

GRUR/ECTA

Joint Brussels Workshop

The New Package and Legal Proposals – Outcome and next steps

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Preliminary thoughts

- Past and present
- Amendment of CTMR and abolishment of the CTM
Implementing Regulation and Fees Regulation:
Governance of the Agency
- “Recast” of Directive and National /Benelux IP Offices

Fees for the European Trade Mark

		Current	New
Application fee		900 (3 classes)	775 (1 class)
Class fees	2nd class	--	50
	3rd class	--	75
	4th and subsequent classes	150	150
Total amounts	Application fee (1 class)	900	775
	Application fee (2 classes)	900	825
	Application fee (3 classes)	900	900
Renewal fee		1350 (3 classes)	1000 (1 class)
Class fees	2nd class	--	100
	3rd class	--	150
	4th and subsequent classes	400	300
Total amounts	Renewal fee (1 class)	1350	1000
	Renewal fee (2 classes)	1350	1100
	Renewal fee (3 classes)	1350	1250

Streamlining procedures

- Filing Office (only Agency in Alicante) .art 25
- Payment due in filing date (one-month period to pay abolished) .art 27
- Priority claim: only with application .art. 30 and 33
- National searches abolished .art 38 and 155

Streamlining procedures

- Observations by third parties: more flexible term .art 40
- Revision of decisions inter partes deleted . art 62
- Continuation of proceedings clarified .art 82
- Opposition period for IR shortened .art 156

Streamlining procedures (cont.)

- Disclaimers deleted .art 37 (para 2 deleted)
- Registration with no fee payment confirmed .art 45
- Use of a symbol meaning “registered mark”: art 45 (3) and (4)
- Form of decisions and communications from the Agency. Identifying name or names of officials responsible .art 75
- Notification .art 79

Increasing legal certainty

- Designation and classification of goods and services (clarity and precision) .art 28
- Amendment of lists filed before 22 June 2012, within 4 months from the entry into force of the Regulation

If not: literal meaning of the indications included in the heading of the relevant class

Promoting cooperation and convergence .art 123c

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.

Promoting cooperation and convergence .art 123c

This cooperation shall cover the following areas of activity:

- the development of common examination standards;
- the creation of common or connected databases and portals for Union-wide consultation, search and classification purposes;
- the continuous provision and exchange of data and information, including the feeding of the said databases and portals;
- 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;
- the sharing of information on industrial property rights and procedures, including mutual support to helpdesks and information centres;
- the exchange of technical expertise and assistance in relation to the areas laid down in precedent points.

New Directive

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’).

The new proposals intend to make 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.

New Directive: Objectives

- Modernising and improving the existing provisions of the Directive;
- Achieving greater approximation of national trade mark laws and procedures and make them more consistent with the Community trade mark system, by (a) adding further substantive rules and (b) introducing principal procedural rules into the Directive in accordance with provisions contained in the Regulation;
- Facilitating cooperation between the offices of the Member States and OHIM for the purpose of promoting convergence of practices and the development of common tools, by putting in place a legal basis for this cooperation.

New Directive

The existing divergences between national systems and the Community trade mark system are regarded significant.

They are due to the fact that the Directive does not cover procedural aspects and that a number of important substantive law issues are not yet harmonised.

Convergence of practices and tools at trade mark offices is needed: more cooperation between offices will avoid legal uncertainty, and will enhance the complementarity between the Community (European) trade mark and national trade mark systems.

New Directive

Option 2: Partial expansion of the approximation of national laws and their consistency with the Community trade mark system. This would include aligning the principal procedural rules with the relevant provisions of the Regulation, including those where existing difference create major problems from the users' perspective, and where such alignments are deemed indispensable for creating a harmonious, complementary system of trade mark protection in Europe. It would also cover the alignment of further aspects of substantive law in accordance with the provisions of the Regulation.

New Directive

- Compulsory protection for geographic indications and traditional terms;
- New mandatory protection for marks with reputation (presently optional);
- A new set of rules dealing with trade marks as objects of property;
- Specific provisions relating to collective marks, to complement the changes to the CTM system.

New Directive

Achieving alignment of principal procedural rules

- Designation and classification of goods and services .art 40
- Ex officio examination .art 41
- Fees .art 44
- Opposition administrative procedure .art 45
- Non use as defence in opposition proceedings .art 46
- Revocation and invalidity administrative procedures .art 47
- Non use as defence in invalidity proceedings .art 48

Procedure for revocation or declaration of invalidity .art 47

1. Member States shall provide for an administrative procedure before their offices for revocation or declaration of invalidity of a trade mark.
2. The administrative procedure for revocation shall provide that the trade mark shall be revoked on the grounds provided for in Articles 19 and 20.

Invalidity proceedings .art 47 (cont)

3. The administrative procedure for invalidity shall provide that the trade mark shall be declared invalid at least on the following grounds:

(a) the trade mark should not have been registered because it does not comply with the requirements provided for in Article 4;

(b) the trade mark should not have been registered because of the existence of an earlier right within the meaning of Article 5(2) and (3);

New Directive

Facilitating cooperation between offices and with the Agency (Article 52)

As a complement to the legal framework for cooperation proposed in the context of the review of the Regulation, Article 52 provides a legal basis to facilitate cooperation between OHIM and the intellectual property offices of the Member States for the purpose of promoting convergence of practices and the development of common tools.

New Directive

Transposition

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with Articles 2 to 6, 8 to 14, 16, 17, 18, 22 to 28, and 30 to 53 by 24 months after entry into force of this Directive at the latest. They shall forthwith communicate to the Commission the text of those provisions.



Thank you for your attention!

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