

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

2013/0089(COD) - 16/01/2014 - Committee report tabled for plenary, 1st reading/single reading

The Committee on Legal Affairs adopted the report by Cecilia WIKSTRÖM (ALDE, SE) 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).

The parliamentary committee recommended that the European Parliament's position adopted at first reading under the ordinary legislative procedure should be to amend 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 'European 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: Members considered it would be disproportionate and practically unworkable to require national offices to examine absolute grounds for refusal in all national jurisdictions and languages of the Union. They therefore suggested that this provision be withdrawn.

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

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.

Small consignments: 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.

Ex officio examination for refusal on relative grounds: according to the amended text, **Member States should be free** to decide whether to conduct *ex officio* 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.

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.