



EUROPEAN PARLIAMENT

2009 - 2014

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*Plenary sitting*

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**A7-0032/2014**

16.1.2014

# **\*\*\*I REPORT**

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

Committee on Legal Affairs

Rapporteur: Cecilia Wikström

(Recast – Rule 87 of the Rules of Procedure)

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

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

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

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

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

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

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## **DRAFT EUROPEAN PARLIAMENT LEGISLATIVE RESOLUTION**

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

**(Ordinary legislative procedure – recast)**

*The European Parliament,*

- having regard to the Commission proposal to Parliament and the Council (COM(2013)0162),
  - having regard to Article 294(2) and Article 114 of the Treaty on the Functioning of the European Union, pursuant to which the Commission submitted the proposal to Parliament (C7-0088/2013),
  - having regard to Article 294(3) of the Treaty on the Functioning of the European Union,
  - having regard to the opinion of the European Economic and Social Committee of 11 July 2013<sup>1</sup>,
  - having regard to the Interinstitutional Agreement of 28 November 2001 on a more structured use of the recasting technique for legal acts<sup>2</sup>,
  - having regard to Rules 87 and 55 of its Rules of Procedure,
  - having regard to the report of the Committee on Legal Affairs and the opinions of the Committee on International Trade and the Committee on the Internal Market and Consumer Protection (A7-0032/2014),
- A. whereas, according to the Consultative Working Party of the legal services of the European Parliament, the Council and the Commission, the proposal in question does not include any substantive amendments other than those identified as such in the proposal and whereas, as regards the codification of the unchanged provisions of the earlier acts together with those amendments, the proposal contains a straightforward codification of the existing texts, without any change in their substance;
1. Adopts its position at first reading hereinafter set out, taking into account the recommendations of the Consultative Working Party of the legal services of the European Parliament, the Council and the Commission;
  2. Calls on the Commission to refer the matter to Parliament again if it intends to amend the proposal substantially or replace it with another text;
  3. Instructs its President to forward its position to the Council, the Commission and the national parliaments.

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<sup>1</sup> OJ C 327, 12.11.2013, p. 42.

<sup>2</sup> OJ C 77, 28.3.2002, p. 1.

## Amendment 1

### Proposal for a directive

#### Citation 1

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

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

##### *Amendment*

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

##### *Justification*

*The full legal basis should be referred to.*

## Amendment 2

### Proposal for a directive

#### Recital 5

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

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union<sup>20</sup>, the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC. In doing so, the revision of the latter should include measures to make it more consistent with Regulation (EC) No 207/2009 **and** would thus reduce the areas of divergence within the trade mark system in Europe as a whole.

##### *Amendment*

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union<sup>20</sup>, the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC. In doing so, the revision of the latter should include measures to make it more consistent with Regulation (EC) No 207/2009, **which** would thus reduce the areas of divergence within the trade mark system in Europe as a whole, **while maintaining national trade mark protection as an attractive option for applicants. In this context, the complementary relationship between the European Union trade mark system and national trade mark systems should be ensured.**

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<sup>20</sup> OJ **C** 140, 29.5.2010, p. 22.

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<sup>20</sup> OJ **C** 140, 29.5.2010, p. 22.

### *Justification*

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

## **Amendment 3**

### **Proposal for a directive**

#### **Recital 10**

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

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

##### *Amendment*

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

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

### *Justification*

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

## **Amendment 4**

### **Proposal for a directive**

#### **Recital 13**

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

(13) To this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfil the

##### *Amendment*

(13) To this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfil the

objectives of the registration system for trade marks, which are to ensure legal certainty and sound administration, it is also essential to require that the sign *is* capable of being represented in a manner which *allows for a precise determination of the subject of protection*. A sign should therefore be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.

objectives of the registration system for trade marks, which are to ensure legal certainty and sound administration, it is also essential to require that the sign *be* capable of being represented *in the register* in a manner which is *clear, precise, self-contained, easily accessible, durable and objective*. A sign should therefore be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the representation *uses generally available technology and* offers satisfactory guarantees to that effect.

#### *Justification*

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

## **Amendment 5**

### **Proposal for a directive**

#### **Recital 19**

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

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

##### *Amendment*

*deleted*

#### *Justification*

*Deletion due to deletion in Article 10.*



## Amendment 6

### Proposal for a directive Recital 22

#### *Text proposed by the Commission*

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

#### *Amendment*

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing **counterfeit** goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without **authorisation** a trade mark which is essentially identical to the trade mark registered in respect of such goods. ***This provision should not harm the interests of legitimate trade in goods that can lawfully be placed on the market in their destination countries. In order not to hamper legitimate flows of goods this provision should therefore not apply if the third party provides evidence that the final destination of the goods is a country outside the Union and if the proprietor of the trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. Where the country of final destination has not yet been determined, the proprietor of the European Union trade mark should have the right to prevent all third parties from bringing the goods out of the Union again unless the third party provides evidence that the final destination of the goods is a country outside the Union and the proprietor of the trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. This rule should also be without prejudice to the Union's right to promote access to medicines for third countries as well as compliance with WTO rules, notably with GATT Article V on freedom of transit.***

## **Amendment 7**

### **Proposal for a directive Recital 22 a (new)**

*Text proposed by the Commission*

*Amendment*

***(22a) The proprietor of a trade mark should have the right to take relevant legal actions, including inter alia the right to request national customs authorities to take action in respect of goods which allegedly infringe the proprietor's rights, such as detention and destruction in accordance with Regulation 608/2013 of the European Parliament and of the Council<sup>23a</sup>. Customs authorities should carry out the relevant procedures laid down in Regulation (EC) 608/2013 at the request of a rightholder and on the basis of risk analysis criteria.***

