

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)

CHAPTER 3

PROCEDURES

SECTION 1

Application and registration

Article 37

Application requirements

- 1 An application for registration of a trade mark shall contain at least all of the following:
 - a a request for registration;
 - b information identifying the applicant;
 - c a list of the goods or services in respect of which the registration is requested;
 - d a representation of the trade mark, which satisfies the requirements set out in point (b) of Article 3.
- 2 The application for a trade mark shall be subject to the payment of a fee determined by the Member State concerned.

Article 38

Date of filing

- 1 The date of filing of a trade mark application shall be the date on which the documents containing the information specified in Article 37(1) are filed with the office by the applicant.
- 2 Member States may, in addition, provide that the accordance of the date of filing is to be subject to the payment of a fee as referred to in Article 37(2).

Article 39

Designation and classification of goods and services

- 1 The goods and services in respect of which trade mark 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 ('the Nice Classification').
- 2 The goods and services for which 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.

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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 set out in this Article.

4 The office shall reject an application in respect of indications or terms which are unclear or imprecise, where 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 shall present them 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. 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 40

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 observations, explaining on which grounds the trade mark should not be registered *ex officio*.

Persons and groups or bodies, as referred to in the first subparagraph, shall not be parties to the proceedings before the office.

2 In addition to the grounds referred to in paragraph 1 of this Article, 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 31(1) and (2). This provision may be extended to cover certification and guarantee marks where regulated in Member States.

Article 41

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 declaration to the office and indicating for each divisional application or registration the goods or services covered by the original application or registration which are to be covered by the divisional applications or registrations.

Article 42

Class fees

Member States may provide that the application and renewal of a trade mark is to be subject to an additional fee for each class of goods and services beyond the first class.

SECTION 2

Procedures for opposition, revocation and invalidity

Article 43

Opposition procedure

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

2 The administrative procedure referred to in paragraph 1 of this Article shall at least provide that the proprietor of an earlier trade mark as referred to in Article 5(2) and Article 5(3)(a), and the person authorised under the relevant law to exercise the rights arising from a protected designation of origin or geographical indication as referred to in Article 5(3)(c) shall be entitled to file a notice of opposition. A notice of opposition may be filed on the basis of one or more earlier rights, provided that 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 protected 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.

3 The parties shall be granted, at their joint request, a minimum of two months in the opposition proceedings in order to allow for the possibility of a friendly settlement between the opposing party and the applicant.

Article 44

Non-use as defence in opposition proceedings

1 In opposition proceedings pursuant to Article 43, where at the filing date or date of priority of the later trade mark, the five-year period within which the earlier trade mark must have been put to genuine use as provided for in Article 16 had expired, at the request of the applicant, the proprietor of the earlier trade mark who has given notice of opposition shall furnish proof that the earlier trade mark has been put to genuine use as provided for in Article 16 during the five-year period preceding the filing date or date of priority of the later trade mark, or that proper reasons for non-use existed. In the absence of proof to this effect, the opposition shall be rejected.

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

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

Article 45

Procedure for revocation or declaration of invalidity

1 Without prejudice to the right of the parties to appeal to the courts, Member States shall provide for an efficient and expeditious administrative procedure before their offices for the revocation or declaration of invalidity of a trade mark.

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

3 The administrative procedure for invalidity shall provide that the trade mark is to 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(1) to (3).

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

- a in the case of paragraph 2 and paragraph 3(a), 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, and 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 paragraph 3(b) of this Article, the proprietor of an earlier trade mark as referred to in Article 5(2) and Article 5(3)(a), and the person authorised under the relevant law to exercise the rights arising from a protected designation of origin or geographical indication as referred to in Article 5(3)(c).

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

6 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 46

Non-use as a 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 five-year period 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 are 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 a 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 five-year period within which the earlier trade mark was to 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 under paragraph 1 of this Article, furnish proof that the trade mark was put to genuine use during the five-year period preceding the filing date or date of priority, or that proper reasons for non-use existed.

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

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

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

Article 47

Consequences of revocation and invalidity

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

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

SECTION 3

Duration and renewal of registration

Article 48

Duration of registration

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

2 Registration may be renewed in accordance with Article 49 for further 10-year periods.

Article 49

Renewal

1 Registration of a trade mark shall be renewed at the request of the proprietor of the trade mark or any person authorised to do so by law or by contract, provided that the renewal

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fees have been paid. Member States may provide that receipt of payment of the renewal fees is to 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 the said expiry. The office shall not be held liable if it fails to give such information.

3 The request for renewal shall be submitted and the renewal fees shall be paid within a period of at least six months immediately preceding the expiry of the registration. Failing that, the request may be submitted within a further period of six months immediately 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.

SECTION 4

Communication with the office

Article 50

Communication with the office

Parties to the proceedings or, where appointed, their representatives, shall designate an official address for all official communication with the office. Member States shall have the right to require that such an official address be situated in the European Economic Area.