

Basic information	
2013/0089(COD)	Procedure completed
COD - Ordinary legislative procedure (ex-codecision procedure) Directive	
Trade marks: approximation of the laws of the Member States. Recast Repealing Directive 2008/95/EC 2006/0264(COD) See also 2013/0088(COD)	
Subject	
2.10.03 Standardisation, EC/EU standards and trade mark, certification, compliance 2.80 Cooperation between administrations 3.50.15 Intellectual property, copyright 3.50.16 Industrial property, European patent, Community patent, design and pattern 6.20.01 Agreements and relations in the context of the World Trade Organization (WTO) 6.20.02 Export/import control, trade defence, trade barriers 7.40.02 Judicial cooperation in civil and commercial matters	

Key players			
European Parliament	Committee responsible	Rapporteur	Appointed
	JURI Legal Affairs	WIKSTRÖM Cecilia (ALDE)	24/04/2013
		Shadow rapporteur ANDERSSON Max (Verts/ALE) KARIM Sajjad (ECR) MAŠTÁLKA Jiří (GUE/NGL)	
Former committee responsible		Former rapporteur	Appointed
JURI Legal Affairs		WIKSTRÖM Cecilia (ALDE)	24/04/2013
Former committee for opinion		Former rapporteur for opinion	Appointed
INTA International Trade		CUTAS George Sabin (S&D)	25/04/2013
ITRE Industry, Research and Energy		The committee decided not to give an opinion.	
IMCO Internal Market and Consumer Protection		BASTOS Regina (PPE)	29/05/2013

Council of the European Union	Council configuration	Meetings	Date
	Economic and Financial Affairs ECOFIN	3421	2015-11-10
	Competitiveness (Internal Market, Industry, Research and Space)	3276	2013-12-03
	Competitiveness (Internal Market, Industry, Research and Space)	3317	2014-05-26
European Commission	Commission DG	Commissioner	
	Legal Service	JUNCKER Jean-Claude	
European Economic and Social Committee			

Key events			
Date	Event	Reference	Summary
27/03/2013	Legislative proposal published	COM(2013)0162	 Summary
16/04/2013	Committee referral announced in Parliament, 1st reading		
03/12/2013	Debate in Council		
17/12/2013	Vote in committee, 1st reading		
16/01/2014	Committee report tabled for plenary, 1st reading	A7-0032/2014	 Summary
24/02/2014	Debate in Parliament		
25/02/2014	Decision by Parliament, 1st reading	T7-0119/2014	 Summary
25/02/2014	Results of vote in Parliament		
26/05/2014	Debate in Council		
25/09/2014	Committee decision to open interinstitutional negotiations after 1st reading in Parliament		
16/06/2015	Approval in committee of the text agreed at early 2nd reading interinstitutional negotiations		
12/11/2015	Council position published	10374/1/2015	 Summary
26/11/2015	Committee referral announced in Parliament, 2nd reading		
03/12/2015	Vote in committee, 2nd reading		
07/12/2015	Committee recommendation tabled for plenary, 2nd reading	A8-0355/2015	 Summary
14/12/2015	Debate in Parliament		
15/12/2015	Decision by Parliament, 2nd reading	T8-0440/2015	 Summary
15/12/2015	Results of vote in Parliament		
15/12/2015	End of procedure in Parliament		

16/12/2015	Final act signed		
23/12/2015	Final act published in Official Journal		

Technical information	
Procedure reference	2013/0089(COD)
Procedure type	COD - Ordinary legislative procedure (ex-codecision procedure)
Procedure subtype	Recast
Legislative instrument	Directive
Amendments and repeals	Repealing Directive 2008/95/EC 2006/0264(COD) See also 2013/0088(COD)
Legal basis	Treaty on the Functioning of the EU TFEU 114-p1
Other legal basis	Rules of Procedure EP 165
Mandatory consultation of other institutions	European Economic and Social Committee
Stage reached in procedure	Procedure completed
Committee dossier	JURI/8/00928

Documentation gateway				
European Parliament				
Document type	Committee	Reference	Date	Summary
Committee draft report		PE516.713	31/07/2013	
Committee opinion	INTA	PE514.611	15/10/2013	
Amendments tabled in committee		PE522.796	24/10/2013	
Committee opinion	IMCO	PE516.701	07/11/2013	
Committee report tabled for plenary, 1st reading/single reading		A7-0032/2014	16/01/2014	Summary
Text adopted by Parliament, 1st reading/single reading		T7-0119/2014	25/02/2014	Summary
Committee draft report		PE572.860	24/11/2015	
Committee recommendation tabled for plenary, 2nd reading		A8-0355/2015	07/12/2015	Summary
Text adopted by Parliament, 2nd reading		T8-0440/2015	15/12/2015	Summary
Council of the EU				
Document type	Reference	Date	Summary	
Council statement on its position	13514/2015	03/11/2015		
Council position	10374/1/2015	12/11/2015	Summary	
Draft final act	00070/2015/LEX	16/12/2015		
European Commission				

