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A7-0032/ 001-054

AMENDMENTS 001-054

by the Committee on Legal Affairs

Report

Cecilia Wikström

A7-0032/2014

Laws of the Member States relating to trade marks

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

Amendment 1

Proposal for a directive

Citation 1

Text proposed by the Commission

Amendment

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

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

Justification

The full legal basis should be referred to.

Amendment 2

Proposal for a directive

Recital 5

Text proposed by the Commission

Amendment

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union²⁰, the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC. In doing so, the

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union²⁰, the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC. In doing so, the

revision of the latter should include measures to make it more consistent with Regulation (EC) No 207/2009 **and** would thus reduce the areas of divergence within the trade mark system in Europe as a whole.

²⁰ OJ *c* 140, 29.5.2010, p. 22.

revision of the latter should include measures to make it more consistent with Regulation (EC) No 207/2009, **which** would thus reduce the areas of divergence within the trade mark system in Europe as a whole, **while maintaining national trade mark protection as an attractive option for applicants. In this context, the complementary relationship between the European Union trade mark system and national trade mark systems should be ensured.**

²⁰ OJ *C* 140, 29.5.2010, p. 22.

Justification

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

Amendment 3

Proposal for a directive

Recital 10

Text proposed by the Commission

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

Amendment

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

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

Justification

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

Amendment 4

Proposal for a directive Recital 13

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 5

Proposal for a directive Recital 19

Text proposed by the Commission

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

Amendment

deleted

Deletion due to deletion in Article 10.

Amendment 6

Proposal for a directive

Recital 22

Text proposed by the Commission

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

Amendment

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing **counterfeit** goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without **authorisation** a trade mark which is essentially identical to the trade mark registered in respect of such goods. ***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 provides evidence that the final destination of the goods is a country outside the Union and if the proprietor of the 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 provides evidence that the final destination of the goods is a country outside the Union and the proprietor of the trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. This rule should also be without prejudice to the Union's right to promote access to medicines for third countries as well as compliance with***

WTO rules, notably with GATT Article V on freedom of transit.

Amendment 7

Proposal for a directive Recital 22 a (new)

Text proposed by the Commission

Amendment

(22a) The proprietor of a 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 608/2013 of the European Parliament and of the Council^{23a}. Customs authorities should carry out the relevant procedures laid down in Regulation (EC) 608/2013 at the request of a rightholder and on the basis of risk analysis criteria.

^{23a} *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 8

Proposal for a directive Recital 22 b (new)

Text proposed by the Commission

Amendment

(22b) 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 9

Proposal for a directive

Recital 22 c (new)

Text proposed by the Commission

Amendment

(22c) Member States should take appropriate measures with a view to ensuring the smooth transit of generic medicines. Therefore, a proprietor of a 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 the Member State based upon similarities, perceived or actual, between the international non-proprietary name (INN) for the active ingredient in the medicines and a registered trademark.

Amendment 10

Proposal for a directive

Recital 23

Text proposed by the Commission

Amendment

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

(23) 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 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, 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 11

Proposal for a directive

Recital 29

Text proposed by the Commission

(29) Trade marks fulfil their purpose of distinguishing goods or services and allowing consumers to make informed choices only when they are actually used on the market. A requirement of use is also necessary in order to reduce the total number of trade marks registered and protected in the Union and, consequently, the number of conflicts which arise between them. It is therefore essential to require that registered trade marks must actually be used in connection with the goods or services for which they are registered, or, if not used, must be liable to be revoked.

Amendment

(29) Trade marks fulfil their purpose of distinguishing goods or services and allowing consumers to make informed choices only when they are actually used on the market. A requirement of use is also necessary in order to reduce the total number of trade marks registered and protected in the Union and, consequently, the number of conflicts which arise between them. It is therefore essential to require that registered trade marks must actually be used in connection with the goods or services for which they are registered, or, if not used ***within five years of the date of registration***, must be liable to be revoked.

Justification

To bring the recital into line with Article 16(1) of the Directive. This amendment is also in keeping with EU efforts to support creative endeavour in SMEs, in that it gives them time to develop and protect their trade marks.

Amendment 12

Proposal for a directive
Recital 34

Text proposed by the Commission

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

Amendment

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to European trade marks. ***Member States should be free to decide whether to conduct ex officio examination for refusal on relative grounds.***

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

Amendment 13

Proposal for a regulation Recital 41 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^{23b}.

^{23b} ***Not yet published in the Official Journal.***

Amendment 14

Proposal for a directive Article 1

Text proposed by the Commission

Amendment

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

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

Justification

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

Amendment 15

Proposal for a directive Article 2 – point b

Text proposed by the Commission

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

Amendment

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

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

Justification

Change to reflect the amended name of the Agency.

