

Agreement on Community trademark reform

The Commission, the Council and the European Parliament (EP) have reached a second-reading agreement on the trademark reform package. The Council accepted a significant number of amendments introduced by the EP. Following the Legal Affairs Committee reports adopted on 3 December 2015, the EP plenary is set to approve the amended legislation and the renaming of the 'Office for Harmonization in the Internal Market' as 'European Union Intellectual Property Office'.

Commission proposal

The European Commission tabled a trademark reform package in March 2013. The reform proposes (i) amending the 1989 Directive (codified as [2008/95/EC](#)) which ensures that national trademarks are subject to the same conditions when registered at Member States' Industrial Property offices and enjoy the same protection; (ii) revising the 1994 Regulation on the Community trade mark (codified as [207/2009/EC](#)) which sets an EU-wide unitary intellectual property right; and (iii) revising the 1995 Commission Regulation ([2869/95](#)) on the fees payable to the Office for Harmonization in the Internal Market (OHIM).

The Commission's main aim in proposing this reform is to make the EU trademark system more **accessible, efficient** and **less costly** for business. The new legislation specifically aims at **simplifying, accelerating and harmonising procedures** to make trademark application at national level subject to the same formalities (e.g. filing date) across the EU; at increasing **legal certainty** by clarifying some provisions; at ensuring **better coordination** between the EU trademark agency and national offices for the purpose of promoting convergence of practices and common tools; at putting the legislation into line with the **Lisbon Treaty**; and at updating the **governance** rules of the EU trademark agency.

European Parliament position

The EP (rapporteur: Cecilia Wikström, ALDE, Sweden) introduced several amendments to the draft legislation. Regarding terminology, the EP wanted the name to be '**European Union Intellectual Property Agency**' instead of '**European Union Trade Marks and Designs Agency**' as proposed. Regarding substantive **trademark rules**, the EP called for modifications in order, inter alia, to ensure that trademark protection does not impair **freedom of expression** (e.g. for parody) and to balance the rights of trademark owners with the interests of consumers with regard, in particular, to **goods in transit** through the EU territory. Regarding **procedural rules**, the EP sought to make mandatory the rules on **cooperation** between national and EU trademark offices and to include the rules on **registration fees** directly in the Regulation.

European Parliament and Council compromise

One of the main features of the compromise reached by the EP and the Council is the re-naming of OHIM as '**European Union Intellectual Property Office**' (Office). The two co-legislators agreed too on further harmonising substantive and procedural trademark law rules in several ways. As sought by the EP, the new legislation indicates that **fundamental rights and freedoms** including artistic expression must be safeguarded and the use of a trade mark in accordance with honest industrial and commercial practices should be allowed. New rules on **goods in transit** have been agreed in order to fight more effectively against the trading of counterfeit products. Furthermore, the Council accepted to make the new cooperation framework between national intellectual property offices and the EU Office **mandatory**, but giving national offices the possibility to **opt out** in certain circumstances. The Office is also provided with the necessary legal basis to establish a **Mediation Centre** to help parties to resolve disputes independently of the trademarks offices' decision-making process. Finally, the Council and the EP agreed to significantly **reduce registration fees** for EU trade marks (by up to 37% for business) and to set the features of the fees structure in an annex to the Regulation rather than, as previously, by way of implementing acts of the Commission.