Document type	Reference	Date	Summary
Legislative proposal	COM(2013)0162 	27/03/2013	Summary
Document attached to the procedure	SWD(2013)0095 	27/03/2013	
Document attached to the procedure	SWD(2013)0096 	27/03/2013	
Commission response to text adopted in plenary	SP(2014)446	20/05/2014	
Commission communication on Council's position	COM(2015)0588 	24/11/2015	Summary

National parliaments

Document type	Parliament /Chamber	Reference	Date	Summary
Contribution	PT_PARLIAMENT	COM(2013)0162	29/05/2013	
Contribution	LU_CHAMBER	COM(2013)0162	03/06/2013	
Contribution	ES_PARLIAMENT	COM(2013)0162	07/06/2013	
Contribution	IT_SENATE	COM(2013)0162	31/03/2014	
Contribution	FR_ASSEMBLY	COM(2013)0162	05/08/2014	

Other institutions and bodies

Institution/body	Document type	Reference	Date	Summary
EESC	Economic and Social Committee: opinion, report	CES3456/2013	11/07/2013	
EDPS	Document attached to the procedure	N7-0073/2014 OJ C 032 04.02.2014, p. 0023	11/07/2013	Summary

Additional information

Source	Document	Date
EP Research Service	Briefing	
National parliaments	IPEX	
European Commission	EUR-Lex	

Final act

Corrigendum to final act 32015L2436R(02)
OJ L 110 26.04.2016, p. 0005

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

2013/0089(COD) - 27/03/2013 - Legislative proposal

PURPOSE: to foster innovation and economic growth by making trade mark registration systems all over the EU more accessible.

PROPOSED ACT: Directive of the European Parliament and of the Council (recast of Directive 2008/95/EC).

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: in an increasingly competitive environment, the growing number of trade mark applications at both national and EU levels, and the growing number of trade mark users demonstrates **the crucial role of trade marks** in terms of market success and commercial value. This development has been accompanied by growing expectations on the part of stakeholders for **more streamlined and high-quality trade mark registration systems**, which are more consistent, publicly accessible and technologically up-to-date.

In its '[Small Business Act](#)' of 2008, the Commission pledged to make the Community trademark system more accessible to SMEs. Furthermore, in its 2008 Communication on an [Industrial Property Rights Strategy for Europe](#) the Commission underlined its commitment to effective and efficient trademark protection and to a trademark system of high quality. It concluded that it was time for an overall evaluation, which could form the basis for a [future review of the trademark system in Europe](#) and for the further improvement of cooperation between the Office for Harmonisation in the Internal Market (OHIM) and National Offices.

Lastly, in its [2011 Intellectual Property Rights Strategy for Europe](#), the Commission announced a review of the trade mark system in Europe with a view to modernising the system, both at EU and at national level, by making it more effective, efficient and consistent overall. The Council has also called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC.

IMPACT ASSESSMENT: the impact assessment carried out for both the review of the Regulation and of the Directive identified two main problems: (i) the divergent provisions of the existing regulatory framework, and (ii) the low level of cooperation between trade mark offices in the Union. **Four options** were envisaged.

- **Option 1:** no further approximation of trade mark laws and procedures;
- **Option 2:** Partial expansion of the approximation of national laws and their consistency with the Community trade mark system;
- **Option 3:** full approximation of national trade mark laws and procedures;
- **Option 4:** a single trademark rulebook, which would replace Member States' trade mark laws in their entirety, by setting uniform rules across the Union.

The impact assessment concluded that **option 2** would be proportionate and would best serve to achieve the objectives pursued.

LEGAL BASIS: Article 114 (1) of the Treaty on the Functioning of the EU (TFEU).

CONTENT: the main common objective of this proposal for recasting and of the parallel proposal for the [amendment of the Regulation](#) is to foster innovation and economic growth **by making trade mark registration systems all over the EU more accessible and efficient** for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal security.

