion. The list of clear indicators shall reflect the importance of unrestricted trade in, inter alia, generic medicines, and shall be in line with prevailing CJEU case law.

Or. en

Amendment 82
Marielle Gallo, Tadeusz Zwiefka

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 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.

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.

Customs authorities shall also carry out the relevant controls according to the rules laid down in Regulation (EC) 608/2013 at the request of rightholders and based on risk analysis criteria, on goods, including packaging, suspected of infringing a trade mark that are crossing the territory of the European Union under a suspensive procedure and are destined and released to the market of a third country.

Or. en

Amendment 83
Bernhard Rapkay

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 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. ***This shall be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit.***

Or. en

Amendment 84

Cecilia Wikström, Rebecca Taylor

Proposal for a directive

Article 10 – paragraph 5 – subparagraph 1a (new)

Text proposed by the Commission

Amendment

Member States shall take appropriate measures with regards to ensuring the smooth transit of generic medicines. Therefore a proprietor of a trade mark shall not have the right to prevent any third parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State based upon similarities, perceived or actual, between the international non-proprietary name (INN) for the active ingredient in the medicines and a registered trademark.

Or. en

Justification

There have been cases where International non-proprietary names (INN) printed on the packaging of generic medicines have created a confusion on whether this could constitute a

risk for confusion with trademarks similar to the INN. One such case being a generic medicine containing Amoxicillin and the trademark Axmoxil. INNs by law have to be present on the packaging of pharmaceutical products to provide health professionals with a unique and universally available designated name to identify each pharmaceutical substance. It should thus be clarified that these generic names are not grounds for trademark infringements and thus should also not be grounds to intervene against generic medicines in transit.

Amendment 85
Marielle Gallo

Proposal for a directive
Article 14 – paragraph 1 – subparagraph 2

Text proposed by the Commission

The first subparagraph shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

Amendment

This paragraph shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

Or. en

Amendment 86
Sajjad Karim

Proposal for a directive
Article 14 – paragraph 2

Text proposed by the Commission

2. The use by the third party shall be considered not to be in accordance with honest practices, in particular in the following cases:

(a) it gives the impression that there is a commercial connection between the third party and the proprietor of the trade mark;

(b) it takes unfair advantage of or is detrimental to, the distinctive character or the repute of the trade mark without due cause.

deleted

Amendment

Amendment 87
Pier Antonio Panzeri, Bernhard Rapkay

Proposal for a directive
Article 14 – paragraph 3 a (new)

Text proposed by the Commission

Amendment

3 a. The trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark for a due cause in connection with:

(a) advertising or promotion that permits consumers to compare goods or services; or

(b) identifying and parodying, criticizing, or commenting upon the trade mark proprietor or the goods or services of the trade mark owner proprietor; or

(c) any non-commercial use of a mark.

Amendment 88
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a directive
Article 14 a (new)

Text proposed by the Commission

Amendment

Article 14 a

Limitation of the rights conferred by a trade mark

Nothing in this directive shall limit the right of all persons, including legal persons, to publicly express themselves, through any means or media they choose, provided that they do not violate the rights

afforded by Article 10.

This includes, but is not limited to, expressions for the purposes of political or social commentary, teaching, scientific research, journalism, artistic expression, personal communication, criticism or review, comparisons of products or services, caricature, parody or pastiche.

Or. en

Amendment 89
Cecilia Wikström

Proposal for a directive
Article 15 – paragraph 1

Text proposed by the Commission

1. The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Union under that trade mark by the proprietor or with his consent.

Amendment

1. The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Union under that trade mark by the proprietor or with his consent, *or that have been sold to individual consumers in accordance with article 10(4).*

Or. en

Amendment 90
Tadeusz Zwiefka

Proposal for a directive
Article 17

Text proposed by the Commission

Article 17

Non-use as defence in infringement proceedings

The proprietor of a trade mark shall be entitled to prohibit the use of a sign only to the extent that his rights are not liable

Amendment

deleted

to be revoked pursuant to Article 19 at the time the infringement action is brought.

Or. en

Justification

The provision will shift the obligation to decide upon non-use of trade marks on courts which in fact will extend the proceeding and put additional burden of proof on the plaintiff. Currently, proceedings for invalidity of a registered trade mark often take place within the competences of the national patent offices, while shifting that responsibility to courts will create two different practices and double competences. The abovementioned situation may lead to some discrepancies between judgments of the Patent Office and decisions held by courts in terms of grounds for trade mark invalidation due to non-use.

Amendment 91

Christian Engström

on behalf of the Greens/EFA Group

Proposal for a directive

Article 18 a (new)

Text proposed by the Commission

Amendment

Article 18 a

Indemnification of the Importer and the Owner of the Goods

Appropriate agencies shall have the authority to order a proprietor of a trade mark to pay the importer, the consignee and owner of the goods appropriate compensation for any injury caused to them through a wrongful detention of goods due to import restriction rights granted in Article 10.

