

The Intellectual Property Office
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

16th April 2018

Dear Sir/Madam,

CITMA proposed answers to IP consultation on implementation of the EU Trade Mark Directive 2015

1. The removal of the graphical representation requirement is likely to increase the demand for unusual mark types, although the take-up at the EUIPO appears to have been relatively modest to date. The ability to file such marks means that our clients are likely to consider applying to register them and gain new monopoly rights.
2. We believe that the proposed additional mark types and formats should be sufficient for the time being.
3. The proposed revisions to section 1(1) provides welcome clarity. However, in order to provide for the assessment to be carried out on appeal, we would suggest addition of wording to reflect that it extends to matters on appeal.
4. In practice, where there has been sufficient use prior to the application date that the mark has acquired distinctiveness, use after the application is taken into account. However, we do not consider that formal implementation will bring more clarity or legal certainty, so we do not support implementation of this optional article.
5. We agree that section 6(3) is contrary to the Directive because expired marks are not contained within the relevant definition.
6. We agree with the approach to dealing with the potential gap because it will give greater legal certainty to later applicants whilst not being inequitable to owners of expired registrations.
7. We consider that the reference to “industrial property right” is inherently broader than design rights and registered designs, because these are not the only industrial property rights which exist and are not specifically covered elsewhere. However, the existing reference to “in particular” is sufficient for us to agree that no amendment is necessary.

8. We do not support implementation of this optional article in view of the scope of section 3(6).
9. We agree that section 10(6) can be repealed.
10. We agree that new section 10A should apply to goods originating outside the EU rather than the EEA because of the lack of harmonisation between the relevant customs practice in the EU and the EEA.
11. We agree with the proposal to implement Article 11 by replacing section 10(5) with new provisions because the new provisions are broader than section 10(5) and more closely aligned to Article 11.
12. The changes should assist in tackling counterfeit goods and provide more effective protection. This is because goods in transit are often not genuinely in transit to the stated location and often end up on sale in other jurisdictions. Although there will be obvious costs in detaining the goods, the onus being on the party who is shipping the goods will offset such costs.
13. We have no comments on this point.
14. We agree that a specific enforcement mechanism is required and is the correct approach. However, whilst an order for amendment of the relevant publications appears proportionate, destruction would appear to be appropriate only in extreme cases. We believe that it needs to be clear that destruction is not a default option, otherwise we foresee circumstances whereby dictionaries are destroyed because of the inclusion of just one word.
15. We have no comments on this point.
16. We have no comments on this point.
17. We believe that the introduction of this defence is likely to be beneficial to our members and their clients because it will reduce or even eliminate threats of infringement proceedings based on registrations which are vulnerable to revocation for non-use.
18. We agree because the existing means appear to be sufficient to give effect to Article 24.
19. We are uncomfortable with this point. We are concerned that if the proprietor is not joined in an action, it might lead to situations whereby the proprietor is not putting their head above the parapet, and in turn, this provision could be abused by proprietors as they are effectively able to shield themselves.

20. As a membership association, we are not able to answer this.
21. We agree that this term is too vague, and therefore lacks legal certainty, for the reasons put forward in the consultation document.
22. We agree in general, but believe that there is scope and justification for a broader definition than that proposed.
23. We agree because it is not equitable that any authorised user of a collective mark should have sufficient authority to bring proceedings as if it were the proprietor.
24. a) We agree with this approach, as there appears to be no workable alternative; b) We are unsure that the perceived benefit of precluding the division of a registration with regard to the goods and/or services outweighs the practical benefit of being able to do so; c) We agree that it is preferable to await action from WIPO in relation to the division of international marks.
25. We have no comments on this point.
26. Yes, because a disclaimer or limitation is often integral to the settlement of an opposition or a broader dispute involving trade mark applications and prior rights.
27. It would remove a currently useful option for settlement of disputes involving UK trade marks.
28. Our members would be most likely to use their internal resources, rely on CITMA and the IPO to provide seminars, webinars and perhaps attend commercial events on the changes.
29. This is difficult to quantify, but we would estimate at least 4 to 6 hours per member. The changes will be relevant to our members in every category, from senior chartered trade mark attorneys to those more qualified recently or in this process of qualification and paralegal members.
30. This is difficult to assess, but there is likely to be interest, both from clients of our members in private practice and for those working in industry, in receiving advice on the changes. The advice is likely to be provided at senior level within our members. Quantifying the likely time is not feasible.

Yours faithfully,

Daniel Joy
CITMA Law & Practice Committee