Amendment 16

Proposal for a directive Article 2 – point ca

Text proposed by the Commission

Amendment

(ca) ‘earlier trade marks’ means:

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

– European Union trade marks;

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

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

(ii) European Union trade marks which validly claim seniority, in accordance with Regulation (EC) No 207/2009, to a trade mark referred to in the second and third indents of point (i), even when the latter

trade mark has been surrendered or allowed to lapse;

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

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

Justification

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

Amendment 17

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

Text proposed by the Commission

Amendment

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

Justification

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

Amendment 18

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

Text proposed by the Commission

Amendment

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

Justification

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

Amendment 19

Proposal for a directive Article 3

Text proposed by the Commission

Amendment

A 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 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.

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

Amendment 20

Proposal for a directive Article 4 – paragraph 1 – point j

Text proposed by the Commission

Amendment

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the

Union is party, providing for protection of traditional terms for wine and traditional specialities guaranteed.

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 21

Proposal for a directive

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

Text proposed by the Commission

Amendment

(ja) trade marks which contain or consist of an earlier variety denomination registered in accordance with Council Regulation (EC) No 2100/94^{23c} with respect to the same type of product.

^{23c} ***Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights (OJ L 227, 1.9.1994, p. 1).***

Justification

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

Amendment 22

Proposal for a directive

Article 4 – paragraph 2

Text proposed by the Commission

Amendment

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

deleted

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

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

Justification

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

Amendment 23

**Proposal for a directive
Article 4 – paragraph 5**

Text proposed by the Commission

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

Amendment

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

Amendment 24

**Proposal for a directive
Article 5 – paragraph 2**

Text proposed by the Commission

2. ***‘Earlier trade marks’ within the meaning of paragraph 1 means:***
(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;

Amendment

deleted

- (i) European trade marks;*
- (ii) trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Office for Intellectual Property;*
- (iii) trade marks registered under international arrangements which have effect in the Member State;*
- (b) European trade marks which validly claim seniority, in accordance with Regulation (EC) No 207/2009, from a trade mark referred to in points (a)(ii) and (iii), even when the latter trade mark has been surrendered or allowed to lapse;*
- (c) applications for the trade marks referred to in points (a) and (b), subject to their registration;*
- (d) trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well known in a Member State, in the sense in which the words ‘well known’ are used in Article 6 bis of the Paris Convention.*

Justification

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

Amendment 25

Proposal for a directive
Article 5 – paragraph 3 – point a

Text proposed by the Commission

(a) if it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in **a** Member State or, in case of a European trade mark, has a reputation in the Union and the use of

Amendment

(a) if it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in **the** Member State **in respect of which registration is applied for or in which the trade mark is**

the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

registered or, in **the** case of a European **Union** trade mark, has a reputation in the Union and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

Justification

There seems to be a drafting error as the provision is not compatible with the provision in Art. 10(2)(c). The drafting would have implied that a mark with a reputation in another Member State would have been an obstacle for a mark in the Member State in respect of which registration is applied for (even if this mark did not have a reputation in that Member State). This amendment clarifies that there is only an obstacle due to reputation of national marks within the same Member State.

Amendment 26

Proposal for a directive Article 5 – paragraph 3 – point d

Text proposed by the Commission

Amendment

(d) if it is excluded from registration and shall not continue to be used pursuant to Union legislation providing for protection of designations of origin and geographical indications.

deleted

Justification

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

Amendment 27

Proposal for a directive Article 5 – paragraph 5

Text proposed by the Commission

Amendment

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

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

the earlier trade mark or other earlier right consents to the registration of the later trade mark.

the earlier trade mark or other earlier right consents to the registration of the later trade mark.

Justification

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

Amendment 28

**Proposal for a directive
Article 8 – point c**

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 29

**Proposal for a directive
Article 9 – paragraph 1**

Text proposed by the Commission

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

Amendment

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

faith.

applied for in bad faith.

Justification

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

Amendment 30

Proposal for a directive Article 10

Text proposed by the Commission

1. The registration of a trade mark shall confer on the proprietor exclusive rights therein.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of a registered 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 trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered ***and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services;***
 - (b) the sign is identical, or similar to, the trade mark and is used for goods or services which are identical with or similar to the goods or services for which the trade mark is registered if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
 - (c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar or not similar to those for which the trade mark is

Amendment

1. The registration of a trade mark shall confer on the proprietor exclusive rights therein.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of a registered 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 trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered;
 - (b) ***without prejudice to point a,*** the sign is identical , or similar to, the trade mark and is used for goods or services which are identical with or similar to the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
 - (c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar or not similar to those for which the trade mark is

registered, where the latter has a reputation in the Member State 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 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, or 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 the 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 registered trade mark shall also be entitled to prevent the importing of goods *pursuant to paragraph 3(c)* where only the consignor of the goods acts *for commercial purposes*.

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

registered, where the latter has a reputation in the Member State 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 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, or 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 the 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 registered 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 trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that 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 trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State where the

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

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

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.

