ADDENDUM 3

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 4 and 5 October 1990, amendments are to be made to the following provisions of the above proposal:

   Articles 14 (1)

   15 (1)
   30 (title)
   31(a)
   32 (title) (1)
   33(a) (1)
   72(2)
   82(1).

(1) Position of this Article changed.
2. The changed position of some Articles and/or their classification in new sections has meant that some of them have had to be renumbered. Renumbering has, however, been kept to the strict minimum.

Thus:

Article 14 becomes Article 36(a)
" 15 " " 37(a)
" 31 " " 30(b)
" 32 " " 35(a)
" 33(a) " " 30(c).

3. These amendments are given in the Annex, such amended passages being underlined.

In view of this renumbering of certain Articles, it seemed helpful to give Titles IV (Registration procedure) and V (Duration, renewal and alteration of Community trade marks) in their entirety.
ANNEX

Pages 26, 27, 53 - 68a, 100, 127, 153, 178, 194 and 194a
of 5865/88 PI 36
containing the amendments agreed on
by the Working Party on Intellectual Property
on 4 and 5 October 1990 (*)

(*) These pages replace the corresponding pages in 5865/88 PI 36 + ADD 1 + ADD 2.
Section 4
Duration and alteration of Community trade marks

- deleted -

Article 14
Duration of registration

- This Article has been renumbered Article 36a -
Article 15
Alteration

- This Article has been renumbered
Article 37a -
TITLE IV
REGISTRATION PROCEDURE

Section 1
Examination of applications

Article 30
Examination of the conditions of filing

(1) The Office shall examine whether:

(a) the Community trade mark application satisfies the requirements for the accordance of a date of filing in accordance with Article 25;

(b) the Community trade mark application complies with the conditions laid down in Article 24(3);

(c) where appropriate, the class fees have been paid within the prescribed period.

(2) Where the Community trade mark application does not satisfy the requirements referred to in paragraph 1, the Office shall request the applicant to remedy the deficiencies or the default on payment within the prescribed period.
Article 30 (continued)

(3) If the deficiencies or the default on payment established pursuant to paragraph 1(a) are not remedied within this period, the application shall not be dealt with as a Community trade mark application. If the applicant complies with the Office's request, the Office shall accord as the date of filing of the application the date on which the deficiencies or the default on payment established are remedied.

(4) If the deficiencies established pursuant to paragraph 1(b) are not remedied within the prescribed period, the Office shall refuse the application.

(4a) If the default on payment established pursuant to paragraph 1(c) is not remedied within the prescribed period, the application shall be deemed to be withdrawn unless it is clear which categories of goods or services the amount paid is intended to cover.

(5) Failure to satisfy the requirements concerning the claim to priority will result in loss of the right of priority for the application.

(6) Failure to satisfy the requirements concerning the claiming of seniority of a national trade mark will result in loss of that right for the application.
Article 30a
Examination of the conditions relating to the entitlement of the proprietor

(1) Where, pursuant to Article 4, the applicant may not be the proprietor of a Community trade mark, the application shall be refused.

(2) The application may not be refused before the applicant has been given the opportunity to withdraw his application or submit his observations.
Article 30b (+)

Examination as to absolute grounds for refusal

(1) Where, under Article 6, a trade mark is ineligible for registration in respect of some or all of the goods or services covered by the Community trade mark application. The application shall be refused as regards those goods or services.

(2) Where the trade mark contains an element which is not distinctive, and where the inclusion of said element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the Office may request, as a condition for registration of said trade mark, that the applicant state that he disclaims any exclusive right to such element. Any disclaimer shall be published together with the application or the registration of the Community trade mark, as the case may be.

(3) The application shall not be refused before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations.

(4) )
   ) Deleted.
   (5) )

(+) Formerly Article 31.
Article 31
Examination as to absolute grounds for refusal

- This Article has been
  renumbered Article 30b -
Section 1a
Search

Article 30c (+) (7)
Search

(1) Once a Community trade park application has been accorded a date of filing, the Office shall draw up a Community search report citing those earlier Community trade marks or Community trade mark applications discovered which may be invoked under Article 7 against the registration of the Community trade mark applied for.

(2) As soon as a Community trade mark application has been accorded a date of filing, the Office shall transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks in respect of Community trade mark applications.

(3) Each of the central industrial property offices referred to in paragraph 2 shall communicate to the Office within three months as from the date on which it received the Community trade mark application a search report which shall either cite those earlier national trade marks or trade mark applications discovered which may be invoked under Article 7 against the registration of the Community trade mark applied for, or state that the search has revealed no such rights.

(+) Formerly Article 33a.
(7) The wording of Article 30c reproduced here is that of a compromise solution. See doc. 6383/87, points 5 to 8.
Article 30c (*)(continued)

(4) The Office shall transmit without delay to the applicant for the Community trade mark the Community search report and the national search reports received within the time limit laid down in paragraph 3.

