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**A7-0031/2014**

12.2.2014

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## **REPORT**

on the proposal for a regulation of the European Parliament and of the Council  
amending Council Regulation (EC) No 207/2009 on the Community trade  
mark  
(COM(2013)0161 – C7-0087/2013 – 2013/0088(COD))

Committee on Legal Affairs

Rapporteur: Cecilia Wikström

### ***Symbols for procedures***

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

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

### ***Amendments to a draft act***

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

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

## CONTENTS

	<b>Page</b>
DRAFT EUROPEAN PARLIAMENT LEGISLATIVE RESOLUTION.....	5
EXPLANATORY STATEMENT.....	90
OPINION OF THE COMMITTEE ON LEGAL AFFAIRS ON THE USE OF DELEGATED ACTS.....	95
OPINION OF THE COMMITTEE ON INTERNATIONAL TRADE .....	138
OPINION OF THE COMMITTEE ON THE INTERNAL MARKET AND CONSUMER PROTECTION .....	145
PROCEDURE .....	172



## **DRAFT EUROPEAN PARLIAMENT LEGISLATIVE RESOLUTION**

**on the proposal for a regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark (COM(2013)0161 – C7-0087/2013 – 2013/0088(COD))**

**(Ordinary legislative procedure: first reading)**

*The European Parliament,*

- having regard to the Commission proposal to Parliament and the Council (COM(2013)0161),
  - having regard to Article 294(2) and Article 118(1) of the Treaty on the Functioning of the European Union, pursuant to which the Commission submitted the proposal to Parliament (C7-0087/2013),
  - having regard to Article 294(3) of the Treaty on the Functioning of the European Union,
  - having regard to the opinion of the Committee on Legal Affairs on the use of delegated acts of 14 October 2013,
  - having regard to Rule 55 of its Rules of Procedure,
  - having regard to the report of the Committee on Legal Affairs and the opinions of the Committee on International Trade and the Committee on the Internal Market and Consumer Protection (A7-0031/2014),
1. Adopts its position at first reading hereinafter set out;
  2. Calls on the Commission to refer the matter to Parliament again if it intends to amend the proposal substantially or replace it with another text;
  3. Calls on the Commission to take measures to codify the Regulation once the legislative procedure has come to an end;
  4. Instructs its President to forward its position to the Council, the Commission and the national parliaments.

### **Amendment 1**

#### **Proposal for a regulation**

#### **Recital 2**

*Text proposed by the Commission*

*Amendment*

(2) As a consequence of the entry into

(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’).

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

#### *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

at the level of the Member States.

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

*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 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*

**(15) In order to ensure legal certainty and**

*Amendment*

**deleted**

*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.*

#### *Justification*

*This amendment relates to the deletion in Article 9.*

### **Amendment 5**

#### **Proposal for a regulation Recital 18**

##### *Text proposed by the Commission*

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

##### *Amendment*

(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 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 Council<sup>1</sup>.*

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<sup>1</sup> *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

#### *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 **modalities** for the renewal of a European trade mark and procedures governing the alteration and division of a European trade mark.

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.

#### *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*

(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***.

*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 ***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

*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 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.

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(1).*

## **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 2869/95<sup>1</sup>. 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 2868/95<sup>2</sup> should be deleted.*

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<sup>1</sup> *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).*

<sup>2</sup> *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 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.

##### *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 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<sup>9a</sup>.***

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***<sup>9a</sup> 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*

*Amendment*

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

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

necessary grammatical changes are made;

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 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.

#### *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; **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:

#### *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

(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 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

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 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.

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 *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

#### *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 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 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.

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 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***

#### *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);



*those fees*, 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*

(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;***

#### *Amendment*

(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*

(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;

#### *Amendment*

(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*

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

#### *Amendment*

(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*

*Amendment*

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).

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*

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

#### *Amendment*

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*

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).';

### *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 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*

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

### *Amendment*

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*

(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).';*

*Amendment*

(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*

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.

*Amendment*

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*

(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;***

#### *Amendment*

(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*

***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).'***

#### *Amendment*

***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*

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

#### *Amendment*

(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*

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

#### *Amendment*

(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 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).***';

(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 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**

*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)

*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

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

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 (\*\*\*\*).

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(\*\*\*) OJ L 298, 26.10.2012, p. 1.

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(\*\*\*) OJ L 298, 26.10.2012, p. 1.

(\*\*\*\*) OJ L 362, 31.12.2012, 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 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.***

***deleted***

***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*

*Amendment*

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

***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

*Text proposed by the Commission*

*Amendment*

***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

#### *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

member shall have one vote.

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*

*Amendment*

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

***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*

***(1a) 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 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

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 ***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

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.

*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

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.*

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.

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**

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*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**

*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*

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

***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.

#### *Amendment*

***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*

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

#### *Amendment*

***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*

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 in accordance with Article 161a(f).***

#### *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 international registration designating the European 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

*Amendment*

(a) the formal conditions of an international application, the procedure for the examination of the international application pursuant to Article 147(6) and

application pursuant to Article 147(6) and the modalities of forwarding the international application to the International Bureau pursuant to Article 147(4);

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

*Amendment*

(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.

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)**

Regulation (EC) No 207/2009

Annex -I (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 26(2), Rule 4(a))*** ***EUR 725***

***2. Fee for the second class of goods and services for an individual mark (Article 26(2),*** ***EUR 50***

***Rule 4(b))***

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

***2b. Fee for each class of goods and services exceeding three for an individual mark (Article 26(2), Rule 4(b))*** ***EUR 150***

***3. Basic fee for the application for a collective mark (Article 26(2) and Article 66(3), Rule 4(a) and Rule 42)*** ***EUR 1 000***

***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)*** ***EUR 950***

***4. Fee for the second class of goods and services for a collective mark (Article 26(2) and Article 66(3), Rule 4(b) and Rule 42)*** ***EUR 50***

***4a. Fee for the third class of goods and*** ***EUR 75***



*services for a  
collective mark  
(Article 26(2)  
and Article 66(3),  
Rule 4(b) and  
Rule 42)*

*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  
64(3))* **EUR 0**

*11. Additional fee  
for late payment  
of the* **EUR 0**

*registration fee  
(point 2 of Article  
162(2))*

*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  
(Article 47(1)  
and Article 66(3),* **EUR 1 275**

***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** **EUR 250**

*(Article 49(4)) or an application 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))*

*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*

**25. Fee for the alteration of a registered European Union trade mark (Article 162(2)(f), Rule 25(2))** **EUR 200**

**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,** **EUR 30**  
**plus per page,** **EUR 1**  
**exceeding 10**

<b>29. Fee for the communication of information in a file (Article 162(2)(k), Rule 90)</b>	<b>EUR 10</b>
<b>30. Fee for the review of the determination of the procedural costs to be refunded (Article 162(2)(l), Rule 94 (4))</b>	<b>EUR 100</b>
<b>31. Fee for the filing of an international application at the Agency (Article 147(5))</b>	<b>EUR 300</b>

#### *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*

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

##### *Amendment*

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)**

Regulation (EC) No 2868/95

*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\*.***

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***\* 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.*

## **EXPLANATORY STATEMENT**

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

### **Summary**

The community trade mark system and OHIM has existed for over 15 years and it is reasonable to do a review of the existing rules to improve a system which has been a great success. During these years OHIM has grown into a well functioning and effective agency with a clear view of its mission to assist the trade mark and design community in Europe. The addition of new tasks such as the Observatory on infringements of intellectual property rights and the databases on orphan works is a proof of the trust placed in the Agency both by the co-legislators and by the commission.

The current review requires, in the view of your rapporteur, that changes to the governance of OHIM be made with a view to guaranteeing the continued independence, user-friendliness and competence that has characterised the Agency so far.

It is important to note that the Agency is neither purely a Member State, Commission nor Parliament agency but an agency of the European Union. As such some changes to the governance, notably through the guidance offered by the Common Approach on Decentralised Agencies, should be made.

The issue of the fees for European trade marks ties in closely with the capacity of the Agency to perform its duties. Here your rapporteur will thus argue that this is an issue so closely related with the core governance of the Agency and the capacity of the Agency to perform its tasks that it must be regulated in the basic act rather than through a delegated act.

On substantive law matters the Commission has proposed a number of changes, most of which your rapporteur agrees with, although there is still room for improvements.

### **The name of the Agency**

Your rapporteur notes that the current name of the Agency, "Office for Harmonization in the Internal Market", is well known and established among the trade marks community in Europe and beyond. It is however not a name that is particularly logical for anyone without prior

knowledge of the office seeking to register a trade mark or a design. The current revision would thus seem to be a good opportunity to rename the Agency. The name proposed by the Commission ("European Union Trade Marks and Designs Agency") does not however cover the broad range of tasks entrusted with the Agency. The Agency already hosts the Observatory on infringements of intellectual property rights as well as the register of recognised orphan works. In the future one could also envisage additional functions, such as the registration of geographical indicators and possible tasks in connection with the upcoming legislative proposal on the protection of trade secrets, being added to the tasks of the Agency. It would therefore be useful to find an appropriate long-term name for the Agency that can stand the test of time while giving clarity to the users on its tasks. Your rapporteur therefore proposes to rename the Agency the "European Union Intellectual Property Agency".

## **Definitions**

Your rapporteur suggests a slight change to the Commission proposal on the terminology in the definitions. Rather than changing the name from "Community" trade marks to "European" trade marks they should be called "European Union" trade marks. The main reason for this is that the term "European Union" more accurately describes the territorial area of protection. It should also be noted that the use of the term "European" for example in the realm of patents refers to a bundle of national rights (now extended to European patents with unitary effect). As the Community trade mark is an EU title it would be advisable to name it accordingly.

## **Governance related issues**

The governance of the Agency in charge of registering trademarks is obviously a very important part of this legislative package. Although the Commission has generally presented good proposals in this area there is need for important calibration on a number of points.

### **- Composition of the Management board**

The Common Approach provides for representatives of Member States, Commission and the European Parliament in the management boards of agencies. However the Commission in its proposal omitted the European Parliament from the management board. Your rapporteur suggests correcting this in accordance with the provisions of the Common Approach.

### **- Executive Board**

The Common Approach gives the possibility to include an executive board in management boards of agencies in cases where this promises more efficiency. There does however not seem to be any concrete evidence that such an extra level of administrative bureaucracy would add efficiency in this case. Your rapporteur therefore suggests deleting the addition of an executive board.

### **- Selection of the Executive Director of the Agency (and deputies)**

The Commission has proposed that the executive director should be elected by the management board from a list of candidates by the commission. Your rapporteur does not agree with giving the Commission a veto-power over any names to be proposed to the post and considers that the management board should have its internal pre-selection committee

composed of members from all three institutions to present a list of at least three candidates to the full board. Similarly your rapporteur proposes that the proposed veto-right for the commission on the re-appointment of the executive director be abolished.

