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A7-0031/ 001-114

AMENDMENTS 001-114

by the Committee on Legal Affairs

Report

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Community trade mark

A7-0031/2014

Proposal for a regulation (COM(2013)0161 – C7-0087/2013 – 2013/0088(COD))

Amendment 1

Proposal for a regulation

Recital 2

Text proposed by the Commission

(2) As a consequence of the entry into force of the Lisbon Treaty, the terminology of Regulation (EC) No 207/2009 should be updated. This *implies* the replacement of ‘Community trade mark’ by ‘European trade mark’. In line with the Common approach on decentralised Agencies, agreed in July 2012 by the European Parliament, the Council and the Commission, the name ‘Office for Harmonisation in the Internal Market (trade marks and designs)’ should be replaced by ‘European Union **Trade Marks and Designs** Agency’ (hereinafter ‘the Agency’).

Amendment

(2) As a consequence of the entry into force of the Lisbon Treaty, the terminology of Regulation (EC) No 207/2009 should be updated. This *involves* the replacement of ‘Community trade mark’ by ‘European **Union** trade mark’. In line with the Common approach on decentralised Agencies, agreed in July 2012 by the European Parliament, the Council and the Commission, the name ‘Office for Harmonisation in the Internal Market (trade marks and designs)’ should be replaced by ‘European Union **Intellectual Property** Agency’ (hereinafter ‘the Agency’).

Justification

As the word "European" is broader than the territory of the European Union it would be more precise to use the term "European Union trade mark". Furthermore the term "European" is currently used (notably in patent protection) to designate protection which is not unitary but which refers rather to a bundle of national rights. The current name may be well established

within the design- and trademarks communities but it is hardly a name that clearly designates what the office is doing for a person that is not familiar with it to begin with, including most SMEs. Changing the name of the office to reflect its actual work is thus very reasonable. However a name should be chosen that can both convey the broad range of tasks entrusted to the agency and last if new tasks are added in the future. Given the fact that the Agency hosts the Observatory on infringements of intellectual property rights as well as the registry of recognised orphan works the work clearly goes beyond the scope of just trademarks and designs even though these are the core competencies of the agency. Furthermore it is foreseeable that additional items such as registration of GIs and tasks in relation to trade secrets could be added to the competences of the Agency in the future.

Amendment 2

Proposal for a regulation

Recital 5

Text proposed by the Commission

(5) The experience acquired since the establishment of the Community trade mark system has shown that undertakings from within the Union and from third countries have accepted the system, which has become a successful and viable alternative to the protection of trade marks at the level of the Member States.

Amendment

(5) The experience acquired since the establishment of the Community trade mark system has shown that undertakings from within the Union and from third countries have accepted the system, which has become a successful and viable **complement and** alternative to the protection of trade marks at the level of the Member States.

Justification

It is important to stress the co-existing of the two levels of protection.

Amendment 3

Proposal for a regulation

Recital 9

Text proposed by the Commission

(9) In order to allow for more flexibility while ensuring greater legal certainty with regard to the means of representation of trade marks, the requirement of graphic representability should be deleted from the definition of a European trade mark. A sign should be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the **representation** enables the competent authorities and the public to determine **with**

Amendment

(9) In order to allow for more flexibility while ensuring greater legal certainty with regard to the means of representation of trade marks, the requirement of graphic representability should be deleted from the definition of a European **Union** trade mark. A sign should be permitted to be represented in **the Register of European Union trade marks in** any appropriate form, and thus not necessarily by graphic means, as long as the **sign is capable of**

precision and clarity the *precise* subject matter of protection.

being represented in a manner which is clear, precise, self-contained, easily accessible, durable and objective. A sign should therefore be permitted in any appropriate form, taking account of generally available technology which enables the competent authorities and the public to determine with precision and clarity the subject matter of protection.

Amendment 4

Proposal for a regulation

Recital 15

Text proposed by the Commission

Amendment

(15) 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 European trade mark only if and to the extent that the main function of the European trade mark, which is to guarantee the commercial origin of the goods or services, is adversely affected.

deleted

Justification

This amendment relates to the deletion in Article 9.

Amendment 5

Proposal for a regulation

Recital 18

Text proposed by the Commission

Amendment

(18) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a European trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Union without being released for free circulation there, where such goods come from third countries and bear without **authorization** a trade mark which is

(18) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a European **Union** trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Union without being released for free circulation there, where such goods come from third countries and bear without **authorisation** a trade mark

essentially identical to the European trade mark registered in respect of such goods.

which is essentially identical to the European *Union* trade mark registered in respect of such goods. *This provision should not harm the interests of legitimate trade in goods that can lawfully be placed on the market in their destination countries. In order not to hamper legitimate flows of goods, this provision should therefore not apply if the third party proves that the final destination of the goods is a country outside the Union and if the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. Where the country of final destination has not yet been determined, the proprietor of the European Union trade mark should have the right to prevent all third parties from bringing the goods out of the Union again unless the third party proves that the final destination of the goods is a country outside the Union and the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. This provision should also be without prejudice to the Union's right to promote access to medicines for third countries as well as to compliance with WTO rules, notably with GATT Article V on freedom of transit.*

Amendment 6

Proposal for a regulation Recital 18 a (new)

Text proposed by the Commission

Amendment

(18a) The proprietor of a European Union trade mark should have the right to take relevant legal actions, including inter alia the right to request national customs authorities to take action in respect of goods which allegedly infringe the proprietor's rights, such as detention and destruction in accordance with Regulation (EU) No 608/2013 of the European Parliament and of the

Council¹.

¹ *Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (OJ L 181, 28.6.2013, p. 15).*

Amendment 7

Proposal for a regulation Recital 18 b (new)

Text proposed by the Commission

Amendment

(18b) Article 28 of Regulation (EU) No 608/2013 provides that a right holder is to be liable in damages towards the holder of the goods where, inter alia, the goods in question are subsequently found not to infringe an intellectual property right.

Amendment 8

Proposal for a regulation Recital 18 c (new)

Text proposed by the Commission

Amendment

(18c) Member States should take appropriate measures with a view to ensuring the smooth transit of generic medicines. A proprietor of a European Union trade mark should not have the right to prevent any third party from bringing goods, in the context of commercial activity, into the customs territory of a 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 trade mark.

Amendment 9

Proposal for a regulation

Recital 19

Text proposed by the Commission

(19) 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

(19) In order to more effectively prevent the entry of ***counterfeit*** goods, particularly in the context of sales over the ***internet delivered in small consignments as defined by Regulation (EU) No 608/2013***, the proprietor ***of a validly registered European Union trade mark*** 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 ***in the course of trade. In cases where such measures are taken, Member States should ensure that the individuals or entities that had ordered the goods are informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.***

Amendment 10

Proposal for a regulation

Recital 22

Text proposed by the Commission

(22) In order to ensure legal certainty and safeguard trade mark rights legitimately acquired, it is appropriate and necessary to lay down, without affecting the principle that the later trade mark cannot be enforced against the earlier trade mark, that proprietors of European trade marks should not be entitled to oppose the use of a later trade mark when the later trade mark was acquired at a time when the earlier trade mark could not be enforced against the later trade mark.

Amendment

(22) In order to ensure legal certainty and safeguard trade mark rights legitimately acquired, it is appropriate and necessary to lay down, without affecting the principle that the later trade mark cannot be enforced against the earlier trade mark, that proprietors of European ***Union*** trade marks should not be entitled to oppose the use of a later trade mark when the later trade mark was acquired at a time when the earlier trade mark could not be enforced against the later trade mark. ***When carrying out checks, customs authorities should make use of the powers and procedures laid down in Union legislation regarding customs enforcement of intellectual property rights.***

Amendment 11

Proposal for a regulation

Recital 29

Text proposed by the Commission

(29) In order to provide for an effective and efficient regime for the filing of European trade mark applications including priority and seniority claims, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the means and modalities of filing a European trade mark application, the details regarding the formal conditions of a European trade mark application, the content of that application, **the type of application fee**, as well as the details on the procedures for ascertaining reciprocity, claiming the priority of a previous application, an exhibition priority and the seniority of a national trade mark.

Amendment

(29) In order to provide for an effective and efficient regime for the filing of European trade mark applications including priority and seniority claims, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the means and modalities of filing a European trade mark application, the details regarding the formal conditions of a European trade mark application, the content of that application, as well as the details on the procedures for ascertaining reciprocity, claiming the priority of a previous application, an exhibition priority and the seniority of a national trade mark.

Justification

See also amendment to Article 35a.

Amendment 12

Proposal for a regulation

Recital 32

Text proposed by the Commission

(32) In order to allow European trade marks to be renewed in an effective and efficient manner and to safely apply the provisions on the alteration and the division of a European trade mark in practice without compromising legal certainty, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the **modalities** for the renewal of a European trade mark and procedures governing the alteration and division of a European trade

Amendment

(32) In order to allow European trade marks to be renewed in an effective and efficient manner and to safely apply the provisions on the alteration and the division of a European trade mark in practice without compromising legal certainty, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the **procedure** for the renewal of a European trade mark and procedures governing the alteration and division of a European trade

mark.

mark.

Justification

See also amendment to Article 49a.

Amendment 13

Proposal for a regulation

Recital 35 a (new)

Text proposed by the Commission

Amendment

(35a) In order to contribute to improving the performance of the entire registration system and to ensure that trade marks are not registered where there are absolute grounds for refusal, including, in particular, where the trade mark is descriptive or non-distinctive, or of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service, third parties should be able to submit to the central industrial property offices of the Member States written observations explaining which of the absolute grounds constitute an obstacle to registration.

Amendment 14

Proposal for a regulation

Recital 36

Text proposed by the Commission

Amendment

(36) In order to allow for an effective and efficient use of European collective and certification marks, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the ***periods for submitting*** the regulations governing the use of those marks ***and the content thereof***.

(36) In order to allow for an effective and efficient use of European collective and certification marks, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the ***formal content*** of the regulations governing the use of those marks.

Justification

See also amendment to Articles 74a and 74k.

Amendment 15

Proposal for a regulation

Recital 38

Text proposed by the Commission

(38) In order to ensure a smooth, effective and efficient operation of the European trade mark system, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the requirements as to the form of decisions, the details on oral proceedings and the modalities of taking of evidence, the modalities of notification, the procedure for the noting of loss of rights, the means of communication and the forms to be used by the parties to proceedings, the rules governing the calculation and duration of time limits, the procedures for the revocation of a decision or for cancellation of an entry in the Register and for the correction of obvious errors in decisions and errors attributable to the Agency, the modalities of the interruption of proceedings and the procedures concerning the apportionment and fixing of costs, the particulars to be entered in the Register, *the details concerning the inspection and keeping of files*, the modalities of publications in the European Trade Marks Bulletin and in the Official Journal of the Agency, the modalities of administrative cooperation between the Agency and the authorities of Member States, and the details on representation before the Agency.

Amendment

(38) In order to ensure a smooth, effective and efficient operation of the European trade mark system, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the requirements as to the form of decisions, the details on oral proceedings and the modalities of taking of evidence, the modalities of notification, the procedure for the noting of loss of rights, the means of communication and the forms to be used by the parties to proceedings, the rules governing the calculation and duration of time limits, the procedures for the revocation of a decision or for cancellation of an entry in the Register and for the correction of obvious errors in decisions and errors attributable to the Agency, the modalities of the interruption of proceedings and the procedures concerning the apportionment and fixing of costs, the particulars to be entered in the Register, the modalities of publications in the European Trade Marks Bulletin and in the Official Journal of the Agency, the modalities of administrative cooperation between the Agency and the authorities of Member States, and the details on representation before the Agency.

