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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)

(Text with EEA relevance)

{SWD(2013) 95 final}
{SWD(2013) 96 final}

EXPLANATORY MEMORANDUM

1. CONTEXT OF THE PROPOSAL

1.1. General context and grounds for the proposal

The laws of the Member States relating to trade marks were partially harmonised by Council Directive 89/104/EEC of 21 December 1988, codified as Directive 2008/95/EC (hereinafter referred to as 'the Directive'). Alongside and linked to the national trade mark systems, Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, codified as Regulation (EC) No 207/2009 (hereinafter referred to as 'the Regulation'), established a stand-alone system for the registration of unitary rights having equal effect throughout the EU. In that context, the Office for Harmonization in the Internal Market (OHIM) was set up to be responsible for registering and administering Community trade marks.

A trade mark serves to distinguish the goods and services of a company. It is the mark through which a business can attract and retain customer loyalty, and create value and growth. The mark works in this case as an engine of innovation: the necessity to keep it relevant promotes investments in R&D, which leads in turn to a continuous process of product improvement and development. This dynamic process also has a favourable impact on employment. In an increasingly competitive environment, there has been a steady growth not only in the crucial role of trade marks for market success, but also in their commercial value. This is reflected in the increasing number of trade mark applications at both national and EU levels, and also in the number of trade mark users. 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 2007, when addressing the issue of the financial perspectives of OHIM, the Council[1] emphasised that the establishment of OHIM had been a great success and that it had contributed substantially to strengthening the competitiveness of the EU. It recalled that the Community trade mark system had been designed to co-exist with the national trade mark systems, which continued to be necessary for those undertakings which did not want their trade marks protected at EU level. The Council further noted the importance of the complementary work of national trade mark offices, and called on OHIM to expand its cooperation with them in the interest of the overall functioning of the Community trade mark system. Last, it acknowledged that more than a decade had passed since the creation of the Community trade mark, and therefore underlined the need for an overall assessment of the functioning of the Community trade mark system. It invited the Commission to start work on a corresponding study, in particular with a view to intensifying and broadening the existing instruments of cooperation between OHIM and national trade mark offices.

In its 2008 Small Business Act[2] the Commission pledged to make the Community trade mark system more accessible to SMEs. Furthermore, the 2008 Communication on an Industrial

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[1] Competitiveness Council Conclusions of 21 and 22 May 2007, Council document 9427/07.

[2] Communication from the Commission to the Council, the European Parliament, the European Economic and Social Committee and the Committee of the Regions, COM(2008) 394 final of 26 June 2008.

Property Rights Strategy for Europe[3] underlined the Commission's commitment to effective and efficient trade mark protection and to a trade mark 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 trade mark system in Europe and for the further improvement of cooperation between OHIM and National Offices. In 2010, in the Communication on Europe 2020, under the Flagship Initiative 'Innovation Union', the Commission undertook to modernise the framework of trade marks in order to improve framework conditions for business to innovate[4]. Finally, in its 2011 IPR strategy for Europe[5], 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.

1.2. Aim of the proposal

Considered together as a package, the main common objective of this initiative and of the parallel proposal for the amendment to 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. These adjustments dovetail with efforts to ensure coexistence and complementarity between the Union and national trade mark systems.

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

- Modernising and improving the existing provisions of the Directive, by amending outdated provisions, 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, by (a) adding further substantive rules and (b) introducing principal procedural rules into the Directive in accordance with provisions contained in the Regulation;

- 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.

2. RESULTS OF CONSULTATIONS WITH INTERESTED PARTIES AND IMPACT ASSESSMENT

2.1. Public consultation

This initiative is based on an evaluation of the way the trade mark system works as in Europe as a whole and of extensive consultations with all major stakeholders involved.

The main component of the evaluation was a study the Max Planck Institute for Intellectual Property and Competition Law undertook on behalf of the Commission. The study was

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3 COM(2008) 465 final of 16 July 2008.

4 COM(2010) 546 final of 6 October 2010.

5 COM(2011) 287 final of 24 May 2011, A Single Market for Intellectual Property Rights: Boosting creativity and innovation to provide economic growth, high quality jobs and first class products and services in Europe.

carried out between November 2009 and February 2011[6]. In addition to expert analysis, the study involved consultations with stakeholders. It included a survey among users of the Community trade mark system, contributions from organisations representing trade mark users at national, European and international level, and a hearing in June 2010 involving these organisations. Lastly, the Institute consulted the Intellectual Property Offices of all the Member States and OHIM.

The Final Report of the MPI study concluded that the basics of the European trade mark system are solid. In particular, the procedures followed by OHIM generally met business needs and expectations. There was further consensus that the coexistence of Community and national trade mark rights is fundamental and necessary for the efficient functioning of a trade mark system that meets the requirements of companies of different sizes, markets and geographical needs. The Report nevertheless found that there was a need for modernisation and improvement of the system. It highlighted, in particular, the need to achieve greater consistency between the Community trade mark and national trade mark systems by further harmonising the trade mark laws of Member States both within and beyond the current scope of the Directive.

Responding to the interim results of the study, the Council adopted Conclusions on 25 May 2010[7]. While noting the existing inconsistencies between the Community trade mark and national regimes, these conclusions called on the Commission to include in its proposals measures to make the Directive more consistent with the Regulation, and thereby further contribute to reducing areas of divergence within the trade mark system in Europe as a whole.

As a follow up to the MPI study, the Commission services convened a hearing of user associations on 26 May 2011. The hearing confirmed that there was broad agreement among users of the trade mark system in Europe that the present level of approximation between national trade mark laws, as well as with the Community trade mark system, has not been sufficient. User organisations unanimously stated that further harmonisation of national trade mark laws was required, with regard to both substantive law and procedural issues.

2.2. Impact Assessment

The impact assessment carried out for both the review of the Regulation and of the Directive identified two main problems: the first relates to the divergent provisions of the existing regulatory framework, and the second to the low level of cooperation between trade mark offices in the Union. While the latter problem is due to be addressed in the review of the Regulation, the issue of divergent provisions must be dealt with in the review of the Directive.

The consulation and evaluation exercise has revealed that the business environment in the trade mark field remains very mixed in spite of the partial harmonisation of national laws dating back to early 1990s. The level of harmonisation imposed by the Directive was quite low, focusing on a restricted number of substantive rules that were considered at that time to affect the functioning of the internal market most immediately, whereas a large number of areas, in particular those relating to procedures, were left unharmonised. Moreover, the Regulation was enacted several years after the Directive, which meant that at the time when

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[6] See the final MPI study, including annexes, at http://ec.europa.eu/internal_market/indprop/tm/index_en.htm.

[7] Competitiveness Council Conclusions of 25 May 2010 on the future revision of the Trade Mark system in the EU.

the Directive came into being there was no ‘common benchmark’ against which the efficiency of national proceedings could be measured. However, the procedures followed by OHIM have now been in place for more than 15 years, and are generally regarded as meeting business needs and expectations.

As a result, the current landscape of Union trade mark law is still characterised by a wide divergence between national rules and procedures, both among themselves and in relation to the rules and procedures applied by OHIM, and no attempt has ever been made to apply best practice with regard to procedures.

The existing divergences between national systems and the Community trade mark system are regarded significant. They are due to the fact that the Directive does not cover procedural aspects and that a number of important substantive law issues are not yet harmonised. Together with the limited convergence of practices and tools at trade mark offices - which is due to a low level of cooperation - the existing divergencies of trade mark laws and procedures limit accessibility to the systems of trade mark protection, involve a great deal of legal uncertainty, and endanger the complementary relationship between the Community trade mark and national trade mark systems. Furthermore, they prevent a level playing field for companies, with the consequent adverse impacts on the competitiveness of EU companies and the competiveness of the Union as a whole.

The following possible options for resolving the problem were considered:

- 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. This would include aligning the principal procedural rules with the relevant provisions of the Regulation, including those where existing difference create major problems from the users' perspective, and where such alignments are deemed indispensable for creating a harmonious, complementary system of trade mark protection in Europe. It would also cover the alignment of further aspects of substantive law in accordance with the provisions of the Regulation;

- Option 3: Full approximation of national trade mark laws and procedures. This approach would be based on option 2, embrace all of its components, but also include all remaining aspects of substantive trade mark law and procedures;

- Option 4: A single trade mark 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.

3. LEGAL BASIS AND SUBSIDIARITY

Article 114(1) of the Treaty empowers the European Parliament and the Council to adopt measures for the approximation of the provisions laid down by law, regulation or administrative action in Member States which have as their object the establishment and functioning of the internal market.

The problems identified in relation to the significant divergences in the regulatory framework either prevent, or substantially distort, the level playing field for EU companies with further adverse consequences for their competitiveness and that of the EU as a whole. It is therefore advisable to adopt measures capable of improving the conditions for the functioning of the internal market. Measures aimed at extending the current level of approximation through the Directive can only be taken at Union level. Furthermore, action at Union level is the only way to ensure consistency with the Community trade mark system.

In this context, it has to be borne in mind that the Community trade mark system is embedded in the European trade mark system - the latter being built on the principle of coexistence and complementarity between national and Union-wide trade mark protection. While the Regulation provides a comprehensive system in which all issues of substantive and procedural law are provided for, the current level of legislative approximation provided for in the Directive is limited to selected provisions of substantive law only. In order to be able to ensure effective and sustainable coexistence and complementarity between the components involved, it is therefore necessary to create an overall harmonious system of trade mark protection in the Union with substantially similar substantive rules and at least principal procedural provisions which are compatible.

4. BUDGETARY IMPLICATION

The proposal will not have an impact on the European Union budget and is therefore not accompanied by the financial statement provided for under Article 31 of the Financial Regulation (Regulation (EU, Euratom) No 966/2012 of the European Parliament and of the Council of 25 October 2012 on the financial rules applicable to the general budget of the Union and repealing Council Regulation (EC, Euratom) No 1605/2002).

