

**EUROPEAN UNION LAW**  
**INTELLECTUAL PROPERTY LAW**  
**VOLUME II**



**EUROPEAN UNION LAW**  
**INTELLECTUAL PROPERTY LAW**  
**VOLUME II**

**Edited by:**

**Piotr Popowski, Marzena Zarzeczna-Baran, Izabela Adrych-Brzezińska, Lubomira Wengler, Paulina Czarnecka, Piotr Pietrzak, Tadeusz Jędrzejczyk, Ewa Adamska-Pietrzak**

**FIRST EDITION**

**ISBN 978-83-64287-02-2**

**This publication was reviewed.**

**Publisher:**

Polish Society of Health Programs (Polskie Towarzystwo Programów Zdrowotnych )

Al. Zwycięstwa 42A, 80-210 Gdańsk

Tel. +48587358303, fax +48583491548

[www.ptpz.pl](http://www.ptpz.pl)



**POLSKIE TOWARZYSTWO  
PROGRAMÓW ZDROWOTNYCH**

All rights reserved. No part of this book may be reproduced or transmitted without prior permission of the publisher and authors

© Copyright by Polskie Towarzystwo Programów Zdrowotnych

<b>Piotr Popowski</b>	<b>Medical University of Gdansk, Department of Public Health and Social Medicine</b>
<b>Marzena Zarzechna-Baran</b>	<b>Medical University of Gdansk, Department of Public Health and Social Medicine</b>
<b>Izabela Adrych-Brzezińska</b>	<b>Medical University of Gdansk, Department of Medical Law; University of Gdansk, Department of Law</b>
<b>Lubomira Wengler</b>	<b>Medical University of Gdansk, Department of Medical Law</b>
<b>Paulina Czarnecka</b>	<b>Medical University of Gdansk, Department of Public Health and Social Medicine</b>
<b>Piotr Pietrzak</b>	<b>Medical University of Gdansk, Department of Medical Law</b>
<b>Tadeusz Jędrzejczyk</b>	<b>Medical University of Gdansk, Department of Public Health and Social Medicine</b>
<b>Ewa Adamska-Pietrzak</b>	<b>Medical University of Gdansk, Department of Medical Law</b>

**Source of judgments:**

EUR-Lex Access to European Union law <http://eur-lex.europa.eu/>  
Wolters Kluwer Polska S.A.

## Table of Contents

Chapter I. Inventions .....	7
1.1. Regulations.....	7
1.1.1. Regulation (EC) of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems No 816/2006.....	7
1.1.2. Regulation (EC) of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products No 1610/96.....	21
1.1.3. Regulation (EU) of the European Parliament and of the Council implementing enhanced cooperation in the area of the creation of unitary patent protection No 1257/2012	31
1.2. Directives and decisions .....	47
1.2.1. Directive of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions 98/44/EC .....	47
1.2.2. Council Decision of 10 March 2011 authorising enhanced cooperation in the area of the creation of unitary patent protection .....	62
Chapter II. Trade marks .....	67
2.1. Regulations.....	67
2.1.1. Council Regulation (EC) of 26 February 2009 on the Community trade mark (codified version) Text with EEA relevance No 207/2009 .....	67
2.1.2. Commission Regulation (EC) implementing Council Regulation (EC) No 40/94 on the Community trade mark No 2868/95 .....	153
2.1.3. Commission Regulation (EC) on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) No 2869/95 .....	216
2.1.4. Commission Regulation (EC) No 216/96 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) 222	
2.2. Directives and decisions .....	228
2.2.1. Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Codified version) Text with EEA relevance 2008/95/EC.....	228
Chapter III. Industrial designs and utility models.....	243
3.1. Regulations.....	243
3.1.1. Council Regulation (EC) on Community designs No 6/2002 .....	243
of 12 December 2001 .....	243
3.1.2. Commission Regulation (EC) implementing Council Regulation (EC) No 6/2002 on Community designs No 2245/2002 .....	295

3.1.3.	Commission Regulation (EC) on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs No 2246/2002.....	351
3.2.	Directives and decisions .....	356
3.2.1.	Directive of the European Parliament and of the Council on the legal protection of designs 98/71/EC .....	356
	Chapte IV. Topographies of semiconductor products.....	369
4.1.	Directives and decisions .....	369
4.1.1.	Council Directive on the legal protection of topographies of semiconductor products 87/54/EEC .....	369
4.1.2.	Council Decision on the extension of the legal protection of topographies of semiconductor products to persons from the United States of America and certain territories 93/16/EEC.....	378
	of 21 December 1992 .....	378
4.1.3.	Council Decision on the extension of the legal protection of topographies of semiconductor products to persons from Canada 94/700/EC.....	381
4.1.4.	Council Decision on the extension of the legal protection of topographies of semiconductor products to persons from the Isle of Man 96/644/EC .....	384
	Chapter V. Office for Harmonization in the Internal Market .....	387
5.1.	Regulations.....	387
5.1.1.	Council Regulation (EC) on the Community trade mark (codified version) Text with EEA relevance No 207/2009 .....	387
5.1.2.	Regulation (EU) No 386/2012 of the European Parliament and of the Council on entrusting the Office for Harmonization in the Internal Market (Trade Marks and Designs) with tasks related to the enforcement of intellectual property rights, including the assembling of public and private-sector representatives as a European Observatory on Infringements of Intellectual Property Rights.....	468
5.1.3.	Decision taken by common Agreement between the Representatives of the Governments of the Member States, meeting at Head of State and Government level, on the location of the seats of certain bodies and departments of the European Communities and of Europl 478	
	Chapter VI. International treaties (selection).....	484
6.1.	Geneva Act of July 2, 1999 .....	484
6.2.	Uruguay Round of Multilateral Trade Negotiations (1986- 1994) - Annex 1 - Annex 1C - Agreement on Trade-Related Aspects of Intellectual Property Rights (WTO) WTO.....	509

## Chapter I. Inventions

### 1.1. Regulations

#### 1.1.1. Regulation (EC) of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems No 816/2006<sup>1</sup>

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,  
Having regard to the Treaty establishing the European Community, and in particular Articles 95 and 133 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Economic and Social Committee [1],

Acting in accordance with the procedure laid down in Article 251 of the Treaty [2],

Whereas:

On 14 November 2001 the Fourth Ministerial Conference of the World Trade Organisation (WTO) adopted the Doha Declaration on the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) and Public Health. The Declaration recognises that each WTO Member has the right to grant compulsory licences and the freedom to determine the grounds upon which such licences are granted. It also recognises that WTO Members with insufficient or no manufacturing capacity in the pharmaceutical sector could face difficulties in making effective use of compulsory licensing.

On 30 August 2003 the WTO General Council, in the light of the statement read out by its Chairman, adopted the Decision on the implementation of paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health (the Decision). Subject to certain conditions, the Decision waives certain obligations concerning the issue of compulsory licences set out in the TRIPS Agreement in order to address the needs of WTO Members with insufficient manufacturing capacity.

---

<sup>1</sup> *Official Journal L 157*, 09/06/2006 P. 0001 - 0007

Given the Community's active role in the adoption of the Decision, its commitment made to the WTO to fully contribute to the implementation of the Decision and its appeal to all WTO Members to ensure that the conditions are put in place which will allow the system set up by the Decision to operate efficiently, it is important for the Community to implement the Decision in its legal order.

Uniform implementation of the Decision is needed to ensure that the conditions for the granting of compulsory licences for the manufacture and sale of pharmaceutical products, when such products are intended for export, are the same in all Member States and to avoid distortion of competition for operators in the single market. Uniform rules should also be applied to prevent re-importation into the territory of the Community of pharmaceutical products manufactured pursuant to the Decision.

This Regulation is intended to be part of wider European and international action to address public health problems faced by least developed countries and other developing countries, and in particular to improve access to affordable medicines which are safe and effective, including fixed-dose combinations, and whose quality is guaranteed. In that connection, the procedures laid down in Community pharmaceutical legislation guaranteeing the scientific quality of such products will be available, in particular that provided for in Article 58 of Regulation (EC) No 726/2004 of the European Parliament and of the Council of 31 March 2004 laying down Community procedures for the authorisation and supervision of medicinal products for human and veterinary use and establishing a European Medicines Agency [3].

As the compulsory licensing system set up by this Regulation is intended to address public health problems, it should be used in good faith. This system should not be used by countries to pursue industrial or commercial policy objectives. This Regulation is designed to create a secure legal framework and to discourage litigation.

As this Regulation is part of wider action to address the issue of access to affordable medicines for developing countries, complementary actions are set out in the Commission Programme for Action: Accelerated action on HIV/AIDS, malaria and tuberculosis in the context of poverty reduction and in the Commission Communication on a Coherent European Policy Framework for External Action to Confront HIV/AIDS, malaria and tuberculosis. Continued urgent progress is necessary, including actions to support research to combat these diseases and to enhance capacity in developing countries.

It is imperative that products manufactured pursuant to this Regulation reach only those who need them and are not diverted from those for whom they were intended. The issuing of

compulsory licences under this Regulation must therefore impose clear conditions upon the licensee as regards the acts covered by the licence, the identification of the pharmaceutical products manufactured under the licence and the countries to which the products will be exported.

Provision should be made for customs action at external borders to deal with products manufactured and sold for export under a compulsory licence which a person attempts to reimport into the territory of the Community.

Where pharmaceutical products produced under a compulsory licence have been seized under this Regulation, the competent authority may, in accordance with national legislation and with a view to ensuring that the intended use is made of the seized pharmaceutical products, decide to send the products to the relevant importing country according to the compulsory licence which has been granted.

To avoid facilitating overproduction and possible diversion of products, the competent authorities should take into account existing compulsory licences for the same products and countries, as well as parallel applications indicated by the applicant.

Since the objectives of this Regulation, in particular the establishment of harmonised procedures for the granting of compulsory licences which contribute to the effective implementation of the system set up by the Decision, cannot be sufficiently achieved by the Member States because of the options available to exporting countries under the Decision and can therefore, by reason of the potential effects on operators in the internal market, be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality, as set out in that Article, this Regulation does not go beyond what is necessary in order to achieve those objectives.

The Community recognises the utmost desirability of promoting the transfer of technology and capacity-building to countries with insufficient or no manufacturing capacity in the pharmaceutical sector, in order to facilitate and increase the production of pharmaceutical products by those countries.

In order to ensure the efficient processing of applications for compulsory licences under this Regulation, Member States should have the ability to prescribe purely formal or administrative requirements, such as rules on the language of the application, the form to be used, the identification of the patent(s) and/or supplementary protection certificate(s) in

respect of which a compulsory licence is sought, and rules on applications made in electronic form.

The simple formula for setting remuneration is intended to accelerate the process of granting a compulsory licence in cases of national emergency or other circumstances of extreme urgency or in cases of public non-commercial use under Article 31(b) of the TRIPS Agreement. The figure of 4 % could be used as a reference point for deliberations on adequate remuneration in circumstances other than those listed above,

**HAVE ADOPTED THIS REGULATION:**

Article 1

Scope

This Regulation establishes a procedure for the grant of compulsory licences in relation to patents and supplementary protection certificates concerning the manufacture and sale of pharmaceutical products, when such products are intended for export to eligible importing countries in need of such products in order to address public health problems.

Member States shall grant a compulsory licence to any person making an application in accordance with Article 6 and subject to the conditions set out in Articles 6 to 10.

Article 2

Definitions

For the purposes of this Regulation, the following definitions shall apply:

"pharmaceutical product" means any product of the pharmaceutical sector, including medicinal products as defined in Article 1(2) of Directive 2001/83/EC of the European Parliament and of the Council of 6 November 2001 on the Community code relating to medicinal products for human use [4], active ingredients and diagnostic kits *ex vivo*;

"rights-holder" means the holder of any patent or supplementary protection certificate in relation to which a compulsory licence has been applied for under this Regulation;

"importing country" means the country to which the pharmaceutical product is to be exported;

"competent authority" for the purposes of Articles 1 to 11, 16 and 17 means any national authority having competence to grant compulsory licences under this Regulation in a given Member State.

Article 3

Competent authority

The competent authority as defined in Article 2(4) shall be that which has competence for the granting of compulsory licences under national patent law, unless the Member State determines otherwise.

Member States shall notify the Commission of the designated competent authority as defined in Article 2(4).

Notifications shall be published in the Official Journal of the European Union.

#### Article 4

##### Eligible importing countries

The following are eligible importing countries:

any least-developed country appearing as such in the United Nations list;

any member of the WTO, other than the least-developed country members referred to in point (a), that has made a notification to the Council for TRIPs of its intention to use the system as an importer, including whether it will use the system in whole or in a limited way;

any country that is not a member of the WTO, but is listed in the OECD Development Assistance Committee's list of low-income countries with a gross national product per capita of less than USD 745, and has made a notification to the Commission of its intention to use the system as an importer, including whether it will use the system in whole or in a limited way.

However, any WTO member that has made a declaration to the WTO that it will not use the system as an importing WTO member is not an eligible importing country.

#### Article 5

##### Extension to least-developed and developing countries which are not members of the WTO

The following provisions shall apply to importing countries eligible under Article 4 which are not WTO members:

the importing country shall make the notification referred to in Article 8(1) directly to the Commission;

the importing country shall, in the notification referred to in Article 8(1), state that it will use the system to address public health problems and not as an instrument to pursue industrial or commercial policy objectives and that it will adopt the measures referred to in paragraph 4 of the Decision;

the competent authority may, at the request of the rights-holder, or on its own initiative if national law allows the competent authority to act on its own initiative, terminate a compulsory licence granted pursuant to this Article if the importing country has failed to honour its obligations referred to in point (b). Before terminating a compulsory licence, the competent authority shall take into account any views expressed by the bodies referred to in Article 6(3)(f).

