

Adopted text

- Trade mark directive

The following document is an *unofficial* summary of the text adopted by the legal affairs committee (JURI) of the European Parliament from 17 December 2013. The text is intended for informational purposes only and an official version will be issued by the European Parliament.

Citation 1

Text proposed by the Commission

Having regard to the Treaty on the Functioning of the European Union, and in particular Article 114 thereof,

Amendment

Having regard to the Treaty on the Functioning of the European Union, and in particular Article 114(**I**) thereof,

Recital 5

Text proposed by the Commission

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union, 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.

Amendment

(5) In its conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union, 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, ***while maintaining national trade mark protection as an attractive option for applicants. In this context, the complementary relationship between the European Union trade mark system and national trade mark systems should be ensured.***

Recital 10

Text proposed by the Commission

(10) It is fundamental to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States, and that the protection of trade marks at the national level is the same as the protection of European trade marks. In line with the extensive protection granted to European trade marks which have a reputation in the Union, extensive protection should also be granted at national level to all registered trade marks which have a reputation in the Member State concerned.

Amendment

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

(This amendment applies throughout the text. Adopting it will necessitate corresponding changes throughout.)

Recital 13

Text proposed by the Commission

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

Amendment

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Recital 19

Text proposed by the Commission

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

Amendment

deleted

Recital 22

Text proposed by the Commission

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark should be entitled to prevent third parties from bringing goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without ***authorization*** a trade mark which is essentially identical to the trade mark registered in respect of such goods.

Amendment

(22) With the aim of strengthening trade mark protection and combatting counterfeiting more effectively, the proprietor of a registered trade mark, should be entitled to prevent third parties from bringing ***counterfeit*** goods into the customs territory of the Member State without being released for free circulation there, where such goods come from third countries and bear without ***authorisation*** a trade mark which is essentially identical to the trade mark registered in respect of such goods. ***This provision should not harm the interest of legitimate trade with goods that can lawfully be placed on the market in their destination countries. In order not to hamper legitimate flows of goods this provision shall therefore not apply if the third party provides evidence that the final destination of the goods is a country outside the Union and if the proprietor of the trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. In case the country of destination has not yet been determined, the proprietor of the European Union trade mark shall have the right to prevent all third parties from***

re-bringing the goods out of the Union unless the third party provides evidence that the final destination of the goods is a country outside the Union and the proprietor of the trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. This rule should also be without prejudice to the Union's right to promote access to medicines for third countries as well as compliance with WTO rules, notably with GATT Article V on freedom of transit.

Recital 22a

Text proposed by the Commission

Amendment

(18a) The proprietor of a trade mark should be entitled to take relevant legal actions, including inter alia to request national customs authorities to take action in respect of goods which allegedly infringe their rights, such as detention and destruction in accordance with Regulation 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights. Customs authorities shall carry out the relevant procedures laid down in Regulation (EC) 608/2013 at the request of a rightholder and based on risk analysis criteria.

Recital 22b

Text proposed by the Commission

Amendment

(18b) Recalls that pursuant to Article 28 of Regulation (EC) 608/2013 a right holder shall be liable for damages towards the holder of the goods in case, inter alia, the goods in question are subsequently found not to infringe an intellectual property right.

Recital 22c

Text proposed by the Commission

Amendment

Member States should take appropriate measures with regards to ensuring the smooth transit of generic medicines. Therefore a proprietor of a trade mark should not have the right to prevent any third parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State based upon similarities, perceived or actual, between the international non-proprietary name (INN) for the active ingredient in the medicines and a registered trademark.

Recital 23

Text proposed by the Commission

Amendment

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

(23) In order to more effectively prevent the entry of ***counterfeit*** goods, particularly in the context of sale over the ***internet delivered in small consignments as defined by regulation (EC) 608/2013*** the proprietor ***of a validly registered trade mark*** should be entitled to prohibit the importing of such goods into the Union where it is only the consignor of the ***counterfeit*** goods who acts for commercial purposes. ***In cases where such measures are taken Member States should ensure that the individual or entity that had ordered the goods is informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.***

Recital 29

Text proposed by the Commission

(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.

Amendment

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Recital 34

Text proposed by the Commission

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

Amendment

(34) In order to improve and facilitate access to trade mark protection and to increase legal certainty and predictability, the procedure for the registration of trade marks in the Member States should be efficient and transparent and should follow rules similar to those applicable to European trade marks. ***Member States shall be free to decide whether to conduct ex officio examination for refusal on relative grounds.***

Recital 41 a (new)

Text proposed by the Commission

Amendment

(41a) In accordance with the Joint Political Declaration of Member States and the Commission on explanatory documents of 28 September 2011, Member States have undertaken to accompany, in justified cases, the notification of their transposition measures with one or more documents explaining the relationship between the components of a directive and the corresponding parts of national transposition instruments. With regard to this Directive, the legislator considers the transmission of such documents to be justified.