5. DETAILED EXPLANATION OF THE PROPOSAL

The proposed amendments are presented in accordance with the objectives pursued by the recast of the Directive as set out in section 1.2 above.

5.1. Modernising and improving existing provisions

- Definition of a trade mark (Article 3)

At present, signs must be capable of being represented graphically in order to be protected as a trade mark. This requirement of ‘graphic representability’ is out of date. It creates a great deal of legal uncertainty around the representation of certain non-traditional marks, such as mere sounds. In the latter case, representation by other than graphical means (e.g. by a sound file) may even be preferable to graphic representation, if it permits a more precise identification of the mark and thereby serves the aim of enhanced legal certainty. 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 idea is not to go for a boundless extension of the admissible ways to represent a sign, but to provide for more flexibility in that respect while ensuring greater legal certainty.

- Rights conferred by a trade mark (Articles 10 and 11)

1. Rights conferred without prejudice to prior rights

Neither the Directive nor the Regulation contains a clear rule stating that the trade mark proprietor cannot successfully invoke his rights against the use of an identical or similar sign which is already the subject of an earlier right. In line with Article 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)[8], this proposal would make it clear that infringement claims are without prejudice to earlier rights.

2. Cases of double identity

The recognition of additional trade mark functions under Article 5(1)(a) of the Directive has created legal uncertainty. In particular, the relationship between double identity cases and the extended protection afforded by Article 5(2) to trade marks having a reputation has become unclear[9]. In the interest of legal certainty and consistency, it is clarified that in cases of both double identity under Article 5(1)(a) and similarity under Article 5(1)(b) it is only the origin function which matters.

3. Use as a trade or company name

According to the Court of Justice[10], Article 5(1) of the Directive is applicable where the public considers the use of a company name as (also) relating to the goods or services offered by the company. It is therefore 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.

4. Use in comparative advertising

Directive 2006/114/EC of 12 December 2006 concerning misleading and comparative advertising[11] regulates the conditions under which advertising, which explicitly or by implication identifies a competitor or goods or services offered by a competitor, is permissible. The relationship of Directive 2006/114/EC to the legislation on trade marks has given rise to doubts. It is therefore appropriate to clarify 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.

5. Consignments from commercial suppliers

It should be made clear that the importing of goods into the Union is also prohibited where it is only the consignor who acts for commercial purposes. This is to ensure that a trade mark owner has the right to prevent businesses (whether located in the EU or not) from importing goods located outside the EU that have been sold, offered, advertised or shipped to private consumers, and to discourage the ordering and sale of counterfeit goods in particular over the internet.

6. Goods brought into the customs territory

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8 OJ L 336, 23.12.1994, p. 213.

9 Opinion of AG Jääskinen in Case C-323/09, *Interflora*, para. 9.

10 Judgment of 11 September 2007, Case C-17/06, *Céline*, ECR I-07041.

11 OJ L 376, 27.12.2006, p. 21.

According to the Court of Justice in the *Philips/Nokia* judgment[12], the entry, presence and movement of non-EU goods in the customs territory of the EU under a suspensive procedure does, under the existing acquis, not infringe intellectual property rights as conferred by substantive law of the Union and its Member States. Such goods can only be classified as counterfeit once there is proof that they are subject of a commercial act directed at EU consumers, such as sale, offer for sale or advertising. The implications of the *Philips/Nokia* judgment have met with strong criticism from stakeholders as placing an inappropriately high burden of proof on rights holders, and hindering the fight against counterfeiting. It is evident that there is an urgent need to have in place a European legal framework enabling a more effective fight against the counterfeiting of goods as a fast-growing activity. It is therefore proposed to fill the existing gap by entitling right holders to prevent third parties from bringing goods, from third countries, bearing without authorization a 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.

7. Preparatory acts

Neither the Directive nor the Regulation contains any provisions allowing proceedings against the distribution and sale of labels and packaging and similar items which may subsequently be combined with illicit products. Some national laws have explicit rules covering this activity. Including a rule on this in the Directive and the Regulation is appropriate to provide another practical, relevant and efficient contribution to the combat against counterfeiting.

- Limitation of the effects of a trade mark (Article 14)

The limitation in Article 14(1)(a) of the Directive is restricted in this proposal to cover the use of personal names only in accordance with the Joint Statement of the Council and the Commission[13]. For reasons of consistency, the limitation in Article 14(1)(b) is extended to cover also the use of non-distinctive signs or indications. It is also considered appropriate to provide in Article 14(1)(c) for an explicit limitation covering referential use in general. Finally, a separate paragraph clarifies the conditions under which the use of a trade mark shall not be considered as complying with honest business practices.

5.2. Achieving greater approximation of substantive law

- Protection of geographical indications and traditional terms (Articles 4 and 5)

Contrary to the Regulation, the grounds for refusal contained in the Directive do not address conflicts with protected geographical indications, traditional terms for wines and traditional specialities guaranteed. Consequently, there is no guarantee that the levels of protection afforded to those rights by other instruments of Union law[14] are actually being applied in a uniform and exhaustive manner in trade mark examination throughout the Union, in particular, when applying absolute grounds for refusal. It is therefore proposed to insert

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12 Judgment of 1 December 2011, Cases C-446/09 *Philips* and C-495/09 *Nokia*.

13 Joint statements by the Council and the Commission of the European Communities entered in the minutes of the Council meeting, on the first Council Directive approximating the laws of the Member States on trade marks adopted on 21 December 1998.

14 Notably Regulation (EC) No 510/2006 (agricultural products), OJ L 93, 31.3.2008, p.12; Regulation (EC) No 479/2008 (wines), OJ L 148, 6.6.2008, p. 1; and Regulation (EC) No 110/2008 (spirits), OJ L 39, 13.2.2008, p. 16.

corresponding provisions relating to geographical indications, traditional terms for wine and traditional specialities guaranteed in the Directive.

- Protection of trade marks with reputation (Articles 5 and 10)

Articles 5 and 10 convert extended protection into mandatory provisions in order 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.

- Trade marks as objects of property (Articles 22, 23, 24, 25, 26 and 27)

Apart from some basic rules concerning licensing, and unlike the Regulation, the Directive does not comprise provisions regarding other aspects of trade marks as objects of property, such as transfers or right in rem. As a result, vital aspects of the commercial exploitation of trade marks are regulated poorly or differently across the Union. It is therefore proposed that the Directive be complemented by a corresponding body of rules addressing trade marks as objects of property as contained in the Regulation.

- Collective marks (Articles 28, 30, 31, 32, 33, 34, 35, 36 and 37)

In order to come into line with the Regulation, the amendments to these Articles of the Directive provide for a set of specific provisions for the registration and protection of collective marks. They are protectable in a number of Member States and have proved to be particularly successful in protecting the economic value inherent in such commercial instruments. Although at EU level, and in most Member States, collective marks require a holder – normally an association – whose members use the mark, this is not so in other Member States, and this makes it difficult to keep this type of trade mark clearly apart from certification marks.

5.3. Achieving alignment of principal procedural rules

- Designation and classification of goods and services (Article 40)

In line with the proposal on the Regulation, this Article lays down common rules for the designation and classification of goods and services. These rules follow the principles established by the Court of Justice[15], according to which goods and services for which protection is sought need to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and businesses to determine the extent of protection the trade mark confers. The general indications of the class headings of the Nice Classification may be used to identify goods or services provided that such identification is sufficiently clear and precise. Article 40 further clarifies that the use of general terms has to be interpreted as including only all goods or services clearly covered by the literal meaning of the term.

- Ex officio examination (Article 41)

In line with the Regulation, this Article provides that the ex officio examination of whether a trade mark application is eligible for registration shall be confined to the absence of grounds concerning the mark itself. The ex-officio examination of relative grounds creates several unnecessary barriers to the registration of trade marks. Companies are obliged to undergo

[15] Judgment of 19 June 2012, Case C-307/10, 'IP Translator'.

superfluous expenses and delays and they often fall victim to extortion. The earlier right on which the objection is based may not be used by its owner, which means that the offices concerned raise an objection on the basis of a right that could not have been validly relied on by its proprietor to prevent the registration or use of a later mark. Hence, the ex officio system leads to artificial disputes, and distorts competition by erecting unjustified barriers to market entry.

Finally, the ex officio approach creates legal uncertainty, since offices applying the ex-officio system raise objections, as far as earlier rights are concerned, only on the basis of earlier registered rights that have been filed for identical or similar goods and services. Accordingly, they cannot offer a guarantee that an application which successfully passes the ex-officio control will not subsequently be opposed on the basis of a mark which has acquired reputation in the marketplace and/or on the basis of an earlier well-known mark that has not been registered. However, this leads to an unacceptable duplication of procedures which are both time consuming and inefficient.

- Fees (Article 44)

In order to reduce the potential of cluttering of the registries, this Article aims at aligning the fee structure of offices by making the registration and renewal of a trade mark subject to the payment of an additional (class) fee for each class of goods and services beyond the first class which should be included in the initial (application/registration) fee.

- Opposition procedure (Article 45)

This Article requires Member States to provide for an efficient and expeditious administrative procedure to oppose the registration of a trade mark application on the basis of earlier rights before their offices. An administrative opposition procedure is already available under the Regulation and in almost all Member States.

- Non use as defence in opposition proceedings (Article 46)

In line with the Regulation, this Article enables the person applying for registration of a trade mark to raise the defence of non-use in relation to an opposition filed by the proprietor of an earlier trade mark where, at the filing date or date of priority of the later trade mark, the earlier trade mark has been registered for not less than five years.

