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Proposal for a

REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

amending Council Regulation (EC) No 207/2009 on the Community trade mark

(Text with EEA relevance)

{SWD(2013) 95 final}

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EXPLANATORY MEMORANDUM

1. CONTEXT OF THE PROPOSAL

1.1. General context and grounds for the proposal

The laws of the Member States relating to trade marks were partially harmonised by Council Directive 89/104/EEC of 21 December 1988, codified as Directive 2008/95/EC (hereinafter referred to as ‘the Directive’). Alongside and linked to the national trade mark systems, Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, codified as Regulation (EC) No 207/2009 (hereinafter referred to as ‘the Regulation’), established a stand-alone system for the registration of unitary rights having equal effect throughout the EU. In that context the Office for Harmonization in the Internal Market (OHIM) was set up to be responsible for registering and administering Community trade marks.

A trade mark serves to distinguish the goods and services of a company. It is the mark through which a business can attract and retain customer loyalty, and create value and growth. The mark works in this case as an engine of innovation: the necessity to keep it relevant promotes investments in R & D, which leads in turn to a continuous process of product improvement and development. This dynamic process also has a favourable impact on employment. In an increasingly competitive environment, there has been a steady growth not only in the crucial role of trade marks for market success, but also in their commercial value and number. In 2012, a record number of Community trade mark applications were filed (over 107,900, against 98,217 in 2010 and 49,503 a decade earlier). OHIM also received its millionth application since starting operations in 1996 during 2011. This development has been accompanied by growing expectations on the part of stakeholders for more streamlined and high-quality trade mark registration systems, which are more consistent, publicly accessible and technologically up-to-date.

In 2007, when addressing the issue of the financial perspectives of OHIM, the Council¹ emphasised that the establishment of OHIM had been a great success and that it had contributed substantially to strengthening the competitiveness of the EU. It recalled that the Community trade mark system had been designed to co-exist with the national trade mark systems which continued to be necessary for those undertakings which did not want their trade marks protected at EU level. The Council further noted the importance of the complementary work of national trade mark offices, and called on OHIM to expand its cooperation with them in the interest of the overall functioning of the Community trade mark system. Last, it acknowledged that more than a decade had passed since the creation of the Community trade mark, and underlined the need for an overall assessment of the functioning of the Community trade mark system. It invited the Commission to start work on a corresponding study, in particular, with a view to intensifying and broadening the existing instruments of cooperation between OHIM and national trade mark offices.

¹ Competitiveness Council Conclusions of 21 and 22 May 2007, Council document 9427/07.

In its 2008 Small Business Act² the Commission pledged to make the Community trade mark system more accessible to SMEs. Furthermore, the 2008 Communication on an Industrial Property Rights Strategy for Europe³ underlined the Commission's commitment to effective and efficient trade mark protection and to a trade mark system of high quality. It concluded that it was time for an overall evaluation which could form the basis for a future review of the trade mark system in Europe and for the further improvement of cooperation between OHIM and National Offices. In 2010, in the Communication on Europe 2020, under the Flagship Initiative 'Innovation Union', the Commission undertook to modernise the framework of trade marks in order to improve framework conditions for business to innovate⁴. Finally, in its 2011 IPR strategy for Europe⁵, the Commission announced a review of the trade mark system in Europe with a view to modernising the system, both at EU and at national level, by making it more effective, efficient and consistent overall.

1.2. Aim of the proposal

Considered together as a package, the main common objective of this initiative and of the parallel proposal for recast of the Directive is to foster innovation and economic growth by making trade mark registration systems all over the EU more accessible and efficient for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal security. These adjustments dovetail with efforts to ensure coexistence and complementarity between the Union and national trade mark systems.

As regards this initiative to revise the Regulation, the Commission is not proposing a new system, but well-targeted modernisation of existing provisions, with these main aims:

- Adapting terminology to the Lisbon Treaty and provisions to the Common Approach on decentralised agencies (see section 5.1);
- Streamlining procedures to apply for and register a European trade mark (see section 5.2);
- Increasing legal certainty by clarifying provisions and removing ambiguities (see section 5.3);
- Establishing an appropriate framework for cooperation between OHIM and national offices for the promoting convergence of practices and developing common tools (see section 5.4);
- Aligning the framework to Article 290 of the Treaty on the Functioning of the European Union (TFEU) (see section 5.5).

² Communication from the Commission: "Think Small First", A "Small Business Act" for Europe - COM(2008) 394 final of 25 June 2008.

³ COM(2008) 465 final of 16 July 2008.

⁴ COM(2010)546 final of 6 October 2010.

⁵ A Single Market for Intellectual Property Rights: Boosting creativity and innovation to provide economic growth, high quality jobs and first class products and services in Europe - COM(2011) 287.

2. RESULTS OF CONSULTATIONS WITH INTERESTED PARTIES AND IMPACT ASSESSMENT

2.1. Public consultation

This initiative is based on an evaluation of the way the trade mark system works in Europe as a whole and of extensive consultations with all major stakeholders involved.

The main component of the evaluation was a study the Max Planck Institute for Intellectual Property and Competition Law undertook on behalf of the Commission. The study was carried out between November 2009 and February 2011⁶. In addition to expert analysis, the study involved consultations with various stakeholders. It included a survey among users of the Community trade mark system, contributions from organisations representing trade mark users at national, European and international level and a hearing in June 2010 involving these organisations. Lastly, the Institute consulted the National Offices of all the Member States and OHIM.

The Final Report concluded that the basics of the European trade mark system are solid. In particular, the procedures followed by OHIM generally met business needs and expectations. There was further consensus that the coexistence of Community and national trade mark rights is fundamental and necessary for the efficient functioning of a trade mark system that meets the requirements of companies of different sizes, markets and geographical needs. The Report nevertheless found that further convergence of trade mark laws and practices in the EU was required. It confirmed that many aspects of the current Community trade mark system were working well, and made a large number of proposals for improvement. It identified specific areas in which the OHIM and National Offices could enhance their cooperation.

Responding to the interim results of the study, the Council adopted Conclusions on 25 May 2010⁷. These endorsed the agreement reached in September 2008 within the OHIM governing bodies (Administrative Board and Budget Committee) on a set of budgetary measures intended to better balance OHIM's budget in the future. The Council agreed that these budgetary measures also contributed to modernising, streamlining, harmonising and strengthening the trade mark system in Europe as a whole. It called on the Commission to include in the revision the introduction of a specific provision to define the framework for cooperation between OHIM and the National Offices. This should make explicit that all EU trade mark offices should pursue harmonisation of practices and that the OHIM should facilitate their efforts to this end. It also called for the creation of a legal basis for distributing an amount equal to 50% of OHIM's renewal fees to National Offices to be used for protecting, promoting and/or enforcing trade marks.

As a follow-up to the study, the Commission services convened a hearing of user associations on 26 May 2011. The results shaped and confirmed the Commission's preliminary analysis.

⁶ See the final MPI study, including annexes, at http://ec.europa.eu/internal_market/indprop/tm/index_en.htm.

⁷ Competitiveness Council Conclusions of 25 May 2010 on the future revision of the Trade Mark system in the EU, OJ C 140, 29.5.2010, p.22.

2.2. Impact Assessment

The impact assessment identified one main problem the revised Regulation needs to address: the low level of cooperation among trade mark offices in Europe. As explained in the impact assessment, there are many links between the Community trade mark and national trade mark regimes, with direct consequences for both trade mark users and intellectual property offices. These require a certain level of complementarity between the two systems. To achieve and ensure this, OHIM and National Offices should cooperate closely.

Efficient and effective cooperation between trade mark offices in Europe is currently seriously hindered by a number of obstacles:

- Lack of a clear legal basis for cooperation on EU trade mark legislation
- Lack of technical facilities in National Offices
- Lack of sustainable financing in the medium to long term.

The following options were considered to solve these problems and to achieve three corresponding objectives.

1. Providing an adequate legal basis for cooperation:
 - (a) Option 1: No specific legal basis for cooperation between intellectual property offices in Europe;
 - (b) Option 2: Legal basis allowing National Offices and OHIM to cooperate with one another (optional cooperation);
 - (c) Option 3: Legal basis obliging National Offices and OHIM to cooperate with one another (mandatory cooperation).
2. Technical capacity building at National Offices:
 - (a) Option 1: Each office to procure and develop the required facilities and tools;
 - (b) Option 2: Optional access to tools: the required facilities and tools accessible to IP offices within a framework of voluntary cooperation;
 - (c) Option 3: Mandatory access to tools: the required facilities accessible through a compulsory cooperation framework. This option overlaps with option 3 above regarding an adequate legal basis and option 3 below on long-term financing of cooperation activities.
3. Securing long-term financing for cooperation activities:
 - (a) Option 1: Financing from Member States;
 - (b) Option 2: Financing from EU budget;
 - (c) Option 3: Financing from OHIM budget.

The impact assessment concluded that option 3 would in all cases be proportionate and best suited to achieving the objectives pursued.

3. LEGAL BASIS AND SUBSIDIARITY

In the context of the establishment and functioning of the internal market, Article 118(1) TFEU provides for the creation of European intellectual property rights to provide uniform protection for these rights throughout the EU, including the setting up of centralised Union-wide authorisation, coordination and supervision arrangements.

The Community trade mark is a self-standing EU intellectual property title created by an EU Regulation. The analysis carried out as part of the impact assessment proved that parts of the Regulation need to be changed to improve and streamline the Community trade mark system. Only the EU legislator has the competence to make the amendments needed.

4. BUDGETARY IMPLICATION

The proposal will not have an impact on the European Union budget and is therefore not accompanied by the financial statement required under Article 31 of the Financial Regulation (Regulation (EC, Euratom) No 966/2012 of the European Parliament and of the Council of 25 October 2012 on the financial rules applicable to the general budget of the Union and repealing Council Regulation (EC, Euratom) No 1605/2002).

5. DETAILED EXPLANATION OF THE PROPOSAL

The proposed amendments to the Regulation are presented according to the objectives set out in section 1.2 above.

5.1. Adaptation of terminology and Common approach on Union decentralised agencies

As a consequence of the entry into force of the Lisbon Treaty, the terminology of the Regulation is updated. This means changing ‘Community trade mark’ to ‘European trade mark’.

There is a range of measures to improve the governance and efficiency of existing agencies and agencies yet to be established in the common approach on decentralised agencies, agreed by the European Parliament, the Council and the Commission in July 2012. The Regulation needs to be adapted to take into account the common approach as regards its provisions on OHIM. Regarding the name of the agency, it is proposed to rename it as the ‘European Union Trade Marks and Designs Agency’ (hereinafter ‘the Agency’), to enhance the functions of its Management Board, to align selection procedures for senior officials and to provide for annual and multi-annual work programmes and regular evaluations.

5.2. Streamlining procedures

- Filing of applications (Article 25)

National Offices hardly ever receive applications for European trade marks any more. Almost all applications (96,3% in 2012) are now directly filed through the OHIM’s e-filing system. In

the light of this situation, given that applications can now easily be filed on line, the option for filing these at National Offices should be abolished.

- Filing date (Article 27)

Most European trade mark applications are nowadays examined before the expiry of the one-month period before applicants have to pay the application fee. This allows applicants to file ‘test applications’ and not to pay the fee if a deficiency or objection is raised by the Agency. Payments via current accounts are deemed to be have been made on the last day of the month, if applicants so wish. Article 27 is therefore amended to abolish the one-month period and to link the ‘obligation’ to pay with the filing of the application, so that applicants will have to provide evidence that they submitted or authorised their payment when they filed their application.

- Searches (Articles 38 and 155)

The present regimes on searches provide neither a reliable trade mark clearance tool, nor fully comprehensive monitoring of the Register. The weaknesses of national and EU searches have become more acute over time, while IT advances nowadays mean users can have access to better, faster and cheaper alternatives. Applicants now have very little interest in obtaining the results of national searches from National Offices taking part in the optional system. The Agency is in the process of developing, together with National Offices, a number of promising tools that offer far better means of conducting priority searches and monitoring the registry for infringements. Current search regimes are therefore abolished.

- Publication of the application (Article 39)

Abolishing the search system will also make it possible to abolish the current one-month period between the Agency notifying the applicant of search reports and publication of the application. This will speed up the registration procedure.

- Observations by third parties (Article 40)

To facilitate the submission of observations by third parties, Article 40 is amended by extending the period over which observations can be filed. The reference to the publication date is to be deleted, taking into account that European trade mark applications are already made available to the public in the Agency’s trade mark database ‘CTM online’ within a few days of filing. To streamline proceedings, third parties will be given the opportunity to file observations as soon as they become aware of an application. The deadline for filing observations will be at the end of the opposition period or once opposition proceedings have concluded, following current Agency practice.

- Revision of decisions *inter partes* (Article 62)

Article 62 has turned out to be of no practical relevance. Not a single *inter partes* decision has been revised under this provision to date. The main reason is that the other party has no interest in giving the approval required by Article 62(2). Given that there are sufficient remedies to correct an erroneous *inter partes* decision, Article 62 is deleted.

- Continuation of proceedings (Article 82)

The application of Article 82 has led to some problems in practice and gave rise to a Communication of the President of the Agency, No 06/05⁸. Article 82 is amended to streamline its application and to incorporate the contents of that Communication. As both Article 25(3) and Article 62 are deleted, all mentions of them are also deleted from the list of excluded time limits. The mention of Article 42 is also deleted to enable all time limits in opposition proceedings to continue, with the exception of the opposition period laid down in Article 41(1) and the period for payment of the opposition fee set out in Article 41(3).

