(b) it is liable, in consequence of the use made of it in respect of the goods or services for which it is registered, to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

**Article 15**

Where a ground for refusal of registration or for invalidation of a trade mark exists in respect of only part of the goods or services for which that mark has been applied for or registered, refusal of registration or invalidation shall cover only the goods or services concerned.

**Article 16**

Without prejudice to Article 8, Member States whose laws authorize the registration of collective marks or guarantee marks may provide that such marks be refused registration, or shall be invalidated, on other grounds than those specified in Article 2 and 14 where the function of those marks so requires.

**Article 17**

The laws of the Member States shall determine the procedure for registration and for invalidation of trade marks and the effects of invalidation. They may further provide that a trade mark to which one of the grounds for invalidation mentioned in this Directive applies shall not be capable of defeating the claims of third parties.

**Article 18**

1. The Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than ...

They shall immediately inform the Commission thereof.

2. The Member States shall communicate to the Commission the text of the main provisions of national law which they adopt in the field governed by this Directive.

**Article 19**

This Directive is addressed to the Member States.

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**Proposal for a Council Regulation on Community trade marks**

*(Submitted by the Commission to the Council on 25 November 1980)*

THE COUNCIL OF THE EUROPEAN COMMUNITIES

Having regard to the Treaty establishing the European Economic Community, and in particular Article 235 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Parliament,

Having regard to the opinion of the Economic and Social Committee,

Whereas:

it is desirable to promote throughout the Community a harmonious development of economic activities and a continuous and balanced expansion by establishing a common market which functions properly and offers conditions which are similar to those obtaining in a national market. In order to create a market of this kind and make it increasingly a single market, not only must the barriers to free movement of goods and services be removed and arrangements be instituted which ensure that competition is not distorted, but, in addition, legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community, whether in manufacturing and distributing goods or in providing services. For those purposes, trade marks enabling the products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers, should feature amongst the legal instruments which undertakings have at their disposal;

action by the Community would appear to be necessary for the purpose of attaining the Community's said objectives. Such action involves the creation of Community arrangements for trade marks whereby undertakings can by means of one
system of procedure obtain Community trade marks to which uniform protection is given and which produce their effects throughout the entire area of the Community;

the Treaty does not provide the requisite powers to create a legal instrument such as a Community trade mark. The barrier of territoriality of the rights conferred on proprietors of trade marks by the laws of the Member States cannot be removed by approximation of laws. In these circumstances the only appropriate way of opening up unrestricted economic activity in the whole of the common market for the benefit of undertakings is to create trade marks which are governed solely by a law of the Community, that law being directly applicable in all Member States;

the Community law relating to trade marks nevertheless does not replace the laws of the Member States on trade marks, for at the stage to which the establishment of the common market has now advanced it would not appear to be proper to require undertakings to apply for registration of their trade marks as Community trade marks. National trade marks do in fact continue to be necessary for those undertakings whose activities are such that protection of their trade marks at Community level is of no use to them;

in order not to detract from the unity of the system of Community trade marks and from the primacy of the Community law which governs them, such trade marks must not be subject to the laws of the Member States, save insofar as this Regulation expressly provides;

the rights in a Community trade mark are not to be capable of being obtained otherwise than by registration, and registration is to be refused if the trade mark is not distinctive, is unlawful or is not available. In the latter case the Office should not withhold registration unless the prior right which conflicts with the trade mark is a trade mark which is registered and used in the common market, if the proprietor of the prior right has entered opposition to registration of the trade mark as a Community trade mark and all efforts to produce an amicable settlement between the parties have failed;

the protection conferred by a Community trade mark is bound up with the concept of similarity of signs, similarity of goods and services and the possibility of confusion arising therefrom. The purpose of protection is to guarantee the trade mark's function as an indicator of origin. It is essential that the said concepts be interpreted strictly so that the freedom of action of persons who are in competition with each other is not needlessly restricted. It is necessary, in particular, that by simultaneous comparison of signs, goods and services it be certain in each case that customers are in reality likely to confuse products and services which are identified by those signs. For the purpose of determining whether a sign which is alleged to infringe a trade mark which consists of a number of elements is so similar to it that confusion may arise between them, the trade mark must be viewed as a whole. In order to determine whether a Community trade mark and a sign consisting of words sound the same or are at any rate phonetically similar, it is not possible to disregard the fact that the Community exists and that the public is increasingly aware of the correct pronunciation of words in the languages which are spoken therein;

in view of the fact that the function of a Community trade mark is to indicate origin, the proprietor must not be entitled to prohibit its use by a third party in relation to goods which have been put into circulation in the Community or outside it, under the trade mark, by him or with his consent, nor to prohibit its use, for reasons based on trade marks law, by a licensee who supplies the goods or services under the trade mark outside the territory covered by the licence;

there is no justification for protecting Community trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used;

a Community trade mark is to be regarded as an object of property which exists separately from the undertaking whose products or services are designated by it. Accordingly, a Community trade mark must be capable of being, inter alia, transferred to, or charged as security in favour of, a third party and of being the subject-matter of licences. The conditions applicable for revocation and invalidity of trade marks must also be regulated in a uniform manner;

decisions regarding the validity of Community trade marks must have absolute effect and cover the entire area of the common market, for this is the only way of preventing inconsistent decisions on the part of the courts and the Office and of ensuring that the unitary character of Community trade marks is not undermined. The rules contained in the Convention on jurisdiction and enforcement of judgments in civil and commercial matters apply to all actions at law
HAS ADOPTED THIS REGULATION:

TITLE I
GENERAL PROVISIONS

Article 1

| Community trade marks |

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 identical effect throughout the Community. No trade mark shall be registered as a Community trade mark otherwise than for the entire area of the Community; a Community trade mark shall not be transferred or surrendered or be the subject of a decision revoking the right of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the entire area of the Community.

Article 2

| Community Trade Marks Office |

For the purposes of the application of this regulation a Community Trade Marks Office, hereinafter referred to as 'the Office', is hereby established.
TITLE II
THE LAW RELATING TO TRADE MARKS

Section 1
DEFINITION OF A COMMUNITY TRADE MARK

Article 3
[Signs of which a Community trade mark may consist]

A Community trade mark may consist of words (including surnames), designs, letters, numerals, combinations of colours, the shape of goods or of their packaging, or of any other signs which are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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 any Member State, and nationals of any non-Member State who are habitually resident in the Community or who have a real and effective industrial or commercial place of business in the Community;

(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', and persons who are deemed to be such by the operation of Article 3 thereof;

(c) nationals of any other State which accords to nationals of the Member States the same trade mark protection as it accords to its own nationals.

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

Article 5
[Means whereby the rights in a Community trade mark are obtained]

The rights in a Community trade mark are obtained by registration.

Article 6
[Absolute grounds for refusal]

1. Trade marks which do not conform to the requirements of Article 3 or 4, and trade marks which are not distinctive, shall not be registered; in particular the following trade marks shall not be registered:

(a) those which consist solely of signs or indications which in trade may be requisite for the purpose of showing the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

(b) those which consist solely of signs or indications which are customarily used to designate the goods or service in the current language of the trade or in the bona fide and established practices thereof.

2. In addition, the following shall not be registered:

(a) the shape which results from the nature of the goods themselves, or which has some technical consequence; also the shape of the goods where this affects their intrinsic value;

(b) trade marks which include signs or indications liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or service;

(c) trade marks which are contrary to public policy or to accepted principles of morality, and those which fall within the provisions of Article 6ter of the Paris Convention.

3. Paragraphs 1 and 2 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the common market.

4. Paragraph 1 (a) shall not apply if the trade mark has become distinctive in consequence of the use which has been made of it.

Article 7
[Relative grounds for refusal]
the goods or services designated by each of the trade marks are identical with or similar to each other, with the result that there arises a serious likelihood of confusion on the part of the public in the territory in which the earlier trade mark has effect.

2. Earlier trade marks are trade marks of the following kinds in respect of which the date of application for registration preceded the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(a) Community trade marks,
(b) trade marks registered in a Member State, including those registered in the Benelux countries,
(c) trade marks registered under international arrangements which have effect in a Member State;
and trade marks which, on the date on which application is made for registration of them as Community trade marks, are well known in a Member State, in the sense in which the words ‘well-known’ are used in Article 6 bis of the Paris Convention.

