

## INFORMATION NOTE

7 March 2013

There have been a number of press reports on leaked draft legislation proposed by the European Commission as its long awaited response to the Study on the Overall Functioning of the European Trademark System, initially foreshadowed in 2009, and completed by the Max Planck Institute in February 2011.

As wide publicity has been given to the draft proposals, **MARQUES** is providing this document to inform members of the contents of the leaked drafts. However, it should be noted that the versions available are not “official” and may change prior to being adopted. The document provides an overview of how the proposals compares with previous **MARQUES** positions as well as initial **MARQUES** reactions that are, however, not to be perceived as positions. These will be issued when the Commission has launched its proposals.

Like the Study itself, the Commission’s proposals are wide-ranging. The Commission’s proposals include two draft Regulations – one to amend the CTM Regulation (no 207/2009) and a separate draft Regulation to abolish the CTM Implementing Regulation (no 40/94) and to amend the Fees Regulation (no 2869/95). In addition, changes to national law are proposed, with a “recast” Directive.

The Commission notes that the “main common objective” is “to foster innovation and economic growth by making trademark 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”.

Recital 6 of the recast Directive states:

“in order to meet increased demands from stakeholders for faster, higher quality, more streamlined trademark registration systems, which are more consistent, user friendly, publicly accessible and technologically up-to-date, there is a necessity to modernise the trademark system in the Union as a whole and adapt it to the Internet era”.

**MARQUES** supports these objectives, as well as many of the proposals. **MARQUES** is also pleased to see that the substantial submissions made by **MARQUES** and other user groups have been adopted in large part into the proposals. **MARQUES** will continue to work with the Commission, member states, OHIM and other sister organisations to ensure that the proposals meet the needs of users of the European trademark system.

UNIT Q  
TROON WAY BUSINESS CENTRE  
HUMBERSTONE LANE  
THURMASTON, LEICESTER  
LE4 9HA  
TEL: +44 116 274 7355  
FAX: +44 116 274 7365

email: [info@marques.org](mailto:info@marques.org)  
[www.marques.org](http://www.marques.org)

## 1. Major Proposals – CTMs and OHIM

The Commission notes that it is not proposing a new trademark system, “just well-targeted modernisation of existing provisions”. It has set out the following aims in relation to CTMs:

- Streamlining application and registration procedures for CTMs;
- Increasing legal certainty by clarifying provisions and removing ambiguities;
- Establishing an “appropriate framework for cooperation” between OHIM and national offices for promoting convergence; and
- Aligning the framework to Article 290 of the Treaty on the Functioning of the EU and adapting terminology to the Lisbon Treaty.

Perhaps most readily noticeable is the proposal to change the designation Community trademark (CTM) to European trademark (ETM), and to change the name of OHIM to the European Union Trademarks and Designs Agency (EUTDA?). The President of OHIM will become the Executive Director of the Agency. This is the result of a review of all EU agencies aimed at harmonising agency structures.

Some major changes to CTM filing practice are proposed:

- The ability to file CTMs at national offices (and the Benelux Office of Intellectual Property) will be abolished;
- CTM fees will become due immediately on filing, not a month later, to prevent the filing of “test applications”; and
- The current optional search of some national registries will be abolished. **MARQUES** welcomes the abolishment of national searches.

In terms of legal certainty:

- The requirement for “graphic representability” of a mark is to be abolished, allowing for the registration of sound and smell marks. “Colours as such” and “sounds” will be specifically included in the definition of trademark;
- Following the *Philips/Nokia* decision on suspensive customs procedures, the burden of proof will be reversed so that the importer must prove that the counterfeit goods are destined for a territory outside the EU;
- A prohibition is to be introduced on the production and distribution of labels and packaging which may subsequently be combined with illicit products;
- Amendments are made to incorporate the *IP TRANSLATOR* decision on specifications of goods and services; and
- Certification marks are to be introduced.

Proposals are also made to promote cooperation between OHIM and national trademark offices (and BOIP). OHIM and national offices will be obliged to cooperate with one another. A compulsory cooperation framework will provide for mandatory access to tools to assist in technical capacity building at national offices. This is all to be financed from the OHIM budget.

On fees, the fee structure is amended to include only one class of goods/services on application and renewal. Users will not be penalised – a three class application will not cost more than currently. Further fee incentives are provided for using OHIM's common converged classification database.

## 2. Major Proposals – National Law

The proposed recast Directive is to be considered together with the draft Regulation impacting on CTM practice and procedure. The recast Directive notes some specific objectives:

- Modernising and improving the existing TM Directive by amending outdated provisions, increasing legal certainty and clarifying trademark rights in terms of their scope and limitations;
- Achieving greater harmonisation of national laws and procedures, aiming to make them more consistent with the CTM system by adding further substantive rules and introducing principal procedural rules; and
- Facilitating cooperation between national offices and OHIM.

Interestingly, the Commission considered full scale harmonisation, with a single trademark rulebook to replace member states' national trademark law in their entirety. This was rejected, in favour of partial expansion of harmonisation.

In addition to the substantive laws proposed for the CTM system, the major changes proposed for national law include:

- Compulsory protection for geographic indications and traditional terms;
- New mandatory protection for marks with reputation (presently optional);
- A new body of rules dealing with trademarks as objects of property;
- Specific provisions relating to collective marks, to complement the changes to the CTM system;
- Abolition of relative grounds examination in the 12 member states which maintain it;
- Filing fees will only include one class and additional class fees will be introduced;
- Administrative opposition and cancellation procedures before the national office (rather than having to go to court); and
- The ability for an applicant for national rights to request proof of use of any prior trademark relied on, where it has been registered in excess of five years.

As a general statement, national trademark law and practice will be brought much closer to the law as it relates to CTM and OHIM practice.

Several member states will have little to do to implement the recast Directive – others will need to make significant changes to their local law and practice. **MARQUES** strongly supports the harmonisation of national practices and procedures, and particularly the significant cost savings to be obtained with administrative opposition and cancellation procedures. **MARQUES** also specifically supports the abolishment of relative grounds examination.

### 3. Detailed Proposals - OHIM

#### *Renaming*

Community trademark is to be changed to European trademark, with similar changes to European collective mark and European trademark court (Article 1(1), (2) and (3) of the draft Regulation).

OHIM's name changes to European Union Trademarks and Designs Agency, referred to throughout the legislation now as the Agency, rather than the Office (Article 1(5) and (6) of the draft Regulation).