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***<sup>23a</sup> Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 (OJ L 181, 28.6.2013, p. 15).***

## **Amendment 8**

### **Proposal for a directive Recital 22 b (new)**

*Text proposed by the Commission*

*Amendment*

***(22b) Article 28 of Regulation (EU) No 608/2013 provides that a right holder is to be liable in damages towards the holder of the goods where, inter alia, the goods in question are subsequently found not to infringe an intellectual property right.***

## Amendment 9

### Proposal for a directive Recital 22 c (new)

*Text proposed by the Commission*

*Amendment*

***(22c) Member States should take appropriate measures with a view to ensuring the smooth transit of generic medicines. Therefore, a proprietor of a trade mark should not have the right to prevent any third party from bringing goods, in the context of commercial activity, into the customs territory of the Member State based upon similarities, perceived or actual, between the international non-proprietary name (INN) for the active ingredient in the medicines and a registered trademark.***

## Amendment 10

### Proposal for a directive Recital 23

*Text proposed by the Commission*

*Amendment*

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

(23) In order to more effectively prevent the entry of ***counterfeit*** goods, particularly in the context of sales over the ***internet delivered in small consignments as defined by Regulation (EU) No 608/2013*** the proprietor ***of a validly registered trade mark*** should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the ***counterfeit*** goods who acts ***in the course of trade. In cases where such measures are taken, the individuals or entities that had ordered the goods are informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.***

## Amendment 11

### Proposal for a directive

#### Recital 29

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

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

##### *Amendment*

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

##### *Justification*

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

## Amendment 12

### Proposal for a directive

#### Recital 34

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

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to

##### *Amendment*

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to

European trade marks. *With a view to achieving a consistent and balanced trade mark system both at national and Union level, all the central industrial property offices of the Member States should therefore limit their examination ex officio of whether a trade mark application is eligible for registration to the absence of absolute grounds for refusal only. This should however not prejudice the right of those offices to provide, upon request of applicants, searches for earlier rights on a purely informative basis and without any prejudice to or binding effect on the further registration process, including subsequent opposition proceedings.*

European trade marks. *Member States should be free to decide whether to conduct ex officio examination for refusal on relative grounds.*

#### **Amendment 13**

##### **Proposal for a regulation Recital 41 a (new)**

*Text proposed by the Commission*

*Amendment*

*(46a) The European Data Protection Supervisor was consulted in accordance with Article 28(2) of Regulation (EC) No 45/2001 and delivered an opinion on 11 July 2013<sup>23b</sup>.*

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<sup>23b</sup> *Not yet published in the Official Journal.*

#### **Amendment 14**

##### **Proposal for a directive Article 1**

*Text proposed by the Commission*

*Amendment*

This Directive shall apply to every trade mark in respect of goods or services which

This Directive shall apply to every trade mark in respect of goods or services which

is the subject of registration or of an application *in a Member State* for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.

is the subject of registration or of an application for registration *in a Member State* as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.

#### *Justification*

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

### **Amendment 15**

#### **Proposal for a directive Article 2 – point b**

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

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

##### *Amendment*

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

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

#### *Justification*

*Change to reflect the amended name of the Agency.*

### **Amendment 16**

#### **Proposal for a directive Article 2 – point ca**

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

##### *Amendment*

*(ca) ‘earlier trade marks’ means:*

*(i) trade marks of the following kinds with a date of application for registration*

*which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:*

*– European Union trade marks;*

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

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

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

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

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

#### *Justification*

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

#### **Amendment 17**

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

*Text proposed by the Commission*

*Amendment*

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

*Justification*

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

## **Amendment 18**

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

*Text proposed by the Commission*

*Amendment*

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

*Justification*

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

## **Amendment 19**

### **Proposal for a directive Article 3**



*Text proposed by the Commission*

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

- (a) distinguishing the goods or services of one undertaking from those of other undertakings;
- (b) being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.

*Amendment*

A trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that ***generally available technology is used and*** such signs are capable of:

- (a) distinguishing the goods or services of one undertaking from those of other undertakings; ***and***
- (b) being represented in ***the register in*** a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.

**Amendment 20**

**Proposal for a directive**

**Article 4 – paragraph 1 – point j**

*Text proposed by the Commission*

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine and traditional specialities guaranteed.

*Amendment*

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of ***spirit drinks***, traditional terms for wine and traditional specialities guaranteed.

*Justification*

*Undoubtedly, the provision is beneficial for the owners of GIs. However, the reason to identify spirit drinks in this provision results from the GIs covered by Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008. It is necessary to distinguish them from other geographical indications and designations of origin for agricultural products and foodstuffs included in Council Regulation (EC) No 510/2006 or No 509/2006 of 20 March 2006.*

## Amendment 21

### Proposal for a directive

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

*Text proposed by the Commission*

*Amendment*

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

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

#### *Justification*

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

## Amendment 22

### Proposal for a directive

#### Article 4 – paragraph 2

*Text proposed by the Commission*

*Amendment*

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

***deleted***

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

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

#### *Justification*

*It would be disproportionate and practically unworkable to require national offices to examine absolute grounds for refusal in all national jurisdictions and languages of the Union.*

*It would further run contrary to the principle of territoriality of rights. For users there would be little or no added value to have the application examined for obstacles to registration in other territories than the one for which it would be valid for.*

## **Amendment 23**

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

*Text proposed by the Commission*

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

*Amendment*

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

## **Amendment 24**

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

*Text proposed by the Commission*

**2. ‘Earlier trade marks’ within the meaning of paragraph 1 means:**  
***(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;***  
***(i) European trade marks;***  
***(ii) trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the***

*Amendment*

***deleted***

*Benelux Office for Intellectual Property;*

*(iii) trade marks registered under international arrangements which have effect in the Member State;*

