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EU Trademark Regulation 2013

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Introduction

It has been almost five years since changes were last made to the Trade Mark Directive back in 2008. The latest proposals by the EU Commission to reform the EU Trade Mark Regulation do not propose a major overhaul, but rather update the current EU trade mark framework and address the inconsistencies that exist between the EU Trade Mark Directive 2008/95/EC and the EU Trade Mark Regulation 207/2009/EC. The formal procedures have been left non-harmonised as under the current framework.

The reform package proposes to revise the 1994 Regulation, and the 1995 Community Regulation 2869/95 on fees payable to the OHIM; recast the 1989 Trade Mark Directive (now 2008/95/EC); and deal with the obsolete legal framework for the registration of trade marks. Harmonisation is limited and formal procedures and requirements are not harmonised.

According to Internal Market and Services Commissioner Michel Barnier:

‘Trade marks were the EU’s first success in intellectual property rights. The harmonisation of Member States’ laws in 1989 and the creation of the Community trade mark in 1994 paved the way for other tools for intellectual property protection, such as design protection and the unitary patent. Today, 20 years later, I am very proud to announce that our trade mark system has stood the test of time. There is no need for a major overhaul: the foundations of our system remain perfectly valid. What we are aiming for is a well-targeted modernisation to make trade mark protection easier, cheaper, and more effective.’

According to the proposals, the changes to the trade mark system will:

1 Adapt terminology to the Lisbon Treaty and provisions to the ‘common approach’ on decentralised agencies.

2 Streamline procedures to apply for and register a European trade mark.

3 Increase legal certainty by clarifying provisions and removing ambiguities.

4 Establish an appropriate framework for cooperation between OHIM and national trade mark offices to promote the convergence of practices and develop common tools.

5 Align the framework to Article 290 of the TFEU.

Proposals for the EU Trade Mark Regulation (CTR) were expected to take effect in Spring 2014, but given that it has recently passed the first reading before the European Parliament, it is likely that there will be some delay in the legislative process. The Trade Mark Directive 2013 is expected to be implemented within two years.

In an extensive study carried out by the Max Planck Institute between November 2009 and February 2011, a number of proposals to reform the trade mark system were made. Some of the reform proposals are now found in the draft CTR. This paper will examine the changes made to the proposed CTR and discuss some of the likely amendments made to the trade mark system.

EU Trade Mark Regulation 2013

The CTR will replace the Community Trade Mark Regulation 207/2009 and take effect once this is passed at a European level. The proposed Trade Mark Directive 2013 will replace the Trade Mark Directive 2008/95/EC and Directive 89/104/EC. It comes after two main evaluation studies were carried out in November 2009 and February 2011. The final study concluded that the European trade mark system was solid overall and that the OHIM had met the needs and expectations of business. The report, however, found that there was a need for further convergences of trade mark laws and practices within the EU.

According to the impact assessment, the proposed Regulation needed to address the disparities in cooperation that existed between the trade mark offices in Europe. It recommended that the Office for Harmonization in the Internal Market (OHIM) and national offices should work more closely when dealing with Community and national trade marks.

National trade mark laws and practice had to be harmonised and brought into line with the EU trade mark system and ‘create as far as possible equal
conditions for the registration and protection of trade marks throughout the Union. Therefore, a number of proposals were recommended to address this to improve and modernise the trade mark system so that it was ‘more effective, efficient and consistent as a whole and adapted to the internet era.’ For instance, the OHIM and national offices would improve their cooperation.

The main legal basis for change within the intellectual property is Article 118(1) TFEU, which provides for the creation of European intellectual property rights. Article 118(1) was introduced as a result of changes made to the Treaty of the European Union through the Lisbon Treaty (TFEU). The CTR proposes to make a number of changes.

