



EUROPEAN PARLIAMENT

2009 - 2014

Committee on International Trade

2013/0088(COD)

14.10.2013

OPINION

of the Committee on International Trade

for the Committee on Legal Affairs

on the proposal for a regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark
(COM(2013)0161 – C7-0087/2013 – 2013/0088(COD))

Rapporteur: George Sabin Cutaş

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SHORT JUSTIFICATION

The main objective of the proposal for the amendment of Council Regulation (EC) No 2007/2009 on the Community trade mark together with the proposal for amending Directive 2008/95/EC is to harmonize trade mark registration systems in all EU Member States, as well as to ensure coexistence and complementarity between the EU and national trade mark systems, in order to make them more efficient for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal security. This could lead to a substantive increase in innovation and economic growth.

The opinion focuses exclusively on the trade-related aspects of the proposal and notably on the transit of counterfeit goods through the Union and the sale of counterfeit goods over the internet. Concerning the former, the Commission's proposal aims at reducing the transit of counterfeit goods through the Union. The opinion supports this initiative although it makes it clear that this should not have negative repercussions on the Union's right to support access to medicines for third countries in accordance with the *WTO Doha Ministerial Declaration on the TRIPS agreement and public health* adopted on 14 November 2001. It should be acknowledged, however, that the issue of access to medicines is mainly related to patents and only to a lesser extent to trade marks.

As for the second trade-related aspect, the proposal's objective is to prevent the entry of counterfeit goods into the Union especially through sales over the internet. This is a problem which has become particularly relevant in the last years due to the increase of the number of sales over the internet. The opinion clarifies the legal instruments which allow the trade mark proprietor to take actions to prevent the importing of counterfeit goods where it is only the consignor who acts for commercial purposes. Given the relevance of the problem and the economic interests at stake it is also appropriate that controls by Member States over internet websites selling counterfeit goods are improved.

Finally, the opinion points at the necessity of widening the EU *acquis* on the protection of geographical indications in the Union by including through a future EU legislative act geographical indications on goods other than agricultural and foodstuffs, wine and spirits.

AMENDMENTS

The Committee on International Trade calls on the Committee on Legal Affairs, as the committee responsible, to incorporate the following amendments in its report:

Amendment 1

Proposal for a regulation

Recital 13

Text proposed by the Commission

(13) With the aim of maintaining strong protection of rights in designations of origin and geographical indications protected at Union level, it is necessary to

Amendment

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clarify that those rights entitle to bring an opposition against the registration of a later European trade mark, regardless of whether or not they are also grounds for refusal to be taken into account ex officio by the examiner.

clarify that those rights entitle to bring an opposition against the registration of a later European trade mark, regardless of whether or not they are also grounds for refusal to be taken into account ex officio by the examiner. *Since Union legislation exists only concerning the protection of geographical indications of agricultural products and foodstuff, wine and spirits, the Commission should adopt a proposal for a regulation harmonising Member States' rules on the protection of geographical indications also for goods other than agricultural and foodstuffs, wine and spirits.*

Amendment 2

Proposal for a regulation Recital 18

Text proposed by the Commission

(18) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a European trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Union 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 European trade mark registered in respect of such goods.

Amendment

(18) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a European trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Union 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 European trade mark registered in respect of such goods. *This should be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit and its right to promote access to medicines for third countries, and more specifically to the production, circulation and distribution of generic medicines in the EU and abroad.*

Amendment 3

Proposal for a regulation Recital 19

Text proposed by the Commission

(19) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor should be entitled to prohibit the importing of such goods into the Union, where it is only the consignor of the goods who acts for commercial purposes.