- Procedure for revocation or declaration of invalidity (Article 47)

This Article obliges Member States to provide for an administrative procedure to challenge the validity of a trade mark registration before their offices. In some Member States, trade mark applicants and owners cannot challenge the validity of the earlier rights relied upon against their trade mark in the same proceedings, but need to contest the validity of a prior trade mark in court proceedings. This delays proeedings and usually requires the appointment of a qualified lawyer to prosecute the case. These systems are exceedingly long, cumbersome and expensive. In comparison, the administrative cancellation procedures, as applied at OHIM and the National Offices, are much simpler since the validity of earlier rights can be raised as a defence in the same proceedings and without the need for professional representation. In practice, this means that applicants for a Community trade mark may successfully defend themselves against an opposition and obtain a trade mark years earlier and at considerably less expense than a national applicant.

- Non use as defence in proceedings seeking a declaration of invalidity (Article 48)

In line with the Regulation, this Article enables the person in whose name a trade mark has been registered to raise the defence of non-use in proceedings for a declaration of invalidity based on earlier trade mark, where at the date of the application for a declaration of invalidity the earlier trade mark has been registered for not less than five years.

5.4. Facilitating cooperation between offices (Article 52)

As a complement to the legal framework for cooperation proposed in the context of the review of the Regulation, Article 52 provides a legal basis to facilitate cooperation between OHIM and the intellectual property offices of the Member States for the purpose of promoting convergence of practices and the development of common tools.

↓ 2008/95/EC (adapted)

2013/0089 (COD)

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to approximate the laws of the Member States relating to trade marks

(Recast)

(Text with EEA relevance)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty ~~establishing the European Community~~ ⌦ on the Functioning of the European Union ⌫ , and in particular Article ~~95~~ ⌦ 114 ⌫ thereof,

Having regard to the proposal from the European Commission,

After transmission of the draft legislative act to the national Parliaments,

Having regard to the opinion of the European Economic and Social Committee[1],

Acting in accordance with the ordinary legislative procedure,

Whereas:

↓ 2008/95/EC recital 1 (adapted)
⇨ new

(1) ⇨ A number of amendments are to be made to ⇦ ~~The content of Council~~ Directive ~~89/104/EEC of 21 December 1988~~ 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks[2] ~~has been amended~~[3]. In the interests of clarity, ~~and rationality the said~~ ⌦ that ⌫ Directive should be ~~codified~~ ⇨ recast ⇦ .

[1] OJ C […], […], p. […].

[2] OJ L ~~40~~ 299, ~~11.2.1989~~ 8.11.2008, p. ~~1~~ 25.

[3] ~~See Annex I, Part A.~~

↓ 2008/95/EC recital 2 (adapted)

(2) ~~The~~ ⌦ Directive 2008/95/EC has harmonised central provisions of substantive ⌫ trade mark law~~s applicable in the Member States before the entry into force of Directive 89/104/EEC contained disparities which may have impeded~~ ⌦ which at the time of adoption were considered as most directly affecting the functioning of the internal market by impeding ⌫ the free movement of goods and ⌦ the ⌫ freedom to provide services ⌦ in the Union ⌫ ~~and may have distorted competition within the common market~~. ~~It was therefore necessary to approximate the laws of the Member States in order to ensure the proper functioning of the internal market.~~

↓ 2008/95/EC recital 3 (adapted)

~~It is important not to disregard the solutions and advantages which the Community trade mark system may afford to undertakings wishing to acquire trade marks.~~

↓ 2008/95/EC recital 4

~~It does not appear to be necessary to undertake full-scale approximation of the trade mark laws of the Member States. It will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market.~~

⇩ new

(3) Trade mark protection in the Member States coexists with protection available at Union level through European trade marks which are intellectual property rights unitary in character and valid throughout the Union as laid down in Council Regulation (EC) No 207/2009 of 26 February 2009 on the European trade mark[4]. Coexistence of trade mark systems at national and Union level in fact constitutes a cornerstone of the Union's approach to intellectual property protection.

(4) Further to the Commission's Communication of 16 July 2008 on an Industrial Property Rights Strategy for Europe[5], the Commission carried out a comprehensive evaluation of the overall functioning of the trade mark system in Europe as a whole, covering Union and national levels and the interrelation between each other.

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union[6], the Council called on the Commission to present proposals for the revision of Regulation (EC) No 207/2009 and Directive 2008/95/EC. In doing so, the revision of the latter should include measures to make it more consistent with

[4] OJ L 78, 24.3.2009, p.1.
[5] COM(2008) 465.
[6] OJ c 140, 29.5.2010, p. 22.

Regulation (EC) No 207/2009 and would thus reduce the areas of divergence within the trade mark system in Europe as a whole.

(6) The Commission concluded in its Communication 'A Single Market for Intellectual Property Rights' of 24 May 2011[7] that in order to meet increased demands from stakeholders for faster, higher quality, more streamlined trade mark registration systems, which are more consistent, user friendly, publicly accessible and technologically up-to-date, there is a necessity to modernise the trade mark system in the Union as a whole and adapt it to the Internet era.

(7) Consultation and evaluation for the purpose of this Directive has revealed that in spite of the previous partial harmonisation of national laws, the European business environment remains very heterogeneous, limiting the accessibility to trade mark protection overall and thus having a detrimental effect on competitiveness and growth.

(8) In order to serve the objective of fostering and creating a well functioning single market and to facilitate acquiring and protecting trade marks in the Union, it is therefore necessary to go beyond the limited scope of approximation achieved by Directive 2008/95/EC and extend approximation to all aspects of substantive trade mark law governing trade marks protected through registration as covered by Regulation (EC) No 207/2009.

(9) For the purpose of making trade mark registrations throughout the Union easier to obtain and administer, it is essential to approximate not only provisions of substantive law but also procedural rules. Therefore, principal procedural rules in the Member States and in the European trade mark system, including those in respect of which divergences cause major problems for the functioning of the internal market, should be aligned. As regards procedures under national law it is sufficient to lay down general principles, leaving the Member States free to establish more specific rules.

(10) It is fundamental to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States, and that the protection of trade marks at the national level is the same as the protection of European trade marks. In line with the extensive protection granted to European 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.

↓ 2008/95/EC recital 5 (adapted)

(11) This Directive should not deprive the Member States of the right to continue to protect trade marks acquired through use but should take them into account only in regard to ~~the~~ ⌦ their ⌫ relationship ~~between them and~~ ⌦ with ⌫ trade marks acquired by registration.

[7] COM(2011) 287.

↓ 2008/95/EC recital 6

~~Member States should also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration. They can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an *ex officio* examination procedure or both. Member States should remain free to determine the effects of revocation or invalidity of trade marks.~~

↓ 2008/95/EC recital 8 (adapted)
⇨ new

(12) Attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark be, in general, identical in all Member States.

(13) To this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. ⇨ In order to fulfil the objectives of the registration system for trade marks, which are to ensure legal certainty and sound administration, it is also essential to require that the sign is capable of being represented in a manner which allows for a precise determination of the subject of protection. A sign should therefore be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect. ⇦

(14) ⌦ Furthermore, ⌫ ~~T~~the grounds for refusal or invalidity concerning the trade mark itself, ~~for example,~~ ⌦ including ⌫ the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights, should be listed in an exhaustive manner, even if some of these grounds are listed as an option for the Member States which should therefore be able to maintain or introduce those grounds in their legislation. ~~Member States should be able to maintain or introduce into their legislation grounds of refusal or invalidity linked to conditions for obtaining and continuing to hold a trade mark for which there is no provision of approximation, concerning, for example, the eligibility for the grant of a trade mark, the renewal of the trade mark or rules on fees, or related to the non-compliance with procedural rules.~~

↓ 2008/95/EC recital 9

~~In order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation. It is necessary to provide that a trade mark cannot be invalidated on the basis of the existence of a non-used earlier trade mark, while the Member States should remain free to apply the same principle in respect of the registration of a trade mark or to provide that a trade mark may not~~

~~be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked. In all these cases it is up to the Member States to establish the applicable rules of procedure.~~

↓ 2008/95/EC recital 10

~~It is fundamental, in order to facilitate the free movement of goods and services, to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States. This should not, however, prevent the Member States from granting at their option extensive protection to those trade marks which have a reputation.~~

⇩ new

(15) In order to ensure that the levels of protection afforded to geographical indications by other instruments of Union 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.

↓ 2008/95/EC recital 11

(16) The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services. It is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion. The likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection. The ways in which likelihood of confusion may be established, and in particular the onus of proof, should be a matter for national procedural rules which should not be prejudiced by this Directive.

⇩ new

(17) In order to ensure legal certainty and full consistency with the principle of priority, under which an earlier registered trade mark takes precedence over later registered trade marks, it is necessary to lay down that the enforcement of rights conferred by a trade mark should be without prejudice to the rights of proprietors acquired prior to the filing or priority date of the trade mark. This is in conformity with Article 16(1) of the

Agreement on trade related aspects of intellectual property rights of 15 April 1994 (hereinafter: 'TRIPS Agreement')[8].

(18) It is appropriate to provide that an infringement of a trade mark can only be established if there is a finding that the infringing mark or sign is used in the course of trade for purposes of distinguishing goods or services as to their commercial origin. Uses for other purposes should be subject to the provisions of national law.

(19) In order to ensure legal certainty and clarity, it is necessary to clarify that not only in the case of similarity but also in case of an identical sign being used for identical goods or services, protection should be granted to a trade mark only if and to the extent that the main function of the trade mark, which is to guarantee the commercial origin of the goods or services, is adversely affected.

(20) Infringement of a trade mark should also comprise the use of the sign as a trade name or similar designation as long as the use is made for the purposes of distinguishing goods or services as to their commercial origin.