‘European trade mark’

Firstly, the CTR will change the terminology of ‘Community trade mark’ to ‘European trade mark’ to reflect the changes in the Lisbon Treaty and accord with the common approach on decentralised agencies agreed by the European Parliament, the Council and the Commission in July 2012. The CTR will also improve the governance of existing agencies yet to be established and agreed by the European Parliament, the Council and the Commission in July 2012. The OHIM will be renamed the ‘European Union Trade Marks and Designs Agency’ (EUTMDA) to reflect the functions of the management board. The change in the name of the office is unlikely to change the main functions of the body but would be clearer for the applicant who was applying for a trade mark at a European level.

The filing of trade mark applications

One of the main findings from the Max Planck study was that the current trade mark framework did not cover procedural aspects and cooperation between the OHIM and the national trade mark offices were not harmonised or vague. It recommended the need for increased convergence of the Trade Mark Directive and CTM Regulation and an increased level of cooperation and coherence between the OHIM and national trade mark offices.

For instance, about 96.3 per cent of applications submitted in 2012 for trade marks were filed through the OHIM’s e-filing system rather than the Member State’s trade mark offices. The draft CTR would abolish the filing of trade mark applications at National Offices to streamline and simplify the trade mark process at national and EU level.

Article 27 of the Regulation proposes to abolish the one-month period in which applicants are delayed from paying the application fee until their trade mark applications successfully fulfils the criteria for trade mark registration. This will be replaced with a system to require payment at the time of the filing of the application so that applicants can show they have evidence that they submitted payment at the time when they filed their trade mark application.

Articles 38 and 155 of the CTR propose to abolish the current search tools, as the main weakness is that national and EU searches of trade marks are not necessarily a reliable indicator for trade mark clearance, and users could resort to cheaper alternative means to search a trade mark. The EUTMDA would work with the national offices to improve a number of tools for conducting priority searches and monitor potential trade mark infringements. For instance, it is possible for any person to write to the OHIM and object to the registration of a trade mark. The onus is on the OHIM to determine whether the proposed trade mark could be registered or whether it falls within the grounds for objection.

Article 39 of the Regulation would expedite the registration procedure by abolishing the one month period between the EUTMDA notifying the applicant of search reports.

Article 40 would extend the period in which observations are filed. Third parties would be given the opportunity to make their observations as soon as they become aware of the application. As trade mark applications are made available on the Agency’s trade mark database within a few days of filing, the publication date of the trade mark will be deleted under this proposal. The deadline for filing observations is extended towards the end of the opposition period or once opposition proceedings have concluded.

Article 62 is likely to be deleted since it deals with inter partes decisions, which occur where maybe more than one party is involved in an objection to the registration of a trade mark. The view from the proposal is that there are sufficient remedies to rectify an erroneous inter partes decision, and therefore this article has been deleted.

Article 82 will be amended to ensure that in future the application can be streamlined. The power would be conferred on the European Commission in accordance with Article 290 TFEU to deal with the means and modalities of filing a European trade mark application, including its content and conditions for a European mark. As noted in the Regulation, the application of Article 82 has created some problems in practice which have led the President of the OHIM to issue Communication 06/05. Some of the main problems concern time limits involved in filing opposition to trade mark applications, and these have been further considered in the Communication 06/05.

The issue of legal certainty

According to the Max Planck study the proposal to reform the registration of non-traditional marks such as smell or sound marks would allow for a more liberal practice on the representation of non-traditional signs, and not detract from the ‘exigencies of legal security set under the Sieckmann test.’

The definition of trade mark under the Regulation removes the requirement of graphic representation under Article 4. The proposed Article 4 will be as follows:

‘A European trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours as such, the shape of goods or of their packaging, or sounds, provided that such signs are capable of

a distinguishing the goods or services of one undertaking from those of other undertakings;

b 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.’

The requirement of graphic representation is regarded as being obsolete and creates uncertainty for olfactory marks (non-traditional marks). When the CJEU was asked to consider the registration of olfactory marks in Ralf Sieckmann
v Deutsches Patent- Und Markenamt it held that the then Directive (89/104) had to be interpreted to mean ‘that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically.’ It further held that ‘if the users of that register are to be able to determine the precise nature of a mark on the basis of its registration, its graphic representation in the register must be self-contained, easily accessible and intelligible.’