Justification

See also amendment to Article 93a(l).

Amendment 16

Proposal for a regulation

Recital 40

Text proposed by the Commission

(40) With the aim of promoting convergence of practices and of developing common tools, it is necessary to establish an appropriate framework for cooperation between the Agency and the offices of the Member States, **clearly** defining **the** areas of cooperation and enabling the Agency to coordinate relevant common projects of Union interest and to finance, up to a maximum amount, those common projects by means of grants. Those cooperation activities should be beneficial for undertakings using trade mark systems in **Europe**. For users of the Union regime laid down in **this Regulation**, the common projects, particularly the databases for search and consultation purposes, should provide additional, inclusive, efficient **and free of charge** tools to comply with the specific requirements flowing from the unitary character of the European trade mark.

Amendment

(40) With the aim of promoting convergence of practices and of developing common tools, it is necessary to establish an appropriate framework for cooperation between the Agency and the offices of the Member States, defining **key** areas of cooperation and enabling the Agency to coordinate relevant common projects of Union interest and to finance, up to a maximum amount, those common projects by means of grants. Those cooperation activities should be beneficial for undertakings using trade mark systems in **the Union**. For users of the Union regime laid down in **Regulation (EC) No 207/2009**, the common projects, particularly the databases **used** for search and consultation purposes, should provide, **free of charge**, additional, inclusive **and** efficient tools to comply with the specific requirements flowing from the unitary character of the European **Union** trade mark. **However, it should not be mandatory for Member States to implement the results of such common projects. While it is important that all parties contribute to the success of common projects, not least by sharing best practices and experiences, a strict obligation requiring all Member States to implement the results of common projects, even where, for example, a Member State believes that it already has a better IT or similar tool in place, would be neither proportional nor in the best interests of users.**

Amendment 17

**Proposal for a regulation
Recital 44 a (new)**

Text proposed by the Commission

Amendment

(44a) The fees structure has been laid down by Commission Regulation (EC) No 2869/95¹. However, the fees structure is a

central aspect of the functioning of the Union trade mark system, and has only been revised twice since its establishment, and only after significant political debate. The fees structure should therefore be directly regulated in Regulation (EC) No 207/2009. Regulation (EC) No 2869/95 should therefore be repealed and the provisions concerning the fees structure contained in Commission Regulation (EC) No 2868/95² should be deleted.

¹ *Commission Regulation No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ L 303, 15.12.1995, p. 33).*

² *Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ L 303, 15.12.1995, p. 1).*

Justification

The fees structure is an important element of the EU trade mark system and should therefore be directly regulated in the Regulation and not be left to delegated acts.

Amendment 18

Proposal for a regulation Recital 45

Text proposed by the Commission

(45) In order to ensure an effective and efficient method *to resolve* disputes, *to ensure* consistency with the language regime laid down in Regulation (EC) No 207/2009, the expeditious delivery of decisions *on* a simple subject matter, and the effective and efficient organisation of the Boards of Appeal, *and to guarantee an appropriate and realistic level of fees to be charged by the Agency*, while complying with the budgetary principles set out in Regulation (EC) No 207/2009, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be

Amendment

(45) In order to ensure an effective and efficient method *of resolving* disputes, consistency with the language regime laid down in Regulation (EC) No 207/2009, the expeditious delivery of decisions *in cases having* a simple subject matter, and the effective and efficient organisation of the Boards of Appeal, while complying with the budgetary principles set out in Regulation (EC) No 207/2009, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the details *concerning* the

delegated to the Commission in respect of specifying the details *on* the languages to be used before the Agency, the cases *where* opposition and cancellation decisions should be taken by a single member, the details *on* the organisation of the Boards of Appeal, *the amounts of the fees to be paid to the Agency* and details *related to their* payment.

languages to be used before the Agency, the cases *in which* opposition and cancellation decisions should be taken by a single member, the details *concerning* the organisation of the Boards of Appeal and details *relating to the* payment *of fees*.

Justification

The fees structure is an important element of the EU trade mark system and should therefore be directly regulated in the Regulation and not be left to delegated acts.

Amendment 19

Proposal for a regulation Recital 46 a (new)

Text proposed by the Commission

Amendment

(46a) The European Data Protection Supervisor was consulted in accordance with Article 28(2) of Regulation (EC) No 45/2001 and delivered an opinion on 11 July 2013^{9a}.

^{9a} ***Not yet published in the Official Journal.***

Amendment 20

Proposal for a regulation Article 1 – point 2

Text proposed by the Commission

Amendment

(2) Throughout the Regulation, the words ‘Community trade mark’ are replaced by ‘European trade mark’ and any necessary grammatical changes are made;

(2) Throughout the Regulation, the words ‘Community trade mark’ are replaced by ‘European **Union** trade mark’ and any necessary grammatical changes are made;

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

Justification

As the word "European" is broader than the territory of the European Union it would be more

precise to use the term "European Union trade mark". Furthermore the term "European" is currently used (notably in patent protection) to designate protection which is not unitary but which refers rather to a bundle of national rights.

Amendment 21

Proposal for a regulation

Article 1 – point 3

Text proposed by the Commission

(3) Throughout the Regulation, the words ‘Community trade mark court’ are replaced by ‘European trade mark court’ and any necessary grammatical changes are made;

Amendment

(3) Throughout the Regulation, the words ‘Community trade mark court’ are replaced by ‘European **Union** trade mark court’ and any necessary grammatical changes are made;

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

Justification

As the word "European" is broader than the territory of the European Union it would be more precise to use the term "European Union trade mark court". It further mirrors the name of the Court of Justice of the European Union.

Amendment 22

Proposal for a regulation

Article 1 – point 4

Text proposed by the Commission

(4) Throughout the Regulation, the words ‘Community collective mark’ are replaced by ‘European collective mark’ and any necessary grammatical changes are made;

Amendment

(4) Throughout the Regulation, the words ‘Community collective mark’ are replaced by ‘European **Union** collective mark’ and any necessary grammatical changes are made;

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

Justification

As the word "European" is broader than the territory of the European Union it would be more precise to use the term "European Union collective mark"

Amendment 23

Proposal for a regulation

Article 1 – point 8

Regulation (EC) No 207/2009

Article 2 – paragraph 1

Text proposed by the Commission

1. A European Union **Trade Marks and Designs** Agency, hereinafter referred to as “the Agency”, is hereby established.

Amendment

1. A European Union **Intellectual Property** Agency, hereinafter referred to as “the Agency”, is hereby established.

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

Justification

The current name may be well established within the design- and trademarks communities but it is hardly a name that clearly designates what the office is doing for a person that is not familiar with it to begin with, including most SMEs. Changing the name of the office to reflect its actual work is thus very reasonable. However a name should be chosen that can both convey the broad range of tasks entrusted to the agency and last if new tasks are added in the future. Given the fact that the Agency hosts the Observatory on infringements of intellectual property rights as well as the registry of recognised orphan works the work clearly goes beyond the scope of just trademarks and designs even though these are the core competencies of the agency. Furthermore it is foreseeable that additional items such as registration of GIs and tasks in relation to trade secrets could be added to the competences of the agency in the future.

Amendment 24

Proposal for a regulation

Article 1 – point 9

Regulation (EC) No 207/2009

Article 4

Text proposed by the Commission

Signs of which a European trade mark may consist

A European trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that such signs are capable of

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

Amendment

Signs of which a European **Union** trade mark may consist

A European **Union** trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that **generally available technology is used** and such signs are capable of

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

undertakings;

(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.

undertakings; *and*

(b) being represented *in the Register of European Union trade marks* in a manner which enables the competent authorities and the public to determine the *clear and precise subject matter* of the protection afforded to its proprietor.

Amendment 25

Proposal for a regulation

Article 1 – paragraph 1 – point 10 – point a

Regulation (EC) No 207/2009

Article 7 – paragraph 1 – point k

Text proposed by the Commission

(k) trademarks 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

(k) trademarks 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;

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 26

Proposal for a regulation

Article 1 – paragraph 1 – point 10 – point b

Regulation (EC) No 207/2009

Article 7 – paragraph 2

Text proposed by the Commission

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

(a) in only part of the Union;

(b) *only where a trade mark in a foreign language or script is translated or transcribed in any script or official*

Amendment

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.

language of a Member State.

Amendment 27

Proposal for a regulation

Article 1 – point 11 – point a

Regulation (EC) No 207/2009

Article 8 – paragraph 3 – point a

Text proposed by the Commission

(a) where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;

Amendment

(a) where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action; **or**

Justification

It should be made clear that only one of the conditions in points a and b has to be fulfilled.

Amendment 28

Proposal for a regulation

Article 1 – point 12

Regulation (EC) No 207/2009

Article 9

Text proposed by the Commission

Rights conferred by a European trade mark

1. The registration of a European trade mark shall confer on the proprietor exclusive rights.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the European trade mark, the proprietor of a European trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign in relation to goods or services where:

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

Amendment

Rights conferred by a European **Union** trade mark

1. The registration of a European **Union** trade mark shall confer on the proprietor exclusive rights.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the European **Union** trade mark, the proprietor of a European **Union** trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign in relation to goods or services where:

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

registered, *and where such use affects or is liable to affect the function of the European trade mark to guarantee to consumers the origin of the goods or services*;

(b) the sign is identical, or similar to, the European trade mark and is used for goods or services which are identical with or similar to the goods or services for which the European 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;

(c) the sign is identical with, or similar to, the European trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the European trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the European trade mark.

3. The following, in particular, may be prohibited under paragraph 2:

(a) affixing the sign to the goods or to the packaging thereof;

(b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

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

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

(e) using the sign on business papers and in advertising;

(f) using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC.

mark is registered;

(b) *without prejudice to point (a)*, the sign is identical, or similar to, the European **Union** trade mark and is used for goods or services which are identical with or similar to the goods or services for which the European **Union** 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;

(c) the sign is identical with, or similar to, the European **Union** trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the European **Union** trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the European **Union** trade mark.

3. The following, in particular, may be prohibited under paragraph 2:

(a) affixing the sign to the goods or to the packaging thereof;

(b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

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

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

(e) using the sign on business papers and in advertising;

(f) using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC.

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

5. The proprietor of a 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 third *countries* and bear without *authorization* a trade mark which is identical to the European trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

4. The proprietor of a European *Union* trade mark shall also be entitled to prevent the importing *into the Union* of goods *delivered in small consignments as defined by Regulation (EU) No 608/2013* where only the consignor of the goods acts *in the course of trade and where such goods, including packaging, bear without authorisation a trade mark which is identical to the European Union trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that European Union trade mark. In cases where such measures are taken Member States shall ensure that the individual or entity that ordered the goods is informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.*

5. The proprietor of a *registered* European *Union* 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 *authorisation* a trade mark which is identical to the European *Union* trade mark *validly* registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. *Without prejudice to the obligations of customs authorities to carry out adequate customs controls in accordance with Article 1 of Regulation (EU) No 608/2013, this provision shall not apply if the third party proves that the final destination of the goods is a country outside the Union and if the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. In cases where the country of final destination has not yet been determined, the proprietor of the European Union trade mark shall have the right to prevent all third parties from bringing the goods out of the Union*

again unless the third party proves that the final destination of the goods is a country outside the Union and the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination.

