

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.

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- (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, transshipment, 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.

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- (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

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of a later trade mark if 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 if 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 a reputation.

- (31) 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 actually be used in connection with the goods or services for which they are registered, or, if not used in that connection within five years of the date of the completion of the registration procedure, be liable to be revoked.
- (32) Consequently, a registered trade mark should only be protected in so far as it is actually used and a registered earlier trade mark should not enable its proprietor to oppose or invalidate a later trade mark if that proprietor has not put his 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.
- (33) 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 an EU 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 can still be challenged. Such a challenge should be limited to situations where the mark could have been declared invalid or revoked at the time it was removed from the register.
- (34) 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 EU trade marks, and should include rules on assignment and transfer, licensing, rights *in rem* and levy of execution.
- (35) 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.
- (36) 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 EU trade marks.
- (37) 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

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States and should be aligned to those applicable to EU 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 a term. In the interest of clarity and legal certainty, the Member States' central industrial property offices and the Benelux Office for Intellectual Property should, in cooperation with each other, endeavour to compile a list reflecting their respective administrative practices with regard to the classification of goods and services.

- (38) 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 any person authorised under the relevant law to exercise the rights arising from a protected designation of origin or a geographical indication to oppose the registration of a trade mark application. Furthermore, in order to offer efficient means of revoking trademarks or declaring them invalid, Member States should provide for an administrative procedure for revocation or declaration of invalidity within the longer transposition period of seven years, after the entry into force of this Directive.
- (39) It is desirable that Member States' central industrial property offices and the Benelux Office for Intellectual Property cooperate with each other and with the European Union Intellectual Property Office 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 European Union Intellectual Property Office in all other areas of their activities which are relevant for the protection of trade marks in the Union.
- (40) 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 provisions relating to unfair competition, civil liability or consumer protection.
- (41) Member States are bound by the Paris Convention for the Protection of Industrial Property ('the Paris Convention') and the TRIPS Agreement. It is necessary that this Directive be entirely consistent with that Convention and that Agreement. The obligations of the Member States resulting from that Convention and that Agreement should not be affected by this Directive. Where appropriate, the second paragraph of Article 351 of the Treaty on the Functioning of the European Union should apply.
- (42) Since the objectives of this Directive, namely to foster and create a well-functioning internal market and to facilitate the registration, administration and protection of trade marks in the Union to the benefit of growth and competitiveness, cannot be sufficiently achieved by the Member States but can rather, by reason of its scale and effects, be better achieved at Union level, the Union may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty on European Union. In accordance with the principle of proportionality as set out in that Article, this Directive does not go beyond what is necessary in order to achieve those objectives.

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- (43) Directive 95/46/EC of the European Parliament and of the Council⁽⁷⁾ governs the processing of personal data carried out in the Member States in the context of this Directive.
- (44) The European Data Protection Supervisor was consulted in accordance with Article 28(2) of Regulation (EC) No 45/2001 of the European Parliament and of the Council⁽⁸⁾ and delivered an opinion on 11 July 2013.
- (45) 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.
- (46) This Directive should be without prejudice to the obligations of the Member States under Directive 2008/95/EC relating to the time limit for transposition of Council Directive 89/104/EEC⁽⁹⁾ into national law as set out in Part B of Annex I to Directive 2008/95/EC,

HAVE ADOPTED THIS DIRECTIVE:

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- (1) [OJ C 327, 12.11.2013, p. 42.](#)
- (2) Position of the European Parliament of 25 February 2014 (not yet published in the Official Journal) and position of the Council at first reading of 10 November 2015 (not yet published in the Official Journal). Position of the European Parliament of 15 December 2015.
- (3) 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 ([OJ L 299, 8.11.2008, p. 25](#)).
- (4) Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark ([OJ L 78, 24.3.2009, p. 1](#)).
- (5) Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising ([OJ L 376, 27.12.2006, p. 21](#)).
- (6) Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003 ([OJ L 181, 29.6.2013, p. 15](#)).
- (7) 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 ([OJ L 281, 23.11.1995, p. 31](#)).
- (8) Regulation (EC) No 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 ([OJ L 8, 12.1.2001, p. 1](#)).
- (9) First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ([OJ L 40, 11.2.1989, p. 1](#)).