



Revision of the European Trade Mark system

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Context and preparatory works

- **2008 + 2011 IPR Strategy Communications**
- **Max Planck Study**
- **Stakeholder dialogue**
- **Impact Assessment**
- **Lisbon Treaty & Inter-institutional Common Approach**

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 TM** (Art 3 TMD/4 CTMR) – graphical representability replaced by more flexible criteria
- **Rights conferred by a TM** (Art 10, 11 TMD/9, 9a TMD), in particular more effective protection to fight counterfeiting (goods in transit, commercial consignments and preparatory acts)

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 free of charge → 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**
- **Clearly defined areas of activity**
- **Common projects of Union interest**
- **Funding based on grants**
- **Up to 10% of annual Agency income**

5.1 Alignment 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

5.2 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)**

6. 'One-class-per-fee-system' at Union level

Main considerations for Draft COM Reg. on fees:

- **Take into account diminished scope of TM protection**
- **Preserve balance between CTM and national systems**
- **Meet the requirement of a balanced budget**
- **Ensure overall coherence of the new fee structure**

Proposed fee levels

	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

State of play and outlook

- **Situation in the Council**
- **Situation in the European Parliament**
- **Situation in the Committee on Fees**



**Thank you very much for your
attention!**

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