### **Cooperation projects between the Agency and Member States**

Your rapporteur agrees in principle with the proposals from the Commission in this area, with a number of changes to increase flexibility. The list of areas in which projects can be concluded should for example not be exhaustive but open ended to allow for projects in areas not foreseen during the drafting process. The active participation of users should also be clearly guaranteed. Whilst sharing the Commission view that all member states should participate in the projects, it would seem reasonable not to force Member States to adopt outcomes of common projects in cases where Member States are of the view that they already have better systems or measures in place. In fact, such an approach may reduce the number of possible cooperation projects if member states would block others from participating in projects for fear of having to adopt the outcome.

### **Fees**

The commission has proposed that the fees be regulated by the use of delegated acts. Under the current Regulation they are set in a Commission implementing regulation adopted in comitology. The fees applied for the union trade mark system represent a central aspect to the functioning of the entire European trade mark system. Since the start of the system these fees have only been revised twice, after significant political debates. It would thus be inappropriate to set these fees in a delegated act and it would also be inappropriate to do so in an implementing act, which leads your rapporteur to the conclusion that the fees have to be set in the basic act. In order to make this rather complex change to the proposal your rapporteur has included the current implementing regulation along with the proposals for amending this act proposed in the comitology procedure by the Commission in the regulation. This should not be seen as an implicit endorsement of all aspects of this proposal and your rapporteur reserves the right to come back with specific amendments in this regard.

Further in relation to fees your rapporteur is of the opinion that fees collected by the Agency should neither serve to finance the national system (or indeed general budgets) of Member States nor the general budget of the European Union. The income of the Agency should rather be reinvested to guarantee the excellence of the Agency, and secondly to promote projects that will promote harmonization, convergence and excellence of IP protection in Europe.

### **Delegated acts**

Your rapporteur notes that there are a large number of delegated acts in the proposal from the Commission. It seems rather clear that a number of these go beyond what should be acceptable as delegated acts, not least taking into account that the subject-matters and scope of many of the suggested delegations touch upon essential elements and give the Commission a much too wide margin for appreciation. This concerns the proposed Recitals 24-26, 29, 31-34, 36, 38 and 44-46, and Articles 24a, 35a, 39, 45a, 49a, 57a, 65a, 74a, 74k, 79, 79a, 83, 89, 93a, 114, 114a, 128, 144a, 145, 161a and 163a.

Instead of dealing with these issues already in this report your rapporteur suggests to handle them according to the procedure in Rule 37a whereby the Legal Affairs Committee would prepare an opinion on the objectives, content, scope and duration of the delegations, and to the conditions to which they are subject. Such an opinion should also analyse the consequences of transferring the substance of the Commission implementing regulation on fees to the basic act, as outlined above, as well as other implementing measures previously taken on the basis of the Regulation.

### **Enforcement measures**

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

The Commission has furthermore proposed a provision on goods in transit. Although there is a need to stop counterfeit products entering the Internal Market, the proposal would also hamper legitimate international trade. Your rapporteur would therefore suggest a number of changes in order to ensure a more balanced proposal.



## **OPINION OF THE COMMITTEE ON LEGAL AFFAIRS ON THE USE OF DELEGATED ACTS**

Mr Klaus-Heiner Lehne  
Chair  
Committee on Legal Affairs  
BRUSSELS

Subject: Opinion drawn up pursuant to Rule 37a of the Rules of Procedure on the use of delegated acts, in the context of Parliament's scrutiny of the Community trade mark (COM(2013)0161 – C7-0087/2013 – 2013/0088(COD))

Dear Mr Chair,

The Committee on Legal Affairs has decided to give an opinion on its own initiative on the provisions in the above-mentioned proposal which delegate legislative powers to the Commission in accordance with Article 290 of the Treaty of the Functioning of the European Union (TFEU).

The proposal contains the remarkable number of 63 different suggested delegations of legislative power to the Commission (see Annex).

### **I - Background**

The above-mentioned proposal for a Regulation is part of the trade mark package which the Commission presented on 27 March 2013 and which also consists of a proposal for a recast of the Trade Mark Directive<sup>1</sup>, and a proposal for an implementing act amending two Commission Regulations<sup>2</sup> intended to adapt the fee structure of the Community trade mark system.

According to the Commission, the overall aim of the proposal is to foster innovation and economic growth by making trade mark registration systems all over the EU more accessible and efficient for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal security. The Commission is however not proposing a new system, but

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<sup>1</sup> Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ L 299, 8.11.2008, p. 25).

<sup>2</sup> 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), and Commission Regulation (EC) 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). There is also a third implementing regulation under the current Trade Mark Regulation, namely Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (OJ L 28, 6.2.1996, p. 11), which is not however amended.

a modernisation of existing provisions, with the main aims of adapting terminology to the Lisbon Treaty and provisions to the Common Approach of 19 July 2012 on decentralised agencies<sup>1</sup>, streamlining procedures to apply for and register a European trade mark, increasing legal certainty by clarifying provisions and removing ambiguities, incorporating case law of the Court of Justice, establishing an appropriate framework for cooperation between OHIM and national offices for the promoting convergence of practices and developing common tools, and aligning the framework to Article 290 of the TFEU.

## **II - The proposed draft implementing act on the fee system**

The above-mentioned proposal for an implementing act on the fee system is based on Articles 144, 162 and 163(2) of the Trade Mark Regulation currently in force, in conjunction with Article 13 of the Implementing Acts Regulation<sup>2</sup>. Under these provisions, the regulation of the fees shall determine the amounts of the fees, the ways in which they are to be paid, and shall ensure a balanced OHIM budget. They shall furthermore be adopted and amended using the examination procedure in Article 5 of the Implementing Acts Regulation.

The Commission is however simultaneously proposing to amend the Trade Mark Regulation so as to provide for future amendments of the fee system by delegated acts under Article 290 TFEU.

Recital 2 of the draft implementing act furthermore talks of it being "appropriate to make the fee structure more flexible by adapting it", which arguably goes beyond mere implementation and can be said to be rather a question of policy choices and touch upon essential elements of the trade mark package.

Following opposition to this approach from both the Parliament at shadow meetings and from Member States at Council working party meetings, the Commission announced in a letter to Parliament on 18 July 2013 that it will not go forward with the draft implementing act in the relevant committee, and intends to "convene the next meeting of the Committee towards the end of the year at the earliest". When the draft implementing act was presented, the aim of the Commission was to adopt it before the end of the year, and the Commission appears to maintain the position that it may legally adapt the structure of the fees by an implementing act.

It should furthermore be noted that according to point 38 of the above-mentioned Common Approach on decentralised agencies, fees should be set at a realistic level for self-financed agencies (such as OHIM) to avoid the accumulation of significant surpluses.

Under Article 291 TFEU, where uniform conditions for implementing legally binding Union acts are needed, those acts shall confer implementing powers on the Commission. The Common Approach is however a joint statement of the European Parliament, the Council and

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<sup>1</sup> [http://ec.europa.eu/commission\\_2010-2014/sefcovic/documents/120719\\_agencies\\_common\\_appr\\_en.pdf](http://ec.europa.eu/commission_2010-2014/sefcovic/documents/120719_agencies_common_appr_en.pdf)

<sup>2</sup> Regulation (EU) No 182/2011 of the European Parliament and of the Council of 16 February 2011 laying down the rules and general principles concerning mechanisms for control by Member States of the Commission's exercise of implementing powers (OJ L 55, 28.2.2011, p. 13).



the European Commission, and is thus not a legally binding Union act.

### **III - Background to delegated and implementing acts**

Please see Section II of the Opinion of the Committee on Legal Affairs of 27 April 2012 to the Committee on Agriculture concerning the regulation amending Regulation (EC) No 834/2007 on organic production and labelling of organic products, and the working document drawn up in the context of the follow-up on the delegation of legislative powers and the control by Member States of the Commission's exercise of implementing powers (rapporteur: József Szájer), which provide for an extensive background to both delegated and implementing acts.

### **IV - Parliament's position on the delegation of legislative power**

The demarcation between delegated and implementing acts has been the subject of some controversy in a number of legislative procedures following the entry into force of the Lisbon Treaty. The Council has insisted on the use of implementing acts in order better to influence the preparatory phase of such acts through the experts from the Member States sitting in the relevant committees provided for in the Implementing Acts Regulation. In the preparation of delegated acts there is no formal role for national experts. Furthermore, the role, influence and prerogatives of Parliament are far greater when it comes to delegated acts, with the possibility of objecting to a proposed delegated act and revoking a delegation being the strongest tools in its possession. When it comes to implementing acts, the powers of Parliament are limited to a right of scrutiny, and the Commission may adopt a proposed implementing act notwithstanding any objection from Parliament.

The choice of the correct instrument has significant consequences not only for the possibility of Parliament to exercise its right of control or scrutiny, but also for the validity of the legal act itself. The President of the Commission, in a letter to the President of Parliament, has stressed that the delineation between implementing and delegated acts is not a matter of political choice, and that the starting point of any analysis therefore must be the legal criteria established in Articles 290 and 291 TFEU<sup>1</sup>. The Commission has therefore sought clarification from the Court of Justice on the delineation issue in a case where it considered that the wrong kind of act had been chosen<sup>2</sup>.

In order to establish a horizontal political position on the issue of delegated acts to protect Parliament's prerogatives and avoid further risk of legal challenges and the risk of annulment of legislative acts with an incorrect choice of delegated or implementing acts, the Conference

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<sup>1</sup> Letter of 3 February 2012 from President Barroso to President Schulz.

<sup>2</sup> On 19 September 2012, the Commission brought an action to the Court of Justice seeking to annul an article in the Biocidal Products Regulation which provides for the adoption of measures by an implementing act rather than by a delegated act. The Commission argues that since the article in question seeks to supplement certain non-essential elements of the legislative act, and with regard to the nature of the delegation and the purpose of the act to be adopted under those powers, such an act ought therefore to be adopted in accordance with the procedure laid down in Article 290 TFEU and not the procedures laid down in Article 291 TFEU. Case C-427/12, Commission v European Parliament and Council of the European Union.

of Presidents endorsed in 2012 the following 4-step approach with a view to ensuring that Parliament is capable of exercising to the full the powers conferred on it by the Lisbon Treaty<sup>1</sup>:

1. Choice of the right instrument;
2. Strengthening the Member States' role in the preparatory phase of delegated acts;
3. Inclusion in the basic act ("codecision");
4. Adoption of Parliament's position without a first reading agreement.

As a last step, where delegated acts could not be included in a particular file, although it had been established that they should, this approach calls for refusing to submit the file to the plenary as such, and that further horizontal negotiations with the Council would then be required.

## **V - Analysis**

In the absence of any case law from the Court of Justice on the question of the demarcation between delegated and implementing acts, the starting point for any analysis must be the wording of the Treaty itself. Article 290 TFEU only permits a delegation of legislative power for the adoption of "*non-legislative acts of general application to supplement or amend certain non-essential elements of the legislative act*" (emphasis added).