The court went on to hold that a chemical formula would not sufficiently clear and intelligible nor precise and objective to fulfil the requirements of representation. The CJEU laid down the seven criteria for graphic representation of non-conventional trade marks. For these marks, it should be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Although it was difficult for olfactory marks to be protected, sound marks could be protected through graphic representation by a musical notation or a pantone colour system respectively. The proposed changes to the Regulation considered that representation of a sound mark could be provided through a sound file and thereby increase legal certainty. The new definition would open the way for registering a mark where it could be represented by technological means that offers satisfactory guarantees and may deal with the earlier problems of registering non-traditional marks.

In the context of shape marks, however, the Max Planck study was clear that shape marks continued to be refused protection if they were devoid of distinctiveness, served descriptive purposes or had become generic. An application could also be refused if the mark consisted exclusively of shapes resulting from the nature of the goods that were necessary to obtain a technical result or give substantial value to the goods. Shapes, however, could be protected as distinctive designs if they satisfied the requirements of the Community Design Regulation, eg if they were novel. The current proposed CTR does not appear to make any significant changes to the current framework on shape marks, but rather replaces the definition of trade marks to include marks that differentiate goods or services from one trader to another. As the Regulation does not propose a major overhaul of the trade mark system, its much more conservative approach reinforces the main rationale for the protection of trade marks – namely that trade mark are registered for its distinctive features and serve as a mark of origin.

Although the proposed changes to the CTR are unlikely to have a significant effect on shape marks, it may however lead to the rise in the number of applications of non-traditional marks that could be submitted to the OHIM.

Geographical indications and traditional terms

The current Article 7(j) and (k) of the CTM Regulation is likely to be amended to ensure that the protection of geographical indications (GI) is given full effect in proceedings for the registration of European trade marks, and that absolute grounds for refusal are in line with EU law on geographical indications (GIs):

‘(j) Trade marks which are excluded from registration and shall not continue to be used pursuant to Union legislation or international agreements to which the Union is party, providing for protection of designations or origin and geographical indications.

(k) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine and traditional specialities guaranteed.’

The main reason is to provide further clarity and ensure consistency with other relevant EU laws on the protection of intellectual property rights. It was recognised that the current provisions of Regulation 207/2009 fell short of providing the same degree of protection for marks that denoted their geographical indications (such as Champagne being an indicator of origin in France, or Parma ham in Italy). Article 16 of Regulation (EC) No 110/2008 of 15 January 2008 protects geographical indications of spirit drinks. Articles 13 and 14 of Regulation No 1151/2012 of 21 November 2012 deal with quality schemes for agricultural products and foods.

The scope of absolute grounds would be extended to include protected traditional terms for wine and traditional specialities.

Genuine use

The European Communities Trade Mark Association (ECTA) was of the view that the proposals do not take account of ‘genuine use’ of a trade mark and recent opinions of the European Court of Justice (CJEU) on GIgs such as the Leno Merken case, which dealt with the geographic scope. ECTA was of the view that the discussion on ‘genuine use’ should not be decided on a case by case basis but that some express mention should be made in the proposed CTR to avoid the element of legal uncertainty. In this case, the CJEU held that when interpreting ‘genuine use’, the territorial borders of a Member State were not relevant. The term ‘genuine use’ would be used in accordance with its essential function and for the purpose of maintaining or creating market share within the EU for the goods or services covered by it. Furthermore, it is for the decision-making authority to assess the genuine character of the use, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use, as well as its frequency and regularity.

This is likely to be of assistance to EU Member State courts when interpreting ‘genuine use’. ECTA was of the view that this part needed further clarification and amendment. ECTA was further concerned with the number of CTM registrations that could clutter the trade mark registry, and that the onus would be on the trade mark owner that the CTM was not restricted to one Member State. The judgment from the CJEU has clarified the meaning of ‘genuine use’ in accordance with the EU law (see Art 267 TFEU on preliminary ruling references).

