

Trade marks: approximation of the laws of the Member States. Recast

2013/0089(COD) - 25/02/2014 - Text adopted by Parliament, 1st reading/single reading

The European Parliament adopted by 566 votes to 89 with 18 abstentions, a legislative resolution on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (recast).

Parliament's position adopted at first reading under the ordinary legislative procedure amended the Commission's proposal as follows:

European Union trade mark: given that the term 'European' applies to an area larger than the territory of the European Union, Members proposed to replace the term 'Community trade mark' by the term 'European Union trade mark'. They also stressed the importance of the complementary nature of national and Union protection of trade marks.

Signs likely to constitute a European Union trade mark: it is stipulated that the representation can be in any form so long as it uses generally available technology. The sign should be capable of being represented in the register in a manner which is clear, precise, self-contained, easily accessible, durable and objective.

Examination of absolute grounds for refusal: with regard to geographical indications covered by Regulation No 110/2008 of the European Parliament and of the Council, Members proposed including **spirit drinks** to the grounds for refusal. They also deleted the requirement for national offices to examine absolute grounds for refusal in all national jurisdictions and languages of the Union. It was stated that a trade mark shall not be declared invalid if, before the date of application for invalidity, and following the use which has been made of it, it has acquired a distinctive character.

Registration: Members considered it reasonable to allow for a registration based on the lack of a relative ground for refusal if the proprietor of an earlier right consents to the registration of the mark. It would not seem necessary for this provision to be optional for Member States.

Use of trade marks: Members considered it essential to require that trade marks should be used for products or services for which they were registered, or, if not used within **five years** of the date of registration, should be liable to be revoked.

Rights conferred by the EU trade mark: in order to more effectively prevent the entry of counterfeit goods, particularly in the context of **sales over the internet delivered in small consignments**, the proprietor of a validly registered trade mark should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the counterfeit goods who acts in the course of trade.

In cases where such measures are taken, Member States should ensure that the individuals or entities that had ordered the goods are informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.

In order to strengthen the protection afforded by the trade mark and to **fight more effectively against counterfeit goods**, and without prejudice to WTO rules, in particular Article V of the GATT on freedom of transit, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there,

where such goods come from third countries and bear without authorisation a trade mark which is essentially identical to the trade mark registered in respect of such goods. This should be **without prejudice to the smooth transit of generic medicines**, in compliance with the international obligations of the European Union, in particular as reflected in the 'Declaration on the TRIPS agreement and public health' adopted by the Doha WTO Ministerial Conference on 14 November 2001.

The resolution stipulated that the trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark for a due cause for any non-commercial use of a mark.

Examination for refusal on relative grounds: according to the amended text, Member States should be free to decide whether to conduct an examination for refusal on relative grounds. Members considered that it is possible to retain the option that allows national offices to conduct this examination and combine it with the well founded proposal by the Commission to not let these examinations block the application procedure for the applicant.

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

In order to strengthen this provision, Parliament stated that the proprietor shall have the right to prohibit affixing in the course of trade a sign that is, identical with or similar to the trade mark on packaging, labels, tags, security features, authenticity devices or any other means on which the mark may be affixed.

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

In order to increase effectiveness of national cancellation procedures, to align them with European cancellation procedures, reduce fees, costs and administrative burden, it is proposed that an application for revocation may be directed against (i) part or the totality of the goods or services covered by the contested mark; (ii) one or more earlier right, as well as on part or the totality of the goods or services covered by the earlier right.

Communication with the office: the practice of some Member States to require an address of service in their country for notifications from the office is an unnecessary source of delays and costs, consequent to the need to identify, appoint and pay a local representative. It is therefore proposed that the parties to the proceedings or, where appointed, their representatives, shall designate an official address **within one of the Member States** for all official communication with the office.