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Committee on Legal Affairs

2013/0088(COD)

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AMENDMENTS

71 - 189

Draft report
Cecilia Wikström
(PE516.715v01-00)

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

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

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United in diversity

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Amendment 71
Marielle Gallo

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 (trademarks 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 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 (trademarks and designs)’ should be replaced by ‘European Union **Intellectual Property** Agency’ (hereinafter ‘the Agency’).

Or. en

Amendment 72
Sajjad Karim

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 trademarks, the requirement of graphic representability should be deleted from the definition of a European trade mark. A sign should be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the **representation** enables the competent authorities and the public to determine **with**

Amendment

(9) In order to allow for more flexibility while ensuring greater legal certainty with regard to the means of representation of trademarks, 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 **sign is capable of being represented in a manner which is clear, precise, self-**

precision and clarity the precise subject matter of protection.

contained, easily accessible, durable and objective. A sign is therefore permitted in any appropriate form, taking account of generally available technology and enables the competent authorities and the public to determine *the* subject matter of protection.

Or. en

Amendment 73
Marielle Gallo

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 trademarks, 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 trademarks, 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 any appropriate form, and thus not necessarily by graphic means, as long as the representation **uses freely available technology and** enables the competent authorities and the public to determine with precision and clarity the precise subject matter of protection.

Or. en

Amendment 74
Pier Antonio Panzeri

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.

Or. en

Amendment 75
Marielle Gallo

Proposal for a regulation
Recital 15

Text proposed by the Commission

Amendment

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

deleted

Or. en

Amendment 76
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a regulation
Recital 15

Text proposed by the Commission

Amendment

(15) In order to ensure legal certainty and

(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.

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.

When determining whether 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.

Or. en

Amendment 77

Pier Antonio Panzeri, Bernhard Rapkay

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.

Or. en

Amendment 78
Pier Antonio Panzeri, Bernhard Rapkay

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;

Or. en

Amendment 79
Pier Antonio Panzeri

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.

Or. en

Amendment 80
Giuseppe Gargani, Raffaele Baldassarre

Proposal for a regulation
Recital 16 a (new)

Text proposed by the Commission

Amendment

(16a) Trademarks must confer on their proprietors exclusive rights which must be protected in the course of trade. In this connection ‘the course of trade’ should be understood as covering all trade-related operations, including import, export, production, transit and trans-shipment, taking place on EU territory, even where the products concerned are not intended for release onto the EU market.

Or. it

Amendment 81

Christian Engström

on behalf of the Greens/EFA Group

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 combatting counterfeiting more effectively, the proprietor of a ***registered*** 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 ***a*** third ***country*** and bear without authorization a trade mark which is essentially identical to the European trade mark ***validly*** registered in respect of such goods ***and which cannot be distinguished in its essential aspects from that trade mark.***

In order not to hamper the production, circulation and distribution of legitimate goods, this rule should only apply if the proprietor of the trade mark is able to

demonstrate clear and documented evidence of a substantial risk of fraudulent diversion of the allegedly counterfeit goods into a Member State.

The European Commission shall develop and implement guidelines for national customs authorities with clear indicators on how to establish such substantial risk of fraudulent diversion. The list of clear indicators shall reflect the importance of unrestricted trade in, inter alia, generic medicines, and shall be in line with prevailing CJEU case law.

Or. en

Amendment 82
Bernhard Rapkay

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 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.
This shall be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit.

Or. de

Amendment 83
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a regulation
Recital 18 a (new)

Text proposed by the Commission

Amendment

(18a) Recognising that the main public health concern lies with the quality of the medicines and not with trade mark or other intellectual property enforcement and should be addressed by other measures, including regulation aimed at improving quality standards.

Or. en

Amendment 84
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a regulation
Recital 19

Text proposed by the Commission

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.

deleted

Or. en

Justification

Through clever wording and the doctrine of regional exhaustion, this text, together with its article, tries to restrict parallel imports. It may make it impossible for private individuals to buy completely legitimate goods, if they do this over the internet and from third countries. This affects not only counterfeits but completely legitimate originals as well: EU citizens

would be forbidden to buy certain things over the internet, simply because they do this from, for example, a web shop in the US. Putting up such artificial barriers to trade through trademarks makes no economic sense.