- Opposition period for International Registrations (Article 156)

As there is no need to maintain the six-month-long period currently provided for, Article 156 is amended to shorten the time between publication under Article 152(1) and the start of the opposition period for international registrations to one month.

5.3. Increasing legal certainty

- Definition of a European trade mark (Article 4)

Article 4 is amended to remove the requirement of ‘graphic representability’. The prerequisite that it should be possible to produce a graphic representation of the sign applied for is out of date. It creates a great deal of legal uncertainty with regard to certain non-traditional marks, such as mere sounds. In the latter cases, representation by other than graphical means (e.g. by a sound file) may even be preferable to graphic representation, if it permits a more precise identification of the mark and thereby serves the aim of enhanced legal certainty. The proposed new definition leaves the door open to registering matter that can be represented by technological means offering satisfactory guarantees. The idea is not to go for a boundless extension of the admissible ways to represent a sign but to provide for more flexibility in that respect while ensuring greater legal certainty.

- Protection of geographical indications and traditional terms (Article 7)

Article 7(1)(j) and (k) do not offer the same degree of protection to geographical indications as provided in the following:

- Articles 13 and 14 of Regulation (EU) No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs⁹;
- Articles 118l and 118m of Regulation (EC) No 1234/2007 of 22 October 2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products, as amended by Regulation (EC) No 491/2009 of 25 May 2009¹⁰;
- Article 16 of Regulation (EC) No 110/2008 of 15 January 2008 on the protection of geographical indications of spirit drinks¹¹.

⁸ OJ OHIM 2005, p. 1402.

⁹ OJ L 343, 14.12.2012, p. 1.

¹⁰ OJ L 154, 17.6.2009, p. 1.

¹¹ OJ L 39, 13.2.2008, p. 16.

To ensure that EU law protecting geographical indications is given full effect in proceedings relating to the registration of European trade marks, the relevant absolute grounds for refusal are fully aligned with the EU law on geographical indications and streamlined in the Regulation. Moreover, for reasons of coherence, grounds for refusal are extended to cover protected traditional terms for wine and traditional specialities guaranteed.

- Rights conferred by a European trade mark (Articles 9 and 9a)

1. Rights conferred without prejudice to prior rights

Neither the Regulation nor the Directive contains a clear rule stating that the trade mark proprietor cannot successfully invoke his rights against the use of an identical or similar sign which is already the subject of an earlier right. In line with Article 16(1) of the TRIPS Agreement¹², Article 9 of the Regulation is amended to clarify that infringement claims are without prejudice to earlier rights.

2. Cases of double identity

The recognition of additional trade mark functions under Article 5(1)(a) of the Directive (Article 9(1)(a) of the Regulation) has created legal uncertainty. In particular, the relationship between double identity cases and the extended protection afforded by Article 5(2) of the Directive (Article 9(1)(c) of the Regulation) to trade marks having a reputation has become unclear¹³. In the interest of legal certainty and consistency, it is clarified that in cases of both double identity under Article 9(1)(a) and similarity under Article 9(1)(b) it is only the origin function which matters.

3. Use as a trade or company name

According to the Court of Justice¹⁴, Article 5(1) of the Directive is applicable where the public considers the use of a company name as (also) relating to the goods or services offered by the company. It is therefore appropriate to treat trade name use of a protected trade mark as an infringing act, if the requirements of use for goods or services are met.

4. Use in comparative advertising

Directive 2006/114/EC of 12 December 2006 concerning misleading and comparative advertising¹⁵ regulates the conditions under which advertising, which explicitly or by implication identifies a competitor or goods or services offered by a competitor, is permissible. The relationship of this instrument to the legislation on trade marks has given rise to doubts. It is therefore appropriate to clarify that the trade mark owner may prevent the use of his trade mark in comparative advertising where such comparative advertising does not satisfy the requirements of Article 4 of Directive 2006/114/EC.

5. Consignments from commercial suppliers

¹² Agreement on Trade-Related Aspects of Intellectual Property Rights, OJ L 336, 23.12.1994, p. 213.

¹³ Opinion of AG Jääskinen in Case C-323/09, *Interflora*, para. 9.

¹⁴ Judgment of 11 September 2007, Case C-17/06, *Céline*, ECR I-07041.

¹⁵ OJ L 376, 27.12.2006, p. 21.

Amendments are proposed to clarify that goods may not be imported into the EU even if only the consignor is acting for commercial purposes. This is to ensure that a trade mark owner has the right to prevent businesses (whether located in the EU or not) from importing goods located outside the EU that have been sold, offered, advertised or shipped to private consumers, and to discourage the ordering and sale of counterfeit goods over the internet.

6. Goods brought into the customs territory

According to the Court of Justice in the *Philips/Nokia* judgment¹⁶, the entry, presence and movement of non-EU goods in the customs territory of the EU under a suspensive procedure does, under the existing *acquis*, not infringe intellectual property rights as conferred by substantive law of the Union and its Member States. Such goods can only be classified as counterfeit once there is proof that they are subject of a commercial act directed at EU consumers, such as sale, offer for sale or advertising. The implications of the *Philips/Nokia* judgment have met with strong criticism from stakeholders as placing an inappropriately high burden of proof on rights holders, and hindering the fight against counterfeiting. It is evident that there is an urgent need to have in place a European legal framework enabling a more effective fight against the counterfeiting of goods as a fast-growing activity. It is therefore proposed to fill the existing gap by entitling right holders to prevent third parties from bringing goods, from third countries, bearing without authorization a trade mark which is essentially identical to the trade mark registered in respect of those goods, into the customs territory of the Union, regardless of whether they are released for free circulation.

7. Preparatory acts

Neither the Regulation nor the Directive contains any provisions allowing proceedings against the distribution and sale of labels and packaging or similar items which may subsequently be combined with illicit products. Some national laws have explicit rules covering this activity. Including a rule on this in the Regulation and the Directive is appropriate to provide another practical, relevant and efficient contribution to the combat against counterfeiting.

- Limitation of the effects of a European trade mark (Article 12)

The limitation in Article 12(1)(a) is restricted to cover the use of personal names only in accordance with the Joint Statement of the Council and the Commission¹⁷. For reasons of consistency, the limitation in Article 12(1)(b) is extended to cover the use of non-distinctive signs or indications. It is also considered appropriate to provide in Article 12(1)(c) an explicit limitation covering referential use in general. Finally, a separate paragraph clarifies the conditions under which use of a trade mark is not considered as complying with honest business practices.

- Designation and classification of goods and services (Article 28)

Article 28 is amended to provide essential rules concerning the designation and classification of goods and services in the Regulation. These rules are introduced into the Directive. They

¹⁶ Judgment of 1 December 2011, Cases C-446/09 *Philips* and C-495/09 *Nokia*.

¹⁷ Joint statements by the Council and the Commission of the European Communities entered in the minutes of the Council meeting, on the first Council Directive approximating the laws of the Member States on trade marks adopted on 21 December 1988.

follow the principles established by the Court of Justice¹⁸ according to which goods and services for which protection is sought need to be identified by the applicant with sufficient clarity and precision to enable the relevant authorities and businesses to determine the extent of protection the trade mark confers. The general indications of the class heading of the Nice Classification may be used to identify goods or services provided that such identifications are sufficiently clear and precise. The amendment clarifies that the use of general terms has to be interpreted as including all goods or services clearly covered by the literal meaning of the term. Finally, the amendment allows proprietors of European trade marks which were filed before the date of publication of the Agency's new classification practice¹⁹ to adapt their specifications of goods and services in accordance with the case law of the Court of Justice in order to ensure that the content of the register meets the requisite standard of clarity and precision.

- European certification marks (Articles 74b - 74k)

While various national systems offer protection for certification marks, the European trade mark system currently provides only for the registration of individual and collective marks. Some public and private bodies that do not meet the conditions to be eligible to obtain collective trade mark protection also need a system for protection of certification marks at EU level. Such a system would also remedy the current imbalance between national systems and the European trade mark system. It is proposed to add to the Regulation a specific set of rules covering the registration of European certification marks.

- Tasks of the Agency (Article 123b)

To ensure comprehensive cover, legal certainty and greater transparency, all the Agency's tasks are defined in the new Article 123b, including those which stem from other legal acts and are not related to the EU trade mark system.

5.4. Framework for cooperation (Article 123c)

Article 123c provides a clear framework for mandatory cooperation between the Agency and Member State intellectual property offices with the aim of promoting convergence of practices and the development of common tools. It states that the Agency and Member State offices are obliged to cooperate, and stipulates the main areas for cooperation and specific common projects of Union interest the Agency will coordinate. It further sets up a funding mechanism enabling the Agency to finance those common projects by means of grants. This funding scheme represents a legally and financially feasible alternative to the approach suggested by the Council in its May 2010 Conclusions.

5.5. Alignment to Article 290 TFEU

The Regulation confers powers on the Commission in order to adopt certain rules. Those rules are currently provided in the Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark²⁰, Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the

¹⁸ Judgment of 19 June 2012, Case C-307/10, '*IP Translator*'.

¹⁹ Communication No 2/12 of the President of the Office, OJ OHIM 7/2012.

²⁰ OJ L 303, 15.12.1995, p. 1.

Office for Harmonisation in the Internal Market²¹, and Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market²². The entry into force of the Lisbon Treaty makes it necessary to align the powers conferred upon the Commission under the Regulation to Article 290 of the Treaty (new Articles 24a, 35a, 45a, 49a, 57a, 65a, 74a, 74k, 93a, 114a, 144a and 161a).

²¹ OJ L 303, 15.12.1995, p. 33.

²² OJ L 28, 6.2.1996, p. 11.

Proposal for a

REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL
amending Council Regulation (EC) No 207/2009 on the Community trade mark

(Text with EEA relevance)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty on the Functioning of the European Union, and in particular Article 118(1) thereof,

Having regard to the proposal from the European Commission,

After transmission of the draft legislative act to the national Parliaments,

Acting in accordance with the ordinary legislative procedure,

Whereas:

- (1) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark¹, in 2009 codified as Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark², created a system of trade mark protection specific for the European Union which provided for the protection of trade marks at the level of the European Union, in parallel to the protection of trade marks available at the level of the Member States according to the national trade mark systems harmonized by Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks³, codified as 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 marks⁴.
- (2) As a consequence of the entry into force of the Lisbon Treaty, the terminology of Regulation (EC) No 207/2009 should be updated. This implies the replacement of 'Community trade mark' by 'European trade mark'. In line with the Common approach on decentralised Agencies, agreed in July 2012 by the European Parliament, the Council and the Commission, the name 'Office for Harmonisation in the Internal

¹ OJ C 146 E, 12.6.2008, p. 79.

² OJ L 78, 24.3.2009, p. 1.

³ OJ L 40, 11.2.1989, p. 1.

⁴ OJ L 299, 8.11.2008, p. 25.

Market (trade marks and designs) ' should be replaced by 'European Union Trade Marks and Designs Agency' (hereinafter 'the Agency').

- (3) Further to the Commission's Communication of 16 July 2008 on an Industrial Property Rights Strategy for Europe⁵, the Commission carried out a comprehensive evaluation of the overall functioning of the trade mark system in Europe as a whole, covering Union and national levels and the interrelation between each other.
- (4) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union⁶, the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC.
- (5) The experience acquired since the establishment of the Community trade mark system has shown that undertakings from within the Union and from third countries have accepted the system, which has become a successful and viable alternative to the protection of trade marks at the level of the Member States.
- (6) National trade marks continue nevertheless to be necessary for those undertakings which do not want protection of their trade marks at Union level or which are unable to obtain Union-wide protection while national protection does not face any obstacles. It should be left to the decision of each person seeking trade mark protection whether the protection is sought only as a national mark in one or more Member States, or only as a European trade mark, or both.
- (7) While the evaluation of the overall functioning of the Community trade mark system confirmed that many aspects of that system, including the fundamental principles on which it is based, have stood the test of time and continue meeting business needs and expectations, the Commission concluded in its Communication 'A Single Market for Intellectual Property Rights' of 24 May 2011⁷ that there is a necessity to modernise the trade mark system in the Union by making it more effective, efficient and consistent as a whole and adapting it to the Internet era.
- (8) In parallel to the improvements and amendments of the Community trade mark system, national trade mark laws and practices should be further harmonised and brought in line with the Union trade mark system to the extent appropriate in order to create as far as possible equal conditions for the registration and protection of trade marks throughout the Union.
- (9) In order to allow for more flexibility while ensuring greater legal certainty with regard to the means of representation of trade marks, the requirement of graphic representability should be deleted from the definition of a European trade mark. A sign should be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the representation enables the competent authorities and the public to determine with precision and clarity the precise subject matter of protection.

⁵ COM(2008) 465.

⁶ OJ C 140, 29.5.2010, p. 22.

⁷ COM(2011) 287.

