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**NOTE**

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From:	General Secretariat of the Council
To:	Permanent Representatives Committee
No. prev. doc.:	11490/14 PI 90 CODEC 1558
No. Cion doc.:	8066/13 PI 52 CODEC 711
Subject:	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) - Presidency compromise proposal

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Delegations will find in the Annex a Presidency compromise proposal on the above-mentioned Directive, for discussion at the Coreper meeting on 23 July 2014.

Changes in relation to the previous version (11490/14) are highlighted. Delegations' positions are set out in footnotes.

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)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,  
Having regard to the Treaty on the Functioning of the European Union , and in particular  
Article 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<sup>1</sup>,  
Acting in accordance with the ordinary legislative procedure,

Whereas:

- (1) A number of amendments should be made to Directive 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<sup>2</sup>. In the interests of clarity, that Directive should be recast.

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<sup>1</sup> OJ C 327, 12.11.2013, p. 42.

<sup>2</sup> OJ L 299, 8.11.2008, p. 25.

- (2) Directive 2008/95/EC has harmonised central provisions of substantive trade mark law 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.
- (3) Trade mark protection in the Member States coexists with protection available at Union level through European Union 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 Union trade mark<sup>3</sup>. Coexistence and balance 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<sup>4</sup>, 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.

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<sup>3</sup> OJ L 78, 24.3.2009, p.1.

<sup>4</sup> COM(2008) 465.

- (5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union<sup>5</sup>, 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 Regulation (EC) No 207/2009 and would thus reduce the areas of divergence within the trade mark system in Europe as a whole and maintain national trade mark protection as an option for applicants.
- (6) The Commission concluded in its Communication ‘A Single Market for Intellectual Property Rights’ of 24 May 2011<sup>6</sup> 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) *Deleted*

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<sup>5</sup> OJ C 140, 29.5.2010, p. 22.

<sup>6</sup> COM(2011) 287.

- (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 to the benefit of growth and competitiveness of European businesses, in particular small and medium enterprises, it is necessary to go beyond the limited scope of approximation achieved by Directive 2008/95/EC and extend approximation to other 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 Union trade mark system 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. In line with the extensive protection granted to European Union 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.
- (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 their relationship with trade marks acquired by registration.
- (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 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.
- (14) Furthermore, the grounds for refusal or invalidity concerning the trade mark itself, including the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights, 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.

- (15) In order to ensure that the levels of protection afforded to geographical indications by Union and national law are applied in a uniform and exhaustive manner in the examination of absolute and relative grounds for refusal throughout the Union, this Directive should include the same provisions in relation to geographical indications as contained in Regulation (EC) No 207/2009. It is further appropriate to ensure that the scope of absolute grounds is extended to cover also protected traditional terms for wine and traditional specialities guaranteed.
- (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.

- (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')<sup>7</sup>.
- (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. Use of the sign for purposes other than for distinguishing goods or services should be subject to the provisions of national law.

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<sup>7</sup> OJ L 336, 23.12.1994, p. 213.

(19) Deleted

(20) Infringement of a trade mark should also comprise the use of the sign as a trade name or similar designation, or as a domain name, as long as the use is made for the purposes of distinguishing goods or services

(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<sup>8</sup>.

(21a) In order to more effectively prevent the entry of infringing goods, particularly in the context of counterfeit sales over the Internet, the proprietor of a registered trade mark should be entitled to prohibit the importing of such goods into the Member State where the trade mark is registered where it is only the consignor of the goods who acts in the course of trade. However, if the addressee of such goods (e.g. the consumer) does not act in the course of trade, he shall not be considered as an infringer of the proprietor's rights.<sup>9</sup>

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<sup>8</sup> OJ L 376, 27.12.2006, p. 21.

<sup>9</sup> FR : delete last sentence of recital 21a.

- (22) With the aim of strengthening trade mark protection and combating counterfeiting more effectively and in line with international obligations of the Member State under the WTO framework, in particular Article V of the GATT on freedom of transit and, as regards generic medicines, the ‘Declaration on the TRIPS Agreement and Public Health’ adopted by the Doha WTO Ministerial Conference on 14 November 2001, the proprietor of a trade mark should be entitled to prevent third parties from bringing goods, in the course of trade, into the Member State where the trade mark is registered 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.
- (22a) To this effect, it should be permitted to prevent the entry of infringing goods and their placement in all customs situations, including, in particular transit, transshipment, warehousing, temporary storage, inward processing or temporary admission, also when these goods are not intended to be placed on the market of the Member State concerned. In performing the controls, the customs authorities should make use of the powers and procedures laid down in the Regulation (EU) No 608/2013, concerning customs enforcement of intellectual property rights<sup>10</sup>, also at the request of the right holders. In particular, the customs authorities should carry out the relevant controls on the basis of risk analysis criteria.

