ADDENDUM 2

Subject: Amended proposal for a Council Regulation on the Community trade mark
- consolidated text

1. Following the meeting of the Working Party on Intellectual Property on 19 and 20 July 1990, amendments are to be made to the following provisions of the above proposal:

Articles 6(1)(d) (1)
7(1)(b)
8(1)(b)
10a
23(3)
35(2)
47(2)
72(2).

The amendments are set out below in the Annex, which contains the corresponding pages of 5865/88 with the amended passages underlined.

2. In addition, on page 198 of 5865/88 PI 36 a statement should be inserted between points 4 and 5 as follows:

(1) In certain language versions only.
"4a Re Articles 7(1)(b) and 8(1)(b)

The Council and the Commission note that "likelihood of association" is a concept which in particular has been developed by Benelux case-law."
Pages 10, 13, 17, 20a, 22, 41, 64, 85 and 127 of 5865/88 PI 36, comprising the amendments agreed by the Working Party on Intellectual Property on 19 and 20 July 1990
Article 7
Relative grounds for refusal

(1) Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trademark.
Article 6
Absolute grounds for refusal

(1) The following shall not be registered: (1)

(a) signs which do not conform to the requirements of Article 3,

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade,

(1) The problem of the possible inclusion in Article 6(1) of a provision to the effect that, in addition, a trade mark would not be registered if a conflicting registered national or Community trade mark already existed, has been referred to the Permanent Representatives Committee by the ad hoc Working Party of Counsellors (see 6383/87, points 6(b) and 8).
Section 2
Effects of Community trade marks

Article 8
Rights conferred by a Community trade mark

(1) A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered; (**)

(b) any sign where, because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion include the likelihood of association between the sign and the trade mark.

(**) Term aligned on the Directive, Article 5(1)(a).
Article 9a (+)

Prohibition on the use of a Community trade mark registered in the name of an agent or representative

Where a Community trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorization, the latter shall be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use, unless the agent or representative justifies his action.

(+) Former Article 10a.
Article 10a

Prohibition on the use of a Community trade mark registered in the name of an agent or representative

- deleted -

(becomes Article 9a)
Article 23 (continued)

(3) The applications referred to in paragraph 2 which reach the Office more than one month after filing shall be deemed withdrawn.

(4) Ten years after the entry into force of this Regulation, the Commission shall draw up a report on the operation of the system of filing applications for Community trade marks, together with any proposals for modifying this system.
Article 35
Examination of opposition

(1) In the examination of the opposition the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.

(2) If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.
Article 47 (continued)

(4) If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 35(2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier Community trade mark has been used in relation to part only 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 only of that part of the goods or services.

(4a) Paragraph 4 shall apply to earlier national trade marks referred to in Article 7(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.
Section 4

Representation

Article 72

General principles of representation

(1) Subject to the provisions of paragraph 2, no person shall be compelled to be represented before the Office.

(2) Without prejudice to paragraph 3, second sentence, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 73(1) in all proceedings established by this Regulation, other than in filing an application for a Community trade mark; the Implementing Regulations may permit other exceptions. (+)

(3) Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee, who must file with it a signed authorization for insertion on the files, the details of which are set out in the Implementing Regulation. An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community.

(+ ) Scrutiny reservations by the French and Portuguese delegations on this addition which corresponds to Article 133(2) of the European Patent Convention.