- (10) The current provisions of Regulation (EC) No 207/2009 fall short of offering the same degree of protection to designations of origin and geographical indications as other instruments of Union law. It is therefore necessary to clarify the absolute grounds for refusal concerning designations of origin and geographical indications and to ensure full consistency with relevant Union legislation providing for protection of those intellectual property titles. For reasons of coherence with other Union legislation, the scope of those absolute grounds should be extended to cover also protected traditional terms for wine and traditional specialities guaranteed.
- (11) Trade marks applied for in a script or language not intelligible in the Union should not deserve protection if their registration would have to be refused on absolute grounds when translated or transcribed in any official language of the Member States.
- (12) It is appropriate to make the dishonest appropriation of trade marks more difficult by extending the possibilities to oppose European trade mark applications filed in bad faith.
- (13) With the aim of maintaining strong protection of rights in designations of origin and geographical indications protected at Union level, it is necessary to clarify that those rights entitle to bring an opposition against the registration of a later European trade mark, regardless of whether or not they are also grounds for refusal to be taken into account ex officio by the examiner.
- (14) In order to ensure legal certainty and full consistency with the principle of priority, under which an earlier registered trade mark takes precedence over later registered trade marks, it is necessary to lay down that the enforcement of rights conferred by a European trade mark should be without prejudice to the rights of proprietors acquired prior to the filing or priority date of the European trade mark. This is in conformity with Article 16(1) of the Agreement on trade related aspects of intellectual property rights of 15 April 1994⁸.
- (15) In order to ensure legal certainty and clarity, it is necessary to clarify that not only in the case of similarity but also in case of an identical sign being used for identical goods or services, protection should be granted to a European trade mark only if and to the extent that the main function of the European trade mark, which is to guarantee the commercial origin of the goods or services, is adversely affected.
- (16) Confusion as to the commercial source from which the goods or services emanate may occur when a company uses the same or a similar sign as a trade name in a way that a link is established between the company bearing the name and the goods or services coming from that company. Infringement of a European trade mark should therefore also comprise the use of the sign as a trade name or similar designation as long as the use is made for the purposes of distinguishing goods or services as to their commercial origin.
- (17) In order to ensure legal certainty and full consistency with specific Union legislation, it is appropriate to provide that the proprietor of a European trade mark should be

⁸ OJ L 336, 23.12.1994, p. 214.

entitled to prohibit a third party from using a sign in a comparative advertising where such comparative advertising is contrary to Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising⁹.

- (18) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a European trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Union without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is essentially identical to the European trade mark registered in respect of such goods.
- (19) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor should be entitled to prohibit the importing of such goods into the Union, where it is only the consignor of the goods who acts for commercial purposes.
- (20) In order to enable proprietors of European trade marks to fight counterfeiting more effectively, they should be entitled to prohibit the affixing of an infringing mark to goods and preparatory acts prior to the affixing.
- (21) The exclusive rights conferred by a European trade mark should not entitle the proprietor to prohibit the use of signs or indications which are used fairly and in accordance with honest practices in industrial and commercial matters. In order to create equal conditions for trade names and trade marks in case of conflicts against the background that trade names are regularly granted unrestricted protection against later trade marks, such use should be considered to include the use of one's own personal name only. It should further include the use of descriptive or non-distinctive signs or indications in general. Moreover, the proprietor should not be entitled to prevent the general fair and honest use of the European trade mark for identifying or referring to the goods or services as those of the proprietor.
- (22) In order to ensure legal certainty and safeguard trade mark rights legitimately acquired, it is appropriate and necessary to lay down, without affecting the principle that the later trade mark cannot be enforced against the earlier trade mark, that proprietors of European trade marks should not be entitled to oppose the use of a later trade mark when the later trade mark was acquired at a time when the earlier trade mark could not be enforced against the later trade mark.
- (23) For reasons of equity and legal certainty the use of a European trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered should be sufficient to preserve the rights conferred regardless of whether the trade mark in the form as used is also registered.
- (24) Regulation (EC) No 207/2009 confers powers on the Commission in order to adopt rules implementing that Regulation. As a consequence of the entry into force of the Lisbon Treaty, the powers conferred upon the Commission under Regulation (EC) No

⁹ OJ L 376, 27.12.2006, p. 21.

207/2009 need to be aligned to Article 290 of the Treaty on the Functioning of the European Union.

- (25) It is of particular importance that the Commission carry out appropriate consultations during its preparatory work, including at expert level. The Commission, when preparing and drawing-up delegated acts, should ensure a simultaneous, timely and appropriate transmission of relevant documents to the European Parliament and Council.
- (26) In order to ensure the efficient registration of legal acts concerning the European trade mark as object of property and ensure full transparency of the register of European trade marks, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying certain obligations of the applicant regarding specific trade marks, the details on the procedures for entering the transfer of European trade marks, the creation and transfer of a right in rem, the levy of execution, the involvement in an insolvency procedure and the grant or transfer of a licence in the Register and for cancelling or modifying relevant entries.
- (27) In view of the gradual decline and insignificant number of Community trade mark applications filed at the central intellectual property offices of the Member States ('the offices of the Member States'), it should be only allowed to file a European trade mark application at the Agency.
- (28) European trade mark protection is granted in relation to specific goods or services whose nature and number determine the extent of protection afforded to the trade mark owner. It is therefore essential to establish rules for the designation and classification of goods and services in Regulation (EC) No 207/2009 and to ensure legal certainty and sound administration by requiring that the goods and services for which trade mark protection is sought are identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on the basis of the application alone, to determine the extent of the protection applied for. The use of general terms should be interpreted as including only all goods and services clearly covered by the literal meaning of the term. Proprietors of European trade marks, which because of the previous practice of the Agency are registered in respect of the entire heading of a class of the Nice Classification, should be given the possibility to adapt their specifications of goods and services in order to ensure that the content of the register meets the requisite standard of clarity and precision in accordance with the case law of the Court of Justice of the European Union.
- (29) In order to provide for an effective and efficient regime for the filing of European trade mark applications including priority and seniority claims, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the means and modalities of filing a European trade mark application, the details regarding the formal conditions of a European trade mark application, the content of that application, the type of application fee, as well as the details on the procedures for ascertaining reciprocity, claiming the priority of a previous application, an exhibition priority and the seniority of a national trade mark.

- (30) The current regime of European trade mark and national searches is neither reliable nor efficient. It should therefore be replaced by the making available of all-encompassing, fast and powerful search engines for the free use of the public within the context of cooperation between the Agency and the offices of the Member States.
- (31) In order to ensure an effective, efficient and expeditious examination and registration of European trade mark applications by the Agency using procedures which are transparent, thorough, fair and equitable, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the details on the procedures related to the examination of compliance with the requirements on the filing date and with the formal conditions of an application, the procedures for verifying payment of class fees and the examination of absolute grounds for refusal, the details concerning the publication of the application, the procedures for correcting mistakes and errors in publications of applications, the details on the procedures related to third party observations, the details on the opposition procedure, the details on the procedures for filing and examining an opposition and those governing the amendment and division of the application, the particulars to be recorded in the Register when registering a European trade mark, the modalities of publication of the registration and the content and modalities of issue of a certificate of registration.
- (32) In order to allow European trade marks to be renewed in an effective and efficient manner and to safely apply the provisions on the alteration and the division of a European trade mark in practice without compromising legal certainty, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the modalities for the renewal of a European trade mark and procedures governing the alteration and division of a European trade mark.
- (33) In order to permit the proprietor of a European trade mark to easily surrender a European trade mark, while respecting the rights of third parties entered in the register in relation to that mark, and to ensure that a European trade mark can be revoked or declared invalid in an effective and efficient way by means of transparent, thorough, fair and equitable procedures, and to take into account the principles laid down in this Regulation, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the procedure governing the surrender of a European trade mark as well as the procedures for revocation and invalidity.
- (34) In order to allow for an effective, efficient and complete review of decisions of the Agency by the Boards of Appeal by means of a transparent, thorough, fair and equitable procedure which takes into account the principles laid down in Regulation (EC) No 207/2009, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the details on the content of the notice of appeal, the procedure for the filing and examination of an appeal, the content and form of the Board of Appeal's decisions and the reimbursement of the appeal fees.
- (35) As a complement to the existing provisions on Community collective marks and to remedy the current imbalance between national systems and the European trade mark

system, it is necessary to add a set of specific provisions for the purpose of providing protection to European certification marks which allow a certifying institution or organisation to permit adherents to the certification system to use the mark as a sign for goods or services complying with the certification requirements.

- (36) In order to allow for an effective and efficient use of European collective and certification marks, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the periods for submitting the regulations governing the use of those marks and the content thereof.
- (37) The experience gained in the application of the current system of Community trade marks revealed the potential for improvement of certain aspects of procedure. Consequently, certain measures should be taken to simplify and speed up procedures where appropriate and to enhance legal certainty and predictability where required.
- (38) In order to ensure a smooth, effective and efficient operation of the European trade mark system, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the requirements as to the form of decisions, the details on oral proceedings and the modalities of taking of evidence, the modalities of notification, the procedure for the noting of loss of rights, the means of communication and the forms to be used by the parties to proceedings, the rules governing the calculation and duration of time limits, the procedures for the revocation of a decision or for cancellation of an entry in the Register and for the correction of obvious errors in decisions and errors attributable to the Agency, the modalities of the interruption of proceedings and the procedures concerning the apportionment and fixing of costs, the particulars to be entered in the Register, the details concerning the inspection and keeping of files, the modalities of publications in the European Trade Marks Bulletin and in the Official Journal of the Agency, the modalities of administrative cooperation between the Agency and the authorities of Member States, and the details on representation before the Agency.
- (39) For reasons of legal certainty and greater transparency, it is appropriate to clearly define all the tasks of the Agency including those which are not related to the management of the Union trade mark system.
- (40) With the aim of promoting convergence of practices and of developing common tools, it is necessary to establish an appropriate framework for cooperation between the Agency and the offices of the Member States, clearly defining the areas of cooperation and enabling the Agency to coordinate relevant common projects of Union interest and to finance, up to a maximum amount, those common projects by means of grants. Those cooperation activities should be beneficial for undertakings using trade mark systems in Europe. For users of the Union regime laid down in this Regulation, the common projects, particularly the databases for search and consultation purposes, should provide additional, inclusive, efficient and free of charge tools to comply with the specific requirements flowing from the unitary character of the European trade mark.

- (41) Certain principles regarding the governance of the Agency should be adapted to the Common Approach on EU decentralised agencies adopted by the European Parliament, the Council and the Commission in July 2012.
- (42) In the interest of greater legal certainty and transparency, it is necessary to update some provisions concerning the organization and functioning of the Agency.
- (43) In the interest of sound financial management, the accumulation of significant budgetary surpluses should be avoided. This should be without prejudice to the Agency maintaining a financial reserve covering one year of its operational expenditure to ensure the continuity of its operations and the execution of its tasks.
- (44) In order to allow for an effective and efficient conversion of an application or registration of a European trade mark into a national trade mark application while ensuring a thorough examination of the relevant requirements, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the formal conditions with which a request for conversion must comply and the details of its examination and publication.
- (45) In order to ensure an effective and efficient method to resolve disputes, to ensure consistency with the language regime laid down in Regulation (EC) No 207/2009, the expeditious delivery of decisions on a simple subject matter, and the effective and efficient organisation of the Boards of Appeal, and to guarantee an appropriate and realistic level of fees to be charged by the Agency, while complying with the budgetary principles set out in Regulation (EC) No 207/2009, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the details on the languages to be used before the Agency, the cases where opposition and cancellation decisions should be taken by a single member, the details on the organisation of the Boards of Appeal, the amounts of the fees to be paid to the Agency and details related to their payment.
- (46) In order to ensure the effective and efficient registration of international trade marks in full consistency with the rules of the Protocol relating to the Madrid Agreement concerning the international registration of marks, the power to adopt delegated acts in accordance with Article 290 of the Treaty should be delegated to the Commission in respect of specifying the details on the procedures concerning the international registration of trade marks.
- (47) Regulation (EC) No 207/2009 should therefore be amended accordingly.

HAVE ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 207/2009 is amended as follows:

- (1) In the title, 'Community trade mark' is replaced by 'European trade mark';
- (2) Throughout the Regulation, the words 'Community trade mark' are replaced by 'European trade mark' and any necessary grammatical changes are made;

- (3) Throughout the Regulation, the words 'Community trade mark court' are replaced by 'European trade mark court' and any necessary grammatical changes are made;
- (4) Throughout the Regulation, the words 'Community collective mark' are replaced by 'European collective mark' and any necessary grammatical changes are made;
- (5) Throughout the Regulation, except in the cases referred to in points (2), (3) and (4), the words 'Community', 'European Community' and 'European Communities' are replaced by 'Union' and any necessary grammatical changes are made;
- (6) Throughout the Regulation, the word 'Office', insofar as it refers to the Office for Harmonisation in the Internal Market (trade marks and designs) provided for in Article 2 of the Regulation, is replaced by 'Agency' and any necessary grammatical changes are made;
- (7) Throughout the Regulation, the word 'President' is replaced by 'Executive Director' and any necessary grammatical changes are made;
- (8) Article 2 is replaced by the following:

'Article 2

Agency

1. A European Union Trade Marks and Designs Agency, hereinafter referred to as 'the Agency', is hereby established.

2. All references in Union law to the Office for Harmonisation in the Internal Market (trade marks and designs) shall be read as references to the Agency.';

- (9) Article 4 is replaced by the following:

'Article 4

Signs of which a European trade mark may consist

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

(a) distinguishing the goods or services of one undertaking from those of other undertakings;

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

- (10) Article 7 is amended as follows:

(a) In paragraph 1, points (j) and (k) are replaced by the following:

'(j) trade marks which are excluded from registration and shall not continue to be used pursuant to Union legislation or international agreements to which the Union is party, providing for protection of designations of origin and geographical indications;

(k) 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;

(l) trade marks which contain or consist of an earlier variety denomination registered in accordance with Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights with respect to the same type of product.';

(b) paragraph 2 is replaced by the following:

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

(a) in only part of the Union;

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

(11) Article 8 is amended as follows:

(a) paragraph 3 is replaced by the following:

'3. Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered:

(a) where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;

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

(b) in paragraph 4, the introductory phrase is replaced by the following:

'4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to Union legislation providing for protection of designations of origin and geographical indications, or the law of the Member State governing that sign.'