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 29

Proposal for a regulation

Article 1 – paragraph 1 – point 14

Regulation (EC) No 207/2009

Article 12

Text proposed by the Commission

Limitation of the effects of a European trade mark

1. A European trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

- (a) his own personal name or address;
- (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;
- (c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

Amendment

Limitation of the effects of a European **Union** trade mark

1. A European **Union** trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

- (a) his own personal name or address;
- (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;
- (c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular where the use of the trade mark:
 - (i) is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;
 - (ii) **is made in comparative advertising satisfying all conditions set forth in**

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.

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

Directive 2006/114/EC;

(iii) is made to bring to the attention of consumers the resale of genuine goods that have originally been sold by or with the consent of the proprietor of the trade mark;

(iv) is made to put forward a legitimate alternative to the goods or services of the proprietor of the trade mark;

(v) is made for the purposes of parody, artistic expression, criticism or comment.

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

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

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

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

2a. The trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark for a due cause for any non-commercial use of a mark.

2b. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Member State in question and within the limits of the territory in which it is recognised.

Amendment 30

Proposal for a regulation

Article 1 – point 15

Regulation (EC) No 207/2009

Article 13 – paragraph 1

Text proposed by the Commission

(15) ***In Article 13(1), the words 'in the Community' are replaced by 'in the European Economic Area';***

Amendment

(15) Article 13(1) ***is replaced by the following:***

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

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 31

Proposal for a regulation

Article 1 – point 26 – point aa (new)

Regulation (EC) No 207/2009

Article 26 – paragraph 2

Text proposed by the Commission

Amendment

(aa) paragraph 2 is replaced by the following:

'2. The application for a European Union trade mark shall be subject to the payment of the application fee. The application fee shall consist of:

(a) the basic fee;

(b) the class fees for the classes exceeding one to which the goods or services belong in accordance with Article 28;

(c) where applicable, the search fee referred to in Article 38(2).

The applicant shall give the order for payment of the application fee at the latest on the date on which he files his application.'

Justification

The fees structure is an important element of the EU trade mark system and should therefore be directly regulated in the Regulation. Rule 4 of Regulation (EC) No 2868/95 is hence incorporated into Regulation (EC) No 207/2009.

Amendment 32

Proposal for a regulation

Article 1 – point 27

Regulation (EC) No 207/2009

Article 27

Text proposed by the Commission

The date of filing of a European trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Agency by the applicant, subject to payment of the application fee ***for which the order for payment shall have been given at the latest on that date.***';

Amendment

The date of filing of a European ***Union*** trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Agency by the applicant, subject to ***the order for*** payment of the application fee ***being given within a period of 21 days of filing the abovementioned documents.***

Amendment 33

Proposal for a regulation

Article 1 – point 28

Regulation (EC) No 207/2009

Article 28 – 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.

Justification

Clarification that it is up to the applicant to group the classes.

Amendment 34

Proposal for a regulation

Article 1 – paragraph 1 – point 28
Regulation (EC) No 207/2009
Article 28 – paragraph 8 – subparagraph 1

Text proposed by the Commission

Proprietors of European trade marks applied for before 22 June 2012 which are registered ***solely*** in respect of the entire heading of a Nice class, may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing.

Amendment

Proprietors of European trade marks applied for before 22 June 2012 which are registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing.

Amendment 35

Proposal for a regulation

Article 1 – point 28

Regulation (EC) No 207/2009 EC
Article 28 – paragraph 8 – subparagraph 2

Text proposed by the Commission

The declaration shall be filed at the Agency within **4** months from the entry into force of this Regulation, and shall indicate, in a clear, precise and specific manner, the goods and services, other than those clearly covered by the literal meaning of the indications of the class heading, originally covered by the proprietor's intention. The Agency shall take appropriate measures to amend the Register accordingly. This possibility is without prejudice to the application of **Articles** 15, 42(2), 51(1)(a) and 57(2).

Amendment

The declaration shall be filed at the Agency within **six** months from the entry into force of this Regulation, and shall indicate, in a clear, precise and specific manner, the goods and services, other than those clearly covered by the literal meaning of the indications of the class heading, originally covered by the proprietor's intention. The Agency shall take appropriate measures to amend the Register accordingly. This possibility is without prejudice to the application of **Article** 15, **Article** 42(2), **point (a) of Article** 51(1) and **Article** 57(2).

Justification

It is likely that this will cause quite some work for the users, it would therefore be prudent to extend the deadline somewhat to allow for some additional time to analyse the situation for the users.

Amendment 36

Proposal for a regulation

Article 1 – paragraph 1 – point 28

Regulation (EC) No 207/2009

Article 28 – paragraph 8 a (new)

Text proposed by the Commission

Amendment

8a. Where the register is amended, the exclusive rights conferred by the European Union trade mark under Article 9 shall not prevent any third party from continuing to use a trade mark in relation to goods or services where and to the extent that:

(a) the use of the trade mark for those goods or services commenced before the register was amended, and

(b) the use of the trade mark in relation to those goods or services did not infringe the proprietor's rights based on the literal meaning of the record of the goods and services in the register at that time.

In addition, the amendment of the list of goods or services recorded in the register shall not give the proprietor of the European Union trade mark the right to oppose or to apply for a declaration of invalidity of a later trade mark where and to the extent that:

(a) the later trade mark was either in use, or an application had been made to register the trade mark, for goods or services before the register was amended, and

(b) the use of the trade mark in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the record of the goods and services in the register at that time.

Amendment 37

Proposal for a regulation

Article 1 – point 29

Regulation (EC) No 207/2009

Article 29 – paragraph 5 – added sentence

Text proposed by the Commission

If necessary, the Executive Director of the Agency shall request the Commission to **consider enquiring** whether a State within the meaning of the first sentence accords that reciprocal treatment.

Amendment

If necessary, the Executive Director of the Agency shall request the Commission to **enquire** whether a State within the meaning of the first sentence accords that reciprocal treatment.

Justification

The expression "consider enquiring" is very weak. The Commission is not bound to follow a request for an enquiry anyway.

Amendment 38

Proposal for a regulation

Article 1 – point 30

Regulation (EC) No 207/2009

Article 30 – paragraph 1

Text proposed by the Commission

1. Priority claims shall be filed together with the European trade mark application and shall include the date, number and country of the previous application.

Amendment

1. Priority claims shall be filed together with the European **Union** trade mark application and shall include the date, number and country of the previous application. ***The applicant shall file a copy of the previous application within three months from the filing date. If the previous application is an application for a European Union trade mark, the Agency shall ex officio include a copy of the previous application in the file.***

Justification

The formal conditions of the application should not be entirely left to delegated acts. Some basic rules should be directly established in the basic act. It is suggested to take over some of the content of Rule 6(1) of Regulation (EC) No 2868/95.

Amendment 39

Proposal for a regulation

Article 1 – point 33

Regulation (EC) No 207/2009

Article 35a – point b

Text proposed by the Commission

(b) the details regarding the content of the application for a European trade mark referred to in Article 26(1), ***the type of fees payable for the application referred to in Article 26(2), including the number of classes of goods and services covered by those fees,*** and the formal conditions of the application referred to in Article 26(3);

Amendment

(b) the details regarding the ***formal*** content of the application for a European ***Union*** trade mark referred to in Article 26(1) and the formal conditions of the application referred to in Article 26(3);

Justification

It needs to be clarified that only the formal content can be specified by delegated acts, not the content in terms of substance. The fees structure is an important element of the EU trade mark system and should therefore be directly regulated in the Regulation, as suggested in the amendments on Article 26(2), Article 47(1a) and Annex -I in the draft report.

Amendment 40

Proposal for a regulation

Article 1 – point 40

Regulation (EC) No 207/2009

Article 42 – paragraph 2

Text proposed by the Commission

(40) ***In Article 42(2), first sentence, the phrase 'during the period of five years preceding the date of publication' is replaced by 'during the period of five years preceding the date of filing or the date of priority';***

Amendment

(40) Article 42(2) is replaced by ***the following:***

'2. If the applicant so requests, the proprietor of an earlier European Union trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of filing or the date of priority of the European Union trade mark application, the earlier European Union trade mark has been put to genuine use in the Union in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that

there are proper reasons for non-use, provided the earlier *European Union* trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier *European Union* trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services';

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation)

Amendment 41

Proposal for a regulation

Article 1 – point 43 a (new)

Regulation (EC) No 207/2009

Article 47 – paragraph 1 a (new)

Text proposed by the Commission

Amendment

(43a) In Article 47, the following paragraph is inserted:

'1a. The fee payable for the renewal of a European Union trade mark shall consist of:

(a) a basic fee;

(b) the class fees for the classes exceeding one in respect of which renewal is applied for; and

(c) where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal pursuant to paragraph 3';

Justification

The fees structure is an important element of the EU trade mark system and should therefore be directly regulated in the Regulation. Rule 30(2) of Regulation (EC) No 2868/95 is hence incorporated into Regulation (EC) No 207/2009.

Amendment 42

Proposal for a regulation

Article 1 – point 45

Regulation (EC) No 207/2009

Article 49 a – point a

Text proposed by the Commission

(a) the **procedural modalities** for the renewal of the European trade mark pursuant to Article 47, including the type of fees to be paid;

Amendment

(a) the **procedure** for the renewal of the European trade mark pursuant to Article 47, including the type of fees to be paid;

Amendment 43

Proposal for a regulation

Article 1 – point 46

Regulation (EC) No 207/2009

Article 50 – paragraph 2

Text proposed by the Commission

2. The surrender shall be declared to the Agency in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register. The validity of the surrender of a European trade mark which is declared to the Agency subsequent to the submission of an application for revocation of that trade mark pursuant to Article 56(1) shall be conditional upon the final rejection or withdrawal of the application for revocation.

Amendment

2. The surrender shall be declared to the Agency in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register. The validity of the surrender of a European **Union** trade mark which is declared to the Agency subsequent to the submission of an application for revocation **or for a declaration of invalidity** of that trade mark pursuant to Article 56(1) shall be conditional upon the final rejection or withdrawal of the application for revocation **or for a declaration of invalidity**.

Justification

The Commission has proposed to amend Article 50 in a sense that would impede proprietors of European Union trade marks attacked in cancellation proceedings for non-use ask for their conversion into one or several national marks before a decision on the cancellation is taken. In fact, such a practice grants another period of 5 years during which the proprietor would legitimately be able to abstain from using the mark, circumventing the law. The same provision should be extended to cases where the European Union trade mark is the object of an action for a declaration of invalidity.

Amendment 44

Proposal for a regulation

Article 1 – point 46

Regulation (EC) No 207/2009

Article 50 – paragraph 3

Text proposed by the Commission

3. Surrender shall be entered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender shall be entered in the Register only if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of a period ***established in accordance with Article 57a(a).***

Amendment

3. Surrender shall be entered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender shall be entered in the Register only if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of a period ***of three months after the date on which the proprietor of the trade mark satisfies the Agency that he has informed the licensee of his intention to surrender it.***

Justification

The provision as proposed by the Commission would not be operational and no surrender could be entered in the Register before the adoption of a delegated act in accordance with Article 57a(a). The period should therefore be directly established in the basic act. It is suggested to maintain the same length of period as in Rule 36(2) of Regulation (EC) No 2868/95. See also amendment to Article 57a(a).

Amendment 45

Proposal for a regulation

Article 1 – point 48

Regulation (EC) No 207/2009

Article 54 – paragraphs 1 and 2

Text proposed by the Commission

(48) ***In Article 54(1) and (2), the words 'either' and 'or to oppose the use of the later trade mark' are deleted;***

Amendment

(48) ***Paragraphs 1 and 2 of Article 54 are replaced by the following:***

'1. Where the proprietor of a European Union trade mark has acquiesced, for a period of five successive years, in the use of a later European Union trade mark in the Union 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 *European Union* trade mark was applied for in bad faith.

