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Committee on the Internal Market and Consumer Protection

2013/0088(COD)

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

PA_Legam

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 be 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 Council and the Commission, the name 'Office for Harmonisation in the Internal Market (trade marks and designs)' should be replaced by 'European Union Trade Marks and Designs Agency' (hereinafter 'the Agency').

Amendment

(2) As a consequence of the entry into force of the Lisbon Treaty, the terminology of Regulation (EC) No 207/2009 should be updated. This 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 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

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, ***as long as the representation*** enables the competent authorities and the public to determine with precision and clarity the precise subject matter of protection.

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

Amendment

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

(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.

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***

(18) With the aim of strengthening trade mark protection and ***combating***

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.

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

(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.

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, 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 essential aspects from that trade mark***';

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:

(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

Amendment

5. The proprietor of a registered trade

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.';

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 owner 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

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

Amendment

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

Amendment

The declaration shall be filed at the Agency *at the time of registering alterations or of renewal*, and shall indicate, in a clear,

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).

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

Amendment

They shall not be parties to the proceedings before the Agency.

deleted

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

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

Amendment

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^{9a}**.

^{9a} **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

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

Intellectual Property.

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 submitted by the Executive Director pursuant to Article 128(4)(o)

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

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, **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

Amendment

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

The Executive Director 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

Amendment

deleted

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 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

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 *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.*

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

Title	Community trade mark		
References	COM(2013)0161 – C7-0087/2013 – 2013/0088(COD)		
Committee responsible Date announced in plenary	JURI 16.4.2013		
Opinion by Date announced in plenary	IMCO 16.4.2013		
Rapporteur Date appointed	Regina Bastos 29.5.2013		
Discussed in committee	9.7.2013	25.9.2013	14.10.2013
Date adopted	5.11.2013		
Result of final vote	+: -: 0:	36 1 0	
Members present for the final vote	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		
Substitute(s) present for the final vote	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		
Substitute(s) under Rule 187(2) present for the final vote	Agustín Díaz de Mera García Consuegra		