*(b) European trade marks which validly claim seniority, in accordance with Regulation (EC) No 207/2009, from a trade mark referred to in points (a)(ii) and (iii), even when the latter trade mark has been surrendered or allowed to lapse;*

*(c) applications for the trade marks referred to in points (a) and (b), subject to their registration;*

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

#### *Justification*

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

### **Amendment 25**

#### **Proposal for a directive**

#### **Article 5 – paragraph 3 – point a**

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

(a) if it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in *a* Member State or, in case of a European trade mark, has a reputation in the Union and the use of the later trade mark without due cause

##### *Amendment*

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

would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

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

#### *Justification*

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

### **Amendment 26**

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

*Text proposed by the Commission*

*Amendment*

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

***deleted***

#### *Justification*

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

### **Amendment 27**

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

*Text proposed by the Commission*

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

*Amendment*

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

*Justification*

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

**Amendment 28**

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

*Text proposed by the Commission*

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

*Amendment*

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

*Justification*

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

**Amendment 29**

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

*Text proposed by the Commission*

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) and (3) has

*Amendment*

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) **and point (a) of**

acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.

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

### *Justification*

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

## **Amendment 30**

### **Proposal for a directive Article 10**

#### *Text proposed by the Commission*

1. The registration of a trade mark shall confer on the proprietor exclusive rights therein.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of a registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign in relation to goods or services where:
  - (a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered ***and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services;***
  - (b) the sign is identical, or similar to, the trade mark and is used for goods or services which are identical with or similar

#### *Amendment*

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2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of a registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign in relation to goods or services where:
  - (a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered;
  - (b) ***without prejudice to point a,*** the sign is identical , or similar to, the trade mark and is used for goods or services which are

to the goods or services for which the trade mark is registered if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar or not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

3. The following, in particular may be prohibited under paragraph 2:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under the sign;
- (d) using the sign as a trade or company name or part of a trade or company name;
- (e) using the sign on business papers and in advertising;
- (f) using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC.

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing of goods *pursuant to paragraph 3(c)* where only the consignor of the goods acts *for commercial purposes*.

identical with or similar to the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar or not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

3. The following, in particular may be prohibited under paragraph 2:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under the sign;
- (d) using the sign as a trade or company name or part of a trade or company name;
- (e) using the sign on business papers and in advertising;
- (f) using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC.

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing *into the Union* of goods *delivered in small consignments as defined by Regulation (EU) No 608/2013* where only the consignor of the goods acts *in the course of trade and where such goods, including packaging, bear without authorisation a trade mark which is*



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

6. Where, under the law of a Member

*identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. In cases where such measures are taken, Member States shall ensure that the individual or entity that ordered the goods is informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.*

5. The proprietor of a registered trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State where the trade mark is registered without being released for free circulation there, where such goods, including packaging, come from *a* third *country* and bear without *authorisation* a trade mark which is identical to the trade mark *validly* registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. *Without prejudice to the obligations of customs authorities to carry out adequate customs controls in accordance with Article 1 of Regulation (EU) No 608/2013, this provision shall not apply if the third party proves that the final destination of the goods is a country outside the Union and if the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. In cases where the country of final destination has not yet been determined, the proprietor of the European Union trade mark shall have the right to prevent all third parties from bringing the goods out of the Union again unless the third party proves that the final destination of the goods is a country outside the Union and the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination.*

6. Where, under the law of a Member

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

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

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

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

## Amendment 31

### Proposal for a directive Article 11 – point a

#### *Text proposed by the Commission*

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

#### *Amendment*

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

#### *Justification*

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

## Amendment 32

### Proposal for a directive Article 11 – point b

#### *Text proposed by the Commission*

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

#### *Amendment*

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

#### *Justification*

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

## Amendment 33

### Proposal for a directive Article 14 – paragraph 1 – subparagraph c

#### *Text proposed by the Commission*

(c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular where the use of the trade mark ***is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;***

#### *Amendment*

(c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular where the use of the trade mark:

***(i) is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;***

***(ii) is made in comparative advertising satisfying all conditions set forth in Directive 2006/114/EC<sup>1</sup>;***

***(iii) is made to bring to the attention of consumers the resale of genuine goods that have originally been sold by or with the consent of the proprietor of the trade***

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

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

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

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

3. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Member State in question and within the limits of the territory in which it is recognised.

***mark;***

***(iv) is made to put forward a legitimate alternative to the goods or services of the proprietor of the trade mark;***

***(v) is made for the purposes of parody, artistic expression, criticism or comment;***  
;

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

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

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

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

3. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Member State in question and within the limits of the territory in which it is recognised.

## **Amendment 34**

### **Proposal for a directive Article 14 – paragraph 2**

*Text proposed by the Commission*

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

*Amendment*

***deleted***

*following cases:*

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

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

## **Amendment 35**

### **Proposal for a directive**

#### **Article 14 – paragraph 2 a (new)**

*Text proposed by the Commission*

*Amendment*

*(2a) The trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark for a due cause for any non-commercial use of a mark.*

## **Amendment 36**

### **Proposal for a directive**

#### **Article 16 – paragraph 3 a (new)**

*Text proposed by the Commission*

*Amendment*

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

#### *Justification*

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

## **Amendment 37**

### **Proposal for a directive**

#### **Article 22 – paragraph 3**

*Text proposed by the Commission*

*Amendment*

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

*Justification*

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

## **Amendment 38**

### **Proposal for a directive Article 22 – paragraph 4**

*Text proposed by the Commission*

*Amendment*

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

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

*Justification*

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

## **Amendment 39**

### **Proposal for a directive Article 22 – paragraph 5**

*Text proposed by the Commission*

*Amendment*

5. As long as the transfer has not been ***entered in the register***, the successor in title may not invoke the rights arising from

5. As long as the ***application for registration of the*** transfer has not been ***received by the office***, the successor in title

the registration of the trade mark against third parties.

may not invoke the rights arising from the registration of the trade mark against third parties.