#### *Delegation of powers*

Significant provision is made for the delegation of powers to the Commission, rather than having to enact further changes to the Implementing Regulation and the like. Few aspects of practice or procedure are left untouched by the delegation provisions.

**MARQUES** welcomes the flexibility that this grants, so that minor changes can be made, following consultation, but without the need for primary legislation.

The Implementing Regulation is abolished, with instead a broad power given to the Commission to adopt delegated acts.

#### *Graphical Representation*

The Study looked at the requirement for trademarks to be represented graphically – the Commission now proposes that a sign should be permitted to be represented in any appropriate form, and hence Article 4 of the CTM Regulation is amended to provide that, to be registered, a sign must be capable of “being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor” (Article 1(7) of the draft Regulation).

This, in effect, enables the filing of CAD files, musical recordings, videos and other representations that do not currently meet the *Sieckmann* requirements. OHIM will likely have to make further rules as to which forms of representation it will accept.

The definition of trademark is widened specifically to include “colours as such” and “sounds”.

**MARQUES** supports the additional flexibility that this proposal brings to the system – consumers are used to recognising sounds, smells and other signs as indications of source of origin, and hence such signs should be registerable. Consistency of practice between OHIM and the national offices is to be encouraged, to avoid the situation where a mark is allowed in some member states and not others.

#### *Geographical Indications*

EU trademark law currently provides a lower level of protection for geographical indications and designations of origin than other EU legislative instruments. The proposed amendments add as absolute grounds for refusal of a CTM prior designations of origin, geographical indications and protected traditional terms for wine and traditional specialities (Article 1(8)(a) of the draft Regulation). Designations of origin and geographical indications are also expressly made a ground for third party oppositions: Article 1(9)(b) of the draft Regulation.

#### *Foreign descriptive terms*

Currently, a descriptive term in a language or script other than the EU's 23 (24 from July 2013) official languages or three official alphabets would not be blocked from registration as a CTM.

Article 1(8)(b) of the draft Regulation provides for non-registerability on absolute grounds of terms that would be descriptive if translated or transcribed into any script or official language of a member state. Thus, Chinese characters, for example, that would be descriptive in China will now be blocked from registration in the EU.

#### *Bad faith*

A limited form of bad faith opposition is introduced (currently, it is only available as a grounds for CTM invalidity post-registration). Article 1(9)(a) of the draft Regulation provides for a new Article 8(3)(b) in the CTM Regulation that provides for opposition “where the trademark is liable to be confused with an earlier trademark protected outside the Union, provided that, at the date of the application, the earlier trademark was still in genuine use and the applicant was acting in bad faith”.

This provides for significantly enhanced protection for marks outside the EU. As noted below, the similar amendment to national law achieved through the recast Directive should be altered to provide protection for marks not only outside the EU, but also outside the member state concerned but within the EU.

There had been a discussion during the consultation of adding bad faith as an absolute ground for OHIM to examine. Sensibly, this has not been taken up in the proposals.

#### *Marks with reputation*

Article 8(5) is amended to accommodate the Court of Justice's decision in *Davidoff* – the provision applies irrespective of whether the goods/services applied for are similar to or different than the goods/services for which the earlier mark has reputation.

This simply codifies the existing position.

#### *Rights conferred by a European trademark*

A new provision is proposed to ensure “full consistency with the principle of priority” – enforcement of rights conferred by a European trademark are “without prejudice” to the rights of earlier rights holders in conformity with Article 16(1) of TRIPs (Recital 17 of the draft Regulation). Article 1(10) of the draft Regulation provides a replacement for Article 9 of the CTM Regulation.

Although not expressed, this would appear to implement the Court of Justice's ruling in *Celaya* in relation to RCDs, and recently confirmed by the Court in relation to CTMs in Case C-561/11.

#### *Trade Names*

Use as a trade or company name (or part of a trade or company name) is added to the list of objectionable activities that a CTM owner is entitled to prevent. Recital 18 notes that “[c]onfusion as to the commercial source from which the goods or services emanate may occur when a company uses the same or a similar sign as a trade name in a way that a link is established between the company bearing the name and the goods or services coming from that company”.

The Recital adds a proviso that the use of the company name must be made for the purposes of distinguishing goods or services as to their commercial origin.

In practice, it has been difficult to remove company or trade names from national registers unless and until the company begins to trade. **MARQUES** welcomes this change.

#### *Comparative advertising*

A specific reference is added in the list of actions a CTM owner is entitled to prevent to “using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC” (Article 1(10) of the draft Regulation). This codifies the existing position.

#### *Private importation*

The draft Regulation makes clear that importation into the EU of goods infringing a CTM can be prevented where the importer is not acting for commercial purposes, but the consignor is. This will catch infringing goods bought by individuals outside the EU (for example, over the Internet).

#### *Customs procedure*

The Court of Justice’s decision in *Philips/Nokia* outraged trademark owners, because of the high burden it placed on the policing of counterfeit goods. In short, obviously counterfeit goods from outside the EU that were stopped on their way through the EU to a third territory, could not be seized under the customs procedure. The draft Regulation puts the onus on the counterfeiter to provide evidence that the final destination of the goods is beyond the territory of the EU. Without such evidence, the goods will be presumed destined for the EU, and liable to be seized under the customs procedure (Article 1(10) of the draft Regulation).

Whilst not the optimum outcome for brand owners, **MARQUES** can support this as a good compromise solution.

#### *Preparatory actions - labels*

A new Article 9a is added to the CTM Regulation to enable a CTM owner to take action against get-up or packaging where there would be an infringement if the get-up or packaging were combined with goods.

This clarifies the situation where labels are discovered which, if affixed to goods, would constitute trademark infringement. The proposed change is to be welcomed.

#### *Honest use of trademarks*

Recital 23 of the draft Regulation expresses that CTM rights should “not entitle the proprietor to prohibit the use of signs or indications which are used fairly and in accordance with honest practices in industrial and commercial matters”. Article 12 of the CTM Regulation is therefore replaced by Article 1(12) of the draft Regulation. The impact includes:

- The “own name” defence to trademark infringement will only apply to personal names, and not trading names;
- “signs or indications which are not distinctive” remain free for third parties to use, even if registered as trademarks; and
- The fair and honest use of a third party trademark to identify or refer to the goods or services as those of the proprietor is expressly provided for.

