

European Union trade mark. Codification

2016/0345(COD) - 14/06/2017 - Final act

PURPOSE: to adopt a codified version of Council Regulation (EC) No 207/2009 on the European Union trade mark.

LEGISLATIVE ACT: Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark (codification).

CONTENT: this Regulation **codifies and replaces** Council Regulation (EC) on the European Union trade mark. The codification was carried out in the interests of clarity and transparency, given that the Regulation was substantially amended several times. The new Regulation will supersede the various acts incorporated in it, and fully preserves the content of the acts codified.

EU trade mark: the Regulation establishes **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 Regulation 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, if it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service, or if it conflicts with earlier rights.

Signs of which a EU trade mark may consist: 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 registration of an EU trade mark shall confer on the proprietor exclusive rights therein. 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** to 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 be subject to the payment of the **application fee**. The basic fee for the application for an individual EU trade mark shall be EUR 1 000.

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 and 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. Decisions regarding the validity and infringement of EU trade marks shall have effect and cover the entire area of the Union.

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.

ENTRY INTO FORCE: 6.7.2017.

APPLICATION: from 1.10.2017.

DELEGATED ACTS: the Commission may adopt delegated acts, for example, in order to specify the details of the procedure for filing and examining an opposition and of the procedure governing the amendment of the application, or the details of the procedures governing the revocation and declaration of invalidity. The power to adopt such acts is conferred on the Commission for an **indeterminate period** from 23 March 2016. The European Parliament or the Council have the right to object to a delegated act within two months (which may be extended by two months) from the date of notification of the act.