(21) In order to ensure legal certainty and full consistency with specific Union legislation, it is appropriate to provide that the proprietor of a trade mark should be entitled to prohibit a third party from using a sign in a comparative advertising where such comparative advertising is contrary to Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising[9].

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, 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 authorization a trade mark which is essentially identical to the trade mark registered in respect of such goods.

(23) In order to more effectively prevent the entry of infringing goods, particularly in the context of sales over the Internet, the proprietor should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the goods who acts for commercial purposes.

(24) In order to enable proprietors of registered trade marks to fight counterfeiting more effectively, they should be entitled to prohibit the affixing of an infringing trade mark to goods and certain preparatory acts prior to the affixing.

(25) The exclusive rights conferred by a trade mark should not entitle the proprietor to prohibit the use of signs or indications which are used fairly and in accordance with honest practices in industrial and commercial matters. In order to create equal conditions for trade names and trade marks against the background that trade names are regularly granted unrestricted protection against later trade marks, such use should be considered to include the use of one's own personal name. It should further include the use of descriptive or non-distinctive signs or indications in general. Furthermore,

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[8] OJ L 336, 23.12.1994, p. 213.
[9] OJ L 376, 27.12.2006, p. 21.

the proprietor should not be entitled to prevent the general fair and honest use of the mark for identifying or referring to the goods or services as those of the proprietor.

(26) It follows from the principle of free movement of goods that the proprietor of a trade mark must not be entitled to prohibit its use by a third party in relation to goods which have been put into circulation in the Union, under the trade mark, by him or with his consent, unless the proprietor has legitimate reasons to oppose further commercialisation of the goods.

↓ 2008/95/EC recital 12

(27) It is important, for reasons of legal certainty and without inequitably prejudicing the interests of a proprietor of an earlier trade mark, to provide that the latter may no longer request a declaration of invalidity nor may he oppose the use of a trade mark subsequent to his own of which he has knowingly tolerated the use for a substantial length of time, unless the application for the subsequent trade mark was made in bad faith.

⇩ new

(28) In order to ensure legal certainty and safeguard trade mark rights legitimately acquired, it is appropriate and necessary to lay down, without affecting the principle that the later trade mark cannot be enforced against the earlier trade mark, that proprietors of earlier trade marks should not be entitled to obtain refusal or invalidation or to oppose the use of a later trade mark when the later trade mark was acquired at a time when the earlier trade mark was liable to be declared invalid or revoked, for example because it had not yet acquired distinctiveness through use, or when the earlier trade mark could not be enforced against the later trade mark because the necessary conditions were not applicable, for example when the earlier mark had not yet obtained reputation.

(29) Trade marks fulfil their purpose of distinguishing goods or services and allowing consumers to make informed choices only when they are actually used on the market. A requirement of use is also necessary in order to reduce the total number of trade marks registered and protected in the Union and, consequently, the number of conflicts which arise between them. It is therefore essential to require that registered trade marks must actually be used in connection with the goods or services for which they are registered, or, if not used, must be liable to be revoked.

(30) Consequently a registered trade mark should only be protected in so far as it is actually used and an earlier registered trade mark should not enable its proprietor to oppose or invalidate a later trade mark if that proprietor has not put its trade mark to genuine use. Furthermore, Member States should provide that a trade mark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked or, when the action is brought against a later right, could have been revoked at the time when the later right was acquired.

(31) It is appropriate to provide that, where the seniority of a national mark has been claimed for a European trade mark and the national mark has thereafter been surrendered or allowed to lapse, the validity of that national mark may still be challenged. The challenge should be limited to situations where the national mark could have been declared invalid or revoked at the time the mark was removed from the register.

(32) For reasons of coherence and in order to facilitate the commercial exploitation of trade marks in the Union, the rules applicable to trade marks as objects of property should be aligned with those already in place for European trade marks, and should include rules on assignment and transfer, licensing, rights in rem, levy of execution and insolvency proceedings.

(33) Collective trade marks have proven a useful instrument for promoting goods or services with specific common properties. It is therefore appropriate to subject national collective trade marks to rules similar to the rules applicable to European collective marks.

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to European trade marks. With a view to achieving a consistent and balanced trade mark system both at national and Union level, all the central industrial property offices of the Member States should therefore limit their examination ex officio of whether a trade mark application is eligible for registration to the absence of absolute grounds for refusal only. This should however not prejudice the right of those offices to provide, upon request of applicants, searches for earlier rights on a purely informative basis and without any prejudice to or binding effect on the further registration process, including subsequent opposition proceedings.

(35) In order to ensure legal certainty with regard to the scope of trade mark rights and to facilitate access to trade mark protection, the designation and classification of goods and services covered by a trade mark application should follow the same rules in all Member States and should be aligned on those applicable to European trade marks. In order to enable the competent authorities and economic operators to determine the extent of the trade mark protection sought on the basis of the application alone, the designation of goods and services should be sufficiently clear and precise. The use of general terms should be interpreted as including only goods and services clearly covered by the literal meaning of the term.

(36) For the purpose of ensuring effective trade mark protection, Member States should make available an efficient administrative opposition procedure, allowing proprietors of earlier trade mark rights to oppose the registration of a trade mark application. Furthermore, in order to offer efficient means of revoking or declaring invalid trade marks, Member States should provide for an administrative procedure for revocation or declaration of invalidity similar to that applicable to European trade marks at Union level.

(37) Member States' central industrial property offices should cooperate with each other and with the European Union Trade Marks and Designs Agency (‘the Agency’) in all fields of trade mark registration and administration in order to promote convergence of

practices and tools, such as the creation and updating of common or connected databases and portals for consultation and search purposes. The offices of the Member States and the Agency should further cooperate in all other areas of their activities which are relevant for the protection of trade marks in the Union.

↓ 2008/95/EC recital 7

(38) This Directive should not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection.

↓ 2008/95/EC recital 13 (adapted)

(39) All Member States are bound by the Paris Convention for the Protection of Industrial Property ⌦ (Paris Convention) and the TRIPS Agreement ⌫. It is necessary that the provisions of this Directive should be entirely consistent with those of the said Convention ⌦ and Agreement ⌫. The obligations of the Member States resulting from that Convention ⌦ and Agreement ⌫ should not be affected by this Directive. Where appropriate, the second paragraph of Article ~~307~~ ⌦ 351 ⌫ of the Treaty should apply.

⇩ new

(40) The obligation to transpose this Directive into national law should be confined to those provisions which represent a substantive amendment as compared with the earlier Directive. The obligation to transpose the provisions which are unchanged arises under the earlier Directive.

↓ 2008/95/EC recital 14 (adapted)

(41) This Directive should be without prejudice to the obligations of the Member States relating to the time limit for transposition into national law of ⌦ the ⌫ Directive ~~89/104/EEC~~ set out in ~~Annex I,~~ Part B of Annex I to Directive 2008/95/EC,

↓ 2008/95/EC (adapted)

HAVE ADOPTED THIS DIRECTIVE:

Chapter 1

⌦ General provisions ⌫

↓ 2008/95/EC

Article 1

Scope

This Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee or certification 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.

⇩ new

Article 2

Definitions

For the purpose of this Directive, the following definitions shall apply:

(a) 'office' means the central industrial property office of the Member State or the Benelux Office for Intellectual Property entrusted with the registration of trade marks;

(b) 'Agency' means the European Union Trade Marks and Designs Agency established in accordance with Article 2 of Regulation (EC) No 207/2009;

(c) 'register' means the register of trade marks kept by an office.

↓ 2008/95/EC (adapted)

Chapter 2

⌦ The law on trade marks ⌫

SECTION 1

⌦ SIGNS OF WHICH A TRADE MARK MAY CONSIST ⌫

Article ~~2~~3

Signs of which a trade mark may consist

A trade mark may consist of any signs ~~capable of being represented~~ ~~graphically~~, ⌦ in particular ⌫ ~~particularly~~ words, including personal names, designs, letters, numerals, ⌦ colours as such, ⌫ the shape of goods or of their packaging, ⌦ or sounds, ⌫ provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings~~;~~:

⇩ new

(b) being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.

↓ 2008/95/EC (adapted)

SECTION 2

⌦ GROUNDS FOR REFUSAL OR INVALIDITY ⌫

Article ~~3~~4

⌦ Absolute ⌫ ~~G~~grounds for refusal or invalidity

↓ 2008/95/EC

1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

(a) signs which cannot constitute a trade mark;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(e) signs which consist exclusively of:

(i) the shape which results from the nature of the goods themselves;

(ii) the shape of goods which is necessary to obtain a technical result;

(iii) the shape which gives substantial value to the goods;

(f) trade marks which are contrary to public policy or to accepted principles of morality;

(g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

(h) trade marks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6 *ter* of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the 'Paris Convention';

⇩ new

(i) trade marks which are excluded from registration and shall not continue to be used pursuant to Union legislation or international agreements to which the Union is party, providing for protection of designations of origin and geographical indications.

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine and traditional specialities guaranteed.

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain:

(a) in other Member States than those where the application for registration was filed;

(b) only where a trade mark in a foreign language is translated or transcribed in any script or official language of the Member States.

3. A trade mark shall be liable to be declared invalid where the application for registration of the trade mark was made in bad faith by the applicant. Any Member State may also provide that such a trade mark shall not be registered.

↓ 2008/95/EC

~~2~~4. Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:

↓ 2008/95/EC (adapted)

(a) the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the ⌦ Union ⌫ ~~Community~~;

↓ 2008/95/EC

(b) the trade mark covers a sign of high symbolic value, in particular a religious symbol;

(c) the trade mark includes badges, emblems and escutcheons other than those covered by Article 6 *ter* of the Paris Convention and which are of public interest, unless the consent of the competent authority to their registration has been given in conformity with the legislation of the Member State~~;~~.