## Article 6

### Application for a compulsory licence

Any person may submit an application for a compulsory licence under this Regulation to a competent authority in the Member State or States where patents or supplementary protection certificates have effect and cover his intended activities of manufacture and sale for export.

If the person applying for a compulsory licence is submitting applications to authorities in more than one country for the same product, he shall indicate that fact in each application, together with details of the quantities and importing countries concerned.

The application pursuant to paragraph 1 shall set out the following:

the name and contact details of the applicant and of any agent or representative whom the applicant has appointed to act for him before the competent authority;

the non-proprietary name of the pharmaceutical product or products which the applicant intends to manufacture and sell for export under the compulsory licence;

the amount of pharmaceutical product which the applicant seeks to produce under the compulsory licence;

the importing country or countries;

where applicable, evidence of prior negotiation with the rights-holder pursuant to Article 9;

evidence of a specific request from:

authorised representatives of the importing country or countries; or

a non-governmental organisation acting with the formal authorisation of one or more importing countries; or

UN bodies or other international health organisations acting with the formal authorisation of one or more importing countries,

indicating the quantity of product required.

Purely formal or administrative requirements necessary for the efficient processing of the application may be prescribed under national law. Such requirements shall not add unnecessarily to the costs or burdens placed upon the applicant and, in any event, shall not render the procedure for granting compulsory licences under this Regulation more burdensome than the procedure for the granting of other compulsory licences under national law.

#### Article 7

##### Rights of the rights-holder

The competent authority shall notify the rights-holder without delay of the application for a compulsory licence. Before the grant of the compulsory licence, the competent authority shall give the rights-holder an opportunity to comment on the application and to provide the competent authority with any relevant information regarding the application.

#### Article 8

##### Verification

The competent authority shall verify that:

each importing country cited in the application which is a WTO member has made a notification to the WTO pursuant to the Decision,

or

(b) each importing country cited in the application which is not a WTO member has made a notification to the Commission pursuant to this Regulation in respect of each of the products covered by the application that:

specifies the names and expected quantities of the product(s) needed;

unless the importing country is a least-developed country, confirms that the country has established that it had insufficient or no manufacturing capacity in the pharmaceutical sector in relation to a particular product or products in one of the ways set out in the Annex to the Decision;

confirms that where a pharmaceutical product is patented in the territory of the importing country, that importing country has granted or intends to grant a compulsory licence for import of the product concerned in accordance with Article 31 of the TRIPS Agreement and the provisions of the Decision.

This paragraph is without prejudice to the flexibility that least-developed countries have under the Decision of the Council for TRIPS of 27 June 2002.

The competent authority shall verify that the quantity of product cited in the application does not exceed that notified to the WTO by an importing country which is a WTO member, or to the Commission by an importing country which is not a WTO member, and that, taking into account other compulsory licences granted elsewhere, the total amount of product authorised to be produced for any importing country does not significantly exceed the amount notified by that country to the WTO, in the case of importing countries which are WTO members, or to the Commission, in the case of importing countries which are not WTO members.

#### Article 9

##### Prior negotiation

The applicant shall provide evidence to satisfy the competent authority that he has made efforts to obtain authorisation from the rights-holder and that such efforts have not been successful within a period of thirty days before submitting the application.

The requirement in paragraph 1 shall not apply in situations of national emergency or other circumstances of extreme urgency or in cases of public non-commercial use under Article 31(b) of the TRIPS Agreement.

#### Article 10

##### Compulsory licence conditions

The licence granted shall be non-assignable, except with that part of the enterprise or goodwill which enjoys the licence, and non-exclusive. It shall contain the specific conditions set out in paragraphs 2 to 9 to be fulfilled by the licensee.

The amount of product(s) manufactured under the licence shall not exceed what is necessary to meet the needs of the importing country or countries cited in the application, taking into account the amount of product(s) manufactured under other compulsory licences granted elsewhere.

The duration of the licence shall be indicated.

The licence shall be strictly limited to all acts necessary for the purpose of manufacturing the product in question for export and distribution in the country or countries cited in the application. No product made or imported under the compulsory licence shall be offered for sale or put on the market in any country other than that cited in the application, except where an importing country avails itself of the possibilities under subparagraph 6(i) of the Decision

to export to fellow members of a regional trade agreement that share the health problem in question.

Products made under the licence shall be clearly identified, through specific labelling or marking, as being produced pursuant to this Regulation. The products shall be distinguished from those made by the rights-holder through special packaging and/or special colouring/shaping, provided that such distinction is feasible and does not have a significant impact on price. The packaging and any associated literature shall bear an indication that the product is subject to a compulsory licence under this Regulation, giving the name of the competent authority and any identifying reference number, and specifying clearly that the product is exclusively for export to and distribution in the importing country or countries concerned. Details of the product characteristics shall be made available to the customs authorities of the Member States.

Before shipment to the importing country or countries cited in the application, the licensee shall post on a website the following information:

the quantities being supplied under the licence and the importing countries to which they are supplied;

the distinguishing features of the product or products concerned.

The website address shall be communicated to the competent authority.

If the product(s) covered by the compulsory licence are patented in the importing countries cited in the application, the product(s) shall only be exported if those countries have issued a compulsory licence for the import, sale and/or distribution of the products.

The competent authority may at the request of the rights-holder or on its own initiative, if national law allows the competent authority to act on its own initiative, request access to books and records kept by the licensee, for the sole purpose of checking whether the terms of the licence, and in particular those relating to the final destination of the products, have been met. The books and records shall include proof of exportation of the product, through a declaration of exportation certified by the customs authority concerned, and proof of importation from one of the bodies referred to in Article 6(3)(f).

The licensee shall be responsible for the payment of adequate remuneration to the rights-holder as determined by the competent authority as follows:

in the cases referred to in Article 9(2), the remuneration shall be a maximum of 4 % of the total price to be paid by the importing country or on its behalf;

in all other cases, the remuneration shall be determined taking into account the economic value of the use authorised under the licence to the importing country or countries concerned, as well as humanitarian or non-commercial circumstances relating to the issue of the licence.

The licence conditions are without prejudice to the method of distribution in the importing country.

Distribution may be carried out for example by any of the bodies listed in Article 6(3)(f) and on commercial or non-commercial terms including completely without charge.

## Article 11

### Refusal of the application

The competent authority shall refuse an application if any of the conditions set out in Articles 6 to 9 are not met, or if the application does not contain the elements necessary to allow the competent authority to grant the licence in accordance with Article 10. Before refusing an application, the competent authority shall give the applicant an opportunity to rectify the situation and to be heard.

## Article 12

### Notification

When a compulsory licence has been granted, the Member State shall notify the Council for TRIPS through the intermediary of the Commission of the grant of the licence, and of the specific conditions attached to it.

The information provided shall include the following details of the licence:

the name and address of the licensee;

the product or products concerned;

the quantity to be supplied;

the country or countries to which the product or products are to be exported;

the duration of the licence;

the address of the website referred to in Article 10(6).

## Article 13

### Prohibition of importation

The import into the Community of products manufactured under a compulsory licence granted pursuant to the Decision and/or this Regulation for the purposes of release for free

circulation, re-export, placing under suspensive procedures or placing in a free zone or free warehouse shall be prohibited.

Paragraph 1 shall not apply in the case of re-export to the importing country cited in the application and identified in the packaging and documentation associated with the product, or placing under a transit or customs warehouse procedure or in a free zone or free warehouse for the purpose of re-export to that importing country.

## Article 14

### Action by customs authorities

If there are sufficient grounds for suspecting that products manufactured under a compulsory licence granted pursuant to the Decision and/or this Regulation are being imported into the Community contrary to Article 13(1), customs authorities shall suspend the release of, or detain, the products concerned for the time necessary to obtain a decision of the competent authority on the character of the merchandise. Member States shall ensure that a body has the authority to review whether such importation is taking place. The period of suspension or detention shall not exceed 10 working days unless special circumstances apply, in which case the period may be extended by a maximum of 10 working days. Upon expiry of that period, the products shall be released, provided that all customs formalities have been complied with.

The competent authority, the rights-holder and the manufacturer or exporter of the products concerned shall be informed without delay of the suspended release or detention of the products and shall be given all information available with respect to the products concerned. Due account shall be taken of national provisions on the protection of personal data and commercial and industrial secrecy and professional and administrative confidentiality.

The importer, and where appropriate, the exporter shall be given ample opportunity to supply the competent authority with the information which it deems appropriate regarding the products.

If it is confirmed that products suspended for release or detained by customs authorities were intended for import into the Community contrary to the prohibition in Article 13(1), the competent authority shall ensure that the products are seized and disposed of in accordance with national legislation.

The procedure of suspension or detention or seizure of the goods shall be carried out at the expense of the importer. If it is not possible to recover those expenses from the importer, they

may, in accordance with national legislation, be recovered from any other person responsible for the attempted illicit importation.

If the products suspended for release or detained by customs authorities are subsequently found not to violate the prohibition in Article 13(1), the customs authorities shall release the products to the consignee, provided that all customs formalities have been complied with.

The competent authority shall inform the Commission of any decisions on seizure or destruction adopted pursuant to this Regulation.

## Article 15

### Personal luggage exception

Articles 13 and 14 shall not apply to goods of a non-commercial nature contained in travellers' personal luggage for personal use within the limits laid down in respect of relief from customs duty.

## Article 16

### Termination or review of the licence

Subject to adequate protection of the legitimate interests of the licensee, a compulsory licence granted pursuant to this Regulation may be terminated by a decision of the competent authority or by one of the bodies referred to in Article 17 if the licence conditions are not respected by the licensee.

The competent authority shall have the authority to review, upon reasoned request by the rights-holder or the licensee, whether the licence conditions have been respected. This review shall be based on the assessment made in the importing country where appropriate.

Termination of a licence granted under this Regulation shall be notified to the Council for TRIPS through the intermediary of the Commission.

Following termination of the licence, the competent authority, or any other body appointed by the Member State, shall be entitled to establish a reasonable period of time within which the licensee shall arrange for any product in his possession, custody, power or control to be redirected at his expense to countries in need as referred to in Article 4 or otherwise disposed of as prescribed by the competent authority, or by another body appointed by the Member State, in consultation with the rights-holder.

When notified by the importing country that the amount of pharmaceutical product has become insufficient to meet its needs, the competent authority may, following an application

by the licensee, modify the conditions of the licence permitting the manufacture and export of additional quantities of the product to the extent necessary to meet the needs of the importing country concerned. In such cases the licensee's application shall be processed in accordance with a simplified and accelerated procedure, whereby the information set out in Article 6(3), points (a) and (b), shall not be required provided that the original compulsory licence is identified by the licensee. In situations where Article 9(1) applies but the derogation set out in Article 9(2) does not apply, no further evidence of negotiation with the rights-holder will be required, provided that the additional amount requested does not exceed 25 % of the amount granted under the original licence.

In situations where Article 9(2) applies, no evidence of negotiation with the rights-holder will be required.

#### Article 17

##### Appeals

Appeals against any decision of the competent authority, and disputes concerning compliance with the conditions of the licence, shall be heard by the appropriate body responsible under national law.

Member States shall ensure that the competent authority and/or the body referred to in paragraph 1 have the power to rule that an appeal against a decision granting a compulsory licence shall have suspensory effect.

#### Article 18

##### Safety and efficacy of medicinal products

Where the application for a compulsory licence concerns a medicinal product, the applicant may avail himself of:

the scientific opinion procedure as provided for under Article 58 of Regulation (EC) No 726/2004, or

any similar procedures under national law, such as scientific opinions or export certificates intended exclusively for markets outside the Community.

If a request for any of the above procedures concerns a product which is a generic of a reference medicinal product which is or has been authorised under Article 6 of Directive 2001/83/EC, the protection periods set out in Article 14(11) of Regulation (EC) No 726/2004 and in Articles 10(1) and 10(5) of Directive 2001/83/EC shall not apply.

## Article 19

### Review

Three years after the entry into force of this Regulation, and every three years thereafter, the Commission shall present a report to the European Parliament, the Council, and the European Economic and Social Committee on the operation of this Regulation including any appropriate plans for amendments. The report shall cover, in particular:

the application of Article 10(9) on determining the remuneration of the rights-holder;

the application of the simplified and accelerated procedure referred to in Article 16(4);

the sufficiency of the requirements under Article 10(5) to prevent trade diversion, and

the contribution this Regulation has made to the implementation of the system established by the Decision.

## Article 20

### Entry into force

This Regulation shall enter into force on the 20th day following that of its publication in the Official Journal of the European Union.

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

Done at Strasbourg, 17 May 2006.

For the European Parliament

The President

J. Borrell fontelles

For the Council

The President

H. Winkler

[1] OJ C 286, 17.11.2005, p. 4.

[2] Opinion of the European Parliament of 1.12.2005 (not yet published in the Official Journal), and Council Decision of 28 April 2006.

[3] OJ L 136, 30.4.2004, p. 1.

[4] OJ L 311, 28.11.2001, p. 67. Directive as last amended by Directive 2004/27/EC (OJ L 136, 30.4.2004, p. 34).