6. Where, under the law of a Member State, the use of a sign under the conditions referred to in paragraph 2, point (b) or (c) could not be prohibited before the date of entry into force of the provisions necessary to comply with Directive 89/104/EEC in the Member State concerned, the rights conferred by the trade mark may not be relied on to prevent the continued use of the sign.

6. Where, under the law of a Member State, the use of a sign under the conditions referred to in paragraph 2, point (b) or (c) could not be prohibited before the date of entry into force of the provisions necessary to comply with Directive 89/104/EEC in the Member State concerned, the rights conferred by the trade mark may not be relied on to prevent the continued use of the sign.

7. Paragraphs 1, 2, 3 and 6 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the

7. Paragraphs 1, 2, 3 and 6 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the

distinctive character or the repute of the trade mark.

distinctive character or the repute of the trade mark.

Amendment 31

Proposal for a directive Article 11 – point a

Text proposed by the Commission

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

Amendment

(a) affixing in the course of trade a sign **that is, as specified in Article 5(1) of this Directive**, identical with or similar to the trade mark on **packaging, labels, tags, security features, authenticity devices or any** other means on which the mark may be affixed.

Justification

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

Amendment 32

Proposal for a directive Article 11 – point b

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 33

Proposal for a directive

Article 14 – paragraph 1 – subparagraph c

Text proposed by the Commission

(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;***

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 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

Amendment

(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 Directive 2006/114/EC¹;***

(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 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.

3. 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 34

Proposal for a directive Article 14 – paragraph 2

Text proposed by the Commission

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

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

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

Amendment 35

Proposal for a directive Article 14 – paragraph 2 a (new)

Text proposed by the Commission

Amendment 36

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

cause.

3. 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

deleted

Amendment

(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.

Text proposed by the Commission

Amendment

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

Justification

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

Amendment 37

Proposal for a directive Article 22 – paragraph 3

Text proposed by the Commission

Amendment

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

deleted

Justification

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

Amendment 38

Proposal for a directive Article 22 – paragraph 4

Text proposed by the Commission

Amendment

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

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

Justification

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

Amendment 39

Proposal for a directive
Article 22 – paragraph 5

Text proposed by the Commission

Amendment

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

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

Justification

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

Amendment 40

Proposal for a directive
Article 28 – point c

Text proposed by the Commission

Amendment

Article 28

deleted

Definitions

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

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

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

Justification

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

Amendment 41

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

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 42

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

Text proposed by the Commission

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

Amendment

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

Amendment 43

**Proposal for a directive
Article 40 – paragraph 6**

Text proposed by the Commission

6. Where the applicant requests registration for more than one class, the **goods and services shall be grouped** according to the classes of the Nice classification, each

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 **presented** in the order of the classes.

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 and not the office to group the goods and services according to classes.

Amendment 44

**Proposal for a directive
Article 41**

Text proposed by the Commission

Amendment

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

deleted

Amendment 45

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

Text proposed by the Commission

Amendment

2a. Member States which have established opposition procedures based on absolute grounds provided for by Article 4 shall not be required to implement this Article.

Justification

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

Amendment 46

**Proposal for a directive
Article 45 – paragraph 2**

Text proposed by the Commission

Amendment

2. The administrative procedure referred to

2. The administrative procedure referred to

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

in paragraph 1 shall provide that at least the proprietor of an earlier right referred to in **Article 4(1)(i)**, Article 5(2) and **point (a) of Article 5(3)** shall be able to file a notice of opposition. ***A notice of opposition may be filed on the basis of one or more earlier rights, provided that they all belong to the same proprietor, and on the basis of a part or of the totality of the goods or services in respect of which the earlier right is registered or applied for, and may be directed against a part or the totality of the goods or services in respect of which the contested mark is applied for.***

Justification

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

Amendment 47

Proposal for a directive Article 45 – paragraph 3

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 48

Proposal for a directive Article 47 – paragraph 1

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 49

Proposal for a directive Article 47 – paragraph 4 a (new)

Text proposed by the Commission

Amendment

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

Justification

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

Amendment 50

Proposal for a directive Article 47 – paragraph 4 b (new)

Text proposed by the Commission

Amendment

4b. An application for a declaration of invalidity may be filed on the basis of one

or more earlier rights, provided they all belong to the same proprietor.

Justification

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

Amendment 51

Proposal for a directive Article 48 – paragraph 1

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 52

Proposal for a directive

Article 52

Text proposed by the Commission

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

Amendment

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

Amendment 53

Proposal for a directive

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

Text proposed by the Commission

Amendment

SECTION 3A

COMMUNICATION WITH THE OFFICE

Article 51 a

Communication with the office

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

Justification

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

Amendment 54

Proposal for a directive

Article 53

Text proposed by the Commission

Amendment

Member States shall ensure that the offices cooperate with the Agency in all areas of their activities other than those referred to

Member States shall ensure that the offices **effectively** cooperate with the Agency in all areas of their activities other than those

in Article 52 which are of relevance for the protection of trade marks in the Union.

referred to in Article 52 which are of relevance for the protection of trade marks in the Union.