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<sup>10</sup> OJ L 181, 29.6.2013, p. 15.

(22b) In order to reconcile the need to ensure the effective enforcement trade mark rights with the necessity to avoid hampering the free flow of trade in legitimate goods, the entitlement of the proprietor of the trade mark should lapse where, during the subsequent proceedings initiated before the judicial or other authority competent to take a substantive decision on whether the registered trade mark has been infringed, the declarant or the holder of the goods is able to prove that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market [...] in the country of final destination.

(23) *Deleted.*

(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 necessary use of descriptive or non-distinctive signs or indications in general. Furthermore, 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.
- (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.
- (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 or a trade mark registered under international arrangements having effect in the Member State has been claimed for a European Union trade mark and the mark providing the basis for the seniority claim has thereafter been surrendered or allowed to lapse, the validity of that mark may still be challenged. The challenge should be limited to situations where the 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 to the extent appropriate with those already in place for European Union trade marks, and should include rules on assignment and transfer, licensing, rights in rem and levy of execution.
- (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 Union 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. All the central industrial property offices of the Member States and the Benelux Office for Intellectual Property should undertake examination ex officio of whether a trade mark application is eligible for registration considering absolute grounds for refusal. Without prejudice to the need to provide for an opposition procedure, the offices may also undertake examination ex officio of whether a trademark application is eligible for registration considering the relative grounds for refusal or provide searches and notifications with regard to for earlier rights on a purely informative basis. Those searches and notifications shall not have 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 Union 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. In the interest of clarity and legal certainty, the offices in cooperation with each other should endeavour to compile a list reflecting their respective administrative practices with regard to the classification of goods and services.



- (36) For the purpose of ensuring effective trade mark protection, Member States should make available an efficient administrative opposition procedure, allowing at least the proprietor of earlier trade mark rights and the beneficiary of a protected geographic indication 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 a judicial or an administrative procedure for revocation or declaration of invalidity. [...]
- (37) It is desirable that Member States' central industrial property offices and the Benelux Office for Intellectual Property cooperate with each other and with the Office for Harmonisation in the Internal Market ("the OHIM") 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 Member States should further ensure that their offices cooperate with each other and with the OHIM in all other areas of their activities which are relevant for the protection of trade marks in the Union.
- (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.

- (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 351 of the Treaty should apply.
- (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.
- (41) Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995 on the protection of individuals with regard to the processing of personal data and on the free movement of such data<sup>11</sup> governs the processing of personal data carried out in the Member States in the context of this Directive.

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<sup>11</sup> OJ L 281, 23.11.1995, p. 31.

(41a) The European Data Protection Supervisor was consulted in accordance with Article 28(2) of Regulation (EC) N° 45/2001 of the European Parliament and of the Council of 18 December 2000 on the protection of individuals with regard to the processing of personal data by the Community institutions and bodies and on the free movement of such data<sup>12</sup> and delivered an opinion on 11 July 2013.

(42) 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 set out in Part B of Annex I to Directive 2008/95/EC.

HAVE ADOPTED THIS DIRECTIVE:

## **Chapter 1**

### **General provisions**

#### *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.

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<sup>12</sup> OJ L 8, 12.1.2001, p.1.

*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) ‘OHIM’ means the Office for Harmonisation in the Internal Market (trade marks and designs) as established by Article 2 of Regulation (EC) No 207/2009;
- (c) ‘register’ means the register of trade marks kept by an office.

## **Chapter 2**

### **The law on trade marks**

#### **Section 1**

#### **Signs of which a trade mark may consist**

##### *Article 3*

##### ***Signs of which a trade mark may consist***

A trade mark may consist of any signs , in particular words, including personal names, designs, letters, numerals, colours, 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
- and
- (b) being represented on the register in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.

## Section 2

### Grounds for refusal or invalidity

#### *Article 4*

#### *Absolute grounds for refusal or invalidity*

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;<sup>13</sup>

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<sup>13</sup> ES: move point (d) to Article 45.