3. Where an agent or representative of the rightful proprietor of a trade mark applies for registration thereof in his own name without the proprietor’s consent, registration shall be refused unless the agent or representative justifies his action.

4. This Article applies only where the proprietor of the earlier trade mark, or of a trade mark, to which paragraph (3) applies, has been successful in opposing registration of the Community trade mark, his opposition having been in conformity with the provisions of this Regulation.

Section 2
EFFECTS OF COMMUNITY TRADE MARKS

Article 8

[Rights conferred by a Community trade mark]

1. A Community trade mark confers on the proprietor exclusive rights therein. The proprietor shall be entitled to prohibit any third party from using in the course of trade, save with his consent:

(a) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are identical with or similar to those for which the Community trade mark is registered, where such use involves a serious likelihood of confusion on the part of the public;
(b) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the Community trade mark is of wide repute and use of that sign is detrimental to that repute.

2. Use of the following kinds, inter alia, may be prohibited under paragraph (1):

(a) affixing the sign to the goods or to the packaging thereof;
(b) putting the goods on the market under that sign, or supplying services thereunder;
(c) using the sign on business correspondence or invoices.

3. The rights conferred by a Community trade mark shall prevail against third parties from the date of publication of registration of the trade mark. Reasonable compensation may, however, be claimed in respect of matters arising after the date of publication of a Community trade mark application, which matters would, after publication of registration of the trade mark, be prohibited by virtue of that publication. The court seised of the case shall stay the proceedings until the registration has been published.

Article 9

[Reproduction of Community trade marks in dictionaries]

1. The publisher of a dictionary, encyclopaedia or similar work shall ensure that any reproduction of a Community trade mark therein is accompanied by an indication that the trade mark is registered.

2. Where the publisher fails to comply with the requirements of paragraph 1 he shall, at the request of the proprietor of the Community trade mark, correct the matter at his own expense in the next edition of the publication.

Article 10

[Limitation of the effects of a Community trade mark]

A Community trade mark does not entitle the proprietor to prohibit a third party from using in the course of trade:

(a) his own surname and address;
(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of
rendering of the service, or other characteristics of the goods or service;

(c) the trade mark for the purpose of indicating the intended purpose of accessories or spare parts;

provided he does not use them as a trade mark.

Article 11

[_limits_of_the_rights_conferred_by_a_Community_trade_mark]

1. A Community trade mark does not entitle the proprietor to prohibit its use in relation to goods which have been put on the market under that trade mark by the proprietor or with his consent.

2. Paragraph 1 shall not apply:

(a) Where, the goods having been put on the market outside the Community, the proprietor is legally entitled to oppose their importation into the Community;

(b) Where the condition of the goods is changed or impaired after they have been put on the market;

(c) Where the goods are re-packaged by a third party; but this provision shall not apply where the third party proves that the use made of the trade mark by the proprietor, taking into consideration his system of marketing, tends to fragment the markets artificially and that the re-packaging could not affect the original condition of the goods, if the third party informs the proprietor beforehand that the re-packaged goods are to be put on the market and the new packaging indicates that the goods have been re-packaged by the third party.

Article 12

[Supplementary_application_of_national_lawrelating_to_infringement]

1. The effects of Community trade marks shall be governed solely by the provisions of this Regulation. Save as otherwise herein provided, the civil sanctions for infringement of a Community trade mark shall be governed by the law on civil sanctions for infringement of a national trade mark which applies in the Member State in which the Court hearing the action is located.

2. The rules of procedure to be applied shall be determined in accordance with Article 76 and the Articles which follow it.

Section 3

USE_OF_COMMUNITY_TRADE_MARKS

Article 13

1. A Community trade mark shall be put to serious use in the common market, consistently with the terms of this Regulation, in connection with the goods or services in respect of which it is registered, unless there exist legitimate reasons for not doing so.

2. Circumstances arising independently of the will of the proprietor of a Community trade mark are alone sufficient to constitute legitimate reasons for not using it.

3. Use of a Community trade mark by a licensee or by a person who is associated economically with the proprietor shall be deemed to constitute use by the proprietor.

Section 4

DURATION_AND_ALTERATION_OF_COMMUNITY_TRADE_MARKS

Article 14

[Duration_of_registration]

Community trade marks shall be registered for a period of ten years from the date of filing of the application. Without prejudice to the application of Article 37, registration may be renewed for further periods of ten years.

Article 15

[Alteration]

1. No alteration of a Community trade mark shall be allowed during the period of registration or on renewal thereof.

2. Where, however, a Community trade mark includes the name and address of the proprietor, these may be altered, provided the alteration does not substantially change the trade mark. Any alteration shall be registered.
Section 5

COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY

Article 16

[Dealing with Community trade marks as national trade marks]

1. Unless Articles 17 to 22 otherwise provide, a Community trade mark as an object of property shall be regarded in all respects, including its geographical coverage of the entire area of the Community, as a trade mark registered in the Member State in which, according to the Register of Community trade marks, the applicant had his habitual residence or principal place of business or, failing either of these, a place of business, on the date of filing of the Community trade mark application.

2. In cases which are not provided for by paragraph 1 the Member State referred to in that paragraph shall be the Member State in which the headquarters of the Office is situated.

Article 17

[Transfer]

1. A Community trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.

2. A transfer of the whole of the undertaking shall, unless some other intention appears, have effect to transfer any Community trade mark of the undertaking.

3. Without prejudice to paragraph 2, an assignment of a Community trade mark shall be made in writing; otherwise it shall be void.

4. Where it is clear from the transfer documents that because of the transfer the Community trade mark will mislead the public concerning the nature, quality or geographical origin of the goods or services in respect of which it is registered, the Office shall not register the transfer.

5. A transfer shall not affect rights acquired by third parties before the date of transfer.

6. A transfer shall not take effect vis-à-vis the Office or third parties until it has been registered, and then only to the extent that the transfer documents require.

A transfer shall nevertheless take effect before registration vis-à-vis third parties who have acquired rights in the trade mark after the date of transfer but who knew of the transfer at the date on which they acquired those rights.

Article 18

[Rights in rem]

1. A Community trade mark may be charged as security or otherwise be the subject of security rights in rem, separately from the undertaking.

2. Security rights in rem which are created over a Community trade mark, and any transfer of those rights, shall not have effect vis-à-vis third parties until the rights have been registered, or until the transfer has been registered, as the case may be.

Article 19

[Levy of execution]

1. A Community trade mark may be levied in execution and be the subject of enforcement measures following thereon, separately from the undertaking.

2. As regards the procedure for enforcement measures in respect of a Community trade mark, the courts and authorities of the Member State which is relevant for the purposes of Article 16 shall have exclusive jurisdiction.

Article 20

[Insolvency and similar proceedings]

Until such time as common rules are in operation between the Member States, the only Member State in which a Community trade mark may form part of the assets in an insolvency or in similar proceedings shall be the Member State in which those proceedings are first opened.

Article 21

[Licensing]

1. Licences may be granted in respect of a Community trade mark for some or all of the goods or services for which it is registered.

2. The rights conferred by a Community trade mark shall not be asserted vis-à-vis a licensee unless he operates his licence beyond the period of time for
which it was granted or uses the trade mark in relation to goods or services for which it has not been registered or does not comply with the proprietor’s instructions concerning the quality of the goods or services.

3. The proprietor of a Community trade mark shall ensure that the quality of the goods manufactured or of the services provided by the licensee is the same as that of the goods manufactured or of the services provided by the proprietor.

4. Paragraphs 5 and 6 of Article 17 apply to licences.

**Article 22**

[The right of property in an application for a Community trade mark]

Articles 16 to 21 apply to applications for Community trade marks.

**TITLE III**

**APPLICATIONS FOR COMMUNITY TRADE MARKS**

**Section 1**

**FILING OF APPLICATIONS AND THE CONDITIONS WHICH GOVERN THEM**

**Article 23**

[Filing of applications]

An application for a Community trade mark shall be filed at the Office.

**Article 24**

[Conditions governing applications]

1. The following, *inter alia*, shall be included in an application for a Community trade mark:
   (a) particulars identifying the applicant;
   (b) a list of the goods or services;
   (c) a representation of the trade mark;
   (d) where paragraph 2 of Article 72 applies, the relevant power of attorney.