To examine whether those criteria are fulfilled here, it is necessary to examine the nature of the power in question on a case-by-case basis. Please see the Annex.

First, when it comes to the fee structure of the trademark system, one needs to take into account that the actual levels of the fees have not been altered substantially in the last almost 20 years, and any adjustment in the basic act, using codecision, is likely to last an equal amount of time, thus not requiring any flexibility through the use of delegated act under Article 290 TFEU for the setting the levels of the fees. It is the prerogative of the legislator to delegate or not to delegate legislative power. In this case, the change to the fee structure is not a mere question of implementing rules in legislative acts but rather a question of making a policy choice which is an essential element of the trade mark package. Such a policy choice belongs in the basic act, and cannot be the subject of delegated or implementing acts.

The view that the fee system should be kept in provisions in the basic act is furthermore reinforced by the fact that the driving force behind the fee aspects of the proposed trademark package was the above-mentioned Common Approach, which is not a legally binding Union act. It can therefore be questioned whether the Commission could even claim to have any implementing powers under Article 291 TFEU when it comes to the fees.

Second, concerning the provisions in the amending regulation, it should first be noted that the Commission only proposes provisions on delegated acts, and does not propose any provisions on implementing acts. It should furthermore be noted that the Commission has included the

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<sup>1</sup> *Political guidelines on a horizontal approach within Parliament on dealing with delegated acts* (Letter of 19 April 2012 from the Chair of the CCC to the President of Parliament).

following provisions in the proposal for a basic act which were previously included in Regulation No 2868/95 implementing the Trade Mark Regulation: Articles 19(2), 20(4), 22(6), 75, 79a, 79c, 79d and 87(3).

One major problem with the Commission's approach is that there are a number of provisions on delegated acts in the proposal which lack any foundation in the basic act susceptible of being supplemented or amended, and whose sole purpose seems to be to provide an instrument to permit the Commission to come up with provisions from scratch. In many cases, these provisions could easily have been further specified already in the basic act. In many cases a provision in the basic act contains a reference to "the conditions established in accordance with Article [on delegation of power]" which in turn makes a reference to the "conditions referred to in Article [provision in the basic act]". In such cases, in order for Article 290 TFEU to be applicable the conditions need to be further specified in order to rectify the circular lack of a basic obligation or provision to be supplemented or amended.

This problem can be found in the following provisions: Article 35a(d), paragraphs a and c of Article 45a, Article 74a, Article 74k, paragraphs f, i, j, k, m and p of Article 93a, Article 114a, and paragraphs a, c and f of Article 161a

If no further specification were to be made in the basic act in such cases, one of the possible alternatives would be to confer implementing powers on the Commission, which could entail a loss of influence for Parliament.

A further questionable suggested form of delegation can be found in Article 65a of the basic act, which provides for delegated acts specifying the content of notices of appeal and the content and form of decisions by the Board of Appeal. It is unclear what the word "content" means in this case. This needs to be clarified in the basic act or an alternative needs to be found in order not to come unnecessarily close to the limits of non-essential elements.

Certain provisions providing for delegated acts make references to matters which do not appear in the Article in the basic act to which it refers. For instance, Article 65a provides for delegated acts "specifying the reimbursement of the appeal fees referred to in Article 60", whereas that Article does not refer to reimbursement. Similar discrepancies between provisions can be found in paragraphs h, j and k of Article 161a(h).

One peculiar aspect of the proposal which presents a problem when it comes to the delegation of legislative powers is the provisions on the powers of the Executive Director, which are often contradictory to provisions on delegated acts, for instance in Articles 30, 79, 88 and 128.

Lastly, there are a couple of incorrect references in the provisions providing for delegated acts, for instance in Article 144a(b) and in Article 161a(c).

## **VI - Conclusion and recommendation**

In light of the foregoing reasoning, the Committee on Legal Affairs takes the view that the fee system should not be the subject of an implementing act on the basis of the Trade Mark Regulation currently in force, in conjunction with the transitional provisions in the

Implementing Acts Regulation, as originally proposed by the Commission, but should rather be governed by provisions in the basic act itself, and any amendments to it should be subject to the ordinary legislative procedure.

In certain cases, delegated acts could be used to specify or establish criteria and procedures, but only where the provisions are further specified in the basic act. Alternatively, the Commission could be required to draw up a report within a certain time-span to the co-legislators, with possible accompanying proposals for amending legislative acts.

In view of the political guidance endorsed by the Conference of Presidents, the Committee on Legal Affairs should therefore take these recommendations into consideration when finalising its report. If the Council takes a position contrary to these recommendations and favours delegated or implementing acts where the criteria therefore are not met, the Committee should inform the Council that the file will not be submitted to the plenary as such, and if the Council still persists, the Committee should recommend the adoption of Parliament's position without a first reading agreement.

At its meeting of 14 October 2013 the Committee on Legal Affairs adopted this opinion unanimously<sup>1</sup>.

Yours sincerely,

Klaus-Heiner Lehne

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<sup>1</sup> The following were present: Sebastian Valentin Bodu (Vice-Chair), Françoise Castex (Vice-Chair), Marielle Gallo, Jutta Haug (pursuant to Rule 187(2)), Klaus-Heiner Lehne (Chair), Eva Lichtenberger, Alajos Mészáros, Andrej Plenković (pursuant to Rule 193(3)) Bernhard Rapkay, Francesco Enrico Speroni, Dimitar Stoyanov, Rebecca Taylor, Alexandra Thein, Cecilia Wikström, Tadeusz Zwiefka.

## Annex - Provisions on delegated acts

Article	Relevant text	Objectives, content and scope	Recommendation
Recital 24	Regulation (EC) No 207/2009 confers powers on the Commission in order to adopt rules implementing that Regulation. As a consequence of the entry into force of the Lisbon Treaty, the powers conferred upon the Commission under Regulation (EC) No 207/2009 need to be aligned to Article 290 of the Treaty on the Functioning of the European Union.	Whether to delegate legislative power or to confer implementing powers on the Commission is the sole prerogative of the legislator. The conclusion that the powers conferred upon the Commission under the current Trade Mark Regulation must be aligned to Article 290 TFEU is therefore incorrect. Those powers could also take the form of provisions on implementing acts under Article 290 TFEU or be kept in the basic act.	This recital could be reworded to take into account also the fact that the legislator is free to not delegate legislative powers or confer implementing powers.
Recital 25	It is of particular importance that the Commission carry out appropriate consultations during its preparatory work, including at expert level. The Commission, when preparing and drawing-up delegated acts, should ensure a simultaneous, timely and appropriate transmission of relevant documents to the European Parliament and	This corresponds to parts of the standard recital in the Common Understanding.	Should be kept in since it corresponds to the correct template.

	Council.		
Recital 26	In order to ensure the efficient registration of legal acts concerning the European trade mark as object of property and ensure full transparency of the register of European trade 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 certain obligations of the applicant regarding specific trade marks, the details on the procedures for entering the transfer of European trade marks, the creation and transfer of a right in rem, the levy of execution, the involvement in an insolvency procedure and the grant or transfer of a licence in the Register and for cancelling or modifying relevant entries.	This recital corresponds to Article 24a.	See comments to Article 24a.
Recital 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.	This recital corresponds to Article 35a.	See comments to Article 35a.

Recital 31	In order to ensure an effective, efficient and expeditious examination and registration of European trade mark applications by the Agency using procedures which are transparent, thorough, fair and equitable, 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 on the procedures related to the examination of compliance with the requirements on the filing date and with the formal conditions of an application, the procedures for verifying payment of class fees and the examination of absolute grounds for refusal, the details concerning the publication of the application, the procedures for correcting mistakes and errors in publications of applications, the details on the procedures related to third party observations, the details on the opposition procedure, the details on the procedures for filing and examining an opposition and those governing the amendment and division of the application, the particulars to be recorded in the Register when registering a European trade mark, the modalities of publication of the registration and the content and modalities of issue of a certificate of registration.	This recital corresponds to Article 45a.	See comments to Article 45a.
Recital 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	This recital corresponds to Article 49a.	See comments to Article 49a.

	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 mark.		
Recital 33	In order to permit the proprietor of a European trade mark to easily surrender a European trade mark, while respecting the rights of third parties entered in the register in relation to that mark, and to ensure that a European trade mark can be revoked or declared invalid in an effective and efficient way by means of transparent, thorough, fair and equitable procedures, and to take into account the principles laid down in this Regulation, 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 governing the surrender of a European trade mark as well as the procedures for revocation and invalidity.	This recital corresponds to Article 57a.	See comments to Article 57a.
Recital 34	In order to allow for an effective, efficient and complete review of decisions of the Agency by the Boards of Appeal by means of a transparent, thorough, fair and equitable procedure which takes into account the principles laid down 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	This recital corresponds to Article 65a.  It is unclear what "details on the content" of a notice appeal entails.	See also comments to Article 65a.



	the details on the content of the notice of appeal, the procedure for the filing and examination of an appeal, the content and form of the Board of Appeal's decisions and the reimbursement of the appeal fees.		
Recital 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.	This recital corresponds to Articles 74a and 74k.	See comments to Articles 74a and 74k.
Recital 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	This recital corresponds to Article 93a.	See comments to Article 93a.

	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.		
Recital 44	In order to allow for an effective and efficient conversion of an application or registration of a European trade mark into a national trade mark application while ensuring a thorough examination of the relevant requirements, 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 conditions with which a request for conversion must comply and the details of its examination and publication.	This recital corresponds to Article 114a.	See comments to Article 114a.
Recital 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	This recital corresponds to Article 144a.	See comments to Article 144a.