(c) paragraph 5 is replaced by the following:

'5. Upon opposition by the proprietor of an earlier registered trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied are identical with, similar

to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.';

(12) Article 9 is replaced by the following:

'Article 9

Rights conferred by a European trade mark

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

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the European trade mark, the proprietor of a European trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign in relation to goods or services where:

- (a) the sign is identical with the European trade mark and is used in relation to goods or services which are identical with those for which the European trade mark is registered, and where such use affects or is liable to affect the function of the European trade mark to guarantee to consumers the origin of the goods or services;
- (b) the sign is identical, or similar to, the European trade mark and is used for goods or services which are identical with or similar to the goods or services for which the European trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
- (c) the sign is identical with, or similar to, the European trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the European trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the European trade mark.

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

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under that sign;
- (d) using the sign as a trade or company name or part of a trade or company name;
- (e) using the sign on business papers and in advertising;

(f) using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC.

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

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

(13) The following Articles 9a and 9b are inserted:

'Article 9a

Infringement of the rights of the proprietor by use of get-up, packaging or other means

Where it is likely that the get-up, packaging or other means to which the mark is affixed will be used for goods or services and the use in relation to those goods or services would constitute an infringement of the rights of the proprietor under Article 9(2) and (3), the proprietor of a European trade mark shall have the right to prohibit the following:

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

Article 9b

Date of prevailing of rights against third parties

1. The rights conferred by a European trade mark shall prevail against third parties from the date of publication of the registration of the trade mark.

2. Reasonable compensation may be claimed in respect of acts occurring after the date of publication of a European trade mark application, where those acts would, after publication of the registration of the trade mark, be prohibited by virtue of that publication.

3. The court seized of a case may not decide upon the merits of the case until the registration has been published.';

(14) Article 12 is replaced by the following:

'Article 12

Limitation of the effects of a European trade mark

1. A European trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) his own personal name or address;
- (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services;
- (c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular, where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

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

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

- (a) it gives the impression that there is a commercial connection between the third party and the proprietor of the trade mark;
- (b) it takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark without due cause.';

(15) In Article 13(1), the words 'in the Community' are replaced by 'in the European Economic Area'.

(16) The following Article 13a is inserted:

'Article 13a

Intervening right of the proprietor of a later registered trade mark as defence in infringement proceedings

1. In infringement proceedings, the proprietor of a European trade mark shall not be entitled to prohibit the use of a later registered European trade mark where that later trade mark shall not be declared invalid pursuant to Articles 53(3) and (4), 54(1) and (2) and 57(2).

2. In infringement proceedings, the proprietor of a European trade mark shall not be entitled to prohibit the use of a later registered national trade mark where that later registered national trade mark shall not be declared invalid pursuant to Articles 8, 9(1) and (2) and 48(3) of Directive [xxx].

3. Where the proprietor of a European trade mark shall not be entitled to prohibit the use of a later registered trade mark pursuant to paragraphs 1 or 2, the proprietor of

that later registered trade mark shall not be entitled to prohibit the use of that earlier European trade mark in infringement proceedings.';

- (17) In Article 15(1), the second subparagraph is replaced by the following:

'The following shall also constitute use within the meaning of the first paragraph:

- (a) use of the European trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered;
- (b) affixing of the European trade mark to goods or to the packaging thereof in the Union solely for export purposes.';

- (18) In Article 16(1), the introductory phrase is replaced by the following:

'1. Unless Articles 17 to 24 provide otherwise, a European trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Union, as a national trade mark registered in the Member State in which, according to the Register of European trade marks (hereinafter 'the Register'):';

- (19) In Article 17, paragraph 4 is deleted;

- (20) Article 18 is replaced by the following:

'Article 18

Transfer of a trade mark registered in the name of an agent

1. Where a European trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment of the European trade mark in his favour, unless such agent or representative justifies his action.

2. The proprietor may submit a request for assignment pursuant to paragraph 1 to the following:

- (a) the Agency, instead of an application for a declaration of invalidity based on Article 53(1)(b);
- (b) a European trade mark court as referred to in Article 95, instead of a counterclaim for a declaration of invalidity based on Article 100(1).';

- (21) Article 19 is amended as follows:

- (a) paragraph 2 is replaced by the following:

'2. On request of one of the parties, the rights referred to in paragraph 1 or the transfer of those rights shall be entered in the Register and published.';

- (b) the following paragraph 3 is added:

'3. An entry in the Register effected pursuant to paragraph 2 shall be cancelled or modified on request of one of the parties.';

(22) In Article 20, the following paragraph 4 is added:

'4. An entry in the Register effected pursuant to paragraph 3 shall be cancelled or modified on request of one of the parties.';

(23) In Article 22, the following paragraph 6 is added:

'6. An entry in the Register effected pursuant to paragraph 5 shall be cancelled or modified on request of one of the parties.';

(24) In Title II, the following Section 5 is inserted:

SECTION 5
Delegation of powers

Article 24a
Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the obligation of the applicant to provide a translation or transcription as referred to in Article 7(2)(b) in the language of the application;
- (b) the procedure for entering a transfer as referred to in Article 17(5) in the Register;
- (c) the procedure for entering the creation or transfer of a right *in rem* as referred to in Article 19(2) in the Register;
- (d) the procedure for entering levy of execution as referred to in Article 20(3) in the Register;
- (e) the procedure for entering the involvement in an insolvency procedure as referred to in Article 21(3) in the Register;
- (f) the procedure for entering the grant or transfer of a license as referred to in Article 22(5) in the Register;
- (g) the procedure for cancelling or modifying the entry in the Register of a right *in rem*, levy of execution or a license, as referred to in Articles 19(3), 20(4) and 22(6) respectively.';

(25) Article 25 is replaced by the following:

Article 25
Filing of applications

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

(26) Article 26 is amended as follows:

(a) in paragraph 1, point (d) is replaced by the following:

'(d) a representation of the mark which satisfies the requirements set out in Article 4(b).';

(b) paragraph 3 is replaced by the following:

'3. In addition to the requirements referred to in paragraphs 1 and 2, an application for a European trade mark shall comply with the formal conditions established in accordance with Article 35a(b). If those conditions provide for the trade mark to be represented electronically, the Executive Director of the Agency may determine the formats and maximum size of such an electronic file.';

(27) Article 27 is replaced by the following:

'Article 27

Date of filing

The date of filing of a European trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Agency by the applicant, subject to payment of the application fee for which the order for payment shall have been given at the latest on that date.';

(28) Article 28 is replaced by the following:

'Article 28

Designation and classification of goods and services

1. Goods and services in respect of which registration is applied for shall be classified in conformity with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (hereinafter referred to as the 'Nice Classification').

2. The goods and services for which the protection of the trade mark is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought. The list of goods and services shall allow each item to be classified in only one class of the Nice Classification.

3. For the purposes of paragraph 2, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision.

4. The Agency shall reject the application in respect of indications or terms which are unclear or imprecise, if the applicant does not suggest an acceptable wording within a period set by the Agency to that effect.

5. The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.

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.

7. The classification of goods and services shall serve exclusively administrative purposes. Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

8. Proprietors of European trade marks applied for before 22 June 2012 which are registered solely in respect of the entire heading of a Nice class, may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing.

The declaration shall be filed at the Agency within 4 months from the entry into force of this Regulation, and shall indicate, in a clear, precise and specific manner, the goods and services, other than those clearly covered by the literal meaning of the indications of the class heading, originally covered by the proprietor's intention. The Agency shall take appropriate measures to amend the Register accordingly. This possibility is without prejudice to the application of Articles 15, 42(2), 51(1)(a) and 57(2).

European trade marks for which no declaration is filed within the period referred to in the second subparagraph shall be deemed to extend, as from the expiry of that period, only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.';

(29) In Article 29(5), the following sentence is added:

'If necessary, the Executive Director of the Agency shall request the Commission to consider enquiring whether a State within the meaning of the first sentence accords that reciprocal treatment.';

(30) Article 30 is replaced by the following:

'Article 30

Claiming priority

1. Priority claims shall be filed together with the European trade mark application and shall include the date, number and country of the previous application.

2. The Executive Director of the Agency may determine that additional information and documentation to be provided by the applicant in support of the priority claim may consist of less than is required under the rules adopted in accordance with Article 35a(d), provided that the information required is available to the Agency from other sources.';

(31) Article 33 is amended as follows:

(a) in paragraph 1, the following sentence is added:

'The priority claim shall be filed together with the European trade mark application.';

(b) paragraph 2 is replaced by the following:

'2. An applicant who wishes to claim priority pursuant to paragraph 1 shall file evidence of the display of goods or services under the mark applied for.';

(32) In Article 34, paragraph 3 is replaced by the following:

'3. The seniority claimed for the European trade mark shall lapse where the earlier trade mark the seniority of which is claimed is declared to be invalid or revoked. Where the earlier trade mark is revoked, the seniority shall lapse provided that the revocation takes effect prior to the filing date or priority date of the European trade mark.';

(33) In Title III, the following Section 5 is inserted:

SECTION 5

Delegation of powers

Article 35a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the means and modalities of filing an application for a European trade mark with the Agency in accordance with Article 25;
- (b) the details regarding the content of the application for a European trade mark referred to in Article 26(1), the type of fees payable for the application referred to in Article 26(2), including the number of classes of goods and services covered by those fees, and the formal conditions of the application referred to in Article 26(3);
- (c) the procedures for ascertaining reciprocity in accordance with Article 29(5);
- (d) the procedure and the rules on information and documentation for claiming the priority of a previous application in accordance with Article 30;

- (e) the procedure and the rules on evidence for claiming an exhibition priority in accordance with Article 33(1);
 - (f) the procedure for claiming the seniority of a national trade mark in accordance with Article 34(1) and Article 35(1).';
- (34) In Article 36(1), point (b) is replaced by the following:
- '(b) the European trade mark application complies with the conditions laid down in this Regulation and with the formal conditions referred to in Article 26(3).';
- (35) In Article 37, paragraph 2 is deleted;
- (36) In Title IV, Section 2 is deleted;
- (37) Article 39 is amended as follows:
- (a) paragraph 1 is replaced by the following:
 - '1. If the conditions which the application for a European trade mark must satisfy have been fulfilled, the application shall be published for the purposes of Article 42 to the extent that it has not been refused pursuant to Article 37. The publication of the application shall be without prejudice to information already made available to the public otherwise in accordance with this Regulation or with delegated acts adopted pursuant to this Regulation.';
 - (b) the following paragraph 3 is added:
 - '3. The Agency shall correct any mistakes or errors in the publication of the application.';
- (38) Article 40 is replaced by the following:
- 'Article 40
Observations by third parties
1. Any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Agency written observations, explaining on which grounds under Articles 5 and 7, the trade mark shall not be registered ex officio.

They shall not be parties to the proceedings before the Agency.
 2. Third party observations shall be submitted before the end of the opposition period or, where an opposition against the trade mark has been filed, before the final decision on the opposition is taken.
 3. The submission referred to in paragraph 1 shall be without prejudice to the right of the Agency to re-open the examination of absolute grounds of its own initiative any time before registration, where appropriate.

4. The observations referred to in paragraph 1 shall be communicated to the applicant who may comment on them.';

(39) In Article 41, paragraph 3 is replaced by the following:

'3. Opposition shall be expressed in writing, and shall specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid.

4. Within a period fixed by the Agency, the opponent may submit facts, evidence and arguments in support of his case.';

(40) In Article 42(2), first sentence, the phrase 'during the period of five years preceding the date of publication' is replaced by 'during the period of five years preceding the date of filing or the date of priority';

(41) Article 44 is amended as follows:

(a) in paragraph 2, point (b) is replaced by the following:

'(b) before the date of filing referred to in Article 27 has been accorded by the Agency and during the opposition period provided for in Article 41(1).';

(b) paragraph 3 is deleted;

(42) Article 45 is replaced by the following:

'Article 45

Registration

1. Where an application meets the requirements of this Regulation and where no notice of opposition has been given within the period referred to in Article 41(1) or where opposition has been rejected by a final decision, the trade mark shall be registered as a European trade mark. The registration shall be published.

2. The Agency shall issue a certificate of registration. The certificate may be issued by electronic means.

3. The proprietor of a registered European trade mark shall have the right to use in connection with the goods and services covered by the registration a symbol right next to the trade mark attesting that the trade mark is registered in the Union only as long as the registration remains in force. The exact configuration of that symbol shall be decided by the Executive Director of the Agency.

