



## Trade Marks

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## Border Measures

REGULATION (EU) No 608/2013 of 12 June 2013  
concerning customs enforcement of intellectual  
property rights

Consolidation of system in place for 20 years

But substantial change of previous regime:

- New definitions of counterfeit goods
- Clarification of applicable law
- Transit dilemma unresolved

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| HOYNG<br>MONEGIER™ | Border Measures: Definitions  |
|                    | <p>Counterfeit Goods</p> <p><i>Goods which are the subject of an act infringing a trade mark in the Member State where they are found and bear without authorisation a sign which is identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished in its essential aspects from such a trade mark</i></p> <p>3</p> |

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| HOYNG<br>MONEGIER™ | Border Measures: Transit  |
|                    | <p>The majority of goods that enter the EU are declared in transit</p> <p>In transit, these goods are not <i>subject to an act infringing a trade mark in the Member State where they are found</i></p> <p>Hence they are not counterfeit goods under the Customs Regulation</p> <p>4</p> |

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| HOYNG<br>MONEGIER™ | Border Measures: Applicable Law  |
|                    | <p>Applicable Law</p> <p>Provision referring to Art. 8 of Regulation (EC) No 864/2007 (Rome II, Applicable Law non contractual obligations) taken out of Regulation</p> <ul style="list-style-type: none"> <li>• Article 8 of Regulation 864/2007 allowed the national court to apply the law of the country where the act of infringement occurs</li> <li>• Only national law shall apply</li> </ul> <p>5</p> |

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| HOYNG<br>MONEGIER™ | TM Legislative Package  |
|                    | <p>Two Proposals:</p> <ul style="list-style-type: none"> <li>• Proposal amending Council Regulation (EC) No 207/2009 on the <i>Community trade mark</i> (COM(2013)0161)</li> <li>• Proposal for a Directive of the European Parliament and of the Council to <i>approximate the laws of the Member States relating to trade marks</i> (COM(2013)0162)</li> </ul> <p>6</p> |

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| HOYNG<br>MONEGIER™ | TM Legislative Package: Timeframe  |
|                    | <p>Parliament adopted amended Commission proposals on February 25, 2014 (<i>first reading</i>)</p> <p>Council to start review of amendments end of April</p> <p>Package needs approval of both Parliament and Council</p> <p>(Art. 294 Lisbon Treaty)</p> <p>7</p> |

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| HOYNG<br>MONEGIER™ | TM Legislative Package: Highlights   |
|                    | <p>Increased harmonization and modernization of national TM law:</p> <ul style="list-style-type: none"><li>• Codification and coordination</li><li>• Less optional provisions</li><li>• Trademarks as objects of property</li><li>• Registration process</li></ul> <p>Changes to CTM regime less substantial and related more to institutional aspects of European Trade Marks and Designs Agency</p> <p>8</p> |

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| HOYNG<br>MONEGIER™ | TM Legislative Package: New Directive  |
|                    | <p>Art. 3:</p> <p>No longer requirement of graphical representation: rather<br/> <i>"being represented in the Register in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded"</i></p> |

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| HOYNG<br>MONEGIER™ | TM Legislative Package: New Directive  |
|                    | <p>Art. 5:</p> <p>Refusal for relative grounds now <i>mandatory</i> when:</p> <ul style="list-style-type: none"> <li>• Use of identical/similar mark and unfair advantage/detrimental to distinctive character or reputation of earlier TM with reputation (no similarity of goods required)</li> <li>• Bad faith registration and confusion with earlier foreign TM that is used when application is made</li> </ul> <p><i>Additional</i> refusal for relative ground when:</p> <ul style="list-style-type: none"> <li>• Application by agent/representative</li> </ul> |

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| HOYNG<br>MONEGIER™ | TM Legislative Package: New Directive   |
|                    | <p>Art. 10</p> <p>Exclusive rights: additional <i>mandatory</i> protection when:</p> <ul style="list-style-type: none"> <li>• Art. 10.2.c: Use of identical/similar mark and unfair advantage/detrimental to distinctive character or reputation of earlier TM with reputation (no similarity of goods required)</li> </ul> |

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| HOYNG<br>MONEGIER™ | TM Legislative Package: New Directive   |
|                    | <p>Art. 10</p> <p>Exclusive rights: <i>additional protection</i> when:</p> <ul style="list-style-type: none"> <li>• Art. 10.4: Import of small consignments BUT only when identical/quasi identical sign is used and remedy only against consignor acting in the course of business</li> <li>• Art. 10.5: Import of goods in the course of business w/o release into commerce (transit) when identical/quasi identical sign is used BUT without prejudice to WTO rules</li> </ul> |

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| HOYNG<br>MONEGIER™  | TM Legislative Package: New Directive |
| <p>Art. 11</p> <p><i>New exclusive right:</i></p> <ul style="list-style-type: none"> <li>• affixing a sign identical with or similar to the trade mark on packaging, labels, tags, security features, authenticity devices or any other means.</li> <li>• offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security features, authenticity devices or any other means on which the mark is affixed.</li> </ul> <p>When get-up, packaging or other means is used in relation to goods or services and the use in relation to those goods or services would constitute an infringement of the rights of the proprietor</p> <p style="text-align: right;">13</p> |                                       |

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| HOYNG<br>MONEGIER™   | TM Legislative Package: New Directive |
| <p>Art. 14.c</p> <p><i>New limitations to exclusive rights when use:</i></p> <ul style="list-style-type: none"> <li>• necessary to indicate the intended purpose (e.g. accessories or spare parts);</li> <li>• in comparative advertising as in Directive 2006/114/EC 1;</li> <li>• to bring to the attention of consumers the resale of genuine goods that have originally been sold by or with the consent of the proprietor of the trade mark;</li> <li>• to put forward a legitimate alternative;</li> <li>• for the purposes of parody, artistic expression, criticism or comment</li> </ul> <p style="text-align: right;">14</p> |                                       |



Still work in process, to be continued  
after elections ...

Thank you

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