



20 January 2011

### MEETING OF BUSINESSEUROPE WITH PRESIDENT OF OFFICE FOR THE HARMONISATION IN THE INTERNAL MARKET (OHIM) ANTONIO CAMPINOS

#### BUSINESSEUROPE priorities for the future of the European trademark system:

- Harmonised trademark legislation throughout the EU (at both Community and national level) is needed. A new or amended European Trademark Directive could form the basis for this. This would ensure predictability of decisions to the benefit of users and consumers.
- Procedural requirements (filing trademarks, examination, renewal, changes, opposition etc) are still quite different with respect to the Community Trademark and national trademarks. The same applies to rules and procedures.
- This is why BUSINESSEUROPE supports harmonisation with respect to procedures and practices both at Community as well as national level.
- In addition, dissemination and exchange of information between national offices themselves and also between national offices and OHIM is key to further strengthen cooperation and reliability for the benefit of companies. Similarly exchange of information and cooperation has to be fostered between the administrative authorities and the respective courts involved in trademark matters.
- The Community Trademark system and OHIM have proved to provide a modern and ever improving trademark system over the last decade. Taking into account the fact that Community trademark legislation has now been in effect for more than 15 years, there is room for review and possible improvement. The success that the Community Trademark system (and OHIM) has shown makes it a perfect benchmark for other authorities. This benchmarking is a basic step in improving the European trademark system, at both Community and national level.
- **Genuine use:** BUSINESSEUROPE has been following closely the debate in relation to the use of a Community Trade Mark (CTM) incited by the Benelux Office for Intellectual Property decision in the ONEL/OMEL case that the use of a Community Trade Mark (CTM) in one country (here: Netherlands) was not deemed sufficient to constitute genuine use of such a trade mark in the European Community within the meaning of Article 15 of the Community Trade Mark Regulation. We have also followed subsequent decisions and statements by other national intellectual property offices on the issue of use.



- BUSINESSEUROPE believes that these decisions and statements undermine the unitary nature of the CTM as a fundamental requirement to support the proper functioning of the EU single market. They contradict the position expressed in the Joint Statement by the Council and the Commission of 20 December 1993 concerning the territorial requirement for a CTM to be genuinely used “in the Community” (Article 15 CTMR) and as applied by the OHIM and confirmed by the case law of the European Court of Justice.
- The question of whether or not use of a CTM is genuine use within the Community must be assessed on a case-by-case basis without introducing territorial elements but taking all the circumstances of a specific case into account. Making the assessment of use conditional on the number of Member States affected by the use of the CTM can only lead to fragmentation and repudiation of the single market.
- Such a change would put SMEs in a more disadvantageous position because it takes them longer to develop their businesses due to the lack of resources to expand their market simultaneously across a number of countries. It would also negatively affect predictability of decisions and create an environment of uncertainty for users.

---