**1.1.2. Regulation (EC) of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products No 1610/96<sup>2</sup>**

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,  
Having regard to the Treaty establishing the European Community, and in particular Article 100a thereof,  
Having regard to the proposal from the Commission (1),  
Having regard to the opinion of the Economic and Social Committee (2),  
Acting in accordance with the procedure referred to in Article 189b of the Treaty (3),  
Whereas research into plant protection products contributes to the continuing improvement in the production and procurement of plentiful food of good quality at affordable prices;  
Whereas plant protection research contributes to the continuing improvement in crop production;  
Whereas plant protection products, especially those that are the result of long, costly research, will continue to be developed in the Community and in Europe if they are covered by favourable rules that provide for sufficient protection to encourage such research;  
Whereas the competitiveness of the plant protection sector, by the very nature of the industry, requires a level of protection for innovation which is equivalent to that granted to medicinal products by Council Regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products (4);  
Whereas, at the moment, the period that elapses between the filing of an application for a patent for a new plant protection product and authorization to place the said plant protection

---

<sup>2</sup> *Official Journal L 198*, 08/08/1996 P. 0030 – 0035 31996R1610

product on the market makes the period of effective protection under the patent insufficient to cover the investment put into the research and to generate the resources needed to maintain a high level of research;

Whereas this situation leads to a lack of protection which penalizes plant protection research and the competitiveness of the sector;

Whereas one of the main objectives of the supplementary protection certificate is to place European industry on the same competitive footing as its North American and Japanese counterparts;

Whereas, in its Resolution of 1 February 1993 (5) on a Community programme of policy and action in relation to the environment and sustainable development, the Council adopted the general approach and strategy of the programme presented by the Commission, which stressed the interdependence of economic growth and environmental quality; whereas improving protection of the environment means maintaining the economic competitiveness of industry; whereas, accordingly, the issue of a supplementary protection certificate can be regarded as a positive measure in favour of environmental protection;

Whereas a uniform solution at Community level should be provided for, thereby preventing the heterogeneous development of national laws leading to further disparities which would be likely to hinder the free movement of plant protection products within the Community and thus directly affect the functioning of the internal market; whereas this is in accordance with the principle of subsidiarity as defined by Article 3b of the Treaty;

Whereas, therefore, there is a need to create a supplementary protection certificate granted, under the same conditions, by each of the Member States at the request of the holder of a national or European patent relating to a plant protection product for which marketing authorization has been granted is necessary; whereas a Regulation is therefore the most appropriate legal instrument;

Whereas the duration of the protection granted by the certificate should be such as to provide adequate, effective protection; whereas, for this purpose, the holder of both a patent and a certificate should be able to enjoy an overall maximum of fifteen years of exclusivity from the time the plant protection product in question first obtains authorization to be placed on the market in the Community;

Whereas all the interests at stake in a sector as complex and sensitive as plant protection must nevertheless be taken into account; whereas, for this purpose, the certificate cannot be granted for a period exceeding five years;

Whereas the certificate confers the same rights as those conferred by the basic patent; whereas, consequently, where the basic patent covers an active substance and its various derivatives (salts and esters), the certificate confers the same protection;

Whereas the issue of a certificate for a product consisting of an active substance does not prejudice the issue of other certificates for derivatives (salts and esters) of the substance, provided that the derivatives are the subject of patents specifically covering them;

Whereas a fair balance should also be struck with regard to the determination of the transitional arrangements; whereas such arrangements should enable the Community plant protection industry to catch up to some extent with its main competitors, while making sure that the arrangements do not compromise the achievement of other legitimate objectives concerning the agricultural policy and environment protection policy pursued at both national and Community level;

Whereas only action at Community level will enable the objective, which consists in ensuring adequate protection for innovation in the field of plant protection, while guaranteeing the proper functioning of the internal market for plant protection products, to be attained effectively;

Whereas the detailed rules in recitals 12, 13 and 14 and in Articles 3 (2), 4, 8 (1) (c) and 17 (2) of this Regulation are also valid, *mutatis mutandis*, for the interpretation in particular of recital 9 and Articles 3, 4, 8 (1) (c) and 17 of Council Regulation (EEC) No 1768/92,

HAVE ADOPTED THIS REGULATION:

Article 1

Definitions

For the purposes of this Regulation, the following definitions shall apply:

'plant protection products': active substances and preparations containing one or more active substances, put up in the form in which they are supplied to the user, intended to:

protect plants or plant products against all harmful organisms or prevent the action of such organisms, in so far as such substances or preparations are not otherwise defined below;

influence the life processes of plants, other than as a nutrient (e.g. plant growth regulators);

preserve plant products, in so far as such substances or products are not subject to special Council or Commission provisions on preservatives;

destroy undesirable plants; or

destroy parts of plants, check or prevent undesirable growth of plants;

'substances': chemical elements and their compounds, as they occur naturally or by manufacture, including any impurity inevitably resulting from the manufacturing process;

'active substances': substances or micro-organisms including viruses, having general or specific action:

against harmful organisms; or

on plants, parts of plants or plant products;

'preparations': mixtures or solutions composed of two or more substances, of which at least one is an active substance, intended for use as plant protection products;

'plants': live plants and live parts of plants, including fresh fruit and seeds;

'plant products': products in the unprocessed state or having undergone only simple preparation such as milling, drying or pressing, derived from plants, but excluding plants themselves as defined in point 5;

'harmful organisms': pests of plants or plant products belonging to the animal or plant kingdom, and also viruses, bacteria and mycoplasmas and other pathogens;

'product': the active substance as defined in point 3 or combination of active substances of a plant protection product;

'basic patent': a patent which protects a product as defined in point 8 as such, a preparation as defined in point 4, a process to obtain a product or an application of a product, and which is designated by its holder for the purpose of the procedure for grant of a certificate;

'certificate': the supplementary protection certificate.

## Article 2

### Scope

Any product protected by a patent in the territory of a Member State and subject, prior to being placed on the market as a plant protection product, to an administrative authorization procedure as laid down in Article 4 of Directive 91/414/EEC (6), or pursuant to an equivalent provision of national law if it is a plant protection product in respect of which the application for authorization was lodged before Directive 91/414/EEC was implemented by the Member

State concerned, may, under the terms and conditions provided for in this Regulation, be the subject of a certificate.

### Article 3

#### Conditions for obtaining a certificate

A certificate shall be granted if, in the Member State in which the application referred to in Article 7 is submitted, at the date of that application:

the product is protected by a basic patent in force;

a valid authorization to place the product on the market as a plant protection product has been granted in accordance with Article 4 of Directive 91/414/EEC or an equivalent provision of national law;

the product has not already been the subject of a certificate;

the authorization referred to in (b) is the first authorization to place the product on the market as a plant protection product.

The holder of more than one patent for the same product shall not be granted more than one certificate for that product. However, where two or more applications concerning the same product and emanating from two or more holders of different patents are pending, one certificate for this product may be issued to each of these holders.

### Article 4

#### Subject-matter of protection

Within the limits of the protection conferred by the basic patent, the protection conferred by a certificate shall extend only to the product covered by the authorizations to place the corresponding plant protection product on the market and for any use of the product as a plant protection product that has been authorized before the expiry of the certificate.

### Article 5

#### Effects of the certificate

Subject to Article 4, the certificate shall confer the same rights as conferred by the basic patent and shall be subject to the same limitations and the same obligations.

### Article 6

#### Entitlement to the certificate

The certificate shall be granted to the holder of the basic patent or his successor in title.

## Article 7

### Application for a certificate

The application for a certificate shall be lodged within six months of the date on which the authorization referred to in Article 3 (1) (b) to place the product on the market as a plant protection product was granted.

Notwithstanding paragraph 1, where the authorization to place the product on the market is granted before the basic patent is granted, the application for a certificate shall be lodged within six months of the date on which the patent is granted.

## Article 8

### Content of the application for a certificate

The application for a certificate shall contain:

a request for the grant of a certificate, stating in particular:

the name and address of the applicant;

the name and address of the representative, if any;

the number of the basic patent and the title of the invention;

the number and date of the first authorization to place the product on the market, as referred to in Article 3 (1) (b) and, if this authorization is not the first authorization to place the product on the market in the Community, the number and date of that authorization;

a copy of the authorization to place the product on the market, as referred to in Article 3 (1) (b), in which the product is identified, containing in particular the number and date of the authorization and the summary of the product characteristics listed in Part A.I (points 1-7) or B.I (points 1-7) of Annex II to Directive 91/414/EEC or in equivalent national laws of the Member State in which the application was lodged;

if the authorization referred to in (b) is not the first authorization to place the product on the market as a plant protection product in the Community, information regarding the identity of the product thus authorized and the legal provision under which the authorization procedure took place, together with a copy of the notice publishing the authorization in the appropriate official publication or, failing such a notice, any other document proving that the authorization has been issued, the date on which it was issued and the identity of the product authorized.

Member States may require a fee to be payable upon application for a certificate.

## Article 9

### Lodging of an application for a certificate

The application for a certificate shall be lodged with the competent industrial property office of the Member State which granted the basic patent or on whose behalf it was granted and in which the authorization referred to in Article 3 (1) (b) to place the product on the market was obtained, unless the member State designates another authority for the purpose.

Notification of the application for a certificate shall be published by the authority referred to in paragraph 1. The notification shall contain at least the following information:

the name and address of the applicant;

the number of the basic patent;

the title of the invention;

the number and date of the authorization to place the product on the market, referred to in Article 3 (1) (b), and the product identified in that authorization;

where relevant, the number and date of the first authorization to place the product on the market in the Community.

## Article 10

### Grant of the certificate or rejection of the application

Where the application for a certificate and the product to which it relates meet the conditions laid down in this Regulation, the authority referred to in Article 9 (1) shall grant the certificate.

The authority referred to in Article 9 (1) shall, subject to paragraph 3, reject the application for a certificate if the application or the product to which it relates does not meet the conditions laid down in this Regulation.

Where the application for a certificate does not meet the conditions laid down in Article 8, the authority referred to in Article 9 (1) shall ask the applicant to rectify the irregularity, or to settle the fee, within a stated time.

If the irregularity is not rectified or the fee is not settled under paragraph 3 within the stated time, the application shall be rejected.

Member States may provide that the authority referred to in Article 9 (1) is to grant certificates without verifying that the conditions laid down in Article 3 (1) (c) and (d) are met.

## Article 11

## Publication

Notification of the fact that a certificate has been granted shall be published by the authority referred to in Article 9 (1). The notification shall contain at least the following information:

the name and address of the holder of the certificate;

the number of the basic patent;

the title of the invention;

the number and date of the authorization to place the product on the market referred to in Article 3 (1) (b) and the product identified in that authorization;

where relevant, the number and date of the first authorization to place the product on the market in the Community;

the duration of the certificate.

Notification of the fact that the application for a certificate has been rejected shall be published by the authority referred to in Article 9 (1). The notification shall contain at least the information listed in Article 9 (2).

## Article 12

### Annual fees

Member States may require the certificate to be subject to the payment of annual fees.

## Article 13

### Duration of the certificate

The certificate shall take effect at the end of the lawful term of the basic patent for a period equal to the period which elapsed between the date on which the application for a basic patent was lodged and the date of the first authorization to place the product on the market in the Community, reduced by a period of five years.

Notwithstanding paragraph 1, the duration of the certificate may not exceed five years from the date on which it takes effect.

For the purposes of calculating the duration of the certificate, account shall be taken of a provisional first marketing authorization only if it is directly followed by a definitive authorization concerning the same product.

## Article 14

### Expiry of the certificate

The certificate shall lapse:

at the end of the period provided for in Article 13;

if the certificate-holder surrenders it;

if the annual fee laid down in accordance with Article 12 is not paid in time;

if and as long as the product covered by the certificate may no longer be placed on the market following the withdrawal of the appropriate authorization or authorizations to place it on the market in accordance with Article 4 of Directive 91/414/EEC or equivalent provisions of national law. The authority referred to in Article 9 (1) may decide on the lapse of the certificate either on its own initiative or at the request of a third party.

## Article 15

### Invalidity of the certificate

The certificate shall be invalid if:

it was granted contrary to the provisions of Article 3;

the basic patent has lapsed before its lawful term expires;

the basic patent is revoked or limited to the extent that the product for which the certificate was granted would no longer be protected by the claims of the basic patent or, after the basic patent has expired, grounds for revocation exist which would have justified such revocation or limitation.

Any person may submit an application or bring an action for a declaration of invalidity of the certificate before the body responsible under national law for the revocation of the corresponding basic patent.

## Article 16

### Notification of lapse or invalidity

If the certificate lapses in accordance with Article 14 (b), (c) or (d) or is invalid in accordance with Article 15, notification thereof shall be published by the authority referred to in Article 9 (1).

## Article 17

### Appeals

The decisions of the authority referred to in Article 9 (1) or of the body referred to in Article 15 (2) taken under this Regulation shall be open to the same appeals as those provided for in national law against similar decisions taken in respect of national patents.

The decision to grant the certificate shall be open to an appeal aimed at rectifying the duration of the certificate where the date of the first authorization to place the product on the market in the Community, contained in the application for a certificate as provided for in Article 8, is incorrect.

## Article 18

### Procedure

In the absence of procedural provisions in this Regulation, the procedural provisions applicable under national law to the corresponding basic patent and, where appropriate, the procedural provisions applicable to the certificates referred to in Regulation (EEC) No 1768/92, shall apply to the certificate, unless national law lays down special procedural provisions for certificates as referred to in this Regulation.

Notwithstanding paragraph 1, the procedure for opposition to the granting of a certificate shall be excluded.

## TRANSITIONAL PROVISIONS

### Article 19

Any product which, on the date on which this Regulation enters into force, is protected by a valid basic patent and for which the first authorization to place it on the market as a plant protection product in the Community was obtained after 1 January 1985 under Article 4 of Directive 91/414/EEC or an equivalent national provision may be granted a certificate.

An application made under paragraph 1 for a certificate shall be submitted within six months of the date on which this Regulation enters into force.