According to the Max Planck study, there was a lack of harmony in the current EU legal framework on GIs and the onus fell on the legislators to implement laws to address specific areas. Although the CTR aims to clarify the existing inconsistencies in the protection of GIs, it is submitted that with the complexities of the various different laws that apply to GI, this is likely to be understood by those within the practising trade mark profession and incomprehensible to those working outside it.

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Rights to be conferred on a trade mark

Article 9 and 9a elaborates on the rights to be conferred on a trade mark. Article 9 of the Regulation will be amended so that trade mark infringement claims are without prejudice to earlier rights:

a The registration of a European trade mark shall confer on the proprietor exclusive rights.

b Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the European trade mark, the proprietor of a European trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign in relation to goods or services where…etc.

The rationale for these provisions is that the Regulation and the Directive are not clear in providing that a trade mark owner could not use his rights against the use of an identical or similar sign which is subject to an earlier right. It is unusual for this express provision to be made, as the UK Trade Marks Act 1994 section 10(1) and (2) is very clear about infringement for use of an identical sign or a sign similar to the goods in relation to which the trade mark has been registered. This is further replicated in the provisions for the registration of a trade mark that was identical or similar under sections 5(1) and (2) of the 1994 Act. What Article 9a does is reinforce the rights of trade mark owners and what is permissible within the CTR.

Infringement

A further change is that infringement of a trade mark can occur through the use of get-up, packaging or other means, as Article 9a states:

‘Where it is likely that the get-up, packaging or other means to which the mark is affixed will be used for goods or services and the use in relation to those goods or services would constitute an infringement of the rights of the proprietor under Art. 9(2) and (3), the proprietor of a European trade mark shall have the right to prohibit the following:

a affixing in the course of a 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;

b offering or placing on the market, or stocking for those purposes, or importing or exporting get-up, packaging or other means on which the mark is affixed.’

The get-up of a product is very similar to the common law of passing off where the owner would need to show the key elements. Namely, goodwill in the product, misrepresentation and damage before a claim could succeed. It is questionable whether the rules of the doctrine of exhaustion would apply as the owner could object to the use of its trade mark even though he has exhausted his rights by importing into one EU country. The proposed article is likely to extend trade mark protection to the get-up of the product and therefore may further strengthen the rights of brand name owners.

For instance, in United Biscuits (UK) Ltd v Asda Stores Ltd, the plaintiffs sought an injunction against the defendants under the common law of passing off for similarity in the packaging of chocolate bars. It was found that an early version of the design and use of the slogan was similar to the one which the plaintiffs had held. Although this dealt with the claim of passing off, it could be submitted that these proposals would enable the trade mark owner to bring an action against another trader under the CTR rather than use the claim of passing off.

The owner would not, however, be able to prohibit the use of a sign, if it can be shown that it was used fairly in accordance with honest practices in industrial and commercial matters. Article 12(2) provides that the following circumstances are not regarded as in accordance with honest practices:

1 it gives the impression that there is a commercial connection between the third party and the proprietor of the trade mark;

2 it takes unfair advantage of, or is detrimental to, the distinctive character of the repute of the trade mark without due cause.

The above is not particularly contentious, and would seem logical, if the sign was used in accordance with honest practices. Such use would include using one’s only personal name and extend to the use of descriptive and non-distinctive signs or indications. The UK Trade Mark Acts 1994, section 11 already makes provision for a defence to use one’s name provided this was done in accordance with honest commercial practice, so there is some degree of replication here.

Double identity

Double identity cases occur when an identical sign is used for an identical product. In this scenario, infringement is absolute, and this is covered under s 10(1) TMA 1994, where there is no need to show confusion. The Max Planck study identified that goods and services were identical when the goods, services covered by the earlier trade mark include the goods or services covered by the latest trade marks.

Instances where double identity may occur would be comparative advertising (O2/Hutchinson) or where the use of the mark could occur through importing (parallel importing as in Upjohn v Paranova). Under those circumstances, it would need to be identified that there was a likelihood of infringement for there to be an infringement.

The ECTA was of the view that the addition of another factor on double identity was not justified and would reverse the case law by the CJEU that recognises advertising, communication and investment deserve protection.

