

Hasselblatt (ed.)

Community Trade Mark Regulation

A Commentary

C.H.BECK · Hart · Nomos

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A Commentary

edited by
Gordian N. Hasselblatt

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Foreword

The Community Trade Mark (CTM) is now widely recognised as a very important tool helping entrepreneurs both large and small to gain full access to the European single market while protecting their IP rights.

When OHIM was founded two decades ago, few would have predicted the popularity that the CTM enjoys today. Right from the start demand exceeded expectations and as the Office and the CTM celebrate their 20th year, the statistics speak for themselves.

Total applications from CTMs now top 1.3 million, and the Office has in the region of 350,000 users in almost 200 countries. Demand has continued to grow even through the current financial crisis.

But, in spite of the success and economic importance of the CTM, to date there is only a small body of literature dealing with this EU-level right which is aimed at the needs of IP professionals.

Under the editorship of Professor Hasselblatt, the current book, and a companion volume on the Registered Community Design (RCD) set out to address this gap in the market by providing comprehensive pan-European commentaries in English, covering the entire text of the relevant legislation for Community trade marks and designs, 'provision by provision'.

The volume on the CTM has been prepared against a background of considerable change in Intellectual Property Rights in the EU as the European Commission, Council and Parliament finalise the details of the new Trade Mark Package, which seeks to modernise and further harmonise the Regulation and the Directive.

These changes also reflect the increasingly international nature of business and the high value put by industry on IP rights. While two-thirds of CTM applications come from within the EU, one-third of them are made by companies from elsewhere, eager to trade within the single market.

The value of IP rights was confirmed by a recent study on the economic contribution of IPR-intensive industry, carried out by OHIM through the European Observatory on Infringements of Intellectual Property Rights, in partnership with the European Patent Office, and with the help of a number of other authorities.

The study, which for trade mark data examined CTMs and International Registrations, shows that 39 % of total economic activity in the EU – that is € 4.7 trillion of GDP (\$6.3 trillion) – is provided directly by industries that use IP rights intensively.

Approximately 26 % of all employment in the EU directly depends on the IPR-intensive industries and another 9 % of jobs rely indirectly on these industries and they also account for 90 % of external trade.

The study shows a strong inter-dependence of IP rights, since they are often used in combination, but trade marks emerge as being the IP right that is most relied upon.

The CTM, and its companion design right, the RCD, along with the Unregistered Community Design, are part of a two-tier system of trade marks and design rights. Consequently, OHIM works in close partnership with National IP Offices to provide a choice of national or EU-wide rights to entrepreneurs, depending on their business needs. This relationship has been reinforced by the success of the European Trade Mark and Design Network, which is building shared IT tools to modernise the trade mark and design system, and working to converge practices.

Against this background, it is refreshing to see the increased interest in providing detailed analysis of the legislation underpinning these important IP rights.

Foreword

Professor Hasselblatt is a well-known and highly respected figure in the IP world. A partner in the Cologne office of CMS Hasche Sigle, he is also adjunct professor at both the McGeorge School of Law, Sacramento, as well as the Chicago-Kent College of Law, and he is a member of GRUR's expert committee for trade mark and unfair competition law.

In addition to authoring a number of commentaries personally, Professor Hasselblatt has assembled for both volumes an impressive list of co-authors including leading figures in European Intellectual Property law drawn from a wide spectrum of law firms, faculties and authorities.

The commentaries are written 'by practitioners for practitioners', and as such are a very welcome and useful addition to the canon of literature on IP, deserving a place on the bookshelf of any professional or student interested in the Community trade mark and design system.

I commend him and his fellow authors for the scale and ambition of the work and am particularly pleased to see that the intention is to update both volumes regularly to keep pace with changes in legislation and practice.

António Campinos
President, OHIM

Preface

The international market for books in the field of intellectual property is largely saturated. There is, however, a noticeable void in the area of pan-European commentaries in the English language on both the Community Trade Mark Regulation (CTMR) and the Community Design Regulation (CDR). In fact, the low density of the available English language literature is in striking contrast to the commercial importance of the Community trade mark and the Community design. The present Commentary and the parallel work on the CDR aim to make a contribution to filling this gap.

This Commentary has been written by ‘practitioners for practitioners’, with a focal point on the application, registration and enforcement practice regarding Community Trade Marks. The authors of this work come from all walks of life and are all true trade mark experts; the band of authors encompasses practising lawyers, legal scholars, judges and OHIM officials. Suffice to say that the Commentary reflects the personal views of the authors and should not be attributed to their respective law firms and clients or particular cases. In the case of OHIM agents and officials, the views and opinions expressed do not necessarily reflect those of the Office.

Instead of reflecting the legal conception of one or a few Member States, the Commentary endeavours to interpret the CTMR from a European perspective, focusing on the plethora of decisions rendered by OHIM, the GC and the CJ, supplemented by important decisions handed down by the Community Trade Mark Courts, namely where such decisions were rendered in ‘landmark cases’.