2. The fees shall be paid upon filing of the application.

**Article 25**

[Date of filing]

The date of filing of a Community trade mark application shall be the date on which the documents specified in Article 24 are received, provided the minimum fees have at that date been received by the Office.

**Section 2**

**PRIORITY**

**Article 26**

[Right of Priority]

1. A person who has duly filed an application for a trade mark in or for any State which is a party to the Paris Convention, or his successors in title, shall, for the purpose of filing a Community trade mark application for the same trade mark in respect of goods or services which are identical with those for which the application has been filed, be entitled to a right of priority for a period of six months following the date of filing of the first application.

2. Every filing which is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements shall be recognised as giving rise to a right of priority.

3. Regular national filing means any filing which is sufficient to establish the date on which the application was made, whatever the outcome of the application.

4. A subsequent application for a trade mark which was the subject of a previous first application in respect of the same goods or services, and which is filed in or for the same State shall, for the purpose of determining priority, be considered as the first application, provided that, at the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without leaving any rights outstanding, and no right of priority has been claimed in respect of it. No right of priority shall thereafter be claimed in respect of the previous application.
5. If the first filing has been made in a State which is not a party to the Paris Convention, paragraphs 1 to 4 shall apply only in so far as that State grants on the basis of a first filing made at the Office a right of priority which is subject to conditions equivalent to those laid down in the Paris Convention and which has equivalent effect.

**Article 27**

*Claiming priority*

An applicant who wishes to take advantage of the priority of a previous application shall file a declaration of priority. The Office may require production of a copy of the previous application and, if necessary, a translation of it in the Office's procedural language.

**Article 28**

*Right of Priority*

The right of priority shall operate so that the date of first filing shall be treated as the date of filing of the Community trade mark application, save for purposes of the application of Article 14.

**Article 29**

*Equivalence of Community filing and national filing*

For purposes of the application of Article 4 of the Paris Convention, a Community trade mark application which has been accorded a date of filing shall in the Member States be equivalent to a regular national filing.

**TITLE IV**

**REGISTRATION PROCEDURE**

**Section 1**

**EXAMINATION OF APPLICATIONS**

**Article 30**

*Examination as to whether the application satisfies the relevant substantive conditions*

1. A Community trade mark application shall be rejected if it cannot be accorded a date of filing because the relevant conditions have not been satisfied.

2. A Community trade mark application which is irregular as to form, or in respect whereof the amount of fees paid is equal to the minimum fee chargeable but less than the prescribed fee, shall be rejected. No right of priority may be claimed in respect of an application where the priority provisions contained in this Regulation have not been complied with.

3. Paragraph 2 shall not apply until the applicant has been requested to correct the irregularities or to pay the prescribed amount of fees.

**Article 31**

*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 rejected as regards those goods or services.

2. Where the trade mark includes an element which is not distinctive, registration of the trade mark may be subject to the applicant's agreeing, if the Office requests him to do so, that his rights in the trade mark are not exclusive.

3. The application shall not be rejected before the applicant has been allowed the opportunity of withdrawing or amending the application or of submitting his observations on the matter.

4. The application shall be published in respect of the goods or services for which it is not ineligible for registration.

5. Where, after publication, the application is rejected under paragraph 1 or 2, the decision that it has been rejected shall, upon becoming final, be published.

**Article 32**

*Amendment of application*

A Community trade mark application may upon request be amended by restricting the list of goods or services, or by rectifying the name and address of the
applicant, errors of wording or of copying, or other obvious mistakes, provided that such rectification does not substantially change the trade mark.

Section 2
OBSERVATIONS BY THIRD PARTIES AND OPPOSITION

Article 33
[Observations by third parties]
Any natural or legal person and any group or body representing manufacturers, producers, traders or consumers, may, after publication of a Community trade mark application, submit to the Office written observations explaining on which grounds, under Article 6, the trade mark is ineligible for registration.

Article 34
[Opposition]
1. Proprietors of trade marks of the kinds referred to in Article 7 may within three months following publication of a Community trade mark application enter opposition to registration of the trade mark. Registration may be opposed only on grounds of illegibility under Article 7.

2. Opposition shall be expressed in writing and shall specify the grounds on which it is made. It shall not be treated as duly entered until the opposition fee has been paid.

3. If the opposing party has no habitual residence or place of business within the Community he shall, if the applicant so requests, provide security for the costs of the proceedings. The amount of security and the date by which it must be provided shall be determined by the Office. If security is not provided, the opposition shall be treated as having been withdrawn.

Article 35
[Examination of opposition]
1. When examining the opposition the Office shall invite the parties to submit their observations.

2. If the applicant so requests or the Office so requires, the proprietor of an earlier Community trade mark who has entered an opposition shall furnish proof that that trade mark has been used in manner required by Article 13 during the period of five years preceding the date of publication of the Community trade mark application, 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 purposes of the examination of the opposition, be deemed to be registered in respect of the part. This provision shall apply where the earlier trade mark is a trade mark of the kind described in subparagraph (b) or (c) of paragraph 2 of Article 7.

3. The Office shall, if it thinks fit, invite the parties to make a friendly settlement. The Office shall make proposals to them for this purpose if it considers that conditions can be imposed on the prospective use of the trade mark applied for and of the earlier trade mark in such manner that there will be no serious likelihood of confusion on the part of the public.

4. If examination of the opposition reveals that the trade mark is not eligible for registration 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 rejected in respect of those goods or services. Otherwise the opposition shall be rejected.

5. Where a final decision is taken to refuse the application the decision shall be published.

Section 3
REGISTRATION

Article 36
Where an application meets the requirements of this Regulation and the registration fee has been paid in due time, the trade mark shall be registered as a Community trade mark. If the fee is not paid within the period prescribed the application shall be deemed to have been withdrawn.
TITLE V

RENEWAL

Article 37
1. Where it is desired to renew the registration of a Community trade mark an application shall be made. A declaration of user shall be produced and fees shall be paid.

2. The declaration of user shall specify the goods or services in respect of which the Community trade mark has been used in manner required by Article 13 during the period of five years prior to expiry of the registration.

3. The application shall be submitted, the declaration of user produced and the fees paid not earlier than six months before expiry of the registration.

4. Where the application is submitted, the declaration of user produced and the fees paid in respect of part only of the goods or services for which the Community trade mark is registered, registration shall be renewed only for that part of the goods or services.

5. Renewal shall take effect from the date on which the existing registration expires. The renewal shall be registered.

TITLE VI

SURRENDER, REVOCATION, INVALIDITY

Section 1
SURRENDER

Article 38
1. A Community trade mark may be surrendered in respect of some or all of the goods or services for which it is registered.

2. Surrender shall be effected by the proprietor of the trade mark by means of writing delivered to the Office. The surrender shall not have effect until it is recorded in the Register.

3. Surrender shall be registered only with the consent of any third party who has a right in rem which is recorded in the Register. If a licence is recorded in the Register, the surrender shall be recorded only if the proprietor of the trade mark proves that he has previously informed the licensee of his intention to surrender it.

Section 2
GROUNDS FOR AND CONSEQUENCES OF REVOCATION

Article 39

[Grounds for revocation]

1. The rights of the proprietor of a Community trade mark shall be revoked:

(a) if the trade mark has not been used in a manner required by Article 13 during an unbroken period of five years; but no person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, the trade mark has been used in manner required by Article 13 and this use was made in good faith;

(b) if, in consequence of acts of the proprietor, the trade mark has become the common name for a product or service in respect whereof it is registered;

(c) if, in consequence of the use made of it in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

2. Where the grounds for revocation of rights exist in respect of part only of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be revoked in respect only of that part of the goods or services.

Article 40

[Consequences of revocation]

1. Revocation shall be declared by a decision adopted in conformity with the terms of this Regulation.

2. The Community trade mark shall, within the tenor of the decision revoking it, be deemed not to
have had the effects provided for in this Regulation from the time when any of the grounds for revocation existed.

3. Subject to the provisions contained in the laws of the Member States relating to actions for compensation for damage caused by negligence or by lack of good faith on the part of the proprietor of the trade mark, or relating to unjust enrichment, the retroactive effect of revocation shall not affect:

(a) any decision on infringement which has acquired the authority of a final decision and has been executed before the decision revoking the rights of the proprietor was adopted;

(b) any contract concluded before the decision revoking the rights of the proprietor was adopted, in so far as the contract has been performed before the adoption of that decision; but restitution of sums paid under the contract may be claimed on grounds of equity to the extent justified by the circumstances.

