

COMMUNITY TRADE MARK LAW

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Community Trade Mark Law

Preface

The introduction in 1996 of the Community trade mark (CTM) brought into being a new and independent trade mark system with its own sources of law, its own procedures, and its own administrative and judicial bodies. Today, the case law of OHIM (including its Boards of Appeals), the EGC and the ECJ is absolutely central to Community trade mark law, including the trade mark laws of the Member States.

The practice of the EU bodies is often complicated and a massive number of decisions exist. Central for the focus of this book is to scrutinize, explain and categorize the case law in particular of the ECJ and the EGC. Especially in areas where there is no or limited case law from the courts in Luxembourg, references are made to the practice of OHIM, particularly decisions from the Boards of Appeal.

The book is written by practising attorneys for the benefit of company lawyers, attorneys, trade mark attorneys and anyone else dealing with trade mark law, whether on a Community level or nationally. Our chosen focus is the substantive aspects of Community trade mark law, and the book, therefore, does not offer a general introduction to national systems of trade mark law and deals only to a limited extent with the registration aspects of Community trade mark law. The focus remains also on issues of practical relevance for practitioners, and consequently the book does not embark upon theoretical interesting, but in practical life less important, discussions.

For the sake of clarity, we will often refer only to the Trade Mark Regulation, even when dealing with preliminary references which concerns the Trade Mark Directive, as the material provisions remain similar.

Work is currently ongoing for a revision of the Trade Mark Regulation and the Trade Mark Directive. This book contains, in section §1.06, an overall description of the current stage of these preparations and of the most significant changes. The changes are described in more detail in connection with the discussion of the relevant provisions.

Case law and literature are updated as at 15 August 2015.

List of Abbreviations

Amended Trade Mark Regulation	Council's final compromise text 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 - 2013/0088 (COD) of 8 June 2015
Amended Trade Mark Directive	Council's final compromise text on the proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks - 2013/0089 (COD) of 8 June 2015
BoA	Board of Appeal
Commission	The European Commission
Commission's Proposal (Trade Mark Directive)	The Commission's Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks – 2013/0089 (COD) of 27 March 2013
Commission's Proposal (Trade Mark Regulation)	The Commission's Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No. 207/2009 on the Community trade mark – 2013/0088 (COD) of 27 March 2013
Communication Council	Communication of the President of OHIM The Council of the European Union
Council's Compromise Proposal (Trade Mark Directive)	The Council's Compromise Proposal of 18 July 2009 for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark – 2013/0089 (COD)

Council's Compromise Proposal (Trade Mark Regulation)	The Council's Compromise Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark of 18 July 2014 – 2013/0088 (COD)
CTM	Community trade mark as defined in the Trade Mark Regulation
Customs Code	Regulation (EU) No 952/2013 of the European Parliament and of the Council of 9 October 2013 laying down the Union Customs Code
Customs Regulation	Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights
Design Regulation	Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs
Directive on Electronic Commerce	Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market
Directive on Misleading and Comparative Advertising	Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising
ECJ	The Court of Justice of the European Union
ECTA	European Communities Trade Mark Association
EEA	European Economic Area
EEA Agreement	Agreement on the European Economic Area
EFTA	European Free Trade Association
EGC	The General Court
EIPR	European Intellectual Property Review
EMA	European Medicines Agency
EMA Guidelines	Guideline on the acceptability of names for human medicinal products processed through the centralized procedure of the European Medicines Agency
Fees Regulation	Commission Regulation (EC) No. 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)

General Food Law Regulation	Regulation (EU) No. 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs
ICANN	The Internet Corporation for Assigned Names and Numbers
Implementing Regulation	Commission Regulation (EC) No. 2868/95 of 13 December 1995 implementing Council Regulation (EC) No. 40/94 on the Community trade mark
INID	Internationally agreed Numbers for the Identification of (bibliographic) Data
INTA	International Trademark Association
IP Rights Enforcement Directive	Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights
IPQ	Intellectual Property Quarterly
JiPLP	Journal of Intellectual Property Law & Practice
Madrid Agreement	Madrid Agreement concerning the International Registration of Marks of 14 April 1891, as revised at Brussels on 14 December 1900, at Washington on 2 June 1911, at The Hague on 6 November 1925, at London on 2 June 1934, at Nice on 15 June 1957, and at Stockholm on 14 July 1967, and as amended on 28 September 1979
Madrid Protocol	Protocol relating to the Madrid Agreement concerning the International Registering of Marks, adopted at Madrid on 27 June 1989, as amended on 3 October 2006, and on 12 November 2007
Max Planck Report	<i>'Study on the Overall Functioning of the European Trade Mark System'</i> published by the Max Planck Institute for Intellectual Property and Competition Law Munich 15 February 2011
Nice Agreement	Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised at Stockholm on 14 July 1967, and at Geneva on 13 May 1977, and amended on 28 September 1979
NIR	Nordiskt Immateriellt Rättsskydd
OHIM	Office for Harmonization in the Internal Market (Trade Marks and Designs)

OHIM Guidelines	Guidelines for examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trade Marks
Paris Convention	Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised at Brussels on 14 December 1900, at Washington on 2 June 1911, at The Hague on 6 November 1925, at London on 2 June 1934, at Lisbon on 31 October 1958, and at Stockholm on 14 July 1967, and as amended on 28 September 1979
Regulation on Jurisdiction and Recognition	Council Regulation (EC) No. 1215/2012 of 22 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters
Regulation on Plant Variety Rights	Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights
Spirit Drinks Regulation	Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks
The Parliament's Proposal (Trade Mark Directive)	European Parliament legislative resolution of 25 February 2014 on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks – 2013/0089 (COD)
The Parliament's Proposal (Trade Mark Regulation)	European Parliament legislative resolution of 25 February 2014 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 – 2013/0088 (COD)
Trade Mark Directive	Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks
Trade Mark Regulation	Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark
Treaty TRIPS	The Treaty on the Functioning of the European Union Trade Related Aspects of Intellectual Property Rights – Annex 1C to the Marrakesh Agreement Establishing the World Trade Organization

Wine Regulation	Council Regulation (EC) No 1234/2007 of 22 October 2007 establishing a common organization of agricultural markets and on specific provisions for certain agricultural products (Single CMO Regulation)
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

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