Amendment 85
Evelyn Regner

Proposal for a regulation
Recital 19

Text proposed by the Commission

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.

deleted

Or. de

Amendment 86
Antonio Masip Hidalgo

Proposal for a regulation
Recital 20

Text proposed by the Commission

Amendment

(20) In order to enable proprietors of European trade marks to fight counterfeiting more effectively, they should be entitled to prohibit the affixing of an infringing mark to goods and preparatory acts prior to the affixing.

(20) In order to enable proprietors of European trade marks to fight counterfeiting more effectively, they should be entitled to prohibit the affixing of an infringing mark to **all** goods and preparatory acts prior to the affixing.

Or. fr

Justification

To make it possible for proprietors of trade marks to prohibit the affixing of an infringing

trade mark both to products and to all preparatory acts, in order to provide greater legal certainty.

Amendment 87

Pier Antonio Panzeri, Bernhard Rapkay

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.

Or. en

Amendment 88

Giuseppe Gargani, Raffaele Baldassarre

Proposal for a regulation

Recital 22

Text proposed by the Commission

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 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.

(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. ***When carrying out checks, customs authorities must make use of the powers and procedures laid***

down in EU legislation regarding customs enforcement of intellectual property rights.

Or. it

Justification

European trade mark proprietors must be able to exercise their right to take action in cases where an infringement is thought to have occurred. It is therefore essential for the relevant agencies (customs authorities or police) in each Member State to be able to draw attention to the need for checks to be carried out whenever there is a suspicion that a trade mark may have been infringed, in order to prevent counterfeit goods from entering the EU customs territory.

**Amendment 89
Cecilia Wikström**

**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.

Or. en

Justification

See also amendment to Article 35a.

Amendment 90
Cecilia Wikström

Proposal for a regulation
Recital 32

Text proposed by the Commission

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

Amendment

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

Or. en

Justification

See also amendment to Article 49a.

Amendment 91
Cecilia Wikström

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

Amendment

(36) In order to allow for an effective and efficient use of European collective and certification marks, the power to adopt

delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the *periods for submitting* the regulations governing the use of those marks *and the content thereof*.

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.

Or. en

Justification

See also amendment to Articles 74a and 74k.

Amendment 92 **Cecilia Wikström**

Proposal for a regulation **Recital 38**

Text proposed by the Commission

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

Amendment

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

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.

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.

Or. en

Justification

See also amendment to Article 93a(l).

Amendment 93 Bernhard Rapkay

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, clearly defining the areas of cooperation and enabling the Agency to coordinate relevant common projects of Union interest ***or of interest to the majority of the industrial property offices of the Member States and the Benelux Office for Intellectual Property***, 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.

Or. de

Amendment 94
Marielle Gallo

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, clearly 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 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. Member States may opt out from the implementation of common projects by providing objective reasons justifying their decision.*

Or. en

Amendment 95
Antonio López-Istúriz White

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 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 ***implementing rules with regard to the language regime established for*** 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.

Or. es

Justification

The Commission's powers extend only to specifying the criteria or implementing rules with regard to the language regime, and not to the details on the languages to be used. The language regime itself has already been established by the Basic Regulation.

Amendment 96
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 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.)

Or. en

Amendment 97
Bernhard Rapkay

Proposal for a regulation
Article 1 – paragraph 1 – point 9
Regulation (EC) No 207/2009
Article 4 – introductory part

Text proposed by the Commission

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

Amendment

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 **generally available technology is used and** such signs are capable of

Or. de

Amendment 98
Evelyn Regner

Proposal for a regulation
Article 1 – paragraph 1 – point 9
Regulation (EC) No 207/2009
Article 4 – introductory part

Text proposed by the Commission

A European trade mark may consist of any signs, in particular words, including

Amendment

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

personal names, designs, letters, **patterns, logos**, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that such signs are capable of

Or. de

Amendment 99
Antonio Masip Hidalgo

Proposal for a regulation
Article 1 – paragraph 1 – point 9
Regulation (EC) No 207/2009
Article 4 – introductory part

Text proposed by the Commission

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

Amendment

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

Or. fr

Justification

Models, motifs, devices and logos are common components of signs used as trade marks.