Section 3

GROUNDS FOR AND CONSEQUENCES OF INVALIDITY

Article 41

[Absolute grounds of invalidity]

1. A Community trade mark which is registered in breach of the provisions of Article 6 shall be invalid.

2. Where subparagraph (a) of paragraph 1 of Article 6 has been contravened, the Community trade mark shall nevertheless not be declared invalid if it has become distinctive after registration.

3. Where the ground of invalidity exists in respect of part only of the goods or services for which the Community trade mark is registered, the trade mark shall be invalid as regards only that part of the goods or services.

Article 42

[Relative grounds of invalidity]

1. A Community trade mark shall be invalid:

(a) where a trade mark of the kind described in Article 7 exists in opposition to it and the conditions set out in paragraph 1 or 3 of that Article obtain;

(b) where some other prior right exists in opposition to it and there is a serious likelihood of confusion on the part of the public between the trade mark and that right; but this provision shall not apply if the right subsists only in a particular locality. The expression 'some other prior right' means any sign used in the course of trade before filing of the Community trade mark application and which, under the law of the Member State which governs the sign, entitles the proprietor to prohibit the use of any later trade mark.

2. A Community trade mark shall also be invalid if it contains:

(a) a work protected by copyright or by an industrial design or model;

(b) a portrait;

(c) a surname, where use of the trade mark in relation to the goods or services for which it is registered is liable to cause serious detriment to the honour, reputation or credit of the person whose surname it is.

3. A Community trade mark shall not be declared invalid where the proprietor of any such right as is mentioned in paragraph 1 or 2 has consented to registration of that trade mark.

4. Where the proprietor of any such right as is mentioned in paragraph 1 or 2 applies for a declaration that a Community trade mark is invalid, he shall not enter a new application for that purpose on the basis of another such right which he could have averred in support of the first application.

5. Paragraph 3 of Article 41 shall apply.

Article 43

[Consequences of invalidity]

1. Where a decision is adopted declaring a Community trade mark invalid, the trade mark shall, within the tenor of the decision declaring it invalid, be deemed never to have had the effects provided for in this Regulation from the time when the trade mark came into existence.

2. Paragraphs 1 and 3 of Article 40 shall apply to invalidity of Community trade marks.

Artie 44

[Limitation in consequence of acquiescence]

1. Where the proprietor of any such right as is mentioned in paragraph 1 or 2 of Article 42 has acquiesced in the use of a Community trade mark for a period of three successive years, he shall not be entitled to apply for a declaration that the trade mark is invalid on the ground that he did not consent to the use of the trade mark.
2. Paragraph 1 shall not affect the right of the proprietor of a well-known trade mark, as defined in paragraph 2 of Article 7, to apply for a declaration that a Community trade mark is invalid, provided he makes the application within the period of five years following registration of the Community trade mark.

3. The proprietor of a Community trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though the proprietor of that right is no longer entitled to apply for a declaration that the Community trade mark is invalid.

Article 45

[Prior rights subsisting in particular localities]

1. The proprietor of a prior right subsisting in a particular locality may oppose use of the Community trade mark in the territory where his right is valid.

2. Paragraph 1 shall cease to apply if the proprietor of the prior right has acquiesced in the use of the Community trade mark for a period of three successive years; but this provision shall not apply if the Community trade mark was applied for in bad faith.

3. The proprietor of the Community trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even if that provision has ceased to apply.

Section 4

PROCEEDINGS IN THE OFFICE IN RELATION TO REVOCATION OR INVALIDITY

Article 46

[Application for revocation or for a declaration of invalidity]

1. An application for revocation of the rights of the proprietor of a Community trade mark or for a declaration that the trade mark is invalid may be submitted to the Office:

(a) where Articles 39 and 41 apply, by any natural or legal person and any group or body which has the capacity to be a party to proceedings in court, whether as plaintiff or defendant, for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers.

(b) where paragraph 1 of Article 42 applies, by the proprietor of the trade mark or other prior right;

(c) where paragraph 2 of Article 42 applies, by the owner of the copyright, the proprietor of the design or model, the owner of the relevant surname, the person who is the subject of the portrait, or the persons who are entitled under the laws of the Member States to exercise the rights in question.

2. The application shall be submitted in writing and shall specify the grounds on which it is made. Before the fee has been paid the application shall be treated as not having been submitted.

3. Paragraph 3 of Article 34 shall apply.

4. An application for revocation or for a declaration of invalidity shall not lie if an application relating to the same subject-matter and cause of action, and involving the same parties, has been adjudicated on by a court in a Member State.

Article 47

[Examination of the application]

1. The Office may stay the proceedings of its own motion or at the request of any of the parties if, under paragraph 1 of Article 78, a counterclaim for revocation of the rights of the proprietor of the Community trade mark or for a declaration that the Community trade mark is invalid has been filed with a court in a Member State.

2. When the Office examines the application for revocation of rights or for a declaration of invalidity, it shall as often as necessary invite the parties to file observations on communications from third parties or issued by itself.

3. The Office may of its own motion contend that the Community trade mark, having been registered in breach of Article 3, Article 4 or subparagraphs (b) and (c) of paragraph 2 of Article 6, is invalid.

4. If the proprietor of the Community trade mark so requests or the Office so requires, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that that trade mark has been used in manner required by Article 13 during the period of five years preceding the date of the application for a declaration of invalidity, provided that at that date the earlier Community trade mark has 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 has 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 paragraph 2 of Article 35 were satisfied at that date. In the absence of such proof the application for a declaration of invalidity shall be rejected. Where 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
examinining the application for a declaration of invalidity, be deemed to be registered in respect only of that of the goods or services. This provision shall apply where the earlier Community trade mark is a trade mark of the kind described in subparagraph (b) or (c) of paragraph 2 of Article 7.

5. In the course of the invalidity proceedings the Office shall, if it thinks fit, invite the parties to make a friendly settlement. The Office shall make proposals to them for this purpose if it considers that conditions can be imposed on the prospective use of the Community trade mark, of the earlier trade mark or of the prior right in such manner that there will be no serious likelihood of confusion on the part of the public.

6. Where a final decision is taken revoking the rights of the proprietor of the Community trade mark or declaring it invalid, it shall be removed from the register.

TITLE VII

APPEALS

Article 48

[Decisions from which an appeal will lie]

1. An appeal shall lie from decisions of the Office. It shall have suspensive effect.

2. An appeal against a decision which does not terminate proceedings as regards one of the parties may only be made in conjunction with an appeal against the final decision, unless the latter contemplates separate appeal.

Article 49

[Persons entitled to appeal and to be parties to proceedings on appeal]

Any party to proceedings who is adversely affected by a decision may appeal. The other parties to those proceedings shall automatically be parties to the appeal proceedings.

Article 50

[Time limit and form of appeal]

Notice of appeal shall be filed in writing at the Office within two months after notification of the decision from which the appeal is made. Until such time as the fee for appeal has been paid the notice shall be treated as not having been filed. Within four months after notification of the decision a written statement setting out the grounds of appeal shall be filed.

Article 51

[Interlocutory revision]

1. If the department whose decision is contested considers that the appeal properly lies and is well-founded, it shall rectify its decision. This shall not apply where the appellant is in the proceedings opposed by another party.

2. If the appeal is not allowed within one month after receipt of the statement of grounds, the appeal shall forthwith be remitted to the Board of Appeal without comment on the merits.

Article 52

[Examination of appeals]

If the appeal properly lies, the Board of Appeal shall as often as necessary invite the parties to file observations on communications from another party or issued by itself.

Article 53

[Decision on appeal]

In deciding the appeal the Board of Appeal may exercise any power which lies within the competence of the department whose decision is the subject of the appeal, or it may remit the case to that department for further action. In the latter case the department shall, in so far as the facts are the same, be bound by the decision of the Board of Appeal and by the grounds on which it is based.

Article 54

[Further appeal by the parties]

1. A further appeal to the Court of Justice of the European Communities shall lie from decision of the Boards of Appeal. Such further appeals shall have suspensive effect.