	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 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.		
Recital 46	In order to ensure the effective and efficient registration of international trade marks in full consistency with the rules of the Protocol relating to the Madrid Agreement concerning the international registration of 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 details on the procedures concerning the international registration of trade marks.	This recital corresponds to Article 161a.	See comments to Article 161a.
Article 24a	The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:  (a) the obligation of the applicant to provide a translation or transcription as referred to in Article 7(2)(b) in the language of the application;	The obligation referred to is introduced by the amending act. "Specifying the obligation" is very vague and opens up a possibility of altering the obligation in Article 7(2)(b), which is already clear.	Delete, not appropriate to delegate. Already sufficiently specified in the basic act.
	(b) the procedure for entering a transfer as referred to in Article 17(5) in the Register;	This relates to supplementing non-essential elements of an	Delegated acts acceptable.

		untouched Article in the amended act, and the objective, content and scope are sufficiently stated also taking into account Recital 26.	
	(c) the procedure for entering the creation or transfer of a right in rem as referred to in Article 19(2) in the Register;	This relates to supplementing non-essential elements of an Article in the amended act which will only be amended by the <u>addition of transfers</u> , and the objective, content and scope are sufficiently stated also taking into account Recital 26.	Delegated acts acceptable.
	(d) the procedure for entering levy of execution as referred to in Article 20(3) in the Register;	This relates to supplementing non-essential elements of an untouched Article in the amended act, and the objective, content and scope are sufficiently stated also taking into account Recital 26.	Delegated acts acceptable.
	(e) the procedure for entering the involvement in an insolvency procedure as referred to in Article 21(3) in the Register;	This relates to supplementing non-essential elements of an untouched Article in the amended act, and the objective, content and scope are sufficiently stated also taking	Delegated acts acceptable.

		into account Recital 26.	
	(f) the procedure for entering the grant or transfer of a license as referred to in Article 22(5) in the Register;	This relates to supplementing non-essential elements of an untouched Article in the amended act, and the objective, content and scope are sufficiently stated also taking into account Recital 26.	Delegated acts acceptable.
	(g) the procedure for cancelling or modifying the entry in the Register of a right <i>in rem</i> , levy of execution or a license, as referred to in Articles 19(3), 20(4) and 22(6) respectively.';	This relates to supplementing non-essential elements of Articles in the amended act which will be consequently amended to take into account <u>requests of one of the parties</u> , and the objective, content and scope are sufficiently stated also taking into account Recital 26.	Delegated acts acceptable.
Article 35a	<p>The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:</p> <p>(a) the means and modalities of filing an application for a European trade mark with the Agency in accordance with Article 25;</p>	<p>This relates to supplementing non-essential elements of an Article in the amended act which will be amended only to the effect of <u>restricting filing with OHIM</u>, and the objective, content and scope are</p>	Delegated acts acceptable.

		sufficiently stated also taking into account Recital 29.	
	(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);	<p>The details concerning the application are non-essential elements, and the objective, content and scope are sufficiently stated also taking into account Recital 29.</p> <p>The fee system does however constitute essential elements which should be kept in the basic act.</p> <p>The formal conditions of the application refers to new Article 26(3) which however in turn refers to the formal conditions established in accordance with Article 35a(b). There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define those formal conditions.</p>	<p>Delegated acts acceptable for specifying details regarding the application.</p> <p>Provisions on the fee system should be kept in the basic act.</p> <p>The formal conditions of the application in question should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.</p>

	(c) the procedures for ascertaining reciprocity in accordance with Article 29(5);	This relates to supplementing non-essential elements of an Article in the amended act which will be amended only to <u>allow the Commission to ascertain equivalent conditions</u> , and the objective, content and scope are sufficiently stated also taking into account Recital 29.	Delegated acts acceptable.
	(d) the procedure and the rules on information and documentation for claiming the priority of a previous application in accordance with Article 30;	<p>The rules refer to new Article 30 which however in turn refers to the rules adopted in accordance with Article 35a(d). There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define those rules.</p> <p>Under Article 30(2), the Executive Director may furthermore determine that additional information and</p>	<p>The rules in question should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.</p> <p>There should not be any contradiction between the requirements according to delegated</p>

		documentation to be provided by an applicant may consist of less than is required under the rules adopted in accordance with Article 35a(d).	acts and the powers of the Executive Director.
	(e) the procedure and the rules on evidence for claiming an exhibition priority in accordance with Article 33(1);	This relates to supplementing non-essential elements of an Article in the amended act which will be marginally amended, and the objective, content and scope are sufficiently stated also taking into account Recital 29.	Delegated acts acceptable.
	(f) the procedure for claiming the seniority of a national trade mark in accordance with Article 34(1) and Article 35(1).';	This relates to supplementing non-essential elements of an untouched Article in the amended act, and the objective, content and scope are sufficiently stated also taking into account Recital 29.	Delegated acts acceptable.
Article 39	1. If the conditions which the application for a European trade mark must satisfy have been fulfilled, the application shall be published for the purposes of Article 42 to the extent that it has not been refused pursuant to Article 37. The publication of the	This relates to supplementing non-essential elements of an untouched Article in the amended act, and the objective, content and scope are	Delegated acts acceptable.



	<p>application shall be without prejudice to information already made available to the public otherwise in accordance with this Regulation or with delegated acts adopted pursuant to this Regulation.</p>	<p>sufficiently stated also taking into account Recital 29.</p>	
Article 45a	<p>The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:</p> <p>(a) the procedure for the examination of compliance with the requirements for a filing date referred to in Article 36(1)(a) and with the formal conditions referred to in Article 26(3) and the procedure for verifying payment of the class fees referred to in Article 36(1)(c);</p>	<p>The formal conditions of the application refer to new Article 26(3) which however in turn refers to the formal conditions established in accordance with Article 35a(b). There is therefore no obligation in the basic act, and the Commission is effectively giving itself an unlimited margin of appreciation to define those formal conditions.</p> <p>The specification of procedures for compliance with requirements for a filing date and for verifying payment concern non-essential elements of an untouched Article in the amended act, and the objective, content and scope are sufficiently stated also taking into account Recital 31.</p>	<p>The rules in question should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU. Alternatively, this could be the subject of an implementing act.</p> <p>Delegated acts acceptable for procedures for compliance with requirements for a filing date and for verifying payment.</p>

	(b) the procedure for the examination of the absolute grounds for refusal as referred to in Article 37;	This relates to supplementing non-essential elements of an Article in the amended act which will only be amended by <u>deleting the rule on disclaiming exclusive rights to non-distinctive elements</u> , and the objective, content and scope are sufficiently stated also taking into account Recital 31.	Delegated acts acceptable.
	(c) the details which the publication of the application referred to in Article 39(1) shall contain;	The details of the publication refer to new Article 39(1) which however in turn refers to information made available in accordance with delegated acts. There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define those details.	The details and information in question should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.
	(d) the procedure for correcting mistakes and errors in publications of European trade mark applications	This relates to supplementing non-essential elements of new	Delegated acts acceptable.

	referred to in Article 39(3);	Article 39(3) in the amended act which aims at <u>obligating OHIM to correct mistakes</u> , and the objective, content and scope are sufficiently stated also taking into account Recital 31.	
	(e) the procedure for the submission of observations by third parties referred to in Article 40;	This relates to supplementing non-essential elements of new Article 40 in the amended act which <u>clarifies the conditions for interventions by third parties</u> , and the objective, content and scope are sufficiently stated also taking into account Recital 31.	Delegated acts acceptable.
	(f) the details on the procedure for filing and examining an opposition set out in Articles 41 and 42;	This relates to supplementing non-essential elements of Articles in the amended act which will be amended to <u>clarify the conditions concerning opposition</u> , and the objective, content and scope are sufficiently stated also taking into account Recital 31.	Delegated acts acceptable.
	(g) the procedures governing the amendment of the	This relates to supplementing	Delegated acts

	application pursuant to Article 43(2) and the division of the application pursuant to Article 44;	non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 31.	acceptable.
	(h) the particulars to be recorded in the Register when registering a European trade mark and the modalities of the publication of the registration referred to in Article 45(1), the content and the modalities of issue of the certificate of registration referred to in Article 45(2).';	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 31.	Delegated acts acceptable.
Article 49a	<p>The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:</p> <p>(a) the procedural modalities for the renewal of the European trade mark pursuant to Article 47, including the type of fees to be paid;</p>	<p>It is unclear why this provision uses the phrase "<u>the procedural modalities for</u>" rather than "the procedure for", which is used in the two ensuing suggested delegations in paragraphs (b) and (c) and elsewhere. The word "modalities" has connotations of policy choices which "procedure" does not.</p> <p>With the use of "procedure for", this provision would concern non-essential elements of the</p>	Delegated acts acceptable if "procedural modalities" is changed to "procedure for".

		Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 31.	
	(b) the procedure governing the alteration of the registration of a European trade mark provided for in Article 48(2);	This relates to supplementing non-essential elements of an untouched Article in the amended act, and the objective, content and scope are sufficiently stated also taking into account Recital 32.	Delegated acts acceptable.
	(c) the procedure governing the division of a European trade mark provided for in Article 49.;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 32.	Delegated acts acceptable.
Article 57a	<p>The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:</p> <p>(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;</p>	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 33.	Delegated acts acceptable.

	(b) the procedures governing the revocation and invalidity of a European trade mark referred to in Articles 56 and 57.';	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 33.	Delegated acts acceptable.
Article 65a	The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:  (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;	It is unclear what is meant by "content" here, and in what way it is intended to be specified by delegated acts.  Without "content" this provision would concern non-essential elements of the Regulation, and the objective, content and scope would be sufficiently stated also taking into account Recital 34.	Delegated acts acceptable if "content" is deleted or clarified.
	(b) the content and form of the Board of Appeal's decisions referred to in Article 64;	It is unclear what is meant by "content" here, and in what way it is intended to be specified by delegated acts.  Without "content" this provision would relate to supplementing	Delegated acts acceptable if "content" is deleted or clarified.

		<p>non-essential elements of the Regulation, and the objective, content and scope would be sufficiently stated also taking into account Recital 34.</p> <p>In could be noted that Article 93a below uses the wording "requirements concerning the form of the decisions" without any mentioning of "content".</p>	
	(c) the reimbursement of the appeal fees referred to in Article 60.";	There are no provisions in Article 60 providing for reimbursement of fees.	In order for this paragraph to be able to delegate powers, there needs to be rules on reimbursement in the basic act.
Article 74a	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).	There is no period referred to in Article 67(1). That article as amended does refer instead to the period prescribed in accordance with Article 74a. There is therefore no obligation in the basic act which can be supplemented or amended, and	The period in question should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or

		<p>the Commission is effectively giving itself an unlimited margin of appreciation to define that period.</p> <p>It is furthermore unclear what is meant by "content of those regulations" here, and in what way it is intended to be specified by delegated acts. With "content of those regulations" this provision would be too wide and possibly touch upon essential elements.</p>	<p>supplemented in accordance with Article 290 TFEU.</p> <p>The "content of those regulations" should be further specified in the basic act.</p>
Article 74k	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).	There is no period referred to in Article 74c(1). That article as amended does refer instead to the period prescribed in accordance with Article 74k. There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define that period.	<p>The period in question should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.</p> <p>Alternatively, this could be the subject of an</p>



		It is furthermore unclear what is meant by "content of those regulations" here, and in what way it is intended to be specified by delegated acts. With "content of those regulations" this provision would be too wide and possibly touch upon essential elements.	implementing act.  The "content of those regulations" should be further specified in the basic act.
Article 79	1. The Agency shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of delegated acts adopted pursuant to this Regulation, or of which notification has been ordered by the Executive Director of the Agency.	This provision does not provide for the adoption of delegated acts, but for an obligation for OHIM to make notifications of decisions and summonses if that is required under delegated acts adopted pursuant to the Regulation.	So long as the provisions on delegated acts in question allow for the introduction of a notification requirement, this provision should be acceptable.
Article 79a	Where the Agency finds that the loss of any rights results from this Regulation or delegated acts adopted pursuant to this Regulation without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 79. The latter may apply for a decision on the matter. The Agency shall adopt such a decision where it disagrees with the person requesting it; otherwise the Agency shall amend	This provision does not provide for the adoption of delegated acts, but for an obligation for OHIM to communicate any loss of rights and take decisions on any affected findings, where a delegated act adopted pursuant to the Regulation results in a loss.	So long as the provisions on delegated acts in question allow for the loss of rights, this provision should be acceptable.

	its finding and inform the person requesting the decision.		
Article 83	In the absence of procedural provisions in this Regulation or in delegated acts adopted pursuant to this Regulation, the Agency shall take into account the principles of procedural law generally recognised in the Member States.	This provision does not provide for the adoption of delegated acts, but a possibility for OHIM to fill any lacunae created by delegated acts by taking into account recognised principles.	This provision aims at dealing with legal voids, and does not directly affect delegated acts.
Article 89	1. The Agency shall periodically publish:  (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;	This provision does not provide for the adoption of delegated acts, it merely requires the publication of particulars prescribed by delegated acts adopted pursuant to the Regulation.	This provision provides a publication requirement, and does not directly affect delegated acts.
Article 93a	The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:  (a) the requirements concerning the form of the decisions referred to in Article 75;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 38.	Delegated acts acceptable.
	(b) the modalities of oral proceedings and of the taking of evidence referred to in Articles 77 and 78;	This relates to supplementing non-essential elements of the	Delegated acts acceptable.

		Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 38.	
	(c) the modalities of the notification referred to in Article 79;	<p>The provisions in Article 79 already include rules on notification by registered letter with advice of delivery and notification by electronic means. It also requires the Executive Director to determine how a public notice is to be given. It is therefore unclear what further modalities are required to be adopted by delegated acts.</p> <p>It could also be questioned whether this provision is redundant taking into account paragraph (e) below.</p>	Delegated acts do not seem to be necessary since the basic act and paragraph (e) already provides for modalities.
	(d) the procedure for the noting of loss of rights referred to in Article 79a;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking	Delegated acts acceptable.

		into account Recital 38.	
	(e) the rules on the means of communication, including the electronic means of communication referred to in Article 79b, to be used by the parties to proceedings before the Agency and the forms to be made available by the Agency;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 38.	Delegated acts acceptable.
	(f) the rules governing the calculation and duration of the time limits referred to in Article 79c(1);	There are no rules or time limits in Article 74c(1). That article as amended does refer instead to the rules and time limits adopted in accordance with Article 93a(f). There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define the rules and time-limits.	The rules and time limits in question should be further specified in the basic in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.
	(g) the procedure for the correction of linguistic errors or errors of transcription and manifest oversights in the Agency's decisions and technical errors attributable to the Agency in registering the trade mark or in publishing its registration as referred to in Article 79d;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking	Delegated acts acceptable.

		into account Recital 38.	
	(h) the procedure for the revocation of a decision or for the cancellation of an entry in the Register as referred to in Article 80(1);	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 38.	Delegated acts acceptable.
	(i) the modalities of the interruption and resumption of proceedings before the Agency as referred to in Article 82a;	There are no modalities in Article 82a. That article as amended does rather refer to the modalities adopted in accordance with Article 93a(i). There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define the modalities.	The modalities in question should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.
	(j) the procedures concerning the apportionment and fixing of costs, as referred to in Article 85(1);	There are no conditions in Article 85(1). That article as amended does rather refer to the conditions laid down in accordance with Article 93a(j).	The conditions in question should be further specified in the basic act in order to rectify the current

		There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define the modalities.	circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.
	(k) the particulars referred to in Article 87(1);	Under Article 87(1), there is already a requirement for OHIM to keep a register containing those particulars which are provided for by the Regulation. The Commission is therefore effectively supplementing or amending delegated acts, which is not possible under Article 290 TFEU.	The specific particulars not already provided for by other provisions should be further specified in the basic act and the phrase "or by a delegated act adopted pursuant to this Regulation" in Article 87(1) should be deleted in order to rectify the current situation whereby delegated acts effectively could be supplemented or amended.
	(l) the procedure for the inspection of files provided for in Article 88, including the parts of the file excluded	Article 88 as amended already provides that the Executive	No delegation needed, this provision should be

	from inspection, and the modalities of the keeping of files of the Agency provided for in Article 88(5);	Director shall determine the means of inspection and the form in which the files shall be kept.	deleted.
	(m) the modalities of publication of the particulars and entries referred to in Article 89(1)(a) in the European Trade Marks Bulletin, including the type of information, and the languages in which those particulars and entries are to be published;	See paragraph (k) above.	The specific particulars not already prescribed by other provisions should be further specified in the basic act and the phrase "or by delegated acts adopted pursuant to this Regulation" in Article 89(1)(a) should be deleted in order to rectify the current situation whereby delegated acts effectively could be supplemented or amended.
	(n) the frequency, form and languages in which publications of the Official Journal of the Agency referred to in Article 89(1)(b) shall be made;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking	Delegated acts acceptable.

		into account Recital 38.	
	(o) the modalities of the exchange of information and communications between the Agency and the authorities of the Member States and of the inspection of files by or via courts or authorities of the Member States pursuant to Article 90;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 38.	Delegated acts acceptable.
	(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 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).';	<p>The conditions under which employees referred to in Article 92(3) and professional representatives referred to in Article 93(1) must file with the Agency a signed authorisation relate to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 38.</p> <p>When it comes to paragraphs 2, 4 and 5 of Article 92, as amended, they refer to cases provided for and the conditions established in accordance with Article 93a(p).</p>	<p>Delegated acts acceptable concerning Article 92(3).</p> <p>The specific cases and conditions in Paragraphs 2, 4 and 5 of Article 92, should be further specified in the basic act and the phrase "or by a delegated act adopted pursuant to this Regulation" in Article 87(1) should be deleted in order to rectify the current situation whereby delegated acts could effectively be</p>



		There are therefore no obligations in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define the modalities.	supplemented or amended.
Article 114	In Article 114(2), the words 'the Implementing Regulation' are replaced by 'delegated acts adopted in accordance with this Regulation';	This Article relates to formal requirements of national law, concerning the transmission of applications or trade marks, which are different from or additional to those in the Regulation or delegated acts.	
Article 114a	The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying the formal conditions with which a request for conversion of a European trade mark application must comply, the details of its examination, and those concerning its publication.	This provision is a blanket delegation without any stated corresponding rule or obligation in the basic act. There is therefore nothing which can be amended or supplemented.	If there are no rules or obligations in Articles 112-114 in the Regulation on which to base the delegation, those should be further specified in the basic act.
Article 128	4. The Executive Director shall have in particular the following functions:	See above concerning Articles 30, 79 and 88.	Either the powers of the Executive Director or

	<p>[...]</p> <p>(n) he shall exercise the powers conferred to him by Articles 26(3), 29(5), 30(2), 45(3), 75(2), 78(5), 79, 79b, 79c, 87(3), 88, 89, 93(4), 119(8) and 144 in accordance with the criteria set out in this Regulation and in the delegated acts adopted pursuant to this Regulation;</p>	There cannot be any contradictions between the powers of the Executive Director and the scope of the delegation of legislative power.	the delegations of power must be amended in order to avoid contradictions.
Article 144a	<p>The Commission shall be empowered to adopt delegated acts in accordance with Article 163 in order to establish:</p> <p>(a) the specific criteria of use of the languages referred to in Article 119;</p>	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 45.	Delegated acts acceptable.
	<p>(b) the cases in which opposition and cancellation decisions shall be taken by a single member under Article 132(2) and Article 134(2);</p>	<p>This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 45.</p> <p>The references in Articles 132(2) and 134(2) are currently to Article 144a(c).</p>	<p>Delegated acts acceptable.</p> <p>The references in Articles 132(2) and 134(2) should however be to Article 144a(b).</p>

	(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 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);	<p>The "role of the authority" seems a bit wide, in terms of its scope, and could possibly touch upon essential elements.</p> <p>Other than that, this provision relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 45.</p>	Delegated acts acceptable, except that the "role of the authority" could be made explicit in the basic act.
	(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).';	With the exception of the structure and the amounts of fees, which are essential elements and should therefore not be the subject of delegations, this provision relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 45.	Delegated acts acceptable except for the structure and amounts of fees.
Article 145	In Article 145, the words 'its Implementing Regulations' are replaced by 'the delegated acts adopted pursuant to this Regulation';	This provision concerns the application of rules to international registrations.	This provision does not directly affect the delegation of power.

Article 161a	<p>The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:</p> <p>(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);</p>	<p>There are no formal conditions in Article 147(5). That article as amended does rather refer to the formal conditions established in accordance with Article 161a(a). There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define the formal conditions.</p> <p>Other than that, this provision relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 46.</p>	<p>Delegated acts acceptable except for the formal conditions of an international application which should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.</p>
	<p>(b) the modalities of the notification provided for in Article 148a;</p>	<p>This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking</p>	<p>Delegated acts acceptable.</p>

		into account Recital 46.	
	(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;	<p>There are no formal conditions in Article 149. That article as amended does rather refer to the formal conditions established in accordance with Article 161a(c). There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define the formal conditions.</p> <p>There is no Article 149(2), it has just one paragraph. The amendment concerning formal conditions is added as a final sentence.</p>	<p>The formal conditions for a request should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.</p> <p>The reference should be to Article 149.</p>
	(d) the procedure for filing a seniority claim pursuant to Article 153;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 46.	Delegated acts acceptable.

	(e) the procedures for the examination of absolute grounds for refusal referred to in Article 154 and for the filing and examination of an opposition pursuant to Article 156, including the necessary communications to be made to the International Bureau;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 46.	Delegated acts acceptable.
	(f) the procedures with regard to the international registrations referred to in Article 154a;	There are no procedures referred to in Article 154a. That article as amended does rather refer to the procedures provided for in accordance with Article 161a(f). There is therefore no obligation in the basic act which can be supplemented or amended, and the Commission is effectively giving itself an unlimited margin of appreciation to define the procedures.	The procedures should be further specified in the basic act in order to rectify the current circular lack of obligation which means that nothing is in fact amended or supplemented in accordance with Article 290 TFEU.
	(g) the cases where the Agency shall notify the International Bureau of the invalidation of the effects of an international registration pursuant to Article 158 and the information that such notification shall contain;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 46.	Delegated acts acceptable.

