



EUROPEAN PARLIAMENT

2009 - 2014

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*Committee on International Trade*

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**2013/0089(COD)**

7.10.2013

## **OPINION**

of the Committee on International Trade

for the Committee on Legal Affairs

on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Recast) (COM(2013)0162 – C7-0088/2013 – 2013/0089(COD))

Rapporteur: George Sabin Cutaş

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## SHORT JUSTIFICATION

The main objective of the proposal for the amendment of 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 and the related Regulation which form part of the same package 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 also 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 directive Recital 15

#### *Text proposed by the Commission*

(15) In order to ensure that the levels of protection afforded to geographical indications by other instruments of Union law are applied in a uniform and exhaustive manner in the examination of absolute and relative grounds for refusal throughout the Union, this Directive should include the same provisions in relation to geographical indications as contained in Regulation (EC) No 207/2009.

#### *Amendment*

(15) In order to ensure that the levels of protection afforded to geographical indications by other instruments of Union law are applied in a uniform and exhaustive manner in the examination of absolute and relative grounds for refusal throughout the Union, this Directive should include the same provisions in relation to geographical indications as contained in Regulation (EC) No 207/2009. ***Since Union legislation exists only concerning the protection of geographical indications of agricultural products and foodstuffs, 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 directive Recital 22

#### *Text proposed by the Commission*

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

#### *Amendment*

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is identical to the 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 directive Recital 23

*Text proposed by the Commission*

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

*Amendment*

(23) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor should be entitled to prohibit the importing of such goods into the Union, where it is only the consignor of the goods who acts for commercial purposes. ***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 directive Recital 24

*Text proposed by the Commission*

(24) In order to enable proprietors of registered trade marks to fight counterfeiting more effectively, they

*Amendment*

(24) In order to enable proprietors of registered trade marks to fight counterfeiting more effectively, they

should be entitled to prohibit the affixing of an infringing trade mark to goods and *certain* preparatory acts prior to the affixing.

should be entitled to prohibit the affixing of an infringing trade mark to goods and *all* preparatory acts prior to the affixing.

## Amendment 5

### Proposal for a directive Article 10 – paragraph 4

#### *Text proposed by the Commission*

4. The proprietor of a registered 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 registered 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 6

### Proposal for a directive Article 10 – paragraph 5

#### *Text proposed by the Commission*

5. The proprietor of a registered trade mark shall also be entitled to prevent all third

#### *Amendment*

5. The proprietor of a registered trade mark shall also be entitled to prevent all third

parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State where the trade mark is registered without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State where the trade mark is registered without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. ***This shall be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit.***

## **Amendment 7**

### **Proposal for a directive Article 11 – paragraph 1 – point a**

*Text proposed by the Commission*

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

*Amendment*

(a) affixing in the course of trade a sign identical with or similar to, ***as specified in Article 5 paragraph 1 of this Directive***, the 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 5(1).*

## **Amendment 8**

### **Proposal for a directive Article 37 a (new)**

*Text proposed by the Commission*

*Amendment*

***Article 37 a***

***Indemnification of the Importer and the***

### ***Owner of the Goods***

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

### ***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>	Laws of the Member States relating to trade marks (Recast)
<b>References</b>	COM(2013)0162 – C7-0088/2013 – 2013/0089(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>	+:                    21 –:                    2 0:                    0
<b>Members present for the final vote</b>	Laima Liucija Andrikiienė, 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, Henri Weber, 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