2. The further appeal may be lodged on grounds of want of jurisdiction, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application, in so far as that rule of law is not a provision of national law, or misuse of power. The Court of Justice shall not question the facts as found by and recorded in the decision of the Board of Appeal.
Section 1

GENERAL PROVISIONS

Article 56

[Statement of grounds on which decisions are based]

Decisions of the Office shall state the grounds on which they are based. They shall be based only on
grounds or on evidence on which the parties involved have had the opportunity of presenting their observations.

Article 57

[Examination of the facts by the Office of its own motion]

In proceedings before it the Office shall examine the facts of its own motion. It may disregard facts or
items of evidence which have not been submitted in due time by the parties involved.

Article 58

[Oral proceedings]

1. If the Office considers that oral proceedings would be useful they shall be held either on motion of
the Office itself or at the request of any of the parties to the proceedings.

2. Oral proceedings before the Examining Division, Opposition Division or Administration
Division shall not be public.

3. Oral proceedings, including delivery of the decision, shall, as regards the Cancellation Division
and the Board of Appeal, be public, in so far as the department before which the proceedings are taking
place does not decide otherwise in circumstances where serious and unwarranted disadvantages could
arise from admitting the public, particularly for any of the parties to the proceedings. In derogation from
paragraph 2, this present paragraph shall apply to oral proceedings before the Opposition Division in
cases where Article 91 applies.

Article 59

[Taking of evidence]

1. In any proceedings before the Office, the means of giving or obtaining evidence shall include the
following:

(a) hearing the parties;
(b) requests for information;
(c) production of documents;
(d) hearing the witnesses;
(e) opinions by experts;
(f) inspection;
(g) sworn statements in writing.
2. The relevant department may commission one of its members to examine the evidence adduced.

3. If the Office considers it necessary that a party, witness or expert give evidence orally, it shall either:
   (a) issue a summons requiring the relevant person to appear before it, or
   (b) request the competent judicial authority in the country of residence of the relevant person to take the evidence, as provided in paragraph 3 of Article 70.

4. A party, witness or expert who is summoned before the Office may request it to allow his evidence to be heard by the competent judicial authority in his country of residence. On receipt of such request, or if there is no response to the summons, the Office may, in accordance with the provisions of paragraph 3 of Article 70, request the competent judicial authority to take the evidence of that person.

5. If a party, witness or expert gives evidence before the Office, the Office may, if it considers it advisable that the evidence be given in solemn form, request the competent authority in the country of residence of the relevant person to hear his evidence under the requisite conditions.

6. When the Office requests a competent judicial authority to take evidence, it may request it to take the evidence in solemn form and to permit a member of the relevant department to attend the hearing and question the party, witness or expert either through the intermediary of that judicial authority or directly.

**Article 60**

**[Service]**

The Office shall effect service of all decisions and summonses, and of notices which cause time-limits to run or which are required to be served either in pursuance of other provisions of this Regulation or by order of the President of the Office.

**Article 61**

**[Restitutio in integrum]**

1. Where, in spite of having taken all due care in the particular circumstances, the applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office has been unable to observe a time-limit vis-à-vis the Office, his rights shall, upon application, be restored if his failure to respect the time-limit has resulted directly, by virtue of the provisions of this Regulation, in the loss of any right or means of redress.

2. Applications shall be filed in writing within two months after the cause of non-compliance with the time-limit has ceased to operate. The act omitted shall be completed within this period. Application may be made only within the period of one year following the expiry of the time-limit which has not been observed. Where the formalities for renewal have not been complied with, the period specified in paragraph 3 of Article 37 shall be deducted from the one-year period.

3. An application shall state the grounds on which it is based and the facts on which it relies. It shall not be regarded as duly filed until the fee for restoration of rights has been paid.

4. The decision on the application shall be determined by the department which is competent in relation to the omitted act.

5. The provisions of this Article shall not apply to the time-limits referred to in paragraph 2 of this Article nor to the time-limit specified in paragraph 1 of Article 26.

6. The applicant for or proprietor of a Community trade mark shall not oppose the use of a sign in good faith by a third party during the period between the time when the rights in the application or in the trade mark are lost and the restoration of those rights.

**Article 62**

**[Reference to general principles]**

In the absence of procedural provisions in this Regulation, the Office shall take into account the principles of procedural law which are generally recognized in the Member States.

**Article 63**

**[Termination of financial obligations]**

1. The Office’s right to require payment of fees shall be extinguished after four years from the end of the calendar year in which the fees become due for payment.

2. Rights against the Office for the refunding of fees or of sums overcharged by the Office shall be extinguished after four years from the end of the calendar year in which the rights arose.

3. A request for payment of a fee shall have effect to interrupt the period specified in paragraph 1, and a written claim for refund, stating the grounds on which it is made, shall have effect to interrupt the period specified in paragraph 2. After interruption the period shall begin to run again immediately and shall terminate at the latest six years after the end of the calendar year in which it originally commenced, unless in the meantime judicial proceedings to enforce the right have been instituted; in this case the period shall end not earlier than one year after the
Section 2

COSTS

Article 64
[Costs]

1. Each party to opposition proceedings or to proceedings for revocation or for a declaration of invalidity shall pay the costs incurred by him unless the Opposition Division or Cancellation Division decides that it would be equitable that the costs of oral proceedings or of certain stages in the examination be borne in some other manner. A decision concerning division of costs may, if applied for, be adopted where a Community trade mark application, an opposition, an application for revocation of rights or an application for a declaration of invalidity is withdrawn, or where registration of a Community trade mark is not renewed or where the proprietor of a Community trade mark surrenders it.

2. Paragraph 1 shall also apply to the costs incurred by each of the parties to appeal proceedings. A Board of Appeal decision on division of costs may cover all essential items including travel and subsistence and the remuneration of an agent, adviser or advocate.

3. The Registrar of the Opposition Division or Cancellation Division shall upon application determine the amount of costs to be paid where a decision is taken to divide them. The amount so determined may upon application be amended if the Opposition Division or Cancellation Division so decides.

Article 65
[Enforcement of decisions which determine the amount of costs]

1. Final decisions of the Office which determine the amount of costs shall be enforceable.

4. Enforcement shall not be suspended except by decision of the Court of Justice. Control as to the regularity of enforcement measures shall, however, reside with the national courts.

Section 3

INFORMATION OF THE PUBLIC AND OF THE OFFICIAL AUTHORITIES OF THE MEMBER STATES

Article 66
[Register of Community trade marks]

The Office shall keep a register which shall be known as the Register of Community trade marks, wherein shall be recorded the particulars whose registration is required by this Regulation. The Register shall be open to public inspection.

Article 67
[Inspection of files]

1. The files relating to Community trade mark applications which are awaiting publication shall not be made available for inspection without the consent of the applicant.

2. Any person who proves that the applicant for a Community trade mark has stated, directly or indirectly, that after the trade mark has been registered he will invoke it against that person, may, without the applicant's consent, inspect the file before the application is published.

3. After publication of a Community trade mark application the files relating to the application and to the trade mark itself may be inspected on request. Certain documents in the file may, however, be withheld from inspection.

Article 68
[Community Trade Marks Bulletin]

The Office shall publish periodically a Community Trade Marks Bulletin containing entries made in the Register of Community trade marks and all other particulars of which publication is required under this Regulation.
**Article 69**

**[Classification of Community trade marks]**

Goods and services for which Community trade marks are applied for shall be classified in conformity with the Office's system of classification.

**Article 70**

**[Administrative and legal cooperation]**

1. Unless this Regulation otherwise provides, the Office and the courts or authorities of the Member States shall on request give assistance to each other by supplying information or sending files for inspection. Where the Office sends files for inspection to courts, Public Prosecutors’ Offices or central industrial property offices the restrictions laid down in Article 67 shall not apply.

2. Information received in pursuance of paragraph 1 shall be used only for the purpose for which it was requested. The Office and the courts or authorities of the Member States, and the officials and other employees thereof, shall not disclose information received by them in pursuance of paragraph 1 if that information is of a confidential nature.

3. Upon receipt of letters rogatory from the Office, the courts or other competent authorities of the Member States shall undertake on its behalf any enquiries or other judicial measures to the extent that they have power to do so.

**Article 71**

**[Exchange of publications]**

The Office and the central industrial property offices of the Member States shall on request despatch to each other for their own use, free of charge, one or more copies of their respective publications.