Specifically, the initiative to recast the Directive is driven by the following objectives:

1) Modernising and Improving the existing provisions of the Directive. This will be achieved by amending outdated provisions, increasing legal certainty and clarifying trade mark rights in terms of their scope and limitations:

- the proposed new definition does not restrict the permissible means of representation to graphic or visual representation but leaves the door open to register matter that can be represented by technological means offering satisfactory guarantees;
- the proposal makes it clear that infringement claims are without prejudice to earlier rights;
- it is clarified that in cases of both double identity and similarity, it is only the origin function which matters;
- in accordance with the rulings of the Court of Justice, it is appropriate to treat trade name use of a protected trade mark as an infringing act, if the requirements of use for goods or services are met;
- the trade mark owner may prevent the use of his trade mark in comparative advertising where such comparative advertising does not satisfy the requirements of Directive 2006/114/EC;
- it is made clear that the importing of goods into the Union is also prohibited where it is only the consignor who acts for commercial purposes;

- bearing in mind the outcome of the Philips/Nokia judgment, the proposal entitles right holders to stop third parties from bringing goods, from third countries, bearing an unauthorised trade mark which is essentially identical to the trade mark registered in respect of those goods, into the customs territory of the Union, regardless of whether they are released for free circulation;
- there are provisions allowing proceedings against the distribution and sale of labels and packaging and similar items which may subsequently be combined with illicit products.

2) **Achieve greater approximation of national trade mark laws and procedures** with the aim of making them more consistent with the Community trade mark system, by (a) adding further substantive rules and (b) introducing principal procedural rules into the Directive in accordance with provisions contained in the Regulation. In this regard, it is proposed, *inter alia*:

- to insert provisions relating to geographical indications, traditional terms for wine and traditional specialities guaranteed in the Directive;
- to ensure that, in all Member States, national trade marks with reputation enjoy the same level of protection as that afforded to Community trade marks;
- to complement the Directive with a corresponding body of rules addressing trade marks as objects of property as contained in the Regulation;
- to provide for a set of specific provisions for the registration and protection of collective marks.

3) **Facilitate 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.

BUDGETARY IMPLICATIONS: the proposal has no implications for the EU budget.

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

2013/0089(COD) - 25/02/2014 - Text adopted by Parliament, 1st reading/single reading

The European Parliament adopted by 566 votes to 89 with 18 abstentions, a legislative resolution on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (recast).

Parliament's position adopted at first reading under the ordinary legislative procedure amended the Commission's proposal as follows:

European Union trade mark: given that the term 'European' applies to an area larger than the territory of the European Union, Members proposed to replace the term 'Community trade mark' by the term 'European Union trade mark'. They also stressed the importance of the complementary nature of national and Union protection of trade marks.

Signs likely to constitute a European Union trade mark: it is stipulated that the representation can be in any form so long as it uses generally available technology. The sign should be capable of being represented in the register in a manner which is clear, precise, self-contained, easily accessible, durable and objective.

Examination of absolute grounds for refusal: with regard to geographical indications covered by Regulation No 110/2008 of the European Parliament and of the Council, Members proposed including **spirit drinks** to the grounds for refusal. They also deleted the requirement for national offices to examine absolute grounds for refusal in all national jurisdictions and languages of the Union. It was stated that a trade mark shall not be declared invalid if, before the date of application for invalidity, and following the use which has been made of it, it has acquired a distinctive character.

Registration: Members considered it reasonable to allow for a registration based on the lack of a relative ground for refusal if the proprietor of an earlier right consents to the registration of the mark. It would not seem necessary for this provision to be optional for Member States.

Use of trade marks: Members considered it essential to require that trade marks should be used for products or services for which they were registered, or, if not used within **five years** of the date of registration, should be liable to be revoked.

Rights conferred by the EU trade mark: in order to more effectively prevent the entry of counterfeit goods, particularly in the context of **sales over the internet delivered in small consignments**, the proprietor of a validly registered trade mark should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the counterfeit goods who acts in the course of trade.

In cases where such measures are taken, Member States should ensure that the individuals or entities that had ordered the goods are informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.

In order to strengthen the protection afforded by the trade mark and to **fight more effectively against counterfeit goods**, and without prejudice to WTO rules, in particular Article V of the GATT on freedom of transit, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without authorisation a trade mark which is essentially identical to the trade mark registered in respect of such goods. This should be **without prejudice to the smooth transit of generic medicines**, in compliance with the international obligations of the European Union, in particular as reflected in the 'Declaration on the TRIPS agreement and public health' adopted by the Doha WTO Ministerial Conference on 14 November 2001.

The resolution stipulated that the trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark for a due cause for any non-commercial use of a mark.

Examination for refusal on relative grounds: according to the amended text, Member States should be free to decide whether to conduct an examination for refusal on relative grounds. Members considered that it is possible to retain the option that allows national offices to conduct this examination and combine it with the well founded proposal by the Commission to not let these examinations block the application procedure for the applicant.

