

European Union trade mark. Codification

2016/0345(COD) - 31/10/2016 - Legislative proposal

PURPOSE: to codify Council Regulation (EC) No 207/2009 on the European Union trade mark.

PROPOSED ACT: Regulation of the European Parliament and of the Council.

ROLE OF THE EUROPEAN PARLIAMENT: the European Parliament decides in accordance with the ordinary legislative procedure and on an equal footing with the Council.

BACKGROUND: [Council Regulation \(EC\) No 207/2009](#) has been substantially amended several times.

On 1 April 1987 the Commission decided to instruct its staff that all acts should be codified after no more than ten amendments, stressing that this is a minimum requirement. The Edinburgh European Council in December 1992 confirmed this, stressing the importance of codification.

The European Parliament, the Council and the Commission have agreed, by an interinstitutional agreement dated 20 December 1994, that an accelerated procedure may be used for the fast-track adoption of codification instruments.

CONTENT: in the interests of clarity and transparency, the aim of the proposal is to **proceed with the codification of Council Regulation (EC) No 207/2000 on the European Union trade mark**. The new Regulation will **supersede the various acts incorporated in it**; the proposal fully preserves the content of the acts being codified and hence does no more than bring them together with only such formal amendments as are required by the codification exercise itself.

EU trade mark: the draft regulation establishes, at Union level, **the modalities and the conditions for the grant** of an EU trade mark. An EU trade mark shall have a unitary character. It shall have equal effect throughout the Union. The proposal also sets up a European Union Intellectual Property Office.

The rights in an EU trade mark should not be obtained otherwise than by **registration**, and registration should be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights.

An EU 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 provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Rights conferred by an EU trade mark: the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

- the sign is **identical** with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;
- the use of the sign means that there is **likelihood of confusion** on the part of the public, including the likelihood of association between the sign and the trade mark.

The exclusive rights conferred by an EU trade mark should not entitle the proprietor to prohibit the use of signs or indications by third parties which are used **fairly** and thus in accordance with honest practices in industrial and commercial matters.

Application: an application for an EU trade mark shall be filed at the Office. It shall contain:

- a request for the registration of an EU trade mark ;
- information identifying the applicant;
- a list of the goods or services in respect of which the registration is requested;
- a representation of the mark.

The application for an EU trade mark shall be subject to the payment of the application fee.

Where an application meets the requirements set out in the Regulation and where no notice of opposition has been given, the trade mark and the particulars shall be recorded in the Register. The registration shall be published, and the Office shall issue a **certificate of registration**.

Duration and renewal: EU trade marks shall be registered for **a period of 10 years from the date of filing of the application**. Registration may be renewed for further periods of 10 years at the request of the proprietor, provided that the fees have been paid. The request for renewal shall be submitted in the six-month period prior to the expiry of the registration.

Surrender, revocation and invalidity: an EU trade mark may be surrendered in respect of some or all of the goods or services for which it is registered.

The rights of the proprietor of the EU trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim:

- if, within a **continuous period of five years**, the trade mark has not been put to genuine use in the Union | in connection with the goods or services in respect of which it is registered;
- if, in consequence of acts or inactivity of the proprietor, the trade mark has become the **common name** in the trade for a product or service;
- if, in consequence of the use made of it by the proprietor, the trade mark is **liable to mislead the public**.

An EU trade mark shall be declared invalid on application to the Office or on the basis of a **counterclaim in infringement proceedings** where there is an earlier trade mark in accordance with EU or national law.

The decisions of the Office will be subject to **appeal**.

EU certification marks: the Regulation states that such a mark shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.

DELEGATED ACTS: the proposal contains provisions empowering the Commission to adopt delegated acts in accordance with Article 290 of the Treaty of the Functioning of the EU.