2. Where the proprietor of an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced, for a period of five successive years, in the use of a later *European Union* trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign [...] 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 *European Union* trade mark was applied for in bad faith.';

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 46

Proposal for a regulation

Article 1 – point 50

Regulation (EC) No 207/2009

Article 57 – paragraph 2

Text proposed by the Commission

(50) *In* Article 57(2), *second sentence*, 'was published' is replaced by 'was filed or at the priority date of the European trade mark application';

Amendment

(50) Article 57(2) is replaced by *the following*:

'2. If the proprietor of the *European Union* trade mark so requests, the proprietor of an earlier *European Union* trade mark, being a party to the invalidity proceedings, shall furnish

proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier *European Union* trade mark has been put to genuine use in the *Union* 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 the earlier *European Union* trade mark has at that date been registered for not less than five years. If, at the date on which the *European Union* trade mark application was filed or at the priority date of the *European Union* trade mark application, the earlier *European Union* trade mark had been registered for not less than five years, the proprietor of the earlier *European Union* trade mark shall furnish proof that, in addition, the conditions contained in Article 42(2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier *European Union* trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.';

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 47

Proposal for a regulation

Article 1 – point 51

Regulation (EC) No 207/2009

Article 57 a – point a

Text proposed by the Commission

Amendment

(a) the procedure governing the surrender of a European trade mark set out in Article 50, **including the period referred to in paragraph 3 of that Article**;

(a) the procedure governing the surrender of a European trade mark set out in Article 50;

Justification

The period should be directly established in the basic act. See also amendment to Article 50(3).

Amendment 48

Proposal for a regulation

Article 1 – point 56

Regulation (EC) No 207/2009

Article 65 a – point a

Text proposed by the Commission

Amendment

(a) the content of the notice of appeal referred to in Article 60 and the procedure for the filing and the examination of an appeal;

(a) the **formal** content of the notice of appeal referred to in Article 60 and the procedure for the filing and the examination of an appeal;

Justification

It needs to be clarified that only the formal content can be specified by delegated acts, not the content in terms of substance.

Amendment 49

Proposal for a regulation

Article 1 – point 56

Regulation (EC) No 207/2009

Article 65 a – point b

Text proposed by the Commission

Amendment

(b) the content and form of the Board of Appeal's decisions referred to in Article 64;

(b) the **formal** content and form of the Board of Appeal's decisions referred to in Article 64;

Justification

It needs to be clarified that only the formal content can be specified by delegated acts, not the content in terms of substance.

Amendment 50

Proposal for a regulation

Article 1 – point 60

Regulation (EC) No 207/2009

Article 67 – paragraph 1

Text proposed by the Commission

(60) *In* Article 67(1), *the words 'within the period prescribed' are replaced by 'within the period prescribed in accordance with Article 74a';*

Amendment

(60) Article 67(1) *is replaced by the following:*

'1. An applicant for a *European Union* collective mark *shall* submit regulations governing its use within a period of two months after the date of filing.'

Justification

The provision as proposed by the Commission would not be operational and the period would not be defined before the adoption of a delegated act in accordance with Article 74a. The period should therefore be directly established in the basic act. It is suggested to maintain the same length of period as in Rule 43(1) of Regulation (EC) No 2868/95.

Amendment 51

Proposal for a regulation

Article 1 – point 61 a (new)

Regulation (EC) No 207/2009

Article 71 – paragraph 3

Text proposed by the Commission

Amendment

(61a) Article 71(3) is replaced by the following:

'3. Written observations in accordance with Article 69 may also be submitted with regard to amended regulations governing use.'

Justification

This amendment clarifies the meaning of the sentence "Article 69 shall apply to amended regulations governing use". Related to the amendment on Article 74f(3).

Amendment 52

Proposal for a regulation

Article 1 – point 62

Regulation (EC) No 207/2009

Article 74 a

Text proposed by the Commission

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying ***the period referred to in Article 67(1) for submitting the regulations governing use of the European collective mark to the Agency and the content of those regulations as set out in Article 67(2).***

Amendment

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying the ***formal*** content of ***the regulations governing use of the European collective mark*** as set out in Article 67(2).

Justification

The period should be directly established in the basic act. See also amendment to Article 67(1).

Amendment 53

Proposal for a regulation

Article 1 – point 63

Regulation (EC) No 207/2009

Article 74 c – paragraph 1

Text proposed by the Commission

1. An applicant for a European certification mark shall submit regulations governing the use of the certification mark within ***the*** period ***prescribed in accordance with Article 74k.***

Amendment

1. An applicant for a European certification mark shall submit regulations governing the use of the certification mark within ***a*** period ***of two months after the date of filing.***

Justification

The provision as proposed by the Commission would not be operational and the period would not be defined before the adoption of a delegated act in accordance with Article 74a. The period should therefore be directly established in the basic act. It is suggested to establish the same length of period as foreseen for the regulations governing the use of collective marks. See also amendment to Article 74k.

Amendment 54

Proposal for a regulation

Article 1 – point 63

Regulation (EC) No 207/2009

Article 74f – paragraph 3

Text proposed by the Commission

Amendment

3. Article 74e **shall apply** to amended regulations governing use.

3. **Written observations in accordance with** Article 74e **may also be submitted with regard** to amended regulations governing use.

Justification

This amendment clarifies the meaning of the reference to Article 74e. Related to the amendment on Article 71(3).

Amendment 55

Proposal for a regulation

Article 1 – point 63

Regulation (EC) No 207/2009

Article 74 k

Text proposed by the Commission

Amendment

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying ***the period referred to in Article 74c(1) for submitting the regulations governing use of the European certification mark to the Agency and*** the content of ***those*** regulations as set out in Article 74c(2).';

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying the ***formal*** content of ***the*** regulations ***governing use of the European certification mark*** as set out in Article 74c(2).';

Justification

The period should be directly established in the basic act. It needs to be clarified that only the formal content of the regulations can be further specified by delegated acts, not the content in terms of substance. See also amendment to Article 74c(1).

Amendment 56

Proposal for a regulation

Article 1 – point 68

Regulation (EC) No 207/2009

Article 79 c – paragraph 1

Text proposed by the Commission

Amendment

1. ***The calculation and duration of*** time limits shall be ***subject to the rules adopted in accordance with Article 93a(f).***

1. Time limits shall be ***laid down in periods of full years, months, weeks or days. Calculation shall start on the day following the day on which the relevant***

event occurred.

Justification

The basic rules for the calculation of time limits should be established directly in the basic act. This amendment furthermore corrects the problem of circular cross-references in the Commission's proposal.

Amendment 57

Proposal for a regulation

Article 1 – point 68

Regulation (EC) No 207/2009

Article 79d

Text proposed by the Commission

The Agency shall correct any linguistic errors or errors of transcription and manifest oversights in the Agency's decisions or technical errors attributable to the Agency in registering the trade mark or in publishing its registration.

Amendment

The Agency shall correct any linguistic errors or errors of transcription and manifest oversights in the Agency's decisions or technical errors attributable to the Agency in registering the trade mark or in publishing its registration. ***The Agency shall keep records of any such corrections.***

Justification

The possibility for the agency to correct errors is useful but there should always be a record of which corrections have been made so that they can be traced.

Amendment 58

Proposal for a regulation

Article 1 – point 69 – point a

Regulation (EC) No 207/2009

Article 80 – paragraph 1

Text proposed by the Commission

(a) ***in*** paragraph 1, ***first sentence, the phrase 'decision which contains an obvious procedural error'*** is replaced by ***'decision which contains an obvious error'***;

Amendment

(a) paragraph 1 is replaced by ***the following:***

'1. Where the Agency has made an entry in the Register or taken a decision which contains an obvious [...] error attributable to the Agency, it shall ensure that the entry is cancelled or the

decision is revoked. Where there is only one party to the proceedings and the entry or the act affects its rights, cancellation or revocation shall be determined even if the error was not evident to the party.';

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 59

Proposal for a regulation

Article 1 – point 69 – point b

Regulation (EC) No 207/2009

Article 80 – paragraph 2

Text proposed by the Commission

(b) *in* paragraph 2, **the second sentence** is replaced by the following:

'The cancellation of the entry in the Register or the revocation of the decision shall be effected within one year from the date on which the entry was made in the Register or that decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the European trade mark in question that are entered in the Register.';

Amendment

(b) paragraph 2 is replaced by the following:

'2. Cancellation or revocation as referred to in paragraph 1 shall be determined, ex officio or at the request of one of the parties to the proceedings, by the department which made the entry or took the decision. The cancellation of the entry in the Register or the revocation of the decision shall be effected within one year from the date on which the entry was made in the Register or that decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the European **Union** trade mark in question that are entered in the Register. **The Agency shall keep records of any such cancellation or revocation.'**;

Justification

The inclusion of the first sentence is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more sentences (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation). Added last sentence: These cancellations / revocations should be entered into the register in order to be traceable.

Amendment 60

Proposal for a regulation

Article 1 – point 71

Regulation (EC) No 207/2009

Article 82 a

Text proposed by the Commission

When interrupting or resuming proceedings, the Agency shall comply with the modalities set out in accordance with Article 93a(i).';

Amendment

1. Proceedings before the Agency shall be interrupted:

(a) in the event of the death or legal incapacity of the applicant for or proprietor of a European Union trade mark or of the person authorised by national law to act on his behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Article 93, proceedings shall be interrupted only on application by such representative;

(b) in the event of the applicant for or proprietor of a European Union trade mark being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the Agency;

(c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European Union trade mark or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the Agency.

(2) When, in the cases referred to in points (a) and (b) of paragraph 1, the Agency has been informed of the identity of the person authorised to continue the proceedings before the Agency, the Agency shall inform that person and any interested third parties that the proceedings will be resumed as from a date to be fixed by the Agency.

(3) In the case referred to in point (c) of paragraph 1, the proceedings shall be

resumed when the Agency has been informed of the appointment of a new representative of the applicant or when the Agency has notified to the other parties the appointment of a new representative of the proprietor of the European Union trade mark. If, three months after the beginning of the interruption of the proceedings, the Agency has not been informed of the appointment of a new representative, it shall inform the applicant for or proprietor of the European Union trade mark:

(a) where Article 92(2) is applicable, that the European Union trade mark application will be deemed to be withdrawn if the information is not submitted within two months after this notification; or

(b) where Article 92(2) is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the European Union trade mark as from the date of this notification.

(4) The time limits, other than the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the European Union trade mark at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed.

Justification

The rules for the interruption of proceedings should be established directly in the basic act. It is suggested to take over the rules established in Rule 73 of Regulation (EC) No 2868/95. This amendment furthermore corrects the problem of circular cross-references in the Commission's proposal.

Amendment 61

Proposal for a regulation

Article 1 – point 73

Regulation (EC) No 207/2009

Article 85 – paragraph 1

Text proposed by the Commission

Amendment

(73) **In** Article 85(1), **the words 'under the conditions laid down in the Implementing Regulation' are replaced by 'under the conditions laid down in accordance with Article 93a(j).';**

(73) Article 85(1) **is replaced by the following:**

'1. The losing party in opposition proceedings, proceedings for revocation, proceedings for a declaration of invalidity or appeal proceedings shall bear the fees incurred by the other party as well as all costs, without prejudice to Article 119(6), incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of the scales set for each category of costs [...].';

Justification

The deletion of the words "under the conditions laid down in accordance with Article 93a(j)" corrects the problem of circular cross-references in the Commission's proposal.