Amendment 100
Giuseppe Gargani, Raffaele Baldassarre

Proposal for a regulation
Article 1 – paragraph 1 – point 9
Regulation (EC) No 207/2009
Article 4 – introductory part

Text proposed by the Commission

A European trade mark may consist of any signs, in particular words, including

Amendment

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

personal names, designs, **models, motifs, devices, logos**, letters, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that such signs are capable of

Or. it

Amendment 101
Tadeusz Zwiefka

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;

Or. en

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 102
Sajjad Karim

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 language of a Member State.

Amendment

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

Or. en

Amendment 103
Cecilia Wikström

Proposal for a regulation
Article 1 – point 10 – point b
Regulation (EC) No 207/2009
Article 7 – paragraph 2 – point b

Text proposed by the Commission

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

Amendment

(b) only where a trade mark in a foreign language or script is translated or transcribed in any script or official language of a Member State; ***the applicant shall provide a translation or transcription in the language of the application upon request by the Agency.***';

Or. en

Justification

The Commission suggests establishing an obligation to provide a translation or transcription by delegated acts (Article 24a (a) in the Commission's proposal). However, the establishment of such an obligation constitutes an essential element and can therefore not be left to delegated acts, but should rather be set out in the basic act.

Amendment 104
Sajjad Karim

Proposal for a regulation
Article 1 – paragraph 1 – point 11 – point a
Regulation (EC) No 207/2009
Article 8 – paragraph 3 – point b

Text proposed by the Commission

(b) where the trade mark is liable to be confused with an earlier trade mark ***protected outside the Union***, provided that, at the date of the application, the earlier trade mark was still in genuine use and the applicant was acting in bad faith.

Amendment

(b) where the trade mark is liable to be confused with an earlier trade mark, provided that, at the date of the application, the earlier trade mark was still in genuine use and the applicant was acting in bad faith.

Or. en

Amendment 105
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 1

Text proposed by the Commission

1. The registration of a European trade mark shall confer on the proprietor exclusive rights.

Amendment

1. The registration of a European trade mark shall confer on the proprietor exclusive rights ***in particular, the positive right to use it and to prevent any third party not having his consent from using it.***

Or. en

Amendment 106
Marielle Gallo

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

Regulation (EC) No 207/2009
Article 9 – paragraph 2 – point a

Text proposed by the Commission

(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;***

Amendment

(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;

Or. en

Amendment 107
Pier Antonio Panzeri, Bernhard Rapkay

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 2 – point a

Text proposed by the Commission

(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;

Amendment

(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 ***by enabling him or her to distinguish without any possibility of confusion between that product and products which have another origin;***

Or. en

Amendment 108
Marielle Gallo

Proposal for a regulation

Article 1 – paragraph 1 – point 12

Regulation (EC) No 207/2009

Article 9 – paragraph 2 – point b

Text proposed by the Commission

(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;

Amendment

(b) ***without prejudice to point a*** 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;

Or. en

Amendment 109

Antonio Masip Hidalgo

Proposal for a regulation

Article 1 – paragraph 1 – point 12

Regulation (EC) No 207/2009

Article 9 – paragraph 2 – point c

Text proposed by the Commission

(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.

Amendment

(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 ***a substantial part of the territory of*** 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.

Or. fr

Justification

The wording 'a substantial part of the territory of the Union' ties in with the Court of Justice's judgment of 6 October 2009 in Case C-301/07, PAGO v TIROLMILCH, which states that 'Article 9(1)(c) of [Council Regulation (EC) No 40/94 of 20 December 1993] must be interpreted as meaning that (...) a Community trade mark must be known by a significant part of the public concerned'.

