

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

2013/0089(COD) - 16/12/2015 - Final act

PURPOSE: to reform the EU trade mark system with a view to fostering and creating a well-functioning internal market and to facilitate acquiring and protecting trade marks in the Union, to the benefit of the growth and the competitiveness of European businesses.

CONTENT: this Directive recasts Directive 2008/95/EC as well as the [parallel Regulation](#) aiming to amend [Council Regulation \(EC\) No 207/2009](#) on the Community trade mark by creating a new legal framework to reform the current trademark system whose aim is to strengthen trade mark protection and combat counterfeiting more effectively.

The new legal framework is also aimed at encouraging innovation and economic growth by making trade mark registration systems all over the European Union more accessible and efficient for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal certainty.

Scope: this Directive applies to every trade mark in respect of goods or services which is the subject of registration or of an application for registration in a Member State as an individual trade mark, a guarantee or certification mark or a collective mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.

Signs of which a trade mark may consist: the Directive lists examples of signs which are capable of constituting a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. Trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds.

In order to fulfil the objectives of the registration system for trade marks, namely to ensure legal certainty and sound administration, the Directive require that the sign is capable of being represented in a manner which is **clear, precise, self-contained, easily accessible, intelligible, durable and objective**.

A sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.

Grounds for refusal and invalidity: the Directive lists, in an exhaustive manner, the grounds for refusal or invalidity concerning the trade mark itself, including the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights.

In order to ensure that the levels of protection afforded to **geographical indications** by Union legislation and national law are applied in a uniform and exhaustive manner in the examination of absolute and relative grounds for refusal throughout the Union, this Directive should include the same provisions in relation to geographical indications as contained in Regulation (EC) No 207/2009. Furthermore, it extends the scope of the absolute grounds to **cover protected traditional terms for wine and traditional specialties guaranteed**.

The Directive also stipulates that extensive protection be granted to EU trade marks which have a reputation in the Union, extensive protection should also be granted at national level to all registered trade marks which have a reputation in the Member State concerned.

Rights conferred by an EU trade mark: the registration of an EU trade mark shall confer on the proprietor exclusive rights therein. The proprietor of that EU trade mark may prohibit: (i) affixing the sign to the goods or to the packaging thereof; (ii) importing or exporting the goods under the sign; (iii) using the sign as a trade or company name or part of a trade or company name; (iv) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC.

In order to enable proprietors of registered trade marks to combat counterfeiting more effectively, they should be entitled to prohibit the affixing of an infringing trade mark to goods, and certain preparatory acts carried out prior to such affixing.

Such use should further permit the use of descriptive or non-distinctive signs or indications in general. Furthermore, the proprietor should not be entitled to prevent the **fair and honest** use of the mark for the purpose of identifying or referring to the goods or services as those of the proprietor

Combatting counterfeiting: the Directive stipulates that the proprietor of an EU trade mark should be entitled to prevent third parties from bringing goods, in the course of trade, into the Union without being released for free circulation there, where such goods come from third countries and bear without authorisation a trade mark which is identical or essentially identical with the EU trade mark registered in respect of such goods.

To this effect, it should be permissible for trade mark proprietors to prevent the entry of infringing goods and their placement in all customs situations, including, in particular transit, transhipment, warehousing, free zones, temporary storage, inward processing or temporary admission, also when such goods are not intended to be placed on the market of the Member State concerned.

Procedures: the Directive contains measures concerning the requirements for application and registration, designation and classification of goods and services, procedures for opposition, revocation and invalidity including the non-use as a defence in proceedings seeking a declaration of invalidity.

Member States shall provide for an **efficient and expeditious administrative procedure** before their offices for opposing the registration of a trade mark application on specific grounds, as well as on the issue of revocation and invalidity.

ENTRY INTO FORCE: 12.01.2016.

TRANSPOSITION: 14.01.2019 (14.01.2013 for Article 45).