Amendment 62

Proposal for a regulation

Article 1 – point 75

Regulation (EC) No 207/2009

Article 87 – paragraph 1

Text proposed by the Commission

Amendment

1. The Agency shall keep a Register, **which shall contain those particulars the registration or inclusion of which is provided for by this Regulation or by a delegated act adopted pursuant to this Regulation. The Agency shall keep the** Register up to date.

1. The Agency shall keep a Register **of European Union trade marks and** shall keep **that** Register up to date.

Justification

It is obvious that the Register contains the particulars which are provided for by the Regulation. This amendment also corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 93a(k).

Amendment 63

Proposal for a regulation

Article 1 – point 77

Regulation (EC) No 207/2009

Article 89 – paragraph 1 – point a

Text proposed by the Commission

Amendment

(a) a European Trade Marks Bulletin containing entries made in the Register as well as other particulars ***the publication of which is prescribed by this Regulation or by delegated acts adopted in accordance with this Regulation;***

(a) a European Trade Marks Bulletin containing entries made in the Register as well as other particulars;

Justification

It is obvious that the European Trade Marks Bulletin contains the particulars which are provided for by the Regulation and does hence not to be explicitly mentioned. This amendment also corrects the problem of circular cross-references in the Commission's proposal.

Amendment 64

Proposal for a regulation

Article 1 – point 78

Regulation (EC) No 207/2009

Article 92 – paragraph 2 – subparagraph 2

Text proposed by the Commission

Amendment

By way of derogation from the first subparagraph, the natural or legal persons referred to in that subparagraph need not be represented before the Agency in the cases provided for in accordance with Article 93a(p).';

deleted

Justification

This subparagraph has no added legal value because it simply refers to the content of delegated acts to be adopted in the future. This amendment corrects the problem of circular cross-references in the Commission's proposal.

Amendment 65

Proposal for a regulation

Article 1 – point 78

Regulation (EC) No 207/2009

Article 92 – paragraph 4

Text proposed by the Commission

Amendment

'4. Where the conditions established in accordance with Article 93a(p) are fulfilled, a common representative shall be appointed.'; **deleted**

Justification

This subparagraph has no added legal value because it just refers to the content of delegated acts to be adopted in the future. This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 93a(p).

Amendment 66

Proposal for a regulation

Article 1 – point 79

Regulation (EC) No 207/2009

Article 93 – paragraph 5

Text proposed by the Commission

Amendment

'5. A person may be removed from the list of professional representatives under the conditions established in accordance with Article 93a(p).'; **deleted**

Justification

This subparagraph has no added legal value because it just refers to the content of delegated acts to be adopted in the future. This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 93a(p).

Amendment 67

Proposal for a regulation

Article 1 – point 80

Regulation (EC) No 207/2009

Article 93 a – point j

Text proposed by the Commission

Amendment

(j) the procedures concerning the apportionment and fixing of costs, as referred to in Article 85(I);

(j) the procedures concerning the apportionment and fixing of costs as referred to in Article 85;

Justification

Correction of the reference. The apportionment and fixing of costs is further regulated in other

paragraphs of Article 85.

Amendment 68

Proposal for a regulation

Article 1 – point 80

Regulation (EC) No 207/2009

Article 93a – point k

Text proposed by the Commission

Amendment

(k) the particulars referred to in Article 87(1);

(k) the particulars ***to be entered in the Register*** referred to in Article 87;

Justification

This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 87(1).

Amendment 69

Proposal for a regulation

Article 1 – point 80

Regulation (EC) No 207/2009

Article 93 a – point l

Text proposed by the Commission

Amendment

(l) the procedure for the inspection of files provided for in Article 88, including the parts of the file excluded from inspection, and the modalities of the keeping of files of the Agency provided for in Article 88(5);

deleted

Amendment 70

Proposal for a regulation

Article 1 – point 80

Regulation (EC) No 207/2009

Article 93 a – point p

Text proposed by the Commission

Amendment

(p) derogations from the obligation to be represented before the Agency pursuant to Article 92(2), the conditions under which a common representative shall be appointed ***pursuant to Article 92(4)***, the conditions under which employees referred to in

(p) derogations from the obligation to be represented before the Agency pursuant to Article 92(2), the conditions under which a common representative shall be appointed, the conditions under which employees referred to in Article 92(3) and

Article 92(3) and professional representatives referred to in Article 93(1) must file with the Agency a signed authorisation in order to be able to undertake representation, the content of that authorisation, and the conditions under which a person may be removed from the list of professional representatives ***referred to in Article 93(5).***';

professional representatives referred to in Article 93(1) must file with the Agency a signed authorisation in order to be able to undertake representation, the content of that authorisation, and the conditions under which a person may be removed from the list of professional representatives.';

Justification

This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendments on Article 92(4) and (5).

Amendment 71

Proposal for a regulation

Article 1 – point 82 – point b

Regulation (EC) No 207/2009 EC

Article 94 – paragraph 1

Text proposed by the Commission

(b) ***in*** paragraph 1, '***Regulation (EC) No 44/2001***' is replaced by '***the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters***';

Amendment

(b) paragraph 1 is replaced by ***the following:***

'1. Unless otherwise specified in this Regulation, the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters shall apply to proceedings relating to European Union trade marks and applications for European Union trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of European Union trade marks and national trade marks.'

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 72

Proposal for a regulation

Article 1 – point 88

Regulation (EC) No 207/2009

Article 113 – paragraph 3

Text proposed by the Commission

(88) *In* Article 113(3), *the phrase 'together with the formal conditions laid down in the Implementing Regulation'* is replaced by '*together with the formal conditions laid down in accordance with Article 114a*';

Amendment

(88) Article 113(3) is replaced by *the following*:

'3. The Agency shall check whether the conversion requested fulfils the conditions set out in this Regulation, in particular Article 112(1), (2), (4), (5) and (6), and paragraph 1 of this Article, together with the formal conditions laid down in accordance with Article 114a. If these conditions are fulfilled, the Agency shall transmit the request for conversion to the industrial property offices of the Member States specified therein.'

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 73

Proposal for a regulation

Article 1 – point 89

Regulation (EC) No 207/2009

Article 114 – paragraph 2

Text proposed by the Commission

(89) *In* Article 114(2), *the words 'the Implementing Regulation'* are replaced by '*delegated acts adopted in accordance with this Regulation*';

Amendment

(89) Article 114(2) *is* replaced by *the following*:

'2. A European Union trade mark application or a European Union trade mark transmitted in accordance with

Article 113 shall not be subjected to formal requirements of national law which are different from or additional to those provided for in this Regulation or in delegated acts adopted pursuant to this Regulation.';

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 74

Proposal for a regulation

Article 1 – point 92

Regulation (EC) No 207/2009 C

Article 117

Text proposed by the Commission

(92) ***In*** Article 117, ***the words 'to the Office' are replaced by 'to the Agency and its staff';***

Amendment

(92) Article 117 ***is replaced by the following:***

'The Protocol on the Privileges and Immunities of the European Union shall apply to the Agency and its staff.';

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 75

Proposal for a regulation

Article 1 – point 94

Regulation (EC) No 207/2009 EC

Article 120 – paragraph 1

Text proposed by the Commission

(94) ***In*** Article 120(1), ***the words 'the Implementing Regulation' are replaced by 'a delegated act adopted pursuant to this Regulation';***

Amendment

(94) Article 120(1) ***is replaced by the following:***

'1. An application for a European Union

trade mark, as described in Article 26(1), and all other information the publication of which is prescribed by this Regulation or by a delegated act adopted pursuant to this Regulation, shall be published in all the official languages of the European Union.';

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 76

Proposal for a regulation

Article 1 – paragraph 1 – point 98

Regulation (EC) No 207/2009

Article 123 b – paragraph 1 – point d a (new)

Text proposed by the Commission

Amendment

(da) the tasks conferred on it by Directive 2012/28/EU.*

** Directive 2012/28/EU of the European Parliament and of the Council of 25 October 2012 on certain permitted uses of orphan works (OJ L 299, 27.10.2012, p. 5).*

Amendment 77

Proposal for a regulation

Article 1 – paragraph 1 – point 98

Regulation (EC) No 207/2009

Article 123 b – paragraph 3

Text proposed by the Commission

Amendment

3. The Agency may provide voluntary mediation services for the purpose of assisting parties in reaching an amicable settlement.

3. The Agency may provide voluntary mediation *and arbitration* services for the purpose of assisting parties in reaching an amicable settlement.

Amendment 78

Proposal for a regulation

Article 1 – point 98

Regulation (EC) No 207/2009

Article 123c – paragraph 1 – subparagraph 2 – introductory part

Text proposed by the Commission

This cooperation shall cover the following areas of activity:

Amendment

This cooperation shall cover, *inter alia*, the following areas of activity:

Justification

This list should not be exhaustive as this could limit the possibility to flexibly initiate useful projects in the future.

Amendment 79

Proposal for a regulation

Article 1 – point 98

Regulation (EC) No 207/2009

Article 123c – paragraph 2

Text proposed by the Commission

2. The Agency shall define, elaborate and coordinate common projects of *Union* interest with regard to the areas referred to in paragraph 1. The project definition shall *contain* the specific obligations and responsibilities of each participating industrial property office of the Member States and the Benelux Office for Intellectual Property.

Amendment

2. The Agency shall define, elaborate and coordinate common projects of interest *to the Union and Member States* with regard to the areas referred to in paragraph 1. The project definition shall *set out* the specific obligations and responsibilities of each participating industrial property office of the Member States and the Benelux Office for Intellectual Property. *Throughout all phases of the common projects, the Agency shall consult with users' representatives.*

Amendment 80

Proposal for a regulation

Article 1 – point 98

Regulation (EC) No 207/2009

Article 123c – paragraph 3 – subparagraph 1 a (new)

Text proposed by the Commission

Amendment

Nevertheless, if the outcome of those projects leads to the development of

instruments that a Member State considers, by way of a substantiated decision, to be equivalent to instruments which already exist in that Member State, the participation in the cooperation project shall not give rise to an obligation to implement the outcome in that Member State.

Amendment 81

Proposal for a regulation

Article 1 – point 98

Regulation (EC) No 207/2009

Article 123c – paragraph 4

Text proposed by the Commission

4. The Agency shall provide financial support to the common projects of Union **interest** referred to in paragraph 2 to the extent this is necessary to ensure the effective participation of the industrial property offices of the Member States and the Benelux Office for Intellectual Property in the projects within the meaning of paragraph 3. That financial support may take the form of grants. The total amount of funding shall not exceed **10%** of the yearly income of the Agency. The beneficiaries of grants shall be the industrial property offices of the Member States and the Benelux Office for Intellectual Property. Grants may be awarded without calls for proposals in accordance with the financial rules applicable to the Agency and with the principles of grant procedures contained in **the Financial** Regulation (EU) No 966/2012 of the European Parliament and of the Council and in **the** Commission **delegated** Regulation (EU) No 1268/2012 (****).