Amendment 110
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 3 – point c

Text proposed by the Commission

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

Amendment

(c) ***manufacturing or placing under a suspensive procedure***, importing, ***exporting, re exporting or transshipping*** the goods under that sign;

Or. en

Amendment 111
Giuseppe Gargani, Raffaele Baldassarre

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 3 – point c

Text proposed by the Commission

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

Amendment

(c) ***producing or entering for a suspensive procedure***, importing or exporting, ***re-exporting or trans-shipping*** the goods under that sign;

Or. it

Amendment 112
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 3– point d

Text proposed by the Commission

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

Amendment

(d) using the sign as a trade or company name or part of a trade or company name, *or domain names*;

Or. en

Amendment 113
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 4

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

deleted

Or. en

Amendment 114
Evelyn Regner

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 4

Text proposed by the Commission

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.

deleted

Or. de

Amendment 115
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 4

Text proposed by the Commission

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*.

4. The proprietor of a *registered* trade mark shall also be entitled to prevent the importing *into the Union* of goods *that may be prohibited pursuant to* paragraph 3(c) where only the consignor of the goods acts *in the context of* commercial *activity*.

Or. en

Amendment 116
Giuseppe Gargani, Raffaele Baldassarre

Proposal for a regulation
Article 1 – paragraph 1 – point 12
Regulation (EC) No 207/2009
Article 9 – paragraph 4

Text proposed by the Commission

Amendment

4. The proprietor of a European trade mark shall also be entitled to prevent the importing of goods referred to in paragraph

4. The proprietor of a European trade mark shall also be entitled to prevent the importing *into the European Union* of

3(c) where only the consignor of the goods acts *for* commercial *purposes*.

goods referred to in paragraph 3(c) where only the consignor of the goods acts *in the context of* commercial *activity*.

Or. it

Justification

The Commission's proposed wording 'in the context of commercial activity' could be interpreted as being equivalent to 'in the course of trade', and hence in a restrictive manner. The amendment clarifies the aim established in recital 18 and avoids any ambiguity regarding the contradiction between the lack of a requirement for goods to be released for free circulation and the concept of 'in the course of trade'.

Amendment 117

Christian Engström

on behalf of the Greens/EFA Group

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* 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 *a* third *country* and bear without authorization a trade mark which is *essentially* identical to the European trade mark *validly* registered in respect of such goods *and* which cannot be distinguished in its essential aspects from that trade mark.

In order not to hamper the production, circulation and distribution of legitimate goods, this rule shall only apply if the proprietor of the trade mark is able to demonstrate clear and documented evidence of a substantial risk of

fraudulent diversion of the allegedly counterfeit goods into a Member State.

The European Commission shall develop and implement guidelines for national customs authorities with clear indicators on how to establish such substantial risk of fraudulent diversion. The list of clear indicators shall reflect the importance of unrestricted trade in, inter alia, generic medicines, and shall be in line with prevailing CJEU case law.

Or. en

Amendment 118

Marielle Gallo, Tadeusz Zwiefka

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 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.

Customs authorities shall also carry out the relevant controls according to the rules laid down in Regulation (EC) 608/2013 at the request of rightholders and based on risk analysis criteria, on goods, including packaging, suspected of infringing a trade mark that are crossing the territory of the European Union under

a suspensive procedure and are destined and released to the market of a third country.

Or. en

Amendment 119
Bernhard Rapkay

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 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. ***This shall be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit.***

Or. de

Amendment 120
Giuseppe Gargani, Raffaele Baldassarre

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 European trade mark shall also be entitled to prevent all third parties from bringing goods into the customs territory of the Union without ***their*** being ***intended for release*** for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical ***or similar*** to the European trade mark registered in respect of such goods ***in accordance with paragraph 2, points (a), (b) and (c) of this article***, or which cannot be distinguished in its essential aspects from that trade mark. ***The customs authorities shall, inter alia on a complaint from the right holder, carry out appropriate checks based on risk analysis criteria on goods in transit through the territory of the Union on their way to a third country which are suspected of infringing an intellectual property right for which protection has been sought.***

Or. it

Justification

See justification for amendment to Recital 22.

Amendment 121

Cecilia Wikström, Rebecca Taylor

Proposal for a regulation

Article 1 – paragraph 1 – point 12

Regulation (EC) No 207/2009

Article 9 – paragraph 5 a (new)

Text proposed by the Commission

Amendment

5a. Member states shall take appropriate measures with regards to ensuring the smooth transit of generic medicines.