The format corresponds to that of a ‘traditional’ German commentary, dealing with the entire text of the CTMR on an article by article basis. As far as possible, the commentaries on the individual articles are for the most part structured identically so as to enhance the user-friendliness of the work. In addition, by way of cross references, the reader’s attention is called to systematics not only in the CTMR, but also to similarities or differences in terms of the CDR. Where appropriate, the authors explain the practical implications of the provisions contained in the CTMIR and the CTMFR.

The CTMR commentary under A. obviously constitutes the main part of the present work. However, the CTMR does not regulate all of the proprietor’s rights but limits itself to the right to injunctive relief and to the claim for reasonable compensation under Article 9 (3) CTMR. The Regulation remains silent about all other claims. Under Art. 101 CTMR, the courts are to apply their national law on all matters not covered by the CTMR. This holds true, amongst others, to many remedies in infringement actions. Therefore, in order to achieve the quite ambitious goal of a ‘unitary character’ throughout the EU, it is of paramount importance to establish and maintain uniform standards for the enforcement of the CTMR in all EU Member States. At the same time, it has to be ensured that, as far as it is possible, these standards will be uniformly applied by the courts. In this respect, the Enforcement Directive (2004/48/EC) has proven to be quite valuable, as it provides for a harmonized body of law. As it is crucial for the proprietors of CTM rights to be familiar with said legal framework, under B. this Commentary deals with those measures and remedies that are not regulated in the CTMR.

Furthermore, under C. the Commentary includes a section explaining the enforcement of intellectual property rights under the national laws in each of the 28 Member States. This entails the assertion of the proprietors’ IP rights out of court as well as in litigation in summary and main proceedings. All of these ‘country reports’ are written by experts from the respective EU jurisdiction and follow a uniform structure.

Preface

The Commentary is rounded off by supplementary rules, such as implementing regulations and examination guidelines under D., followed by a Table of Cases under E., reflecting the decisions cited throughout this Commentary.

Most recently, the Commission's reform plans have triggered lively discussions, which are also dealt with in this Commentary. Certainly it is safe to say that, all in all, the CTMR has stood the test of time. Even after some 20 years its foundations remain perfectly valid. Nonetheless, it appears to be time to adapt the current system to the technological, commercial and political developments that have taken place over the past 25 years. Therefore, the Commission rightfully deems it necessary to modernise the EU trade mark system by making it more effective, efficient and consistent. The Commission submitted far-reaching reform proposals on 27 March 2013, which are aimed at a well-targeted modernization rather than a major overhaul of the current regime. At the time of printing the present Commentary, it could not be foreseen when and to what extent the proposals for a revision of the CTMR and a recast of the TMDir – seen by the Commission as one package – were going to mature into legal force. Owing to its importance, the Commission's reform efforts are discussed in detail in the present Commentary under Art. 1 CTMR mn. 42–60; moreover, individual aspects of the 27 March 2013 reform proposals are examined in the comments on the provisions concerned.

The authors, the publisher and the editor would be very appreciative of readers' comments and suggestions. Please send any feedback and criticism to gordian.hasselblatt@cms-hs.com.

Gordian N. Hasselblatt
Cologne, February 2015

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List of Abbreviations

acc.	according to
ACRR	(Polish) Act on Copyright and Related Rights
AIPPO	International Association for the Protection of Intellectual Property
All E.R.	All England Reporter
AnwBl	Anwaltsblatt (German law journal)
approx.	approximately
BGB	Bürgerliches Gesetzbuch (German Civil Code)
BGH	Bundesgerichtshof (German Federal Court of Justice)
BoA	Board of Appeal
BT	Bundestag (German Federal Parliament)
C&D	cease and desist
CD	Community Design
CDFR	Community Design Fees Regulation
CDIR	Community Design Implementation Regulation
CDPA (UK)	Copyright, Designs and Patents Act
CDR	Community Design Regulation (EC) 6/2002 of 12 December 2001 on Community Designs
cf.	confer (consult; see)
Ch D	Chancery Division (UK)
ch.	chapter(s)
CJ	Court of Justice
CJEU	Court of Justice of the European Union
cl.	clause
COM	Proposed legislation and other Commission communications to the Council and/or the other institutions, and their preparatory papers. Commission documents for the other institutions
Com.	Commission
Common Regulations	Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement
CTM	Community Trademark
CTMDir	Community Trade Mark Directive
CTMFR	Community Trade Mark Fees Regulation
CTMIR	Community Trade Mark Implementing Regulation
CTMR	Community Trade Mark Regulation
DDir	Design Directive
Dec.	Decision
Dir.	Directive
diss.op.	dissenting opinion
Drs	Drucksache (printed matter of the German Parliament)
Duke LJ	Duke Law Journal
E.C.D.R.	European Copyright and Design Reports
e. g.	exempli gratia (for example)
EnforcementDir	Directive on the enforcement of intellectual property rights
E.I.P.R.	European Intellectual Property Review
E.T.M.R.	European Trade Mark Report
ECHR	European Convention on Human Rights
ECR	Report of cases before the European Court of Justice and the General Court
EEA	European Economic Area/European Economic Agreement
EIPR	European Intellectual Property Review
ELJ	European Law Journal
EPC	European Patent Convention of 1973
EPLA	European Patent Litigation Agreement
EPO	European Patent Office
EuR	Europarecht (German law journal)
EuZW	Europäische Zeitschrift für Wirtschaftsrecht (German law journal)

