SUBJECT: Amended proposal for a Council Regulation on the Community trade mark

1. At its tenth meeting on 4 November 1987 the ad hoc Working Party of Counsellors on Trade Mark Law continued its examination of the questions raised by the proposal for a Regulation which the Working Party on Intellectual Property had been unable to resolve and the question referred to it by the Permanent Representatives Committee. It examined Articles 20, 29a and X, 41 paragraph 1, 55A, 59 paragraph 1(g), 81a and 106.

2. Article 20 (doc. 9050/87, Annex II)

The Working Party of Counsellors examined the following statement to be entered in the Council minutes and proposed by the Commission representative:
The Council and the Commission consider that Article 234 of the EEC Treaty applies to conventions concluded before the entry into force of the Regulation between one or more Member States on the one side and one or more third countries on the other side.

The United Kingdom delegation, referring to a judgment by the Court of Justice in case 181/80, entered a scrutiny reservation on this statement, expressing doubts as to the applicability of Article 234 of the EEC Treaty. The French and Portuguese delegations entered a scrutiny reservation on the need for this statement.

According to the Council's Legal Service, there is no need to change the declaration because of the abovementioned judgment of the Court of Justice.

3. Articles 29a and X (doc. 8778/87, Annex II)

The Working Party did not agree on a definition of the effects of seniority (Article 29a paragraph 2).

The majority of delegations and the Commission could accept the text set out in 8778/87, Annex II.

The German delegation suggested another text (see Annex) which could not be accepted by the French delegation.

In respect of Article X, the Greek delegation considers that seniority could be claimed only within a certain time limit (5 or 10 years), whereas the majority of delegations considered that a time limit is not necessary. No agreement was reached on this question.
4. **Article 41 paragraph 1** (doc. 6383/87, p. 11/12 and 6587/87, p. 73)

The [Danish delegation](#) lifted its reservation concerning paragraph 1 subparagraph (b).

The [French delegation](#), referring to the commentary on Article 6 bis of the Paris Convention contained in the Guide to the application of this Convention, lifted its scrutiny reservation. As a result, the Working Party agreed on the text set out in document 6587/87, page 73.

5. **Articles 55A** (Working document No. 21/87 - SN/2943/87)

The Working Party examined the compromise proposal put forward by the Presidency (Working Document No. 21/87). This proposal suggests limiting the scope of Article 55A paragraph 1a so that a Community collective mark may be registered in respect of an indication of geographical origin only if such marks are registered or may be registered in the country in which the geographical locality is situated.

The Danish, Greek, Spanish and Portuguese delegations could support this compromise solution.

The [French delegation](#) could not accept this compromise, being opposed to the idea that a sign consisting exclusively of an indication of geographical origin may be registered as a Community collective mark. On the other hand, it could accept that a sign including such an indication among other elements could be registered. This delegation suggested the deletion of paragraph 1a of Article 55A.
The German delegation and the Commission could not accept the compromise either, because it makes a Community mark dependent upon national trade mark legislation. They preferred the text set out in document 6587/87.

The Irish, Italian, Netherlands and United Kingdom delegations considered it also to be less satisfactory than the text previously agreed by the majority of delegations (document 6587/87, p. 97).

6. Article 59 paragraph 1(g) (doc. 9050/87)

The Working Party agreed on the following text for Article 59 paragraph 1 subparagraph (g) (see doc. 9050/87, p. 6):

"(g) statements in writing sworn or affirmed or having a similar binding effect under the law of the State in which the statement is drawn up."

The Belgian delegation entered a scrutiny reservation concerning the translation into Dutch.

7. Article 81a

The Working Party examined a compromise text proposed by the United Kingdom delegation (Working Document No. 20/87).

The German and Netherlands delegations could not accept this compromise text, although they noted some improvement compared to the text set out in document 6587/87. They still consider that there is no need for any provision in the Regulation on the Community trade mark in respect of successive actions on the basis of parallel trade marks because, in their view, such cases are covered adequately by Article 22.
of the Brussels Convention which provides that in the case of related actions, any court other than the court first seised has the option of staying proceedings.

The other delegations considered that such a provision is necessary. Some of them would however accept paragraph 1 of the compromise proposal being deleted. However, the United Kingdom delegation entered a reservation on the deletion of paragraph 1.

The Greek delegation reserved its position on this paragraph.

Paragraphs 2, 3 and 4 of the compromise text were not discussed in depth by the Working Party.

8. Article 106 (doc. 8292/87)

The Working Party examined Article 106 in the version set out in document 8292/87, page 16. The representative of the Council Legal Service considered that this text would not give sufficient legal protection to third parties; he therefore advocated the addition of a third paragraph as set out in document 6587/87, page 172, footnote 59.

The majority of delegations and the Commission considered that there is a need for such a provision whereby acts of the President of the Office can be referred by third parties directly involved to the Commission for a check on their legality.

The German and French delegations expressed reservations with regard to paragraph 3 as drafted in document 6587/87, footnote 59. The German delegation doubted its practicability in the proceedings before the Trade Marks Office. The French delegation reserved its position as to who should be responsible for checking the legality of the acts of the President of the Office.
Text of Article 29a paragraph 2 proposed by the German delegation

(2) Seniority shall have the sole effect that the proprietor of the Community trade mark shall have the same rights under this Regulation as he would have if he were to invoke the Community trade mark and the earlier trade mark separately. It shall have this effect irrespective of whether or not the earlier trade mark continues to be registered.