4. The registered trade mark symbol shall not be used by any person other than the proprietor of the mark, or without the proprietor's consent. The proprietor of the trade mark shall not use the trade mark symbol before the mark is registered or after the revocation, declaration of invalidity, expiry or surrender of the trade mark.';

(43) In Title IV, the following Section 7 is inserted:

'SECTION 7

Delegation of powers

Article 45a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the procedure for the examination of compliance with the requirements for a filing date referred to in Article 36(1)(a) and with the formal conditions referred to in Article 26(3) and the procedure for verifying payment of the class fees referred to in Article 36(1)(c);
 - (b) the procedure for the examination of the absolute grounds for refusal as referred to in Article 37;
 - (c) the details which the publication of the application referred to in Article 39(1) shall contain;
 - (d) the procedure for correcting mistakes and errors in publications of European trade mark applications referred to in Article 39(3);
 - (e) the procedure for the submission of observations by third parties referred to in Article 40;
 - (f) the details on the procedure for filing and examining an opposition set out in Articles 41 and 42;
 - (g) the procedures governing the amendment of the application pursuant to Article 43(2) and the division of the application pursuant to Article 44;
 - (h) the particulars to be recorded in the Register when registering a European trade mark and the modalities of the publication of the registration referred to in Article 45(1), the content and the modalities of issue of the certificate of registration referred to in Article 45(2).';
- (44) In Article 49, paragraph 3 is deleted;
- (45) The following Article 49a is inserted:

'Article 49a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the procedural modalities for the renewal of the European trade mark pursuant to Article 47, including the type of fees to be paid;
- (b) the procedure governing the alteration of the registration of a European trade mark provided for in Article 48(2);
- (c) the procedure governing the division of a European trade mark provided for in Article 49.');

- (46) In Article 50, paragraphs 2 and 3 are replaced by the following:
2. The surrender shall be declared to the Agency in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register. The validity of the surrender of a European trade mark which is declared to the Agency subsequent to the submission of an application for revocation of that trade mark pursuant to Article 56(1) shall be conditional upon the final rejection or withdrawal of the application for revocation.';
3. Surrender shall be entered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender shall be entered in the Register only if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of a period established in accordance with Article 57a(a).';
- (47) In Article 53(1), the following subparagraph is added:
- 'The conditions referred to in points (a), (b) and (c) of the first subparagraph shall be fulfilled at the filing date or the priority date of the European trade mark.';
- (48) In Article 54(1) and (2), the words 'either' and 'or to oppose the use of the later trade mark' are deleted;
- (49) Article 56 is amended as follows:
- (a) in paragraph 1, point (c), 'under the law of the Member State concerned' is replaced by 'under Union law or the law of the Member State concerned';
- (b) paragraph 3 is replaced by the following:
- '3. An application for revocation or for a declaration of invalidity shall be inadmissible where an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on its merits, either by the Agency or by a European trade mark court as referred to in Article 95 and the decision of the Agency or that court on that application has acquired the authority of a final decision.';
- (50) In Article 57(2), second sentence, 'was published' is replaced by 'was filed or at the priority date of the European trade mark application';
- (51) In Title VI, the following Section 6 is inserted:
- SECTION 6**
Delegation of powers
- Article 57a
Delegation of powers
- The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the procedure governing the surrender of a European trade mark set out in Article 50, including the period referred to in paragraph 3 of that Article;
- (b) the procedures governing the revocation and invalidity of a European trade mark referred to in Articles 56 and 57.;

(52) Article 58(1) is replaced by the following:

'1. An appeal shall lie from decisions of any of the decision-making instances of the Agency listed in Article 130 points (a) to (d). Both the appeal period provided for in Article 60 and the filing of the appeal shall have suspensive effect.');

(53) Article 62 is deleted;

(54) Article 64(3) is replaced by the following:

'3. The decisions of the Boards of Appeal shall take effect only as from the date of expiry of the period referred to in Article 65(5) or, if an action has been brought before the General Court within that period, as from the date of dismissal of such action or of any appeal filed with the Court of Justice against the decision of the General Court.');

(55) Article 65 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. Actions may be brought before the General Court against decisions of the Boards of Appeal on appeals.');

(b) paragraph 3 is replaced by the following:

'3. The General Court shall have jurisdiction to annul or to alter the contested decision.');

(c) paragraphs 5 and 6 are replaced by the following:

'5. The action shall be brought before the General Court within two months of the date of notification of the decision of the Board of Appeal.

6. The Agency shall take the necessary measures to comply with the judgment of the General Court or, in case of appeal against that judgment, the Court of Justice.');

(56) The following Article 65a is inserted:

'Article 65a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the content of the notice of appeal referred to in Article 60 and the procedure for the filing and the examination of an appeal;
- (b) the content and form of the Board of Appeal's decisions referred to in Article 64;
- (c) the reimbursement of the appeal fees referred to in Article 60.";
- (57) The title of Title VIII is replaced by the following:
'SPECIFIC PROVISIONS ON EUROPEAN COLLECTIVE MARKS AND CERTIFICATION MARKS';
- (58) Between the title of Title VIII and Article 66, the following heading is inserted:
**'SECTION 1
European collective marks';**
- (59) In Article 66, paragraph 3 is replaced by the following:
'3. Titles I to VII and IX to XIV shall apply to European collective marks to the extent that this section does not provide otherwise.';
- (60) In Article 67(1), the words 'within the period prescribed' are replaced by 'within the period prescribed in accordance with Article 74a';
- (61) Article 69 is replaced by the following:
**'Article 69
Observations by third parties**
Where written observations on a European collective mark are submitted to the Agency pursuant to Article 40, those observations may also be based on the particular grounds on which the application for a European collective mark shall be refused pursuant to Article 68.';
- (62) The following Article 74a is inserted:
**'Article 74a
Delegation of powers**
The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying the period referred to in Article 67(1) for submitting the regulations governing use of the European collective mark to the Agency and the content of those regulations as set out in Article 67(2).';
- (63) In Title VIII, the following Section 2 is added:
**'SECTION 2
European Certification Marks**

Article 74b

European certification marks

1. A European certification mark shall be a European 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 characteristic from goods and services which are not so certified.

2. Any legal person, including institutions, authorities and bodies governed by public law, may apply for European certification marks provided that:

- (a) the legal person does not carry on a business involving the supply of goods or services of the kind certified;
- (b) the legal person is competent to certify the goods or services for which the mark is to be registered.

3. By way of derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute European certification marks within the meaning of paragraph 1. A certification mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided the third party uses them in accordance with honest practices in industrial or commercial matters. A certification mark may not be invoked against a third party who is entitled to use a geographical name.

4. Titles I to VII and IX to XIV shall apply to European certification marks to the extent that this Section does not provide otherwise.

Article 74c

Regulations governing use of the mark

1. An applicant for a European certification mark shall submit regulations governing the use of the certification mark within the period prescribed in accordance with Article 74k.

2. The regulations governing use shall specify the persons authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark as well as the conditions of use of the mark, including sanctions.

Article 74d

Refusal of the application

1. In addition to the grounds for refusal of a European trade mark application provided for in Articles 36 and 37, an application for a European certification mark shall be refused where Articles 74b and 74c are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

2. An application for a European certification mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

3. An application shall not be refused if the applicant, as a result of an amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

Article 74e

Observations by third parties

Where written observations on a European certification mark are submitted to the Agency pursuant to Article 40, those observations may also be based on the particular grounds on which the application for a European certification mark shall be refused pursuant to Article 74d.

Article 74f

Amendment of the regulations governing use of the mark

1. The proprietor of a European certification mark shall submit to the Agency any amended regulations governing use.

2. The amendment shall not be mentioned in the Register where the amended regulations do not satisfy the requirements of Article 74c or involve one of the grounds for refusal referred to in Article 74d.

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

4. For the purposes of this Regulation, amendments to the regulations governing use shall take effect only from the date of entry of the mention of the amendment in the Register.

Article 74g

Transfer

By way of derogation from Article 17(1), a European certification mark may only be transferred to a legal person which meets the requirements of Article 74b(2).

Article 74h

Persons who are entitled to bring an action for infringement

1. Only the proprietor of a European certification mark or any person specifically authorised by him to that effect shall be entitled to bring an action for infringement.

2. The proprietor of a European certification mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorised use of the mark.

Article 74i

Grounds for revocation

In addition to the grounds for revocation provided for in Article 51, the rights of the proprietor of a European certification mark shall be revoked on application to the Agency or on the basis of a counterclaim in infringement proceedings, where any of the following conditions is fulfilled:

- (a) the proprietor no longer meets the requirements of Article 74b(2);
- (b) the proprietor does not take reasonable steps to prevent the mark being used in a manner incompatible with the conditions of use laid down in the regulations governing use, amendments to which have, where appropriate, been mentioned in the Register;
- (c) the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 74d(2);
- (d) an amendment to the regulations governing use of the mark has been mentioned in the Register in breach of Article 74f(2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of that Article.

Article 74j

Grounds for invalidity

In addition to the grounds for invalidity provided for in Articles 52 and 53, a European certification mark which is registered in breach of Article 74d shall be declared invalid on application to the Agency or on the basis of a counterclaim in infringement proceedings, unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of Article 74d.

Article 74k

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying the period referred to in Article 74c(1) for submitting the regulations governing use of the European certification mark to the Agency and the content of those regulations as set out in Article 74c(2).';

- (64) Article 75 is replaced by the following:

'Article 75

Form of decisions and communications of the Agency

1. Decisions of the Agency shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

2. Any decision, communication or notice from the Agency shall indicate the department or division of the Agency as well as the name or the names of the official or officials responsible. They shall be signed by the official or officials, or, instead of a signature, carry a printed or stamped seal of the Agency. The Executive Director may determine that other means of identifying the department or division of the

Agency and the name of the official or officials responsible or an identification other than a seal may be used where decisions, communications or notices from the Agency are transmitted by telecopier or any other technical means of communication.';

(65) In Article 76(1), the following sentence is added:

'In invalidity proceedings pursuant to Article 52, the Agency shall limit its examination to the grounds and arguments provided by the parties.';

(66) In Article 78, the following paragraph 5 is added:

'5. The Executive Director of the Agency shall determine the amounts of expenses, to be paid, including advances, as regards the costs of taking of evidence referred to in Article 93a(b).';

(67) Article 79 is replaced by the following:

'Article 79
Notification

1. The Agency shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of delegated acts adopted pursuant to this Regulation, or of which notification has been ordered by the Executive Director of the Agency.

2. The Executive Director may determine which documents other than decisions subject to a time limit for appeal and summonses shall be notified by registered letter with advice of delivery.

3. Notification may be effected by electronic means, the details of which shall be determined by the Executive Director.

4. Where notification shall be effected by public notice, the Executive Director shall determine how the public notice is to be given and shall fix the beginning of the one month period on the expiry of which the document shall be deemed to have been notified.';

(68) The following Articles 79a, 79b, 79c and 79d are inserted:

'Article 79a
Noting of loss of rights

Where the Agency finds that the loss of any rights results from this Regulation or delegated acts adopted pursuant to this Regulation without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 79. The latter may apply for a decision on the matter. The Agency shall adopt such a decision where it disagrees with the person requesting it; otherwise the Agency shall amend its finding and inform the person requesting the decision.

Article 79b

Communications to the Agency

Communications addressed to the Agency may be effected by electronic means. The Executive Director shall determine the extent and the technical conditions under which those communications may be submitted electronically.

Article 79c

Time limits

1. The calculation and duration of time limits shall be subject to the rules adopted in accordance with Article 93a(f).
2. The Executive Director of the Agency shall determine before the commencement of each calendar year the days on which the Agency is not open for receipt of documents or on which ordinary mail is not delivered in the locality in which the Agency is located.
3. The Executive Director shall determine the duration of the period of interruption in case of a general interruption in the delivery of mail in the Member State where the Agency is located or in case of an actual interruption of the Agency's connection to admitted electronic means of communication.
4. If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates proper communication from the parties to the proceedings to the Agency or vice-versa, the Executive Director may determine that for parties of the proceedings having their residence or registered office in the State concerned or who have appointed a representative with a place of business in the State concerned, all time limits that otherwise would expire on or after the date of commencement of such occurrence, as determined by him, shall extend until a date to be determined by him. When determining that date, he shall assess when the exceptional occurrence comes to an end. If the occurrence affects the seat of the Agency, such determination of the Executive Director shall specify that it applies in respect of all parties to the proceedings.

