

**Feedback form for comments on the draft  
Communication of the President concerning the implementation of Article 28 EUTMR**

<b>User Association/National Office</b>	<b>MARQUES - THE EUROPEAN ASSOCIATION OF TRADE MARK OWNERS</b>
<b>Contributor (name &amp; position)</b>	Adrian Smith – Member to <b>MARQUES</b> European Trade Mark Law & Practice Team
<b>Linguistic version the comments refer to</b>	EN <input checked="" type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	<b>Numbered paragraphs 2 &amp; 15</b> in particular (plus others) of the draft Communication of the President concerning the implementation of Article 28 EUTMR
<b>Page of the document</b>	Pages 2 and 7 in particular
<b>Issue(s) you wish to comment on</b>	<p>From the content of numbered paragraphs 2 and 15 it is apparent that the Office is intending to implement the EUTMR in such a way that Art. 28(8) will not apply to International Registrations (“IRs”) designating the EU, but rather will be limited to applying only to EUTMs. <b>MARQUES</b> is very surprised and concerned at this indication.</p> <p>Concerning the basis for this approach, the draft Communication states (para 15) that “<i>Article 154 EUTMR does not contemplate the application of Article 28 (8) EUTMR to international registrations designating the EU</i>”. In fact, Art. 154 does not appear to make specific mention of Art. 28(8) at all – in particular it does not state that Art. 28(8) is not to apply to IR’s designating the EU. Moreover Article 145 EUTMR makes it clear that unless otherwise specified, the Regulation is to apply to IR’s designating the EU. Furthermore, Art 151 EUTMR also confirms the key principle that an IR designation of the EU is to have the same effect as a CTM.</p> <p>With regard to the effect of the Office’s proposed approach to this issue, this would lead to a situation in which owners of relevant IRs designating the EU would be put at a material disadvantage compared to the owners of equivalent EUTMs. This runs counter to the clear understanding which <b>MARQUES</b> members and other trade mark owners have had as to the equivalence of EU trade mark protection obtained by designating the EU within an IR with the protection obtained by a direct CTM registration and upon which understanding they have relied whenever they have chosen to adopt the IR route for protecting marks in the EU. If the Office proceeds to disapply Art 28(8) for EU designations of IRs which would otherwise qualify, it will be discriminating against the owners of such marks as compared to the owners of equivalent CTM registrations.</p> <p><b>MARQUES</b> is aware of the feedback provided to the Office on this point by the International Bureau (“IB”) of WIPO and, as will be apparent from the above comments, <b>MARQUES</b> endorses the stated position of the IB on this issue, including as to the actions which the IB indicates are appropriate to address the issue so as to enable Art 28(8) to apply to EU designations of IRs.</p> <p><b>MARQUES</b> requests, respectfully, that the Office should alter its position on this issue in order to have Art 28 (8) apply to EU designations of IRs as it applies to CTMs and that the Office should liaise with the IB so far as necessary to implement such change.</p>

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<b>Suggestion for text</b>	Amendments will be required at least to paragraphs 2 and 15 of the draft Communication to make clear that Art 28 (8) is to apply to EU designations of IRs as it applies to CTMs/EUTMs.
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<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	<b>Numbered paragraph 12 (Traceability)</b> of the draft Communication of the President concerning the implementation of Article 28 EUTMR
<b>Page of the document</b>	5
<b>Issue(s) you wish to comment on</b>	<p><b>MARQUES</b> notes with approval the principle stated in para. 12 (Traceability) of the draft Communication – namely that, in the interests of certainty and in order to keep track of additions made by virtue of Art.28(8) EUTMR, declarations which are accepted will be entered in the Register. Doubtless, the Office appreciates the importance of this so that users are able to establish whether and to what extent any of the goods/services which appear to be covered by a particular mark are subject to the saving provisions of Article 28(9). However, <b>MARQUES</b> is concerned that the way in which the Office proposes to implement this will not generally, in practice, lead to such certainty for users of the EUTM system.</p> <p>The reason for this concern is that it appears that it will be necessary, in respect of any EUTM, to take specific additional steps to access the relevant information - i.e. as to whether or not the list of goods/services covered by the mark has been amended pursuant to a declaration under Art 28(8). Specifically, it appears that it will be necessary to consult the “Publications” section and/or the “Recordals” section of the records for the mark concerned. It appears that it will not be apparent on viewing the essential core details of any given mark (e.g. the mark, its status, its date, its proprietor and, critically, its list of goods/services) that its list of goods/services has been amended pursuant to a declaration under Art 28(8). Unless the proactive step is taken of reviewing the “Publications” and/or “Recordals” records for the mark to check for any such amendment it appears that there will be nothing apparent to alert a user viewing the usual essential details for a given mark that it has been subject to amendment pursuant to Art. 28(8). This risk exists when users are viewing the details of marks directly on the Office’s online database via eSearch plus but will perhaps be even more pronounced when users view the details provided of marks via third party search systems.</p> <p><b>MARQUES</b> considers that to achieve the stated aim of certainty for users on this issue it should be the case that a clear indication appears within the essential core details on the Register (in particular those referred to above) for affected marks, so that it is apparent, without requiring specific additional steps to be taken in accessing and checking the “Publications” and/or “Recordals” records for the mark, that it has been subject to amendment pursuant to Art. 28(8). In particular,</p>

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	such indication should appear within the goods and services field within the record for the mark concerned.
<b>Suggestion for text</b>	Appropriate amendments will be required to para 12 to describe such revised means as the Office adopts to address this issue .