Greater assistance is given on what third party use is not in accordance with honest practices:

- “it gives the impression that there is a commercial connection” between the third party and the CTM owner; and
- “it takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark without due cause”.

These clarifying provisions on the extent of CTM rights are to be welcomed.

However, the wording “signs or indications which are not distinctive” should be clarified to “signs or indications which are [not distinctive] used in a descriptive manner”, in order to avoid discussions on whether the trademark is descriptive. This should be left to the proceedings provided for this purpose.

#### *Intervening rights*

A proposed new Article 13a of the CTM Regulation attempts to deal with intervening rights. Take, for example, the following situation. CTM A has been registered for more than 5 years, and has never been in genuine use. CTM B is applied for, and registered. The owner of CTM A could not oppose without proof of use. The proposal prevents CTM A from being used later against goods bearing CTM B, once CTM A has been put to genuine use.

The wording of the new Article 13a instead requires the owner of CTM A to apply to invalidate CTM B first.

#### *Use of a different sign still genuine use*

Despite discussions about reducing the non-use period to three years, it has been maintained at five years, as **MARQUES** advocated. Also, although genuine use in only one member state was a hot issue during consultations, it is not dealt with in the proposed legislation. Rather, this issue has been left to the Court of Justice (*ONEL*, Case C149/11).

Many trademarks are used in forms slightly different from the registration. Use of a CTM in a form differing in elements, which do not alter the distinctive character of the mark has long been accepted as “genuine use”. However, there has been debate as to whether this still applies if the “differing” form is also registered.

Article 1(14) of the draft Regulation amends Article 15(1) of the CTM Regulation to make it clear that it does not matter if the differing form is also registered – use of the differing form can still count as genuine use.

#### *Recordal of CTM transfers*

OHIM’s role in assessing whether a transfer of a CTM might mislead the public is removed – Article 17(4) of the CTM Regulation is deleted.

Article 18 of the CTM Regulation is amended in effect providing for applications to OHIM or a Community trademark court for assignment of marks wrongly registered by agents or representatives, rather than necessitating requests/counterclaims for invalidity.

Amendments are also proposed to Articles 19, 20 and 22 for the recordal of rights *in rem*, levies of execution and licenses.

#### *Filing CTM applications at national offices*

Although only a few applications are filed via the national offices, **MARQUES** and sister organisations requested that the Commission retain the ability to file CTM applications at national offices in member states as an option for SMEs until the use ceased completely. However, this alternative route will be abolished by amendments to Article 25 of the CTM Regulation. OHIM will be the sole agency to which CTM applications can be made.

#### *Fee required for filing date*

OHIM had submitted to the Study that CTM applicants were taking advantage of the rapid examination of CTMs by filing applications, and then not paying the filing fee if a negative examination report was received.

Amendments to Article 27 of the CTM Regulation remove this difficulty, by requiring the fee to be paid in order to obtain a filing date. The proposed language refers to the "order for payment" being made, rather than the fee itself having been paid. This presumably allows for a filing date where the box has been ticked to take the money from an account at OHIM, and there are sufficient funds in the account.

#### *Designation and classification of goods and services*

The rulings of the *IP TRANSLATOR* decision of the Court of Justice are implemented in a new Article 28, set out at Article 1(24) of the draft Regulation. **MARQUES** supports the requirement for sufficient clarity and precision as put forward by the Court.

In the *IP TRANSLATOR* decision, the Court of Justice did not rule on already registered trademarks, which recite one or more class headings. Article 28(8), as set out in the draft Regulation, provides that the owners of these registrations may declare, within a (not yet) specified term from the entry into force of the draft Regulation, "that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing". Registrations for which no declaration is filed shall be deemed to extend, *as from the expiry of that period*, only to goods or services covered by the literal meaning.

The purpose of this provision is obviously to give those applicants who relied on OHIM's Communication 4/03, an opportunity to "correct" their list of goods and services to what they had intended to protect when, at the time of filing, they recited a class heading instead of the individual goods and services of interest.

**MARQUES** has been a long-standing supporter of the 'means-what-it-says' approach, and while **MARQUES** appreciates the fact that the Commission is seeking to assist businesses that might have been misled by Communication 4/03, it is apparent that such an option would only add another layer of complication. The "corrected" registrations would have to be republished for opposition purposes, and in effect this would only increase the lack of clarity.

The majority of the registrations (those from June 2003 to June 2007) will already be vulnerable to non-use cancellation actions, and **MARQUES** questions how many applicants did in fact rely completely on the Communication 4/03. **MARQUES** would prefer to leave any interpretation of individual registrations made prior to the *IP TRANSLATOR* decision in the hands of the Courts.

**MARQUES** suggests that Article 28(8) is deleted.

The aforementioned comments apply *mutatis mutandis* to Article 40 of the recast Directive.



### *Priority*

Claiming priority is simplified, whether from a foreign trademark application (Article 30 of the CTM Regulation) or exhibition priority (Article 33 of the CTM Regulation). In relation to priority from a foreign trademark application, the priority claim need only include the date, number and country of the previous application.

No changes are proposed to OHIM's procedures for examining priority claims.

### *Seniority*

Although changes to the seniority examination process were mooted during consultations, none have been proposed. **MARQUES** is pleased to see that no fee has been suggested for seniority claims.

Changes are proposed to seniority claims where the earlier mark is declared invalid or revoked. Paragraph 3 of Article 34 of the CTM Regulation is replaced. Surrender of the earlier trademark is no longer covered (only invalidity and revocation). Seniority will only lapse on revocation if the revocation takes effect prior to the filing (or priority) date of the CTM.

Some limited harmonisation is proposed in the recast Directive – see below.

### *Disclaimers of non-distinctive material*

The proposals abolish the ability of OHIM to require that non-distinctive elements in a CTM are disclaimed. This is achieved through the deletion of Article 37(2) of the CTM Regulation. **MARQUES** supports this proposed change.

### *Searches*

Searches by OHIM and by member states are abolished. Recital 30 notes that the current regime is “neither reliable nor efficient”. The Recital notes that it should be replaced by “all-encompassing, fast and powerful search engines for the free use of the public”. This, however, is not provided for in the proposed changes.

As a result, there is no need for publication to be held up for one month after the searches are provided – OHIM may publish immediately (and Article 39 of the CTM Regulation is amended accordingly).

It also means that prior CTM owners will not be notified of later CTM applications filed.

