Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast) (Text with EEA relevance)

DIRECTIVE (EU) 2015/2436 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL

of 16 December 2015

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(1) thereof,

Having regard to the proposal from the European Commission,

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

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

Acting in accordance with the ordinary legislative procedure[(2)],

Whereas:

(1) A number of amendments should be made to Directive 2008/95/EC of the European Parliament and of the Council[(3)]. In the interests of clarity, that Directive should be recast.

(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 (‘EU trade marks’) which are unitary in character and valid throughout the Union as laid down in Council Regulation (EC) No 207/2009[(4)]. The 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, 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 the two.

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(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. The revision of that Directive should include measures to make it more consistent with Regulation (EC) No 207/2009, which 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 EU trade mark system and national trade mark systems should be ensured.

(6) The Commission concluded in its communication of 24 May 2011 entitled 'A single market for intellectual property rights' that in order to meet increased demands from stakeholders for faster, higher quality, more streamlined trade mark registration systems, which are also more consistent, user friendly, publicly accessible and technologically up to date, there is a necessity to modernise the trade mark system in the Union as a whole and adapt it to the internet era.

(7) Consultation and evaluation for the purpose of this Directive has revealed that, in spite of the previous partial harmonisation of national laws, there remain areas where further harmonisation could have a positive impact on competitiveness and growth.

(8) In order to serve the objective of fostering and creating a well-functioning internal market and to facilitate acquiring and protecting trade marks in the Union, to the benefit of the growth and the competitiveness of European businesses, in particular small and medium-sized 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 pursuant to 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, the principal procedural rules in the area of trade mark registration in the Member States and in the EU 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 essential 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 EU 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 with regard to their relationship with trade marks acquired by registration.

(12) Attainment of the objectives of this approximation of laws 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 are capable of constituting a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfil the objectives of the registration system for trade marks, namely 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 those grounds are listed as an option for the Member States which should therefore be able to maintain or introduce them in their legislation.

(15) In order to ensure that the levels of protection afforded to geographical indications by Union legislation 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. Furthermore, it is appropriate to ensure that the scope of absolute grounds is extended to also cover protected traditional terms for wine and traditional specialties 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 event of there being identity between the mark and the corresponding 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 a likelihood of confusion can be established, and in particular the onus of proof in that regard, 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 a registered earlier trade mark takes precedence over later registered trade marks, it is necessary to provide that the enforcement of rights which are 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. Such an approach is in conformity with Article 16(1) of the Agreement on trade-related aspects of intellectual property rights of 15 April 1994 (‘TRIPS Agreement’).

(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 the

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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.

(19) The concept of infringement of a trade mark should also comprise the use of the sign as a trade name or similar designation, as long as such use is made for the purposes of distinguishing goods or services.

(20) 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 comparative advertising where such comparative advertising is contrary to Directive 2006/114/EC of the European Parliament and of the Council[(5)].

(21) In order to strengthen trade mark protection and combat counterfeiting more effectively, and in line with international obligations of the Member States under the World Trade Organisation (WTO) framework, in particular Article V of the General Agreement on Tariffs and Trade 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 authorisation a trade mark which is identical or essentially identical with the trade mark registered in respect of such goods.

(22) To this effect, it should be permissible for trade mark proprietors to prevent the entry of infringing goods and their placement in all customs situations, including, in particular transit, transhipment, warehousing, free zones, temporary storage, inward processing or temporary admission, also when such goods are not intended to be placed on the market of the Member State concerned. In performing customs controls, the customs authorities should make use of the powers and procedures laid down in Regulation (EU) No 608/2013 of the European Parliament and of the Council[(6)], 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.

(23) In order to reconcile the need to ensure the effective enforcement of 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.

(24) Article 28 of Regulation (EU) No 608/2013 provides that a right holder is to be liable for damages towards the holder of the goods where, inter alia, the goods in question are subsequently found not to infringe an intellectual property right.

(25) Appropriate measures should be taken with a view to ensuring the smooth transit of generic medicines. With respect to international non-proprietary names (INN) as globally recognised generic names for active substances in pharmaceutical preparations, it is vital to take due account of the existing limitations on the effect of trade mark rights. Consequently, the proprietor of a trade mark should not have the right to prevent a third party from bringing goods into a Member State where the trade mark is registered without being released for free circulation there based upon similarities between the INN for the active ingredient in the medicines and the trade mark.

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

(27) The exclusive rights conferred by a trade mark should not entitle the proprietor to prohibit the use of signs or indications by third parties which are used fairly and thus in accordance with honest practices in industrial and commercial matters. 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 only be considered to include the use of the personal name of the third party. Such use should further permit the use of descriptive or non-distinctive signs or indications in general. Furthermore, the proprietor should not be entitled to prevent the fair and honest use of the mark for the purpose of identifying or referring to the goods or services as those of the proprietor. Use of a trade mark by third parties to draw the consumer's attention to the resale of genuine goods that were originally sold by, or with the consent of, the proprietor of the trade mark in the Union should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters. Use of a trade mark by third parties for the purpose of artistic expression should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters. Furthermore, this Directive should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression.

(28) It follows from the principle of free movement of goods that the proprietor of a trade mark should 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.

(29) It is important, for reasons of legal certainty to provide that, without prejudice to his interests as a proprietor of an earlier trade mark, the latter may no longer request a declaration of invalidity or oppose the use of a trade mark subsequent to his own trade mark, 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.

(30) In order to ensure legal certainty and safeguard legitimately acquired trade mark rights, it is appropriate and necessary to provide that, without prejudice to the principle that the later trade mark cannot be enforced against the earlier trade mark, proprietors of earlier trade marks should not be entitled to obtain refusal or invalidation or to oppose the use