

Trade marks: approximation of the laws of the Member States. Recast

2013/0089(COD) - 24/11/2015 - Commission communication on Council's position

The Commission **gave its opinion** on the position of the Council on the adoption of a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (recast).

The Proposal to recast the Directive - and of the [parallel proposal](#) for the amendment of the Regulation on the Community trade mark - aims at:

- **modernising and improving the current provisions of Directive 2008/95**, by amending outdated provisions to take account of the entry into force of the Lisbon Treaty, increasing legal certainty and clarifying trade mark rights in terms of their scope and limitations;
- **achieving greater approximation of national trade mark laws** and procedures for the purpose of making them more consistent with the EU trade mark system;
- **facilitating cooperation between the offices of the Member States and OHIM** for the purpose of promoting convergence of practices and the development of common tools, by putting in place a legal basis for this cooperation.

The position of the Council reflects the provisional political agreement reached by the Council, the JURI Committee of the European Parliament and the Commission in informal tripartite discussions on 21 April 2015. The Council position **meets the main aims of the Commission's initial proposal**. The Commission therefore supports the text.

The Council's position in first reading **encompasses almost all main amendments introduced by the European Parliament**, such as:

- the removal of the obligation for Member States' national offices to examine absolute grounds for refusal in all jurisdictions and languages of the Union, and;
- the deletion of the provision giving guidance as to when use of a trade mark by a third party should not be considered in accordance with honest practices. All those amendments can be endorsed by the Commission as being reasonable.

The Council also **adopted the amendments** from the Parliament which concern:

- the deletion of the proposed confinement of the so-called "double identity" rule – regulating protection against the use of identical signs for identical goods or services – to cases which affect the origin function of a trade mark;
- the maintenance of the option for Member States to examine relative grounds for refusal of its own motion as favoured by the European Parliament. The Commission regrets the missed opportunity to remove such option in order to ensure a level playing field for businesses in the Union;
- allowing a notice of opposition and a request for revocation or for a declaration of invalidity to be filed on the basis of one or more earlier rights and be directed against a part or the totality of the goods or services applied for or registered.

The Council did not include in its position at first reading the Parliament's amendments which sought to:

- limit the scope of the proposed new provision on the import of small consignments to counterfeit goods implied an inappropriate restriction of already existing rights conferred by a trade mark. It was therefore decided to delete the proposed provision
- limit the effects of a trade mark as favoured by the European Parliament. The Council accepted though the insertion in the relevant recital concerning the resale of genuine goods of clarification in relation to, the use of trade marks for the purpose of artistic expression, and the need for the Directive to be applied in a manner that ensures the full respect for fundamental rights and freedoms.

As regards the **new provisions introduced in the Council position**, the Commission accepted the compromise solution with respect to the **provision on goods in transit**, whereby the right to prevent goods being brought into the Member State where the trade mark is registered shall lapse if the declarant/holder of the goods is able to show before the competent court that the trade mark proprietor is not entitled to prohibit the placing of the goods on the market of the country of final destination.

Lastly, the Commission regretted that the Council further did not endorse the mandatory introduction of a so-called "**one-class-per-fee system**" at national level but opted for an optional regime only. The Commission regrets that decision but can accept it as part of the package.