Article 1

Text proposed by the Commission

Amendment

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.

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

Article 2 – point b

Text proposed by the Commission

Amendment

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

(b) ‘Agency’ means the European Union ***Intellectual Property*** Agency established in accordance with Article 2 of Regulation (EC) No 207/2009;

(This amendment applies throughout the text. Adopting it will necessitate corresponding changes throughout.)

Article 2 – point ca

Text proposed by the Commission

Amendment

(ca) ‘earlier trade marks’ means:

(i) 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:

– European Union trade marks;

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

– trade marks registered under international arrangements which have effect in the Member State;

(ii) European trade marks which validly claim seniority, in accordance with Regulation (EC) No 207/2009, from a trade mark referred to in the second and third indents of point (i), even when the latter trade mark has been surrendered or allowed to lapse;

(iii) applications for the trade marks referred to in points (i) and (ii), subject to their registration;

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

Article 2 – point cb (new)

Text proposed by the Commission

Amendment

(cb) ‘guarantee or certification mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of geographical origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods and services which are not so certified;

Article 2 – point cc (new)

Text proposed by the Commission

Amendment

cc) ‘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 3

Text proposed by the Commission

Amendment

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 as such, the shape of goods or of their packaging, or sounds, provided that such signs are capable of:

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

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

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 as such, the shape of goods or of their packaging, or sounds, provided that ***generally available technology is used and*** such signs are capable of:

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

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

Article 4 – paragraph 1 – point j

Text proposed by the Commission

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

Amendment

(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 *spirit drinks*, traditional terms for wine and traditional specialities guaranteed.

Article 4 – paragraph 1 – point j a (new)

Text proposed by the Commission

Amendment

(ja) trade marks which contain or consist of an earlier variety denomination registered in accordance with Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights¹ with respect to the same type of product.

¹ OJ L 227, 1.9.1994, p. 1.

Article 4 – paragraph 2

Text proposed by the Commission

Amendment

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

deleted

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

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

Article 4 – paragraph 5

Text proposed by the Commission

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

Amendment

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 invalidity***, following use which has been made of it, it has acquired a distinctive character.

Article 5 – paragraph 2

Text proposed by the Commission

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 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 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;

Amendment

deleted

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

Article 5 – paragraph 3 – point a

Text proposed by the Commission

(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 *a* Member State or, in case of a European 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;

Article 5 – paragraph 3 – point d

Text proposed by the Commission

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

Amendment

(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 *in respect of which registration is applied for or in which the trade mark is registered* or, in *the* 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;

Amendment

deleted

Article 5 – paragraph 5

Text proposed by the Commission

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.

Amendment

5. The Member States *shall* 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.

Article 8 – point c

Text proposed by the Commission

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

Amendment

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

Article 9 – paragraph 1

Text proposed by the Commission

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) and (3) has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark 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.

Amendment

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) *and point (a) of Article 5(3)* has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark 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.

Article 10

Text proposed by the Commission

Rights conferred by a trade mark

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

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, 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 ***and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services;***

(b) 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.

Amendment

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(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) ***without prejudice to point a,*** 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 part of a trade or company name;
- (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)* where only the consignor of the goods acts *for commercial purposes*.

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

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- (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 part of a trade or company name;
- (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 *into the Union* of goods *delivered in small consignments as defined by regulation (EC) 608/2013* where only the consignor of the goods acts *in the course of trade and where such goods, including packaging bear without authorisation 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. In cases where such measures are taken Member States shall ensure that the individual or entity that had ordered the goods is informed of the reason for the measures as well as of their legal rights vis-a-vis the consignor.*

5. The proprietor of a registered trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Member State where the trade mark is registered without being released for free circulation there, where such goods, including packaging, come from *a* third *country* and bear without authorization a trade mark which is identical to the trade mark *validly* registered in respect of such goods, or

distinguished in its essential aspects from that trade mark.

which cannot be distinguished in its essential aspects from that trade mark. *Without prejudice to the obligations of customs authorities to carry out adequate customs controls in accordance with Article 1 of regulation 608/2013 (EC) this provision shall not apply if the third party proves that the final destination of the goods is a country outside the Union and if the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination. In case where the country of destination has not yet been determined, the proprietor of the European Union trade mark shall have the right to prevent all third parties from re-bringing the goods out of the Union unless the third party proves that the final destination of the goods is a country outside the Union and the proprietor of the European Union trade mark is not able to prove that his trade mark is also validly registered in that country of final destination.*

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.

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.

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 10 – paragraph 2 – point a

Text proposed by the Commission

(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 ***and where such use affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services*** ;

Article 11 – paragraph 1 – point a

Text proposed by the Commission

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

Article 11 – point b

Text proposed by the Commission

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

Article 14 – paragraph 1 – subparagraph c

Text proposed by the Commission

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) his own personal name 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

Amendment

(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;

Amendment

(a) affixing in the course of trade a sign identical with or similar to, ***as specified in Article 5 paragraph 1 of this Directive***, the trade mark on get-up, packaging or other means on which the mark may be affixed

Amendment

(b) offering or placing on the market, or stocking for those purposes, or importing or exporting, ***packaging, labels, tags, security features, authenticity devices or any*** other means on which the mark is affixed.