Therefore a proprietor of a trade mark shall not have the right to prevent any third parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State based upon similarities, perceived or actual, between the international non-proprietary name (INN) for the active ingredient in the medicines and a registered trademark.

Or. en

Justification

There have been cases where International non-proprietary names (INN) printed on the packaging of generic medicines have created a confusion on whether this could constitute a risk for confusion with trademarks similar to the INN. One such case being a generic medicine containing Amoxicillin and the trademark Axmoxil. INNs by law have to be present on the packaging of pharmaceutical products to provide health professionals with a unique and universally available designated name to identify each pharmaceutical substance. It should thus be clarified that these generic names are not grounds for trademark infringements and thus should also not be grounds to intervene against generic medicines in transit.

Amendment 122

Christian Engström

on behalf of the Greens/EFA Group

Proposal for a regulation

Article 1 – paragraph 1 – point 14

Regulation (EC) No 207/2009

Article 12 a (new)

Text proposed by the Commission

Amendment

Article 12 a

Limitation of the rights conferred by a trade mark

Nothing in this regulation shall limit the right of all persons, including legal persons, to publicly express themselves, through any means or media they choose, provided that they do not violate the rights

afforded by Article 9.

This includes, but is not limited to, expressions for the purposes of political or social commentary, teaching, scientific research, journalism, artistic expression, personal communication, criticism or review, comparisons of products or services, caricature, parody or pastiche.

Or. en

Amendment 123
Marielle Gallo

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.

Or. en

Amendment 124
Pier Antonio Panzeri, Bernhard Rapkay

Proposal for a regulation
Article 1 – paragraph 1 – point 14
Regulation (EC) No 207/2009
Article 12 – paragraph 2 a (new)

Text proposed by the Commission

Amendment

2a. 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

Or. en

Amendment 125
Cecilia Wikström

Proposal for a regulation
Article 1 – paragraph 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 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, or that have been sold to individual consumers in accordance with Article 9(4) '.

Or. en

Justification

This amendment partly re-tables the technical changes made already in the draft report by the rapporteur but also adds a more substantive change by introducing a link to article 9(4)

Amendment 126
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a regulation
Article 1 – paragraph 1 – point 23 a (new)
Regulation (EC) No 207/2009
Article 23 a (new)

Text proposed by the Commission

Amendment

(23a) The following Article 23a is inserted:

'Article 23a

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 9.'

Or. en

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.

Amendment 127
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 27
Regulation (EC) No 207/2009
Article 27

Text proposed by the Commission

Amendment

The date of filing of a European trade mark

The date of filing of a European ***Union***

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.*

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 *within a period of one month of filing the abovementioned documents.*

Or. en

Amendment 128
Marielle Gallo

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.

Or. en

Amendment 129
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 28
Regulation (EC) No 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 within **9** 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).

Or. en

Amendment 130
Sajjad Karim

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 on 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 goods and services recorded 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 to invalidate a later filed 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 goods and services recorded in the register at that time.

Or. en

Amendment 131
Antonio Masip Hidalgo

Proposal for a regulation
Article 1 – paragraph 1 – point 28
Regulation (EC) No 207/2009
Article 28 a (new)

Text proposed by the Commission

Amendment

Article 28 a

Fees

The registration and renewal of a European trade mark shall be subject to an additional fee for each class of goods and services below the first class.

Or. fr

Justification

The article on fees that appears in the directive should be included in the regulation, both for

purposes of standardisation and because it makes protection more affordable, which will help small and medium-sized businesses.

Amendment 132
Cecilia Wikström

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 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.***

Or. en

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 133
Cecilia Wikström

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

Amendment

(b) the details regarding the ***formal*** content

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);

of the application for a European trade mark referred to in Article 26(1) and the formal conditions of the application referred to in Article 26(3);

Or. en

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 134 **Sajjad Karim**

Proposal for a regulation
Article 1 – paragraph 1 – point 36
Regulation (EC) No 207/2009
Article 38 – paragraph 1a

Text proposed by the Commission

(36) In *Title IV, Section 2 is deleted*;

Amendment

(36) In *Article 38, the following paragraph 1a is inserted*:

1a. Upon notification to the Agency at the time of registration, applicants may choose to not receive the Union search report referred to in paragraph 1.