### *Publication*

There is a further amendment to Article 39 of the CTM Regulation that perhaps has further reaching consequences than at first appears. The new sentence reads: “The publication of the application shall be without prejudice to information already made available to the public otherwise in accordance with this Regulation or with delegated acts adopted pursuant to this Regulation”.

A specific requirement for OHIM to correct any mistakes or errors in the publication of an application is also newly provided.

### *Observations*

Observations enable a third party to submit comments on the registerability on absolute grounds of a CTM application, without becoming a party to the proceedings.

Article 40 of the CTM Regulation is amended, with the main changes being that observations can be filed at any time prior to the end of the opposition period, or, if an opposition is filed, prior to the opposition being determined. There will be no requirement for the third party to wait until the CTM is published for opposition purposes before the third party files observations.

Whilst **MARQUES** is happy to see amendments to make it easier for third parties to file observations, it is the experience of many **MARQUES** members that observations are rarely heeded by OHIM. It does not require legislative amendments to effect this. However, the compulsory introduction of observations at national level (see below) will hopefully encourage OHIM examiners to take observations seriously.

### *Oppositions*

It was suggested during the consultation process that the opposition period of three months should be reduced to two months, to speed up registration of CTMs. **MARQUES** advocated against a change, and none has been included in the proposals. A three month period is needed to enable analysis of the situation, and the taking of instructions, often from outside the EU. The three month period also enables savvy rights owners to contact the CTM applicant before filing an opposition to attempt to settle the issue.

### *Date of proof of use in oppositions*

An amendment is proposed to Article 42(2) of the CTM Regulation, which in effect moves the five year period during which genuine use must be evidenced from the five years preceding the date of publication to the five years preceding the date of filing (or the date of priority) of the later CTM.

Thus, for a CTM filed on 1 June claiming priority from a foreign application filed on 1 February which publishes on 1 December, the five year non-use period will shift from the five years before 1 December, to the five years before 1 February. The difference could be even more significant where a CTM application is held up for some years with specification queries and absolute grounds objections.

### *Registration*

A new Article 45 of the CTM Regulation tidies up some of the requirements around registration.

The necessity to pay a registration fee was removed some years ago, and so has been deleted from the legislation. The proposed new Article also provides for electronic registration certificates.

Interestingly, the proposed amendments provide for a right to use a “symbol right next to the trademark attesting that the trademark is registered”. The symbol shall be decided by the President of OHIM. It is to be hoped that the symbol will be ®, so as to be consistent with the rest of the world.

### *Surrender when invalidity application already filed*

Amendments to Article 50 of the CTM Regulation provide for an invalidity application to take precedence over a surrender. Revocation may take effect from an earlier date than surrender, hence this change makes sense.

### *Date for relative grounds of invalidity*

A proposed addition to Article 53(1) provides that the invalidity of a CTM on relative grounds shall be tested “at the filing date or the priority date” of the CTM.

This makes sense, although the inclusion of the priority date as an alternative could have unintended consequences.

#### *Acquiescence*

Article 54(1) and (2) are to be amended to remove reference to opposing the use of the later trademark. Thus, removing the double negative, an acquiescing earlier rights owner may still be able before court to prevent the later third party from using a sign where the later trademark was applied for in bad faith.

This provision needs to be read in conjunction with the other proposed amendments dealing with rights of priority.

#### *Application for revocation or invalidity*

Minor changes are proposed to Article 56 of the CTM Regulation providing for applications for revocation or invalidity of a CTM. First, revocation on the basis of a prior right under EU law is expressly acknowledged alongside prior national rights. Second, the *res judicata* provisions are amended slightly to acknowledge that a prior final decision on the merits by either OHIM or a Community trademark court will render inadmissible a later application for revocation or invalidity.

#### *Proof of use in invalidity and revocation proceedings*

In Article 57(2), the dates from which the five year non-use period run in invalidity and revocation proceedings are amended in line with opposition proceedings – see above.

#### *Appeals*

Proposed amendments to Article 58 of the CTM Regulation clarify that appeals lie to the Boards of Appeal from any first instance OHIM decision. Whilst the CTM Regulation previously noted that filing an appeal has suspensive effect (ie, the earlier decision does not come into force), the proposed amendments confirm that the appeal period itself also has suspensive effect (that is, an unappealed decision does not come into effect until the appeal period ends).

#### *Revision in inter partes cases*

The possibility for revision in *inter partes* cases has been removed. The provision has not been widely used, perhaps because it requires the successful party to consent. Article 62 of the CTM Regulation will be deleted.

#### *Appeals to the General Court*

Article 65 of the CTM Regulation is amended to tidy up the language. In the context of appeals from the Boards of Appeal, references to the Court of Justice are replaced by references to the General Court. This does not change current practice.

#### *Collective marks*

Some minor amendments are made to the treatment of collective marks to harmonise with changes made elsewhere in the draft Regulation.

#### *Certification marks*

Certification marks are introduced by a new Article 74b of the CTM Regulation. A certification mark is defined as “a European trademark which is described as such when the mark is applied

for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of geographical origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristic from goods and services which are not so certified”.

An applicant for a certification mark cannot carry on business supplying goods or services of the type certified.

Detailed provisions concerning applications, use, amendment and the like are proposed.

#### *Examination of facts by OHIM in invalidity proceedings*

A minor amendment is proposed to Article 76(1) of the CTM Regulation to confirm that, in invalidity proceedings on relative grounds, OHIM shall limit its examination to the grounds, facts and arguments provided by the parties. This is the same position as with opposition proceedings.

#### *Notification by electronic means*

An amendment proposed to Article 79 of the CTM Regulation expressly provides that OHIM may send any notices electronically.

A new Article 79b of the CTM Regulation provides that communications to OHIM may be made by electronic means.

These provisions are to be welcomed, given the importance of email in current forms of communication.

#### *Noting of loss of rights*

A proposed new Article 79a provides for notification of loss of rights. This occurs where rights are lost without a decision being taken by OHIM – for example, on failure to renew a CTM. OHIM must notify the rights holder of the loss of rights, and the rights owner may request a decision.

This replaces Rule 54 of the Implementing Regulation.

#### *Correction of errors*

Article 80 of the CTM Regulation is amended to make it easier for OHIM to correct errors, and places an onus on OHIM to do so.

