



# **Revision of the European Trade Mark system**

**Tomás Lorenzo Eichenberg  
Industrial Property Unit**

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# Initiatives package

**1. Revision of Regulation 207/2009 on the CTM**

**2. Recast of Directive 2008/95 approximating the laws of the Member States relating to trade marks**

**PLUS**

**3. Draft Commission Reg. adjusting fees payable to OHIM**

- Different legislative path (former comitology)
- Adoption by the Commission as an implementing act

## **Main objectives of package**

**1) to foster innovation and economic growth by making trade mark systems all over Europe more accessible, efficient and effective for businesses**

**dovetailed with efforts**

**2) to ensure and develop complementarity and interoperability between Union and national systems**

# 1. Modernising & increasing legal certainty

## Both instruments, e.g.:

- **Definition of a trade mark** (Art 3 TMD/4 CTMR) – graphical representability replaced by more flexible criteria
- **Rights conferred by a trade mark** (Art 10, 11 TMD/9, 9a TMD), in particular more effective protection to fight counterfeiting (goods in transit)
- **Intervening rights** (Art 8, 18 TMD/Art 13a , 53(1) CTMR) → proof of use/5 years preceding *date of filing/date of priority* (Art 46(1), 48(2) TMD/42(2), 57(2) CTMR)

## Regulation, e.g.:

- **Protection of geographical indications** (Art 7(1)(j) CTMR)
- **European Certification Marks** (Art 74b – 74k CTMR)

## 2. Greater approximation of substantive law

- **Protection of geographical indications** (Art 4(1)(i), 5(3)(d) TMD)
- **Protection of trade marks with reputation** (Art 5(3)(a) TMD)
- **Trade marks as objects of property** (transfer, licencing, rights in rem, levy of execution and insolvency, Art 22 – 27 TMD)
- **Collective marks** (Art 30 – 37 TMD)

## 3.1 Harmonising principal procedural rules

e.g.:

- **Designation and classification of goods and services**, including use and interpretation of class headings (Art 40 TMD/28 CTMR)
- **Ex officio examination** – limited to absolute grounds for refusal (Art 41 TMD)
- **Fees** – "one-class-per-fee" system, allowing more targeted registration per product class for a proportionate fee (Art 44 TMD) → Draft COM Reg. on fees
- **Mandatory administrative opposition procedure**, incl. non-use defense (Art 45, 46 TMD)
- **Mandatory administrative cancellation procedure**, incl. non-use defense (Art 47, 48 TMD)

## 3.2 Streamlining procedures in CTM Reg.

e.g.:

- **Filing of applications** (Art 25 CTMR) – filing via national offices abolished
- **Filing date** (Art 27 CTMR) – obligation to pay the fee linked with the filing of the application (one-month period abolished)
- **Searches** (Art 38 and 155 CTMR) – current search regimes abolished to be replaced by modern IT tools → speeds up registration procedure as publication of the application can occur one month earlier (Art 39 CTMR becoming obsolete so far)

## 4. Providing framework for cooperation to promote convergence of practices and common tools

- Explicit task for OHIM as set out in new Art 123b(1)(c) CTMR
- New Art 123c CTMR: Legally and financially solid, result oriented mechanism
- Mandatory cooperation to promote convergence of practices and tools, coordinated by Agency
- Broadly defined areas of activity (flexibility)
- Common projects of Union interest
- Funding based on grants
- Up to 10% of annual Agency income



## 5a. Adapting to the Lisbon Treaty

- **Terminology**
  - Community trade mark → European trade mark
- **Delegated powers**
  - **Alignment of the "comitology" powers conferred upon the Commission to Article 290 of the Treaty**
    - Currently three implementing Regulations on: (i) procedures in general, (ii) fees, and (iii) functioning of Board of Appeals
    - New Articles:  
24a, 35a, 45a, 49a, 57a, 65a, 74a, 74k, 93a, 114a, 144a and 161a  
CTMR

## 5b. Improving rules on governance

- **Inter-institutional Common Approach on decentralised agencies of July 2012 as benchmark/best practice**

### Main changes:

- **Terminology:**
  - OHIM → European Union Trade Mark and Design Agency (Art 2 CTMR)
- **Modernising OHIM's governance rules for more transparency and accountability**
  - In part. strengthening role of the Management Board
- **Ensuring balanced OHIM budget in future (Art 139(4), 144(2) CTMR)**