



association des praticiens du droit des marques et des modèles

Paris, 15 octobre 2013

APRAM Comments
On the
Committee on Legal Affairs draft report of July 31, 2013 on the proposal
for a recast of the Trade Mark Directive and on the proposal for a
regulation amending the Community Trade Mark regulation.

APRAM globally approves the proposals for amendments made by the Rapporteur and appreciates the time spent by the Rapporteur to hear the major stakeholders, in particular our association, and greatly appreciates the considerable work undertaken in such a short timeframe.

APRAM particularly welcomes the following proposed amendments:

- The fact that the “complementary relationship between the European Union trade mark system and national trade mark system should be ensured” (recital 5 of the Directive).
- The suppression of the Absolute grounds for refusal in other Member States (Art 452 a Directive).
- The suppression of the reference to the function of origin in the case of double identity (Art. 10§2 Directive; 9§2 Regulation). In this regard, APRAM has already clearly expressed its opposition to the Commission’s proposal, as it limits the scope of trade mark protection.
- The possibility to file an opposition on the basis of one or more earlier rights (Art.45§2 Directive).
- The fact that the fee structure should be regulated in the Regulation and not to be left to delegated acts. The Rapporteur rightly pointed out that the fee structure is an important element of the EU trade mark system.
- The role of the users and the importance to consult them (Art 123 c Regulation).
- The abolition of the executive board of the Office (Art 127 a Regulation).



However, APRAM is opposed to the following proposed amendments:

- Rights conferred by a trade mark (Art. 10§4 Directive; Art 9-4 Regulation)

APRAM strongly approves the text of the Commission, which would be a more effective means to fight against the entry of infringing goods in the EU. The modification proposed by the Rapporteur and the justification for this modification is unconvincing. Indeed, even if some goods have been legitimately placed on the market outside of the EU, the importation within the EU is not legitimate if such goods infringe a mark protected within the EU.

- Transit (Art 10-5 Directive ; Article 9-5 Regulation)

APRAM strongly supports the text of the Commission, which constitutes the minimum protection to which trade mark owners are entitled, and therefore disagrees with the proposed amendment of the Rapporteur to limit the rights of trade mark owners to cases where the trade marks are identical.

However, the terms of recital 22 and article 10-5 should be aligned for consistency to prevent any difficulties of interpretation.

Text proposed by the Commission
Recital 22

With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is **essentially identical** to the trade mark registered in respect of such goods

Text proposed by APRAM
Recital 22

With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorization a trade mark which is **identical** to the trade mark registered in respect of such goods **or which cannot be distinguished in its essential aspects from that trade mark.**

APRAM disagrees with the Rapporteur's proposed amendment requiring the right owner to provide proof of a validly registered trade mark in the country of destination. Such a requirement is not appropriate since, in practice, customs documents seldom disclose the country of final destination.



Moreover, by virtue of Customs Regulations 608/2013, which come into force 1st January 2014, and in particular article 17-2 the only information that the Customs services will be entitled to disclose is “information about the actual or estimated quantity of goods, their actual or presumed nature and images thereof, as appropriate” but never the country of destination.

Requiring protection in the country of destination could undermine the purpose of such a provision, as counterfeiters could declare a false final destination or select final destinations where the mark is not protected.

Finally, the final sentence of recital 22, as proposed by the Rapporteur, relating to medicines should be deleted because it lacks legitimacy and is not related to the question of goods in transit which counterfeit a mark.

- Recordals of Transfers

APRAM supports amendments 30-31 of the Directive but does not support amendment 29 of the Directive which deletes the requirement for an assignment to be in writing.

It is desirable for reasons of legal certainty for an assignment to be attested in writing to avoid difficulties of proving proprietorship at a later date where such changes have not been recorded. The assignment should be signed by at least the assignor.

- Name of the Agency

APRAM does not see the need to change the name of the Agency. The current name OHIM is now well-known in the IP community throughout the world. A compromise could be to maintain the current name OHIM and to add an indication which reflects the activities of OHIM such as:

OHIM
European Union Intellectual Property Agency

- Fees

Whilst APRAM supports both the fact that the fees be governed by the Regulation and the fee structure, APRAM considers that the level of the renewal fee and the fee for recording a transfer remains too high.

- Delegated Acts

APRAM has previously expressed the view that OHIM has significant expertise in conducting proceedings in accordance with underlying procedural rules. OHIM should therefore remain directly involved in the adoption of these delegated acts. Moreover, users should also be closely involved and consulted in the process concerning the adoption of these rules. A provision which guarantees the role of both OHIM and users should be included in the proposal.

- Role of users

The Rapporteur proposes to add a representative of the European Parliament in the management board of the Agency. In the current system, user associations are observers at the Administrative Board and Budget Committee of the OHIM. We suggest that the presence of the user association in the management Board should also be stipulated in the regulation.

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