~~(d) the application for registration of the trade mark was made in bad faith by the applicant.~~

↓ 2008/95/EC (adapted)
⇨ new

~~3~~5. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration ⇨ or after the date of registration, ⇦ and following the use which has been made of it, it has acquired a distinctive character.

6. Any Member State may ~~in addition~~ provide that ~~this provision~~ ⌦ paragraph 5 ⌫ shall also apply where the distinctive character was acquired after the date of application for registration ~~or after~~ ⇨ and before ⇦ the date of registration.

~~4. Any Member State may provide that, by derogation from paragraphs 1, 2 and 3, the grounds of refusal of registration or invalidity in force in that State prior to the date of entry into force of the provisions necessary to comply with Directive 89/104/EEC, shall apply to trade marks for which application has been made prior to that date.~~

Article ~~4~~5

~~Further~~ ⌦ Relative ⌫ grounds for refusal or invalidity ~~concerning conflicts with earlier rights~~

↓ 2008/95/EC

1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. 'Earlier trade marks' within the meaning of paragraph 1 means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;

↓ 2008/95/EC (adapted)

(i) ⌦ European ⌫ ~~Community~~ trade marks;

↓ 2008/95/EC

(ii) trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Office for Intellectual Property;

(iii) trade marks registered under international arrangements which have effect in the Member State;

↓ 2008/95/EC (adapted)

(b) ⌦ European ⌫ ~~Community~~ trade marks which validly claim seniority, in accordance with ~~Council~~ Regulation (EC) No ~~40/94[10] of 20 December 1993 on the Community trade mark~~ 207/2009, from a trade mark referred to in points (a)(ii) and (iii), even when the latter trade mark has been surrendered or allowed to lapse;

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10 ~~OJ L 11, 14.1.1994, p. 1.~~

↓ 2008/95/EC

(c) applications for the trade marks referred to in points (a) and (b), subject to their registration;

(d) trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well known in a Member State, in the sense in which the words 'well known' are used in Article 6 *bis* of the Paris Convention.

↓ 2008/95/EC (adapted)
⇨ new

3. A trade mark shall ~~furthermore~~ not be registered or, if registered, shall be liable to be declared invalid:

(a) if it is identical with, or similar to, an earlier ~~Community~~ trade mark ⇨ irrespective of whether the goods or services for which it is applied or ⇦ ~~within the meaning of paragraph 2 and is to be, or has been,~~ registered ~~for goods or services which~~ are ⇨ identical with, similar to or ⇦ not similar to those for which the earlier ~~Community~~ trade mark is registered, where the earlier ~~Community~~ trade mark has a reputation in ~~the Community~~ ⇨ a Member State or, in case of a European trade mark, has a reputation in the Union ⇦ and ~~where~~ the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier ~~Community~~ trade mark~~.~~;

⇩ new

(b) where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;

(c) where the trade mark is liable to be confused with an earlier mark protected outside the Union, provided that the mark was still in genuine use at the date of the application and the applicant was acting in bad faith;

(d) if it is excluded from registration and shall not continue to be used pursuant to Union legislation providing for protection of designations of origin and geographical indications.

↓ 2008/95/EC (adapted)

4. Any Member State may~~, in addition,~~ provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

↓ 2008/95/EC

~~(a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;~~

(~~b~~a) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;

(~~c~~b) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraph 2 and point (~~b~~a) of this paragraph and in particular:

(i) a right to a name;

(ii) a right of personal portrayal;

(iii) a copyright;

(iv) an industrial property right~~.~~.

~~(d) the trade mark is identical with, or similar to, an earlier collective trade mark conferring a right which expired within a period of a maximum of three years preceding application;~~

~~(e) the trade mark is identical with, or similar to, an earlier guarantee or certification mark conferring a right which expired within a period preceding application the length of which is fixed by the Member State;~~

~~(f) the trade mark is identical with, or similar to, an earlier trade mark which was registered for identical or similar goods or services and conferred on them a right which has expired for failure to renew within a period of a maximum of two years preceding application, unless the proprietor of the earlier trade mark gave his agreement for the registration of the later mark or did not use his trade mark;~~

~~(g) the trade mark is liable to be confused with a mark which was in use abroad on the filing date of the application and which is still in use there, provided that at the date of the application the applicant was acting in bad faith.~~

5. The Member States may permit that in appropriate circumstances registration need not be refused or the trade mark need not be declared invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.

6. Any Member State may provide that, by derogation from paragraphs 1 to 5, the grounds for refusal of registration or invalidity in force in that State prior to the date of the entry into force

of the provisions necessary to comply with Directive 89/104/EEC, shall apply to trade marks for which application has been made prior to that date.

↓ 2008/95/EC (adapted)
⇨ new

Article ~~1~~46

Establishment *a posteriori* of invalidity or revocation of a trade mark

Where the seniority of a~~n earlier~~ ⌦ national ⌫ trade mark which has been surrendered or allowed to lapse is claimed for a ⌦ European ⌫ ~~Community~~ trade mark, the invalidity or revocation of the ~~earlier~~ ⌦ national ⌫ trade mark may be established *a posteriori* ⇨, provided that the invalidity or revocation could also have been declared at the time the mark was surrendered or allowed to lapse. In such a case the seniority shall cease to produce its effects ⇦ .

Article 7

⌦ Grounds for refusal or invalidity relating to only some of the goods or services ⌫

⌦ Where grounds for refusal of registration or for invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied or registered, refusal of registration or invalidity shall cover those goods or services only. ⌫

⇩ new

Article 8

Lack of distinctive character or of reputation of an earlier trade mark precluding a declaration of invalidity of a registered trade mark

A registered trade mark shall not be declared invalid on the basis of an earlier trade mark in any of the following cases:

(a) where the earlier trade mark, liable to be declared invalid pursuant to Article 4(1)(b), (c) or (d), had not acquired a distinctive character in accordance with Article 4(5) at the filing date or the priority date of the registered trade mark;

(b) where the application for a declaration of invalidity is based on Article 5(1)(b) and the earlier trade mark had not become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of Article 5(1)(b) at the filing date or the priority date of the registered trade mark;

(c) where the application for a declaration of invalidity is based on Article 5(3) and the earlier trade mark did not have a reputation within the meaning of Article 5(3) at the filing date or the priority date of the registered trade mark.

↓ 2008/95/EC (adapted)
⇨ new

Article 9

~~Limitation~~ ⌦ Preclusion of a declaration of invalidity ⌫ in consequence of acquiescence

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article ~~4~~5(2) ⇨ and (3) ⇦ has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark ~~either~~ to apply for a declaration that the later trade mark is invalid ~~or to oppose the use of the later trade mark~~ in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.

2. Any Member State may provide that paragraph 1 shall apply ~~*mutatis mutandis*~~ to the proprietor of ~~an earlier trade mark referred to in Article 4(4)(a) or~~ ~~an~~ ⌦ any ⌫ other earlier right referred to in Article ~~4~~5(4)(a~~b~~) or (b~~c~~).

↓ 2008/95/EC

3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later registered trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trade mark.

↓ 2008/95/EC (adapted)
⇨ new

~~SECTION 3~~

⌦ RIGHTS CONFERRED AND LIMITATIONS ⌫

Article ~~5~~10

Rights conferred by a trade mark

1. The ~~registered~~ ⌦ registration of a ⌫ trade mark shall confer on the proprietor exclusive rights ~~therein~~.

⌦ 2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, ⌫ ~~T~~the proprietor ⌦ of a registered trade mark ⌫ shall be entitled to prevent all third parties not having his consent from using in the course of trade ⌦ any sign in relation to goods or services where ⌫ :

(a) ~~any~~ ⌦ the ⌫ sign ~~which~~ is identical with the trade mark ⌦ and is used ⌫ in relation to goods or services which are identical with those for which the trade mark is registered ⇨ and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services ⇦;

(b) ~~any~~ ⌦ the ⌫ sign ~~where, because of its identity~~ ⌦ is identical ⌫ ~~with~~, or similar~~ity~~ to, the trade mark and ~~the identity or similarity of the~~ ⌦ is used for ⌫ goods or services ~~covered by~~ ⌦ which are identical with or similar to the goods or services for which ⌫ the trade mark ⌦ is registered ⌫ ~~and the sign~~, ⌦ if ⌫ there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

~~2.~~ (c) ~~Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any~~ ⌦ the ⌫ sign ~~which~~ is identical with, or similar to, the trade mark ⌦ irrespective of whether it is used ⌫ in relation to goods or services which are ⇨ identical with, similar or ⇦ not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

⇩ 2008/95/EC (adapted)

3. The following, ⌦ in particular ⌫ ~~*inter alia*~~, may be prohibited under paragraph~~s~~ ~~1 and~~ 2:

⇩ 2008/95/EC

(a) affixing the sign to the goods or to the packaging thereof;

(b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

⇩ new

(d) using the sign as a trade or company name or part of a trade or company name;

⇩ 2008/95/EC

(~~d~~e) using the sign on business papers and in advertising~~;~~.

⇩ new

(f) using the sign in comparative advertising in a way which is contrary to Directive 2006/114/EC.

4. The proprietor of a registered trade mark shall also be entitled to prevent the importing of goods pursuant to paragraph 3(c) where only the consignor of the goods acts for commercial purposes.

5. The proprietor of a registered trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State where the trade mark is registered without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

🡻 2008/95/EC

~~4~~6. Where, under the law of a Member State, the use of a sign under the conditions referred to in paragraph ~~2~~1, point (b) or (c)~~paragraph 2~~ could not be prohibited before the date of entry into force of the provisions necessary to comply with Directive 89/104/EEC in the Member State concerned, the rights conferred by the trade mark may not be relied on to prevent the continued use of the sign.