#### *Continuation of proceedings*

Continuation of proceedings is a step before *restitution in integrum*, which enables a party before OHIM to make up a missed deadline in certain circumstances. Article 82(2) of the CTM Regulation excludes certain time limits from the continuation option, and it is proposed to remove from the list Articles 25(3), 27, 41(2), 42 and 62. Whilst this would appear generously to increase the use of continuation, it does not – the removal of these articles consequently tidies up provisions that are being removed by other amendments.

Proposed amendments to paragraph 4 of Article 82 make clear that any decision taken as a result of failure to meet a deadline can be retaken in light of the continuation. This was already OHIM practice.

### *Costs enforcement*

An amendment is proposed to make the enforcement of costs easier. Rather than costs being enforced as a matter of national law (which in effect never happens), a new Article 86(2) of the CTM Regulation provides for each member state to notify to OHIM, the Court of Justice and the Commission a single authority responsible for verifying the authenticity of the decision, and providing for its enforcement, without other formality.

Properly handled, this should make the enforcement of OHIM costs awards significantly more efficient. However, as OHIM costs awards continue not to reflect the actual legal costs of opposition and other proceedings, the low amounts awarded will continue to mitigate against enforcement efforts by successful parties. **MARQUES** would like to see the costs awards made at OHIM more accurately reflect the actual costs to the parties concerned. The primary aim is to encourage settlement so as to avoid a costs order, which currently never happens.

### *Register*

Proposed amendments to Article 87 provide for a Register of European Trademarks, which must be kept up to date, and may be kept electronically. This is to be welcomed.

OHIM must also maintain an electronic data bank with particulars of CTM applications, which must be made available to the public. OHIM does this already.

Further amendments are proposed to enable the electronic keeping of files and publications.

### *Earlier right of the defendant in infringement proceedings*

A minor change is proposed to Article 99 of the CTM Regulation, which deals with the presumption of validity of a CTM. This requires a defendant in infringement proceedings to raise certain issues by way of a counterclaim. However, the current CTM Regulation provides that two issues may be raised by way of a simple plea – invalidity through non-use, and the CTM relied on being invalid by virtue of an earlier right of the defendant. The draft Regulation drops the second of these, consistently with the other new provisions on priority.

### *Informing OHIM of challenges to the validity of a CTM*

Proposed amendments to Article 100 of the CTM Regulation clarify who is required to inform OHIM when a CTM is challenged for validity in a Community trademark court – the interested party or the court. Under the amended text, the court cannot proceed to determine the counterclaim until OHIM has been informed. If the CTM is already being challenged at OHIM, the court must stay its proceedings until OHIM's decision is final.

### *Acts of the President*

Article 122, which provided for checks on the President of OHIM, is abolished.

Legislative footing is also given to the Administrative Board of OHIM, the Budget Committee and the powers of the Executive Director (formerly President). Alterations are made to the provisions for the examination, opposition and cancellation divisions of OHIM, and the Boards of Appeal. The Executive Director (formerly President) and the President of the Boards of Appeal will no longer be appointed by the Council of Ministers, but by the Administrative Board upon proposals by the Commission.

### *Cooperation to promote convergence*

New Articles 123b and 123c provide obligations on OHIM to administer and promote the CTM system, to cooperate with the national offices, and to cooperate to promote convergence of practices and tools.

**MARQUES** supports initiatives to increase harmonisation and is an active supporter of the Cooperation Fund. **MARQUES** participates in projects run both in the context of the Cooperation Fund as well as the Convergence Program.

OHIM will coordinate common projects of EU interest, and OHIM will finance or co-finance these projects with grants from its budget. The total amount of these grants shall not exceed 10% of the yearly income of OHIM, and the beneficiaries shall be the IP offices of the member states and the Benelux Office.

**MARQUES** assumes that "projects of Union interest" will in fact all be projects that are in the interest of the users. **MARQUES** welcomes the obligation that is placed on the Offices to participate and will continue to support and actively participate in future projects.

### *Fees*

A new Article 144 is proposed, dealing with fees. OHIM may charge a fee for a range of new tasks, including issuing a copy of the certificate of registration, or registering a license. Permission is also given to the President to decide that certain publications etc shall be free of charge.

The new fees charged are dealt with below.

### *International Registrations*

Consequential amendments are made in relation to International Registrations designating the EU (for example, searches are abolished). One of the significant changes is the reduction of the delay for International Registrations from six months to one month. This will significantly speed up the processing of CTMs filed through the Madrid System, and is to be welcomed.

### *Review*

A proposed new Article 165a of the CTM Regulation provides for an evaluation on the implementation of the Regulation by 2019 and every five years thereafter. The evaluation is to examine how effectively and efficiently OHIM fulfils its tasks. The Administrative Board is to consider the evaluation and provide recommendations.

**MARQUES** welcomes the automatic review process, to provide a simple, regular mechanism for dealing with issues as and when they arise.

## **4. Detailed Proposals - Fees**

The new fee proposals for commonly used fees are as follows, with the current fee shown by way of a comparator:

	Current fee	Proposed fee
1. Basic fee for the application for an individual	1050	925
2. Basic fee for the application for an individual mark by electronic means	900	775
3. Basic fee for the application for an individual mark by electronic means and	NA	725

using the online classification database

4. Fee for the second class of goods and services	NA	50
5. Fee for the third class of goods and services	NA	75
6. Fee for each class of goods and services exceeding three	150	150
7. Basic fee for the renewal of an individual mark	1500	1150
8. Basic fee for the renewal of an individual mark by electronic means	1350	1000
9. Fee for the renewal of the second class of goods and services for an individual mark	NA	100
10. Fee for the renewal of the third class of goods and services for an individual mark	NA	150
11. Fee for the renewal of each class of goods and services exceeding three	400	300

**MARQUES** is pleased to note that the cost of filing an application for three classes has remained unchanged and supports the proposed filing fees (lines 1 and 2 and 4 to 6).

**MARQUES** continues to advocate against a renewal fee that is greater than the original application fee – it makes no logical sense that it should be cheaper to refile than to renew.

That being said, **MARQUES** notes that there is a decrease in the renewal fees. Renewing a registration covering three classes is less expensive, and the class fee for four classes and up has been lowered.

With the above remarks **MARQUES** supports the proposed renewal fees (lines 7 to 11).

**MARQUES** is a strong supporter of equal treatment and has not, for example, supported fast track solutions in the past.

