

Max Planck Institute
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The EU trademark reform package –
Back to status quo?

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What happened so far

- March 2013 Publication of Commission Proposals (CP) for CTMR amendment and TMD recast
- July 2013 Draft report of EP Legal Committee (C. Wikström)
- Dec. 2013 Proposal of Lithuanian presidency to Council working group
- Jan. 2013 Report of EP Legal Committee

- 27 Feb 2014 – 1st reading of CP in EP (plenary)

Effect of elections??



Issues and reactions (so far)

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|--|------------------------|
| ■ Distribution of OHIM revenues | CP modified |
| ■ Deletion of graphical representation | CP (slightly) modified |
| ■ Prohibition of ex-officio examination of relative grounds (prior rights) | CP rejected |
| ■ Examination of absolute grounds obtaining in other MS (and world-wide) | CP rejected |
| ■ Restriction of 'double identity' protection to the origin function | CP rejected |
| ■ Infringement by goods in transit | CP modified |



Examination of absolute grounds

- Pursuant to CP, offices in MS shall reject applications (also) if
 - An absolute ground for refusal obtains in other MS or in case that the application is transcribed/translated into an official language or script of a MS
 - The latter provision shall also apply in the CTMR
- MS argue that such an obligation would be inappropriate and disproportional
- EP follows suit and rejects the proposal
- A (better) compromise solution might have been to exclude terms from registration that are plainly descriptive (or generic) of the goods or services they shall designate (e.g. “matratzen“ for mattresses)



Trade mark functions

- According to CP, absolute protection under the double identity rule shall only apply if the origin function of the mark is negatively affected thereby
 - The change is (allegedly) motivated by a need to reinstall clarity and legal certainty that have been distorted by recent CJEU jurisprudence
- However, the proposal is self-contradictory
 - Use of mark in comparative advertisement shall remain a potential case of tm infringement
 - Principle of regional exhaustion could be jeopardized by CP (but shall be maintained)
- EP rejects CP, preserves status quo
- Preferably, scope and purpose of double identity rule should be clarified in the preamble



Goods in transit

- According to CP, goods entering EU territory in transit shall be considered as infringing if they bear, without authorization of the right holder, an identical or very similar sign to a CTM (or a national mark in the state of entry), thereby appearing as counterfeits
- EP Legal Committee report: provision goes too far, should be restricted to cases when marketing of the goods would also be illegal in the country of destination
- EP plenary: accepts CP, under the reservation of compatibility with Art. V GATT, and provided that no prejudice is caused to transit of generic medicaments
- Will satisfy WTO requirements?



Thank you for your attention!