~~5~~7. Paragraphs 1,2,3 and 6 ~~to 4~~ shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

⇩ new

Article 11

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

Where it is likely that the get-up, packaging or other means to which the mark is affixed will be used in relation to goods or services and the use in relation to those goods or services would constitute an infringement of the rights of the proprietor under Article 10(2) and (3), the proprietor shall have the right to prohibit the following:

(a) affixing in the course of trade a sign identical with or similar to the trade mark on get-up, packaging or other means on which the mark may be affixed;

(b) offering or placing on the market, or stocking for those purposes, or importing or exporting get-up, packaging or other means on which the mark is affixed.

Article 12

Reproduction of trade marks in dictionaries

If the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark.

Article 13

Prohibition of the use of a trade mark registered in the name of an agent or representative

1. Where a trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's consent, the latter shall be entitled to either of the following:

(a) to oppose the use of his mark by his agent or representative;

(b) to demand from the agent or representative the assignment of the trade mark in his favour.

2. Paragraph 1 shall not apply where the agent or representative justifies his action.

↓ 2008/95/EC

Article ~~6~~14

Limitation of the effects of a trade mark

1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

↓ 2008/95/EC (adapted)
⇨ new

(a) his own ⌦ personal ⌫ name or address;

(b) ⇨ signs or ⇦ indications ⇨ which are not distinctive or which ⇦ concern~~ing~~ the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;

(c) the trade mark ⇨ for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular ⇦ where ~~it~~ ⌦ the use of the

trade mark ⌫ is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts~~;~~.

~~provided he uses them~~ ⌦ The first subparagraph shall only apply where the use made by the third party is ⌫ in accordance with honest practices in industrial or commercial matters.

⇩ new

2. The use by the third party shall be considered not to be in accordance with honest practices, in particular in the following cases:

(a) it gives the impression that there is a commercial connection between the third party and the proprietor of the trade mark;

(b) it takes unfair advantage of or is detrimental to, the distinctive character or the repute of the trade mark without due cause.

🡻 2008/95/EC

~~2~~3. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Member State in question and within the limits of the territory in which it is recognised.

Article ~~7~~15

Exhaustion of the rights conferred by a trade mark

🡻 2008/95/EC (adapted)

1. The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the ~~Community~~ ⌦ Union ⌫ under that trade mark by the proprietor or with his consent.

🡻 2008/95/EC

2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

↓ 2008/95/EC (adapted)

Article ~~10~~16

Use of trade marks

1. If, within a period of five years following the date of ~~the completion of the~~ registration ~~procedure~~, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the ⌦ limits and ⌫ sanctions provided for in ⌦ Article 17, Article 19(1), Article 46(1), and Article 48(3) and (4) ⌫ ~~this Directive~~, unless there are proper reasons for non-use.

⇩ new

2. Where a Member State provides for opposition proceedings following registration, the five years referred to in paragraph 1 shall be calculated from the date when the mark can no longer be opposed or, in case an opposition has been lodged and not withdrawn, from the date when a decision terminating the opposition proceedings has become final.

3. With regard to trade marks registered under international arrangements which have effect in the Member State, the five years referred to in paragraph 1 shall be calculated from the date when the mark can no longer be rejected or opposed. Where an opposition has been lodged and not withdrawn, the period shall be calculated from the date when a decision terminating the opposition proceedings has become final.

↓ 2008/95/EC

4. The following shall also constitute use within the meaning of ~~the first~~ ~~sub~~paragraph 1:

↓ 2008/95/EC
⇨ new

(a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered ⇨ , regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor ⇦ ;

(b) affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.

~~2~~5. Use of the trade mark with the consent of the proprietor ~~or by any person who has authority to use a collective mark or a guarantee or certification mark~~ shall be deemed to constitute use by the proprietor.

~~3. In relation to trade marks registered before the date of entry into force in the Member State concerned of the provisions necessary to comply with Directive 89/104/EEC:~~

~~(a) where a provision in force prior to that date attached sanctions to non-use of a trade mark during an uninterrupted period, the relevant period of five years mentioned in the first subparagraph of paragraph 1 shall be deemed to have begun to run at the same time as any period of non-use which is already running at that date;~~

~~(b) where there was no use provision in force prior to that date, the periods of five years mentioned in the first subparagraph of paragraph 1 shall be deemed to run from that date at the earliest.~~

⇩ new

Article 17

Non-use as defence in infringement proceedings

The proprietor of a trade mark shall be entitled to prohibit the use of a sign only to the extent that his rights are not liable to be revoked pursuant to Article 19 at the time the infringement action is brought.

Article 18

Intervening right of the proprietor of a later registered trade mark as defence in infringement proceedings

1. In infringement proceedings, the proprietor of a trade mark shall not be entitled to prohibit the use of a later registered mark where that later trade mark shall not be declared invalid pursuant to Articles 8, 9(1) and (2) and 48(3).

2. In infringement proceedings, the proprietor of a trade mark shall not be entitled to prohibit the use of a later registered European trade mark where that later trade mark shall not be declared invalid pursuant to Article 53(3) and (4), Article 54(1) and (2) or Article 57(2) of Regulation (EC) No 207/2009.

3. Where the proprietor of a trade mark shall not be entitled to prohibit the use of a later registered mark pursuant to paragraphs 1 or 2, the proprietor of that later registered trade mark shall not be entitled to prohibit the use of the earlier trade mark in infringement proceedings, even though that right may no longer be invoked against the later trade mark.

🡻 2008/95/EC

~~*Article 11*~~

~~**Sanctions for non-use of a trade mark in legal or administrative proceedings**~~

~~1. A trade mark may not be declared invalid on the ground that there is an earlier conflicting trade mark if the latter does not fulfil the requirements of use set out in Article 10(1) and (2), or in Article 10(3), as the case may be.~~

~~2. Any Member State may provide that registration of a trade mark may not be refused on the ground that there is an earlier conflicting trade mark if the latter does not fulfil the requirements of use set out in Article 10(1) and (2) or in Article 10(3), as the case may be.~~

~~3. Without prejudice to the application of Article 12, where a counter-claim for revocation is made, any Member State may provide that a trade mark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked pursuant to Article 12(1).~~

~~4. If the earlier trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for purposes of applying paragraphs 1, 2 and 3, be deemed to be registered in respect only of that part of the goods or services.~~

↓ 2008/95/EC (adapted)

SECTION 4

⌦ REVOCATION OF TRADE MARK RIGHTS ⌫

Article ~~12~~19

⌦ Absence of genuine use as ⌫ ~~G~~grounds ~~for revocation~~

↓ 2008/95/EC

1. A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

↓ 2008/95/EC (adapted)

2. ~~However, n~~No person may claim that the proprietor's rights in a trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed.

↓ 2008/95/EC

3. The commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

↓ 2008/95/EC (adapted)

Article 20

⌦ Development into a common name or misleading indication as grounds for revocation ⌫

~~2. Without prejudice to paragraph 1,~~ ~~a~~ A trade mark shall be liable to revocation if, after the date on which it was registered:

↓ 2008/95/EC

(a) in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered;

(b) in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Article ~~13~~21

↓ 2008/95/EC (adapted)

~~Grounds for refusal or~~ ~~r~~Revocation ~~or invalidity~~ relating to only some of the goods or services

Where grounds ~~for refusal of registration or~~ for revocation ~~or invalidity~~ of a trade mark exist in respect of only some of the goods or services for which that trade mark has been ~~applied for or~~ registered, ~~refusal of registration or~~ revocation ~~or invalidity~~ shall cover those goods or services only.

⇩ new

SECTION 5

TRADE MARKS AS OBJECTS OF PROPERTY

Article 22

Transfer of registered trade marks

1. A trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.

2. A transfer of the whole of the undertaking shall include the transfer of the trade mark except where there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

3. Without prejudice to paragraph 2, an assignment of the trade mark shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

4. On request of one of the parties a transfer shall be entered in the register and published.

5. As long as the transfer has not been entered in the register, the successor in title may not invoke the rights arising from the registration of the trade mark against third parties.

6. Where there are time limits to be observed vis-à-vis the office, the successor in title may make the corresponding statements to the office once the request for registration of the transfer has been received by the office.

Article 23

Rights in rem

1. A trade mark may, independently of the undertaking, be given as security or be the subject of rights in rem.

2. On request of one of the parties, the rights referred to in paragraph 1 shall be entered in the register and published.

Article 24

Levy of execution

1. A trade mark may be levied in execution.

2. On request of one of the parties, levy of execution shall be entered in the register and published.

Article 25

Insolvency proceedings

Where a trade mark is involved in insolvency proceedings, on request of the competent authority an entry to this effect shall be made in the register and published.

↓ 2008/95/EC

Article ~~8~~26

Licensing

1. A trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Member State concerned. A licence may be exclusive or non-exclusive.

2. The proprietor of a trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to:

(a) its duration;

(b) the form covered by the registration in which the trade mark may be used;

(c) the scope of the goods or services for which the licence is granted;

(d) the territory in which the trade mark may be affixed; or

(e) the quality of the goods manufactured or of the services provided by the licensee.

⇩ new

3. Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a trade mark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

4. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor of the trade mark.

5. On request of one of the parties the grant or transfer of a licence in respect of a trade mark shall be entered in the register and published.

Article 27

The application for a trade mark as an object of property

Articles 22 to 26 shall apply to applications for trade marks.