## Section 4

**REPRESENTATION**

**Article 72**

**[General principles applicable to representation]**

1. No person shall be compelled to be represented before the Office by a professional representative.

2. However, any natural or legal person whose place of habitual residence or principal place of business is not in the Community shall be represented before the Office by a professional representative.

3. Natural or legal persons whose place of habitual residence or principal place of business is in the Community may act vis-à-vis the Office through one of their employees; due authority shall be conferred for this purpose on such employee. An employee of a legal person to which this paragraph applies may, in derogation from paragraph 2 in appropriate cases, also represent other legal persons which are economically associated with that legal person.

**Article 73**

**[Professional representatives]**

1. Professional representation of natural or legal persons before the Office may be undertaken by:

(a) any advocate who is authorized to practice in a Member State and whose place of business is in the Community, to the extent that he can act in that State as a representative in trade mark matters; or

(b) those professional representatives whose names appear on the list maintained for this purpose by the Office.

2. Any natural person who fulfils the following conditions may be entered on the list of professional representatives:

(a) he must be a national of one of the Member States;

(b) his place of business or employment must be in the Community;

(c) he must be entitled to represent natural or legal persons in trade mark matters before the competent departments in the Member State where he practises or is employed. Where, in that State, the right to act is not conditional on the obtaining of a particular professional qualification, any person who acts in trade mark matters before the competent departments of that State and who applies for his name to be entered on the list must have practised continuously for not less than five years.

3. Entry on the list shall be effected upon request, provided it is accompanied by a certificate issued by the central industrial property office showing that the conditions laid down in paragraph 2 are satisfied.
TITLE IX

JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO COMMUNITY TRADE MARKS

Section 1

JURISDICTION

Article 74

[Jurisdiction of national courts to bear actions for infringement of Community trade marks]

1. Actions for infringement of a Community trade mark shall be heard by the courts of the Member State in which the defendant has his habitual residence or, if he has no habitual residence in the Community, in which he has a place of business. If the defendant has neither habitual residence nor place of business in one of the Member States, such actions shall be heard by a court in the Member State in which the plaintiff has his habitual residence or, if he has no habitual residence in the Community, in which he has a place of business. If neither the defendant nor the plaintiff has his habitual residence or a place of business in the Community, the action shall be heard by a court in the State in which the headquarters of the Office is situated. The court hearing the action shall have jurisdiction in respect of acts of infringement alleged to have been committed in any Member State.

2. Actions for infringement of a Community trade mark may also be heard by a court in the Member State in which an act of infringement has been committed. The court hearing the action shall have jurisdiction only in respect of acts of infringement alleged to have been committed in that State.

3. If the court hearing the action finds that the Community trade mark has been infringed by use of another Community trade mark it shall order that the latter shall not be used anywhere in the Community; in any other case the order prohibiting the use of the Community trade mark shall have effect only in the Member State in which an act of infringement occurred.

Article 75

[Supplementary provisions]

Each Member State shall arrange that actions for infringement of Community trade marks which are brought at first instance shall be heard by a court which has jurisdiction for the whole of that State or for several jurisdictional districts therein.

Section 2

PROCEDURE

Article 76

[Rules applicable]

Unless this Regulation otherwise provides, actions for infringement of Community trade marks shall be subject to those rules of procedure applicable in the laws of the Member States to actions for infringement of national trade marks.

Article 77

[Persons who are entitled to bring an action for infringement]

1. Actions for infringement may be brought by the proprietor of a Community trade mark. A licensee may bring such actions only if the proprietor consents thereto.

2. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in an infringement action brought by the proprietor of the Community trade mark.

Article 78

[Counterclaims for declaration of revocation or invalidity]

1. The court which is hearing an action for infringement of a Community trade mark shall have jurisdiction to give judgment on a counterclaim made by the original defendant for a declaration that the rights of the proprietor are revoked or that the trade mark is invalid.

2. No such counterclaim as aforesaid may be made if an application or counterclaim relating to the same subject-matter and cause of action, and involving the same parties, has been determined by the Office.

3. Article 47, paragraphs 2 to 5 shall apply.

4. If the court declares that the rights of the proprietor are revoked or that the Community trade mark is invalid, it shall of its own motion order that the trade mark be removed from the Register. When the judgment has acquired the authority of a final decision, the Office shall remove the trade mark from
the Register upon application by whichever of the parties first requests it.

Article 79
[Stay of proceedings]
1. The court which is hearing a counterclaim under paragraph 1 of Article 78 for a declaration that the rights of the proprietor of a Community trade mark are revoked or that the trade mark is invalid may, of its own motion or on application by any of the parties, stay the proceedings and invite the original defendant to present to the Office, within such time as the court determines, an application for a declaration of revocation or for a declaration of invalidity.

 Article 80
[Defences as to the merits]
In proceedings concerning a Community trade mark, the fact that the proprietor's rights therein have been revoked or that the trade mark is invalid shall not be pleaded by way of defence as to the merits.

TITLE X
EFFECT ON THE LAWS OF THE MEMBER STATES

Section 1
CUMULATIVE PROTECTION PROHIBITED

Article 81
1. Where the proprietor of a Community trade mark is also the proprietor in a Member State of a national trade mark which is identical with or similar to the Community trade mark and is for goods or services for which the Community trade mark is registered, the effects of the national trade mark shall, upon publication of the registration of the Community trade mark, be suspended for so long as the Community trade mark produces its effects.

2. The proprietor of the Community trade mark shall however be entitled to claim that in the Member State in which the national trade mark exists, or continues to be registered, his rights in the Community trade mark are effective from the date on which he acquired the national trade mark.

3. In derogation from paragraph 1, the effects of the national trade mark shall not revive if the Community trade mark is removed from the Register following a declaration that the proprietor's rights therein are revoked on the ground of non-user.

Section 2
PROHIBITION ON APPLICATION OF THE NATIONAL LAWS OF THE MEMBER STATES TO COMMUNITY TRADE MARKS

Article 82
Without prejudice to Article 45, the national laws of the Member States shall not apply in relation to the validity or use of Community trade marks.

2. The court which is hearing any action relating to a Community trade mark may also, of its own motion or on application by any of the parties, stay the proceedings where an application for a declaration that the rights of the proprietor of a Community trade mark shall be revoked or that such trade mark is invalid has been submitted to the Office.

Article 83
[Request for the application of national procedure]
1. The central industrial property offices in the Member States shall not apply the procedure for registration of a national trade mark on the basis of a Community trade mark application or Community trade mark, save where the applicant or proprietor of the trade mark so requests and the following circumstances obtain:

(a) the Community trade mark application has been refused, withdrawn or deemed to have been withdrawn;

(b) the Community trade mark ceases to have effect, but this provision shall not apply where the trade mark has been removed from the Register following a declaration that the proprietor's rights are revoked on the ground of non-user.

2. Paragraph 1 shall apply only in those Member States where the Office or a national court has not decided that grounds for refusal of registration or grounds of invalidity exist under this Regulation in connection with the Community trade mark application or in connection with the Community trade mark itself.

3. A request for conversion shall be filed within three months after the application has been refused or withdrawn or within three months after the Community trade mark ceases to have effect. An
application or proprietor who does not file within the
said period of three months shall lose the right to
claim priority for the national trade mark from the
date of filing of the application or from the date of
the Community trade mark.

Article 84

[Submission of the request for conversion]

1. The Member States shall determine the
conditions which are to apply to the submission of
requests for conversion.

2. The Office shall, if so requested, and provided
the fee is paid, make available to the applicant or
proprietor a copy of the file relating to the
Community trade mark application or Community
trade mark.

Article 85

[Communication and publication]

1. The central industrial property offices in the
Member States shall inform the Office of all requests
for conversion which they receive.

2. Receipt of any such request shall be recorded in
the Register of Community trade marks. If the
Community trade mark application has been
published, the request for conversion shall be
published also.

TITLE XI

COMMUNITY GUARANTEE MARKS AND COMMUNITY
COLLECTIVE MARKS

Article 86

[Community guarantee marks]

1. Community guarantee marks may consist of any
sign which is described as such when the guarantee
mark is applied for, if its purpose is to guarantee the
quality, method of manufacture or other common
characteristics of goods or services of different
undertakings which use the guarantee mark under the
proprietor's control.

