LaV 20.11.2018, HE 201/2018, MAOn lausunto,

Korjus Nina (MAO) <nina.korjus@oikeus.fi>

Hei,

aiemmin lähettämääni markkinaoikeuden lausuntoon liitteenä oheinen tavaramerkkidirektiivin 43 artiklan tulkintaa koskevaan kysymykseeni saatu komission vastaus, joka vahvistaa lausunnossamme väitemenettelyn osalta esitettyä ja jonka mukaan näyttäisi selvältä, ettei jäsenvaltioissa voida enää säätää väitemenettelystä myös ehdottomilla hylkäys- ja mitätöintiperusteilla. Ehdotetun lain 31 § vaikuttaisi siten direktiivin vastaiselta, kun siinä mahdollistetaan vetoaminen myös ehdottomiin hylkäys- ja mitätöintiperusteisiin eikä vain suhteellisiin.

Ystävällisin terveisin,

Nina Korjus

Markkinaoikeustuomari – Marknadsrättsdomare – Judge

Markkinaoikeus – Marknadsdomstolen – The Market Court

Radanrakentajantie 5 / Banbyggarvägen 5

FI-00520 Helsinki / Helsingfors

+358 29 564 3303 / +358 50 441 4709

nina.korjus@oikeus.fi

Lähettäjä: tomas.eichenberg@ec.europa.eu <tomas.eichenberg@ec.europa.eu>

Lähetetty: 19. marraskuuta 2018 16:32

Vastaanottaja: Korjus Nina (MAO) <nina.korjus@oikeus.fi>

Aihe: RE: Directive 2015/2436; Article 43 Opposition procedure

Dear Ms Korjus,

Thank you for your enquiry in relation to Article 43 of Directive (EU) 2015/2436.

As main drafter of the original Commission proposal (COM(2013) 162 final), it is my clear understanding that the word "at least" in Article 43(2) only refers to the relative grounds for refusal laid down in Article 5 of the Directive and only concerns the capacity to be an opponent and file an opposition (i.e. the issue of locus standi), which the co-legislator, in contrast to the issue of opposition grounds addressed in Article 43(1), did not consider worth regulating exhaustively. It is therefore important to note that these two provisions in fact regulate different subject matter which should not be mixed up.

The wording in Article 43(1) is clear by referring to the relative grounds provided for in Article 5 only. In terms of legislative history it should be further noted that contrary to the original Commission proposal, the Council compromise proposal of 18 July 2014 (Doc. No. ST 11827 2014 INIT) included an additional “may” provision supposed to allow Member States, in addition, to provide that the registration of a trade mark application may also be opposed on the grounds provided in Article 4. However, the Council agreed to give up that position in the framework of the trilogues negotiations in view of the European Parliament's insistence on maintaining the original Commission text in that respect for the sake of efficiency and expeditiousness of opposition procedures.

In conclusion: Article 43(1) is to be seen as exhaustive provision which does not permit Member States to further keep absolute grounds for refusal provided for in Article 4 as opposition grounds. Nothing to the contrary may be concluded from what is provided in Article 43(2) or stated in Recital 38 of the Directive making reference to that provision.

Kind regards

Tomas L. Eichenberg

Tomás Lorenzo Eichenberg

Principal Administrator

European Commission

DG for Internal Market, Industry, Entrepreneurship and SMEs

Unit F3 Intellectual Property and Fight against Counterfeiting

Avenue des Nerviens 105 (9/39)

B-1040 Brussels/Belgium

+32 229 61662

tomas.eichenberg@ec.europa.eu

From: Korjus Nina (MAO) [mailto:nina.korjus@oikeus.fi]

Sent: Friday, November 16, 2018 12:10 PM

To: EICHENBERG Tomas (GROW)

Subject: Directive 2015/2436; Article 43 Opposition procedure

Dear Mr. Eichenberg,

I got your name on the who is who and I would like to ask you a question concerning the interpretation of the Article 43 of the Trade Mark Directive.

According to Article 43, para 1, Member States shall provide for an efficient and expeditious administrative procedure before their offices for opposing the registration of a trade mark application **on the grounds provided for in Article 5**. According to para 2, the administrative procedure referred to in paragraph 1 of this Article shall **at least** provide that the proprietor of an earlier trade mark as referred to in Article 5(2) and Article 5(3)(a), and the person authorised under the relevant law to exercise the rights arising from a protected designation of origin or geographical indication as referred to in Article 5(3)(c) shall be entitled to file a notice of opposition. A notice of opposition may be filed on the basis of one or more earlier rights, provided that they all belong to the same proprietor, and on the basis of part or the totality of the goods or services in respect of which the earlier right is protected or applied for, and may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.

Does the “at least” in para 2 refer only to the grounds provided for in Article 5 or does it give the possibility for the Member States to provide an opposition procedure also on the absolute grounds for refusal or invalidity in Article 4?

Finland is currently implementing the Directive and we have been asked to give our opinion on the law project.

Thank you in advance!

Kind regards,

Nina Korjus

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