	(h) the modalities of transmission of the requests referred to in Article 158c to the International Bureau;	<p>Article 158c refers to "the cases specified in accordance with Article 161a(h)" and not "the modalities of transmission".</p> <p>Whichever is the case, this relates to supplementing non-essential elements of the Regulation.</p>	Delegated acts acceptable so long as it is clarified whether the object is modalities of transmission or specified cases.
	(i) the conditions with which a request for conversion pursuant to Article 159(1) shall comply;	This relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 46.	Delegated acts acceptable.
	(j) the formal conditions of an application for transformation referred to in Article 161 and the procedures for such a transformation;	<p>There are no "formal conditions of an application for transformation" referred to in Article 161.</p> <p>The provision on procedures relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are</p>	Delegated acts acceptable except for "formal conditions", which need to be clarified in the basic act.

		sufficiently stated also taking into account Recital 46.	
	(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.';	<p>There is no "communication to be made" pursuant to Article 147(4).</p> <p>Except for this, the provision relates to supplementing non-essential elements of the Regulation, and the objective, content and scope are sufficiently stated also taking into account Recital 46.</p>	Delegated acts acceptable except for "communication to be made", which needs to be clarified in the basic act.
Article 163a	1. The power to adopt delegated acts is conferred on the Commission subject to the conditions laid down in this Article.		Corresponds to the model Article in the Common Understanding.
	2. The delegation of power referred to in Articles 24a, 35a, 45a, 49a, 57a, 65a, 74a, 74k, 93a, 114a, 144a and 161a shall be conferred for an indeterminate period of time.	Parliament could opt for a set duration, for instance a number of years, coupled with reporting requirements (option 2 in the Common Understanding).	Corresponds to the model Article in the Common Understanding.



	3. The delegation of power referred to in paragraph 2 may be revacetableed at any time by the European Parliament or by the Council. A decision of revocation shall put an end to the delegation of the power specified in that decision. It shall take effect the day following the publication of the decision in the <i>Official Journal of the European Union</i> or at a later date specified therein. It shall not affect the validity of any delegated acts already in force.		Corresponds to the model Article in the Common Understanding.
	4. As soon as it adopts a delegated act, the Commission shall notify it simultaneously to the European Parliament and to the Council.		Corresponds to the model Article in the Common Understanding.
	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.';	The objection period is the standard 2+2 months, which Parliament is free to make longer or shorter.	Corresponds to the model Article in the Common Understanding.  Parliament is free to change the timeframes.

14.10.2013

## **OPINION OF THE COMMITTEE ON INTERNATIONAL TRADE**

for the Committee on Legal Affairs

on the proposal for a regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark (COM(2013)0161 – C7-0087/2013 – 2013/0088(COD))

Rapporteur: George Sabin Cutaş

### **SHORT JUSTIFICATION**

The main objective of the proposal for the amendment of Council Regulation (EC) No 2007/2009 on the Community trade mark together with the proposal for amending Directive 2008/95/EC is to harmonize trade mark registration systems in all EU Member States, as well as to ensure coexistence and complementarity between the EU and national trade mark systems, in order to make them more efficient for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal security. This could lead to a substantive increase in innovation and economic growth.

The opinion focuses exclusively on the trade-related aspects of the proposal and notably on the transit of counterfeit goods through the Union and the sale of counterfeit goods over the internet. Concerning the former, the Commission's proposal aims at reducing the transit of counterfeit goods through the Union. The opinion supports this initiative although it makes it clear that this should not have negative repercussions on the Union's right to support access to medicines for third countries in accordance with the *WTO Doha Ministerial Declaration on the TRIPS agreement and public health* adopted on 14 November 2001. It should be acknowledged, however, that the issue of access to medicines is mainly related to patents and only to a lesser extent to trade marks.

As for the second trade-related aspect, the proposal's objective is to prevent the entry of counterfeit goods into the Union especially through sales over the internet. This is a problem which has become particularly relevant in the last years due to the increase of the number of sales over the internet. The opinion clarifies the legal instruments which allow the trade mark proprietor to take actions to prevent the importing of counterfeit goods where it is only the consignor who acts for commercial purposes. Given the relevance of the problem and the economic interests at stake it is also appropriate that controls by Member States over internet websites selling counterfeit goods are improved.

Finally, the opinion points at the necessity of widening the EU *acquis* on the protection of geographical indications in the Union by including through a future EU legislative act geographical indications on goods other than agricultural and foodstuffs, wine and spirits.

### **AMENDMENTS**

The Committee on International Trade calls on the Committee on Legal Affairs, as the committee responsible, to incorporate the following amendments in its report:

## Amendment 1

### Proposal for a regulation

#### Recital 13

##### *Text proposed by the Commission*

(13) With the aim of maintaining strong protection of rights in designations of origin and geographical indications protected at Union level, it is necessary to clarify that those rights entitle to bring an opposition against the registration of a later European trade mark, regardless of whether or not they are also grounds for refusal to be taken into account ex officio by the examiner.

##### *Amendment*

(13) With the aim of maintaining strong protection of rights in designations of origin and geographical indications protected at Union level, it is necessary to clarify that those rights entitle to bring an opposition against the registration of a later European trade mark, regardless of whether or not they are also grounds for refusal to be taken into account ex officio by the examiner. ***Since Union legislation exists only concerning the protection of geographical indications of agricultural products and foodstuff, wine and spirits, the Commission should adopt a proposal for a regulation harmonising Member States' rules on the protection of geographical indications also for goods other than agricultural and foodstuffs, wine and spirits.***

## Amendment 2

### Proposal for a regulation

#### Recital 18

##### *Text proposed by the Commission*

(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

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

from third countries and bear without authorization a trade mark which is identical to the European trade mark registered in respect of such goods. ***This should be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit and its right to promote access to medicines for third countries, and more specifically to the production, circulation and distribution of generic medicines in the EU and abroad.***

### Amendment 3

#### 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 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. ***For this purpose, the proprietor should take relevant actions as provided for under Directive 48/2004/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights and Regulation 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights.***

### Amendment 4

#### Proposal for a regulation Article 1 – point 12

*Text proposed by the Commission*

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.

*Amendment*

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.

***To this purpose the proprietor of a European trade mark shall be entitled to take relevant legal actions as provided by Directive 48/2004/EC and to request national customs authorities to take action in respect of goods which allegedly infringe their rights, such as detention and destruction in accordance with. Regulation 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights .***

***Member States shall also take appropriate measures to prevent the sale of counterfeit goods over the internet.***

**Amendment 5**

**Proposal for a regulation**  
**Article 1 – paragraph 1 – point 12**  
Regulation 2009/207/EC  
Article 9 – paragraph 5

*Text proposed by the Commission*

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

*Amendment*

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.

registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. ***This shall be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit.***

## **Amendment 6**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 13**

Regulation 2009/207/EC

Article 9a – point a

#### *Text proposed by the Commission*

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

#### *Amendment*

(a) affixing in the course of trade a sign identical with or similar to, ***as specified in Article 8(1) of this Regulation***, the European trade mark on get-up, packaging or other means on which the mark may be affixed;

#### *Justification*

*Paragraph should be consistent with the identification and similarity provisions already specified in Article 8(1).*

## **Amendment 7**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 74 a a (new)**

#### *Text proposed by the Commission*

#### *Amendment*

***(74 aa) Indemnification of the Importer and the Owner of the Goods***

***The Agency shall have the authority to order a proprietor of a European trade mark to pay the importer, the consignee and owner of the goods appropriate compensation for any injury caused to them through a wrongful detention of***

***goods due to import restriction rights  
granted in Article 9.***

*Justification*

*In accordance with TRIPS Article 56, the relevant agency shall have the authority to order an applicant, in this case a trade mark proprietor, to appropriately compensate importers or owners for wrongful detentions. Wrongful detentions are a major and escalating problem. According to the Commission annual report "EU Customs Enforcement of Intellectual Property Rights: Results at the Border", in 2011, goods were detained by mistake in more than 2 700 cases, an increase of 46 % over two years before.*

## PROCEDURE

<b>Title</b>	Community trade mark
<b>References</b>	COM(2013)0161 – C7-0087/2013 – 2013/0088(COD)
<b>Committee responsible</b> Date announced in plenary	JURI 16.4.2013
<b>Opinion by</b> Date announced in plenary	INTA 16.4.2013
<b>Rapporteur</b> Date appointed	George Sabin Cutaş 25.4.2013
<b>Discussed in committee</b>	11.7.2013                      16.9.2013
<b>Date adopted</b>	14.10.2013
<b>Result of final vote</b>	+:                      22 –:                      2 0:                      0
<b>Members present for the final vote</b>	Laima Liucija Andrikienė, Maria Badia i Cutchet, Nora Berra, Daniel Caspary, María Auxiliadora Correa Zamora, Andrea Cozzolino, George Sabin Cutaş, Marielle de Sarnez, Christofer Fjellner, Yannick Jadot, Franziska Keller, Bernd Lange, Vital Moreira, Paul Murphy, Niccolò Rinaldi, Helmut Scholz, Peter Šťastný, Robert Sturdy, Jan Zahradil
<b>Substitute(s) present for the final vote</b>	Jarosław Leszek Wałęsa
<b>Substitute(s) under Rule 187(2) present for the final vote</b>	Elisabeth Jeggle, Krzysztof Lisek, Iosif Matula, Paul Rübig, Catherine Stihler



7.11.2013

## **OPINION OF THE COMMITTEE ON THE INTERNAL MARKET AND CONSUMER PROTECTION**

for the Committee on Legal Affairs

on the proposal for a regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark (COM(2013)0161 – C7-0087/2013 – 2013/0088(COD))

Rapporteur: Regina Bastos

### **SHORT JUSTIFICATION**

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

#### **Aim of the proposal**

The Community trade mark is an intellectual property right established under Article 118, first paragraph, of the Treaty on the Functioning of the European Union (TFEU). The Commission's impact assessment has demonstrated that some amendments need to be made to the regulation in order to improve and streamline the Community trade mark system.

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

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

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

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

As regards the revision of the regulation, the Commission is not proposing a new system, but modernisation focusing on given existing provisions, primarily with a view to:

- adapting the terminology of the regulation to the Treaty of Lisbon and its provisions to the Common Approach on decentralised agencies,
- streamlining European trade mark application and registration procedures,
- clarifying certain legal points,
- organising cooperation between the OHIM and national offices, and
- aligning the framework with Article 290 TFEU on delegated acts.

### **Internal market aspects**

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

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

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

## The rapporteur's view

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

- strengthen the role of national authorities in the trade mark protection system and in combating counterfeiting;
- remove the stipulation that the Agency is the only place at which European trade mark applications may be filed;
- make some clarifications regarding the signs of which a European trade mark may consist;
- alter the time-frame for designation and classification of goods and services;
- add to the tasks to be undertaken by the Agency;
- adjust the membership of the Management Board; and
- propose alternative arrangements regarding fees.

## AMENDMENTS

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

### Amendment 1

#### Proposal for a 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

###### *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 implies 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

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').

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

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

#### *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 trade mark. A sign should be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, ***with the requirement that it be possible to represent the sign, when published and inscribed in the register, in a way that*** enables the competent authorities and the public to determine with precision and clarity the precise subject matter of protection.

## Amendment 3

### Proposal for a regulation Recital 12 a (new)

#### *Text proposed by the Commission*

#### *Amendment*

***(12a) Notice of opposition to registration of the trade mark may also be given by any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or***

*consumers furnishing proof that a trade mark is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;*

#### **Amendment 4**

##### **Proposal for a regulation**

##### **Recital 15**

###### *Text proposed by the Commission*

(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.