Additional trade mark functions under Article 5(1) of the Directive (Art 9(1)(a) of the Regulation) had introduced legal uncertainty. According to the proposals, this is particularly the case for double identity cases and extended protection provided under Article 5(2) of the Directive (Art 9(1)(c) of the Regulation) to trade marks having a reputation. The proposals aim to reduce or eradicate double identity cases.

Use as a trade or company name

Article 5(1) of the Directive applies where the public considers the use of a company name relates to the goods or services offered by the company. Therefore, the use of a protected trade mark would infringe the trade mark if the requirements of use for goods
or services are met. According to recital 16 of the Regulation, confusion regarding the commercial source may arise from goods or services where a company uses the same or similar sign as a trade name such that a link is established between the company and the goods or services from that company. Infringement should extend to the use of a sign as a trade name or similar designation provided that the use was made for the purposes of distinguishing goods or services as to their commercial origin. This is unlikely to make any significant changes to the current trade mark laws. The implications, however, are that if there is a similarity in the names, then section 10(1)(2) and (3) TMA 1994 would continue to apply unless there are defences provided under section 11 of the Act, or a co-existence agreement for the use of similar marks in place.

Comparative advertising

Further clarity is provided where a trade mark is used when compared with other products. Comparative advertising is currently regulated under Directive 2006/114/EC of 12 December 2006, which deals with misleading and comparative advertising and identifies the circumstances where advertising and using a competitor’s or goods or services by a competitor is permitted. The Regulation would prohibit a third party from using a sign in a comparative advertising where such comparative advertising was contrary to Directive 2006/114/EC.

Consignments

This deals with goods that could not be imported into the EU even if it was for commercial purposes only. The aim is to prevent infringing goods from entering the EU, particularly in the context of sales over the internet. This would enable the trade mark owner to prevent businesses (within the EU or not) from importing goods located outside the EU that have been sold, offered, advertised or shipped to private consumers and discourage the ordering and sale of counterfeit goods over the internet. This issue clarifies the extent to which right holders can object to the importation of counterfeit items and this was welcomed by the ECTA.

Goods brought into the customs territory

The proposal is to close a loophole created by a recent CJEU decision in the Philips/Nokia case in which the entry, presence and movement of non-EU goods into the customs territory of the EU under a suspensive procedure would not infringe intellectual property rights. According to the CJEU, there would only be an infringement if it could be proved that they were the subject of a commercial act directed at EU consumers. The proposal would enable the right holders to prevent third parties from bringing goods from third countries bearing without authorisation a trade mark identical to the trade mark registered for those goods into the customs territory of the Union.

Limitation of the effects of a European trade mark

Article 12(1)(a) provides a limitation to use the trade mark to cover personal names only. For instance, the use of McDonalds for fish and chips in a specific locality could be permitted. Article 12(1)(b) is extended to deal with the use of non-distinctive signs or indications, and Article 12(1)(c) provides express reference to cover referential use in general. Conditions in which honest business practices are not complied with are also covered within the proposed CTR.

Designation and classification of goods and services

Article 28 is amended to deal with the designation and classification of goods and services in the Regulation. It follows a decision by the CJEU in which goods and services for which protection is sought need to be identified by the applicant with sufficient clarity and precision so that relevant authorities and businesses could determine the extent of protection the trade mark provides. According to the proposal, the OHIM would reject any application where it was registered against a certain class that was unclear. Where the registration is in more than one class, it is grouped according to the classes laid down under the Nice classification. Based on the proposals, the onus is placed on the applicants to be clear about the Nice classification system and identify which class its goods should be registered.

European certification marks

The European trade mark rules currently provide for the registration of individual and collective marks only. The proposals would provide a set of rules to cover the registration of European certification marks. These powers would be delegated to the Commission under Article 290 TFEU. Certification marks were, up until 1994, the main form in which a group of traders could protect their trade mark as a group. According to Torremans, it was the only form under which the quality of the product was testified to by the existence of the trade marks. Certification marks are currently covered under section 50 of the UK Trade Marks Act 1994. Certification marks are defined as an indication that the goods or services in question are, by the mark ‘certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods, or performance of services, quality, accuracy or other characteristics.’ It is not required that the mark be used during the course of trade. Schedule 2 of the TMA 1994 provides further detailed regulations on this. A good example of a certification mark is the name associated with the origin of goods indicating its quality, such as champagne in France.

