“EU Trade Mark Reform”

Imogen Wiseman, Cleveland

2 October 2014

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Proposal for amending the 2008/95/EC Directive to approximate the laws of the Member States relating to trade marks

and

Proposal for a Regulation of the European Parliament and Council amending Council Regulation (EC) No. 207/2009 on the Community Trade Mark

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History of the reforms

July 2009:

European Commission publish a call for tender for a study on the overall functioning of the trade mark system in Europe

February 2011:

Max Plank Institute publish the results of their study analysing current performances and identifying areas for improvement

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MPI study: conclusions

- Greater harmonisation of substantive provisions to achieve single market
- Greater alignment of CTMD and CTMR
- Greater co-operation between OHIM and national Offices
- Specific amendments to CTMD and CTMR recommended

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History of the reforms (cont.)

March 2013:

European Commission publish their proposals, which is made open for consultation with stakeholders

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Commission’s objectives

- Cheaper, quicker, more reliable and predictable system
- Harmonised procedures, based on the CTM
- Greater cooperation between national Offices and OHIM
- Improved anti-counterfeiting measures
- Reduction of the OHIM surplus
- Implementation of the Lisbon Treaty

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History of the reforms (cont.)

July 2013:

The Committee on Legal Affairs of the European Parliament publish their draft report

September - October 2013:

European Parliament publish their amendments

February 2014:

European Parliament vote on and adopt their proposed amendments

March 2014:

Presidency table a compromise proposal

May 2014:

Progress report published

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Amendments to the CTMR and CTMD

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“Agreed” amendments

- Individual class fees
- Graphical representation
- Class headings
- Small consignments

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Goods in transit

- Without prejudice to WTO rules, trade mark owners would be entitled to prevent the import of “counterfeit” goods into the EU, without them being released for free circulation

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Amendments to the CTMR

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“Agreed” amendments

- Certification marks
- OHIM mediation centre
- OHIM’s governance and delegated acts
- Fees

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Surplus

- The Agency shall provide financial support to common projects of interest to the Union and Member States

  - Financial support may take the form of grants

  - Total funding shall not exceed 20% of OHIM's income

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Class headings

- Proprietors of CTMs covering class headings filed before 22 June 2012 may declare their intention to cover all the goods or services included in that class at the date of filing, provided the declaration is filed 4 months after the new CTMR enters into force

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Amendments to the CTMD

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“Agreed” amendments

- Absolute grounds: mandatory examination on geographical indications and designations of origin
- Relative grounds: ex-officio relative ground examination optional
- Reputation outside Member States to be disregarded

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“Agreed” amendments (cont.)

- Administrative opposition

  Obligation on all national Offices to provide administrative opposition procedures

  Obligation on national Offices to accept oppositions based on more than one earlier right in the same ownership

  No limitation regarding the locus standi of an opponent

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“Agreed” amendments (cont.)

- Administrative cancellation

  Obligation on national Offices to provide for efficient and expeditious administrative revocation and invalidity actions

  Declarations of invalidity can be based on more than one earlier right in the same ownership

  Proof of use must be filed for the 5 years preceding the date the cancellation action was filed

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Omissions

- Extended absolute grounds examination
- Double identity rule
- Genuine use
- Bad faith opposition

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Current status

- May 2014 – European elections
- New parliament – including large number of nationalists
- Cecilia Wikstrom re-appointed Rapporteur:-

born
could

"I won't be able to give any timeframes on when we will start the negotiations or have a final decision on the package but I am a optimist and I think that, if everyone gets their act together, we conclude before Christmas. "

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Conclusions

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