Or. en

Justification

In accordance with TRIPS Article 56, the relevant agency shall have the authority to order an applicant, in this case a trade mark proprietor, to appropriately compensate importers or owners for wrongful detentions. Wrongful detentions are a major and escalating problem. According to the Commission annual report "EU Customs Enforcement of Intellectual Property Rights: Results at the Border", in 2011, goods were detained by mistake in more

than 2 700 cases, an increase of 46 % over two years before.

Amendment 92
Tadeusz Zwiefka

Proposal for a directive
Article 38 – paragraph 1 – introductory part

Text proposed by the Commission

Amendment

1. An application for registration of a trade mark shall contain:

1. An application for registration of a trade mark shall contain **at least**:

Or. en

Amendment 93
Tadeusz Zwiefka

Proposal for a directive
Article 41 – paragraph 1

Text proposed by the Commission

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.

The offices shall **undertake** examination ex officio of whether a trade mark application is eligible for registration **considering** the absolute grounds for refusal provided for in Article 4.

Or. en

Justification

Currently, the full examination system examining for both absolute and relative grounds for refusal is used by 11 Member States i.e. Poland, Cyprus, Czech Republic, Estonia, Finland, Greece, Ireland, Malta, Portugal, Slovakia and Sweden. The report of the Max Planck institute in 2011 confirms the strong support by 48 per cent of the proprietors for introducing an ex-officio examination of relative grounds for refusal.

Amendment 94
Pier Antonio Panzeri

Proposal for a directive
Article 42 – paragraph 1

Text proposed by the Commission

1. Prior to registration of a trade mark, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the office written observations, explaining on which of the grounds listed in Article 4 the trade mark shall not be registered ex officio. ***They shall not be parties to the proceedings before the office.***

Amendment

1. Prior to registration of a trade mark, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the office written observations, explaining on which of the grounds listed in Article 4 the trade mark shall not be registered ex officio.

Or. en

Amendment 95
Antonio López-Istúriz White

Proposal for a directive
Article 42 – paragraph 2 a (new)

Text proposed by the Commission

Amendment

2a. Member States establishing opposition procedures based on absolute grounds covered by Article 4 shall not be required to implement this provision.

Or. en

Justification

It is redundant to impose an inefficient procedure of observations by third parties to those Member States who already have an opposition procedure based on those very same absolute grounds. This duplicity makes no sense. Therefore, it is proposed that this provision would be optional for these Member States.

Amendment 96
Antonio López-Istúriz White

Proposal for a directive
Article 45 – paragraph 1

Text proposed by the Commission

1. Member States shall provide for an efficient and expeditious administrative procedure before their offices for opposing the registration of a trade mark application **on the grounds provided for in Article 5.**

Amendment

1. Member States shall provide for an efficient and expeditious administrative procedure before their offices for opposing the registration of a trade mark application.

Or. en

Justification

Reference to Article 5 is deleted. It is intended to allow Member States to freely determine the grounds of opposition including, if desired, absolute grounds of refusal.

Amendment 97
Antonio López-Istúriz White

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 4(1)(i),** Article 5(2) and (3) shall be able to file a notice of opposition.

Or. en

Justification

A reference to Article 4, paragraph 1(i) is included and as a consequence, not only the owners of prior rights according to article 5 but also right owners of designations of origin and geographical indications may file an opposition.

Amendment 98
Antonio López-Istúriz White

Proposal for a directive
Article 45 – paragraph 3

Text proposed by the Commission

3. The parties shall be granted **a period of time of at least** two months **before** the opposition **proceedings commence** in order to negotiate the possibility of an amicable settlement between the opposing party and the applicant.

Amendment

3. The parties shall be granted, **at their joint request, a minimum of** two months **in** the opposition **proceeding** in order to negotiate the possibility of an amicable settlement between the opposing party and the applicant.

Or. en

Justification

The automatic grant of a cooling off period is deleted since it is inefficient, but a cooling off period for a minimum of two months is proposed if the parties jointly request it.

Amendment 99

Pier Antonio Panzeri

Proposal for a directive

Article 45 – paragraph 3 a (new)

Text proposed by the Commission

Amendment

3a. Notice of opposition to registration of the trade mark may also be given by any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers.