### Article 20

In those Member States whose national law did not, on 1 January 1990, provide for the patentability of plant protection products, this Regulation shall apply from 2 January 1998.

Article 19 shall not apply in those Member States.

## FINAL PROVISION

### Article 21

#### Entry into force

This Regulation shall enter into force six months after its publication in the Official Journal of the European Communities.

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

Done at Brussels, 23 July 1996.

For the European Parliament

The President

K. HÄNSCH

For the Council

The President

M. LOWRY

OJ C 390, 31. 12. 1994, p. 21 and OJ C 335, 13. 12. 1995, p. 15.

OJ No C 155, 21. 6. 1995, p. 14.

Opinion of the European Parliament of 15 June 1995 (OJ C 166, 3. 7. 1995, p. 89), common position of the Council of 27 November 1995 (OJ C 353, 30. 12. 1995, p. 36) and decision of the European Parliament of 12 March 1996 (OJ C 96, 1. 4. 1996, p. 30).

OJ No L 182, 2. 7. 1992, p. 1.

OJ No C 138, 17. 5. 1993, p. 1.

OJ L 230, 19. 8. 1991, p. 1. Directive as last amended by Directive 95/36/EC (OJ L 172, 22. 7. 1995, p. 8).

**1.1.3. Regulation (EU) of the European Parliament and of the Council  
implementing enhanced cooperation in the area of the creation of unitary  
patent protection No 1257/2012**

of 17 December 2012

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty on the Functioning of the European Union and in particular the first paragraph of Article 118 thereof,

Having regard to Council Decision 2011/167/EU of 10 March 2011 authorising enhanced cooperation in the area of the creation of unitary patent protection [1],

Having regard to the proposal from the European Commission,

After transmission of the draft legislative act to the national parliaments,

Acting in accordance with the ordinary legislative procedure [2],

Whereas:

The creation of the legal conditions enabling undertakings to adapt their activities in manufacturing and distributing products across national borders and providing them with greater choice and more opportunities contributes to the attainment of the objectives of the Union set out in Article 3(3) of the Treaty on European Union. Uniform patent protection within the internal market, or at least a significant part thereof, should feature amongst the legal instruments which undertakings have at their disposal.

Pursuant to the first paragraph of Article 118 of the Treaty on the Functioning of the European Union (TFEU), measures to be taken in the context of the establishment and functioning of the internal market include the creation of uniform patent protection throughout the Union and the establishment of centralised Union-wide authorisation, coordination and supervision arrangements.

On 10 March 2011, the Council adopted Decision 2011/167/EU authorising enhanced cooperation between Belgium, Bulgaria, the Czech Republic, Denmark, Germany, Estonia, Ireland, Greece, France, Cyprus, Latvia, Lithuania, Luxembourg, Hungary, Malta, the Netherlands, Austria, Poland, Portugal, Romania, Slovenia, Slovakia, Finland, Sweden and the United Kingdom (hereinafter "participating Member States") in the area of the creation of unitary patent protection.

Unitary patent protection will foster scientific and technological advances and the functioning of the internal market by making access to the patent system easier, less costly and legally secure. It will also improve the level of patent protection by making it possible to obtain uniform patent protection in the participating Member States and eliminate costs and complexity for undertakings throughout the Union. It should be available to proprietors of a European patent from both the participating Member States and from other States, regardless of their nationality, residence or place of establishment.

The Convention on the Grant of European Patents of 5 October 1973, as revised on 17 December 1991 and on 29 November 2000 (hereinafter "EPC"), established the European

Patent Organisation and entrusted it with the task of granting European patents. This task is carried out by the European Patent Office (hereinafter "EPO"). A European patent granted by the EPO should, at the request of the patent proprietor, benefit from unitary effect by virtue of this Regulation in the participating Member States. Such a patent is hereinafter referred to as a "European patent with unitary effect".

In accordance with Part IX of the EPC a group of Contracting States to the EPC may provide that European patents granted for those States have a unitary character. This Regulation constitutes a special agreement within the meaning of Article 142 of the EPC, a regional patent treaty within the meaning of Article 45(1) of the Patent Cooperation Treaty of 19 June 1970 as last modified on 3 February 2001 and a special agreement within the meaning of Article 19 of the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883 and last amended on 28 September 1979.

Unitary patent protection should be achieved by attributing unitary effect to European patents in the post-grant phase by virtue of this Regulation and in respect of all the participating Member States. The main feature of a European patent with unitary effect should be its unitary character, i.e. providing uniform protection and having equal effect in all the participating Member States. Consequently, a European patent with unitary effect should only be limited, transferred or revoked, or lapse, in respect of all the participating Member States. It should be possible for a European patent with unitary effect to be licensed in respect of the whole or part of the territories of the participating Member States. To ensure the uniform substantive scope of protection conferred by unitary patent protection, only European patents that have been granted for all the participating Member States with the same set of claims should benefit from unitary effect. Finally, the unitary effect attributed to a European patent should have an accessory nature and should be deemed not to have arisen to the extent that the basic European patent has been revoked or limited.

In accordance with the general principles of patent law and Article 64(1) of the EPC, unitary patent protection should take effect retroactively in the participating Member States as from the date of publication of the mention of the grant of the European patent in the European Patent Bulletin. Where unitary patent protection takes effect, the participating Member States should ensure that the European patent is deemed not to have taken effect on their territory as a national patent, so as to avoid any duplication of patent protection.

The European patent with unitary effect should confer on its proprietor the right to prevent any third party from committing acts against which the patent provides protection. This

should be ensured through the establishment of a Unified Patent Court. In matters not covered by this Regulation or by Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of unitary patent protection with regard to the applicable translation arrangements [3], the provisions of the EPC, the Agreement on a Unified Patent Court, including its provisions defining the scope of that right and its limitations, and national law, including rules of private international law, should apply.

Compulsory licences for European patents with unitary effect should be governed by the laws of the participating Member States as regards their respective territories.

In its report on the operation of this Regulation, the Commission should evaluate the functioning of the applicable limitations and, where necessary, make appropriate proposals, taking account of the contribution of the patent system to innovation and technological progress, the legitimate interests of third parties and overriding interests of society. The Agreement on a Unified Patent Court does not preclude the European Union from exercising its powers in this field.

In accordance with the case-law of the Court of Justice of the European Union, the principle of the exhaustion of rights should also be applied to European patents with unitary effect. Therefore, rights conferred by a European patent with unitary effect should not extend to acts concerning the product covered by that patent which are carried out within the participating Member States after that product has been placed on the market in the Union by the patent proprietor.

The regime applicable to damages should be governed by the laws of the participating Member States, in particular the provisions implementing Article 13 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [4].

As an object of property, a European patent with unitary effect should be dealt with in its entirety, and in all the participating Member States, as a national patent of the participating Member State determined in accordance with specific criteria such as the applicant's residence, principal place of business or place of business.

In order to promote and facilitate the economic exploitation of an invention protected by a European patent with unitary effect, the proprietor of that patent should be able to offer it to be licensed in return for appropriate consideration. To that end, the patent proprietor should be able to file a statement with the EPO that he is prepared to grant a license in return for

appropriate consideration. In that case, the patent proprietor should benefit from a reduction of the renewal fees as from the EPO's receipt of such statement.

The group of Member States making use of the provisions of Part IX of the EPC may give tasks to the EPO and set up a select committee of the Administrative Council of the European Patent Organisation (hereinafter "Select Committee").

The participating Member States should give certain administrative tasks relating to European patents with unitary effect to the EPO, in particular as regards the administration of requests for unitary effect, the registration of unitary effect and of any limitation, licence, transfer, revocation or lapse of European patents with unitary effect, the collection and distribution of renewal fees, the publication of translations for information purposes during a transitional period and the administration of a compensation scheme for the reimbursement of translation costs incurred by applicants filing European patent applications in a language other than one of the official languages of the EPO.

In the framework of the Select Committee, the participating Member States should ensure the governance and supervision of the activities related to the tasks entrusted to the EPO by the participating Member States, ensure that requests for unitary effect are filed with the EPO within one month of the date of publication of the mention of the grant in the European Patent Bulletin and ensure that such requests are submitted in the language of the proceedings before the EPO together with the translation prescribed, during a transitional period, by Regulation (EU) No 1260/2012. The participating Member States should also ensure the setting, in accordance with the voting rules laid down in Article 35(2) of the EPC, of the level of the renewal fees and the share of the distribution of the renewal fees in accordance with the criteria set out in this Regulation.

Patent proprietors should pay a single annual renewal fee for a European patent with unitary effect. Renewal fees should be progressive throughout the term of the patent protection and, together with the fees to be paid to the European Patent Organisation during the pre-grant stage, should cover all costs associated with the grant of the European patent and the administration of the unitary patent protection. The level of the renewal fees should be set with the aim of facilitating innovation and fostering the competitiveness of European businesses, taking into account the situation of specific entities such as small and medium-sized enterprises, for example in the form of lower fees. It should also reflect the size of the market covered by the patent and be similar to the level of the national renewal fees for an

average European patent taking effect in the participating Member States at the time when the level of the renewal fees is first set.

The appropriate level and distribution of renewal fees should be determined in order to ensure that, in relation to the unitary patent protection, all costs of the tasks entrusted to the EPO are fully covered by the resources generated by the European patents with unitary effect and that, together with the fees to be paid to the European Patent Organisation during the pre-grant stage, the revenues from the renewal fees ensure a balanced budget of the European Patent Organisation.

Renewal fees should be paid to the European Patent Organisation. The EPO should retain an amount to cover the expenses generated at the EPO in carrying out tasks in relation to the unitary patent protection in accordance with Article 146 of the EPC. The remaining amount should be distributed among the participating Member States and should be used for patent-related purposes. The share of distribution should be set on the basis of fair, equitable and relevant criteria, namely the level of patent activity and the size of the market, and should guarantee a minimum amount to be distributed to each participating Member State in order to maintain a balanced and sustainable functioning of the system. The distribution should provide compensation for having an official language other than one of the official languages of the EPO, having a disproportionately low level of patenting activity established on the basis of the European Innovation Scoreboard, and/or having acquired membership of the European Patent Organisation relatively recently.

An enhanced partnership between the EPO and central industrial property offices of the Member States should enable the EPO to make regular use, where appropriate, of the result of any search carried out by central industrial property offices on a national patent application the priority of which is claimed in a subsequent European patent application. All central industrial property offices, including those which do not perform searches in the course of a national patent-granting procedure, can play an essential role under the enhanced partnership, inter alia, by giving advice and support to potential patent applicants, in particular small and medium-sized enterprises, by receiving applications, by forwarding applications to the EPO and by disseminating patent information.

This Regulation is complemented by Regulation (EU) No 1260/2012, adopted by the Council in accordance with the second paragraph of Article 118 of the TFEU.

Jurisdiction in respect of European patents with unitary effect should be established and governed by an instrument setting up a unified patent litigation system for European patents and European patents with unitary effect.

Establishing a Unified Patent Court to hear cases concerning the European patent with unitary effect is essential in order to ensure the proper functioning of that patent, consistency of case-law and hence legal certainty, and cost-effectiveness for patent proprietors. It is therefore of paramount importance that the participating Member States ratify the Agreement on a Unified Patent Court in accordance with their national constitutional and parliamentary procedures and take the necessary steps for that Court to become operational as soon as possible.

This Regulation should be without prejudice to the right of the participating Member States to grant national patents and should not replace the participating Member States' laws on patents. Patent applicants should remain free to obtain either a national patent, a European patent with unitary effect, a European patent taking effect in one or more of the Contracting States to the EPC or a European patent with unitary effect validated in addition in one or more other Contracting States to the EPC which are not among the participating Member States.

Since the objective of this Regulation, namely the creation of unitary patent protection, cannot be sufficiently achieved by the Member States and can therefore, by reason of the scale and effects of this Regulation, be better achieved at Union level, the Union may adopt measures, where appropriate by means of enhanced cooperation, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty on European Union. In accordance with the principle of proportionality, as set out in that Article, this Regulation does not go beyond what is necessary in order to achieve that objective,

HAVE ADOPTED THIS REGULATION:

## CHAPTER I

### GENERAL PROVISIONS

#### Article 1

##### Subject matter

This Regulation implements enhanced cooperation in the area of the creation of unitary patent protection, authorised by Decision 2011/167/EU.

This Regulation constitutes a special agreement within the meaning of Article 142 of the Convention on the Grant of European Patents of 5 October 1973, as revised on 17 December 1991 and on 29 November 2000 (hereinafter "EPC").

## Article 2

### Definitions

For the purposes of this Regulation, the following definitions shall apply:

"Participating Member State" means a Member State which participates in enhanced cooperation in the area of the creation of unitary patent protection by virtue of Decision 2011/167/EU, or by virtue of a decision adopted in accordance with the second or third subparagraph of Article 331(1) of the TFEU, at the time the request for unitary effect as referred to in Article 9 is made;

"European patent" means a patent granted by the European Patent Office (hereinafter "EPO") under the rules and procedures laid down in the EPC;

"European patent with unitary effect" means a European patent which benefits from unitary effect in the participating Member States by virtue of this Regulation;

"European Patent Register" means the register kept by the EPO under Article 127 of the EPC;

"Register for unitary patent protection" means the register constituting part of the European Patent Register in which the unitary effect and any limitation, licence, transfer, revocation or lapse of a European patent with unitary effect are registered;

"European Patent Bulletin" means the periodical publication provided for in Article 129 of the EPC.

## Article 3

### European patent with unitary effect

A European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection.

A European patent granted with different sets of claims for different participating Member States shall not benefit from unitary effect.