Or. en

Amendment 135 **Pier Antonio Panzeri**

Proposal for a regulation
Article 1 – paragraph 1 – point 38
Regulation (EC) No 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

Or. en

Amendment 136

Pier Antonio Panzeri

Proposal for a regulation

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

Regulation (EC) No 207/2009

Article 41 – paragraph 4 a (new)

Text proposed by the Commission

Amendment

4a. 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;

Or. en

Amendment 137

Cecilia Wikström

Proposal for a regulation

Article 1 – point 45

Regulation (EC) No 207/2009

Article 49 a – point a

Text proposed by the Commission

Amendment

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

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

of fees to be paid;

Or. en

Amendment 138
Cecilia Wikström

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.***

Or. en

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 139
Antonio Masip Hidalgo

Proposal for a regulation
Article 1 – paragraph 1 – point 46

Regulation (EC) No 207/2009
Article 52 – paragraph 2 a (new)

Text proposed by the Commission

Amendment

2a. Paragraph 2 shall also apply where the distinctive character was acquired after the date of application for registration and before the date of registration.

Or. fr

Justification

The regulation needs to be brought into line with the directive, so as to include provisions allowing proprietors of European trade marks to prove that the distinctive character was acquired (i) before the date of application for registration and (ii) between the date of application and the date of registration.

Amendment 140
Cecilia Wikström

Proposal for a regulation
Article 1 – point 51
Regulation (EC) No 207/2009
Article 57 a – point a

Text proposed by the Commission

Amendment

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

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

Or. en

Justification

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

Amendment 141
Cecilia Wikström

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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;

Or. en

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 142
Cecilia Wikström

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;

Or. en

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 143
Cecilia Wikström

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.';

Or. en

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 144

Cecilia Wikström

Proposal for a regulation

Article 1 – point 62

Regulation (EC) No 207/2009

Article 74 a

Text proposed by the Commission

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

Amendment

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

Justification

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

Amendment 145
Cecilia Wikström

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 146
Cecilia Wikström

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).¹;

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).¹;

Or. en

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 147
Cecilia Wikström

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.***

Or. en

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 148
Cecilia Wikström

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 authorized by national law to act on his behalf. To the extent that the above events do not affect the authorization of a representative appointed under Article 89 of the Regulation, 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, as a result of some action taken against his property, being prevented for legal reasons 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 paragraph 1 (a) and (b), the Agency has been informed of the identity of the person authorized to continue the proceedings before the Agency, the Agency shall communicate to such person and to any interested third parties that the

proceedings shall be resumed as from a date to be fixed by the Agency.

(3) In the case referred to in paragraph 1 (c), 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 communication of 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) of the Regulation 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 communication is notified; or

(b) where Article 92(2) of the Regulation 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 on which this communication is notified.

(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.

Or. en

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 149
Cecilia Wikström

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 [...].'

Or. en

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 150
Cecilia Wikström

Proposal for a regulation
Article 1 – point 75

Text proposed by the Commission

Amendment

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

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

Or. en

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 151
Cecilia Wikström

Proposal for a regulation

Article 1 – point 77

Regulation (EC) No 207/2009

Article 89 – paragraph 1 – point a

Text proposed by the Commission

Amendment

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

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

Or. en

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 152
Cecilia Wikström

Proposal for a regulation
Article 1 – point 78
Regulation (EC) No 207/2009
Article 92 – paragraph 2 – subparagraph 2

Text proposed by the Commission

Amendment

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

Or. en

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 153
Cecilia Wikström

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*

Or. en

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 154
Cecilia Wikström

Proposal for a regulation
Article 1 – point 78
Regulation (EC) No 207/2009
Article 92 – 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**

Or. en

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 155
Cecilia Wikström

Proposal for a regulation
Article 1 – point 80
Regulation (EC) No 207/2009
Article 93 a – point j

Text proposed by the Commission

Amendment

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

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

Or. en

Justification

Correction of the reference. The apportionment and fixing of costs is further regulated in other paragraphs of Article 85.