SECTION 6

GUARANTEE MARKS, CERTIFICATION MARKS AND COLLECTIVE MARKS

Article 28

Definitions

For the purposes of this section, the following shall apply:

(1) 'Guarantee or certification mark' means a 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 geographical origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods and services which are not so certified;

(2) 'Collective mark' means a trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of an association which is the proprietor of the mark from the goods or services of other undertakings.

↓ 2008/95/EC (adapted)

Article ~~15~~29

~~Special provisions in respect of collective marks,~~ ~~g~~Guarantee marks and certification marks

⌦ 1. Member States may provide for the registration of guarantee or certification marks. ⌫

~~1~~2. ~~Without prejudice to Article 4,~~ Member States ~~whose laws authorise the registration of collective marks or of guarantee or certification marks~~ may provide that ~~such~~ ⌦ guarantee or certification ⌫ marks shall not be registered, or shall be revoked or declared invalid, on grounds ~~additional to~~ ⌦ other than ⌫ those specified in Articles 3 ⌦ ,19 ⌫ and ~~12~~ 20 where the function of those marks so requires.

~~2~~3. ~~By way of derogation from Article 3(1)(c), Member States may provide that~~ ⌦ A guarantee or certification mark consisting of ⌫ signs or indications which may serve, in trade, to designate the geographical origin of the goods or services ~~may constitute collective, guarantee or certification marks. Such a mark does~~ ⌦ shall ⌫ not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters~~:~~. ~~I~~In

particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

Article 30

⌦ Collective marks ⌫

⇩ new

1. Member States shall provide for the registration of collective marks.

2. Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for collective marks.

3. By way of derogation from Article 4(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective marks.

🡻 2008/95/EC (adapted)

⌦ A collective mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name. ⌫

⇩ new

Article 31

Regulations governing use of the collective mark

1. An applicant for a collective mark shall submit the regulations governing its use.

2. The regulations governing use shall specify the persons authorised to use the mark, the conditions of membership of the association and the conditions of use of the mark, including sanctions. The regulations governing use of a mark referred to in Article 30(3) shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark.

Article 32

Refusal of the application

1. In addition to the grounds for refusal of a trade mark application provided for in Articles 4 and 5, an application for a collective mark shall be refused where the provisions of Articles 28(2), 30 or 31 are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

2. An application for a collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

3. An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

Article 33

Use of collective marks

The requirements of Article 16 shall be satisfied where genuine use of a collective mark in accordance with Article 16 is made by any person who has authority to use it.

Article 34

Amendment to the regulations governing use of the collective mark

1. The proprietor of a collective mark shall submit to the office any amended regulations governing use.

2. The amendment shall be mentioned in the register unless the amended regulations do not satisfy the requirements of Article 31 or involve one of the grounds for refusal referred to in Article 32.

3. Article 42(2) shall apply to amended regulations governing use.

4. For the purposes of this Directive, amendments to the regulations governing use shall take effect only from the date of entry of the mention of the amendment in the register.

Article 35

Persons who are entitled to bring an action for infringement

1. Article 26(3) and (4) shall apply to every person who has authority to use a collective mark.

2. The proprietor of a collective mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where those persons have sustained damage in consequence of unauthorised use of the mark.

Article 36

Additional grounds for revocation

In addition to the grounds for revocation provided for in Articles 19 and 20, the rights of the proprietor of a collective mark shall be revoked on application to the office or on the basis of a counterclaim in infringement proceedings on the following grounds:

(a) the proprietor does not take reasonable steps to prevent the mark being used in a manner incompatible with the conditions of use laid down in the regulations governing use, amendments to which have, where appropriate, been mentioned in the register;

(b) the manner in which the mark has been used by authorised persons has caused it to become liable to mislead the public in the manner referred to in Article 32(2);

(c) an amendment to the regulations governing use of the mark has been mentioned in the register in breach of Article 34(2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of that Article.

Article 37

Additional grounds for invalidity

In addition to the grounds for invalidity provided for in Articles 4 and 5, a collective mark which is registered in breach of the provisions of Article 32 shall be declared invalid unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of Article 32.

Chapter 3

Procedures

SECTION 1

APPLICATION AND REGISTRATION

Article 38

Conditions with which applications must comply

1. An application for registration of a trade mark shall contain:

(a) a request for the registration,

(b) information identifying the applicant,

(c) a list of the goods or services in respect of which the registration is requested,

(d) a representation of the trade mark.

2. The application for a trade mark shall be subject to the payment of an application fee and, where appropriate, one or more class fees.

Article 39

Date of filing

1. The date of filing of a trade mark application shall be the date on which the documents containing the information specified in Article 38 are filed with the office by the applicant.

2. Member States may, in addition, provide that the accordance of the date of filing shall be subject to the payment of the basic application or registration fee.

Article 40

Designation and classification of goods and services

1. The goods and services in respect of which registration is applied for shall be classified in conformity with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (hereinafter referred to as the 'Nice Classification').

2. The goods and services for which the protection is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought. The list of goods and services shall allow each item to be classified in only one class of the Nice Classification. 3. For the purposes of paragraph 2, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision.

4. The office shall reject the application in respect of terms which are unclear or imprecise if the applicant does not suggest an acceptable wording within a period set by the office to that effect. In the interest of clarity and legal certainty, the offices in cooperation with each other shall compile a list reflecting their respective administrative practices with regard to the classification of goods and services.

5. The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.

6. Where the applicant requests registration for more than one class, the goods and services shall be grouped according to the classes of the Nice classification, each group being preceded by the number of the class to which that group of goods or services belongs and presented in the order of the classes.

7. The classification of goods and services shall serve exclusively administrative purposes. Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services shall not

be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

Article 41

Ex officio examination

The offices shall limit their examination *ex officio* of whether a trade mark application is eligible for registration to the absence of the absolute grounds for refusal provided for in Article 4.

Article 42

Observations by third parties

1. Prior to registration of a trade mark, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the office written observations, explaining on which of the grounds listed in Article 4 the trade mark shall not be registered *ex officio*. They shall not be parties to the proceedings before the office.

2. In addition to the grounds referred to in paragraph 1, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the office written observations based on the particular grounds on which the application for a collective mark should be refused under Article 32(1) and (2).

Article 43

Division of applications and registrations

The applicant or proprietor may divide a trade mark application or registration into one or more separate applications or registrations by submitting a declaration to the office.

Article 44

Fees

The registration and renewal of a trade mark shall be subject to an additional fee for each class of goods and services beyond the first class.

SECTION 2

PROCEDURES FOR OPPOSITION, REVOCATION AND INVALIDITY

Article 45

Opposition procedure

1. Member States shall provide for an efficient and expeditious administrative procedure before their offices for opposing the registration of a trade mark application on the grounds provided for in Article 5.

2. The administrative procedure referred to in paragraph 1 shall provide that at least the proprietor of an earlier right referred to in Article 5(2) and (3) shall be able to file a notice of opposition.

3. The parties shall be granted a period of time of at least two months before the opposition proceedings commence in order to negotiate the possibility of an amicable settlement between the opposing party and the applicant.

Article 46

Non-use as defence in opposition proceedings

1. In administrative opposition proceedings, where at the filing date or date of priority of the later trade mark, the period of five years within which the earlier trade mark must have been put to genuine use as provided for in Article 16 had expired, upon request of the applicant the proprietor of the earlier trade mark who has given notice of opposition shall furnish proof that the earlier trade mark has been put to genuine use as provided for in Article 16 during the period of five years preceding the filing date or date of priority of the later trade mark, or that proper reasons for non-use existed. In the absence of proof to this effect the opposition shall be rejected.

2. If the earlier trade mark has been used in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the opposition as provided for in paragraph 1, be deemed to be registered in respect only of that part of the goods or services.

3.. Paragraphs 1 and 2 shall apply where the earlier trade mark is a European trade mark. In such a case, the genuine use of the European trade mark shall be determined in accordance with Article 15 of Regulation (EC) No 207/2009.

Article 47

Procedure for revocation or declaration of invalidity

1. Member States shall provide for an administrative procedure before their offices for revocation or declaration of invalidity of a trade mark.

2. The administrative procedure for revocation shall provide that the trade mark shall be revoked on the grounds provided for in Articles 19 and 20.

3. The administrative procedure for invalidity shall provide that the trade mark shall be declared invalid at least on the following grounds:

(a) the trade mark should not have been registered because it does not comply with the requirements provided for in Article 4;

(b) the trade mark should not have been registered because of the existence of an earlier right within the meaning of Article 5(2) and (3);

4. The administrative procedure shall provide that at least the following shall be able to file an application for revocation or for a declaration of invalidity:

(a) in the case of paragraph 2 and of point (a) of paragraph 3, any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, which under the terms of the law governing it has the capacity to sue in its own name and to be sued;

(b) in the case of point (b) of paragraph 3, the proprietor of an earlier right referred to in Article 5(2) and (3).

Article 48

Non-use as defence in proceedings seeking a declaration of invalidity

1. In administrative proceedings for a declaration of invalidity based on a registered trade mark with an earlier filing date or priority date, if the proprietor of the later trade mark so requests, the proprietor of the earlier trade mark shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use as provided for in Article 16 in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided that the period of five years within which the earlier trade mark must have been put to genuine use has expired at the date of the application for a declaration of invalidity.

2. Where, at the filing date or date of priority of the later trade mark, the period of five years within which the earlier trade mark must have been put to genuine use as provided for in Article 16 had expired, the proprietor of the earlier trade mark shall, in addition to the proof required in paragraph 1, furnish proof that the trade mark has been put to genuine use during the period of five years preceding the filing date or date of priority, or that proper reasons for non-use existed.

3. In the absence of the proofs referred to in paragraphs 1 and 2, the application for a declaration of invalidity on the basis of an earlier trade mark shall be rejected.

