SUMMARY OF CONCLUSIONS

of: 18th meeting of the Working Party on Intellectual Property (Trade Marks)
    held on 17 and 18 September 1984

No. prev. doc. 8404/84 No. Cion prop. amended Commission proposal 8896/84

Subject: Proposal for a Council Regulation on the Community Trade Mark

I. Co-ordination between the Member States on certain intellectual property questions raised in WIPO

The Working Party's conclusions on this point are contained in 9334/84 PI 22.

II. Draft progress report on the first reading of the proposal for a Regulation on the Community Trade Mark

The Working Party examined the draft report to the Permanent Representatives Committee submitted by the Chair in 8987/84 PI 20 (MARCA).

It adopted this report as set out in 9277/84 PI 21 (MARCA).

III. Second reading of the proposal for a Regulation on the Community Trade Mark

At the second reading, the Working Party examined Articles 1 to 4 of the Commission proposal (8896/84 PI 19), and began examining Article 5. The Danish delegation entered a general reservation on the amended proposal as a whole as the Danish authorities had not yet had time to examine it.

Delegations will find below the text of the Articles as they stand following the Working Party's meeting, together with any reservations or comments by the delegations. Changes made to the amended Commission proposal are underlined.
TITLE I

GENERAL PROVISIONS

Article 1

Community trade mark

(1) A trade mark for goods or services which conforms with the conditions contained in this Regulation and is registered in manner herein provided is hereinafter referred to as a "Community trade mark".

(2) A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: unless as otherwise provided for by this Regulation, it shall not be registered, transferred or surrendered (¹) or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the entire area of the Community (²).

¹) Draft statement for entry in the Council minutes:
"The term "surrendered" in Article 1(2) refers to surrender within the meaning of Article 38."

²) Reservation by the Italian delegation, which thought that the words "unless as otherwise provided for by this Regulation" should cover the whole of paragraph 2, and should therefore be placed at the beginning of it.
Article 2

Community Trade Marks Office

A Community Trade Marks Office, hereinafter referred to as "the Office", is hereby established.

(3) The United Kingdom, Danish and French delegations recalled their reservations on the possibility of setting up a Community Trade Marks Office by means of a Regulation based on Article 235 of the EEC Treaty.
TITLE II

THE LAW RELATING TO TRADE MARKS

Section 1

Definition of a Community trade mark
Obtaining a Community trade mark

Article 3

Signs of which a Community trade mark may consist

A Community trade mark may consist of any signs capable of being represented graphically, particularly words, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. (4) (5)

(4) Reservation by the Italian delegation on the words in square brackets.

(5) Reservation by the Italian delegation which felt that the trade mark should be intended to distinguish one product or service from another product or service. Accordingly, it suggested the following wording:

"... provided that such a sign is capable of distinguishing between products or between services."

(6) The Chairman of the Working Party suggested the following statement for entry in the Council minutes:

"Article 3 does not rule out the possibility of registering as a Community trade mark a combination of colours or a single colour, provided that the conditions of Article 3 are fulfilled".

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Article 4
Persons who can be proprietors of Community trade marks

(1) The following persons may be proprietors of Community trade marks:

(a) nationals of the Member States;

(b) nationals of any State which is party to the Paris Convention for the protection of industrial property, hereinafter referred to as "the Paris Convention";

(c) nationals of States which are not party to the Paris Convention:

- who are domiciled or who have real and effective industrial or commercial establishments on the territory of the Community or of a State which is party to the Paris Convention, or

- when these States accord to nationals of all the Member States the same trade mark protection as they accord to their own nationals. (7) (8)

(2) Legal persons, including those companies and associations which under the law that governs them are regarded as legal persons, (9) shall be treated as nationals within the meaning of paragraph 1. (10) (11)

(7) On the question of how it was to be established that a State not party to the Paris Convention accorded to nationals of the Member States the same protection as accorded to its own nationals

- the Danish delegation reiterated its position that the power to establish this could not be delegated to the Office (see 6695/82, page 19, (e));

- the German delegation suggested stipulating in the Regulation, or possibly in the implementing Regulation, that the Office should publish a notice establishing that the third State in question accorded nationals of the Ten the same protection as its own nationals.
Article 4 (continued)

(8) The Danish and German delegations wondered whether a national of a country not party to the Paris Convention applying for a Community trade mark would have to supply proof that he held a similar trade mark in his own country.

The German delegation undertook to submit a proposal on this matter to the Working Party.

(9) Reservation pending examination by the German delegation.

The question was also raised whether the European Economic Interest Grouping would be covered by this wording.

(10) The Italian delegation, considered that paragraph 2 did not cover all the relevant situations and suggested wording this paragraph as follows:

"For the purpose of paragraph 1, legal persons, including those companies and associations which under the law that governs them are regarded as legal persons, and associations and groups of undertakings shall be treated as nationals."

(11) Two questions were raised regarding Article 4 as a whole:

(a) What would be the consequence (for example, revocation or invalidity of, the trademark) if the proprietor of a Community trade mark ceased to possess the qualification which had enabled him to obtain it (for example: if the proprietor of a trade mark who was a national of a country not party to the Paris Convention left his industrial establishment in a country which was party to that Convention)?

(b) As several delegations thought that it would be desirable to establish rules to prevent trafficking in trade marks (6695/82 Annex; page 17), the German delegation put forward its views on this subject. It stated that it would submit its ideas to the Working Party in writing.
Article 5 (12)

Means whereby the rights in a Community trade mark are obtained

"The rights in (*) A Community trade mark are is obtained by registration.

(12) The Working Party did not finish discussing this Article at its meeting on 17 and 18 September 1984. However, it appeared that the majority of delegations would be willing to agree to the rights conferred by the Community trade mark - as opposed to the rights in the trade mark - being obtained by registration, even though some of those rights could have retroactive effect back to a date prior to registration (on this point, see Article 8(3) on entitlement to reasonable compensation as from publication of the application).

(*) Secretariat note: in the Commission proposal there is a substantive difference between the DK/E/F/NL/I/GR versions and the D version: the rights in the trade mark - the rights conferred by the trade mark.

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