#### *Justification*

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

### **Amendment 40**

#### **Proposal for a directive Article 28 – point c**

*Text proposed by the Commission*

*Amendment*

#### **Article 28**

**deleted**

#### **Definitions**

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

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

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

#### *Justification*

*This is a technical change. In the interest of a well-structured text, the definitions contained in*

*the proposed Article 28 are moved to Article 2 on definitions.*

## **Amendment 41**

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

#### *Text proposed by the Commission*

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

#### *Amendment*

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

#### *Justification*

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

## **Amendment 42**

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

#### *Text proposed by the Commission*

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

#### *Amendment*

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

## **Amendment 43**

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

#### *Text proposed by the Commission*

6. Where the applicant requests registration for more than one class, the ***goods and services shall be grouped*** according to the classes of the Nice classification, each group being preceded by the number of the class to which that group of goods or services belongs and ***presented*** in the order of the classes.

#### *Amendment*

6. Where the applicant requests registration for more than one class, the ***applicant shall group the goods and services*** according to the classes of the Nice classification, each group being preceded by the number of the class to which that group of goods or services belongs, and ***shall present them*** in the order of the classes.



*Justification*

*Clarification that it is up to the applicant and not the office to group the goods and services according to classes.*

**Amendment 44**

**Proposal for a directive  
Article 41**

*Text proposed by the Commission*

*Amendment*

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

*deleted*

**Amendment 45**

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

*Text proposed by the Commission*

*Amendment*

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

*Justification*

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

**Amendment 46**

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

*Text proposed by the Commission*

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

*Amendment*

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

*Justification*

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

**Amendment 47**

**Proposal for a directive  
Article 45 – paragraph 3**

*Text proposed by the Commission*

3. The parties shall be granted **a period of time of at least** two months **before** the opposition **proceedings commence** in order

*Amendment*

3. The parties shall, **at their joint request**, be granted **a minimum of** two months **within** the opposition **proceedings** in order

to negotiate the possibility of an amicable settlement between the opposing party and the applicant.

to negotiate the possibility of an amicable settlement between the opposing party and the applicant.

*Justification*

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

**Amendment 48**

**Proposal for a directive  
Article 47 – paragraph 1**

*Text proposed by the Commission*

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

*Amendment*

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

*Justification*

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

**Amendment 49**

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

*Text proposed by the Commission*

*Amendment*

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

*Justification*

*The proposal of the Commission obliges Member States to provide for an administrative procedure to challenge the validity of a trade mark registration before their offices. In order to increase effectiveness of national cancellation procedures, to align them with European cancellation procedures, reduce fees, costs and administrative burden, it is proposed that an*

*application for revocation may be directed against part or the totality of the goods or services covered by the contested mark. This way, Member States will not be allowed to make cancellation administrative actions conditional upon the fact that they are directed only against one class of the contested mark.*

## **Amendment 50**

### **Proposal for a directive**

#### **Article 47 – paragraph 4 b (new)**

*Text proposed by the Commission*

*Amendment*

***4b. An application for a declaration of invalidity may be filed on the basis of one or more earlier rights, provided they all belong to the same proprietor.***

*Justification*

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

## **Amendment 51**

### **Proposal for a directive**

#### **Article 48 – paragraph 1**

*Text proposed by the Commission*

*Amendment*

1. In ***administrative*** proceedings for a declaration of invalidity based on a registered trade mark with an earlier filing date or priority date, if the proprietor of the later trade mark so requests, the proprietor of the earlier trade mark shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use as provided for in Article 16 in connection

1. In proceedings for a declaration of invalidity based on a registered trade mark with an earlier filing date or priority date, if the proprietor of the later trade mark so requests, the proprietor of the earlier trade mark shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use as provided for in Article 16 in connection with the goods or

with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided that the period of five years within which the earlier trade mark must have been put to genuine use has expired at the date of the application for a declaration of invalidity.

services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided that the period of five years within which the earlier trade mark must have been put to genuine use has expired at the date of the application for a declaration of invalidity.

#### *Justification*

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

### **Amendment 52**

#### **Proposal for a directive Article 52**

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

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

##### *Amendment*

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

### **Amendment 53**

#### **Proposal for a directive Chapter 3 – section 3 a (new) – Article 51 a (new)**

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

##### *Amendment*

#### **SECTION 3A COMMUNICATION WITH THE OFFICE**

##### **Article 51 a**

***Communication with the office  
Parties to the proceedings or, where***

*appointed, their representatives, shall designate an official address within one of the Member States for all official communication with the office.*

*Justification*

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

**Amendment 54**

**Proposal for a directive  
Article 53**

*Text proposed by the Commission*

Member States shall ensure that the offices cooperate with the Agency in all areas of their activities other than those referred to in Article 52 which are of relevance for the protection of trade marks in the Union.

*Amendment*

Member States shall ensure that the offices ***effectively*** cooperate with the Agency in all areas of their activities other than those referred to in Article 52 which are of relevance for the protection of trade marks in the Union.

## **EXPLANATORY STATEMENT**

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

### **Summary and introduction**

The directive harmonising certain aspects of trade mark law of the Member States of the European Union has existed for over 20 years. The present review provides an opportunity to learn from best practices and further strengthen the harmonizing aspects of substantive trade mark law and procedures used by national trade mark offices.

Your rapporteur wants to make clear from the start that this review should have as its foremost guiding principle the preservation and strengthening of the dual-level system of trade mark protection in Europe. The business community in the European Union consists of over 20 million companies with vastly differing needs. The trade mark system should be simple and flexible enough to give the users of the system access to a protection that suits their needs.