###### *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 is adversely affected.

#### **Amendment 5**

##### **Proposal for a regulation**

##### **Recital 15 a (new)**

###### *Text proposed by the Commission*

###### *Amendment*

***(15a) The main function of a trademark is to guarantee the origin of the product to the consumer or final user by enabling him or her to distinguish without any possibility of confusion between that product and products which have another origin;***

## Amendment 6

### Proposal for a regulation Recital 15 b (new)

*Text proposed by the Commission*

*Amendment*

***(15b) When determining whether the main function of a trade mark is adversely affected, it is necessary to interpret this provision in the light of Article 11 of the Charter of Fundamental Rights of the European Union and Article 10 of the European Convention on Human Rights in order to guarantee the fundamental right of freedom of expression.***

## Amendment 7

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

(18) With the aim of strengthening trade mark protection and ***combating*** counterfeiting more effectively, the proprietor of a registered trade mark, ***assisted by the national authorities***, should be entitled to prevent third parties from bringing goods into the customs territory of the Union 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 European trade mark registered in respect of such goods.

*Justification*

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

## Amendment 8

### 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 infringing goods, particularly in the context of sales over the Internet, the proprietor, ***assisted by the national authorities***, should be entitled to prohibit the importing ***or offering*** of such goods into the Union, where it is only the consignor, ***intermediary, agent or online sales services provider of the merchandise*** of the goods who acts for commercial purposes.

#### *Justification*

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

## Amendment 9

### Proposal for a regulation Recital 21 a (new)

#### *Text proposed by the Commission*

#### *Amendment*

***(21a) The exclusive rights conferred by a trade mark should not entitle the proprietor to prohibit the use of signs or indications which are used for a due cause in order to allow consumers to make comparisons, to express opinions or where there is no commercial use of the mark.***

## Amendment 10

### Proposal for a regulation Recital 27

*Text proposed by the Commission*

*Amendment*

***(27) In view of the gradual decline and insignificant number of Community trade mark applications filed at the central intellectual property offices of the Member States ('the offices of the Member States'), it should be only allowed to file a European trade mark application at the Agency.***

***deleted***

*Justification*

*Given that the aim is to make life easier for people and businesses, all the options for registering trade marks at European level should continue to be available; in future, therefore, the procedure should still be possible to handle at national offices acting purely as intermediaries of the Agency.*

## Amendment 11

### Proposal for a regulation Recital 45

*Text proposed by the Commission*

*Amendment*

(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 delegated to the Commission in respect of specifying the ***details on the languages*** to be used ***before*** the Agency, the cases

(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 delegated to the Commission in respect of specifying the ***rules for applying the language regime*** to be used ***in*** the Agency,



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.

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.

## **Amendment 12**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 9**

Regulation (EC) 207/2009

Article 4 – point b

#### *Text proposed by the Commission*

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

#### *Amendment*

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

#### *Justification*

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

## **Amendment 13**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 12**

Regulation (EC) 207/2009

Article 9 – paragraph 2 – point a

#### *Text proposed by the Commission*

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 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;

#### *Amendment*

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 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 *by enabling him or her to distinguish without any*

*possibility of confusion between that product and products which have another origin;*

## Amendment 14

### Proposal for a regulation

#### Article 1 – paragraph 1 – point 12

Regulation (EC) 207/2009

Article 9 – paragraph 4

#### *Text proposed by the Commission*

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.

#### *Amendment*

The proprietor of a European trade mark shall also be entitled to prevent, ***with the assistance of the national authorities***, the importing of goods pursuant to paragraph 3(c) ***or the offering of goods pursuant to paragraph 3(b)***, where the consignor, ***intermediary, agent or online sales services provider of the merchandise*** acts for commercial purposes.

## Amendment 15

### Proposal for a regulation

#### Article 1 – paragraph 1 – point 12

Regulation (EC) 207/2009

Article 9 – Paragraph 5

#### *Text proposed by the Commission*

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***

#### *Amendment*

The proprietor of a European trade mark shall also be entitled to prevent all third parties from bringing goods ***infringing this European trade mark*** into the customs territory of the Union, where such goods, including packaging:

*essential aspects from that trade mark';*

*(a) 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;*

*(b) and are intended to be the subject of commercial activity without being released for free circulation in that territory.*

#### *Justification*

*The channels for trade in counterfeit and contraband goods tend to follow the channels for legitimate international trade. As some criminal networks find it relatively easy to forge customs documents, particularly in regard to the goods' origin and destination, the Committee on the Internal Market and Consumer Protection feels it necessary to reiterate the importance of protecting the internal market and consumer rights, health and safety by controlling trade flows.*

#### **Amendment 16**

##### **Proposal for a regulation**

##### **Article 1 – paragraph 1 – point 12**

Regulation (EC) No 207/2009

Article 9 – paragraph 5

##### *Text proposed by the Commission*

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.';

##### *Amendment*

5. The proprietor of a registered trade mark, ***assisted by the national authorities***, shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Union 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 European trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.';

*Justification*

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

**Amendment 17**

**Proposal for a regulation**

**Article 1 – paragraph 1 – point 14**

Regulation (EC) No 207/2009

Article 12 – paragraph 1 – subparagraph 2

*Text proposed by the Commission*

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

*Amendment*

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

*Justification*

*This amendment seeks to clarify that the requirement of fair use applies to points (a), (b) and (c), not only to point (a).*

**Amendment 18**

**Proposal for a regulation**

**Article 1 – paragraph 1 – point 14**

Regulation (EC) 207/2009

Article 12 – paragraph 2 a (new)

*Text proposed by the Commission*

*Amendment*

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

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

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

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

## **Amendment 19**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 16**

Regulation (EC) 207/2009

Article 15 – paragraph 1

*Text proposed by the Commission*

*Amendment*

***In Article 15(1), the first subparagraph is replaced by the following:***

***If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in a Member State or a part thereof in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.***

#### *Justification*

*It is suggested to replace the words "in the Community" by the words "in a Member State or a part thereof". As long as use is 'genuine', it should be sufficient to defeat a claim for revocation on grounds of non-use of an EU trade mark if the use has been confined to a single Member State or a part thereof.*

## **Amendment 20**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 25**

Regulation (EC) 207/2009

Article 25

*Text proposed by the Commission*

*Amendment*

An application for a European trade mark shall be filed at the Agency.’;

An application for a European trade mark shall be filed at the Agency ***or at the***

*office.’;*

#### *Justification*

*Given that the aim is to make life easier for people and businesses, all the options for registering trade marks at European level should continue to be available; in future, therefore, the procedure should still be possible to handle at national offices acting purely as intermediaries of the Agency.*

### **Amendment 21**

#### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 27**

Regulation (EC) 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 trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Agency ***or the office*** by the applicant, subject to payment of the application fee ***within a period of one month of filing the abovementioned documents;***

#### *Justification*

*The date of filing of a European trade mark application means the date on which documents containing the information specified in Article 26(1) are filed by the applicant with the Agency or the national industrial property office. The current grace period of one month should be preserved in order to enable applicants to withdraw and re-file applications without having to pay the fee twice. This is especially important for SMEs, who are more likely to submit erroneous applications and would particularly suffer if they had to pay the fee twice.*

### **Amendment 22**

#### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 28**

Regulation (EC) 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.

*Justification*

*The window to amend class headings should not only apply to registrations solely comprised of class headings, but also to those which comprise an entire class heading as well as certain other goods/services.*

**Amendment 23**

**Proposal for a regulation**

**Article 1 – paragraph 1 – point 28**

Regulation (EC) 207/2009

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 ***at the time of registering alterations or of renewal***, 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).

### *Justification*

*Anyone who registered a trade mark before 22 June 2012 complied with all the legal requirements in force at that time. To avoid complicated additional formalities, the procedure concerned here should be completed when the Register is to be amended or at the time of applying for renewal of a trade mark.*

## **Amendment 24**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 30**

Regulation (EC) 207/2009

Article 30 – paragraph 1 – subparagraph 1

*Text proposed by the Commission*

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*

*An applicant desiring to take advantage of the priority of a previous application shall file a declaration of priority and a copy of the previous application. If the language of the latter is not one of the languages of the Agency, the applicant shall file a translation of the previous application in one of those languages.*

### *Justification*

*According to the Implementing Regulation of the CTMR, the priority right may be claimed either in the application or within a period of two months from the filing date of the application. The right of priority shall have the effect that the date of priority shall count as the date of filing of the application for the purposes of establishing which rights take precedence. This change seeks to maintain the current wording of Article 30, thereby maintaining the two month grace period.*

## **Amendment 25**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 38**

Regulation (EC) 207/2009

Article 40 – paragraph 1 – subparagraph 2

*Text proposed by the Commission*

*They shall not be parties to the*

*Amendment*

*deleted*



*proceedings before the Agency.*

## **Amendment 26**

### **Proposal for a regulation**

**Article 1 – paragraph 1 – point 39 a (new)**

Regulation (EC) 207/2009

Article 41 – paragraph 5 (new)

*Text proposed by the Commission*

*Amendment*

***(39a) In Article 41, the following paragraph 5 is added:***

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

## **Amendment 27**

### **Proposal for a regulation**

**Article 1 – paragraph 1 – point 40 a (new)**

Regulation (EC) 207/2009

Article 42 – paragraph 4

*Text proposed by the Commission*

*Amendment*

***(40a) In Article 42, paragraph 4 is replaced by the following:***

***The Agency may, if it thinks fit, invite the parties to make a friendly settlement, preferably before the formal start of opposition proceedings. In doing so, the Agency shall include information on available mediation proceedings and specialised mediation services, including services provided by external mediators***

*accredited by the Agency.*

*Where the parties decide to make a friendly settlement during the opposition proceedings, the Agency shall grant both parties reasonable extensions to conclude the mediation process.*

#### *Justification*

*Current wording of Article 42(4): "The Office may, if it thinks fit, invite the parties to make a friendly settlement. "Mediation services provided by OHIM are limited to appeal proceedings and only its employees can serve as mediators. The number of mediations conducted to date has been minimal. In order to increase the attractiveness of mediation, parties should be encouraged to make use of it at an earlier stage. The parties should also be entitled to choose external mediators.*

## **Amendment 28**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 50 a (new)**

Regulation (EC) 207/2009

Article 57 – paragraph 4

*Text proposed by the Commission*

*Amendment*

*(50a) Article 57 (4) is replaced by the following:*

*The Agency may, if it thinks fit, invite the parties to make a friendly settlement, preferably before the formal start of cancellation proceedings. In doing so, the Agency shall include information on available mediation proceedings and specialised mediation services, including services provided by external mediators accredited by the Agency.*

*Where the parties decide to make a friendly settlement during the opposition proceedings, the Agency shall grant both parties reasonable extensions to conclude the mediation process.*