Amendment

4. The Agency shall provide financial support to the common projects of **interest to the Union and Member States** referred to in paragraph 2 to the extent **that** this is necessary **in order** to ensure the effective participation of the industrial property offices of the Member States and the Benelux Office for Intellectual Property in the projects within the meaning of paragraph 3. That financial support may take the form of grants. The total amount of funding shall not exceed **20%** of the yearly income of the Agency **and shall cover the minimum amount for every Member State for purposes closely related to the participation in common projects.** The beneficiaries of grants shall be the industrial property offices of the Member States and the Benelux Office for Intellectual Property. Grants may be awarded without calls for proposals in accordance with the financial rules applicable to the Agency and with the principles of grant procedures contained in Regulation (EU, **Euratom**) No 966/2012 of the European Parliament and of the Council (**) and in Commission **Delegated** Regulation (EU) No 1268/2012 (****).

(**) OJ L 298, 26.10.2012, p. 1.
(**) OJ L 362, 31.12.2012, p. 1.';

(**) OJ L 298, 26.10.2012, p. 1.
(**) OJ L 362, 31.12.2012, p. 1.';

Amendment 82

Proposal for a regulation

Article 1 – point 99

Regulation (EC) No 207/2009

Article 124 – paragraph 1 – point i a (new)

Text proposed by the Commission

Amendment

(ia) the Management Board shall define and elaborate common projects of interest to the Union and Member States in accordance with Article 123c;

Amendment 83

Proposal for a regulation

Article 1 – paragraph 1 – point 99

Regulation (EC) No 207/2009

Article 124 – paragraph 1 – point f

Text proposed by the Commission

Amendment

(f) in accordance with paragraph 2, it shall exercise, with respect to the staff of the Agency, the powers conferred by the Staff Regulations on the Appointing Authority and by the Conditions of Employment of Other Servants on the Authority Empowered to Conclude Contract of Employment (“the appointing authority powers”);

deleted

Amendment 84

Proposal for a regulation

Article 1 – paragraph 1 – point 99

Regulation (EC) No 207/2009

Article 124 – paragraph 2

Text proposed by the Commission

Amendment

2. The Management Board shall adopt, in accordance with Article 110 of the Staff Regulations and 142 of the Conditions of Employment of Other Servants, a decision

deleted

based on Article 2(1) of the Staff Regulations and on Article 6 of the Conditions of Employment of Other Servants, delegating the relevant appointing authority powers to the Executive Director and defining the conditions under which this delegation of powers can be suspended.

The Executive Director shall be authorised to sub-delegate those powers.

Where exceptional circumstances so require, the Management Board may by way of a decision temporarily suspend the delegation of the appointing authority powers to the Executive Director and those sub-delegated by the latter and exercise them itself or delegate them to one of its members or to a staff member other than the Executive Director.

Amendment 85

Proposal for a regulation

Article 1 – point 99

Regulation (EC) No 207/2009

Article 125 – paragraph 1

Text proposed by the Commission

1. The Management Board shall be composed of one representative of each Member State **and** two representatives of the Commission and their alternates.

Amendment

1. The Management Board shall be composed of one representative of each Member State, two representatives of the Commission and ***one representative of the European Parliament and*** their ***respective*** alternates.

Justification

Point 10 in the Common Approach on Agencies states that "The composition of the board should be: [...] - Where appropriate, one member designated by the European Parliament, without prejudice to the relevant arrangements for existing agencies". It thus seems natural to include at least one member of the management board designated by the European Parliament.

Amendment 86

Proposal for a regulation

Article 1 – point 99

Regulation (EC) No 207/2009

Title XII – Section 2a

SECTION 2a

deleted

Executive Board

Article 127a

Establishment

The Management Board may establish an Executive Board.

Article 127b

Functions and organisation

1. The Executive Board shall assist the Management Board.

2. The Executive Board shall have the following functions:

(a) preparing decisions to be adopted by the Management Board;

(b) ensuring, together with the Management Board, adequate follow-up to the findings and recommendations stemming from the internal or external audit reports and evaluations, as well as from investigations of the European Antifraud Office (OLAF);

(c) without prejudice to the functions of the Executive Director, as set out in Article 128, assisting and advising the Executive Director in the implementation of the decisions of the Management Board, with a view to reinforcing supervision of administrative management.

3. When necessary, because of urgency, the Executive Board may take certain provisional decisions on behalf of the Management Board, in particular on administrative management matters, including the suspension of the delegation of the appointing authority powers.

4. The Executive Board shall be composed of the Chairperson of the Management Board, one representative of the Commission to the Management Board and three other members appointed by the

Management Board from among its members. The Chairperson of the Management Board shall also be the Chairperson of the Executive Board. The Executive Director shall take part in the meetings of the Executive Board, but shall not have the right to vote.

5. The term of office of members of the Executive Board shall be four years. The term of office of members of the Executive Board shall end when their membership of the Management Board ends.

6. The Executive Board shall hold at least one ordinary meeting every three months. In addition, it shall meet on the initiative of its Chairperson or at the request of its members.

7. The Executive Board shall comply with the rules of procedure laid down by the Management Board.

Justification

The joint statement (point 10) states that a two-level governance structure should be introduced "when it promises more efficiency". There does not seem to be any convincing evidence that such an Executive Board would provide additional efficiency in this agency, rather it would risk adding a new bueraucratic layer and leading to less transparency for non-members of the Exectuve Board as well as users.

Amendment 87

Proposal for a regulation

Article 1 – point 99

Regulation (EC) No 207/2009

Article 127 – paragraph 3

Text proposed by the Commission

3. The Management Board shall hold an ordinary meeting **once** a year. In addition, it shall meet on the initiative of its chairperson or at the request of the Commission or of one-third of the Member States.

Amendment

3. The Management Board shall hold an ordinary meeting **twice** a year. In addition, it shall meet on the initiative of its chairperson or at the request of the Commission, **of the European Parliament** or of one-third of the Member States.

Justification

It would seem reasonable that all three institutions have the right to convene the management

board. Also the Management Board should continue to meet two times per year as is currently the practice for the corresponding administrative board. This change is further suggested as the executive board is proposed to be deleted.

Amendment 88

Proposal for a regulation

Article 1 – point 99

Regulation (EC) No 207/2009

Article 127 – paragraph 5

Text proposed by the Commission

5. The Management Board shall take its decisions by an absolute majority of its members. However, a majority of two-thirds of its members shall be required for the decisions which the Management Board is empowered to take under Article 124(1)(a) and (b), Article 126(1) and Article 129(2) and (4). In both cases each member shall have one vote.

Amendment

5. The Management Board shall take its decisions by an absolute majority of its members. However, a majority of two-thirds of its members shall be required for the decisions which the Management Board is empowered to take under *points (a) and (b) of* Article 124(1), Article 126(1) and Article 129(2) and (3). In both cases each member shall have one vote.

Justification

Consequence of amendment of Article 129 (3) and (4).

Amendment 89

Proposal for a regulation

Article 1 – paragraph 1 – point 99

Regulation (EC) No 207/2009

Article 128 – paragraph 4 – point m

Text proposed by the Commission

(m) he shall exercise the powers entrusted to him in respect of the staff by the Management Board under Article 124(1)(f);

Amendment

deleted

Amendment 90

Proposal for a regulation

Article 1 – paragraph 1 – point 99

Regulation (EC) No 207/2009

Article 128 – paragraph 4 – point m a (new)

Text proposed by the Commission

Amendment

(ma) he may submit to the Commission any proposal to amend this Regulation, the delegated acts adopted pursuant to this Regulation and any other rules applying to European Union trade marks after consulting the Management Board and, in the case of fees and budgetary provisions laid down by this Regulation, the Budget Committee;

Justification

The addition corresponds largely to current Article 124 (2) (b) of the CTMR. The provision would naturally be without prejudice to the right of initiative of the European Commission and would only be a suggestion that the commission can choose whether to act or not to act on. Nevertheless it would be reasonable to give this formal way for the office to express an opinion on how to improve the functioning of the European Trademark ecosystem.

Amendment 91

Proposal for a regulation

Article 1 – paragraph 1 – point 99

Regulation (EC) No 207/2009

Article 128 – paragraph 4 – point 1 a (new)

Text proposed by the Commission

Amendment

(la) without prejudice to Articles 125 and 136, he shall exercise, with respect to the staff of the Agency, the powers conferred by the Staff Regulations on the Appointing Authority and by the Conditions of Employment of Other Servants on the Authority Empowered to Conclude Contracts of Employment ("the appointing authority powers");

Amendment 92

Proposal for a regulation

Article 1 – point 99

Regulation (EC) No 207/2009

Article 129

Text proposed by the Commission

Amendment

1. The Executive Director shall be engaged

1. The Executive Director shall be engaged

as a temporary agent of the Agency under Article 2(a) of the Conditions of Employment of Other Servants.

2. The Executive Director shall be appointed by the Management Board, from a list of candidates proposed by *the Commission*, following an open and transparent selection procedure. Before being appointed, the candidate selected by the Management Board may be invited to make a statement before any competent European Parliament committee and to answer questions put by its members. For the purpose of concluding the contract with the Executive Director, the Agency shall be represented by the chairperson of the Management Board.

The Executive Director may be removed from office only upon a decision of the Management Board acting on a proposal from the *European* Commission.

3. The term of office of the Executive Director shall be five years. By the end of that period, the *Commission* shall undertake an assessment which takes into account an evaluation of the performance of the Executive Director and the Agency's future tasks and challenges.

as a temporary agent of the Agency under Article 2(a) of the Conditions of Employment of Other Servants.

2. The Executive Director shall be appointed by the Management Board from a list of *at least three* candidates proposed by *a pre-selection committee of the Management Board composed of representatives of the Member States, of the Commission and of the European Parliament*, following an open and transparent selection procedure *and the publication, in the Official Journal of the European Union and elsewhere, of a call for expressions of interest*. Before being appointed, the candidate selected by the Management Board may be invited to make a statement before any competent European Parliament committee and to answer questions put by its members. For the purpose of concluding the contract with the Executive Director, the Agency shall be represented by the chairperson of the Management Board.

The Executive Director may be removed from office only upon a decision of the Management Board acting on a proposal from the Commission, *after an evaluation report has been prepared by the Commission at the request of the Management Board or the European Parliament*.

3. The term of office of the Executive Director shall be five years. By the end of that period, the *Management Board* shall undertake an assessment which takes into account an evaluation of the performance of the Executive Director and the Agency's future tasks and challenges. *The Management Board may extend once the term of office of the Executive Director for no more than five years. The Management Board, when taking its decisions on the extension of the term of office of the Executive Director, shall take into account the Commission's assessment report of the Executive Director's performance as well as the*

Agency's future tasks and challenges.

4. The Management Board, acting on a proposal from the Commission which takes into account the assessment referred to in paragraph 3, may extend once the term of office of the Executive Director for no more than five years.

5. An Executive Director whose term of office has been extended may not participate in another selection procedure for the same post at the end of the overall period.

6. The Deputy Executive Director or Deputy Executive Directors shall be appointed or removed from office as provided for in paragraph 2, after consultation of the Executive Director and, where applicable, the Executive Director elect. The term of office of the Deputy Executive Director shall be five years. It may be extended once for no more than five years by the Management Board ***acting on a proposal from the Commission*** as provided for in paragraph 4, after consultation of the Executive Director.

5. An Executive Director whose term of office has been extended may not participate in another selection procedure for the same post at the end of the overall period.

6. The Deputy Executive Director or Deputy Executive Directors shall be appointed or removed from office as provided for in paragraph 2, after consultation of the Executive Director and, where applicable, the Executive Director-elect. The term of office of the Deputy Executive Director shall be five years. It may be extended once for no more than five years by the Management Board as provided for in paragraph 3, after consultation of the Executive Director.