Infringement of the rights of the proprietor by use of get-up, packaging or other means

In order to strengthen this provision, Parliament stated that the proprietor shall have the right to prohibit affixing in the course of trade a sign that is, identical with or similar to the trade mark on packaging, labels, tags, security features, authenticity devices or any other means on which the mark may be affixed.

Procedure for revocation or declaration of invalidity: Member States shall provide for an **efficient and expeditious administrative procedure** before their offices for revocation or declaration of invalidity of a trade mark.

In order to increase effectiveness of national cancellation procedures, to align them with European cancellation procedures, reduce fees, costs and administrative burden, it is proposed that an application for revocation may be directed against (i) part or the totality of the goods or services covered by the contested mark; (ii) one or more earlier right, as well as on part or the totality of the goods or services covered by the earlier right.

Communication with the office: the practice of some Member States to require an address of service in their country for notifications from the office is an unnecessary source of delays and costs, consequent to the need to identify, appoint and pay a local representative. It is therefore proposed that the parties to the proceedings or, where appointed, their representatives, shall designate an official address **within one of the Member States** for all official communication with the office.

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

2013/0089(COD) - 16/01/2014 - Committee report tabled for plenary, 1st reading/single reading

The Committee on Legal Affairs adopted the report by Cecilia WIKSTRÖM (ALDE, SE) on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (recast).

The parliamentary committee recommended that the European Parliament's position adopted at first reading under the ordinary legislative procedure should be to amend the Commission's proposal as follows:

European Union trade mark: given that the term 'European' applies to an area larger than the territory of the European Union, Members proposed to replace the term 'European trade mar' by the term '**European Union trade mark**'. They also stressed the importance of the **complementary nature** of national and Union protection of trade marks.

Signs likely to constitute a European Union trade mark: it is stipulated that the representation can be **in any form** so long as it uses generally available technology. The sign should be capable of being represented in the register in a manner which is clear, precise, self-contained, easily accessible, durable and objective.

Examination of absolute grounds for refusal: Members considered it would be disproportionate and practically unworkable to require national offices to examine absolute grounds for refusal in all national jurisdictions and languages of the Union. They therefore suggested that this provision be withdrawn.

Registration: it would seem reasonable to allow for a registration based on the lack of a relative ground for refusal if the proprietor of an earlier right consents to the registration of the mark. It would not seem necessary for this provision to be optional for Member States.

Use of trade marks: Members considered it essential to require that trade marks should be used for products or services for which they were registered, or, if not used **within five years** of the date of registration, should be liable to be revoked.

Small consignments: in order to more effectively prevent the entry of counterfeit goods, particularly in the context of sales over the internet delivered in small consignments, the proprietor of a validly registered trade mark should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the counterfeit goods who acts in the course of trade.

In cases where such measures are taken, Member States should ensure that the individuals or entities that had ordered the goods are informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.

Ex officio examination for refusal on relative grounds: according to the amended text, **Member States should be free** to decide whether to conduct **ex officio** examination for refusal on relative grounds. Members considered that it is possible to retain the option that allows national offices to conduct this examination and combine it with the well founded proposal by the Commission to not let these examinations block the application procedure for the applicant.

Procedure for revocation or declaration of invalidity: Member States shall provide for an **efficient and expeditious administrative procedure** before their offices for revocation or declaration of invalidity of a trade mark.

In order to increase effectiveness of national cancellation procedures, to align them with European cancellation procedures, reduce fees, costs and administrative burden, it is proposed that an application for revocation may be directed against (i) part or the totality of the goods or services covered by the contested mark; (ii) one or more earlier right, as well as on part or the totality of the goods or services covered by the earlier right.

Communication with the office: the practice of some Member States to require an address of service in their country for notifications from the office is an unnecessary source of delays and costs, consequent to the need to identify, appoint and pay a local representative. It is therefore proposed that the parties to the proceedings or, where appointed, their representatives, shall designate an official address **within one of the Member States** for all official communication with the office.

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

2013/0089(COD) - 11/07/2013 - Document attached to the procedure

Opinion of the European Data Protection Supervisor on (i) the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (recast) and (ii) the proposal for a regulation of the European Parliament and of the Council amending Regulation (EC) No 207/2009 on the Community trade mark.

The EDPS notes that these two proposals – the objective of which is to harmonise further all aspects of substantive trade mark law as well as procedural rules within the EU – establish a few processing operations, which may have an impact on individuals' right to privacy and data protection.