- (e) signs which consist exclusively of::
- (i) the shape or another characteristic which results from the nature of the goods themselves;
  - (ii) the shape or another characteristic of goods which is necessary to obtain a technical result;
  - (iii) the shape or another characteristic which gives substantial value to the goods;<sup>14 15</sup>
- (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’;

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<sup>14</sup> IE, HR, SI, : replace point (e) by the following :  
"signs of which the essential elements:

- (i) result from the nature of the goods themselves;
- (ii) are necessary to obtain a technical result;
- (iii) give substantial value to the goods;"

<sup>15</sup> DK : delete " or another characteristic" in all (i) to (iii)

- (i) trade marks which are excluded from registration pursuant to Union legislation, national legislation in the Member State concerned, or international agreements to which the Union or the Member State concerned 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<sup>16</sup> traditional terms for wine;<sup>17</sup>
- (ja) 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 specialities guaranteed;<sup>18</sup>
- (k) trade marks which consist of, or reproduce in its essential elements an earlier plant variety denomination registered in accordance with Union or national legislation providing protection for plant variety rights and are in respect to plant varieties of the same or related species.<sup>19 20</sup>

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<sup>16</sup> PL : insert "spirit drinks,".

<sup>17</sup> HU, HR : replace point (j) by the following :  
"trade marks which are excluded from registration pursuant to Union legislation, national legislation in the Member State concerned, or international agreements to which the Union or the Member State concerned is party, providing for protection of traditional terms for wine;".

<sup>18</sup> HU, HR: delete point (ja).

<sup>19</sup> IE, NL, SE, BE, ES, UK, SI: point (k) should be moved to Article 5.

<sup>20</sup> HU : replace by "with respect to the same type of product".



2. Deleted.
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.
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:
  - (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 ;
  - (b) the trade mark includes 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.

5. A trade mark shall not be refused registration in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration, following use which has been made of it, it has acquired a distinctive character. A trade mark shall not be declared invalid for the same reasons if, before the date of application for a declaration of invalidity, following use which has been made of it, it has acquired a distinctive character.
6. Any Member State may provide that paragraph 5 shall also apply where the distinctive character was acquired after the date of application for registration and before the date of registration.<sup>21</sup>

#### *Article 5*

#### ***Relative grounds for refusal or invalidity***

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;

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<sup>21</sup> SE, FI: Add "Member States may also provide that paragraph 5 shall apply where the distinctive character was acquired after the date of application for declaration of invalidity and before the date of declaration of invalidity".

- (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;
  - (i) European Union trade marks;
  - (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;
- (b) European Union trade marks which validly claim seniority, in accordance with Regulation (EC) No 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;

- (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 the Member State, in the sense in which the words ‘well known’ are used in Article 6 *bis* of the Paris Convention.

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

- (a) if it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or 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 or, in case of a European Union trade mark, has a reputation in the Union and 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) 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) *moved to paragraph 4* <sup>22</sup>

(d) where and to the extent that, pursuant to Union legislation or the law of the Member State concerned providing for protection of designations of origin and geographical indications :

(i) an application for a designation of origin or a geographical indication had already been submitted according to Union legislation or the law of the Member State concerned prior to the date of application for registration of the trade mark or the date of the priority claimed for the application, subject to its subsequent registration;

(ii) that designation of origin or geographical indication confers on its beneficiary the right to prohibit the use of a subsequent trade mark.

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:

(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;

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<sup>22</sup> UK against moving (c) to the optional list.

(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 (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.

(ba) where the trade mark is liable to be confused with an earlier trade mark protected abroad<sup>23</sup>, provided that, at the date of the application, the applicant was acting in bad faith.';

(c) Deleted

(d) Deleted

(e) Deleted

(f) Deleted.<sup>24</sup>

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.

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<sup>23</sup> LV, ES : delete "protected abroad".

<sup>24</sup> BE : bring back points (c) to (f).

6. Any Member State may provide that, by derogation from paragraphs 1 to 5, the grounds for 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 6*

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

Where the seniority of a national trade mark or of a trade mark registered under international arrangements having effect in the Member State which has been surrendered or allowed to lapse is claimed for a European Union trade mark, the invalidity or revocation of the trade mark providing the basis for the seniority claim may be established *a posteriori* , provided that the invalidity or revocation could 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.