Amendment

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) his own personal name 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 for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;

production of goods or of rendering of the service, or other characteristics of goods or services;

(c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of the trade mark, in particular where the use of the trade mark:

- (i) is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;
- (ii) *is made in comparative advertising satisfying all conditions set forth in Directive 2006/114/EC¹;*
- (iii) *is made to bring to the attention of consumers the resale of genuine goods that have originally been sold by or with the consent of the trademark owner²;*
- (iv) *is made to put forward a legitimate alternative to the goods or services of the proprietor of the trade mark³;*
- (v) *is made for the purposes of parody, artistic expression, criticism or comment;*

The first subparagraph shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

This paragraph shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

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

(a) it gives the impression that there is a

¹ CJEU, 12 June 2008, case C-533/06, O2/Hutchison, para. 45; CJEU, 18 June 2009, case C-487/07, L'Oréal/Bellure, para. 54, available at www.curia.eu.

² CJEU, 4 November 1997, case C-337/95, Dior/Evora, para. 38.

³ CJEU, 22 September 2011, case C-323/09, Interflora/Marks & Spencer, para. 91.

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.

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 14 – paragraph 2a (new)

Text proposed by the Commission

Amendment

(2a) The trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark for a due cause for any non-commercial use of the mark.

Article 16 – paragraph 3 a (new)

Text proposed by the Commission

Amendment

3a. The date of commencement of the period of five years referred to in paragraphs 1, 2 and 3 shall be entered in the register.

Article 22 – paragraph 3

Text proposed by the Commission

Amendment

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

deleted

Article 22 – paragraph 4

Text proposed by the Commission

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

Amendment

4. On request of one of the parties a transfer shall be entered in the register and published, ***if the requesting party has provided documentary evidence of the transfer to the office.***

Article 22 – paragraph 5

Text proposed by the Commission

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

Amendment

5. As long as the ***application for registration of the*** transfer has not been ***received by the office***, the successor in title may not invoke the rights arising from the registration of the trade mark against third parties.

Article 28 – point c

Text proposed by the Commission

Article 28

Definitions

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

(1) ‘Guarantee or certification mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of geographical origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods and services which are not so certified;

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

Amendment

deleted

Article 31 – paragraph 1

Text proposed by the Commission

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

Amendment

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

Article 38 – paragraph 1 – introductory part

Text proposed by the Commission

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

Amendment

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

Article 40 – paragraph 6

Text proposed by the Commission

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

Amendment

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 ***shall present them*** in the order of the classes.

Article 41

Text proposed by the Commission

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

Amendment

deleted

Article 42 – paragraph 2 a (new)

Text proposed by the Commission

Amendment

2a. Member States establishing opposition procedures based on absolute grounds covered by Article 4 shall not be required to implement this provision.

Article 45 – paragraph 2

Text proposed by the Commission

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

Amendment

2. The administrative procedure referred to in paragraph 1 shall provide that at least the proprietor of an earlier right referred to **in Article 4(1)(i)**, in Article 5(2) and **point (a) of Article 5(3)** shall be able to file a notice of opposition. **A notice of opposition may be filed on the basis of one or more earlier rights, provided they all belong to the same proprietor, and on the basis of part or the totality of the goods or services in respect of which the earlier right is registered or applied for, and may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.**

Article 45 – paragraph 3

Text proposed by the Commission

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

Amendment

3. The parties shall be granted, **at their joint request, a minimum of** two months **in** the opposition **proceeding** in order to negotiate the possibility of an amicable settlement between the opposing party and the applicant.

Article 47 – paragraph 1

Text proposed by the Commission

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

Amendment

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

Article 47 – paragraph 4 a (new)

Text proposed by the Commission

Amendment

4a. An application for revocation or for a declaration of invalidity may be directed against part or the totality of the goods or services in respect of which the contested mark is registered.

Article 47 – paragraph 4 b (new)

Text proposed by the Commission

Amendment

4b. An application for a declaration of invalidity may be filed on the basis of one or more earlier rights, provided they all belong to the same proprietor.

Article 48 – paragraph 1

Text proposed by the Commission

Amendment

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

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 in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided that the period of five years within which the earlier trade mark must have been put to genuine use has expired at the date of the application for a declaration of invalidity.

Article 51 a (new)

Text proposed by the Commission

Amendment

SECTION 3a

COMMUNICATION WITH THE OFFICE

Article 51 a

Communication with the office

Parties to the proceedings or, where appointed, their representatives, shall designate an official address within one of the Member States for all official communication with the office

Article 52

Text proposed by the Commission

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

Amendment

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

Article 53

Text proposed by the Commission

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

Amendment

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