Amendment

(19) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor should be entitled to prohibit the importing of such goods into the Union, where it is only the consignor of the goods who acts for commercial purposes. ***For this purpose, the proprietor should take relevant actions as provided for under Directive 48/2004/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights and Regulation 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights.***

Amendment 4

Proposal for a regulation

Article 1 – point 12

Regulation (EC) No 207/2009

Article 9 – paragraph 4

Text proposed by the Commission

4. The proprietor of a European trade mark shall also be entitled to prevent the importing of goods referred to in paragraph 3(c) where only the consignor of the goods acts for commercial purposes.

Amendment

4. The proprietor of a European trade mark shall also be entitled to prevent the importing of goods referred to in paragraph 3(c) where only the consignor of the goods acts for commercial purposes.

To this purpose the proprietor of a European trade mark shall be entitled to take relevant legal actions as provided by Directive 48/2004/EC and to request national customs authorities to take action in respect of goods which allegedly

infringe their rights, such as detention and destruction in accordance with. Regulation 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights .

Member States shall also take appropriate measures to prevent the sale of counterfeit goods over the internet.

Amendment 5

Proposal for a regulation

Article 1 – paragraph 1 – point 12

Regulation 2009/207/EC

Article 9 – paragraph 5

Text proposed by the Commission

The proprietor of a European trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the European trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

Amendment

The proprietor of a European trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the European trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. ***This shall be without prejudice to the Union's compliance with WTO rules, notably with GATT Article V on freedom of transit.***

Amendment 6

Proposal for a regulation

Article 1 – paragraph 1 – point 13

Regulation 2009/207/EC

Article 9a – point a

Text proposed by the Commission

(a) affixing in the course of trade a sign identical with or similar to the European trade mark on get-up, packaging or other means on which the mark may be affixed;

Amendment

(a) affixing in the course of trade a sign identical with or similar to, ***as specified in Article 8(1) of this Regulation***, the European trade mark on get-up, packaging or other means on which the mark may be affixed;

Justification

Paragraph should be consistent with the identification and similarity provisions already specified in Article 8(1).

Amendment 7

Proposal for a regulation

Article 1 – paragraph 1 – point 74 a a (new)

Text proposed by the Commission

Amendment

(74 aa) Indemnification of the Importer and the Owner of the Goods

The Agency shall have the authority to order a proprietor of a European trade mark to pay the importer, the consignee and owner of the goods appropriate compensation for any injury caused to them through a wrongful detention of goods due to import restriction rights granted in Article 9.

Justification

In accordance with TRIPS Article 56, the relevant agency shall have the authority to order an applicant, in this case a trade mark proprietor, to appropriately compensate importers or owners for wrongful detentions. Wrongful detentions are a major and escalating problem. According to the Commission annual report "EU Customs Enforcement of Intellectual Property Rights: Results at the Border", in 2011, goods were detained by mistake in more than 2 700 cases, an increase of 46 % over two years before.

PROCEDURE

Title	Community trade mark
References	COM(2013)0161 – C7-0087/2013 – 2013/0088(COD)
Committee responsible Date announced in plenary	JURI 16.4.2013
Opinion by Date announced in plenary	INTA 16.4.2013
Rapporteur Date appointed	George Sabin Cutaş 25.4.2013
Discussed in committee	11.7.2013 16.9.2013
Date adopted	14.10.2013
Result of final vote	+: 22 -: 2 0: 0
Members present for the final vote	Laima Liucija Andrikiienė, Maria Badia i Cutchet, Nora Berra, Daniel Caspary, María Auxiliadora Correa Zamora, Andrea Cozzolino, George Sabin Cutaş, Marielle de Sarnez, Christofer Fjellner, Yannick Jadot, Franziska Keller, Bernd Lange, Vital Moreira, Paul Murphy, Niccolò Rinaldi, Helmut Scholz, Peter Šťastný, Robert Sturdy, Jan Zahradil
Substitute(s) present for the final vote	Jarosław Leszek Wałęsa
Substitute(s) under Rule 187(2) present for the final vote	Elisabeth Jeggle, Krzysztof Lisek, Iosif Matula, Paul Rübig, Catherine Stihler