



European Union - Plugging the leak: MARQUES reacts to unofficial European trademark proposals

By Trevor Little

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Last month *WTR* presented **analysis of leaked documents** detailing proposed changes to the European trademark framework (including amendments to the Community Trademark Regulation (207/2009), a recasting of the Trademarks Directive and an overhaul of the filing fees regime), as well as **initial industry reaction**. Today MARQUES **issued a lengthy 24-page information note** on the documents, providing a user perspective and detailing the good, the bad and the missing aspects of the proposals.

One of the commentators *WTR* interviewed in February was Tove Graulund, chair of the **MARQUES** Study Task Force (and principal of **Graulund IP Services**). Many of her initial observations have been echoed in the more detailed review; however the organisation is at pains to note that, while the review presents initial reactions, it should not be viewed as representing official positions, which will only be issued once the Commission launches its proposals.

There is much that MARQUES supports in the proposals. Considering efforts to facilitate cooperation between national offices and OHIM-which include such proposed changes to national law as the abolition of relative grounds examination in the 12 member states which maintain it, the requirement of administrative opposition and cancellation procedures before national offices and that filing fees will only include one class (with additional class fees to be introduced)- the organisation notes: “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.”

As Graulund previously told *WTR*, while there are some cautionary notes (the organisation feeling that there is no logical sense for renewals fees being higher than the original application fee and uneasy about the establishment of a differentiation of fees to promote the use of the online classification database), there is positivity towards the fee changes proposed and national offices

are urged “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”. “Heartily” welcomed were the requirement for member states to introduce administrative opposition proceedings before the office and the “mandating of administrative revocation and invalidity proceedings, rather than requiring parties to go to the expense of court proceedings”.

However, one article that MARQUES recommends removing prior to publication relates to the **IP TRANSLATOR** decision: “Article 28(8), as set out in the draft Regulation, provides that the owners of these registrations [already registered trademarks, which recite one or more class headings] 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.”

For MARQUES, a supporter of the 'means-what-it-says' approach, such a move would add a layer of complication as “the ‘corrected’ registrations would have to be republished for opposition purposes, and in effect this would only increase the lack of clarity”. Graulund previously told *WTR*: “We need to look at the bigger picture here. Any applications filed or registered before June 2007 are going to be vulnerable for non-use so if there is any disagreement over the list of goods it will be limited. And of the last five years’ worth of applications how many were actually filed using only class headings? Therefore we feel it would be better to leave it alone – of course have harmonisation, and we want OHIM to get rid of the tick box practice as soon as possible, or at least as soon as taxonomy comes into place, so we have clarity again. We do appreciate that the Commission is trying to come to the aid of companies that might have relied on the Communication, but we are worried that it may raise more problems that it solves.”

It remains to be seen whether subsequent changes are made to the documents before official publication and adoption, at which point MARQUES suggests a two-year implementation window. Similarly, MARQUES points to a number of issues that were raised by the Max Planck Study and by user groups that have not been adopted into the drafts. These include:

- Pre-registration opposition proceedings have not been made mandatory in all member states;

- 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; and
- No harmonisation has been proposed to procedures for when a CTM is converted to national applications.

MARQUES further notes that “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”. However, it is an issue the association can continue to push as “greater consistency does not require primary legislation”.

Whether or not some of MARQUES’ desired changes appear in the final documents, there is clearly going to be debate once the proposals are officially published. In the meantime, the 24-page note issued by MARQUES, [available here](#), makes for essential reading for those practitioners who do not have access to the leaked documents.

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