



European Communities Trade Mark Association

Minutes of the meeting with – DG Internal Market – European Commission
February 29, 2008

PARTICIPANTS:

On behalf of the Commission

Margot Fröhlinger,	Director DG MARKT - Knowledge based economy
Harrie Temmink	Internal Market and Services DG - Industrial Property Unit
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On behalf of ECTA

Mireia Curell	President
Simon Reeves	First Vice-President
Doris Bandin	Chair of the Law Committee
Joao Pereira da Cruz	Chair of the OHIM-Link Committee
Ignacio D. Rivera Elzaburu	Chair of the Anti-Counterfeiting Committee
Fabio Angelini	Member of the Law and OHIM-Link Committees
Sandrine Peters	Legal Co-ordinator

1. Commission's communication on CTM fees

The Commission is still working on the follow up of the communication from the Commission to the European Parliament and the Council on the "Financial perspectives of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) dated 22 December 2006 (http://oami.europa.eu/EN/office/pdf/ohim_EN.pdf)

Indeed, at first instance the Commission has to propose some reduction of fees (namely the application, registration and renewal fees) in such a way that the OHIM budget reaches a balance. The reason of the delay in making the proposal is due to the fact that it has to be accompanied by an impact assessment.

At the same time the Commission informs that it is trying to enhance the cooperation between OHIM and the national offices namely in 2 areas:

- in the modernisation of the national offices and to rationalise the national offices
- to develop the role of the national offices in the field of counterfeiting and Piracy such as for instance the UKIPO.

ECTA underlines the necessity for more harmonization and the fact that the CTM system and Harmonization Directive might be worth to be reviewed as these were drafted in a different EU context (for instance the EU growth from 12 to 27 Member States). Also, the CTM system has been drafted about 10 years later than the Harmonization Directive both are not totally in line either.

The Commission confirmed that on top of the question of the fee reduction and the impact assessment, it is launching a comprehensive evaluation of the trade mark systems in Europe.

This would take the form of an evaluation of both the CTM and national systems, including the CTM and national courts.

In this context, the Commission will be in contact with the stakeholders to discuss concrete problems and draft concrete proposals. ECTA has been formally invited to contribute to this study.

2. The OHIM and its administration.

ECTA shared its view that OHIM is well administered but that some fine tunings are still necessary such as for example on improvements in the opposition proceedings.

3. Enforcement of OHIM decisions on costs

ECTA submitted the fact that the enforcement of OHIM decisions on costs system does not work – but this could make part of the study on the evaluation of the trade mark system as referred to under point 1 above.

4. Representation before the European Court of Justice and the Court of First Instance

Some German Members are concerned about the fact that Patentanwälte who are qualified as representatives and who advise and represent clients from birth of their trade marks up to appeal at the Board of Appeal – and therefore have the best knowledge of the matter – must retain Rechtsanwälte (who need not even be specialised in trade mark law) to deal with the case before the ECJ.

Ms Fröhlinger said that there is little they can do in this matter as this is not of their competence.

5. Oral hearings and Judicial panel at the ECJ level

Judicial Panel

Ms Fröhlinger notes this issue is handled by the Legal Service and that it is at present kept in abeyance since it does not constitute any priority. Instead there is the idea to possibly organize special chambers dealing with IP matters.

Oral Hearings

ECTA underlines the need to keep oral hearings at the CFI and ECJ levels as this can be very helpful in some cases.

6. Enforcement of IP rights.

Unit D-3

ECTA welcomes the Creation of the new Unit D-3 dedicated to "Enforcement of industrial and intellectual property rights". ECTA also underlines the need for coordination between the various DGs dealing with Counterfeiting and Piracy matters.

Ms Fröhlinger confirms this need and is willing that this new Unit plays this coordination role but does not underestimate the difficulty to do so.

She also underlines the need of some structure and coordination between the Member States as is already the case at the custom level. This should include cross-boarder exchanges between the Member States.

The Unit will also be active in getting the necessary information from the Public Partnership and to structure all relevant information received from the various sources such as the Customs, the Public Sector or the OECDE.

The Unit will also seek contact with Internet companies in order to gather information on the selling of counterfeit goods on the Internet.

Status of implementation of Directive 2004/48 in the Member States.

Four countries have yet not implemented the Directive (Germany, Portugal, Sweden and Luxemburg) and necessary actions have been taken accordingly.

In April 2009, we should receive the report of the Member States on the results of the Directive and the Commission will then evaluate the necessity to take any possible action further to these reports.

Criminal Sanctions

We are informed that the Proposal of Directive on Criminal Sanctions is actually in the "refrigerator". The Commission underlines the fact this being a delicate question which might not be solved in the near future.

7. Free Trade Agreement with Ukraine

ECTA mentioned that it is important that the Free Trade Agreement (FTA) includes a Chapter on IP rights as for instance:

- a lot of counterfeiting is to be noticed in Ukraine;
- Ukraine ignores famous rights;

- It is very difficult to go through an Ukrainian registration and to enforce its IP rights.

The Commission confirms that the FTA will include an IP Chapter.

ECTA has further been informed that the Commission is preparing a communication on Strategy of Industrial Property Rights which amongst other could include references to IP chapters in FTAs.

8. **ETMA**

Further to the request of ITMA (UK Institute of Trade mark Attorneys) at the joint meeting held on February 28, ECTA raised the issue of the title ETMA (European Trade Mark Attorney) for representatives in trade mark matters before OHIM.

According to ITMA there is a recommendation on the use of this title by OHIM and it was wondered whether the title European Trade Mark Attorney could be officially recognised, so as to avoid for instance that non "OHIM" representatives qualifies themselves as European Trade Mark Attorney.

Ms Fröhlinger was unaware of this and is willing to inquire this matter.

Reported by Sandrine Peters, ECTA Legal Co-ordinator