2. Community guarantee marks shall not be used in
respect of goods or services produced or supplied by
the proprietor himself or by a person who is
economically associated with him.

Article 87

[Community collective marks]

Representative groups or bodies of manufacturers,
producers, suppliers of services, or traders may, if
they have legal personality, apply for Community
collective marks which are described as such in the
application and are capable of distinguishing the
goods or services of their members from those of
other undertakings.

Article 88

[Application of provisions]

The provisions of this Regulation shall apply to
Community guarantee marks and to Community
collective marks, unless Articles 86 to 99 provide
otherwise.

Article 89

[Rules relating to the mark]

1. Applications for Community guarantee marks or
Community collective marks shall be accompanied
by regulations relating to them.

2. The regulations governing a Community
guarantee mark shall set out the common
characteristics of the goods or services which the
mark is intended to guarantee and shall specify the
detailed arrangements for real and effective
supervision of the use of the mark, and suitable
sanctions.

Article 90

[Refusal of application]

1. An application for a Community guarantee mark
or Community collective mark shall be refused where
the provisions of Articles 86, 87 or 89 are not
satisfied, or where the regulations are contrary to
public policy or to accepted principles of morality.

2. An application for a Community guarantee mark
shall also be refused if the public is liable to be misled
as regards the nature of the mark.

Article 91

[Opposition of Community guarantee marks on
absolute grounds for refusal]

1. Any natural or legal person and any group or
body which has the capacity to be a party to
proceedings in court, whether as plaintiff or defendant, for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers may, within a period of three months after publication of an application for a Community guarantee mark, file opposition at the Office, on any of the following grounds, against registration of the mark:

(a) that under Article 6 or 86 the mark is ineligible for registration;
(b) that the regulations do not comply with the requirements of paragraph 2 of Article 89 or are contrary to public policy or to accepted principles of morality;
(c) that the public is liable to be misled as regards the nature of the mark.

2. The opposition shall be expressed in writing and shall specify the grounds on which it is based. It shall not be treated as duly entered until the opposition fee has been paid.

**Article 92**

[Observations by third parties]

Article 33 shall apply in the cases described in Article 90.

**Article 93**

[Use of marks]

The use made of a Community guarantee mark or of a Community collective mark by a person entitled to use it shall be in conformity with the provisions of this Regulation and with the conditions which it imposes as regards such use.

**Article 94**

[Amendment of the regulations governing the mark]

1. The proprietor of a Community guarantee mark or of a Community collective mark shall inform the Office of any amendment to the regulations governing it.

2. Amendments shall not be accepted if they are inconsistent with the provisions of Article 86 or are contrary to public policy or to accepted principles of morality, or, where they relate to Community guarantee marks, are liable to mislead the public as regards the nature of the mark or the guarantees provided by the regulations.

3. The Office shall publish the amendments to regulations governing Community guarantee marks or Community collective marks, or shall publish the fact that the regulations have been amended. Where the amendments are published in full, Articles 91 and 92 shall apply.

4. Amendments to regulations shall not take effect until they have been registered.

**Article 95**

[Persons who are entitled to bring an action for infringement]

1. The provisions of Article 77 concerning the rights of licensees shall apply to every person who has authority to use a Community guarantee mark or Community collective mark.

2. The proprietor of a Community guarantee mark or Community collective mark shall also be entitled to claim compensation for damage sustained by persons who have authority to use the mark, if the damage arises in consequence of an unauthorized use of the mark.

**Article 96**

[Grounds for revocation]

The rights of the proprietor of a Community guarantee mark or of a Community collective mark shall be revoked if:

(a) he uses the mark in a manner which is inconsistent with the provisions of paragraph 2 of Article 86, or
(b) he authorizes or acquiesces in the use of the mark on terms which are different from those prescribed by this Regulation.

**Article 97**

[Grounds for and consequences of invalidity]

1. A Community guarantee mark or a Community collective mark which is registered in breach of the provisions of Article 90 shall be invalid. Such mark shall also be invalid if an amendment to the regulations governing it is registered in breach of paragraph 2 of Article 94. The provisions of this Article shall not apply however if the proprietor of the mark, by further amending the regulations, complies with the requirements of those Articles.

2. Where a Community guarantee mark or Community collective mark is invalid in consequence of amendment of the regulations governing it, it shall be deemed not to have had the effects provided for in this Regulation from the time when the amendment was registered.

**Article 98**

[No applications to be made for registration of Community guarantee marks or Community collective marks which have been removed from the Register, and such marks are not to be used]

1. Where a Community guarantee mark or a Community collective mark has not been renewed, or
the proprietor's rights therein have been revoked, or the mark has been declared invalid or has been surrendered, no fresh application shall be made for registration thereof and it shall not be used on any ground whatsoever for goods or services which are similar to those in respect of which it was registered until three years have elapsed since the relevant non-renewal, revocation, surrender or declaration of invalidity.

2. Without prejudice to the application of subparagraph (b) of paragraph 1 of Article 83, paragraph 1 of this Article shall not apply to the former proprietor of the mark or to his successors in title thereto.

TITLE XII

THE COMMUNITY TRADE MARKS OFFICE

Section 1

GENERAL PROVISIONS

Article 99

[Legal Status]

1. The Office is a body of the Community.

2. In each of the Member States the Office shall enjoy the most extensive legal capacity accorded to legal persons under their laws; it may, in particular, acquire or dispose of movable and immovable property and may be a party to legal proceedings. For these purposes the Office shall be represented by its President.

3. The seat of the Office shall be located at...

Article 100

[Staff]

1. The Staff Regulations of officials of the European Communities, the conditions of employment of other servants of the European Communities, and the rules adopted jointly by the Institutions of the European Communities for purposes of the application of those Staff Regulations and conditions of employment shall apply to the staff of the Office, but without prejudice to the application of Article 118 to the members of the Boards of Appeal.

2. Without prejudice to Article 105, the powers conferred on each Institution by the Staff Regulations, and by the conditions of employment of other servants, shall be exercised by the Office in relation to its staff.

Article 101

[Privileges and immunities]

The Protocol on the Privileges and Immunities of the European Communities shall apply to the Office.

Article 102

[Liability]

1. The contractual liability of the Office shall be governed by the law applicable to the relevant contract.

2. The Court of Justice of the European Communities shall have jurisdiction to give judgment pursuant to any arbitration clause contained in a contract concluded by the Office.

3. As regards non-contractual liability, the Office shall, in accordance with the general principles common to the laws of the Member States, make good any damage caused by its departments or servants in the performance of their duties.

4. The Court of Justice shall have jurisdiction in disputes relating to compensation for any such damage as is referred to in paragraph 3.

5. The personal liability of servants towards the Office shall be governed by the provisions laid down in its Staff Regulations or in the conditions of employment applicable to its staff.

Article 103

[Language]

The language of the Office for procedural purposes is...

Section 2

ADMINISTRATION OF THE OFFICE

Article 104

[Powers of the President]

1. The Office shall be administered by the President.

2. To this end the President shall have *inter alia* the following functions and powers:
(a) he shall take all necessary steps, including the adoption of internal administrative instructions and the publication of notices to ensure the functioning of the Office;

(b) he may, after consulting the Advisory Committee, place before the Commission any proposal to amend this Regulation, the implementing Regulation, the rules of procedure of the Boards of Appeal, the fees regulations or the financial rules;

(c) he shall draw up the estimates of revenues and expenditure of the Office and shall implement the budget;

(d) he shall submit a management report to the Commission and Advisory Committee each year;

(e) he shall exercise the powers conferred by paragraph 2 of Article 100;

3. The President shall be assisted by a number of Vice-Presidents. If the President is unable to act, one of the Vice-Presidents shall act in place of him.

Article 105

[Appointment of senior officials]

1. The President of the Office shall be selected from a list of three candidates which shall be prepared by the Advisory Committee, and shall be appointed by the Commission. Power to dismiss the President shall lie with the Commission after consulting the Advisory Committee.

2. The Vice-President of the Office and the members of the Boards of Appeal shall be appointed or dismissed as in paragraph 1.

3. Without prejudice to paragraph 1 of Article 118, the Commission shall exercise disciplinary authority over the employees referred to in paragraphs 1 and 2 of this Article.

