

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

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

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

The recast of the Directive has the following objectives:

- modernising and improving the existing provisions of the Directive, by increasing legal certainty and clarifying trade mark rights in terms of their scope and limitations;
- achieving greater approximation of national trade mark laws and procedures with the aim of making them more consistent with the Community trade mark system;
- facilitating cooperation between the offices of the Member States and the Office for Harmonisation in the Internal Market (Trade marks and Designs) (OHIM).

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

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

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

- **lists examples of signs which are capable of constituting a trade mark**, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. The sign should be capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. A sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect;
- **list the grounds for refusal or invalidity concerning the trade mark itself in an exhaustive manner**, including the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights.

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

- preservation of the right of Member States to decide whether to conduct examinations for refusal on relative grounds ex officio;
- introduction of an explicit provision ensuring that trade mark rights cannot be invoked against prior rights on the mark;
- extension of trade mark protection to cover the use of the mark in trade or company names;

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