(5) Upon publication of the Community trade mark application, which may not take place before the expiry of a period of one month as from the date on which the Office transmits the search reports to the applicant, the Office shall inform the proprietors of any earlier Community trade marks or Community trade mark applications cited in the Community search report of the publication of the Community trade mark application.

(6) The Commission shall, five years after the opening of the Office for the filing of applications, submit to the Council a report on the operation of the system of searching resulting from the Article and, if necessary, appropriate proposals for amending this Regulation with a view to adapting the system of searching on the basis of the experience gained and bearing in mind developments in searching techniques.

(*) Formerly Article 33a.

5865/88 ADD 3  (ANNEX)
Section 1b
Publication of the application

Article 31a
Publication of the application

(1) If the conditions which the application for a Community trade mark must satisfy have been fulfilled and if the period referred to in Article 30c(5) has expired, the application shall be published to the extent that it has not been refused pursuant to Articles [30a and] (8) 30b.

(2) Where, after publication, the application is refused under Articles [30a and] (8) 30b, the decision that it has been refused shall be published upon becoming final.

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(8) Reservation by the Spanish delegation concerning the reference to Article 30a.
(See 9083/90 P1 58, point 6(b) and (cc).)
Article 32
Amendment of the application

- This Article has been
renumbered Article 35a -
Section 2
Observations by third parties and opposition

Article 33
Observations by third parties

(1) Following the publication of the Community trade mark application, any
natural or legal person and any group or body representing manufacturers,
producers, suppliers of services, traders or consumers may submit to the
Office written observations, explaining on which grounds under Article 6 (9)
in particular, the trade mark shall not be registered ex officio. They shall
not be parties to the proceedings before the Office.

(2) The observations referred to in paragraph 1 shall be communicated to the
applicant who may comment on them.

(9) Reservations by the Irish and Italian delegations in connection with the
problem of search and earlier rights. See doc. 6387/87, points 6(c) and 9.
Article 33a

Search

- This Article has been
renumbered Article 30c -
Article 34 (10)

Opposition

(1) Within a period of three months following the publication of a Community trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 7.

(a) by the proprietors of earlier trade marks referred to in Article 7(2) as well as licensees authorized by the proprietors of those trade marks, in respect of Article 7(1) and (5);

(b) Deleted;

(c) by the proprietors of trade marks referred to in Article 7(3);

(d) by the proprietors of earlier signs referred to in Article 7(4), and by persons authorized under the relevant national law to exercise these rights.

(10) Four delegations (B/GR/IRL/I) entered reservations on Article 34, as the problem of the absolute or relative nature of the grounds for refusal constituted by the existence of identical earlier rights and the related problem of search for earlier rights (see Article 30c) had not yet been resolved. The Danish delegation would also enter a reservation on this point if the compromise proposal on searches (Article 30c) was not accepted. See doc. 6387/87, points 5 to 8.
Article 34 (continued)

(1a) Notice of opposition to registration of the trade mark may also be given subject to the conditions laid down in paragraph 1, in the event of the publication of an amended application in accordance with the second sentence of Article 35a(2).

(2) Opposition must be expressed in writing and must specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid. Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments.

(3) Deleted.
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 35 (continued)

(2a) Paragraph 2 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.

(3) The Office may, if it thinks fit, invite the parties to make a friendly settlement.

(4) If examination of the opposition reveals that the trade mark may not be registered in respect of some or all of the goods or services for which the Community trade mark application has been made, the application shall be refused in respect of those goods or services. Otherwise the opposition shall be rejected.

(5) The decision refusing the application shall be published upon becoming final.
Section 2a
Withdrawal, restriction and amendment of the application

Article 35a (*)
Withdrawal, restriction and amendment of the application

(1) The applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein. Where the application has already been published, the withdrawal or restriction shall also be published.

(2) In other respects, a Community trade mark application may be amended, upon request of the applicant, only by correcting the name and address of the applicant, errors of wording or of copying, or obvious mistakes, provided that such correction does not substantially change the trade mark or extend the list of goods or services. Where the amendments affect the representation of the trade mark or the list of goods or services and are made after publication of the application, the trade mark application shall be published as amended.

(*) Formerly Article 32.
Section 3
Registration

Article 36
Registration

Where an application meets the requirements of this Regulation and where no notice of opposition has been given within the period referred to in Article 34(1) or where opposition has been rejected by a definitive decision, the trade mark shall be registered as a Community trade mark, provided that the registration fee has been paid within the period prescribed. If the fee is not paid within this period the application shall be deemed to be withdrawn.
TITLE V
DURATION, RENEWAL AND ALTERATION OF THE COMMUNITY TRADEMARK

Article 36a (+)
Duration of registration

Community trade marks shall be registered for a period of ten years from the date of filing of the application. Registration may be renewed in accordance with Article 37 for further periods of ten years.
Article 37
Renewal

(1) Registration of the Community trade mark shall be renewed at the request of the proprietor of the trade mark or any person expressly authorized by him, provided that the fees have been paid.