4. If the earlier trade mark has been used in accordance with Article 16 in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

5. Paragraphs 1 to 4 shall apply where the earlier trade mark is a European trade mark. In such a case, genuine use of the European trade mark shall be determined in accordance with Article 15 of Regulation (EC) No 207/2009.

Article 49

Consequences of revocation and invalidity

1. A registered trade mark shall be deemed not to have had, as from the date of the application for revocation, the effects specified in this Directive, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

2. A registered trade mark shall be deemed not to have had, as from the outset, the effects specified in this Directive, to the extent that the trade mark has been declared invalid.

SECTION 3

DURATION AND RENEWAL OF REGISTRATION

Article 50

Duration of registration

1. Trade marks shall be registered for a period of 10 years from the date of filing of the application.

2. Registration may be renewed in accordance with Article 51 for further periods of 10 years.

Article 51

Renewal

1. Registration of a trade mark shall be renewed at the request of the proprietor of the trade mark or any person authorised by him, provided that the renewal fees have been paid.

2. The office shall inform the proprietor of the trade mark, and any person having a registered right in respect of the trade mark, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the office.

3. The request for renewal shall be submitted and the renewal fees shall be paid within a period of six months ending on the last day of the month in which protection ends. Failing this, the request may be submitted within a further period of six months following the day referred to in the first sentence. The renewal fees and an additional fee shall be paid within that further period.

4. Where the request is submitted or the fees paid in respect of only some of the goods or services for which the trade mark is registered, registration shall be renewed for those goods or services only.

5. Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be registered and published.

Chapter 4

Administrative cooperation

Article 52

Cooperation in the area of trade mark registration and administration

Member States shall ensure that the offices cooperate with each other and with the Agency in order to promote convergence of practices and tools and achieve coherent results in the examination and registration of trade marks.

Article 53

Cooperation in other areas

Member States shall ensure that the offices cooperate with the Agency in all areas of their activities other than those referred to in Article 52 which are of relevance for the protection of trade marks in the Union.

Chapter 5

Final provisions

↓

Article 54

Transposition

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with Articles 2 to 6, 8 to 14, 16, 17, 18, 22 to 28, and 30 to 53 by 24 months after entry into force of this Directive at the latest. They shall forthwith communicate to the Commission the text of those provisions.

When Member States adopt those provisions, they shall contain a reference to this Directive or be accompanied by such a reference on the occasion of their official publication. They shall also include a statement that references in existing laws, regulations and administrative provisions to the directive repealed by this Directive shall be construed as references to this Directive. Member States shall determine how such reference is to be made and how that statement is to be formulated.

↓ 2008/95/EC (adapted)

~~*Article 16*~~

~~**Communication**~~

2. Member States shall communicate to the Commission the text of the main provisions of national law ~~adopted~~ ⌦ which they adopt ⌫ in the field governed by this Directive.

Article ~~17~~55

Repeal

Directive ~~89/104/EEC~~ ⌦ 2008/95/EC ⌫ ~~,~~ ~~as amended by the Decision listed in Annex I, Part A,~~ is repealed ⌦ with effect from [*day after the date set out in the first subparagraph of Article 54(1) of this Directive*] ⌫ , without prejudice to the obligations of the Member States relating to the time limit for ⌦ the ⌫ transposition into national law of ~~that~~ ⌦ the ⌫ Directive~~,~~ set out in ~~Annex I,~~ Part B of Annex I to Directive 2008/95/EC.

↓ 2008/95/EC

References to the repealed Directive shall be construed as references to this Directive and shall be read in accordance with the correlation table in the Annex ~~II~~.

Article ~~18~~56

Entry into force

↓ 2008/95/EC (adapted)

This Directive shall enter into force on the ⌦ twentieth ⌫ ~~20th~~ day following ⌦ that of ⌫ its publication in the *Official Journal of the European Union*.

↓

Articles 1, 7, 15, 19, 20, 21 and 54 to 57 shall apply from [*day after the date set out in the first subparagraph of Article 54(1) of this Directive*].'

↓ 2008/95/EC

Article ~~19~~57

Addressees

This Directive is addressed to the Member States.

Done at Brussels,

For the European Parliament	*For the Council*
The President	*The President*

↓ 2008/95/EC (adapted)

~~ANNEX I~~

~~PART A~~

~~Repealed Directive with its amendment~~	
~~(referred to in Article 17)~~	
~~Council Directive 89/104/EEC~~	~~(OJ L 40, 11.2.1989, p. 1)~~
~~Council Decision 92/10/EEC~~	~~(OJ L 6, 11.1.1992, p. 35)~~

~~PART B~~

~~Time limit for transposition into national law~~	
~~(referred to in Article 17)~~	
~~Directive~~	~~Time limit for transposition~~
~~89/104/EEC~~	~~31 December 1992~~

↓ 2008/95/EC (adapted)

~~ANNEX II~~

~~Correlation table~~	
~~Directive 89/104/EEC~~	~~This Directive~~
~~Article 1~~	~~Article 1~~
~~Article 2~~	~~Article 2~~
~~Article 3(1)(a) to (d)~~	~~Article 3(1)(a) to (d)~~
~~Article 3(1)(e), introductory wording~~	~~Article 3(1)(e), introductory wording~~
~~Article 3(1)(e), first indent~~	~~Article 3(1)(e)(i)~~
~~Article 3(1)(e), second indent~~	~~Article 3(1)(e)(ii)~~
~~Article 3(1)(e), third indent~~	~~Article 3(1)(e)(iii)~~
~~Article 3(1)(f), (g) and (h)~~	~~Article 3(1)(f), (g) and (h)~~
~~Article 3(2), (3) and (4)~~	~~Article 3(2), (3) and (4)~~
~~Article 4~~	~~Article 4~~
~~Article 5~~	~~Article 5~~
~~Article 6~~	~~Article 6~~
~~Article 7~~	~~Article 7~~
~~Article 8~~	~~Article 8~~
~~Article 9~~	~~Article 9~~
~~Article 10(1)~~	~~Article 10(1), first subparagraph~~
~~Article 10(2)~~	~~Article 10(1), second subparagraph~~
~~Article 10(3)~~	~~Article 10(2)~~
~~Article 10(4)~~	~~Article 10(3)~~
~~Article 11~~	~~Article 11~~
~~Article 12(1), first sentence~~	~~Article 12(1), first subparagraph~~

~~Article 12(1), second sentence~~	~~Article 12(1), second subparagraph~~
~~Article 12(1), third sentence~~	~~Article 12(1), third subparagraph~~
~~Article 12(2)~~	~~Article 12(2)~~
~~Article 13~~	~~Article 13~~
~~Article 14~~	~~Article 14~~
~~Article 15~~	~~Article 15~~
~~Article 16(1) and (2)~~	~~—~~
~~Article 16(3)~~	~~Article 16~~
~~—~~	~~Article 17~~
~~—~~	~~Article 18~~
~~Article 17~~	~~Article 19~~
~~—~~	~~Annex I~~
~~—~~	~~Annex II~~

↑

ANNEX

CORRELATION TABLE

Directive 2008/95/EC	This Directive
Article 1	Article 1
---	Article 2
Article 2	Article 3
Article 3(1)(a) to (h)	Article 4(1)(a) to (h)
---	Article 4(1)(i) and (j)
---	Article 4(2) and (3), first sentence
Article 3(2)(a) to (c)	Article 4(4)(a) to (c)
Article 3(2)(d)	Article 4(3), second sentence
Article 3(3), first sentence	Article 4(5)
Article 3(3), second sentence	Article 4(6)
Article 4(1) and (2)	Article 5(1) and (2)
Article 4(3) and (4)(a)	Article 5(3)(a)
---	Article 5(3)(b)
Article 4(4)(g)	Article 5(3)(c)
---	Article 5(3)(d)
Article 4(4)(b) and (c)	Article 5(4)(a) and (b)
Article 4(4)(d) to (f)	---
Article 4(5) and (6)	Article 5(5) and (6)
---	Article 8
Article 5(1), first introductory sentence	Article 10(1)
Article 5(1), second introductory sentence	Article 10(2), introductory sentence

Article 5(1)(a) and (b)	Article 10(2)(a) and (b)
Article 5(2)	Article 10(2)
Article 5(3)(a) to (c)	Article 10(3)(a) to (c)
---	Article 10(3)(d)
Article 5(3)(d)	Article 10(3)(e)
---	Article 10(3)(f)
---	Article 10(4) and (5)
Article 5(4) and (5)	Article 10(6) and (7)
---	Article 11
---	Article 12
---	Article 13
Article 6(1)(a) to (c)	Article 14(1)(a) to (c)
---	Article 14(2)
Article 6(2)	Article 14(3)
Article 7	Article 15
Article 8(1) and (2)	Article 26(1) and (2)
---	Article 26(3) to (5)
Article 9	Article 9
Article 10(1), first subparagraph	Article 16(1)
---	Article 16(2) and (3)
Article 10(1), second subparagraph	Article 10(4)
Article 10(2)	Article 10(5)
Article 10(3)	---
Article 11(1)	Article 48(1) to (3)
Article 11(2)	Article 46(1)
Article 11(3)	Article 17
Article 11(4)	Articles 17, 46(2) and Article 48(4)

---	Article 18
Article 12(1), first subparagraph	Article 19(1)
Article 12(1), second subparagraph	Article 19(2)
Article 12(1), third subparagraph	Article 19(3)
Article 12(2)	Article 20
Article 13	Article 7 and Article 21
Article 14	Article 6
---	Articles 22 to 25
---	Article 27
---	Article 28
Article 15(1)	29(1) and (2)
Article 15(2)	Article 29(3)
---	Articles 30 to 54(1)
Article 16	Article 54(2)
Article 17	Article 55
Article 18	Article 56
Article 19	Article 57