The proposed regulation amends the current legal framework applicable to the Community trade mark

set forth in Regulation (EC) No 207/2009. The Office for Harmonization in the Internal Market ('OHIM') is renamed 'European Trade Marks and Design Agency'. The proposed regulation clarifies substantive and procedural rules that apply to the European trade mark. It provides for the establishment by the Agency of a register and of an electronic database. It also clarifies the role and tasks of the Agency, in particular in relation to its cooperation with the national central industrial property offices in the EU.

In particular, the EDPS recommendations are to:

- insert a substantive provision underlining the need for any processing of personal data carried out by national industrial property offices to respect applicable data protection law, in particular national laws implementing Directive 95/46/EC;
- underline in a substantive provision that any processing of personal data by the Agency in the context of the cooperation between national offices and the Agency is subject to compliance with the rules set forth in Regulation (EC) No 45/2001;
- clarify in a substantive provision whether the common or connected databases and portals planned under the Directive involve the processing of personal data as well as their scope and purpose(s);
- clearly establish in a substantive provision the modalities for the exchanges of information through the common or connected databases and portals, in particular by determining the authorised recipients of personal data, the types of data, the purpose of such exchanges, and the length of the retention of the data in those IT systems.

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

2013/0089(COD) - 15/12/2015 - Text adopted by Parliament, 2nd reading

The European Parliament adopted a legislative resolution on the Council position at first reading with a view to 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).

Parliament **approved the Council position at first reading** without amendment.

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).

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

2013/0089(COD) - 12/11/2015 - Council position

The Council adopted its position in first reading regarding **reform of the trademarks system**. This reform includes a proposal for a directive to approximate the laws of the Member States on trademarks as well as a [parallel proposal amending the Regulation on the Community trademark](#).

The recast of the Directive has the following objectives:

- modernising and improving the existing provisions of the Directive, by 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 with the aim of making them more consistent with the Community trade mark system;
- facilitating cooperation between the offices of the Member States and the Office for Harmonisation in the Internal Market (Trade marks and Designs) (OHIM).

The common position on the adoption of a directive approximating the laws of the Member States on trade marks aims to foster and create a well-functioning internal market and to **facilitate the registration, administration and protection of trademarks** in the Union to the benefit of growth and competitiveness.

For the purpose of making trademark registrations throughout the Union easier to obtain and administer, the new Directive aligns the principal procedural rules in the area of trademark registration in the Member States to the EU trade mark system. Registered trademarks should benefit from the same protection in all Member States.

The conditions for obtaining and continuing to hold a registered trademark be, in general, identical in all Member States. Accordingly, the common position:

- **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. The sign should be 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;
- **list the grounds for refusal or invalidity concerning the trade mark itself in an exhaustive manner**, including the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights.

Amongst the main points in the common position, the following should be noted:

- preservation of the right of Member States to decide whether to conduct examinations for refusal on relative grounds *ex officio*;
- introduction of an explicit provision ensuring that trade mark rights cannot be invoked against prior rights on the mark;
- extension of trade mark protection to cover the use of the mark in trade or company names;
- clarification that the trade mark owner may prevent the use of his trade mark in comparative advertising where such comparative advertising does not satisfy the requirements of Article 4 of Directive 2006/114/EC;
- the right of trade mark holders to prevent the distribution and sale of labels and packaging and of similar items which may subsequently be used in relation to infringing goods or services;
- the extension of the absolute grounds for refusal to cover designations of origin, geographical indications, traditional terms for wine, traditional specialities guaranteed and plant variety rights;
- the extension of the relative grounds for refusal to cover designations of origin and geographical indications;
- harmonisation of national law regulating: (i) the degree of protection of trade marks with reputation; (ii) trade marks as objects of property, such as transfers or licensing; (iii) Guarantee or Certification marks and Collective marks;
- harmonisation of national law regarding designation and classification of goods and services covered by a trade mark in accordance with the case law of Court of Justice;
- the establishment of an efficient and expeditious administrative procedure before each national office for opposing the registration of a trade mark application on the basis of relative grounds;
- harmonisation of national law regarding the "non use" defence in opposition proceedings and in proceedings seeking a declaration of invalidity;
- the establishment of an efficient and expeditious administrative procedure before each national office for revocation or declaration of invalidity of a trade mark;
- lastly, clarification that the right to prevent third countries goods into the customs territory of Member States will lapse if the declarant or the holder of the goods in question proves that the trade mark holder is not entitled to prohibit the placing of the goods on the market in the country of final destination.

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

2013/0089(COD) - 07/12/2015 - Committee recommendation tabled for plenary, 2nd reading

The Committee on Legal Affairs adopted the recommendation for second reading contained in the report by Cecilia WIKSTRÖM (ADLE, SE) on the Council position at first reading with a view to 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 committee recommended that the European Parliament **approve the Council position at first reading** without amendment.

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.