Article 106

[Control of legality]

1. The Commission shall be responsible for legal supervision of the acts of the President.

2. It shall require that any unlawful act of the President be altered or annulled.

3. Any Member State, or any third party who is directly and personally concerned, may refer to the Commission any act of the President, whether express or implied, so that the Commission will examine the legality of that act.

Section 3

ADVISORY COMMITTEE

Article 107

[Creation and powers]

1. An advisory committee to the Office is hereby established and is hereinafter referred to as ‘the Committee’.

2. It shall settle the list of candidates provided for in Article 105.

3. It shall advise the President concerning matters for which the Office is responsible.

4. It shall be consulted in the cases provided for in this Regulation.

5. It may deliver opinions to the Commission and to the President where it considers that this is necessary.

Article 108

[Composition]

1. The Committee shall be composed of one representative of the government of each Member State and one representative of the Commission, and their alternates.

2. The members who represent the governments of the Member States, and the alternates of those members, shall be appointed by the Council. The member who represents the Commission, and his alternate, shall be appointed by the Commission.

3. The term of office of members and of their alternates shall be three years. It shall be renewable.

Article 109

[Presidency]

The Committee shall elect a President and Vice-President from among its members. If the President is unable to act the Vice-President shall act in place of him.

Article 110

[Meetings]

1. Meetings of the Committee shall be convened by the President.

2. The President of the Office may take part in the deliberations.

3. The Committee shall hold an ordinary meeting once a year; it shall also meet at the request of its President or of the Commission or of one third of its members.
4. It shall adopt rules of procedure.

5. Its decisions shall be taken by simple majority vote. Where, however, the Committee has to take a decision under paragraph 1 or 2 of Article 105 or paragraph 1 of Article 121, a majority of not less than three quarters of the votes shall be required.

Article 111

[Duties of Office]

The members of the Committee shall be bound, even after cessation of their appointment, not to disclose or make use of information which is of a confidential nature.

Section 4

ARRANGEMENT OF DEPARTMENTS

Article 112

[Departments responsible for procedure]

For the purposes of implementing the procedures laid down in this Regulation, there shall be established within the Office:

(a) an Examining Division;
(b) an Opposition Division;
(c) an Administration of Trade Marks Division;
(d) a Cancellation Division;
(e) Boards of Appeal.

Article 113

[Examining Division]

1. The Examining Division shall be responsible for examining Community trade mark applications and for deciding whether trade marks applied for are to be registered.

2. Decisions of the Examining Division shall be taken by one of its members.

Article 114

[Opposition Division]

1. The Opposition Division shall be responsible for deciding whether a trade mark is to be registered as a Community trade mark in cases where observations are submitted or opposition is entered.

2. Decisions of the Opposition Division shall be taken by three of its members, of whom two shall not have taken part in examining the application. One of the deciding members must be qualified in law.

3. Examination of the opposition may be conducted by one of those three members.

Article 115

[Administration of Trade Marks Division]

1. The Administration of Trade Marks Division shall be responsible for doing all such acts of the Office in relation to Community trade marks as lie outside the competence of other departments thereof. It shall be responsible inter alia for deciding what particulars are to be recorded in or are to be deleted from the Register of Community trade marks.

2. Decisions of the Administration of Trade Marks Division shall be taken by one of its members.

Article 116

[Cancellation Division]

1. The Cancellation Division shall be responsible for examining applications for revocation or for declarations of invalidity of Community trade marks.

2. Decisions of the Cancellation Division shall be taken by three members who are qualified in law.

3. Examination of applications may be conducted by one of those three members.

Article 117

[Boards of Appeal]

1. The Boards of Appeal shall be responsible for examining appeals from decisions of the Examining Division, Opposition Division, Cancellation Division and Administration of Trade Marks Division.

2. Each Board of Appeal shall be composed of three members who are qualified in law.

Article 118

[Independence of members of the Boards of Appeal]

1. The members of the Boards of Appeal shall be appointed for a term of five years and may not be removed from office during that term, except where there are serious grounds for removing them and the
Court of Justice, having been seized by the Commission decides that the member in question shall be removed.

2. The members of the Boards of Appeal shall be independent. In making their decisions they shall not be bound by any instructions they may have received.

3. The members of the Boards of Appeal shall not be members of the Examining Division, Opposition Division, Administration of Trade Marks Division or Cancellation Division.

Article 119

[Exclusion and objection]

1. Members of the Cancellation Division or of the Boards of Appeal shall not take part in determining any matter in which they have a personal interest, or in which they have previously been involved as representatives of any of the parties, or in relation to which they participated in taking the final decision in the course of the registration procedure. Members of the Boards of Appeal shall not take part in appeal proceedings if they participated in making the decision under appeal.

2. If, for any of the reasons mentioned in paragraph 1, or for any other reason, a member of the Cancellation Division or of a Board of Appeal considers that he should not take part in determining a matter, he shall inform the Division or Board accordingly.

3. Members of the Cancellation Division or of a Board of Appeal may be objected to by any party for any of the reasons mentioned in paragraph 1, or if suspected of partiality. An objection shall not lie if, while being aware of a reason for objecting the relevant party has taken any procedural steps. No objection shall be based upon the nationality of members.

4. In the situations mentioned in paragraph 2 and 3 the Cancellation Division and the Boards of Appeal shall decide, without the participation of the member concerned, as to the action to be taken. For the purposes of making the decision the member objected to shall be replaced in the Division or Board of Appeal by his alternate.

Section 5

BUDGET AND FINANCIAL CONTROL

Article 120

[Budget]

1. Estimates of all the Office's revenue and expenditure shall be prepared for each financial year and shall be shown in the Office's budget, and each financial year shall correspond with the calendar year.

2. The revenue and expenditure shown in the budget shall be in balance.

3. Revenue means (without prejudice to other types of income) total fees payable under the fees regulations, and to the extent that it is necessary a subvention recorded under a specific heading of the Budget of the European Communities, Commission Section.

Article 121

[Preparation of the Budget]

1. The President shall draw up each year an estimate of the Office's revenue and expenditure for the following year and shall send it to the Commission not later than 31 March in each year, together with an establishment plan and an opinion from the Committee.

2. The Commission shall annex the estimate to the preliminary draft Budget of the European Communities. The Commission may attach an opinion on the estimate along with an alternative estimate. If a subvention under paragraph 3 of Article 120 is necessary, the Commission may propose such amendment of the estimate as it considers requisite.

3. The Office's budget shall be adopted by the budget authority in accordance with the same procedure as the general budget.

Article 122

[Control]

1. Not later than 31 March in each year the President shall transmit to the Commission and to the Audit Board accounts of the Office's total revenue and expenditure for the preceding financial period. The Audit Board shall examine them in accordance with Article 206a of the Treaty.

2. The European Parliament shall give a discharge to the President of the Office in accordance with the procedure laid down in Article 206c of the Treaty.

3. Control of commitment and payment of all expenditure and control of the existence and recovery of all revenue of the Office shall be carried out by the financial controller of the Commission.

Article 123

[Financial provisions]

The financial regulation applicable to the general budget of the European Communities shall apply to
the Office without prejudice to the provisions contained in this Regulation or to special provisions determined by regulations adopted by the Council in accordance with the conditions laid down in Article 209 of the Treaty.

Article 124

[Fees regulations]

1. The fees regulations shall determine in particular the amounts of the fees and the ways in which they are to be paid.

2. The amounts of the fees shall be fixed in such manner that the Office’s revenue covers its expenditure.

3. The fees regulations shall be adopted on a proposal from the Commission by qualified majority vote of the Council after obtaining the opinion of the European Parliament.

TITLE XIII

FINAL PROVISIONS

Article 125

[Community implementing provisions]

1. The rules implementing this Regulation, particularly as regards the calculation and extension of periods of time to which a time-limit applies, shall be adopted in an implementing regulation.

2. The implementing regulation and the rules of procedure of the Boards of Appeal shall be adopted by the Council, by qualified majority vote, on a proposal from the Commission.

Article 126

[National implementing provisions]

The Member States shall within twelve months following the adoption of this Regulation bring into operation the measures which are requisite for the purpose of implementing Articles 75 and 84 hereof and shall forthwith inform the Commission of those measures.

Article 127

Save as regards Articles 75 and 84, this Regulation shall enter into force twelve months after it has been published in the Official Journal of the European Communities.

This Regulation shall be binding in its entirety and directly applicable in all Member States.