Amendment 156
Cecilia Wikström

Proposal for a regulation
Article 1 – point 80
Regulation (EC) No 207/2009
Article 93a – point k

Text proposed by the Commission

Amendment

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

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

Or. en

Justification

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

Amendment 157
Cecilia Wikström

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

Or. en

Amendment 158
Cecilia Wikström

Proposal for a regulation

Article 1 – point 80

Regulation (EC) No 207/2009

Article 93 a – point p

Text proposed by the Commission

(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)***.';

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, 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.';

Or. en

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 159
Tadeusz Zwiefka

Proposal for a regulation

Article 1 – paragraph 1 – point 98

Regulation (EC) No 207/2009

Article 123 b – paragraph 1 – introductory part

Text proposed by the Commission

The Agency shall have the following tasks:

Amendment

The Agency shall have the following **primary** tasks:

Or. en

Amendment 160
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123 b – paragraph 1 – introductory part

Text proposed by the Commission

Amendment

The Agency shall have the following other tasks:

Or. en

Amendment 161
Bernhard Rapkay

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123b – paragraph 1 – point d a (new)

Text proposed by the Commission

Amendment

(da) the tasks conferred on it by Directive 2012/28/EU of the European Parliament and of the Council on certain permitted uses of orphan works.

Or. de

Amendment 162
Bernhard Rapkay

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123b – 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 voluntary mediation **and arbitration** services for the purpose of assisting parties in reaching an amicable settlement.

Or. de

Amendment 163
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 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 **in particular** cover the following areas of activity:

Or. en

Amendment 164
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123 c – 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

Amendment

2. The Agency shall define, elaborate and coordinate **the** projects of **interest to the Union and Member States** with regard to the areas referred to in paragraph 1. The

contain the specific obligations and responsibilities of each participating industrial property office of the Member States and the Benelux Office for Intellectual Property.

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.

Or. en

Amendment 165
Bernhard Rapkay

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123 c – 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 Union interest ***or of interest to the majority of the industrial property offices of the Member States and the Benelux Office for Intellectual Property*** 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.

Or. de

Amendment 166
Sajjad Karim

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123 c – paragraph 2

Text proposed by the Commission

2. The ***Agency*** shall define, ***elaborate and***

Amendment

2. The ***Management Board*** shall define

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.

and elaborate common projects of Union interest 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 coordinate the common projects and consult with representatives from users.***

Or. en

Amendment 167
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123c – paragraph 3

Text proposed by the Commission

The Agency and the industrial property offices of the Member States and the Benelux Office for Intellectual Property shall cooperate with each other to promote convergence of practices and tools in the field of trademarks and designs.

Amendment

The Agency and the industrial property offices of the Member States and the Benelux Office for Intellectual Property shall cooperate with each other to promote convergence of practices and tools in the field of trademarks and designs. ***Member States may opt out from the implementation of the common projects by a substantiated decision.***

Or. en

Amendment 168
Bernhard Rapkay

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123 c – paragraph 3

Text proposed by the Commission

3. The industrial property offices of the Member States and the Benelux Office for Intellectual Property shall participate effectively in the common projects referred to in paragraph 2 with a view to ensuring their development, functioning, interoperability, and keeping up to date.

Amendment

3. The industrial property offices of the Member States and the Benelux Office for Intellectual Property shall participate effectively in the common projects referred to in paragraph 2 with a view to ensuring their development, functioning, interoperability, and keeping up to date.
Participation in these projects shall be obligatory. Nevertheless, if the outcome of these projects leads to the development of instruments that are equivalent to instruments which already exist in the Member States, participation shall not give rise to an obligation to implement the outcome in the Member States concerned.

Or. de

Amendment 169
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 1 – point 98
Regulation (EC) No 207/2009
Article 123 c – paragraph 4

Text proposed by the Commission

4. The Agency shall provide financial support to the common projects of Union ***interest*** referred to in paragraph 2 to the extent this is necessary to ensure the effective participation of the industrial property offices of the Member States and the Benelux Office for Intellectual Property in the projects within the meaning of paragraph 3. That financial support may take the form of grants. The total amount of funding shall ***not exceed 10%*** of the yearly income of the Agency. The beneficiaries of grants shall be the industrial property offices of the Member States and the Benelux Office for

Amendment

4. The Agency shall provide financial support to the common projects of ***interest to the Union and Member States*** referred to in paragraph 2 to the extent 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 ***be at least 5%*** of the yearly income of the Agency ***and cover the minimal amount for every Member State for purposes closely related to the***

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 (****).

protection, promotion or enforcement.
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 (****).