**MARQUES** encourages applicants to make use of the online classification database (whenever possible) and will continue to assist OHIM in promoting the tool. **MARQUES** finds that it is inappropriate to promote the use of the online classification database through a differentiation of fees (as set out at line 3). Such a policy would disadvantage applicants who have developed new and innovative products or services.

**MARQUES** would instead suggest that the basic fee of 725 be made available to all applicants. **MARQUES** will support OHIM in its work to add new terms to the database in a speedy manner so that all applicants may benefit from the faster application procedure.

## 5. Detailed Proposals - National law

Some of the proposals for changes to national law mirror those set out above. Hence, only those that are different or specific to national law are dealt with below.

The major changes introduced by the recast Directive relate to further harmonisation of national law and practice. Areas that were left optional in the TM Directive have now largely become mandatory – **MARQUES** heartily welcomes the additional harmonisation that this achieves. As a result, the 18 articles of the TM Directive are now expanded to 57 articles in the recast Directive.

**MARQUES** supports the continuing coexistence of national trademark systems alongside the CTM system. This is now expressly recognised in Recital 3 of the recast Directive:

“Coexistence of trademark systems at national and Union level in fact constitutes a cornerstone of the Union’s approach to intellectual property protection.”

That express recognition is to be welcomed.

Some member states will already be close to complying with the requirements of the recast Directive. In other member states, significant changes will be required to national law and office practice and procedure. **MARQUES** recognises the challenges occasioned by these changes, particularly for smaller member states. However, the benefits for all users throughout the EU of a harmonised trademark system are great.

Unfortunately, the recast Directive does not mandate pre-registration oppositions – indeed, it continues to provide expressly for the option of post-registration opposition periods (see, for example, Article 16(2)). This is regrettable – **MARQUES** calls for mandatory pre-registration opposition periods for consistency, clarity and fairness.

#### *Provisions consistent with changes to the CTM Regulation*

The recast Directive includes a number of changes to mirror changes proposed to the CTM Regulation:

- The renaming of OHIM (Article 2(b) of the recast Directive);
- The specific addition of “colours as such” and “sounds” to the list of signs which are capable of being trademarks and the abolition of the requirement for graphical representation (Article 3 of the recast Directive);
- Designations of origin, geographical indications (Article 4(1)(i) of the recast Directive) and traditional terms for wine and traditional specialities (Article 4(1)(j) of the recast Directive) are specifically included as absolute grounds for refusal of a national application;
- As is proposed for OHIM, each national office will now be required to examine on relative grounds taking into account translation or transcription of the mark applied for into each official EU language (Article 4(2)(b) of the recast Directive);
- Relative grounds invalidity for marks with reputation is similarly harmonised, to give effect to the *Adidas* decision (Article 5(3)(a) of the recast Directive);
- The exclusive rights granted by a trademark registration are harmonised with the draft Regulation (Article 10(2) of the recast Directive) and the specific prohibited acts will include use as a trade or company name, and use in comparative advertising (Articles 10(3)(d) and (f) of the recast Directive: **MARQUES** welcomes these important harmonising changes;
- As with the changes to the CTM, national registered trademark owners will be able to prevent importation by an individual where the consignor acts for commercial purposes (Article 10(4) of the recast Directive);
- The proposed changes to the CTM Regulation to accommodate the *Philips/Nokia* decision are carried through into national law;



- A new Article 11 includes in national law the same provisions as proposed for the CTM relating to labels and packages not yet applied to goods/services;
- Article 14 of the recast Directive is amended to match the changes to the CTM Regulation dealing with the own name defence, signs which are not distinctive, and use to identify the proprietor's goods, as well as clarification of what does not constitute use in accordance with honest practices;
- For genuine use of a trademark, national law is harmonised with CTM law, in providing that it does not matter if the mark is used in a different form, and that form is also registered (Article 16(4)(a) of the recast Directive); and
- Changes to what will become Article 18 of the TM Directive implement the same rules on intervening rights as newly provided for in the draft Regulation.

#### *Extension of territories where absolute grounds apply*

In a significant move, the recast Directive provides for the listed absolute grounds to apply, even if the issue arises in another member state of the EU. Hence, signs which are descriptive in Latvian will not be registerable in any member state. This will solve the difficult issue of parties using national registrations to block descriptive terms in CTM applications: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. Hence, under the new rules, MATRATZEN (German for mattress) would not be registerable in Spain for mattresses.

**MARQUES** welcomes this change and the greater harmonisation it brings to EU trademark law. There is an issue with respect to reciprocity that is not expressly dealt with – if a national office declares an application to be devoid of distinctive character, will other national offices be bound by that decision, on the basis that the ground for refusal applies in another member state?

#### *Acquired distinctive character*

A slight change is proposed to the ability to prove acquired distinctiveness to overcome objections based on lack of distinctive character (Article 4(1)(b)), signs which may serve in trade to designate quality etc (Article 4(1)(c)) or signs which have become customary (Article 4(1)(d)). Previously, the TM Directive provided for evidence of acquired distinctiveness to be provided from before the date of application. The recast Directive enables proof to be given from after the date of registration.

Oddly, having harmonised before application, and after registration, the recast Directive leaves it open to member states optionally to apply the provision to the time between date of application and registration. However, as it will be an unusual mark that only acquires distinctiveness in that tight timeframe, the situation is unlikely to arise often in practice.

#### *New relative grounds*

Three new, mandatory relative grounds are added, identical to those in the draft Regulation:

- Marks applied for by agents or representatives without consent (Article 5(3)(b) of the recast Directive);
- Marks liable to be confused with an earlier mark protected outside the Union, providing the mark was still in genuine use and the applicant was acting in bad faith (Article 5(3)(c) of

the recast Directive) – this amendment would appear to leave a lacuna for marks in another member state; and

- Marks excluded from registration as protected designations of origin and geographical indications (Article 5(3)(d) of the recast Directive).

These new mandatory relative grounds bring national law in all member states into line with the proposed new CTM law.

The recast Directive leaves two optional relative grounds – non-registered trademark rights (Article 5(4)(a)) and rights to a name, personal portrayal, copyright and industrial property right (Article 5(4)(b)). National law on the protection of these rights has not been harmonised, so harmonising their impact on trademark rights would be difficult. However, **MARQUES** supports ongoing attempts to harmonise these relative grounds.