Article 79d

Correction of errors and manifest oversights

The Agency shall correct any linguistic errors or errors of transcription and manifest oversights in the Agency's decisions or technical errors attributable to the Agency in registering the trade mark or in publishing its registration.';

(69) Article 80 is amended as follows:

- (a) in paragraph 1, first sentence, the phrase 'decision which contains an obvious procedural error' is replaced by 'decision which contains an obvious error';
- (b) in paragraph 2, the second sentence is replaced by the following:

'The cancellation of the entry in the Register or the revocation of the decision shall be effected within one year from the date on which the entry was made in

the Register or that decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the European trade mark in question that are entered in the Register.';

(c) paragraph 3 is replaced by the following:

'3. This Article shall be without prejudice to the right of the parties to submit an appeal under Articles 58 and 65, or to the possibility of correcting errors and manifest oversights under Article 79d. Where an appeal has been filed against an Agency's decision containing an error, the appeal proceedings shall become devoid of purpose upon revocation by the Agency of its decision pursuant to paragraph 1 of this Article.';

(70) Article 82 is amended as follows:

(a) paragraph 2 is replaced by the following:

'2. This Article shall not apply to the time limits laid down in Article 29(1), Article 33(1), Article 36(2), Article 41(1) and (3), Article 47(3), Article 60, Article 65(5), Article 81, Article 112, or to the time limits laid down in paragraph 1 of this Article or the time limit for claiming seniority pursuant to Article 34 after the application has been filed.';

(b) paragraph 4 is replaced by the following:

'4. If the Agency accepts the application, the consequences of having failed to observe the time limit shall be deemed not to have occurred. If a decision has been taken between the expiry of the unobserved time limit and the request for continuation of proceedings, the department competent to decide on the omitted act shall review the decision and, where completion of the omitted act itself is sufficient, take a different decision. If the original decision is not to be altered, it shall be confirmed in writing.';

(71) The following Article 82a is inserted:

'Article 82a

Interruption of proceedings

When interrupting or resuming proceedings, the Agency shall comply with the modalities set out in accordance with Article 93a(i).';

(72) Article 83 is replaced by the following:

'Article 83

Reference to general principles

In the absence of procedural provisions in this Regulation or in delegated acts adopted pursuant to this Regulation, the Agency shall take into account the principles of procedural law generally recognised in the Member States.';

(73) In Article 85(1), the words 'under the conditions laid down in the Implementing Regulation' are replaced by 'under the conditions laid down in accordance with Article 93a(j).';

(74) In Article 86(2), the second sentence is replaced by the following:

'Each Member State shall designate a single authority responsible for verifying the authenticity of the decision and shall communicate its contact details to the Agency, the Court of Justice and the Commission. The order for the enforcement of the decision shall be appended to the decision by that authority, without other formality than verification of the authenticity of the decision.';

(75) Article 87 is replaced by the following:

'Article 87

Register of European trade marks

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

2. The Register shall be open to public inspection. It may be kept electronically.

3. The Agency shall maintain an electronic database containing the particulars of applications for registration of European trade marks and the entries made in the Register. The contents of that database may be made available to the public. The Executive Director shall determine the conditions of access to the database and the manner in which the contents of this database may be made available in machine-readable form, including the corresponding charges.';

(76) Article 88 is amended as follows:

(a) the title 'Inspection of files' is replaced by 'Inspection and keeping of files';

(b) paragraph 4 is replaced by the following:

'4. Where the files are inspected pursuant to paragraphs 2 or 3, certain documents in the file may be withheld from inspection. The Executive Director shall determine the means of inspection.

5. The Agency shall keep the files of any procedure relating to a European trade mark application or European trade mark registration. The Executive Director shall determine the form in which those files shall be kept. Where the files are kept in electronic format, the original documents forming the basis of such electronic files shall be disposed of after a period following their reception by the Agency, which shall be determined by the Executive Director.';

(77) Article 89 is replaced by the following:

'Article 89

Periodical publications

1. The Agency shall periodically publish:

- (a) a European Trade Marks Bulletin containing entries made in the Register as well as other particulars the publication of which is prescribed by this Regulation or by delegated acts adopted in accordance with this Regulation;
- (b) an Official Journal containing notices and information of a general character issued by the Executive Director of the Agency, as well as any other information relevant to this Regulation or its implementation.

The publications referred to in points (a) and (b) may be effected by electronic means.

2. The European Trade Marks Bulletin shall be published in the manner and frequency determined by the Executive Director.

3. The Executive Director may determine that certain items shall be published in the Official Journal in all the official languages of the Union.';

(78) Article 92 is amended as follows:

(a) paragraph 2 is replaced by the following:

'2. Without prejudice to paragraph 3, second sentence, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Union shall be represented before the Agency in accordance with Article 93(1) in all proceedings provided for by this Regulation, other than in filing an application for a European trade mark.

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

(b) paragraph 4 is replaced by the following:

'4. Where the conditions established in accordance with Article 93a(p) are fulfilled, a common representative shall be appointed.';

(79) Article 93 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. Representation of natural or legal persons before the Agency may only be undertaken by:

- (a) any legal practitioner qualified in a Member State and having his place of business within the Union, to the extent that he is entitled, within the said State, to act as a representative in trade mark matters;

- (b) professional representatives whose names appear on the list maintained for this purpose by the Agency.

Representatives acting before the Agency shall, on request by the Agency, file with it a signed authorisation for insertion on the files.';

- (b) paragraph 4 is replaced by the following:

'4. The Executive Director of the Agency may grant exemption from:

- (a) the requirement of paragraph 2(c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way;
- (b) the requirement of paragraph 2(a) in case of highly qualified professionals, provided that the requirements of paragraphs 2(b) and (c) are fulfilled.';

- (c) paragraph 5 is replaced by the following:

'5. A person may be removed from the list of professional representatives under the conditions established in accordance with Article 93a(p).';

- (80) In Title IX, the following Section 5 is inserted:

SECTION 5

Conferral of powers

Article 93a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

- (a) the requirements concerning the form of the decisions referred to in Article 75;
- (b) the modalities of oral proceedings and of the taking of evidence referred to in Articles 77 and 78;
- (c) the modalities of the notification referred to in Article 79;
- (d) the procedure for the noting of loss of rights referred to in Article 79a;
- (e) the rules on the means of communication, including the electronic means of communication referred to in Article 79b, to be used by the parties to proceedings before the Agency and the forms to be made available by the Agency;
- (f) the rules governing the calculation and duration of the time limits referred to in Article 79c(1);

- (g) the procedure for the correction of linguistic errors or errors of transcription and manifest oversights in the Agency's decisions and technical errors attributable to the Agency in registering the trade mark or in publishing its registration as referred to in Article 79d;
- (h) the procedure for the revocation of a decision or for the cancellation of an entry in the Register as referred to in Article 80(1);
- (i) the modalities of the interruption and resumption of proceedings before the Agency as referred to in Article 82a;
- (j) the procedures concerning the apportionment and fixing of costs, as referred to in Article 85(1);
- (k) the particulars referred to in Article 87(1);
- (l) the procedure for the inspection of files provided for in Article 88, including the parts of the file excluded from inspection, and the modalities of the keeping of files of the Agency provided for in Article 88(5);
- (m) the modalities of publication of the particulars and entries referred to in Article 89(1)(a) in the European Trade Marks Bulletin, including the type of information, and the languages in which those particulars and entries are to be published;
- (n) the frequency, form and languages in which publications of the Official Journal of the Agency referred to in Article 89(1)(b) shall be made;
- (o) the modalities of the exchange of information and communications between the Agency and the authorities of the Member States and of the inspection of files by or via courts or authorities of the Member States pursuant to Article 90;
- (p) derogations from the obligation to be represented before the Agency pursuant to Article 92(2), the conditions under which a common representative shall be appointed pursuant to Article 92(4), the conditions under which employees referred to in Article 92(3) and professional representatives referred to in Article 93(1) must file with the Agency a signed authorisation in order to be able to undertake representation, the content of that authorisation, and the conditions under which a person may be removed from the list of professional representatives referred to in Article 93(5).';

(81) In Title X, the title of Section 1 is replaced by the following:

'Application of the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters';

(82) Article 94 is amended as follows:

(a) the title is replaced by the following:

'Application of the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters';

(b) in paragraph 1, 'Regulation (EC) No 44/2001' is replaced by 'the Union rules on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters';

(c) the following paragraph 3 is added:

'3. References in this Regulation to Regulation (EC) No 44/2001 shall include, where appropriate, the Agreement between the European Community and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters done on 19 October 2005.';

(83) In Article 96(c), 'Article 9(3), second sentence' is replaced by 'Article 9b(2)';

(84) In Article 99, paragraph 3 is replaced by the following:

'3. In the actions referred to in Article 96(a) and (c), a plea relating to revocation or invalidity of the European trade mark submitted otherwise than by way of a counterclaim shall be admissible in so far as the defendant claims that the rights of the proprietor of the European trade mark could be revoked for lack of genuine use at the time the infringement action was brought.';

(85) Article 100 is amended as follows:

(a) paragraph 4 is replaced by the following:

'4. The European trade mark court with which a counterclaim for revocation or for a declaration of invalidity of the European trade mark has been filed shall not proceed with the examination of the counterclaim, until either the interested party or the court have informed the Agency of the date on which the counterclaim was filed. The Agency shall record that information in the Register. If an application for revocation or for a declaration of invalidity of the European trade mark is pending before the Agency, the court shall be informed thereof by the Agency and stay the proceedings until the decision on the application is final or the application is withdrawn.';

(b) paragraph 6 is replaced by the following:

'6. Where a European trade mark court has given a judgment which has become final on a counterclaim for revocation or for invalidity of a European trade mark, a copy of the judgment shall be sent to the Agency without delay, either by the court or by any of the parties to the national proceedings. The Agency or any other interested party may request information about such transmission. The Agency shall mention the judgment in the Register and shall take the necessary measures to comply with its operative part.';

(86) In Article 102, paragraph 2 is replaced by the following:

'2. The European trade mark court may also apply measures or orders available under the applicable law which it deems appropriate under the circumstances of the case.';

(87) Article 108 is deleted;

(88) In Article 113(3), the phrase 'together with the formal conditions laid down in the Implementing Regulation' is replaced by 'together with the formal conditions laid down in accordance with Article 114a';

(89) In Article 114(2), the words 'the Implementing Regulation' are replaced by 'delegated acts adopted in accordance with this Regulation';

(90) The following Article 114a is inserted:

'Article 114a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying the formal conditions with which a request for conversion of a European trade mark application must comply, the details of its examination, and those concerning its publication.';

(91) In Article 116, paragraph 2 is replaced by the following:

'2. Without prejudice to paragraph 1, the Agency may make use of seconded national experts or other staff not employed by the Agency. The Management Board shall adopt a decision laying down rules on the secondment to the Agency of national experts.';

(92) In Article 117, the words 'to the Office' are replaced by 'to the Agency and its staff';

(93) Article 119 is amended as follows:

(a) in paragraph 6, second subparagraph, the second sentence is replaced by the following:

'The translation shall be produced within the period prescribed in accordance with Article 144a(b).';

(b) the following paragraph 8 is added:

'8. The Executive Director shall determine the manner in which translations shall be certified.';

(94) In Article 120(1), the words 'the Implementing Regulation' are replaced by 'a delegated act adopted pursuant to this Regulation';

(95) Article 122 is deleted;

(96) Article 123 is replaced by the following:

'Article 123

Transparency

1. Regulation (EC) No 1049/2001 of the European Parliament and of the Council (*) shall apply to documents held by the Agency.

2. The Management Board shall adopt the detailed rules for applying Regulation (EC) No 1049/2001.

3. Decisions taken by the Agency under Article 8 of Regulation (EC) No 1049/2001 may form the subject of a complaint to the Ombudsman or of an action before the Court of Justice of the European Union, under the conditions laid down in Articles 228 and 263 of the Treaty respectively.

4. The processing of personal data by the Agency shall be subject to Regulation (EC) No 45/2001 of the European Parliament and of the Council (**).

(*) OJ L 145, 31.5.2001, p. 43.

(**) OJ L 8, 12.1.2001, p. 1.';

(97) The following Article 123a is inserted:

'Article 123a

Security rules on the protection of classified and sensitive non-classified information

The Agency shall apply the security principles contained in the Commission's security rules for protecting European Union Classified Information (EUCI) and sensitive non-classified information, as set out in the annex to Commission Decision 2001/844/EC, ECSC, Euratom (*). Applying the security principles shall cover, inter alia, provisions for the exchange, processing and storage of such information.

(*) OJ L 317, 3.12.2001, p. 1.';

(98) In Title XII, the following Section 1a is inserted:

'SECTION 1a

Tasks of the Agency and cooperation to promote convergence

Article 123b

Tasks of the Agency

1. The Agency shall have the following tasks:

- (a) administration and promotion of the European trade mark system established in this Regulation;
- (b) administration and promotion of the European design system established in Council Regulation (EC) No 6/2002 (*);

- (c) promoting convergence of practices and tools in the fields of trade marks and designs in cooperation with the central industrial property offices in the Member States, including the Benelux Intellectual Property Office;
- (d) the tasks referred to in Regulation (EU) No 386/2012 of the European Parliament and of the Council (**).

2. The Agency shall cooperate with institutions, authorities, bodies, industrial property offices, international and non-governmental organisations in relation to the tasks laid down in paragraph 1.

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

Article 123c

Cooperation to promote convergence of practices and tools

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

This cooperation shall cover the following areas of activity:

- (a) the development of common examination standards;
- (b) the creation of common or connected databases and portals for Union-wide consultation, search and classification purposes;
- (c) the continuous provision and exchange of data and information, including the feeding of the databases and portals referred to in point (b);
- (d) the establishment of common standards and practices, with a view to ensuring interoperability between procedures and systems throughout the Union and enhancing their consistency, efficiency and effectiveness;
- (e) the sharing of information on industrial property rights and procedures, including mutual support to helpdesks and information centres;
- (f) the exchange of technical expertise and assistance in relation to the areas laid down in points (a) to (e).

2. The Agency shall define, elaborate and coordinate common projects of Union interest with regard to the areas referred to in paragraph 1. The project definition shall contain the specific obligations and responsibilities of each participating industrial property office of the Member States and the Benelux Office for Intellectual Property.

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

4. The Agency shall provide financial support to the common projects of Union interest referred to in paragraph 2 to the extent this is necessary to ensure the effective participation of the industrial property offices of the Member States and the Benelux Office for Intellectual Property in the projects within the meaning of paragraph 3. That financial support may take the form of grants. The total amount of funding shall not exceed 10% of the yearly income of the Agency. The beneficiaries of grants shall be the industrial property offices of the Member States and the Benelux Office for Intellectual Property. Grants may be awarded without calls for proposals in accordance with the financial rules applicable to the Agency and with the principles of grant procedures contained in the Financial Regulation (EU) No 966/2012 of the European Parliament and of the Council (***) and in the Commission delegated Regulation (EU) No 1268/2012 (****).