Abbreviations

EWCA	Court of Appeal for England and Wales
ExaminationGuidelines	Guideline for the Examination of Community Designs by OHIM
Fed.	Federal
fn.	footnote
FS	Festschrift (liber amicorum)
FSR	Fleet Street Reports: Cases on Intellectual Property Law (UK)
GC	General Court
GCA	German Copyright Act
GDA	German Design Act
Geneva Act	Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs
GRUR	Gewerblicher Rechtsschutz und Urheberrecht (German law journal)
GRUR Int.	Gewerblicher Rechtsschutz und Urheberrecht – Internationaler Teil (German law journal)
GRUR Prax	Gewerblicher Rechtsschutz und Urheberrecht, Praxis im Immaterialgüter- und Wettbewerbsrecht (German law journal)
GRUR-RR	Gewerblicher Rechtsschutz und Urheberrecht – Rechtsprechungsteil (German law journal)
i. e.	id est
ibid.	in the same place
ICA	Italian Copyright Act
id.	idem, the same
IEHC	High Court of Ireland decisions
IIC	International Review of Intellectual Property and Competition Law
INID	Internationally agreed Numbers for the Identification of Data
INTA	International Trademark Association
Invalidity Guideline	Guideline for the Proceedings Relating to a Declaration of Invalidity of a Registered Community Design by OHIM
IP	Intellectual Property
IPC	(Italian) Industrial Property Code
IPL	(Polish) Industrial Property Law Act
IPLR	Intellectual Property Law Reports
IPR	Intellectual Property Rights
IR	International Registration
J	Judge
lit.	letter; littera
LOC	Locarno Classification
loc. cit.	in the place cited
Madrid Agreement	Madrid Agreement Concerning the International Registration of Marks of 14 April 1891
MarkenG	Markengesetz (German Act on the Protection of Marks and Other Designations)
Mitt.	Mitteilungen der deutschen Patentanwälte (German law journal)
mn./mns.	margin number/margin numbers
MPI	Max-Planck-Institut
Nice Agreement	Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957
nyp	not yet published
NZI	Neue Zeitschrift für Insolvenzrecht (German law journal)
OAPI	African Intellectual Property Organisation
Öbl	Österreichische Blätter für gewerblichen Rechtsschutz (Austrian law journal)
OECD	Organisation for Economic Cooperation and Development
Office	Office for Harmonization in the Internal Market
OGH	Oberster Gerichtshof (Supreme Court of Austria)
OHIM	Office for Harmonization in the Internal Market
OJ	Official Journal
para./paras.	paragraph(s)
Paris Convention	Paris Convention for the Protection of Industrial Property of 20 March 1883
PatG	Patentgesetz (German Patent Act)
PCT	Patent Cooperation Treaty

Abbreviations

PI	preliminary injunction
Protocol	Protocol Relating to the Madrid Agreement of 27 June 1989
pub.	publication
R	rule (WIPO)
RBC	Revised Berne Convention
Rc.	recital
RCD	Registered Community Design
Reg.	Regulation
RenewalGuidelines	Registered Community Design Renewal Guidelines by OHIM
Rope	Rules of Procedure
RPC	Reports of Patents, Designs and Trade Mark Cases
RTM	Registered Trade Mark
RTMA	Registered Trade Mark Attorney
s.	see
SCT	The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications
SEA	Single European Act
Sec.	section
SME	Small and medium sized enterprise
Stat.	Statute(s)
Swiss IPRG	Bundesgesetz über das Internationale Privatrecht (Swiss law on conflicts of law)
TEC	Treaty of the European Community
TEU	Treaty on European Union
TFEU	Treaty on the Function of the European Union
TM	Trademark
TMR	Trademark Report
TMDir	Directive (EC) 2008/95 of 22 October 2008 to approximate the law of the Member States relating to Trade Marks
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
TRT	Trademark Registration Treaty
U.S.	United States Reports
U.S.C.	US Supreme Court cases
UCD	Unregistered Community Design
UDRP	Uniform Domain-Name Dispute-Resolution Policy
UKHL	UK House of Lords
UKSC	UK Supreme Court (decided cases)
UNCITRAL	United Nations Commission on International Trade Law
USPTO	U.S. Patent and Trademark Office
v	versus
VAT	Value Added Tax
WIPO	World Intellectual Property Organization
WM	Wertpapier-Mitteilungen (German law journal)
WRP	Wettbewerb in Recht und Praxis (German law journal)
WTO	World Trade Organisation
Yb	Yearbook
ZfRV	Zeitschrift für Europarecht, Int. Privatrecht & Rechtsvergleichung (German law journal)
ZGE	Zeitschrift für Geistiges Eigentum (German law journal)
ZUM	Zeitschrift für Urheber- und Medienrecht (German law journal)
ZUR	Zeitschrift für Umweltrecht (German law journal)

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