Some users want to seek the protection only in one Member State whilst some want to seek unitary protection in the 28 member states of the Union. It should however be noted that there are also many users that depend on using the national system for protection in several different Member States. This could for example be the case for users that are not able to get an EU trade mark because of prior existing rights in one or several Member States. It could also be the very conscious choice of a company active in a small number of countries or in a border region.

In order to assist these users which are relying on the services of multiple national offices for their protection it is reasonable to harmonize procedures so that the users are not forced to deal with completely different procedural approaches in the different Member States where they wish to seek protection. Although the fees, notably at OHIM, make up an important component of the choice of strategy for where a trade mark is registered, there are many other factors at play as well.

The focus on implementing best practices for procedures and substantive law should be to make national trade mark systems more attractive for users. For this reason it would also be reasonable to harmonize a number of additional procedural aspects that would improve the

situation for users protecting their trade marks in multiple national offices.

Whilst having a generally positive outlook on harmonization it also has to be noted that some of the proposals of the Commission go too far in that they disregard the territorial nature of the protection offered. Other proposals need clarifications to ensure that important features, notably to SMEs, are preserved.

### **Examination of absolute grounds, Article 4(2)**

This is the most obvious case where the proposal from the Commission goes too far and your rapporteur suggests deleting this provision in its entirety. The results of keeping this provision would be that the examination before a national office would be no different from the examination before the Agency. As the right awarded by a national office only concerns the territory of that Member State it would not be appropriate to require examination on absolute grounds with respect to territories which will not be covered by the trade mark anyway.

### **Ex officio examination of relative grounds**

A number of national offices in the European Union still perform ex officio examinations of relative grounds. The Commission has presented a good case underlining the complications that this procedure entails for applicants of the system, due for example to considerable delays. It should however be noted that many offices that have abolished the ex officio examination of relative grounds still provide (ex officio) their applicants with searches and search results with regards to earlier rights as well as notifications to proprietors of earlier rights of applications that may conflict with their rights. Your rapporteur considers it perfectly possible to preserve the option for national offices to provide this examination, and combine it with the well founded proposal by the Commission to not let these examinations block the application procedure for the applicant.

### **Enforcement measures**

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

The Commission has further proposed a provision on goods in transit. Although there is a need to stop counterfeit products entering the European internal market the proposal would also hamper legitimate international trade. Your rapporteur would thus suggest a number of changes in order to ensure a more balanced proposal.

### **Administrative simplification**

In the view of your rapporteur there would still be room for additional proposals to strengthen the attractiveness of the national trade mark system by simplifying some procedural rules. Parties to a proceeding before a national office should for instance not be forced to designate an official address within this Member State.



**ANNEX: OPINION OF THE CONSULTATIVE WORKING PARTY OF THE LEGAL SERVICES OF THE EUROPEAN PARLIAMENT, THE COUNCIL AND THE COMMISSION**



CONSULTATIVE WORKING PARTY  
OF THE LEGAL SERVICES

Brussels, 4 June 2013

**OPINION**

**FOR THE ATTENTION OF THE EUROPEAN PARLIAMENT  
THE COUNCIL  
THE COMMISSION**

**Proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks  
COM(2013) 162 final of 27.3.2013 - 2013/0089 (COD)**

Having regard to the Inter-institutional Agreement of 28 November 2001 on a more structured use of the recasting technique for legal acts, and in particular to point 9 thereof, the Consultative Working Party consisting of the respective legal services of the European Parliament, the Council and the Commission met on 23 April 2013 for the purpose of examining, among others, the aforementioned proposal submitted by the Commission.

At that meeting<sup>1</sup>, an examination of the proposal for a directive of the European Parliament and of the Council recasting Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks resulted in the Consultative Working Party's establishing, by common accord, as follows.

- 1) As far as the explanatory memorandum is concerned, in order to be drafted in full compliance with the relevant requirements laid down by the Inter-institutional Agreement such a document should have specified which provisions of the earlier act remain unchanged in the proposal, as is provided for under point 6(a)(iii) of that agreement.
- 2) In the draft recast text, the following proposed changes should have been identified with

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<sup>1</sup> The Consultative Working Party had at its disposal the English, French and German language versions of the proposal and worked on the basis of the English version, being the master-copy language version of the text under discussion.

the grey-shaded type generally used for marking substantive changes:

- in Article 14(1)(a), which corresponds to Article 6(1)(a) of Directive 2008/95/EC, the adding of the word "*personal*";
- in Article 29(2), which corresponds to Article 15(1) of Directive 2008/95/EC, the deletion of the initial wording "*Without prejudice to Article 4*".

3) In Article 29(2), the reference made to Article 3 should be adapted so as to read as a reference made to Article 4.

In consequence, examination of the proposal has enabled the Consultative Working Party to conclude, without dissent, that the proposal does not comprise any substantive amendments other than those identified as such therein or in the present opinion. The Working Party also concluded, as regards the codification of the unchanged provisions of the earlier act with those substantive amendments, that the proposal contains a straightforward codification of the existing text, without any change in its substance.

C. PENNERA  
Jurisconsult

H. LEGAL  
Jurisconsult

L. ROMERO REQUENA  
Director General

7.10.2013

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

for the Committee on Legal Affairs

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

Rapporteur: George Sabin Cutaş

### **SHORT JUSTIFICATION**

The main objective of the proposal for the amendment of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks and the related Regulation which form part of the same package is to harmonize trade mark registration systems in all EU Member States, as well as to ensure coexistence and complementarity between the EU and national trade mark systems, in order to make them more efficient for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal security. This could lead to a substantive increase in innovation and economic growth.