Amendment 93

Proposal for a regulation

Article 1 – paragraph 1 – point 106

Regulation (EC) No 207/2009

Article 136 a (new)

Text proposed by the Commission

Amendment

Article 136a

Mediation and arbitration centre

1. The Agency may establish a mediation and arbitration centre which is independent of the decision-making instances listed in Article 130. The centre shall be located on the Agency's premises.

2. Any natural or legal person may use the centre's services on a voluntary basis with the aim of resolving, by mutual agreement, disputes covered by this

Regulation and by Directive ...

3. The Agency may also start an arbitration procedure on its own initiative with a view to giving parties the opportunity to reach an agreement by common consent.

4. The centre shall be led by a director who shall be responsible for the centre's activities.

5. The director shall be appointed by the Management Board.

6. The centre shall draw up rules governing mediation and arbitration procedures and rules governing the centre's work. The rules governing mediation and arbitration procedures and the rules governing the centre's work shall be ratified by the Management Board.

7. The centre shall establish a register of mediators and arbitrators who help parties to resolve disputes. They must be independent and possess relevant skills and experience. The register shall require the approval of the Management Board.

8. Examiners and members of the Division of the Institute or Boards of Appeal may not take part in any mediation or arbitration concerning a case in which they have:

(a) any prior involvement in the procedures undergoing mediation or arbitration;

(b) any personal interest; or

(c) been previously involved as a representative of one of the parties.

9. No person called to testify as a member of an arbitration or mediation panel may be involved in the objection, annulment or proceedings which gave rise to the mediation or arbitration process.';

Amendment 94

Proposal for a regulation

Article 1 – point 108

Regulation (EC) No 207/2009

Article 139 – paragraph 4

Text proposed by the Commission

4. The Agency shall prepare on a biannual basis a report to the Commission on its financial situation. On the basis of **this** report, the Commission shall review the financial situation of the Agency.

Amendment

4. The Agency shall prepare on a biannual basis a report to the **European Parliament, the Council and the** Commission on its financial situation. On the basis of **that** report, the Commission shall review the financial situation of the Agency.

Justification

It would be reasonable to clearly state that this report should be transmitted also to the European Parliament and Council.

Amendment 95

Proposal for a regulation

Article 1 – point 108

Regulation (EC) No 207/2009

Article 139 – paragraph 4 a (new)

Text proposed by the Commission

Amendment

4a. The Agency shall provide for a reserve fund covering one year of its operational expenditure to ensure the continuity of its operations.

Justification

Recital 43 of the Commission's proposal foresees that, 'in the interest of sound financial management, the accumulation of significant budgetary surpluses should be avoided' and 'this should be without prejudice to the Agency maintaining a financial reserve covering one year of its operational expenditure to ensure the continuity of its operations and the execution of its tasks'. The following paragraph clarifies that such a fund shall be maintained. As a matter of fact, sound financial management requires not only that an excessive accumulation of surplus takes place, but also that a prudential reserve fund is created in order to cope with unexpected drops in income or unforeseeable expenditures, which could hamper the continuity of the Agency's operations.

Amendment 96

Proposal for a regulation

Article 1 – point 110

Regulation (EC) No 207/2009

Article 144 – paragraph 2

Text proposed by the Commission

2. The amounts of the fees referred to in paragraph 1 shall be fixed at ***such level*** as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Agency to be balanced while avoiding the accumulation of significant surpluses. ***Without prejudice to Article 139(4), the Commission shall review the level of fees should a significant surplus become recurrent. If this review does not lead to a reduction or modification in the level of fees which has the effect of preventing the further accumulation of a significant surplus, the surplus accumulated after the review shall be transferred to the budget of the Union.***

Amendment

2. The amounts of the fees referred to in paragraph 1 shall be fixed at ***the levels set out in Annex -I so*** as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Agency to be balanced while avoiding the accumulation of significant surpluses.

Justification

The fees structure is an important element of the EU trade mark system and should therefore be directly regulated in the Regulation and not left to delegated acts. This implies that the Commission would be unable to review and modify the level of fees by itself. It should also be noted that no money should flow back from the Agency either to the EU-budget or the general budgets of Member States, or their national offices, with the exception of grants related to the cooperation and convergence projects.

Amendment 97

Proposal for a regulation

Article 1 – paragraph 1 – point 111

Regulation (EC) No 207/2009

Article 144a – point c

Text proposed by the Commission

(c) the details on the organisation of the Boards of Appeal, including the setting up and the role of the authority of the Boards of Appeal referred to in Article 135(3)(a), the composition of the enlarged Board and the rules on referrals to it as referred

Amendment

deleted

to in Article 135(4), and the conditions under which decisions shall be taken by a single member in accordance with Article 135(2) and (5);

Amendment 98

Proposal for a regulation

Article 1 – paragraph 1 – point 111

Regulation (EC) No 207/2009

Article 144a – point d

Text proposed by the Commission

Amendment

(d) the system of fees and charges payable to the Agency in accordance with Article 144, including the amount of fees, the methods of payment, the currencies, the due date for fees and charges, the deemed date of payment and the consequences of lack of or late payment, and under- and overpayment, the services which may be free of charge, and the criteria under which the Executive Director may exercise the powers set out in Article 144(3) and (4).

deleted

Amendment 99

Proposal for a regulation

Article 1 – point 112

Regulation (EC) No 207/2009

Article 145

Text proposed by the Commission

Amendment

(112) In Article 145, the words 'its Implementing Regulations' are replaced by 'the delegated acts adopted pursuant to this Regulation';

(112) Article 145 is replaced by the following:

'Article 145

Application of provisions

Unless otherwise specified in this title, this Regulation and the delegated acts adopted pursuant to this Regulation shall apply to applications for international registrations under the Protocol relating to the Madrid Agreement concerning the

international registration of marks, adopted at Madrid on 27 June 1989 (hereafter referred to as ‘international applications’ and ‘the Madrid Protocol’ respectively), based on an application for a *European Union* trade mark or on a *European Union* trade mark and to registrations of marks in the international register maintained by the International Bureau of the World Intellectual Property Organisation (hereafter referred to as ‘international registrations’ and ‘the International Bureau’, respectively) designating the *European Union*.’;

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 100

Proposal for a regulation

Article 1 – point 113

Regulation (EC) No 207/2009

Article 147 – paragraph 5

Text proposed by the Commission

Amendment

5. The international application shall **deleted**
fulfil the formal conditions established in
accordance with Article 161a(a).

Justification

This paragraph has no added legal value because it just refers to the content of delegated acts to be adopted in the future. This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 161a(a).

Amendment 101

Proposal for a regulation

Article 1 – point 114

Regulation (EC) No 207/2009

Article 148 a

Text proposed by the Commission

Amendment

Within a period of five years from the date of the international registration, the Agency shall notify the International Bureau of ***the*** facts and decisions affecting the validity of the European trade mark application or the European trade mark registration on which the international registration was based.

During a period of five years from the date of the international registration, the Agency shall notify the International Bureau of ***any*** facts and decisions affecting the validity of the European ***Union*** trade mark application or the European ***Union*** trade mark registration on which the international registration was based.

Justification

This amendment clarifies that the period of five years is not a time limit, but the period during which any relevant facts and decisions are to be notified.

Amendment 102

Proposal for a regulation

Article 1 – point 115

Regulation (EC) No 207/2009

Article 149 – second sentence

Text proposed by the Commission

Amendment

'The request shall fulfil the formal conditions established in accordance with Article 161a(c).';

deleted

Justification

This paragraph has no added legal value because it just refers to the content of delegated acts to be adopted in the future. This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 161a(c).

Amendment 103

Proposal for a regulation

Article 1 – point 117

Regulation (EC) No 207/2009

Article 154 a

Text proposed by the Commission

Amendment

Where an international registration is based on a basic application or basic registration relating to a collective mark, certification mark or guarantee mark, ***the Agency shall comply with the procedures provided for***

Where an international registration is based on a basic application or basic registration relating to a collective mark, certification mark or guarantee mark, ***the international registration designating the European***

in accordance with Article 161a(f).

Union shall be dealt with as a European Union collective mark. The holder of the international registration shall submit the regulations governing use of the mark as provided for in Article 67 directly to the Agency within a period of two months from the date on which the International Bureau notifies the international registration to the Agency.

Justification

The procedures with regard to such international registrations should not entirely be left to delegated acts, but some basic rules should be established directly in the basic act. It is suggested to take over some of the rules established in Rule 121 of Regulation (EC) No 2868/95. This amendment furthermore corrects the problem of circular cross-references in the Commission's proposal.

Amendment 104

Proposal for a regulation

Article 1 – point 119 – point a

Regulation (EC) No 207/2009

Article 156 – paragraph 2

Text proposed by the Commission

(a) *in* paragraph 2, *the words 'six months' are replaced by 'one month';*

Amendment

(a) paragraph 2 *is replaced by the following:*

'2. Notice of opposition shall be filed within a period of three months which shall begin *one month* following the date of the publication pursuant to Article 152(1). The opposition shall not be treated as duly entered until the opposition fee has been paid.'

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 105

Proposal for a regulation

Article 1 – point 120

Regulation (EC) No 207/2009

Article 158 c

Text proposed by the Commission

The Agency shall transmit requests to register a change in ownership, a license or a restriction of the holder's right of disposal, the amendment or cancellation of a license or the removal of a restriction of the holder's right of disposal which have been filed with it to the International Bureau ***in the cases specified in accordance with Article 161a(h).***

Amendment

The Agency shall transmit requests to register a change in ownership, a license or a restriction of the holder's right of disposal, the amendment or cancellation of a license or the removal of a restriction of the holder's right of disposal which have been filed with it to the International Bureau.

Justification

Article 161a(h) does not specify cases, but the modalities of the transmission of the request.

Amendment 106

Proposal for a regulation
Article 1 – point 121 – point b
Regulation (EC) No 207/2009
Article 159 – paragraph 2

Text proposed by the Commission

(b) ***in*** paragraph 2, ***the words 'or the Madrid Agreement' are deleted;***

Amendment

(b) paragraph 2 ***is replaced by the following:***

'2. The national trade mark application or the designation of a Member State party to the Madrid Protocol [...] resulting from the conversion of the designation of the European *Union* through an international registration shall enjoy, in respect of the Member State concerned, the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date of the extension to the European *Union* pursuant to Article 3ter(2) of the Madrid Protocol if the latter was made subsequently to the international registration, or the date of priority of that registration and, where appropriate, the seniority of a trade mark of that State claimed under Article 153.'

Justification

This is a technical change, not a change in substance. In the interest of clarity, the replacement of complete units of texts is preferable to the replacement of just one or more terms (see point 18.12.1 of the Joint Practical Guide for persons involved in the drafting of legislation).

Amendment 107

Proposal for a regulation

Article 1 – point 122

Regulation (EC) No 207/2009

Article 161 a – point a

Text proposed by the Commission

(a) the formal conditions of an international application ***referred to in Article 147(5)***, the procedure for the examination of the international application pursuant to Article 147(6) and the modalities of forwarding the international application to the International Bureau pursuant to Article 147(4);

Amendment

(a) the formal conditions of an international application, the procedure for the examination of the international application pursuant to Article 147(6) and the modalities of forwarding the international application to the International Bureau pursuant to Article 147(4);

Justification

This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 147(5).