A European patent with unitary effect shall have a unitary character. It shall provide uniform protection and shall have equal effect in all the participating Member States.

It may only be limited, transferred or revoked, or lapse, in respect of all the participating Member States.

It may be licensed in respect of the whole or part of the territories of the participating Member States.

The unitary effect of a European patent shall be deemed not to have arisen to the extent that the European patent has been revoked or limited.

#### Article 4

##### Date of effect

A European patent with unitary effect shall take effect in the participating Member States on the date of publication by the EPO of the mention of the grant of the European patent in the European Patent Bulletin.

The participating Member States shall take the necessary measures to ensure that, where the unitary effect of a European patent has been registered and extends to their territory, that European patent is deemed not to have taken effect as a national patent in their territory on the date of publication of the mention of the grant in the European Patent Bulletin.

## CHAPTER II

### EFFECTS OF A EUROPEAN PATENT WITH UNITARY EFFECT

#### Article 5

##### Uniform protection

The European patent with unitary effect shall confer on its proprietor the right to prevent any third party from committing acts against which that patent provides protection throughout the territories of the participating Member States in which it has unitary effect, subject to applicable limitations.

The scope of that right and its limitations shall be uniform in all participating Member States in which the patent has unitary effect.

The acts against which the patent provides protection referred to in paragraph 1 and the applicable limitations shall be those defined by the law applied to European patents with unitary effect in the participating Member State whose national law is applicable to the European patent with unitary effect as an object of property in accordance with Article 7.

In its report referred to in Article 16(1), the Commission shall evaluate the functioning of the applicable limitations and shall, where necessary, make appropriate proposals.

#### Article 6

##### Exhaustion of the rights conferred by a European patent with unitary effect

The rights conferred by a European patent with unitary effect shall not extend to acts concerning a product covered by that patent which are carried out within the participating

Member States in which that patent has unitary effect after that product has been placed on the market in the Union by, or with the consent of, the patent proprietor, unless there are legitimate grounds for the patent proprietor to oppose further commercialisation of the product.

## CHAPTER III

### A EUROPEAN PATENT WITH UNITARY EFFECT AS AN OBJECT OF PROPERTY

#### Article 7

Treating a European patent with unitary effect as a national patent

A European patent with unitary effect as an object of property shall be treated in its entirety and in all the participating Member States as a national patent of the participating Member State in which that patent has unitary effect and in which, according to the European Patent Register:

the applicant had his residence or principal place of business on the date of filing of the application for the European patent; or

where point (a) does not apply, the applicant had a place of business on the date of filing of the application for the European patent.

Where two or more persons are entered in the European Patent Register as joint applicants, point (a) of paragraph 1 shall apply to the joint applicant indicated first. Where this is not possible, point (a) of paragraph 1 shall apply to the next joint applicant indicated in the order of entry. Where point (a) of paragraph 1 does not apply to any of the joint applicants, point (b) of paragraph 1 shall apply accordingly.

Where no applicant had his residence, principal place of business or place of business in a participating Member State in which that patent has unitary effect for the purposes of paragraphs 1 or 2, the European patent with unitary effect as an object of property shall be treated in its entirety and in all the participating Member States as a national patent of the State where the European Patent Organisation has its headquarters in accordance with Article 6(1) of the EPC.

The acquisition of a right may not be dependent on any entry in a national patent register.

#### Article 8

Licences of right

The proprietor of a European patent with unitary effect may file a statement with the EPO to the effect that the proprietor is prepared to allow any person to use the invention as a licensee in return for appropriate consideration.

A licence obtained under this Regulation shall be treated as a contractual licence.

## CHAPTER IV

### INSTITUTIONAL PROVISIONS

#### Article 9

##### Administrative tasks in the framework of the European Patent Organisation

The participating Member States shall, within the meaning of Article 143 of the EPC, give the EPO the following tasks, to be carried out in accordance with the internal rules of the EPO:

to administer requests for unitary effect by proprietors of European patents;

to include the Register for unitary patent protection within the European Patent Register and to administer the Register for unitary patent protection;

to receive and register statements on licensing referred to in Article 8, their withdrawal and licensing commitments undertaken by the proprietor of the European patent with unitary effect in international standardisation bodies;

to publish the translations referred to in Article 6 of Regulation (EU) No 1260/2012 during the transitional period referred to in that Article;

to collect and administer renewal fees for European patents with unitary effect, in respect of the years following the year in which the mention of the grant is published in the European Patent Bulletin; to collect and administer additional fees for late payment of renewal fees where such late payment is made within six months of the due date, as well as to distribute part of the collected renewal fees to the participating Member States;

to administer the compensation scheme for the reimbursement of translation costs referred to in Article 5 of Regulation (EU) No 1260/2012;

to ensure that a request for unitary effect by a proprietor of a European patent is submitted in the language of the proceedings as defined in Article 14(3) of the EPC no later than one month after the mention of the grant is published in the European Patent Bulletin; and

to ensure that the unitary effect is indicated in the Register for unitary patent protection, where a request for unitary effect has been filed and, during the transitional period provided for in Article 6 of Regulation (EU) No 1260/2012, has been submitted together with the

translations referred to in that Article, and that the EPO is informed of any limitations, licences, transfers or revocations of European patents with unitary effect.

The participating Member States shall ensure compliance with this Regulation in fulfilling their international obligations undertaken in the EPC and shall cooperate to that end. In their capacity as Contracting States to the EPC, the participating Member States shall ensure the governance and supervision of the activities related to the tasks referred to in paragraph 1 of this Article and shall ensure the setting of the level of renewal fees in accordance with Article 12 of this Regulation and the setting of the share of distribution of the renewal fees in accordance with Article 13 of this Regulation.

To that end they shall set up a select committee of the Administrative Council of the European Patent Organisation (hereinafter "Select Committee") within the meaning of Article 145 of the EPC.

The Select Committee shall consist of the representatives of the participating Member States and a representative of the Commission as an observer, as well as alternates who will represent them in their absence. The members of the Select Committee may be assisted by advisers or experts.

Decisions of the Select Committee shall be taken with due regard for the position of the Commission and in accordance with the rules laid down in Article 35(2) of the EPC.

The participating Member States shall ensure effective legal protection before a competent court of one or several participating Member States against the decisions of the EPO in carrying out the tasks referred to in paragraph 1.

## CHAPTER V

### FINANCIAL PROVISIONS

#### Article 10

##### Principle on expenses

The expenses incurred by the EPO in carrying out the additional tasks given to it, within the meaning of Article 143 of the EPC, by the participating Member States shall be covered by the fees generated by the European patents with unitary effect.

#### Article 11

##### Renewal fees

Renewal fees for European patents with unitary effect and additional fees for their late payment shall be paid to the European Patent Organisation by the patent proprietor. Those fees shall be due in respect of the years following the year in which the mention of the grant of the European patent which benefits from unitary effect is published in the European Patent Bulletin.

A European patent with unitary effect shall lapse if a renewal fee and, where applicable, any additional fee have not been paid in due time.

Renewal fees which fall due after receipt of the statement referred to in Article 8(1) shall be reduced.

## Article 12

### Level of renewal fees

Renewal fees for European patents with unitary effect shall be:

progressive throughout the term of the unitary patent protection;

sufficient to cover all costs associated with the grant of the European patent and the administration of the unitary patent protection; and

sufficient, together with the fees to be paid to the European Patent Organisation during the pre-grant stage, to ensure a balanced budget of the European Patent Organisation.

The level of the renewal fees shall be set, taking into account, among others, the situation of specific entities such as small and medium-sized enterprises, with the aim of:

facilitating innovation and fostering the competitiveness of European businesses;

reflecting the size of the market covered by the patent; and

being similar to the level of the national renewal fees for an average European patent taking effect in the participating Member States at the time the level of the renewal fees is first set.

In order to attain the objectives set out in this Chapter, the level of renewal fees shall be set at a level that:

is equivalent to the level of the renewal fee to be paid for the average geographical coverage of current European patents;

reflects the renewal rate of current European patents; and

reflects the number of requests for unitary effect.

## Article 13

## Distribution

The EPO shall retain 50 per cent of the renewal fees referred to in Article 11 paid for European patents with unitary effect. The remaining amount shall be distributed to the participating Member States in accordance with the share of distribution of the renewal fees set pursuant to Article 9(2).

In order to attain the objectives set out in this Chapter, the share of distribution of renewal fees among the participating Member States shall be based on the following fair, equitable and relevant criteria:

the number of patent applications;

the size of the market, while ensuring a minimum amount to be distributed to each participating Member State;

compensation to the participating Member States which have:

an official language other than one of the official languages of the EPO;

a disproportionately low level of patenting activity; and/or

acquired membership of the European Patent Organisation relatively recently.

## CHAPTER VI

### FINAL PROVISIONS

#### Article 14

##### Cooperation between the Commission and the EPO

The Commission shall establish a close cooperation through a working agreement with the EPO in the fields covered by this Regulation. This cooperation shall include regular exchanges of views on the functioning of the working agreement and, in particular, on the issue of renewal fees and their impact on the budget of the European Patent Organisation.

#### Article 15

##### Application of competition law and the law relating to unfair competition

This Regulation shall be without prejudice to the application of competition law and the law relating to unfair competition.

#### Article 16

##### Report on the operation of this Regulation

Not later than three years from the date on which the first European patent with unitary effect takes effect, and every five years thereafter, the Commission shall present to the European Parliament and the Council a report on the operation of this Regulation and, where necessary, make appropriate proposals for amending it.

The Commission shall regularly submit to the European Parliament and the Council reports on the functioning of the renewal fees referred to in Article 11, with particular emphasis on compliance with Article 12.

#### Article 17

##### Notification by the participating Member States

The participating Member States shall notify the Commission of the measures adopted in accordance with Article 9 by the date of application of this Regulation.

Each participating Member State shall notify the Commission of the measures adopted in accordance with Article 4(2) by the date of application of this Regulation or, in the case of a participating Member State in which the Unified Patent Court does not have exclusive jurisdiction with regard to European patents with unitary effect on the date of application of this Regulation, by the date from which the Unified Patent Court has such exclusive jurisdiction in that participating Member State.

#### Article 18

##### Entry into force and application

This Regulation shall enter into force on the twentieth day following that of its publication in the Official Journal of the European Union.

It shall apply from 1 January 2014 or the date of entry into force of the Agreement on a Unified Patent Court (the "Agreement"), whichever is the later.

By way of derogation from Articles 3(1), 3(2) and 4(1), a European patent for which unitary effect is registered in the Register for unitary patent protection shall have unitary effect only in those participating Member States in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date of registration.

Each participating Member State shall notify the Commission of its ratification of the Agreement at the time of deposit of its ratification instrument. The Commission shall publish in the Official Journal of the European Union the date of entry into force of the Agreement and a list of the Member States who have ratified the Agreement at the date of entry into force. The Commission shall thereafter regularly update the list of the participating Member

States which have ratified the Agreement and shall publish such updated list in the Official Journal of the European Union.

The participating Member States shall ensure that the measures referred to in Article 9 are in place by the date of application of this Regulation.

Each participating Member State shall ensure that the measures referred to in Article 4(2) are in place by the date of application of this Regulation or, in the case of a participating Member State in which the Unified Patent Court does not have exclusive jurisdiction with regard to European patents with unitary effect on the date of application of this Regulation, by the date from which the Unified Patent Court has such exclusive jurisdiction in that participating Member State.

Unitary patent protection may be requested for any European patent granted on or after the date of application of this Regulation.

This Regulation shall be binding in its entirety and directly applicable in the participating Member States in accordance with the Treaties.

Done at Brussels, 17 December 2012.

For the European Parliament

The President

M. Schulz

For the Council

The President

D. Mavroyiannis

[1] OJ L 76, 22.3.2011, p. 53.

[2] Position of the European Parliament of 11 December 2012 (not yet published in the Official Journal) and decision of the Council of 17 December 2012.

[3] See page 89 of this Official Journal.

[4] OJ L 157, 30.4.2004, p. 45.