*Article 8*

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

An application for a declaration of invalidity on the basis of an earlier mark shall not succeed at the date of application for invalidation if it would not have been successful at the filing date or the priority date of the later trade mark for any of the following reasons:

- (a) the earlier trade mark, liable to be declared invalid pursuant to Article 4(1)(b), (c) or (d), had not yet acquired a distinctive character in accordance with Article 4(5);
- (b) the application for a declaration of invalidity is based on Article 5(1)(b) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of Article 5(1)(b) ;
- (c) the application for a declaration of invalidity is based on Article 5(3)(a) and the earlier trade mark had not yet acquired reputation within the meaning of Article 5(3)(a).



## *Article 9*

### ***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 5(2) and (3)(a) <sup>25</sup> 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 to apply for a declaration that the later trade mark is invalid 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 to the proprietor of any other earlier right referred to in Article 5(4)(a) or (b).
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.

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<sup>25</sup> ES: insert: "and (b)".

### **Section 3**

#### **Rights conferred and limitations**

##### *Article 10*

##### ***Rights conferred by a trade mark***

1. The registration of a trade mark shall confer on the proprietor exclusive rights .
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, 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) the sign 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;
  - (b) the sign is identical, or similar to, the trade mark and is used for goods or services which are identical with or similar to the goods or services for which the trade mark is registered, 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;

- (c) the sign 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.

3. The following, in particular, may be prohibited under paragraph 2:

- (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;
- (d) using the sign as a trade or company name, or as a domain name, or as a part thereof;
- (e) using the sign on business papers and in advertising;
- (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) into a Member State in which the trade mark is registered where only the consignor of the goods acts in the course of trade. <sup>26</sup>
5. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of a registered trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into 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.

The entitlement of the trade mark proprietor pursuant to the first subparagraph shall lapse if during the proceedings to determine whether the registered trade mark has been infringed, initiated in accordance with the provisions of Regulation (EU) No 608/2013 concerning customs enforcement of intellectual property rights<sup>27</sup>, evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market [...] in the country of final destination.

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<sup>26</sup> UK, HR, DK, AT, BE, NL: add "unless those goods were manufactured with the express authorisation of the proprietor of that mark and are for the personal use of the intended recipient."

<sup>27</sup> OJ L 181, 29.6.2013, p. 15.

6. Where, under the law of a Member State, the use of a sign under the conditions referred to in paragraph 2, point (b) or (c) 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.
7. Paragraphs 1,2,3 and 6 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.

*Article 11*

***The right to prohibit preparatory acts in relation to the use of packaging or other means***

Where the risk exists<sup>28</sup> that the packaging, labels, tags, security or authenticity features or devices or any other means to which the trade 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 acts when they are carried out in the course of trade <sup>29</sup>:

- (a) affixing a sign identical with or similar to the trade mark on packaging, labels, tags, security or authenticity features or devices or any 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, packaging, labels, tags, security or authenticity features or devices or any other means on which the mark is affixed.

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<sup>28</sup> NL : replace by "Where it is likely...".

<sup>29</sup> SE, FI : replace the introductory sentence by the following :  
"The proprietor shall have the right to prohibit the following preparatory acts in relation to the get-up, packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed provided that the use in relation to goods or services would constitute an infringement of the rights of the proprietor under Article 10(2) and (3):"

*Article 12*

***Reproduction of trade marks in dictionaries***

If the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work in print or electronic form 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 is, without delay, and in case of works in printed form at the latest in the next edition of the publication, 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 or both of the following:
  - (a) to oppose the use of his trade mark by his agent or representative;
  - (b) to demand the assignment of the trade mark in his favour.
2. Paragraph 1 shall not apply where the agent or representative justifies his action.

*Article 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:
  - (a) where the third party is a natural person,<sup>30</sup> his own full name or surname or address;
  - (b) signs or indications which are not distinctive or which concern 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 where that is necessary for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

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<sup>30</sup> SE, FI: delete " where the third party is a natural person".



2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters. 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 is done in a manner that gives the false 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.
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 15*

***Exhaustion of the rights conferred by a trade mark***

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 Union under that trade mark by the proprietor or with the proprietor's consent.
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.

*Article 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), unless there are proper reasons for non-use.