(1a) The Office shall inform the proprietor of the Community trade mark, and any person having a registered right in respect of the Community trade mark, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office.

(2) Deleted.

(3) The request for renewal shall be submitted within a period of six months preceding the last day of the month in which protection ends. The fees shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months from the day referred to in the first sentence, provided that an additional fee is paid within this further period.
Article 37 (continued)

(4) Where the request is submitted or the fees paid in respect of only some of the goods or services for which the Community trade mark is registered, registration shall be renewed for those goods or services only.

(5) Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be registered.
Article 37a (+)

Alteration

(1) The Community trade mark shall not be altered in the register during the period of registration or on renewal thereof.

(2) Nevertheless, where the Community trade mark includes the name and address of the proprietor, any alteration thereof not substantially affecting the identity of the trade mark as originally registered may be registered at the request of the proprietor.

(3) The publication of the registration of the alteration shall contain a representation of the Community trade mark as altered. Third parties whose rights may be affected by the alteration may challenge the registration thereof within a period of three months following publication.

(+) Formerly Article 15.
Article 55 C (ex Article 90)
Refusal of the application

(1) In addition to the grounds for refusal of a Community trade mark application provided for in Articles 30 and 30(b), an application for a Community collective mark shall be refused where the provisions of Articles 55 A or Article 55 B are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

(2) An application for a Community collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(3) An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.
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 Regulation 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.
Section 2
Application of national laws for the purpose of prohibiting the
use of Community trade marks

Article 82
Prohibition of use of Community trade marks

(1) This Regulation shall, unless otherwise provided for, not affect the right
existing under the laws of the Member States to invoke claims for
infringement of earlier rights within the meaning of Article 7 or
Article 42(2) in relation to the use of a later Community trade mark. Claims
for infringement of earlier rights within the meaning of Article 7(2) and (4)
may, however, no longer be invoked if the proprietor of the earlier right may
no longer apply for a declaration that the Community trade mark is invalid in
accordance with Article 44(1a).

(2) This Regulation shall, unless otherwise provided for, not affect the right to
bring proceedings under the civil, administrative or criminal law of a Member
State or under provisions of Community law for the purpose of prohibiting the
use of a Community trade mark to the extent that the use of a national trade
mark may be prohibited under the law of that Member State or under Community
law.
An examiner shall be responsible for taking decisions on behalf of the Office in relation to an application for registration of a Community trade mark, including the matters referred to in Articles 30, 30(a), 30(b), 31 and 55 C, except insofar as an Opposition Division is responsible.
Article 125
Community implementing provisions

(1) The rules implementing this Regulation shall be adopted in an Implementing Regulation.

(1a) In addition to the fees provided for in the preceding Articles, fees shall be charged, in accordance with the detailed rules of application laid down in the Implementing Regulation, in the cases listed below: (*)

(1) change of representation of a Community trade mark (Rule 13(2)) (46);

(2) late payment of the registration fee (Rule 18(2a));

(3) issue of a copy of the certificate of registration (Rule 19(2));

(4) registration of the transfer of a Community trade mark (Rule 22(3));

(5) registration of a licence or another right in respect of a Community trade mark (Rule 23(1));

(6) registration of a licence or another right in respect of an application for a Community trade mark (Rule 23(3));

(*) Paragraph 1(a) was supplemented by the Working Party on Intellectual Property (Trade Mark) at its meeting on 4 and 5 October 1990. Changes to 9641/88 are underlined.

(46) The Working Party will have to examine whether the references in brackets should be deleted in the final version of the Regulation.
Article 125 (continued)

(7) cancellation of the registration of a licence or another right (Rule 25(2));

(8) alteration of a registered Community trade mark (Rule 27(2));

(9) issue of an extract from the Register (Rule 69(5));

(10) inspection of the files (Rule 73(1)); (46a)

(11) issue of copies (Rule 73(3));

(12) issue of certified copies (Rule 73(4));

(13) communication of information in a file (Rule 74);

(14) review of the determination of the procedural costs to be refunded (Rule 79(4)).

(2) The Implementing Regulation and the rules of procedure of the Boards of Appeal shall be adopted by the Council (46b) by qualified majority vote on a proposal from the Commission. They shall be amended in accordance with the same procedure.

(46a) Reservation by the Greek delegation.
(46b) for the records reservations by the French and Portuguese delegations, which advocated that the Regulation be adopted by the Administrative Board.