## **1.2. Directives and decisions**

### **1.2.1. Directive of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions 98/44/EC**

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 100a thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the Economic and Social Committee (2),

Acting in accordance with the procedure laid down in Article 189b of the Treaty (3),

Whereas biotechnology and genetic engineering are playing an increasingly important role in a broad range of industries and the protection of biotechnological inventions will certainly be of fundamental importance for the Community's industrial development;

Whereas, in particular in the field of genetic engineering, research and development require a considerable amount of high-risk investment and therefore only adequate legal protection can make them profitable;

Whereas effective and harmonised protection throughout the Member States is essential in order to maintain and encourage investment in the field of biotechnology;

Whereas following the European Parliament's rejection of the joint text, approved by the Conciliation Committee, for a European Parliament and Council Directive on the legal protection of biotechnological inventions (4), the European Parliament and the Council have determined that the legal protection of biotechnological inventions requires clarification;

Whereas differences exist in the legal protection of biotechnological inventions offered by the laws and practices of the different Member States; whereas such differences could create barriers to trade and hence impede the proper functioning of the internal market;

Whereas such differences could well become greater as Member States adopt new and different legislation and administrative practices, or whereas national case-law interpreting such legislation develops differently;

Whereas uncoordinated development of national laws on the legal protection of biotechnological inventions in the Community could lead to further disincentives to trade, to the detriment of the industrial development of such inventions and of the smooth operation of the internal market;

Whereas legal protection of biotechnological inventions does not necessitate the creation of a separate body of law in place of the rules of national patent law; whereas the rules of national patent law remain the essential basis for the legal protection of biotechnological inventions given that they must be adapted or added to in certain specific respects in order to take adequate account of technological developments involving biological material which also fulfil the requirements for patentability;

Whereas in certain cases, such as the exclusion from patentability of plant and animal varieties and of essentially biological processes for the production of plants and animals, certain concepts in national laws based upon international patent and plant variety conventions have created uncertainty regarding the protection of biotechnological and certain microbiological inventions; whereas harmonisation is necessary to clarify the said uncertainty;

Whereas regard should be had to the potential of the development of biotechnology for the environment and in particular the utility of this technology for the development of methods of cultivation which are less polluting and more economical in their use of ground; whereas the patent system should be used to encourage research into, and the application of, such processes;

Whereas the development of biotechnology is important to developing countries, both in the field of health and combating major epidemics and endemic diseases and in that of combating hunger in the world; whereas the patent system should likewise be used to encourage research in these fields; whereas international procedures for the dissemination of such technology in the Third World and to the benefit of the population groups concerned should be promoted;

Whereas the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) (5) signed by the European Community and the Member States, has entered into force and provides that patent protection must be guaranteed for products and processes in all areas of technology;

Whereas the Community's legal framework for the protection of biotechnological inventions can be limited to laying down certain principles as they apply to the patentability of biological material as such, such principles being intended in particular to determine the difference between inventions and discoveries with regard to the patentability of certain elements of human origin, to the scope of protection conferred by a patent on a biotechnological invention, to the right to use a deposit mechanism in addition to written descriptions and lastly to the option of obtaining non-exclusive compulsory licences in respect of interdependence between plant varieties and inventions, and conversely;

Whereas a patent for invention does not authorise the holder to implement that invention, but merely entitles him to prohibit third parties from exploiting it for industrial and commercial purposes; whereas, consequently, substantive patent law cannot serve to replace or render superfluous national, European or international law which may impose restrictions or prohibitions or which concerns the monitoring of research and of the use or commercialisation of its results, notably from the point of view of the requirements of public health, safety, environmental protection, animal welfare, the preservation of genetic diversity and compliance with certain ethical standards;

Whereas no prohibition or exclusion exists in national or European patent law (Munich Convention) which precludes a priori the patentability of biological matter;

Whereas patent law must be applied so as to respect the fundamental principles safeguarding the dignity and integrity of the person; whereas it is important to assert the principle that the human body, at any stage in its formation or development, including germ cells, and the simple discovery of one of its elements or one of its products, including the sequence or partial sequence of a human gene, cannot be patented; whereas these principles are in line with the criteria of patentability proper to patent law, whereby a mere discovery cannot be patented;

Whereas significant progress in the treatment of diseases has already been made thanks to the existence of medicinal products derived from elements isolated from the human body and/or otherwise produced, such medicinal products resulting from technical processes aimed at obtaining elements similar in structure to those existing naturally in the human body and whereas, consequently, research aimed at obtaining and isolating such elements valuable to medicinal production should be encouraged by means of the patent system;

Whereas, since the patent system provides insufficient incentive for encouraging research into and production of biotechnological medicines which are needed to combat rare or 'orphan' diseases, the Community and the Member States have a duty to respond adequately to this problem;

Whereas account has been taken of Opinion No 8 of the Group of Advisers on the Ethical Implications of Biotechnology to the European Commission;

Whereas, therefore, it should be made clear that an invention based on an element isolated from the human body or otherwise produced by means of a technical process, which is susceptible of industrial application, is not excluded from patentability, even where the structure of that element is identical to that of a natural element, given that the rights conferred by the patent do not extend to the human body and its elements in their natural environment;

Whereas such an element isolated from the human body or otherwise produced is not excluded from patentability since it is, for example, the result of technical processes used to identify, purify and classify it and to reproduce it outside the human body, techniques which human beings alone are capable of putting into practice and which nature is incapable of accomplishing by itself;

Whereas the discussion on the patentability of sequences or partial sequences of genes is controversial; whereas, according to this Directive, the granting of a patent for inventions which concern such sequences or partial sequences should be subject to the same criteria of patentability as in all other areas of technology: novelty, inventive step and industrial application; whereas the industrial application of a sequence or partial sequence must be disclosed in the patent application as filed;

Whereas a mere DNA sequence without indication of a function does not contain any technical information and is therefore not a patentable invention;

Whereas, in order to comply with the industrial application criterion it is necessary in cases where a sequence or partial sequence of a gene is used to produce a protein or part of a protein, to specify which protein or part of a protein is produced or what function it performs;

Whereas, for the purposes of interpreting rights conferred by a patent, when sequences overlap only in parts which are not essential to the invention, each sequence will be considered as an independent sequence in patent law terms;

Whereas if an invention is based on biological material of human origin or if it uses such material, where a patent application is filed, the person from whose body the material is taken must have had an opportunity of expressing free and informed consent thereto, in accordance with national law;

Whereas if an invention is based on biological material of plant or animal origin or if it uses such material, the patent application should, where appropriate, include information on the geographical origin of such material, if known; whereas this is without prejudice to the processing of patent applications or the validity of rights arising from granted patents;

Whereas this Directive does not in any way affect the basis of current patent law, according to which a patent may be granted for any new application of a patented product;

Whereas this Directive is without prejudice to the exclusion of plant and animal varieties from patentability; whereas on the other hand inventions which concern plants or animals are patentable provided that the application of the invention is not technically confined to a single plant or animal variety;

Whereas the concept 'plant variety' is defined by the legislation protecting new varieties, pursuant to which a variety is defined by its whole genome and therefore possesses individuality and is clearly distinguishable from other varieties;

Whereas a plant grouping which is characterised by a particular gene (and not its whole genome) is not covered by the protection of new varieties and is therefore not excluded from patentability even if it comprises new varieties of plants;

Whereas, however, if an invention consists only in genetically modifying a particular plant variety, and if a new plant variety is bred, it will still be excluded from patentability even if the genetic modification is the result not of an essentially biological process but of a biotechnological process;

Whereas it is necessary to define for the purposes of this Directive when a process for the breeding of plants and animals is essentially biological;

Whereas this Directive shall be without prejudice to concepts of invention and discovery, as developed by national, European or international patent law;

Whereas this Directive shall be without prejudice to the provisions of national patent law whereby processes for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body are excluded from patentability;

Whereas the TRIPs Agreement provides for the possibility that members of the World Trade Organisation may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law;

Whereas the principle whereby inventions must be excluded from patentability where their commercial exploitation offends against ordre public or morality must also be stressed in this Directive;

Whereas the operative part of this Directive should also include an illustrative list of inventions excluded from patentability so as to provide national courts and patent offices with a general guide to interpreting the reference to ordre public and morality; whereas this list obviously cannot presume to be exhaustive; whereas processes, the use of which offend against human dignity, such as processes to produce chimeras from germ cells or totipotent cells of humans and animals, are obviously also excluded from patentability;

Whereas ordre public and morality correspond in particular to ethical or moral principles recognised in a Member State, respect for which is particularly important in the field of biotechnology in view of the potential scope of inventions in this field and their inherent relationship to living matter; whereas such ethical or moral principles supplement the standard legal examinations under patent law regardless of the technical field of the invention;

Whereas there is a consensus within the Community that interventions in the human germ line and the cloning of human beings offends against ordre public and morality; whereas it is therefore important to exclude unequivocally from patentability processes for modifying the germ line genetic identity of human beings and processes for cloning human beings;

Whereas a process for cloning human beings may be defined as any process, including techniques of embryo splitting, designed to create a human being with the same nuclear genetic information as another living or deceased human being;

Whereas, moreover, uses of human embryos for industrial or commercial purposes must also be excluded from patentability; whereas in any case such exclusion does not affect inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it;

Whereas pursuant to Article F(2) of the Treaty on European Union, the Union is to respect fundamental rights, as guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms signed in Rome on 4 November 1950 and as they result from the constitutional traditions common to the Member States, as general principles of Community law;

Whereas the Commission's European Group on Ethics in Science and New Technologies evaluates all ethical aspects of biotechnology; whereas it should be pointed out in this connection that that Group may be consulted only where biotechnology is to be evaluated at the level of basic ethical principles, including where it is consulted on patent law;

Whereas processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit in terms of research, prevention, diagnosis or therapy to man or animal, and also animals resulting from such processes, must be excluded from patentability;

Whereas, in view of the fact that the function of a patent is to reward the inventor for his creative efforts by granting an exclusive but time-bound right, and thereby encourage inventive activities, the holder of the patent should be entitled to prohibit the use of patented self-reproducing material in situations analogous to those where it would be permitted to prohibit the use of patented, non-self-reproducing products, that is to say the production of the patented product itself;

Whereas it is necessary to provide for a first derogation from the rights of the holder of the patent when the propagating material incorporating the protected invention is sold to a farmer for farming purposes by the holder of the patent or with his consent; whereas that initial derogation must authorise the farmer to use the product of his harvest for further multiplication or propagation on his own farm; whereas the extent and the conditions of that derogation must be limited in accordance with the extent and conditions set out in Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights (6);

Whereas only the fee envisaged under Community law relating to plant variety rights as a condition for applying the derogation from Community plant variety rights can be required of the farmer;

Whereas, however, the holder of the patent may defend his rights against a farmer abusing the derogation or against a breeder who has developed a plant variety incorporating the protected invention if the latter fails to adhere to his commitments;

Whereas a second derogation from the rights of the holder of the patent must authorise the farmer to use protected livestock for agricultural purposes;

Whereas the extent and the conditions of that second derogation must be determined by national laws, regulations and practices, since there is no Community legislation on animal variety rights;

Whereas, in the field of exploitation of new plant characteristics resulting from genetic engineering, guaranteed access must, on payment of a fee, be granted in the form of a compulsory licence where, in relation to the genus or species concerned, the plant variety represents significant technical progress of considerable economic interest compared to the invention claimed in the patent;

Whereas, in the field of the use of new plant characteristics resulting from new plant varieties in genetic engineering, guaranteed access must, on payment of a fee, be granted in the form of a compulsory licence where the invention represents significant technical progress of considerable economic interest;

Whereas Article 34 of the TRIPs Agreement contains detailed provisions on the burden of proof which is binding on all Member States; whereas, therefore, a provision in this Directive is not necessary;

Whereas following Decision 93/626/EEC (7) the Community is party to the Convention on Biological Diversity of 5 June 1992; whereas, in this regard, Member States must give particular weight to Article 3 and Article 8(j), the second sentence of Article 16(2) and Article 16(5) of the Convention when bringing into force the laws, regulations and administrative provisions necessary to comply with this Directive;

Whereas the Third Conference of the Parties to the Biodiversity Convention, which took place in November 1996, noted in Decision III/17 that 'further work is required to help develop a common appreciation of the relationship between intellectual property rights and the relevant

provisions of the TRIPs Agreement and the Convention on Biological Diversity, in particular on issues relating to technology transfer and conservation and sustainable use of biological diversity and the fair and equitable sharing of benefits arising out of the use of genetic resources, including the protection of knowledge, innovations and practices of indigenous and local communities embodying traditional lifestyles relevant for the conservation and sustainable use of biological diversity` ,

HAVE ADOPTED THIS DIRECTIVE:

## CHAPTER I Patentability

### Article 1

Member States shall protect biotechnological inventions under national patent law. They shall, if necessary, adjust their national patent law to take account of the provisions of this Directive.

This Directive shall be without prejudice to the obligations of the Member States pursuant to international agreements, and in particular the TRIPs Agreement and the Convention on Biological Diversity.

### Article 2

For the purposes of this Directive,

'biological material` means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system;

'microbiological process` means any process involving or performed upon or resulting in microbiological material.

A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.

The concept of 'plant variety` is defined by Article 5 of Regulation (EC) No 2100/94.

### Article 3

For the purposes of this Directive, inventions which are new, which involve an inventive step and which are susceptible of industrial application shall be patentable even if they concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used.

Biological material which is isolated from its natural environment or produced by means of a technical process may be the subject of an invention even if it previously occurred in nature.

#### Article 4

The following shall not be patentable:

plant and animal varieties;

essentially biological processes for the production of plants or animals.

Inventions which concern plants or animals shall be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety.

Paragraph 1(b) shall be without prejudice to the patentability of inventions which concern a microbiological or other technical process or a product obtained by means of such a process.

#### Article 5

The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

#### Article 6

Inventions shall be considered unpatentable where their commercial exploitation would be contrary to ordre public or morality; however, exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation.

On the basis of paragraph 1, the following, in particular, shall be considered unpatentable:

processes for cloning human beings;

processes for modifying the germ line genetic identity of human beings;

uses of human embryos for industrial or commercial purposes;

processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

#### Article 7

The Commission's European Group on Ethics in Science and New Technologies evaluates all ethical aspects of biotechnology.

### CHAPTER II Scope of protection

#### Article 8

The protection conferred by a patent on a biological material possessing specific characteristics as a result of the invention shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

The protection conferred by a patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention shall extend to biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

#### Article 9

The protection conferred by a patent on a product containing or consisting of genetic information shall extend to all material, save as provided in Article 5(1), in which the product is incorporated and in which the genetic information is contained and performs its function.

#### Article 10

The protection referred to in Articles 8 and 9 shall not extend to biological material obtained from the propagation or multiplication of biological material placed on the market in the territory of a Member State by the holder of the patent or with his consent, where the multiplication or propagation necessarily results from the application for which the biological material was marketed, provided that the material obtained is not subsequently used for other propagation or multiplication.

#### Article 11

By way of derogation from Articles 8 and 9, the sale or other form of commercialisation of plant propagating material to a farmer by the holder of the patent or with his consent for agricultural use implies authorisation for the farmer to use the product of his harvest for propagation or multiplication by him on his own farm, the extent and conditions of this derogation corresponding to those under Article 14 of Regulation (EC) No 2100/94.