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, from the date when a decision terminating the opposition proceedings became final or the opposition was withdrawn.
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 or when an objection on absolute or relative grounds has been notified, the period shall be calculated from the date when a decision terminating the opposition proceedings or ruling on absolute or relative grounds for refusal became final or the opposition was withdrawn.
4. The following shall also constitute use within the meaning of paragraph 1:
  - (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.

5. Use of the trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

*Article 17*

***Non-use as defence in infringement proceedings***

<sup>31</sup>The proprietor of a trade mark shall be entitled to prohibit the use of a sign only to the extent that the proprietor's rights are not liable to be revoked pursuant to Article 19 at the time the infringement action is brought. If the defendant so requests, the proprietor of the trade mark shall furnish proof that, during the period of five years preceding the date of bringing the action the trade mark has been put to genuine use as provided in Article 16 in connection with the goods or services in respect of which it is registered and which is cited as justification for the action, or that there are proper reasons for non-use, provided that the registration procedure of the trade mark has at the date of bringing the action been completed for not less than five years.

*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 would not be declared invalid pursuant to Articles 8, 9(1) and (2) and 48(3).

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<sup>31</sup> PL, SE, SI : insert "Member States may provide that..."

2. In infringement proceedings, the proprietor of a trade mark shall not be entitled to prohibit the use of a later registered European Union trade mark where that later trade mark would 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 is not 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.

## **Section 4**

### **Revocation of trade mark rights**

#### *Article 19*

#### ***Absence of genuine use as ground for revocation***

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.

2. 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.
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.

*Article 20*

***Trade mark having become generic or misleading indication as grounds for revocation***

A trade mark shall be liable to revocation if, after the date on which it was registered:

- (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 the proprietor's 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 21*

***Revocation relating to only some of the goods or services***

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

**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. Deleted.
4. Member States shall have procedures in place to allow for the recordal of transfers in their registers.
5. Deleted.
6. Deleted.

*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. Member States shall have procedures in place to allow for the recordal of rights in rem in their registers.

*Article 24*

***Levy of execution***

1. A trade mark may be levied in execution.
2. Member States shall have procedures in place to allow for the recordal of levy of execution in their registers.



*Article 25*  
***Insolvency proceedings***

Deleted.

*Article 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.
3. Deleted.
4. Deleted.

5. Member States shall have procedures in place to allow for the recordal of licences in their registers.

*Article 27*

***The application for a trade mark as an object of property***

Articles 22 to 26 shall<sup>32</sup> 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<sup>33</sup> material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods and services which are not so certified;

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<sup>32</sup> FI : render Art. 27 optional for Member States.

<sup>33</sup> UK, IE, ES : re-insert "geographical origin,"

- (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.

*Article 29*

***Guarantee or certification marks***

1. Member States may provide for the registration of guarantee or certification marks.
  - 1a. Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for guarantee or certification marks provided that the person does not carry on a business involving the supply of goods or services of the kind certified.

Member States may provide that a certification mark shall not be registered unless the applicant is competent to certify the goods or services for which the mark is to be registered.

2. Member States may provide that guarantee or certification marks shall not be registered, or shall be revoked or declared invalid, on grounds other than those specified in Articles 3 ,19 and 20 where the function of those marks so requires.

3. By way of derogation from Article 4(1)(c), Member States may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute guarantee or certification marks. Such a guarantee or certification 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.<sup>34</sup>
4. The requirements of Article 16 shall be satisfied where genuine use of a guarantee or certification mark in accordance with Article 16 is made by any person who has authority to use it.

#### *Article 30*

#### ***Collective marks***

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 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.<sup>35</sup>

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<sup>34</sup> HU, FI : delete paragraph 3.

<sup>35</sup> FR, FI : against limiting the circle of potential proprietors of collective marks.

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

#### *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 at least 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, provided that the person fulfills all the other conditions of the regulations.

*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, where appropriate, with the exception of Art. 4(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services<sup>36</sup> and without prejudice to the right of an office not to undertake examination ex officio of relative grounds pursuant to Article 41(2), 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.<sup>37</sup>
2. Deleted.
3. An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraph 1.

*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.

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<sup>36</sup> FR, FI: delete " with the exception of Art. 4(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services ".

<sup>37</sup> FR, FI : against requiring national offices to control the legality of the regulations governing use.

*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. Deleted.
4. Deleted.