(*) OJ L 3, 5.1.2002, p. 1.

(**) OJ L 129, 16.5.2012, p. 1.

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

(****) OJ L 362, 31.12.2012, p. 1.';

(99) In Title XII, sections 2 and 3 are replaced by the following:

'SECTION 2

Management Board

Article 124

Functions of the Management Board

1. Without prejudice to the functions attributed to the Budget Committee in Section 5, the Management Board shall have the following functions:

- (a) on the basis of a draft submitted by the Executive Director in accordance with Article 128(4)(c), the Management Board shall adopt the annual work programme of the Agency for the coming year, taking into account the opinion of the Commission, and shall forward the adopted annual work programme to the European Parliament, the Council and the Commission;
- (b) on the basis of a draft submitted by the Executive Director in accordance with Article 128(4)(d) and taking into account the opinion of the Commission, the Management Board shall adopt a multi-annual strategic programme for the Agency, including the Agency's strategy for international cooperation, following an exchange of views between the Executive Director and the relevant committee in the European Parliament, and shall forward the adopted multi-annual strategic programme to the European Parliament, the Council and the Commission;
- (c) on the basis of a draft submitted by the Executive Director in accordance with Article 128(4)(f), the Management Board shall adopt the annual report and shall forward the adopted annual report to the European Parliament, the Council, the Commission and the Court of Auditors;

- (d) on the basis of a draft submitted by the Executive Director in accordance with Article 128(4)(g), the Management Board shall adopt the multiannual staff policy plan;
- (e) the Management Board shall adopt rules on the prevention and management of conflicts of interest in the Agency;
- (f) in accordance with paragraph 2, it shall exercise, with respect to the staff of the Agency, the powers conferred by the Staff Regulations on the Appointing Authority and by the Conditions of Employment of Other Servants on the Authority Empowered to Conclude Contract of Employment ("the appointing authority powers");
- (g) the Management Board shall adopt appropriate implementing rules to the Staff Regulations and the Conditions of Employment of Other Servants in accordance with Article 110 of the Staff Regulations;
- (h) the Management Board shall appoint and may remove the Executive Director and the Deputy Executive Director or Deputy Executive Directors from office pursuant to Article 129, and shall appoint the President, the chairpersons and the members of the Boards of Appeal pursuant to Article 136;
- (i) the Management Board shall ensure adequate follow-up to the findings and recommendations stemming from the internal or external audit reports and evaluations referred to in Article 165a, as well as from investigations of the European Anti-fraud Office (OLAF);
- (j) the Management Board shall be consulted before adoption of the guidelines for examination in the Agency and in the other cases provided for in this Regulation;
- (k) the Management Board may deliver opinions and requests for information to the Executive Director and to the Commission where it considers that this is necessary.

2. The Management Board shall adopt, in accordance with Article 110 of the Staff Regulations and 142 of the Conditions of Employment of Other Servants, a decision based on Article 2(1) of the Staff Regulations and on Article 6 of the Conditions of Employment of Other Servants, delegating the relevant appointing authority powers to the Executive Director and defining the conditions under which this delegation of powers can be suspended.

The Executive Director shall be authorised to sub-delegate those powers.

Where exceptional circumstances so require, the Management Board may by way of a decision temporarily suspend the delegation of the appointing authority powers to the Executive Director and those sub-delegated by the latter and exercise them itself or delegate them to one of its members or to a staff member other than the Executive Director.

Article 125

Composition of the Management Board

1. The Management Board shall be composed of one representative of each Member State and two representatives of the Commission and their alternates.
2. The members of the Management Board may, subject to its rules of procedure, be assisted by advisers or experts.
3. The duration of the term of office shall be four years. The term of office shall be extendable.

Article 126

Chairperson of the Management Board

1. The Management Board shall elect a chairperson and a deputy chairperson from among its members. The deputy chairperson shall ex officio replace the chairperson in the event of his being prevented from attending to his duties.
2. The duration of the terms of office of the chairperson and the deputy chairperson shall be four years. The terms of office shall be renewable once. If, however, their membership of the Management Board ends at any time during their term of office, their term of office shall automatically expire on that date also.

Article 127

Meetings

1. Meetings of the Management Board shall be convened by its chairperson.
2. The Executive Director shall take part in the deliberations, unless the Management Board decides otherwise.
3. The Management Board shall hold an ordinary meeting once a year. In addition, it shall meet on the initiative of its chairperson or at the request of the Commission or of one-third of the Member States.
4. The Management Board shall adopt rules of procedure.
5. The Management Board shall take its decisions by an absolute majority of its members. However, a majority of two-thirds of its members shall be required for the decisions which the Management Board is empowered to take under Article 124(1)(a) and (b), Article 126(1) and Article 129(2) and (4). In both cases each member shall have one vote.
6. The Management Board may invite observers to attend its meetings.
7. The Secretariat for the Management Board shall be provided by the Agency.

SECTION 2a

Executive Board

Article 127a

Establishment

The Management Board may establish an Executive Board.

Article 127b

Functions and organisation

1. The Executive Board shall assist the Management Board.
2. The Executive Board shall have the following functions:
 - (a) preparing decisions to be adopted by the Management Board;
 - (b) ensuring, together with the Management Board, adequate follow-up to the findings and recommendations stemming from the internal or external audit reports and evaluations, as well as from investigations of the European Anti-fraud Office (OLAF);
 - (c) without prejudice to the functions of the Executive Director, as set out in Article 128, assisting and advising the Executive Director in the implementation of the decisions of the Management Board, with a view to reinforcing supervision of administrative management.
3. When necessary, because of urgency, the Executive Board may take certain provisional decisions on behalf of the Management Board, in particular on administrative management matters, including the suspension of the delegation of the appointing authority powers.
4. The Executive Board shall be composed of the Chairperson of the Management Board, one representative of the Commission to the Management Board and three other members appointed by the Management Board from among its members. The Chairperson of the Management Board shall also be the Chairperson of the Executive Board. The Executive Director shall take part in the meetings of the Executive Board, but shall not have the right to vote.
5. The term of office of members of the Executive Board shall be four years. The term of office of members of the Executive Board shall end when their membership of the Management Board ends.
6. The Executive Board shall hold at least one ordinary meeting every three months. In addition, it shall meet on the initiative of its Chairperson or at the request of its members.
7. The Executive Board shall comply with the rules of procedure laid down by the Management Board.

SECTION 3

Executive Director

Article 128

Functions of the Executive Director

1. The Agency shall be managed by the Executive Director. The Executive Director shall be accountable to the Management Board.
2. Without prejudice to the powers of the Commission, the Management Board, and the Budget Committee, the Executive Director shall be independent in the performance of the duties and shall neither seek nor take instructions from any government or from any other body.
3. The Executive Director shall be the legal representative of the Agency.
4. The Executive Director shall have in particular the following functions:
 - (a) he shall take all necessary steps, including the adoption of internal administrative instructions and the publication of notices, to ensure the functioning of the Agency;
 - (b) he shall implement the decisions adopted by the Management Board;
 - (c) he shall prepare a draft annual work programme indicating estimated human and financial resources for each activity, and submit it to the Management Board after consultation of the Commission;
 - (d) he shall prepare a draft multiannual strategic programme, including the Agency's strategy for international cooperation, and submit it to the Management Board after consultation of the Commission and following an exchange of views with the relevant committee in the European Parliament;
 - (e) he shall implement the annual work programme and the multiannual strategic programme and report to the Management Board on their implementation;
 - (f) he shall prepare the annual report on the Agency's activities and present it to the Management Board for approval;
 - (g) he shall prepare a draft multiannual staff policy plan and submit it to the Management Board after consultation of the Commission;
 - (h) he shall prepare an action plan following-up on the conclusions of the internal or external audit reports and evaluations, as well as from investigations of the European Anti-fraud Office (OLAF), and shall report on progress twice a year to the Commission and to the Management Board;
 - (i) he shall protect the financial interests of the Union by the application of preventive measures against fraud, corruption and any other illegal activities, by effective checks and, if irregularities are detected, by the recovery of the amounts wrongly paid and, where appropriate, by imposing effective, proportionate and dissuasive administrative and financial penalties;

- (j) he shall prepare an anti-fraud strategy of the Agency and shall present it to the Budget Committee for approval;
- (k) in order to ensure uniform application of the Regulation, he may refer to the enlarged Board of Appeal questions on a point of law, in particular if the Boards of Appeal have issued diverging decisions on that point;
- (l) he shall draw up estimates of the revenue and expenditure of the Agency and shall implement the budget;
- (m) he shall exercise the powers entrusted to him in respect of the staff by the Management Board under Article 124(1)(f);
- (n) he shall exercise the powers conferred to him by Articles 26(3), 29(5), 30(2), 45(3), 75(2), 78(5), 79, 79b, 79c, 87(3), 88, 89, 93(4), 119(8) and 144 in accordance with the criteria set out in this Regulation and in the delegated acts adopted pursuant to this Regulation;
- (o) he may delegate his functions.

5. The Executive Director shall be assisted by one or more Deputy Executive Directors. If the Executive Director is absent or indisposed, the Deputy Executive Director or one of the Deputy Executive Directors shall replace him in accordance with the procedure laid down by the Management Board.

Article 129

Appointment and removal of the Executive Director and extension of his term of office

1. The Executive Director shall be engaged as a temporary agent of the Agency under Article 2(a) of the Conditions of Employment of Other Servants.

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

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

3. The term of office of the Executive Director shall be five years. By the end of that period, the Commission shall undertake an assessment which takes into account an evaluation of the performance of the Executive Director and the Agency's future tasks and challenges.

4. The Management Board, acting on a proposal from the Commission which takes into account the assessment referred to in paragraph 3, may extend once the term of office of the Executive Director for no more than five years.

5. An Executive Director whose term of office has been extended may not participate in another selection procedure for the same post at the end of the overall period.

6. The Deputy Executive Director or Deputy Executive Directors shall be appointed or removed from office as provided for in paragraph 2, after consultation of the Executive Director and, where applicable, the Executive Director elect. The term of office of the Deputy Executive Director shall be five years. It may be extended once for no more than five years by the Management Board acting on a proposal from the Commission as provided for in paragraph 4, after consultation of the Executive Director.';

(100) Article 130 is amended as follows:

(a) point (c) is replaced by the following:

'(c) a department entrusted with the keeping of the Register;'

(b) the following point (f) is added:

'(f) any other unit or person appointed by the Executive Director to that effect.';

(101) In Article 132(2), the third sentence is replaced by the following:

'In specific cases laid down in accordance with Article 144a(c), the decisions shall be taken by a single member.';

(102) Article 133 is replaced by the following:

'Article 133

Department entrusted with the keeping of the Register

1. The Department entrusted with the keeping of the Register shall be responsible for taking decisions in respect of entries in the Register.

2. It shall also be responsible for keeping the list of professional representatives referred to in Article 93(2).

3. The decisions of the Department shall be taken by one member.';

(103) Article 134 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. A Cancellation Division shall be responsible for taking decisions in relation to:

(a) an application for the revocation or declaration of invalidity of a European trade mark,

(b) a request for the assignment of a European trade mark as provided for in Article 18.';

(b) in paragraph 2, the third sentence is replaced by the following:

'In specific cases laid down in accordance with Article 144a(c), the decisions shall be taken by a single member.';

(104) The following Article 134a is inserted:

'Article 134a

General Competence

Decisions required by this Regulation which do not fall within the competence of an examiner, an Opposition Division, a Cancellation Division or the Department entrusted with the keeping of the Register, shall be taken by any official or unit appointed by the Executive Director for that purpose.';

(105) Article 135 is amended as follows:

(a) paragraph 1 is replaced by the following:

'1. The Boards of Appeal shall be responsible for deciding on appeals from decisions taken pursuant to Articles 131 to 134a.';

(b) in paragraph 3, point (a) is replaced by the following::

'(a) by the authority of the Boards of Appeal referred to in Article 136(4)(a); or';

(c) paragraph 4 is replaced by the following:

'4. The enlarged Board shall also be responsible for giving reasoned opinions on questions of law referred to it by the Executive Director pursuant to Article 128(4)(k).';

(d) in paragraph 5, the last sentence is deleted;

(106) Article 136 is replaced by the following:

'Article 136

Independence of the members of the Boards of Appeal

1. The President of the Boards of Appeal and the chairpersons of the Boards shall be appointed, in accordance with the procedure laid down in Article 129 for the appointment of the Executive Director, for a term of five years. They shall not be removed from office during this term, unless there are serious grounds for such removal and the Court of Justice, on application by the institution which appointed them, takes a decision to this effect.

2. The term of office of the President of the Boards of Appeal may be extended once for one additional five-year period, or until retirement age if this age is reached during the new term of office, after a prior positive evaluation of his performance by the Management Board.

3. The term of office of the chairpersons of the Boards may be extended for additional five-year periods, or until retirement age if this age is reached during the new term of office, after a prior positive evaluation of their performance by the Management Board, subject to a favourable opinion by the President of the Boards of Appeal.

4. The President of the Boards of Appeal shall have the following managerial and organisational functions:

- (a) chairing the authority of the Boards of Appeal responsible for laying down the rules and organising the work of the Boards;
- (b) ensuring the implementation of the authority's decisions;
- (c) allocating cases to a Board on the basis of objective criteria determined by the authority of the Boards of Appeal;
- (d) forwarding to the Executive Director the Boards' expenditure requirements, with a view to drawing up the expenditure estimates.