### *Seniority*

To implement minor changes to the CTM Regulation, a new Article 6 in the recast Directive replaces the old Article 14 and deals with *a posteriori* invalidity or revocation of a national mark from which seniority has been claimed. Thus, it will be possible to challenge a lapsed or surrendered national registration, in order to remove the seniority claim at OHIM. To invalidate the national registration *a posteriori*, the ground of invalidity or revocation must have been available at the time the trademark was surrendered or allowed to lapse.

If the national registration is revoked or invalidated *a posteriori*, the seniority claim ceases.

It is a little odd to deal with the results of the invalidity in the recast Directive (the effect on a CTM is more properly dealt with in the draft Regulation), but the impact will be the same. The impact of the new provision is limited, arising only in rare circumstances.

**MARQUES** had advocated greater harmonisation of seniority claims at member state level, particularly in relation to the maintenance of files for marks from which CTM seniority has been claimed. These suggestions have not been taken up. **MARQUES** will continue to push for more countries to join the Seniority database project of the Cooperation Fund so that this problem will be solved. 13 national offices have implemented the project as of February 2013.

### *Proof of earlier rights in invalidity actions*

A new Article 8 provides that various relative grounds can only be relied on in an invalidity application if proper proof can be made of the earlier right. Thus, an earlier mark with reputation cannot be relied on if the mark did not have reputation at the filing date or priority date of the registered trademark.

Interestingly, Article 8(a) appears to provide for an earlier registered trademark to be questioned for lack of distinctiveness. Under OHIM and many national rules at the moment, an earlier registered trademark is considered distinctive – if an opposed later party wants to contest the validity, it must commence separate proceedings to do so. The new provision states:

“A registered trademark shall not be declared invalid on the basis of an earlier trademark ... (a) where the earlier trademark, liable to be declared invalid pursuant to Article 4(1)(b), (c) or (d), had not acquired a distinctive character in accordance with Article 4(5) at the filing date or the priority date of the registered trademark”.

This would appear to provide for the testing of the validity of the earlier trademark in trademark invalidity proceedings (but not opposition proceedings, as Article 8 only relates to registered trademarks).

### *Acquiescence*

National rules on acquiescence are largely harmonised with the CTM rules by a new Article 9. Member states retain an option to broaden the acquiescence rules from earlier rights under Article 5(2) (earlier trademarks) and Article 5(3) (marks with reputation, marks filed by agents, bad faith applications and protected designations of origin and geographical indications) to cover all earlier rights referred to in Articles 5(4)(a) and (b) (non-registered trademark rights, rights in a name, personal portrayal, copyright, industrial property rights).

### *Exclusive rights*

The exclusive rights provided by a trademark registration are harmonised with CTM law, and made mandatory. Additional protection for marks with reputation will no longer be optional.

### *Dictionaries*

A new Article 12 implements into national law Article 10 of the CTM Regulation, enabling a national trademark owner to correct dictionary entries that give the impression that a trademark is a generic name.

### *Representatives and agents*

A new Article 13 implements into national law Article 11 of the CTM Regulation, giving national trademark owners the right to prohibit use by an agent or representative in certain circumstances.

### *Genuine use*

There has been some unclarity around when the five year use period runs following registration. The previous language – “the completion of the registration procedure” – was unclear. A new Article 16(2) provides:

“Where a Member State provides for opposition proceedings following registration, the five years referred to in paragraph 1 shall be calculated from the date when the mark can no longer be opposed or, in case an opposition has been lodged and not withdrawn, from the date when a decision terminating the opposition proceedings has become final”.

As noted above, **MARQUES** does not support post-registration opposition procedures. Greater clarity would be provided to users of the system if it were clear in all cases that, five years following registration, a mark becomes vulnerable to revocation in relation to the goods and services for which it has not been put to genuine use.

Further harmonisation is brought to national procedure relating to marks which are not in use – a new Article 17 provides that the proprietor of a trademark shall be entitled to prohibit third party use only to the extent that the rights are not liable to be revoked. This introduces to some national laws the ability to rely on non-use in infringement proceedings, without having to commence separate proceedings to invalidate the trademark relied on for non-use.

### *Trademarks as objects of property*

New Articles harmonise the rules with respect to dealing with trademarks as objects of property. The recast Directive achieves this by including as mandatory provisions relevantly identical provisions to the draft Regulation.

Thus, newly harmonised, is the law with respect to:

- Transfer of registered trademarks (Article 22 of the recast Directive);
- Rights *in rem* (Article 23 of the recast Directive);
- Levies of execution (Article 24 of the recast Directive);
- Insolvency proceedings (Article 25 of the recast Directive);
- Licensing (Article 26 of the recast Directive, replacing Article 8 of the TM Directive); and
- The treatment of applications for trademarks as objects of property (Article 27 of the recast Directive).

#### *Guarantee, certification and collective marks*

Guarantee and certification marks remain optional for member states (Article 29 of the recast Directive). Collective marks were optional, but become mandatory under the recast Directive (Articles 30 to 37).

**MARQUES** welcomes the harmonisation of collective marks, and would like to see similar mandatory harmonisation of guarantee and certification marks.

#### *Harmonisation of application procedures*

A series of new articles have been proposed to provide for greater harmonisation of application processes.

Thus, a new Article 38 provides for what an application for a trademark must contain (mirroring Article 26 of the draft Regulation). There is no limit imposed on what other information may be required at a national level. However, a filing date shall be accorded if the information required by Article 38 is provided (Article 39 of the recast Directive):

- A request for registration;
- Information identifying the applicant;
- A list of the goods or services in respect of which the registration is requested; and
- A representation of the trademark.

**MARQUES** welcomes minimum requirements for obtaining a filing date, consistent with the Singapore Treaty. Obtaining a filing date, particularly in circumstances of a priority claim, can be important for trademark owners, so the requirements for obtaining a filing date should be kept as few as possible.

#### *Abolition of relative grounds examination*

Article 41 of the recast Directive abolishes relative grounds examination in member states by limiting *ex officio* examination to absolute grounds. The 12 member states that currently examine on relative grounds will cease to do so.

**MARQUES** strongly supports the abolition of relative grounds examination in the member states that still provide for it.

#### *Observations*

A new Article 42 provides for third parties to be able to file observations on absolute grounds without becoming a party to the proceedings. This OHIM procedure is therefore adopted into all member states.

#### *Division of applications and registrations*

A new Article 43 provides for the division of applications and registrations. Again, **MARQUES** welcomes this harmonising measure.

#### *Fees*

As with the changes to the CTM, a new Article 44 requires member states to charge additional fees for each class of goods and services beyond the first class. This will alter practice in those member states that, like OHIM currently, offer more than one class for the filing fee.