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

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

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

## AMENDMENTS

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

### Amendment 1

#### Proposal for a directive

##### Recital 15

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

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

###### *Amendment*

(15) In order to ensure that the levels of protection afforded to geographical indications by other instruments of Union law are applied in a uniform and exhaustive manner in the examination of absolute and relative grounds for refusal throughout the Union, this Directive should include the same provisions in relation to geographical indications as contained in Regulation (EC) No 207/2009. ***Since Union legislation exists only concerning the protection of geographical indications of agricultural products and foodstuffs, wine and spirits, the Commission should adopt a proposal for a regulation harmonising Member States' rules on the protection of geographical indications also for goods other than agricultural and foodstuffs, wine and spirits.***

### Amendment 2

#### Proposal for a directive

##### Recital 22

*Text proposed by the Commission*

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

*Amendment*

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is identical to the trade mark registered in respect of such goods. ***This should be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit and its right to promote access to medicines for third countries, and more specifically to the production, circulation and distribution of generic medicines in the EU and abroad.***

**Amendment 3**

**Proposal for a directive  
Recital 23**

*Text proposed by the Commission*

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

*Amendment*

(23) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor should be entitled to prohibit the importing of such goods into the Union, where it is only the consignor of the goods who acts for commercial purposes. ***For this purpose, the proprietor should take relevant actions as provided for under Directive 48/2004/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights and Regulation 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning***

#### **Amendment 4**

##### **Proposal for a directive Recital 24**

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

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

###### *Amendment*

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

#### **Amendment 5**

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

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

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing of goods referred to in paragraph 3(c) where only the consignor of the goods acts for commercial purposes.

###### *Amendment*

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing of goods referred to in paragraph 3(c) where only the consignor of the goods acts for commercial purposes.

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

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

## **Amendment 6**

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

#### *Text proposed by the Commission*

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

#### *Amendment*

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

## **Amendment 7**

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

#### *Text proposed by the Commission*

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

#### *Amendment*

(a) affixing in the course of trade a sign identical with or similar to, ***as specified in Article 5 paragraph 1 of this Directive***, the trade mark on get-up, packaging or other means on which the mark may be affixed

#### *Justification*

*Paragraph should be consistent with the identification and similarity provisions already*

*specified in Article 5(1).*

## **Amendment 8**

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

*Text proposed by the Commission*

*Amendment*

#### **Article 37 a**

##### ***Indemnification of the Importer and the Owner of the Goods***

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

#### *Justification*

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



## PROCEDURE

<b>Title</b>	Laws of the Member States relating to trade marks (Recast)	
<b>References</b>	COM(2013)0162 – C7-0088/2013 – 2013/0089(COD)	
<b>Committee responsible</b> Date announced in plenary	JURI	16.4.2013
<b>Opinion by</b> Date announced in plenary	INTA	16.4.2013
<b>Rapporteur</b> Date appointed	George Sabin Cutaş	25.4.2013
<b>Discussed in committee</b>	11.7.2013	16.9.2013
<b>Date adopted</b>	14.10.2013	
<b>Result of final vote</b>	+: 21 –: 2 0: 0	
<b>Members present for the final vote</b>	Laima Liucija Andrikienė, Maria Badia i Cutchet, Nora Berra, Daniel Caspary, María Auxiliadora Correa Zamora, Andrea Cozzolino, George Sabin Cutaş, Marielle de Sarnez, Christofer Fjellner, Yannick Jadot, Franziska Keller, Bernd Lange, Vital Moreira, Paul Murphy, Niccolò Rinaldi, Helmut Scholz, Peter Šťastný, Robert Sturdy, Henri Weber, Jan Zahradil	
<b>Substitute(s) present for the final vote</b>	Jarosław Leszek Wałęsa	
<b>Substitute(s) under Rule 187(2) present for the final vote</b>	Elisabeth Jeggle, Krzysztof Lisek, Iosif Matula, Paul Rübig, Catherine Stihler	



7.11.2013

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

for the Committee on Legal Affairs

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

Rapporteur: Regina Bastos

### **SHORT JUSTIFICATION**

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

### **Aim of the proposal**

Given that the directive is based on Article 114 of the Treaty on the Functioning of the European Union (TFEU) – employed in order to adopt 'measures for the approximation of the provisions laid down by law, regulation or administrative action in Member States which have as their object the establishment and functioning of the internal market' – it deals with national trade mark systems, which continue to be necessary for those businesses that do not wish their trade marks to be protected at EU level.

The Commission's impact assessment has demonstrated the need to harmonise certain aspects of national procedures and lay down a system for cooperation between national offices and the OHIM.

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

- modernise the trade mark system in Europe,

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

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

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

As far as the recast directive is concerned, the Commission is seeking to:

- modernise and improve the existing provisions in order to provide greater legal certainty and clarify trade mark rights in terms of their scope and limitations;
- achieve greater approximation of national trade mark laws and procedures so as to make them more consistent with the Community trade mark system established under the regulation; and
- facilitate cooperation – on a legal basis to be established to that end – between the Member States’ national offices and the OHIM with a view to promoting convergence of practices and developing common tools.

### **Internal market aspects**

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

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

- a trade mark owner may prevent the use of its trade mark in any comparative advertising failing to satisfy the requirements of Article 4 of Directive 2006/114/EC of 12 December 2006 concerning misleading and comparative advertising;
- imports of goods into the EU may be prohibited even when the consignor alone is acting for commercial purposes (the object of this clarification is to discourage online orders and sales of counterfeit goods);

- right holders may prevent third parties from bringing goods from non-EU countries into Union customs territory, whether released for free circulation or otherwise, if these, without authorisation, bear a trade mark essentially identical to one registered in respect of goods of the same type.