*Article 35*

***Persons who are entitled to bring an action for infringement***

1. Without prejudice to the regulations governing use, any person authorised to use the collective mark may bring infringement proceedings only if its proprietor consents thereto. Any person authorised to use the collective mark 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 collective mark.<sup>38</sup>

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<sup>38</sup> SE, IE: delete Article 35 (1) for the same reasons for which Articles 26(3) and 26(4) were deleted.

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 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, including any amendment thereof mentioned in the register;
- (b) Deleted.
- (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, where appropriate, with the exception of Art. 4(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services<sup>39</sup>, 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 at least:
  - (a) a request for the registration,

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<sup>39</sup> HU, FR, FI: delete: "with the exception of Art. 4(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services "

- (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, which satisfies the requirements set out in Article 3(b).<sup>40</sup>

2. The application for a trade mark shall be subject to the payment of any fee determined by the Member State concerned.

### *Article 39*

#### ***Date of filing***

1. The date of filing of a trade mark application shall be the date on which the application containing the information specified in Article 38(1) is 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 a fee referred to in Article 38(2).<sup>41 42</sup>

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<sup>40</sup> DK : delete " which satisfies the requirements set out in Article 3(b)".

<sup>41</sup> DE, DK, AT, HU: delete paragraph 2.

<sup>42</sup> DK : replace Art. 39 by the following:

"The date of filing of a trade mark application shall be the date on which documents containing the following information are filed with the office by the applicant:

- (i) indications allowing the identity of the applicant to be established;
- (ii) a sufficiently clear representation of the mark whose registration is sought;
- (iii) the list of the goods and/or services for which the registration is sought."

*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.
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.

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 applicant shall group the goods and services 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. 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***

1. The offices shall undertake examination *ex officio* of whether a trade mark application is eligible for registration considering the absolute grounds for refusal provided for in Article 4.

2. Without prejudice of paragraph 1, the offices may also undertake examination *ex officio* of whether a trade mark application is eligible for registration considering the relative grounds for refusal provided for in Article 5.
3. The offices may also provide for searches and notifications with regard to earlier rights within the meaning of Article 5 on a purely informative basis<sup>43</sup>. Such searches and notifications shall not have binding effect on the further registration process, including on subsequent opposition proceedings.

#### *Article 42*

#### ***Observations by third parties***

1. Member States may provide that 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<sup>44</sup> observations, explaining on which grounds the trade mark should 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). This provision may be extended to cover certification and guarantee marks where regulated in Member States.

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<sup>43</sup> HU: delete: "on a purely informative basis."

<sup>44</sup> SE : delete "written", otherwise delete whole Art. 42.

*Article 43*

***Division of applications and registrations***

The applicant or proprietor may divide a national trade mark application or registration into two or more separate applications or registrations by sending a request to the office and indicating for each divisional application or registration those goods or services of the original application or registration which are to be covered by the divisional applications or registrations.

*Article 44*

***Class fees***

Member States may<sup>45</sup> provide that the application and renewal of a trade mark shall be subject to an additional fee for each class of goods and services beyond the first class.

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<sup>45</sup> FR : replace "may" by "shall".

## SECTION 2

### Procedures for opposition, revocation and invalidity

#### *Article 45*

#### ***Opposition procedure***<sup>46</sup>

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. Any Member State may, in addition, provide that the registration of a trade mark application may be opposed on the grounds provided in Article 4.<sup>47</sup>
2. The administrative procedure referred to in paragraph 1 shall at least provide that the proprietor of an earlier right referred to in Article 5(2) and (3) (a) and (d)<sup>48</sup> shall be able to file a notice of opposition.
3. The parties shall be granted, at their joint request, a minimum of two months in the opposition proceeding in order to explore the possibility of an amicable settlement between the opposing party and the applicant.<sup>49 50</sup>

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<sup>46</sup> EE, NL, MT : delete Articles 45 to 49 or render them optional.

<sup>47</sup> HU: delete second sentence of (1).

<sup>48</sup> AT: delete "and (3)(a) and (d)".

<sup>49</sup> FR: replace paragraph 3 by the following :

"(3) The parties shall be granted, a minimum of two months before the opposition proceeding, unless they jointly request otherwise, in order to negotiate the possibility of an amicable settlement between the opposing party and the applicant."

<sup>50</sup> HU, SE: delete paragraph 3.

