Basic information

2016/0345(COD) COD - Ordinary legislative procedure (ex-codecision procedure) Regulation	Procedure completed
European Union trade mark. Codification Repealing Regulation (EC) No 207/2009 2006/0267(CNS) Amended by 2022/0089(COD) Amended by 2022/0115(COD) **Subject** 2.10.03 Standardisation, EC/EU standards and trade mark, certification, compliance 3.50.15 Intellectual property, copyright	

Key players

European Parliament	**Committee responsible**	**Rapporteur**	**Appointed**
	JURI Legal Affairs	ZWIEFKA Tadeusz (PPE)	08/02/2017
Council of the European Union	**Council configuration**	**Meetings**	**Date**
	Education, Youth, Culture and Sport	3541	2017-05-23

Key events

Date	Event	Reference	Summary
31/10/2016	Legislative proposal published	COM(2016)0702	Summary
21/11/2016	Committee referral announced in Parliament, 1st reading		
28/02/2017	Vote in committee, 1st reading		
06/03/2017	Committee report tabled for plenary, 1st reading	A8-0054/2017	Summary
27/04/2017	Decision by Parliament, 1st reading	T8-0133/2017	Summary
27/04/2017	Results of vote in Parliament		
23/05/2017	Act adopted by Council after Parliament's 1st reading		
14/06/2017	Final act signed		
14/06/2017	End of procedure in Parliament		
16/06/2017	Final act published in Official Journal		

Technical information

Procedure reference	2016/0345(COD)
Procedure type	COD - Ordinary legislative procedure (ex-codecision procedure)
Procedure subtype	Codification
Legislative instrument	Regulation
Amendments and repeals	Repealing Regulation (EC) No 207/2009 2006/0267(CNS) Amended by 2022/0089(COD) Amended by 2022/0115(COD)
Legal basis	Treaty on the Functioning of the European Union TFEU 118-p1
Other legal basis	Rules of Procedure EP 165
Stage reached in procedure	Procedure completed
Committee dossier	JURI/8/08341

Documentation gateway

European Parliament

Document type	Committee	Reference	Date	Summary
Committee draft report		PE599.671	08/02/2017	
Committee report tabled for plenary, 1st reading/single reading		A8-0054/2017	06/03/2017	Summary
Text adopted by Parliament, 1st reading/single reading		T8-0133/2017	27/04/2017	Summary

Council of the EU

Document type	Reference	Date	Summary
Draft final act	00012/2017/LEX	14/06/2017	

European Commission

Document type	Reference	Date	Summary
Legislative proposal	COM(2016)0702	31/10/2016	Summary

Additional information

Source	Document	Date
European Commission	EUR-Lex	

Final act

Regulation 2017/1001
OJ L 154 16.06.2017, p. 0001 Summary

European Union trade mark. Codification

2016/0345(COD) - 06/03/2017 - Committee report tabled for plenary, 1st reading/single reading

The Committee on Legal Affairs adopted the report by Tadeusz ZWIEFKA (EPP, PL) on the proposal for a regulation of the European Parliament and of the Council on the European Union trade mark (codified text).

The committee recommended the European Parliament to adopt its position at first reading taking over the Commission proposal as adapted to the recommendations of the Consultative Working Party of the legal services of the European Parliament, the Council and the Commission.

According to the Consultative Working Party of the legal services of the European Parliament, the Council and the Commission, the proposal in question contains a straightforward codification of the existing texts without any change in their substance.

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.

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 i**dentical** 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 Î1 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.

European Union trade mark. Codification

2016/0345(COD) - 27/04/2017 - Text adopted by Parliament, 1st reading/single reading

The European Parliament adopted by 596 votes to 28, with 6 abstentions, a legislative resolution on the proposal for a regulation of the European Parliament and of the Council on the European Union trade mark (codified text).

Parliament adopted its position at first reading taking over the Commission proposal which contains a straightforward codification of the existing texts without any change in their substance.

In the interests of clarity and rationality, the aim of the proposal is to proceed with the codification of Council Regulation (EC) No 207/2000 on the European Union trade mark which has been substantially amended several times.

The Regulation establishes, at Union level, the **modalities and the conditions for the grant of an EU trade mark**. It provides for a system of EU trade marks whereby undertakings can by means of one procedural system obtain EU trade marks to which uniform protection is given and which produce their effects throughout the entire area of the Union.

The proposal also sets up a **European Union Intellectual Property Office** where applicants must submit their applications for EU trade marks.

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; and
- being represented on the Register of European Union trademarks, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

The Regulation provides that any natural or legal person, including authorities established under public law, may be the proprietor of an EU trade mark by registration. It governs, in particular:

- filing of applications;
- rights of priority;
- grounds for refusal ;

- limitation of the effects of an EU trade mark;
- exhaustion of the rights conferred by an EU trade mark;
- time limit and renewal of trademarks;
- grounds for revocation, invalidity;
- EU collective marks;
- EU certification marks.