Brussels, 26 November 1987

EUROPEAN COMMUNITIES
THE COUNCIL

PI 101 (MARCA)

NOTE

from: Permanent Representatives Committee
to: Council (Internal Market)

No. prev. doc. 9631/87 PI 92 (MARCA) No. amended Cion. prop. 4090/86 PI 4

Subject: Amended proposal for a first Council Directive to approximate the laws of the Member States relating to trade marks

- Amendments and additions to be made to the text contained in document 9631/87

Council will find the text of the draft first Directive to approximate the laws of the Member States relating to trade marks as it stands after discussion by the Permanent Representatives Committee in document 9631/87 PI 92 (MARCA).

However, the amendments and additions set out below should be made to that text:

1. **Recital 10**

   The text of recital 10 on page 5 should be replaced by the following text:

   ...

   ...

   .../...
"10 whereas the protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and goods or services; whereas the protection applies also in case of similarity between the trade mark and the sign and the goods or services; whereas it is indispensable to interpret the notion of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which depends on numerous elements and in particular on the recognition of the trade mark on the market, on the association which can be made with the used or registered sign, on the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection; whereas the ways in which likelihood of confusion may be established, and in particular the onus of proof, are a matter for national procedural rules which are not prejudiced by the Directive;"

Delete footnote 3.

2. Article 2a paragraph 1(b)

The text on page 12 should be replaced by the following text:

"(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

3. Article 2a paragraph 4(a)

(Does not concern the English text).
4. Article 3 paragraph 1(b)

The text on page 18 should be replaced by the following text:

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

Delete footnotes 8 and 9.

5. Article 3 paragraph 5 (new)

The following new paragraph 5 should be added:

"(5) Paragraphs 1 to 4 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of or is detrimental to the distinctiveness or the repute of the trade mark."

6. Article 7

Delete footnote 10.
7. Article 12

The reference to the German delegation should be removed from footnote 12.

8. Article 14

The reference to the Netherlands delegation should be removed from footnote 13.

9. Article 16 paragraph 2

Paragraph 2 should be replaced by the following text:

"(2) In derogation from Article 2 paragraph 1(c), Member States may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective, guarantee or certification marks. Such a mark does not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use a geographical name."

Delete footnote 14.

10. Article 16

Delete footnote 15.
11. **Statements**

The statements re Article 2a paragraph 1(b) and Article 3 paragraph 1(b) should be replaced by the following texts:

"1. The Council and the Commission consider that, for the purposes of this Directive, goods may be considered to be similar to services in appropriate circumstances.

2. The Council and the Commission note that "likelihood of association" is a concept which in particular has been developed by Benelux case-law."

Delete footnotes 16 and 17.