*Article 46*

***Non-use as defence in opposition proceedings***

1. In opposition proceedings pursuant to Article 45, 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 <sup>51</sup>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<sup>52</sup>. In the absence of proof to this effect the opposition shall be rejected.<sup>53</sup>
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 also apply where the earlier trade mark is a European Union trade mark. In such a case, the genuine use of the European Union trade mark shall be determined in accordance with Article 15 of Regulation (EC) No 207/2009.

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<sup>51</sup> SE, SK include also reference to Art. 19.

<sup>52</sup> IE: delete "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."

<sup>53</sup> ES, CZ, SI: paragraph 1 should be made optional for Member States.



***Procedure for revocation or declaration of invalidity***

1. Member States shall provide for a judicial procedure or 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).

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

1. In 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<sup>54</sup> in connection with the goods or services in respect of which it is registered and which is cited as justification for the application, or that there are proper reasons for non-use, provided that the registration process of the earlier trade mark has at the date of the application for declaration of invalidity been completed for not less than five years.
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.

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<sup>54</sup> SE, SK: include also reference to Article 19.

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

*Article 49*

***Consequences of revocation and invalidity***<sup>55</sup>

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.<sup>56</sup>
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.

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<sup>55</sup> AT, CZ, SE: delete Article 49.

<sup>56</sup> AT: delete the second sentence of paragraph 1.

### **Section 3**

#### **Duration and renewal of registration<sup>57</sup>**

##### *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<sup>58</sup>.
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 upon request provided that the renewal fees have been paid. Member States may provide that receipt of payment of the renewal fees shall be deemed to constitute such a request.
2. The office shall inform the proprietor of the trade mark of the expiry of the registration at least six months before<sup>59</sup> the said expiry. The office shall not be held liable if it fails to give such information.<sup>60</sup>

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<sup>57</sup> AT, HU : delete the whole Section 3.

<sup>58</sup> EE, AT, SE, PT, FI: replace " filing of the application." with "the registration of the trade mark. ". Alternatively, leave it to MS.

<sup>59</sup> DE, FI: "at least three months after ".

<sup>60</sup> EE, ES, SE, HU : delete paragraph 2.

3. The request for renewal shall be submitted and the renewal fees shall be paid within a period of at least six months before the expiry of the registration. Failing this, the request may be submitted within a further period of six months following the expiry of the registration or of the subsequent renewal thereof. 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 recorded in the register.

## Chapter 4

### Administrative cooperation

#### *Article 52*

#### ***Cooperation in the area of trade mark registration and administration***

Member States shall ensure that the offices may cooperate with each other and with the OHIM in order to promote convergence of practices and tools in relation to the examination and registration of trade marks.<sup>61</sup>

#### *Article 53*

#### ***Cooperation in other areas***

Member States shall ensure that the offices cooperate with each other and the OHIM on a voluntary basis 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.

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<sup>61</sup> IE, FI, FR, UK: replace Art. 52 by the following:  
"Member States shall ensure that the offices cooperate with each other and with the OHIM on a voluntary basis in order to promote convergence of practices and tools in relation to the examination and registration of trade marks."  
IE (*Alternatively*): "Member States shall ensure that the offices [endeavour to] cooperate with each other and with the Office in order to promote convergence of practices and tools in relation to the examination and registration of trade marks."

## **Chapter 5**

### **Final provisions**

#### *Article 53a*

#### ***Data protection***

1. The processing of any personal data carried out in the framework of this Directive shall be subject to national laws implementing Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995 on the protection of individuals with regard to the processing of personal data and on the free movement of such data.
2. Processing of personal data within the context of administrative cooperation referred to in Articles 52 and 53 may be related to additional purposes, such as better performance of existing purposes. Processing of personal data for such purposes should be explicitly justified and respect the purpose limitation principle referred to in Article 6(1)(b) of the Directive 95/46/EC.

#### *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 36 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.

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

#### *Article 55*

#### ***Repeal***

Directive 2008/95/EC 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 the Directive set out in Part B of Annex I to Directive 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 .

Article 56

***Entry into force***

This Directive shall enter into force on the twentieth 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*].’

Article 57

***Addressees***

This Directive is addressed to the Member States.

Done at Brussels,

*For the European Parliament*

*The President*

*For the Council*

*The President*

## 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 18  
Article 19

Article 55  
Article 56  
Article 57