The President of the Boards of Appeal shall chair the enlarged Board.

5. The members of the Boards of Appeal shall be appointed by the Management Board for a term of five years. Their term of office may be extended for additional five-year periods, or until retirement age if that age is reached during the new term of office after a prior positive evaluation of their performance by the Management Board, subject to a favourable opinion by the President of the Boards of Appeal.

6. The members of the Boards of Appeal shall not be removed from office unless there are serious grounds for such removal and the Court of Justice, after the case has been referred to it by the Management Board on the recommendation of the President of the Boards of Appeal, after consulting the chairperson of the Board to which the member concerned belongs, takes a decision to this effect.

7. The President of the Boards of Appeal and the chairpersons and members of the Boards of Appeal shall be independent. In their decisions they shall not be bound by any instructions.

8. Decisions taken by an enlarged Board on appeals or opinions on questions of law referred to it by the Executive Director pursuant to Article 135 shall be binding on the decision-making instances of the Agency referred to in Article 130.

9. The President of the Boards of Appeal and the chairpersons and members of the Boards of Appeal shall not be examiners or members of the Opposition Divisions, the Department entrusted with the keeping of the Register or Cancellation Divisions.';

(107) Article 138 is replaced by the following:

'Article 138
Budget Committee

1. The Budget Committee shall have the functions assigned to it in this Section.
2. Articles 125, 126 and 127(1) to (4), (6) and (7) shall apply to the Budget Committee *mutatis mutandis*.
3. The Budget Committee shall take its decisions by an absolute majority of its members. However, a majority of two-thirds of its members shall be required for the decisions which the Budget Committee is empowered to take under Article 140(3) and Article 143. In both cases each member shall have one vote.';

(108) In Article 139 the following paragraph 4 is added:

'4. The Agency shall prepare on a biannual basis a report to the Commission on its financial situation. On the basis of this report, the Commission shall review the financial situation of the Agency.';

(109) The following Article 141a is inserted:

'Article 141a

Combating fraud

1. In order to facilitate combating fraud, corruption and other unlawful activities under Regulation (EC) No 1073/1999 the Agency shall accede to the Interinstitutional Agreement of 25 May 1999 concerning internal investigations by the European Anti-fraud Office (OLAF) and adopt the appropriate provisions applicable to all the employees of the Agency using the template set out in the Annex to that Agreement.

2. The European Court of Auditors shall have the power of audit, on the basis of documents and on the spot, over all grant beneficiaries, contractors and subcontractors who have received Union funds from the Agency.

3. OLAF may carry out investigations, including on-the-spot checks and inspections, in accordance with the provisions and procedures laid down in Regulation (EC) No 1073/1999 and Regulation (Euratom, EC) No 2185/96 with a view to establishing whether there has been fraud, corruption or any other illegal activity affecting the financial interests of the Union in connection with a grant or a contract funded by the Agency.

4. Without prejudice to paragraphs 1, 2 and 3, cooperation agreements with third countries and international organisations, contracts, grant agreements and grant decisions of the Agency shall contain provisions expressly empowering the European Court of Auditors and OLAF to conduct such audits and investigations, according to their respective competences.

5. The Budget Committee shall adopt an anti-fraud strategy, which is proportionate to the fraud risks having regard to the cost-benefit of the measures to be implemented.';

(110) Article 144 is replaced by the following:

'Article 144

Fees

1. In addition to the fees provided for in Articles 26(2), 36(1)(c), 41(3), 44(4), 47(1) and (3), 49(4), 56(2), 60, 81(3), 82(1), 113(1) and 147(5), fees shall be charged in the following cases:

- (a) issue of a copy of the certificate of registration;
- (b) registration of a license or another right in respect of a European trade mark;
- (c) registration of a license or another right in respect of an application for a European trade mark;
- (d) cancellation of the registration of a license or another right;
- (e) alteration of a registered European trade mark;
- (f) issue of an extract from the Register;
- (g) inspection of the files;
- (h) issue of copies of file documents;
- (i) issue of certified copies of the application;
- (j) communication of information in a file;
- (k) review of the determination of the procedural costs to be refunded.

2. The amounts of the fees referred to in paragraph 1 shall be fixed at such level as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Agency to be balanced while avoiding the accumulation of significant surpluses. Without prejudice to Article 139(4), the Commission shall review the level of fees should a significant surplus become recurrent. If this review does not lead to a reduction or modification in the level of fees which has the effect of preventing the further accumulation of a significant surplus, the surplus accumulated after the review shall be transferred to the budget of the Union.

3. The Executive Director shall lay down the amount to be charged for any services provided by the Agency other than those referred to in paragraph 1 and for publications issued by the Agency in accordance with the criteria set out in the delegated act adopted pursuant to Article 144a(d). The amount of the charge shall not exceed what is necessary to cover the costs of the specific service rendered by the Agency.

4. In accordance with the criteria set out in the delegated act adopted pursuant to Article 144a(d), the Executive Director may take the following measures:

- (a) he may establish which specific methods of payment other than those set out in accordance with Article 144a(d) may be used, in particular by means of deposits in current accounts held with the Agency;

- (b) he may determine the amounts below which an excessive sum paid to cover a fee or a charge shall not be refunded;
- (c) he may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain.

Where the methods of payment referred to in point (a) may be used, the Executive Director shall establish the date on which such payments are to be considered to have been made to the Agency.';

- (111) The following Section 6 is inserted:

SECTION 6
Delegation of powers

Article 144a
Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 in order to establish:

- (a) the specific criteria of use of the languages referred to in Article 119;
 - (b) the cases in which opposition and cancellation decisions shall be taken by a single member under Article 132(2) and Article 134(2);
 - (c) the details on the organisation of the Boards of Appeal, including the setting up and the role of the authority of the Boards of Appeal referred to in Article 135(3)(a), the composition of the enlarged Board and the rules on referrals to it as referred to in Article 135(4), and the conditions under which decisions shall be taken by a single member in accordance with Article 135(2) and (5);
 - (d) the system of fees and charges payable to the Agency in accordance with Article 144, including the amount of fees, the methods of payment, the currencies, the due date for fees and charges, the deemed date of payment and the consequences of lack of or late payment, and under- and overpayment, the services which may be free of charge, and the criteria under which the Executive Director may exercise the powers set out in Article 144(3) and (4).';
- (112) In Article 145, the words 'its Implementing Regulations' are replaced by 'the delegated acts adopted pursuant to this Regulation';
- (113) In Article 147, paragraphs 4, 5 and 6 are replaced by the following:

'4. The filing of an international application shall be subject to the payment of a fee to the Agency. Where the international registration is to be based on a European trade mark once it is registered, the fee shall be due on the date of registration of the European trade mark. The application shall be deemed not to have been filed until the required fee has been paid.

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

6. The Agency shall examine whether the international application meets the conditions laid down in Article 146 and in paragraphs 1, 3 and 5 of this Article.

7. The Agency shall forward the international application to the International Bureau as soon as possible.';

(114) The following Article 148a is inserted:

'Article 148a

Notification of the invalidity of the basic application or registration

Within a period of five years from the date of the international registration, the Agency shall notify the International Bureau of the facts and decisions affecting the validity of the European trade mark application or the European trade mark registration on which the international registration was based.';

(115) In Article 149, the following sentence is added:

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

(116) Article 154(4) is deleted;

(117) The following Article 154a is inserted:

'Article 154a

Collective and certification marks

Where an international registration is based on a basic application or basic registration relating to a collective mark, certification mark or guarantee mark, the Agency shall comply with the procedures provided for in accordance with Article 161a(f).';

(118) Article 155 is deleted;

(119) Article 156 is amended as follows:

(a) in paragraph 2, the words 'six months' are replaced by 'one month';

(b) paragraph 4 is deleted;

(120) The following Articles 158a, 158b and 158c are inserted:

'Article 158a

Legal effect of registration of transfers

The recordal of a change in the ownership of the international registration on the International Register shall have the same effect as the entry of a transfer in the Register pursuant to Article 17.

Article 158b

Legal effect of registration of licenses and other rights

The recordal of a license or a restriction of the holder's right of disposal in respect of the international registration in the International Register shall have the same effect as the registration of a license, a right in rem, a levy of execution or insolvency proceedings in the Register pursuant to Articles 19, 20, 21 and 22 respectively.

Article 158c

Examination of requests for registration of transfers, licenses or restrictions of the holder's right of disposal

The Agency shall transmit requests to register a change in ownership, a license or a restriction of the holder's right of disposal, the amendment or cancellation of a license or the removal of a restriction of the holder's right of disposal which have been filed with it to the International Bureau in the cases specified in accordance with Article 161a(h).';

(121) Article 159 is amended as follows:

(a) in paragraph 1, point (b) is replaced by the following:

'(b) into a designation of a Member State party to the Madrid Protocol, provided that on the date when conversion was requested it was possible to have designated that Member State directly under the Madrid Protocol. Articles 112, 113 and 114 shall apply.';

(b) in paragraph 2, the words 'or the Madrid Agreement' are deleted;

(122) In Title XIII the following Section 4 is inserted:

'SECTION 4

Conferral of powers

Article 161a

Delegation of powers

The Commission shall be empowered to adopt delegated acts in accordance with Article 163 specifying:

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

(b) the modalities of the notification provided for in Article 148a;

(c) the formal conditions of a request for territorial extension as referred to in Article 149(2), the procedure for the examination of those conditions and the modalities of forwarding the request for territorial extension to the International Bureau;

- (d) the procedure for filing a seniority claim pursuant to Article 153;
 - (e) the procedures for the examination of absolute grounds for refusal referred to in Article 154 and for the filing and examination of an opposition pursuant to Article 156, including the necessary communications to be made to the International Bureau;
 - (f) the procedures with regard to the international registrations referred to in Article 154a;
 - (g) the cases where the Agency shall notify the International Bureau of the invalidation of the effects of an international registration pursuant to Article 158 and the information that such notification shall contain;
 - (h) the modalities of transmission of the requests referred to in Article 158c to the International Bureau;
 - (i) the conditions with which a request for conversion pursuant to Article 159(1) shall comply;
 - (j) the formal conditions of an application for transformation referred to in Article 161 and the procedures for such a transformation;
 - (k) the modalities of communications between the Agency and the International Bureau, including the communications to be made pursuant to Articles 147(4), 148a, 153(2) and 158c.;
- (123) Article 162 is deleted;
- (124) Article 163 is deleted;
- (125) The following Article 163a is inserted:

'Article 163a

Exercise of the delegation

1. The power to adopt delegated acts is conferred on the Commission subject to the conditions laid down in this Article.
2. The delegation of power referred to in Articles 24a, 35a, 45a, 49a, 57a, 65a, 74a, 74k, 93a, 114a, 144a and 161a shall be conferred for an indeterminate period of time.
3. The delegation of power referred to in paragraph 2 may be revoked at any time by the European Parliament or by the Council. A decision of revocation shall put an end to the delegation of the power specified in that decision. It shall take effect the day following the publication of the decision in the *Official Journal of the European Union* or at a later date specified therein. It shall not affect the validity of any delegated acts already in force.
4. As soon as it adopts a delegated act, the Commission shall notify it simultaneously to the European Parliament and to the Council.

5. A delegated act adopted pursuant to Articles 24a, 35a, 45a, 49a, 57a, 65a, 74a, 74k, 93a, 114a, 144a and 161a shall enter into force only if no objection has been expressed either by the European Parliament or the Council within a period of 2 months of notification of that act to the European Parliament and the Council or if, before the expiry of that period, the European Parliament and the Council have both informed the Commission that they will not object. That period shall be extended by 2 months at the initiative of the European Parliament or the Council.';

(126) Article 164 is deleted;

(127) The following Article 165a is inserted:

'Article 165a

Evaluation and review

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

2. The evaluation shall review the legal framework for cooperation between the Agency and the central industrial property offices of the Member States and the Benelux Office for Intellectual Property, with a particular attention to the financing mechanism. The evaluation shall further assess the impact, effectiveness and efficiency of the Agency and its working practices. The evaluation shall, in particular, address the possible need to modify the mandate of the Agency, and the financial implications of any such modification.

3. The Commission shall forward the evaluation report together with its conclusions drawn on the report to the European Parliament, the Council and the Management Board. The findings of the evaluation shall be made public.

4. On the occasion of every second evaluation, there shall be an assessment of the results achieved by the Agency having regard to its objectives, mandate and tasks. If the Commission considers that the continuation of the Agency is no longer justified with regard to its assigned objectives, mandate and tasks, it may propose that this Regulation be repealed.'

Article 2

This Regulation shall enter into force on [specify date 90 days after its publication in the Official Journal of the European Union].

Article 1(9), (10)(b), (21), (22), (23), (25), (26), (27), (29), (30), (31), (34), (37), (38), (41), (44), (46), (57), (58), (59), (60), (61), (63), (64), (66), (67), (68), (69), (70), (71), (72), (73), (75), (76), (77), (78), (79), (88), (89), (93), (94), (99) insofar as it relates to Article 128(4)(n), (101), (103)(b), (105)(d), (112), (113), (114), (115), (117), (120), (123) and (124) shall apply from [specify the first day of the first month after 18 months following the date specified in the first paragraph].

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels,

For the European Parliament
The President

For the Council
The President