### **The rapporteur's view**

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

- strengthen the role of national authorities in the trade mark protection system and in combating counterfeiting;
- make a clarification regarding the signs of which a European trade mark may consist;
- address the absolute grounds for refusal or invalidity; and
- do away with the Commission proposal whereby the offices, when examining ex officio whether a trade mark application was eligible for registration, would in every case be called upon only to ascertain that there were no absolute grounds for refusal.

## **AMENDMENTS**

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

### **Amendment 1**

#### **Proposal for a directive**

#### **Recital 19**

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

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

##### *Amendment*

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

*services*, is adversely affected.

## Amendment 2

### Proposal for a directive

#### Recital 19 a (new)

*Text proposed by the Commission*

*Amendment*

*(19a) The main function of a trademark is to guarantee the origin of the product to the consumer or final user by enabling him or her to distinguish without any possibility of confusion between that product and products which have another origin;*

## Amendment 3

### Proposal for a directive

#### Recital 19 b (new)

*Text proposed by the Commission*

*Amendment*

*(19b) When determining whether the main function of a trade mark is adversely affected, it is necessary to interpret this provision in the light of Article 11 of the Charter of Fundamental Rights of the European Union and Article 10 of the European Convention on Human Rights in order to guarantee the fundamental right of freedom of expression.*

## Amendment 4

### Proposal for a directive

#### Recital 22

*Text proposed by the Commission*

*Amendment*

(22) With the aim of strengthening trade mark protection and **combatting** counterfeiting more effectively, the

(22) With the aim of strengthening trade mark protection and **combating** counterfeiting more effectively, the

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

proprietor of a registered trade mark, ***assisted by the national authorities***, should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is essentially identical to the trade mark registered in respect of such goods.

*Justification*

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

**Amendment 5**

**Proposal for a directive**

**Recital 23**

*Text proposed by the Commission*

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

*Amendment*

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

*Justification*

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

**Amendment 6**

**Proposal for a directive**

**Recital 25 a (new)**

*Text proposed by the Commission*

*Amendment*

***(25a) The exclusive rights conferred by a trade mark should not entitle the***

*proprietor to prohibit the use of signs or indications which are used for a due cause in order to allow consumers to make comparisons, to express opinions or where there is no commercial use of the mark.*

## **Amendment 7**

### **Proposal for a directive Recital 34**

#### *Text proposed by the Commission*

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to European trade marks. ***With a view to achieving a consistent and balanced trade mark system both at national and Union level, all the central industrial property offices of the Member States should therefore limit their examination ex officio of whether a trade mark application is eligible for registration to the absence of absolute grounds for refusal only. This should, however, not prejudice the right of those offices to provide, upon request of applicants, searches for earlier rights on a purely informative basis and without any prejudice to or binding effect on the further registration process, including subsequent opposition proceedings.***

#### *Amendment*

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to European trade marks.

#### *Justification*

*Relative grounds for refusal should, where Member States so decide, continue to be a subject for ex officio examination, bearing in mind the advantages for trade mark applicants and SMEs in particular. At present there are 12 Member States making use of the above option (Bulgaria, the Czech Republic, Cyprus, Estonia, Finland, Greece, Ireland, Malta, Poland,*



Portugal, Slovakia, and Sweden).

## Amendment 8

### Proposal for a directive Recital 36 a (new)

*Text proposed by the Commission*

*Amendment*

***(36 a) 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;***

## Amendment 9

### Proposal for a directive Article 3 – point b

*Text proposed by the Commission*

*Amendment*

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

(b) being represented, ***in its published form and its inscription in the register,*** in a manner which enables the competent authorities and the public to determine ***clearly and exactly*** the subject of the protection afforded to its proprietor.

*Justification*

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

## Amendment 10

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

*Text proposed by the Commission*

*Amendment*

5. A trade mark shall not be refused registration or be declared invalid in

5. A trade mark shall not be refused registration or be declared invalid in

accordance with paragraph 1(b), (c) or (d) if, ***before the date of application for registration or after the date of registration, and following the use which has been made of it***, it has acquired a distinctive character.

accordance with paragraph 1(b), (c) or (d) if it has acquired a distinctive character ***at the time of registration***.

*Justification*

*A trade mark has to have a distinctive character on the date of its registration.*

**Amendment 11**

**Proposal for a directive  
Article 4 – paragraph 6**

*Text proposed by the Commission*

*Amendment*

***6. Any Member State may provide that paragraph 5 shall also apply where the distinctive character was acquired after the date of application for registration and before the date of registration.***

***deleted***

*Justification*

*A trade mark has to have a distinctive character on the date of its registration.*

**Amendment 12**

**Proposal for a directive  
Article 10 – paragraph 2 – point a**

*Text proposed by the Commission*

*Amendment*

(a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services;

(a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services ***by enabling him or her to distinguish without any possibility of confusion between that product and***

*products which have another origin;*

## Amendment 13

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

#### *Text proposed by the Commission*

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing of goods pursuant to paragraph 3(c) where **only** the consignor of the goods acts for commercial purposes.