Or. en

Amendment 100

Tadeusz Zwiefka

Proposal for a directive

Article 46 – paragraph 1

Text proposed by the Commission

Amendment

1. In **administrative** opposition proceedings, where at the filing date or

1. In opposition proceedings, where at the filing date or date of priority of the later

date of priority of the later trade mark, the period of five years within which the earlier trade mark must have been put to genuine use as provided for in Article 16 had expired, upon request of the applicant the proprietor of the earlier trade mark who has given notice of opposition shall furnish proof that the earlier trade mark has been put to genuine use as provided for in Article 16 during the period of five years preceding the filing date or date of priority of the later trade mark, or that proper reasons for non-use existed. In the absence of proof to this effect the opposition shall be rejected.

trade mark, the period of five years within which the earlier trade mark must have been put to genuine use as provided for in Article 16 had expired, upon request of the applicant the proprietor of the earlier trade mark who has given notice of opposition shall furnish proof that the earlier trade mark has been put to genuine use as provided for in Article 16 during the period of five years preceding the filing date or date of priority of the later trade mark, or that proper reasons for non-use existed. In the absence of proof to this effect the opposition shall be rejected.

Or. en

Amendment 101

Antonio López-Istúriz White

Proposal for a directive

Article 46 – paragraph 1

Text proposed by the Commission

1. En el procedimiento administrativo de oposición, si en la fecha de presentación o fecha de prioridad de la marca posterior hubiera expirado el plazo de cinco años durante el cual la marca anterior debía haber sido objeto de un uso efectivo, con arreglo al artículo 16, a instancia del solicitante, el titular de esta última marca que hubiera formulado oposición **presentará** la prueba de que, en el curso de los cinco años anteriores a la fecha de presentación o fecha de prioridad de la marca posterior, la marca anterior ha sido objeto de un uso efectivo, con arreglo al artículo 16, o de que han existido causas justificativas de la falta de uso. A falta de dicha prueba, se desestimarà la oposición.

Amendment

1. En el procedimiento administrativo de oposición, **los Estados miembros podrán prever que**, si en la fecha de presentación o fecha de prioridad de la marca posterior hubiera expirado el plazo de cinco años durante el cual la marca anterior debía haber sido objeto de un uso efectivo, con arreglo al artículo 16, a instancia del solicitante, el titular de esta última marca que hubiera formulado oposición **deba presentar** la prueba de que, en el curso de los cinco años anteriores a la fecha de presentación o fecha de prioridad de la marca posterior, la marca anterior ha sido objeto de un uso efectivo, con arreglo al artículo 16, o de que han existido causas justificativas de la falta de uso. A falta de dicha prueba, se desestimarà la oposición.

Or. es

Justification

Establecer una prueba de uso en un procedimiento de oposición siendo aceptable, no ha de imponerse obligatoriamente. La opción propuesta causa problemas, al no acreditarse el uso en relación con determinados productos, la marca posterior se inscribe, pero la anterior no se extingue y podrá iniciar un uso efectivo en relación con esos productos que entonces no usaba y quedará sanada y conviviendo con la marca a que se opuso, en detrimento del público consumidor.

Amendment 102

Antonio López-Istúriz White

Proposal for a directive

Article 47 – paragraph 1

Text proposed by the Commission

1. Los Estados miembros **establecerán** un procedimiento administrativo que permita solicitar a las oficinas la declaración de caducidad o de nulidad de una marca.

Amendment

1. Los Estados miembros **podrán establecer** un procedimiento administrativo que permita solicitar a las oficinas la declaración de caducidad o de nulidad de una marca.

Or. es

Justification

Imponer unos procedimientos de caducidad y nulidad de carácter administrativo, puede plantear a ciertos Estados un problema jurisdiccional, pues dichas cuestiones queda reservadas a la competencia exclusiva de los Tribunales (art. 22.1 LOPJ). Esta solución no evita que al final se acabe en los Tribunales, pues las decisiones de las OONN serán recurribles, lo que alargará los periodos de obtención de una resolución definitiva.

Amendment 103

Tadeusz Zwiefka

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

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

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.

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

Amendment 104
Tadeusz Zwiefka

Proposal for a directive
Article 52

Text proposed by the Commission

Member States shall ensure that the offices cooperate with each other and with the Agency in order to promote convergence of practices and tools and achieve coherent results in the examination and registration of trade marks.

Amendment

Member States shall ensure that the offices ***may effectively*** cooperate with each other and with the Agency in order to promote convergence of practices and tools and achieve coherent results in the examination and registration of trade marks.

Or. en

Amendment 105
Sajjad Karim

Proposal for a directive
Article 52

Text proposed by the Commission

Member States shall ensure that the offices cooperate with each other and with the Agency in order to promote convergence of practices and tools ***and achieve coherent results in the examination and registration of trade marks.***

Amendment

Member States shall ensure that the offices cooperate with each other and with the Agency in order to promote convergence of practices and tools.

Or. en

Amendment 106
Tadeusz Zwiefka

Proposal for a directive
Article 53

Text proposed by the Commission

Member States shall ensure that the offices cooperate with the Agency in all areas of their activities other than those referred to in Article 52 which are of relevance for the protection of trade marks in the Union.

Amendment

Member States shall ensure that the offices ***may effectively*** cooperate with the Agency in all areas of their activities other than those referred to in Article 52 which are of relevance for the protection of trade marks in the Union.

Or. en