The main provision under the Regulation is Article 74b which provides that:

‘A European certification mark shall be a European trade mark 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.’

The provision will address the lack of provision under the current EU framework on certification marks and the disparities with the national trade mark offices. This is separate from the protection of geographical indicators. The CTR was clear to note that the certification mark would not prevent a third party from using the mark if this was done in accordance with honest practices in industrial or commercial matters. Furthermore, a certification mark could not be used against a third party who is entitled to use a geographical name.
Tasks of the European Union Trade Marks and Designs Agency

Article 123b of the Regulation defines the tasks of the European Union Trade Marks and Designs Agency (formerly the OHIM), which are derived from other legal acts and may not relate to the EU trade mark system. Article 123b provides that:

1. The Agency shall have the following tasks:
   a. administration and promotion of the European trade mark system established in this Regulation;
   b. administration and promotion of the European design system established in Council Regulation (EC) No. 6/2002;
   c. promoting convergence of practices and tools in the fields of trade marks and designs in cooperation with the central industrial property offices in the Member States, including the Benelux Intellectual Property Office;
   d. the tasks referred to in Regulation (EU) No. 386/2012 of the European Parliament and of the Council.’

The agency will also promote convergence with other practices and tools on trade marks and designs (Art 123c). As the agency’s tasks are fairly straightforward, there is no need to discuss its role other than to say it will be given the mandate to ensure that Article 123c is followed.

Framework for cooperation

Article 123c deals with the cooperation between the EUTMDA and Member States’ intellectual property offices in order to promote convergence of practices and development of common tools. The Agency and Member State are required to cooperate and identify specific common projects of Union interest. A funding mechanism is established to enable the Agency to finance these projects.

Article 290 TFEU

Article 290 TFEU allows the legislator to delegate to the Commission the power to adopt non-legislative acts of general application to the Commission. There is no further need for a binding instrument of secondary legislation. These rules are provided under Commission Regulation (EC) No 2868/95 of 13 December 1995 that implements Council Regulation (EC) No 40/94 on the Community trade mark. Recital 26 provides for the Commission to be given powers to ensure ‘the efficient registration of legal acts of European trade mark as object of property and ensure full transparency of the register of European trade marks.’ This would include specific trade marks, the creation and transfer of a right in rem, the levy of execution, the involvement in an insolvency procedure and the grant or transfer of a licence and the cancellation or modifying entries for a trade mark.

The Commission would also introduce rules dealing with the registration of trade marks and the filing of trade mark applications so that an effective, efficient and expeditious system was created. Further rules would be introduced by the Commission under Article 290 TFEU for the revocation of a trade mark, so that it was effective and transparent. Conversion of an application for registration for a European trade mark into a national trade mark application would also come within the Commission’s remit under Article 290. The Commission would also set out the procedures for the international registration of trade marks in line with the rules of the Protocol relating to the Madrid Protocol.

Evaluation

An evaluation is expected by 2019 to review the implementation of the Regulation under Article 165a, in particular the legal framework for cooperation between Agency and the national trade mark offices and the Benelux Office for Intellectual Property (Art 165a).

Conclusion

Although the aim was to streamline and simplify the process for trade mark applications at EU level, ECTA has been clear to voice its concern in relation to the notion of ‘genuine use’ and the need for an express provision within the Regulation which would reduce the number of community trade mark registrations.

Addressing the differences between national trade mark offices and OHIM level is a start in simplifying the trade mark process. Furthermore, the issues on graphic representation in the context of non-traditional marks would increase certainty for trade mark applicants and open the door for an increase in applications in this area.

The Regulation should be viewed as tiding process on the current framework on trade marks rather than a major overhaul, and goes some way to address some of the recommendations on trade marks by the Max Planck study.