By way of derogation from Articles 8 and 9, the sale or any other form of commercialisation of breeding stock or other animal reproductive material to a farmer by the holder of the patent or with his consent implies authorisation for the farmer to use the protected livestock for an agricultural purpose. This includes making the animal or other animal reproductive material available for the purposes of pursuing his agricultural activity but not sale within the framework or for the purpose of a commercial reproduction activity.

The extent and the conditions of the derogation provided for in paragraph 2 shall be determined by national laws, regulations and practices.

### CHAPTER III Compulsory cross-licensing

#### Article 12

Where a breeder cannot acquire or exploit a plant variety right without infringing a prior patent, he may apply for a compulsory licence for non-exclusive use of the invention protected by the patent inasmuch as the licence is necessary for the exploitation of the plant variety to be protected, subject to payment of an appropriate royalty. Member States shall provide that, where such a licence is granted, the holder of the patent will be entitled to a cross-licence on reasonable terms to use the protected variety.

Where the holder of a patent concerning a biotechnological invention cannot exploit it without infringing a prior plant variety right, he may apply for a compulsory licence for non-exclusive use of the plant variety protected by that right, subject to payment of an appropriate royalty. Member States shall provide that, where such a licence is granted, the holder of the variety right will be entitled to a cross-licence on reasonable terms to use the protected invention.

Applicants for the licences referred to in paragraphs 1 and 2 must demonstrate that:

they have applied unsuccessfully to the holder of the patent or of the plant variety right to obtain a contractual licence;

the plant variety or the invention constitutes significant technical progress of considerable economic interest compared with the invention claimed in the patent or the protected plant variety.

Each Member State shall designate the authority or authorities responsible for granting the licence. Where a licence for a plant variety can be granted only by the Community Plant Variety Office, Article 29 of Regulation (EC) No 2100/94 shall apply.

#### CHAPTER IV Deposit, access and re-deposit of a biological material

##### Article 13

Where an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in a patent application in such a manner as to enable the invention to be reproduced by a person skilled in the art, the description shall be considered inadequate for the purposes of patent law unless:

the biological material has been deposited no later than the date on which the patent application was filed with a recognised depository institution. At least the international depository authorities which acquired this status by virtue of Article 7 of the Budapest Treaty of 28 April 1977 on the international recognition of the deposit of micro-organisms for the purposes of patent procedure, hereinafter referred to as the 'Budapest Treaty', shall be recognised;

the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material deposited;

the patent application states the name of the depository institution and the accession number.

Access to the deposited biological material shall be provided through the supply of a sample:

up to the first publication of the patent application, only to those persons who are authorised under national patent law;

between the first publication of the application and the granting of the patent, to anyone requesting it or, if the applicant so requests, only to an independent expert;

after the patent has been granted, and notwithstanding revocation or cancellation of the patent, to anyone requesting it.

The sample shall be supplied only if the person requesting it undertakes, for the term during which the patent is in force:

not to make it or any material derived from it available to third parties; and

not to use it or any material derived from it except for experimental purposes, unless the applicant for or proprietor of the patent, as applicable, expressly waives such an undertaking.

At the applicant's request, where an application is refused or withdrawn, access to the deposited material shall be limited to an independent expert for 20 years from the date on which the patent application was filed. In that case, paragraph 3 shall apply.

The applicant's requests referred to in point (b) of paragraph 2 and in paragraph 4 may only be made up to the date on which the technical preparations for publishing the patent application are deemed to have been completed.

#### Article 14

If the biological material deposited in accordance with Article 13 ceases to be available from the recognised depositary institution, a new deposit of the material shall be permitted on the same terms as those laid down in the Budapest Treaty.

Any new deposit shall be accompanied by a statement signed by the depositor certifying that the newly deposited biological material is the same as that originally deposited.

#### CHAPTER V Final provisions

#### Article 15

Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than 30 July 2000. They shall forthwith inform the Commission thereof.

When Member States adopt these measures, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

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

#### Article 16

The Commission shall send the European Parliament and the Council:

every five years as from the date specified in Article 15(1) a report on any problems encountered with regard to the relationship between this Directive and international agreements on the protection of human rights to which the Member States have acceded;

within two years of entry into force of this Directive, a report assessing the implications for basic genetic engineering research of failure to publish, or late publication of, papers on subjects which could be patentable;

annually as from the date specified in Article 15(1), a report on the development and implications of patent law in the field of biotechnology and genetic engineering.

#### Article 17

This Directive shall enter into force on the day of its publication in the Official Journal of the European Communities.

#### Article 18

This Directive is addressed to the Member States.

Done at Brussels, 6 July 1998.

For the European Parliament

The President

J. M. GIL-ROBLES

For the Council

The President

R. EDLINGER

OJ C 296, 8.10.1996, p. 4 and OJ C 311, 11.10.1997, p. 12.

OJ C 295, 7.10.1996, p. 11.

Opinion of the European Parliament of 16 July 1997 (OJ C 286, 22.9.1997, p. 87). Council Common Position of 26 February 1998 (OJ C 110, 8.4.1998, p. 17) and Decision of the

European Parliament of 12 May 1998 (OJ C 167, 1.6.1998). Council Decision of 16 June 1998.

OJ C 68, 20.3.1995, p. 26.

OJ L 336, 23.12.1994, p. 213.

OJ L 227, 1.9.1994, p. 1. Regulation as amended by Regulation (EC) No 2506/95 (OJ L 258, 28.10.1995, p. 3).

OJ L 309, 31.12.1993, p. 1

## **1.2.2. Council Decision of 10 March 2011 authorising enhanced cooperation in the area of the creation of unitary patent protection 2011/167/EU<sup>3</sup>**

of 10 March 2011

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty on the Functioning of the European Union, and in particular Article 329(1) thereof,

Having regard to the requests made by the Kingdom of Belgium, the Republic of Bulgaria, the Czech Republic, the Kingdom of Denmark, the Federal Republic of Germany, the Republic of Estonia, Ireland, the Hellenic Republic, the French Republic, the Republic of Cyprus, the Republic of Latvia, the Republic of Lithuania, the Grand Duchy of Luxembourg, the Republic of Hungary, Malta, the Kingdom of the Netherlands, the Republic of Austria, the Republic of Poland, the Portuguese Republic, Romania, the Republic of Slovenia, the Slovak Republic, the Republic of Finland, the Kingdom of Sweden and the United Kingdom of Great Britain and Northern Ireland,

Having regard to the proposal from the European Commission,

Having regard to the consent of the European Parliament,

---

<sup>3</sup> *Official Journal L 076*, 22/03/2011 P. 0053 - 0055

Whereas:

In accordance with Article 3(3) of the Treaty on European Union (TEU), the Union shall establish an internal market, shall work for the sustainable development of Europe based on balanced economic growth and shall promote scientific and technological advance. The creation of the legal conditions enabling undertakings to adapt their activities in manufacturing and distributing products across national borders and providing companies with more choice and opportunities contributes to attaining this objective. A unitary patent which provides uniform effects throughout the Union should feature amongst the legal instruments which undertakings have at their disposal.

Pursuant to Article 118 of the Treaty on the Functioning of the European Union (TFEU) and in the context of the establishment and functioning of the internal market, measures should include the creation of uniform patent protection throughout the Union and the establishment of centralised Union-wide authorisation, coordination and supervision arrangements.

On 5 July 2000, the Commission adopted a proposal for a Council Regulation on the Community patent for the creation of a unitary patent providing uniform protection throughout the Union. On 30 June 2010, the Commission adopted a proposal for a Council Regulation on the translation arrangements for the European Union patent (hereinafter "the proposed Regulation on the translation arrangements") providing for the translation arrangements applicable to the European Union patent.

At the Council meeting on 10 November 2010, it was recorded that there was no unanimity to go ahead with the proposed Regulation on the translation arrangements. It was confirmed on 10 December 2010 that insurmountable difficulties existed, making unanimity impossible at the time and in the foreseeable future. Since the agreement on the proposed Regulation on the translation arrangements is necessary for a final agreement on unitary patent protection in the Union, it is established that the objective to create unitary patent protection for the Union could not be attained within a reasonable period by applying the relevant provisions of the Treaties.

In these circumstances, 12 Member States, namely Denmark, Germany, Estonia, France, Lithuania, Luxembourg, the Netherlands, Poland, Slovenia, Finland, Sweden and the United Kingdom, addressed requests to the Commission by letters dated 7, 8 and 13 December 2010 indicating that they wished to establish enhanced cooperation between themselves in the area of the creation of unitary patent protection on the basis of the existing proposals supported by

these Member States during the negotiations and that the Commission should submit a proposal to the Council to that end. The requests were confirmed at the meeting of the Council on 10 December 2010. In the meantime, 13 more Member States, namely Belgium, Bulgaria, the Czech Republic, Ireland, Greece, Cyprus, Latvia, Hungary, Malta, Austria, Portugal, Romania and Slovakia have written to the Commission indicating that they also wish to participate in the envisaged enhanced cooperation. In total, 25 Member States have requested enhanced cooperation.

Enhanced cooperation should provide the necessary legal framework for the creation of unitary patent protection in participating Member States and ensure the possibility for undertakings throughout the Union to improve their competitiveness by having the choice of seeking uniform patent protection in participating Member States, as well as contributing to scientific and technological advance.

Enhanced cooperation should aim at creating a unitary patent, providing uniform protection throughout the territories of the participating Member States, which would be granted in respect of all those Member States by the European Patent Office (EPO). As a necessary part of the unitary patent, the applicable translation arrangements should be simple and cost-effective and correspond to those provided for in the proposal for a Council Regulation on the translation arrangements for the European Union patent, presented by the Commission on 30 June 2010, combined with the elements of compromise proposed by the Presidency in November 2010 that had wide support in Council. The translation arrangements would maintain the possibility of filing patent applications in any language of the Union at the EPO, and would ensure compensation of the costs related to the translation of applications filed in languages other than an official language of the EPO. The patent having unitary effect should be granted only in one of the official languages of the EPO as provided for in the Convention on the Grant of European Patents (European Patent Convention). No further translations would be required without prejudice to transitional arrangements which would be proportionate and require additional translations on a temporary basis, without legal effect and purely for information purposes. In any case, transitional arrangements would terminate when high quality machine translations are made available, subject to an objective evaluation of their quality. In case of a dispute, mandatory translation obligations should apply to the patent proprietor.

The conditions laid down in Article 20 TEU and in Articles 326 and 329 TFEU are fulfilled.

The area within which enhanced cooperation would take place, the establishment of measures for the creation of a unitary patent providing protection throughout the Union and the setting-up of centralised Union-wide authorisation, coordination and supervision arrangements, is identified by Article 118 TFEU as one of the areas covered by the Treaties.

It was recorded at the Council meeting on 10 November 2010 and confirmed on 10 December 2010 that the objective to establish unitary patent protection within the Union cannot be attained within a reasonable period by the Union as a whole, thus fulfilling the requirement in Article 20(2) TEU that enhanced cooperation be adopted only as a last resort.

Enhanced cooperation in the area of the creation of unitary patent protection aims at fostering scientific and technological advance and the functioning of the internal market. The creation of unitary patent protection for a group of Member States would improve the level of patent protection by providing the possibility to obtain uniform patent protection throughout the territories of the participating Member States and eliminate the costs and complexity for those territories. Thus, it furthers the objectives of the Union, protects its interests and reinforces its integration process in accordance with Article 20(1) TEU.

The creation of unitary patent protection is not included in the list of areas of exclusive competence of the Union set out in Article 3(1) TFEU. The legal basis for the creation of European intellectual property rights is Article 118 TFEU, which falls within Chapter 3 (Approximation of Laws) of Title VII (Common Rules on Competition, Taxation and Approximation of Laws), and makes a specific reference to the establishment and functioning of the internal market, which is one of the shared competences of the Union according to Article 4 TFEU. The creation of unitary patent protection, including applicable translation arrangements, therefore falls within the framework of the Union's non-exclusive competence.

Enhanced cooperation in the area of the creation of unitary patent protection complies with the Treaties and Union law, and does not undermine the internal market or economic, social or territorial cohesion. It does not constitute a barrier to, or discrimination in, trade between Member States and does not distort competition between them.

Enhanced cooperation in the area of the creation of unitary patent protection respects the competences, rights and obligations of non-participating Member States. The possibility of obtaining unitary patent protection on the territories of the Member States participating does not affect the availability or the conditions of patent protection on the territories of non-participating Member States. Moreover, undertakings from non-participating Member States

should have the possibility to obtain unitary patent protection on the territories of the participating Member States under the same conditions as undertakings from participating Member States. Existing rules of non-participating Member States determining the conditions of obtaining patent protection on their territory remain unaffected.

In particular, enhanced cooperation in the area of the creation of unitary patent protection would comply with Union law on patents since enhanced cooperation would respect pre-existing *acquis*.

Subject to compliance with any conditions of participation laid down in this Decision, enhanced cooperation in the area of the creation of unitary patent protection is open at any time to all Member States willing to comply with the acts already adopted within this framework in accordance with Article 328 TFEU,

HAS ADOPTED THIS DECISION:

Article 1

The Kingdom of Belgium, the Republic of Bulgaria, the Czech Republic, the Kingdom of Denmark, the Federal Republic of Germany, the Republic of Estonia, Ireland, the Hellenic Republic, the French Republic, the Republic of Cyprus, the Republic of Latvia, the Republic of Lithuania, the Grand Duchy of Luxembourg, the Republic of Hungary, Malta, the Kingdom of the Netherlands, the Republic of Austria, the Republic of Poland, the Portuguese Republic, Romania, the Republic of Slovenia, the Slovak Republic, the Republic of Finland, the Kingdom of Sweden and the United Kingdom of Great Britain and Northern Ireland are hereby authorised to establish enhanced cooperation between themselves in the area of the creation of unitary patent protection, by applying the relevant provisions of the Treaties.