Amendment 108

Proposal for a regulation

Article 1 – point 122

Regulation (EC) No 207/2009

Article 161 a – point c

Text proposed by the Commission

(c) the formal conditions of a request for territorial extension ***as referred to in Article 149(2)***, the procedure for the examination of those conditions and the modalities of forwarding the request for territorial extension to the International Bureau;

Amendment

(c) the formal conditions of a request for territorial extension, the procedure for the examination of those conditions and the modalities of forwarding the request for territorial extension to the International Bureau;

Justification

This amendment corrects the problem of circular cross-references in the Commission's

proposal. See also amendment to Article 149, second sentence.

Amendment 109

Proposal for a regulation

Article 1 – point 122

Regulation (EC) No 207/2009

Article 161 a – point k

Text proposed by the Commission

(k) the modalities of communications between the Agency and the International Bureau, including the communications to be made pursuant to Articles **147(4)**, 148a, 153(2) and 158c.

Amendment

(k) the modalities of communications between the Agency and the International Bureau, including the communications to be made pursuant to Articles 148a, 153(2) and 158c.

Justification

There is no "communication to be made" pursuant to Article 147(4).

Amendment 110

Proposal for a regulation

Article 1 – paragraph 1 – point 125

Regulation (EC) No 207/2009

Article 163 – paragraph 5

Text proposed by the Commission

5. A delegated act adopted pursuant to Articles 24a, 35a, 45a, 49a, 57a, 65a, 74a, 74k, 93a, 114a, 144a and 161a shall enter into force only if no objection has been expressed either by the European Parliament or the Council within a period of **2** months of notification of that act to the European Parliament and the Council or if, before the expiry of that period, the European Parliament and the Council have both informed the Commission that they will not object. That period shall be extended by **2** months at the initiative of the European Parliament or the Council.';

Amendment

5. A delegated act adopted pursuant to Articles 24a, 35a, 45a, 49a, 57a, 65a, 74a, 74k, 93a, 114a, 144a and 161a shall enter into force only if no objection has been expressed either by the European Parliament or the Council within a period of **four** months of notification of that act to the European Parliament and the Council or if, before the expiry of that period, the European Parliament and the Council have both informed the Commission that they will not object. That period shall be extended by **two** months at the initiative of the European Parliament or the Council.';

Amendment 111

Proposal for a regulation

Article 1 – point 127 a (new)

Text proposed by the Commission

Amendment

(127a) The following Annex is inserted:

'Annex -I

Amount of fees

The fees to be paid to the Agency under this Regulation and under Regulation (EC) No 2868/95 shall be as follows:

1. Basic fee for the application for an individual mark (Article 26(2), Rule 4(a)) ***EUR 925***

1a. Search fee for a European Union trade mark application (Article 38(2), Rule 4(c)) ***The amount of EUR 12 multiplied by the number of central industrial property offices referred to in Article 38(2); that amount, and the subsequent changes, shall be published by the Agency in the Official Journal of the Agency***

1b. Basic fee for the application for an individual mark by electronic means (Article 26(2), Rule 4(a)) ***EUR 775***

1c. Basic fee for the application for an individual mark by electronic means, using the online classification database (Article ***EUR 725***

<i>26(2), Rule 4(a))</i>	
<i>2. Fee for the second class of goods and services for an individual mark (Article 26(2), Rule 4(b))</i>	<i>EUR 50</i>
<i>2a. Fee for the third class of goods and services for an individual mark (Article 26(2), Rule 4(b))</i>	<i>EUR 75</i>
<i>2b. Fee for each class of goods and services exceeding three for an individual mark (Article 26(2), Rule 4(b))</i>	<i>EUR 150</i>
<i>3. Basic fee for the application for a collective mark (Article 26(2) and Article 66(3), Rule 4(a) and Rule 42)</i>	<i>EUR 1 000</i>
<i>3a. Basic fee for the application for a collective mark by electronic means, using the online classification database (Article 26(2) and Article 66(3), Rule 4(a) and Rule 42)</i>	<i>EUR 950</i>
<i>4. Fee for the second class of goods and services for a collective mark (Article 26(2) and Article 66(3),</i>	<i>EUR 50</i>

***Rule 4(b) and
Rule 42)***

***4a. Fee for the
third class of
goods and
services for a
collective mark
(Article 26(2)
and Article 66(3),
Rule 4(b) and
Rule 42)*** ***EUR 75***

***4b. Fee for each
class of goods
and services
exceeding three
for a collective
mark (Article
26(2) and 66(3),
Rule 4(b) and
Rule 42)*** ***EUR 150***

***5. Opposition fee
(Article 41(3);
Rule 17(1))*** ***EUR 350***

***7. Basic fee for
the registration
of an individual
mark (Article 45)*** ***EUR 0***

***8. Fee for each
class of goods
and services
exceeding three
for an individual
mark (Article 45)*** ***EUR 0***

***9. Basic fee for
the registration
of a collective
mark (Article 45
and Article
66(3))*** ***EUR 0***

***10. Fee for each
class of goods
and services
exceeding three
for a collective
mark (Article 45
and Article*** ***EUR 0***

64(3))

*11. Additional fee
for late payment
of the
registration fee
(point 2 of Article
162(2))* **EUR 0**

*12. Basic fee for
the renewal of an
individual mark
(Article 47(1),
Rule 30(2)(a))* **EUR 1 150**

*12a. Basic fee for
the renewal of an
individual mark
by electronic
means (Article
47(1), Rule
30(2)(a))* **EUR 1 000**

*13. Fee for the
renewal of the
second class of
goods and
services for an
individual mark
(Article 47(1),
Rule 30(2)(b))* **EUR 100**

*13a. Fee for the
renewal of the
third class of
goods and
services for an
individual mark
(Article 47(1),
Rule 30(2)(b))* **EUR 150**

*13b. Fee for the
renewal of each
class of goods
and services
exceeding three
for an individual
mark (Article
47(1), Rule
30(2)(b))* **EUR 300**

*14. Basic fee for
the renewal of a
collective mark* **EUR 1 275**

*(Article 47(1)
and Article 66(3),
Rule 30(2)(a)
and Rule 42)*

*15. Fee for the
renewal of the
second class of
goods and
services for a
collective mark
(Article 47(1)
and Article 66(3),
Rule 30(2)(b)
and Rule 42)* **EUR 100**

*15a. Fee for the
renewal of the
third class of
goods and
services for a
collective mark
(Article 47(1)
and Article 66(3),
Rule 30(2)(b)
and Rule 42)* **EUR 150**

*15b. Fee for the
renewal of each
class of goods
and services
exceeding three
for a collective
mark (Article
47(1) and Article
66(3), Rule
30(2)(b) and
Rule 42)* **EUR 300**

*16. Additional fee
for late payment
of the renewal
fee or late
submission of the
request for
renewal (Article
47(3), Rule
30(2)(c))* **25% of the
belated renewal
fee, subject to a
maximum of
EUR 1 150**

*17. Fee for the
application for
revocation or for
a declaration of* **EUR 700**

invalidity (Article 56(2), Rule 39(1))

18. Appeal fee (Article 60, Rule 49(3)) **EUR 800**

19. Fee for the application for restitutio in integrum (Article 81(3)) **EUR 200**

20. Fee for the application for the conversion of a European Union trade mark application or a European Union trade mark (Article 113(1), also in conjunction with Article 159(1); Rule 45(2), also in conjunction with Rule 123(2)) **EUR 200**

(a) into a national trade mark application;

(b) into a designation of Member States under the Madrid Agreement

21. Fee for continuation of proceedings (Article 82(1)) **EUR 400**

22. Fee for the declaration of division of a registered European Union trade mark (Article 49(4)) or an application **EUR 250**

for a European Union trade mark (Article 44(4)):

23. Fee for the application for the registration of a licence or another right in respect of a registered European Union trade mark (Article 162(2)(c), Rule 33(2)) or an application for a European Union trade mark (Article 157(2)(d), Rule 33(4)):

(a) grant of a licence;

(b) transfer of a licence;

(c) creation of a right in rem;

(d) transfer of a right in rem;

(e) levy of execution;

24. Fee for the cancellation of the registration of a licence or other right (Article 162(2)(e), Rule 35(3))

25. Fee for the alteration of a registered European Union

EUR 200 per registration, but, where multiple requests are submitted in the same application or at the same time, not to exceed a total of EUR 1 000

EUR 200 per cancellation, but, where multiple requests are submitted in the same application or at the same time, not to exceed a total of EUR 1 000

EUR 200

*trade mark
(Article 162(2)(f),
Rule 25(2))*

*26. Fee for the
issue of a copy of
the application
for a European
Union trade
mark (Article 162
(2)(j), Rule 89
(5)), a copy of the
certificate of
registration
(Article
162(2)(b), Rule
24(2)), or an
extract from the
register (Article
162(2)(g), Rule
84(6)):*

*(a) uncertified
copy or extract;* **EUR 10**

*(b) certified copy
or extract* **EUR 30**

*27. Fee for the
inspection of the
files (Article 162
(2)(h), Rule 89
(1))* **EUR 30**

*28. Fee for the
issue of copies of
file documents
(Article 162(2)(i),
Rule 89(5)):*

*(a) uncertified
copy;* **EUR 10**

*(b) certified copy,
plus per page,
exceeding 10* **EUR 30**
EUR 1

*29. Fee for the
communication
of information in
a file (Article
162(2)(k), Rule
90)* **EUR 10**

30. Fee for the review of the determination of the procedural costs to be refunded (Article 162(2)(l), Rule 94 (4)) **EUR 100**

31. Fee for the filing of an international application at the Agency (Article 147(5)) **EUR 300**

Justification

The fees structure is an important element of the EU trade mark system. The table contained in Regulation (EC) No 2869/95 (including the Commission's proposals for changes and updated references) is hence incorporated into Regulation (EC) No 207/2009. The decision whether the other provisions contained in Regulation (EC) No 2869/95 should be incorporated into Regulation (EC) No 207/2009 or regulated by delegated acts will need to be taken in the framework of the interinstitutional negotiations.

Amendment 112

Proposal for a regulation

Article 1 – point 127

Regulation (EC) No 207/2009

Article 165 a – paragraph 1

Text proposed by the Commission

Amendment

1. By 2019, and every five years thereafter, the Commission shall **commission an evaluation on** the implementation of this Regulation.

1. By 2019, and every five years thereafter, the Commission shall **evaluate** the implementation of this Regulation.

Justification

The Commission should be responsible for the evaluation and should be able to choose whether to carry out the evaluation itself or whether to commission an evaluation.

Amendment 113

Proposal for a regulation

Article 1 a (new)

Text proposed by the Commission

Amendment

Article 1a

Regulation (EC) No 2868/95 is amended as follows:

(1) Rule 4 is deleted;

(2) Rule 30(2) is deleted.

Justification

As the structure of fees is to be directly regulated in the Regulation, the relevant Rules of Regulation (EC) No 2869/95 concerning fees have to be repealed. Related to the amendments on Article 26(2) and Article 47(1a).

Amendment 114

Proposal for a regulation

Article 1 b (new)

Text proposed by the Commission

Amendment

Article 1b

Regulation (EC) No 2869/95 is repealed.

References to the repealed Regulation shall be construed as references to this Regulation and shall be read in accordance with the correlation table set out in the Annex*.

*** The correlation table will be drawn up upon conclusion of an interinstitutional agreement on this Regulation.**

Justification

As the fees structure is to be directly regulated in the Regulation, Regulation (EC) No 2869/95 concerning fees has to be repealed. The decision whether the provisions contained in Regulation (EC) No 2869/95 that do not concern the amount of fees should be incorporated into Regulation (EC) No 207/2009 or regulated by delegated acts will be taken in the framework of the procedure in accordance with Rule 37a.