#### *Amendment*

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

## Amendment 14

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

#### *Text proposed by the Commission*

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

#### *Amendment*

5. The proprietor of a registered trade mark, ***assisted by the national authorities***, shall also be entitled to prevent all third parties from bringing goods ***infringing this registered trade mark*** into the customs territory of the Member State where the trade mark is ***validly*** registered, where such goods, including packaging:

***(a) come from third countries and bear without authorization a trade mark which is identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark;***

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

*Justification*

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

**Amendment 15**

**Proposal for a directive**

**Article 14 – paragraph 3 a (new)**

*Text proposed by the Commission*

*Amendment*

***3a. The trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark for a due cause in connection with:***  
***(a) advertising or promotion that permits consumers to compare goods or services;***  
***or***  
***(b) identifying and parodying, criticizing, or commenting upon the trade mark proprietor or the goods or services of the trade mark owner proprietor; or***  
***(c) any non-commercial use of a mark.***

**Amendment 16**

**Proposal for a directive**

**Article 31 – paragraph 1**

*Text proposed by the Commission*

*Amendment*

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

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

### *Justification*

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

## **Amendment 17**

### **Proposal for a directive Article 41**

*Text proposed by the Commission*

*Amendment*

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

### *Justification*

*Relative grounds for refusal should, where Member States so decide, continue to be a subject for ex officio examination, bearing in mind the advantages for trade mark applicants and SMEs in particular. At present there are 12 Member States making use of the above option (Bulgaria, the Czech Republic, Cyprus, Estonia, Finland, Greece, Ireland, Malta, Poland, Portugal, Slovakia, and Sweden).*

## **Amendment 18**

### **Proposal for a directive Article 42 – paragraph 1**

*Text proposed by the Commission*

*Amendment*

1. Prior to registration of a trade mark, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the office written observations, explaining on which of the grounds listed in Article 4 the trade mark shall not be registered ex officio. ***They shall not be parties to the proceedings before the office.***

1. Prior to registration of a trade mark, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the office written observations, explaining on which of the grounds listed in Article 4 the trade mark shall not be registered ex officio.

## Amendment 19

### Proposal for a directive Article 45 – paragraph 1

*Text proposed by the Commission*

1. Member States shall provide for an efficient and expeditious administrative procedure before their offices for opposing the registration of a trade mark application ***on the grounds provided for in Article 5.***

*Amendment*

1. Member States shall provide for an efficient and expeditious administrative procedure before their offices for opposing the registration of a trade mark application.

## Amendment 20

### Proposal for a directive Article 45 – paragraph 3 a (new)

*Text proposed by the Commission*

*Amendment*

***3a. 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.***

## Amendment 21

### Proposal for a directive Article 53 – paragraph 1

*Text proposed by the Commission*

Member States shall ensure that the offices cooperate with the Agency in ***all*** areas of ***their activities other than those referred to in Article 52*** which ***are*** of relevance for the protection of trade marks in the Union.

*Amendment*

Member States shall ***take steps*** to ensure that the offices cooperate with the Agency in areas of ***activity*** which ***they consider to be*** of relevance for the protection of trade marks in the Union, ***but other than those referred to in Article 52.***

## PROCEDURE

<b>Title</b>	Laws of the Member States relating to trade marks (Recast)		
<b>References</b>	COM(2013)0162 – C7-0088/2013 – 2013/0089(COD)		
<b>Committee responsible</b> Date announced in plenary	JURI 16.4.2013		
<b>Opinion by</b> Date announced in plenary	IMCO 16.4.2013		
<b>Rapporteur</b> Date appointed	Regina Bastos 29.5.2013		
<b>Discussed in committee</b>	9.7.2013	25.9.2013	14.10.2013
<b>Date adopted</b>	5.11.2013		
<b>Result of final vote</b>	+: 34 -: 0 0: 1		
<b>Members present for the final vote</b>	Preslav Borissov, Jorgo Chatzimarkakis, Birgit Collin-Langen, Lara Comi, Anna Maria Corazza Bildt, António Fernando Correia de Campos, Cornelis de Jong, Vicente Miguel Garcés Ramón, Evelyne Gebhardt, Thomas Händel, Małgorzata Handzlik, Malcolm Harbour, Sandra Kalniete, Edvard Kožušník, Toine Manders, Hans-Peter Mayer, Phil Prendergast, Zuzana Roithová, Heide Rühle, Christel Schaldemose, Andreas Schwab, Catherine Stihler, Emilie Turunen, Barbara Weiler		
<b>Substitute(s) present for the final vote</b>	Regina Bastos, Jürgen Creutzmann, María Irigoyen Pérez, Constance Le Grip, Emma McClarkin, Claudio Morganti, Pier Antonio Panzeri, Konstantinos Poupakis, Marek Siwiec, Kerstin Westphal		
<b>Substitute(s) under Rule 187(2) present for the final vote</b>	Agustín Díaz de Mera García Consuegra		

## PROCEDURE

Title	Laws of the Member States relating to trade marks (Recast)			
References	COM(2013)0162 – C7-0088/2013 – 2013/0089(COD)			
Date submitted to Parliament	27.3.2013			
Committee responsible Date announced in plenary	JURI 16.4.2013			
Committee(s) asked for opinion(s) Date announced in plenary	INTA 16.4.2013	ITRE 16.4.2013	IMCO 16.4.2013	
Not delivering opinions Date of decision	ITRE 25.4.2013			
Rapporteur(s) Date appointed	Cecilia Wikström 24.4.2013			
Discussed in committee	29.5.2013	19.6.2013	17.9.2013	14.10.2013
	5.11.2013			
Date adopted	17.12.2013			
Result of final vote	+: 23 -: 0 0: 0			
Members present for the final vote	Raffaele Baldassarre, Sebastian Valentin Bodu, Françoise Castex, Christian Engström, Marielle Gallo, Giuseppe Gargani, Lidia Joanna Geringer de Oedenberg, Klaus-Heiner Lehne, Antonio López-Istúriz White, Antonio Masip Hidalgo, Alajos Mészáros, Bernhard Rapkay, Evelyn Regner, Francesco Enrico Speroni, Dimitar Stoyanov, Rebecca Taylor, Alexandra Thein, Rainer Wieland, Cecilia Wikström, Tadeusz Zwiefka			
Substitute(s) present for the final vote	Eva Lichtenberger, József Szájer			
Substitute(s) under Rule 187(2) present for the final vote	Silvia Costa, Jürgen Klute, Kay Swinburne			
Date tabled	16.1.2014			