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Any errors or omissions remain with the author.

Notes

5 The proposed trade marks. Regulation will streamline the process for the registration of trademarks. For the purposes of this article, the proposed Trademark Directive is not considered. Further details of the proposed Directive can be found at http://eur-lex.europa.eu/legal-content/EN/ALL/?uri=CELEX:52013PC0162.2

7. EU: Final steps for EU Agencies deal available at http://ec.europa.eu/commis-


10. The proposed Regulation is anticipated to take effect in Spring 2014 (following amendments at EP level), and the Trademark Directive will take effect in Spring 2016 (see Art 54 of the proposed Trademark Directive).


12. Ibid.


14. Ibid.

15. Ibid, p 3.

16. Ibid.

17. Recital 27 of the Regulation.

18. Article 1(1) of Regulation.


20. This is yet to be considered under the proposals (see European Commission: ‘Programming of human and financial resources for decentralised agencies 2014-20’ http://ec.europa.eu/budget/library/biblio/documents/rm/144/2013_319_en.pdf, dated 10 July 2013. In the context of trade marks, the workings of the OHIM and the national trademark offices will be streamlined (Arts 1 and 2 of the proposed Regulation).

21. Ibid.

22. Article 38 of the proposed Community Trademark Regulation.

23. Ibid.


26. Article 290 TFEU delegates powers to the European Commission to adopt non-legislative acts to ‘supplement or amend certain non-essential elements of the legislative act.’

27. Recital 29.


29. Paragraph 2.9 of the Max Planck study.


32. Ibid, at para 52.

33. Ibid, at paras 69-79.


36. Paragraph 21.7 of the Max Planck study.


38. Ibid.

39. Ibid.

40. ECTA available at http://www.ecta.org/IMG/pdf/ecta_opinion_on_legislative-

41. C-194/11


43. Ibid.


45. Max Planck, op cit, n 11, p 129.

46. Ibid.

47. Rec 343 (H) – this laid down the three stage for passing off.

48. ECTA, op cit, n 61, p 9.

49. Ibid.

50. Ibid, last accessed 8 April 2014.

51. See also Recital 22.

52. Reckitt & Colman Products v Borden (No 3) [1990] RPC 341 (HL) – this laid down the three stage for passing off.

53. Ibid.

54. Ibid, last accessed 8 April 2014.

55. Ibid.

56. Ibid.


58. Section 5.3 of the Proposal for the Regulation, op cit, n 29.

59. Ibid.

60. C-194/11

61. Ibid.

62. ECTA, op cit, p 5, n 104.

63. ECTA available at http://www.ecta.org/IMG/pdf/ecta_opinion_on_legislative-

64. Recital 16.

65. IBO, ‘What is a co-existence agreement?’ at http://www.ipo.gov.uk/topics/ib-

66. Ibid.

67. Ibid.

68. Ibid.

69. Ibid.

70. Ibid.

71. PO, ‘What is a co-existence agreement?’ at http://www.ipo.gov.uk/topics/ib-

72. Ibid.

73. Ibid.

74. Ibid.

75. Ibid.


77. Ibid.

78. Ibid.

79. Ibid.

80. Ibid.

81. Ibid.

82. Ibid.

83. Ibid.

84. Ibid.

85. Ibid.

86. Ibid.

87. Ibid.

88. Ibid.

89. Ibid.

90. Ibid.

91. Ibid.

92. Ibid.

93. Ibid.

94. Ibid.

95. Ibid.

96. Ibid.

97. Ibid.

98. Ibid.

99. Ibid.

100. Ibid.

101. Ibid.

102. Ibid.

103. Ibid.

104. Ibid.

105. Ibid.

106. Ibid.

107. Ibid.

108. Ibid.

109. Ibid.

110. Ibid.

111. Ibid.

112. Ibid.

113. Ibid.

114. Ibid.

115. Ibid.

116. Ibid.

117. Ibid.

118. Ibid.

119. Ibid.

120. Ibid.

121. Ibid.

122. Ibid.