Or. en

Justification

This provision is in accordance with the Max Planck Institute's Study on the Overall Functioning of the European Trade Mark System from 2011.

Amendment 170 **Marielle Gallo**

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

Or. en

Amendment 171
Marielle Gallo

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.

Or. en

Amendment 172
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 1 – point 99
Regulation (EC) No 207/2009
Article 125 – paragraph 1

Text proposed by the Commission

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

Amendment

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

Or. en

Amendment 173
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 1 – point 99
Regulation (EC) No 207/2009
Section 2 a

Text proposed by the Commission

SECTION 2a

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 Anti-fraud Office (OLAF);

Amendment

deleted

(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.

Or. en

Amendment 174
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 99
Regulation (EC) No 207/2009
Article 128 – paragraph 4 – point 1 a (new)

Text proposed by the Commission

Amendment

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

Or. en

Amendment 175
Marielle Gallo

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*

Or. en

Amendment 176
Cecilia Wikström

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 trade marks after consulting the Management Board and, in the case of fees and budgetary provisions of this regulation, the Budget Committee;

Or. en

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 177
Bernhard Rapkay

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 should 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 disputes covered by this Regulation and by Directive ... by mutual agreement.

3. The Agency may also start an arbitration procedure on its own initiative to give 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 support parties in resolving disputes. They must be independent and possess relevant skills and experience. The register shall require the approval of the Management Board.

8. Any agreement reached as a result of a mediation and arbitration procedure shall be binding on the agency's decision-making instances.

Or. de

Amendment 178
Christian Engström
on behalf of the Greens/EFA Group

Proposal for a regulation
Article 1 – paragraph 1 – point 108 a (new)
Regulation (EC) No 207/2009
Article 139 – paragraph 2

Text proposed by the Commission

Amendment

(108a) In Article 139, paragraph 2 is replaced by the following:

'The revenue and expenditure shown in the budget shall not show a deficit. Any surplus shall be integrated into the general budget of the European Union.'

Or. en

Amendment 179
Marielle Gallo

Proposal for a regulation
Article 1 – paragraph 1 – point 110
Regulation (EC) No 207/2009
Article 144 – paragraph 2

Text proposed by the Commission

Amendment

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.***

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.

Or. en

Amendment 180
Tadeusz Zwiefka

Proposal for a regulation
Article 1 – paragraph 1 – point 111
Regulation (EC) No 207/2009
Article 144a – point c

Text proposed by the Commission

Amendment

(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); ***deleted***

Or. en

Amendment 181
Tadeusz Zwiefka

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***

Or. en

Amendment 182
Cecilia Wikström

Proposal for a regulation
Article 1 – point 113
Regulation (EC) No 207/2009
Article 147 – paragraph 5

Text proposed by the Commission

Amendment

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

Or. en

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 183
Cecilia Wikström

Proposal for a regulation
Article 1 – point 115
Regulation (EC) No 207/2009
Article 149 – second sentence

Text proposed by the Commission

Amendment

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

Or. en

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 184
Cecilia Wikström

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).¹***

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.***

Or. en

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 185
Cecilia Wikström

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.!

Or. en

Justification

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

Amendment 186
Cecilia Wikström

Proposal for a regulation
Article 1 – point 122
Regulation (EC) No 207/2009
Article 161 a – point a

Text proposed by the Commission

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

Amendment

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

Or. en

Justification

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

Amendment 187
Cecilia Wikström

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;

Or. en

Justification

This amendment corrects the problem of circular cross-references in the Commission's proposal. See also amendment to Article 149, second sentence.

Amendment 188
Cecilia Wikström

Proposal for a regulation
Article 1 – point 122
Regulation (EC) No 207/2009
Article 161 a – point k

Text proposed by the Commission

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

Amendment

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

Or. en

Justification

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

Amendment 189
Bernhard Rapkay

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 4 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.';

Or. de