#### *Justification*

*Current wording of Article 57 (4): "The Office may, if it thinks fit, invite the parties to make a*

*friendly settlement. "Mediation services provided by OHIM are limited to appeal proceedings and only its employees can serve as mediators. The number of mediations conducted to date has been minimal. In order to increase the attractiveness of mediation, parties should be encouraged to make use of it at an earlier stage. The parties should be entitled to choose external mediators.*

## **Amendment 29**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 98**

Regulation (EC) 207/2009

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

*Text proposed by the Commission*

*Amendment*

*(da) administration and promotion of the protected designations of origin, protected geographical indications, and traditional specialities guaranteed schemes established by Regulation (EU) No 1151/2012;*

#### *Justification*

*Given that intellectual property rules are increasingly being harmonised at European level, it is entirely logical for all products to be protected by the same rules, as this will make for legal coherence.*

## **Amendment 30**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 98**

Regulation (EC) 207/2009

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

*Text proposed by the Commission*

*Amendment*

*(db) administration and promotion of the protected geographical indications established by Regulation (EC) No 1234/2007 and Regulation (EC) No 110/2008 of the European Parliament and of the Council;*

### *Justification*

*Given that intellectual property rules are increasingly being harmonised at European level, it is entirely logical for all products to be protected by the same rules, as this will make for legal coherence.*

### **Amendment 31**

#### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 98**

Regulation (EC) 207/2009

Title XII – Section 1 a – Article 123 b – paragraph 1 – point d c (new)

*Text proposed by the Commission*

*Amendment*

***(dc) administration and promotion of other European intellectual property rights established pursuant to Article 118 of the Treaty on the Functioning of the European Union.***

### *Justification*

*Given that intellectual property rules are increasingly being harmonised at European level, it is entirely logical for all products to be protected by the same rules, as this will make for legal coherence.*

### **Amendment 32**

#### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 98**

Regulation (EC) 207/2009

Title XII – Section 1 a – 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 ***online and offline*** voluntary mediation services for the purpose of ***facilitating access to alternative dispute resolution procedures and promoting*** amicable settlement ***of disputes, including under Directive 2008/52/EC of the European Parliament and of the Council of 21 May 2008 on certain aspects of mediation in civil and commercial***

*matters*<sup>9a</sup>.

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<sup>9a</sup> OJ L 136, 24.5.2008, p. 3.

*Justification*

*Mediation of this kind is important in that it will avoid the higher costs entailed in litigation as well as enabling disputes to be resolved more quickly.*

**Amendment 33**

**Proposal for a regulation**

**Article 1 – paragraph 1 – point 98**

Regulation (EC) 207/2009

Title XII – Section 1a – Article 123 c – paragraph 2

*Text proposed by the Commission*

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*

The Agency shall, ***in cooperation with the offices of the Member States***, 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 34**

**Proposal for a regulation**

**Article 1 – paragraph 1 – point 99**

Regulation (EC) 207/2009

Title XII – Section 2 – Article 124 – paragraph 1 – point ka (new)

*Text proposed by the Commission*

*Amendment*

***(ka) The Management Board shall approve the rules on mediation and arbitration and those governing the functioning of the Centre established for the purpose, on the basis of a draft***

## **Amendment 35**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 99**

Regulation (EC) 207/2009

Title XII – Section 2 – 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, **one representative** of the Commission, **and one representative of the European Parliament**, and their alternates.

#### *Justification*

*The membership of the Management Board should be based on joint representation, in other words it should consist of one representative per Member State, one representative from the Commission, and one from Parliament so as to provide institutional balance and enable the EP to play a real role in overseeing the management of the Agency.*

## **Amendment 36**

### **Proposal for a regulation**

#### **Article 1 – paragraph 1 – point 99**

Regulation (EC) 207/2009

Title XII – Section 3 – Article 128 – paragraph 4 – point oa (new)

#### *Text proposed by the Commission*

#### *Amendment*

**(oa) he shall prepare a mediation project and rules for arbitration, as well as rules for the functioning of the Centre created for the purpose, and shall submit them to the Management Board for adoption;**

## Amendment 37

### Proposal for a regulation

#### Article 1 – paragraph 1 – point 99

Regulation (EC) 207/2009

Title XII – Section 3 – Article 129 – paragraph 2 – subparagraph 1

#### *Text proposed by the Commission*

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.

#### *Amendment*

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

## Amendment 38

### Proposal for a regulation

#### Article 1 – paragraph 1 – point 99

Regulation (EC) 207/2009

Title XII – Section 3 – Article 129 – paragraph 2 – subparagraph 2

#### *Text proposed by the Commission*

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

#### *Amendment*

The **removal from office of the** Executive Director may only **take place** upon a decision of the Management Board, **reached by a two-thirds majority of its members and** acting on a proposal from the European Commission **or the European Parliament**.

## Amendment 39

### Proposal for a regulation

#### Article 1 – paragraph 1 – point 99

Regulation (EC) 207/2009

Title XII – Section 3 – Article 129 – paragraph 3

*Text proposed by the Commission*

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.*

*Amendment*

The Executive Director shall *hold office for a term of* five years. *The Executive Director's term of office may be extended once by the Management Board, for a single period of five years or until the age of retirement, if this is reached during the course of the term of office.*

## Amendment 40

### Proposal for a regulation

#### Article 1 – paragraph 1 – point 99

Regulation (EC) 207/2009

Title XII – Section 3 – Article 129 – paragraph 4

*Text proposed by the Commission*

*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.*

*Amendment*

*deleted*

## Amendment 41

### Proposal for a regulation

#### Article 1 – paragraph 1 – point 106 a (new)

Regulation (EC) 207/2009

Article 137 a (new)

*Text proposed by the Commission*

*Amendment*

*Centre for arbitration and mediation of trade marks, designs and models*



*1. A centre for the arbitration of trade marks, designs and models (the Centre) shall be created within the Agency.*

*2. Facilities shall be made available to the Centre for the mediation and arbitration of disputes involving two or more parties in relation to trade marks, designs and models, pursuant to this regulation and to Regulation (EC) No 6/2002, in Community project.*

*3. The Administrative Board shall approve the rules on mediation and arbitration and the rules governing the functioning of the Centre, on the basis of a draft submitted by the Executive Director pursuant to Article 128(4)(o).*

*4. Where the dispute concerns an objection, annulment or proceedings between parties, the parties involved may at any point and by mutual agreement ask for the procedure to be suspended so that a mediation or arbitration process can be opened.*

*5. The Agency and its appeal boards may, if they consider it appropriate, discuss with the parties the possibility of an agreement, which may also be reached through mediation and/ or arbitration, using the Centre's facilities.*

*6. The Centre shall draw up a list of mediators and arbitrators to assist the parties in the settlement of their dispute.*

*7. 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;*

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

*8. 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.*

*9. Any agreement reached using the Centre's facilities, including by mediation, shall be enforceable before the Agency or in any Member State, without prejudice to the enforcement procedures established by the law of the Member State in which it is enforced.*

## Amendment 42

### Proposal for a regulation

#### Article 1 – paragraph 11 – point 110

Regulation (EC) 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 such **a** 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 **revise** the level of fees **downwards** should a significant surplus become recurrent. ***Any significant surplus accumulated in spite of such revision shall be used to promote and improve the European trade mark system.***

#### *Justification*

*Given that it stems from the fees paid by applicants for registration and renewal of trade marks, the surplus should be used to improve the EU trade mark system.*

## PROCEDURE

<b>Title</b>	Community trade mark		
<b>References</b>	COM(2013)0161 – C7-0087/2013 – 2013/0088(COD)		
<b>Committee responsible</b> Date announced in plenary	JURI 16.4.2013		
<b>Opinion by</b> Date announced in plenary	IMCO 16.4.2013		
<b>Rapporteur</b> Date appointed	Regina Bastos 29.5.2013		
<b>Discussed in committee</b>	9.7.2013	25.9.2013	14.10.2013
<b>Date adopted</b>	5.11.2013		
<b>Result of final vote</b>	+: 36 -: 1 0: 0		
<b>Members present for the final vote</b>	Preslav Borissov, Jorgo Chatzimarkakis, Birgit Collin-Langen, Lara Comi, Anna Maria Corazza Bildt, António Fernando Correia de Campos, Vicente Miguel Garcés Ramón, Evelyne Gebhardt, Thomas Händel, Małgorzata Handzlik, Malcolm Harbour, Sandra Kalniete, Edvard Kožušník, Toine Manders, Hans-Peter Mayer, Phil Prendergast, Zuzana Roithová, Heide Rühle, Christel Schaldemose, Andreas Schwab, Catherine Stihler, Emilie Turunen, Bernadette Vergnaud, Barbara Weiler		
<b>Substitute(s) present for the final vote</b>	Raffaele Baldassarre, Regina Bastos, Jürgen Creutzmann, Cornelis de Jong, Ildikó Gáll-Pelcz, María Irigoyen Pérez, Constance Le Grip, Emma McClarkin, Claudio Morganti, Pier Antonio Panzeri, Marek Siwiec, Kerstin Westphal		
<b>Substitute(s) under Rule 187(2) present for the final vote</b>	Agustín Díaz de Mera García Consuegra		

## PROCEDURE

<b>Title</b>	Community trade mark			
<b>References</b>	COM(2013)0161 – C7-0087/2013 – 2013/0088(COD)			
<b>Date submitted to Parliament</b>	27.3.2013			
<b>Committee responsible</b> Date announced in plenary	JURI 16.4.2013			
<b>Committee(s) asked for opinion(s)</b> Date announced in plenary	INTA 16.4.2013	ITRE 16.4.2013	IMCO 16.4.2013	
<b>Not delivering opinions</b> Date of decision	ITRE 25.4.2013			
<b>Rapporteur(s)</b> Date appointed	Cecilia Wikström 24.4.2013			
<b>Discussed in committee</b>	29.5.2013	19.6.2013	17.9.2013	14.10.2013
	5.11.2013			
<b>Date adopted</b>	17.12.2013			
<b>Result of final vote</b>	+: –: 0:	23 0 0		
<b>Members present for the final vote</b>	Raffaele Baldassarre, Sebastian Valentin Bodu, Françoise Castex, Christian Engström, Marielle Gallo, Giuseppe Gargani, Lidia Joanna Geringer de Oedenberg, Klaus-Heiner Lehne, Antonio López-Istúriz White, Antonio Masip Hidalgo, Alajos Mészáros, Bernhard Rapkay, Evelyn Regner, Francesco Enrico Speroni, Dimitar Stoyanov, Rebecca Taylor, Alexandra Thein, Rainer Wieland, Cecilia Wikström, Tadeusz Zwiefka			
<b>Substitute(s) present for the final vote</b>	Sergio Gaetano Cofferati, Eva Lichtenberger, József Szájer			
<b>Substitute(s) under Rule 187(2) present for the final vote</b>	Silvia Costa, Jürgen Klute, Kay Swinburne			
<b>Date tabled</b>	12.2.2014			