**MARQUES** encourages member states to set the new one class filing fees in the same manner as proposed by the Commission, so that filing for three classes will not be more expensive than at present.

#### *Administrative oppositions*

**MARQUES** heartily welcomes the requirement for member states to have administrative opposition proceedings before the office, rather than requiring the expense of court proceedings (Article 45 of the recast Directive). The requirement is that the procedure is “efficient and expeditious” – it will be interesting to see Court of Justice case law develop over time on what these words might require, particularly in relation to oppositions that run on for many years.

No mandatory opposition is provided for absolute grounds – this is apparently dealt with by the introduction of an observations procedure. The recast Directive does not appear to abolish absolute grounds oppositions in member states that have them already.

A new Article 45(3) provides for a mandatory two month cooling off period to negotiate a settlement.

#### *Proof of use in opposition and invalidity proceedings*

A new Article 46 mandates proof of use in opposition proceedings. A new Article 48 does the same for invalidity proceedings based on an earlier trademark. This, in effect, adopts the OHIM position for all member states. A party challenged by a right that is vulnerable to revocation for non-use will be entitled to request proof of use of the right, without having to commence separate proceedings to invalidate the earlier mark for non-use.

Where the earlier right is a CTM, genuine use of the CTM is determined in accordance with the draft Regulation.

### *Revocation and invalidity*

Again, **MARQUES** welcomes the mandating of administrative revocation and invalidity proceedings, rather than requiring parties to go to the expense of court proceedings. Unlike with oppositions, there is no requirement that the proceedings be efficient or expeditious.

Article 47 of the recast Directive requires that the following grounds for revocation and invalidity must be provided for:

- Failure to comply with Article 4 (absolute grounds);
- Existence of an earlier right under Article 5(2) and (3); and
- Revocation for non-use (Article 19) or for a mark that has become a common name in trade, or misleading (Article 20).

### *Renewal*

A new Article 50 mandates a 10 year life for a national trademark, taken from the date of filing of the application. Renewal is for a further 10 year period. Again, this adopts the CTM position for all national trademarks.

**MARQUES** supports a 10 year renewal period both for CTMs and national trademarks.

### *Co-operation*

The recast Directive provides that the offices shall cooperate with each other and with OHIM in order to promote convergence of practices and tools and achieve coherent results in the examination and registration of trademarks (Article 52).

Further, each office is required to co-operate with OHIM (but not with each other) in relation to all areas of their activities other than those referred to in Article 52 that are of relevance for the protection of trademarks in the EU.

**MARQUES** welcomes these requirements, having advocated for them through the consultation process.

### *Transposition*

The recast Directive does not currently include an implementation date. **MARQUES** urges the Commission to give member states reasonable time to implement the new procedures, but not to allow long delay in doing so. In **MARQUES**'s opinion, a period of two years from adoption of the Directive should provide sufficient time for the necessitated changes.

## **6. Issues not covered**

Other issues were raised by the Max Planck Study, and by user groups during the various consultations, that have not been adopted into the draft Regulation or the recast Directive. These include:

- **MARQUES** regrets that pre-registration opposition proceedings have not been made mandatory in all member states;

- Nothing has been done to mandate consistency of decision making at OHIM. **MARQUES** would have preferred to see amendments to the Regulation to require OHIM to follow its own decisions, in the same way that precedent works before the Court of Justice;
- The proposals do not deal with an issue of OHIM consistency for which **MARQUES** has long requested. Where a “batch” of trademarks is filed, they tend to be passed to different examiners, leading to different, and often inconsistent examination reports, particularly in relation to specifications. The same difficulty applies to multiple oppositions against the same CTM application. Greater consistency does not require primary legislation. **MARQUES** therefore hopes that greater consistency can be achieved either by administrative changes at OHIM, or, failing that, delegated rule making by the Commission;
- The proposals do not deal with exhaustion of trademark rights, and particularly offer no further harmonisation of national law with respect to the burden of proof, especially if the trademark owner is operating a selective distribution system;
- **MARQUES** would also like to see greater harmonisation of the remedies available for trademark infringement. It is well known that some national courts will issue *ex parte* injunctions in trademark cases for little more than the asking, whilst the courts in other member states have significant requirements to protect third parties. Damages assessments also vary greatly. Whilst the Enforcement Directive has gone some way to effect harmonisation, it is insufficient, particularly in relation to preliminary measures. The differences in enforcement practices lead to significant forum shopping (for a multi-jurisdictional dispute) or greatly differing levels of enforcement of national rights (very few trademark cases in some countries, many cases in others);
- No harmonisation has been proposed to procedures for when a CTM is converted to national applications. Whilst the draft Regulation continues to provide for conversion, national practices, once they receive a request to process a CTM converted to their national mark, are widely inconsistent. Greater harmonisation is required;
- The Study had also looked at the issue of conversion of a CTM opposed on the basis of another CTM, but where the conflict only arose in some member states (ie, there was only likelihood of confusion for consumers in Bulgaria): see also *ARMAFOAM/NOMAFOAM*, Case C-514/06 P. No proposals have been put forward in this regard;
- **MARQUES** submitted that a specialised chamber of the General Court to deal with intellectual property matters would be appropriate. This suggestion has not been taken up in the proposed legislative changes;
- There was a suggestion in the Study that a re-filed application that appears to seek to avoid the non-use provisions is *a priori* filed in bad faith. This is the law in some member states. This suggestion has not been picked up in either the draft Regulation or the recast Directive;
- Whilst third party liability for infringing goods was discussed during the consultations, and **MARQUES** advocated third party liability at least for counterfeit goods, these proposals have not been taken up;
- Proposals to allow “fair use” of trademarks and use of trademarks in parodies have not been taken up – **MARQUES** supports the absence of any proposals in this regard; and

- At paragraph 201 of the Study, suggestions were made for rules requiring parties submitting evidence to specify those parts they rely on. This would prevent the blunderbuss of chaff that many parties file as evidence, wasting costs for the other party and for OHIM, forced to sift through it. These proposals have not been adopted at this stage, and **MARQUES** hopes that they will find a place in the delegated rule making that is anticipated.

Compiled by the **MARQUES** Study Task Force. Please direct any questions or comments to Tove Graulund and David Stone at [studytaskforce@marques.org](mailto:studytaskforce@marques.org).