

# Procedure file

Basic information		
CNS - Consultation procedure Regulation	<a href="#">2002/0308(CNS)</a>	Procedure completed
Community trade mark		
Repealed by <a href="#">2006/0267(CNS)</a>		
Subject 2.10.03 Standardisation, EC/EU standards and trade mark, certification, compliance		

Key players			
European Parliament	Committee responsible	Rapporteur	Appointed
	<b>JURI</b> Legal Affairs and Internal Market		20/02/2003
		PSE <a href="#">BERENGUER FUSTER Luis</a>	
	Committee for opinion	Rapporteur for opinion	Appointed
	<b>ITRE</b> Industry, External Trade, Research, Energy	The committee decided not to give an opinion.	
Council of the European Union	Council configuration	Meeting	Date
	<a href="#">Justice and Home Affairs (JHA)</a>	<a href="#">2561</a>	19/02/2004
	<a href="#">Competitiveness (Internal Market, Industry, Research and Space)</a>	<a href="#">2547</a>	26/11/2003
European Commission	Commission DG <a href="#">Financial Stability, Financial Services and Capital Markets Union</a>	Commissioner	

Key events			
27/12/2002	Legislative proposal published	<a href="#">COM(2002)0767</a>	Summary
29/01/2003	Committee referral announced in Parliament		
17/06/2003	Vote in committee		Summary
17/06/2003	Committee report tabled for plenary, 1st reading/single reading	<a href="#">A5-0236/2003</a>	
23/09/2003	Decision by Parliament	<a href="#">T5-0398/2003</a>	Summary
19/02/2004	Act adopted by Council after consultation of Parliament		
19/02/2004	End of procedure in Parliament		
	Final act published in Official Journal		

Technical information	
Procedure reference	2002/0308(CNS)
Procedure type	CNS - Consultation procedure
Procedure subtype	Legislation
Legislative instrument	Regulation
	Repealed by <a href="#">2006/0267(CNS)</a>
Legal basis	EC Treaty (after Amsterdam) EC 308
Stage reached in procedure	Procedure completed
Committee dossier	JURI/5/19083

Documentation gateway					
Legislative proposal		<a href="#">COM(2002)0767</a>	27/12/2002	EC	Summary
Economic and Social Committee: opinion, report		<a href="#">CES0576/2003</a>	14/05/2003	ESC	
Economic and Social Committee: opinion, report		<a href="#">CES0598/2003</a> <a href="#">OJ C 208 03.09.2003, p. 0007-0010</a>	14/05/2003	ESC	
Committee report tabled for plenary, 1st reading/single reading		<a href="#">A5-0236/2003</a>	17/06/2003	EP	
Text adopted by Parliament, 1st reading/single reading		<a href="#">T5-0398/2003</a> OJ C 077 26.03.2004, p. 0023-0068 E	23/09/2003	EP	Summary

Additional information	
European Commission	<a href="#">EUR-Lex</a>

Final act
<a href="#">Regulation 2004/422</a> <a href="#">OJ L 070 09.03.2004, p. 0001-0007</a> Summary

## Community trade mark

**PURPOSE** : to amend certain provisions in Regulation 94/40/EC on the Community trade mark. **CONTENT** : The latter regulation instituted a unitary system of protection of the mark throughout the Member States via Community registration. This system has generally been satisfactory in fulfilling users' expectations. The functioning of the system has made it possible to identify other aspects which could clarify and further supplement it. The following changes are proposed: - Proprietors (Article 5): Under current provisions, proprietorship of a mark is allowed to certain persons under certain conditions. This is now changed so that the definition of proprietor is now open to any natural or legal person or authority established under public law. However, the rules on the priority of an earlier trade mark will continue to apply so as not to damage the rights of proprietors who are nationals of the Member States. - Search: The purpose of the searching system is to identify conflicts with other prior rights which might be invoked via the opposition procedure and might prevent the registration of the Community trade mark applied for. Having identified several drawbacks of the system, the proposal is to abolish the searching system. - Representation: The wording of Article 89(2)(c) has been adapted so that it suffices to be resident in any EU Member State to be able to deal with the Office. Changing one's place of residence or employment within the territory of the various Member States would no longer have any implications for one's representation at the Office. - Boards of Appeal: The following amendments are proposed: -the members of the Boards of Appeal, including the Chairmen, will be appointed by the Administrative Board and not the Council. This will make the appointment procedure more efficient. On the other hand, the removal of members will continue to be the responsibility of the Court of Justice; -a chairman of the Boards of Appeal can also take on the position of chairman of the appeals department; -a single member may take decisions where circumstances so merit; -the board of Appeal may take decisions, in certain cases, in an enlarged Board. - Points of procedure: The following amendments are proposed: -a provision has been added to the list of absolute grounds of refusal to make explicit that Regulation 2081/92 is not affected; -relative grounds for refusal concerning the proprietors of signs; -a technical amendment on insolvency proceedings; -filing of applications where the document

is submitted late; -division of the application and the registration; -revision of ex parte and inter parte decisions; -revocation of decisions within six months; -the alignment of the text with regard to powers with the new Community design system; -apportionment of cost, which is set automatically; -continuation of proceedings where a party to proceedings before the Office has failed to observe a time limit; -request for conversion to be entrusted to the Office and not to the national offices; -provisions on counterclaims, checks on legality and decisions on opposition or cancellation. Finally, certain fees have been abolished, such as those which do not provide the Office with real revenue but make the procedure considerably more cumbersome.?

## Community trade mark

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The committee adopted the report by Luis BERENQUER FUSTER (PES, E) amending the proposal under the consultation procedure. Whereas the proposal introduced a chairman of the appeal boards and other OHIM bodies such as the enlarged Board, the MEPs felt that this was unsatisfactory in that it stopped short of forming an organisational whole. They therefore proposed instituting an umbrella organisational entity for the boards in the form of an Administrative Tribunal, headed by a chairman, which in certain cases would be able to act as an enlarged Board. Other amendments sought to bring the proposed text into line with the TRIPS Agreement, as regards trade marks containing a geographical indication of wines and spirits, and with the Community regulation on geographical indications and designations of origin. MEPs also adopted an amendment enabling the proprietor of an earlier trade mark to oppose the registration of a new trade mark "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". In this way, the committee hoped to strengthen legal certainty and protection for the proprietors of Community geographical indications by virtue of reputation.?

## Community trade mark

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The European Parliament adopted a resolution by 464 votes in favour, 10 against and 30 abstentions a non-binding resolution on the Community trade mark system. The rapporteur was Luis BERENQUER FUSTER (PES, Spain). (Please see the document dated 17/06/03.)?

## Community trade mark

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PURPOSE : to improve the functioning of the system on the Community trademark. LEGISLATIVE ACT : Council Regulation 422/2004/EC amending Regulation 40/94/EC on the Community trade mark. CONTENT : Council Regulation 40/94/EC set up a unitary system of protection of trade marks throughout the Member States via Community registration. This Regulation aims to improve the effectiveness of the system, increase the value it adds and anticipate the consequences of additional members in future, without it being necessary to change the substance of the system, which has proven itself to be perfectly valid with regard to the objectives set. In order to rationalise the procedure, the search system is amended. It remains compulsory for Community trade marks, but it is made optional, subject to the payment of a fee, for searches in the trade mark registers of the Member States which notified their own decision to carry out such a search. Furthermore, there are measures to improve the quality of the search reports, ensuring greater uniformity by using a standard form and laying down their essential contents. There are also amendments with regard to the Boards of Appeal and certain aspects of the procedure. ENTRY INTO FORCE : 10/03/04. Point 9 of Article 1 (search) shall apply from 10 March 2008.?