Article 2

This Decision shall enter into force on the day of its adoption.

Done at Brussels, 10 March 2011.

For the Council

The President

Cséfalvay Z.

## Chapter II. Trade marks

### 2.1. Regulations

#### 2.1.1. Council Regulation (EC) of 26 February 2009 on the Community trade mark (codified version) Text with EEA relevance No 207/2009<sup>4</sup>

of 26 February 2009

(codified version) (Text with EEA relevance)

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Parliament [1],

Whereas:

Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [2] has been substantially amended several times [3]. In the interests of clarity and rationality the said Regulation should be codified.

It is desirable to promote throughout the Community a harmonious development of economic activities and a continuous and balanced expansion by completing an internal 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 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

---

<sup>4</sup> *Official Journal L 078* , 24/03/2009 P. 0001 - 0042

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.

For the purpose of pursuing the Community's said objectives it would appear necessary to provide for Community arrangements for trade marks whereby undertakings can by means of one procedural system obtain Community trade marks to which uniform protection is given and which produce their effects throughout the entire area of the Community. The principle of the unitary character of the Community trade mark thus stated should apply unless otherwise provided for in this Regulation.

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 order to open up unrestricted economic activity in the whole of the internal market for the benefit of undertakings, trade marks should be created which are governed by a uniform Community law directly applicable in all Member States.

Since the Treaty has not provided the specific powers to establish such a legal instrument, Article 308 of the Treaty should be applied.

The Community law relating to trade marks nevertheless does not replace the laws of the Member States on trade marks. It would not in fact appear to be justified to require undertakings to apply for registration of their trade marks as Community trade marks. National trade marks continue to be necessary for those undertakings which do not want protection of their trade marks at Community level.

The rights in a Community trade mark should not be obtained otherwise than by registration, and registration should be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights.

The protection afforded by a Community trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in cases of similarity between the mark and the sign and the goods or services. An interpretation should be given of the concept of similarity in relation to the likelihood of confusion. 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, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection.

It follows from the principle of free movement of goods that the proprietor of a Community trade mark 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, under the trade mark, by him or with his consent, save where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods.

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 undertakings whose goods or services are designated by it. Accordingly, it should be capable of being transferred, subject to the overriding need to prevent the public being misled as a result of the transfer. It should also be capable of being charged as security in favour of a third party and of being the subject matter of licences.

Administrative measures are necessary at Community level for implementing in relation to every trade mark the trade mark law created by this Regulation. It is therefore essential, while retaining the Community's existing institutional structure and balance of powers, to provide for an Office for Harmonisation in the Internal Market (trade marks and designs) which is independent in relation to technical matters and has legal, administrative and financial autonomy. To this end it is necessary and appropriate that that Office should be a body of the Community having legal personality and exercising the implementing powers which are conferred on it by this Regulation, and that it should operate within the framework of Community law without detracting from the competencies exercised by the Community institutions.

It is necessary to ensure that parties who are affected by decisions made by the Office are protected by the law in a manner which is suited to the special character of trade mark law. To that end provision is made for an appeal to lie from decisions of the examiners and of the various divisions of the Office. If the department whose decision is contested does not rectify its decision it is to remit the appeal to a Board of Appeal of the Office, which is to decide on

it. Decisions of the Boards of Appeal are, in turn, amenable to actions before the Court of Justice of the European Communities, which has jurisdiction to annul or to alter the contested decision.

Under the first subparagraph of Article 225(1) of the EC Treaty the Court of First Instance of the European Communities has jurisdiction to hear and determine at first instance the actions referred to in particular in Article 230 of the EC Treaty with the exception of those assigned to a judicial panel and those reserved in the Statute to the Court of Justice. The jurisdiction which this Regulation confers on the Court of Justice to cancel and alter decisions of the Boards of Appeal should accordingly be exercised at first instance by the Court.

In order to strengthen the protection of Community trade marks the Member States should designate, having regard to their own national system, as limited a number as possible of national courts of first and second instance having jurisdiction in matters of infringement and validity of Community trade marks.

Decisions regarding the validity and infringement of Community trade marks must have effect and cover the entire area of the Community, as 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 provisions of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters [4] should apply to all actions at law relating to Community trade marks, save where this Regulation derogates from those rules.

Contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of a Community trade mark and parallel national trade marks. For this purpose, when the actions are brought in the same Member State, the way in which this is to be achieved is a matter for national procedural rules, which are not prejudiced by this Regulation, whilst when the actions are brought in different Member States, provisions modelled on the rules on *lis pendens* and related actions of Regulation (EC) No 44/2001 appear appropriate.

In order to guarantee the full autonomy and independence of the Office, it is considered necessary to grant it an autonomous budget whose revenue comes principally from fees paid by the users of the system. However, the Community budgetary procedure remains applicable

as far as any subsidies chargeable to the general budget of the European Communities are concerned. Moreover, the auditing of accounts should be undertaken by the Court of Auditors.

Measures necessary for the implementation of this Regulation should be adopted, particularly as regards fees regulations and an Implementing Regulation, in accordance with Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission [5],

HAS ADOPTED THIS REGULATION:

## TITLE I

### GENERAL PROVISIONS

#### Article 1

##### Community trade mark

A trade mark for goods or services which is registered in accordance with the conditions contained in this Regulation and in the manner herein provided is hereinafter referred to as a "Community trade mark".

A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle shall apply unless otherwise provided in this Regulation.

#### Article 2

##### Office

An Office for Harmonisation in the Internal Market (trade marks and designs), hereinafter referred to as "the Office", is hereby established.

#### Article 3

##### Capacity to act

For the purpose of implementing this Regulation, companies or firms and other legal bodies shall be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued.

## TITLE II

### THE LAW RELATING TO TRADE MARKS

#### SECTION 1

Definition of a Community trade mark and obtaining a Community trade mark

##### Article 4

Signs of which a Community trade mark may consist

A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

##### Article 5

Persons who can be proprietors of Community trade marks

Any natural or legal person, including authorities established under public law, may be the proprietor of a Community trade mark.

##### Article 6

Means whereby a Community trade mark is obtained

A Community trade mark shall be obtained by registration.

##### Article 7

Absolute grounds for refusal

The following shall not be registered:

signs which do not conform to the requirements of Article 4;

trade marks which are devoid of any distinctive character;

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

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

signs which consist exclusively of:

the shape which results from the nature of the goods themselves;

the shape of goods which is necessary to obtain a technical result;

the shape which gives substantial value to the goods;

trade marks which are contrary to public policy or to accepted principles of morality;

trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the "Paris Convention";

trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the competent authority to their registration has been given;

trade marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin;

trade marks which contain or consist of a designation of origin or a geographical indication registered in accordance with Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs [6] when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication.

Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

## Article 8

### Relative grounds for refusal

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

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

if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

For the purposes of paragraph 1, "earlier trade marks" means:

trade marks of the following kinds with a date of application for registration which is earlier than 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:

Community trade marks;

trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;

trade marks registered under international arrangements which have effect in a Member State;

trade marks registered under international arrangements which have effect in the Community;

applications for the trade marks referred to in subparagraph (a), subject to their registration;

trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words "well known" are used in Article 6bis of the Paris Convention.

Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

## SECTION 2

### Effects of Community trade marks

#### Article 9

##### Rights conferred by a Community trade mark

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

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

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

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 latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.

The following, inter alia, may be prohibited under paragraph 1:

affixing the sign to the goods or to the packaging thereof;

offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

importing or exporting the goods under that sign;

using the sign on business papers and in advertising.

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 acts occurring after the date of publication of a Community trade mark application, which acts would, after publication of the registration of the trade mark, be prohibited by virtue of that publication. The court seized of the case may not decide upon the merits of the case until the registration has been published.

## Article 10

### Reproduction of Community trade marks in dictionaries

If the reproduction of a Community trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the Community trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark.

## Article 11

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

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

## Article 12

Limitation of the effects of a Community trade mark

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

his own name or address;

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;

the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided he uses them in accordance with honest practices in industrial or commercial matters.

## Article 13

Exhaustion of the rights conferred by a Community trade mark

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

Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

## Article 14

Complementary application of national law relating to infringement

The effects of Community trade marks shall be governed solely by the provisions of this Regulation. In other respects, infringement of a Community trade mark shall be governed by the national law relating to infringement of a national trade mark in accordance with the provisions of Title X.

This Regulation shall not prevent actions concerning a Community trade mark being brought under the law of Member States relating in particular to civil liability and unfair competition.

The rules of procedure to be applied shall be determined in accordance with the provisions of Title X.

### SECTION 3

Use of Community trade marks

#### Article 15

Use of Community trade marks

If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes.

Use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

### SECTION 4

Community trade marks as objects of property

#### Article 16

Dealing with Community trade marks as national trade marks

Unless Articles 17 to 24 provide otherwise, a Community trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national trade mark registered in the Member State in which, according to the Register of Community trade marks:

the proprietor has his seat or his domicile on the relevant date;

where point (a) does not apply, the proprietor has an establishment on the relevant date.

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 seat of the Office is situated.

If two or more persons are mentioned in the Register of Community trade marks as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply.

## Article 17

### Transfer

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.

A transfer of the whole of the undertaking shall include the transfer of the Community trade mark except where, in accordance with the law governing the transfer, there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

Without prejudice to paragraph 2, an assignment of the Community trade mark shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

Where it is clear from the transfer documents that because of the transfer the Community trade mark is likely to 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 unless the successor agrees to limit registration of the Community trade mark to goods or services in respect of which it is not likely to mislead.

On request of one of the parties a transfer shall be entered in the Register and published.

As long as the transfer has not been entered in the Register, the successor in title may not invoke the rights arising from the registration of the Community trade mark.

Where there are time limits to be observed vis-à-vis the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office.

All documents which require notification to the proprietor of the Community trade mark in accordance with Article 79 shall be addressed to the person registered as proprietor.

#### Article 18

Transfer of a trade mark registered in the name of an agent

Where a Community trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment in his favour of the said registration, unless such agent or representative justifies his action.

#### Article 19

Rights in rem

A Community trade mark may, independently of the undertaking, be given as security or be the subject of rights in rem.

On request of one of the parties, rights mentioned in paragraph 1 shall be entered in the Register and published.

#### Article 20

Levy of execution

A Community trade mark may be levied in execution.

As regards the procedure for levy of execution in respect of a Community trade mark, the courts and authorities of the Member States determined in accordance with Article 16 shall have exclusive jurisdiction.

On request of one the parties, levy of execution shall be entered in the Register and published.

#### Article 21

Insolvency proceedings

The only insolvency proceedings in which a Community trade mark may be involved are those opened in the Member State in the territory of which the debtor has his centre of main interests.

However, where the debtor is an insurance undertaking or a credit institution as defined in Directive 2001/17/EC of the European Parliament and of the Council of 19 March 2001 on the reorganisation and winding-up of insurance undertakings [7] and Directive 2001/24/EC of the European Parliament and of the Council of 4 April 2001 on the reorganisation and winding up of credit institutions [8], respectively, the only insolvency proceedings in which a Community trademark may be involved are those opened in the Member State where that undertaking or institution has been authorised.

In the case of joint proprietorship of a Community trade mark, paragraph 1 shall apply to the share of the joint proprietor.

Where a Community trade mark is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the Register and published in the Community Trade Marks Bulletin referred to in Article 89.

## Article 22

### Licensing

A Community trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Community. A licence may be exclusive or non-exclusive.

The proprietor of a Community trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to:

its duration;

the form covered by the registration in which the trade mark may be used;

the scope of the goods or services for which the licence is granted;

the territory in which the trade mark may be affixed; or

the quality of the goods manufactured or of the services provided by the licensee.

Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community trade mark only if its proprietor consents

thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

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

On request of one of the parties the grant or transfer of a licence in respect of a Community trade mark shall be entered in the Register and published.

#### Article 23

##### Effects vis-à-vis third parties

Legal acts referred to in Articles 17, 19 and 22 concerning a Community trade mark shall have effects vis-à-vis third parties in all the Member States only after entry in the Register. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired.

Paragraph 1 shall not apply in the case of a person who acquires the Community trade mark or a right concerning the Community trade mark by way of transfer of the whole of the undertaking or by any other universal succession.

The effects vis-à-vis third parties of the legal acts referred to in Article 20 shall be governed by the law of the Member State determined in accordance with Article 16.

Until such time as common rules for the Member States in the field of bankruptcy enter into force, the effects vis-à-vis third parties of bankruptcy or like proceedings shall be governed by the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.

#### Article 24

The application for a Community trade mark as an object of property

Articles 16 to 23 shall apply to applications for Community trade marks.

### TITLE III

### APPLICATION FOR COMMUNITY TRADE MARKS

## SECTION 1

Filing of applications and the conditions which govern them

### Article 25

Filing of applications

An application for a Community trade mark shall be filed, at the choice of the applicant:

at the Office;

at the central industrial property office of a Member State or at the Benelux Office for Intellectual Property. An application filed in this way shall have the same effect as if it had been filed on the same date at the Office.

Where the application is filed at the central industrial property office of a Member State or at the Benelux Office for Intellectual Property, that office shall take all steps to forward the application to the Office within two weeks after filing. It may charge the applicant a fee which shall not exceed the administrative costs of receiving and forwarding the application.

Applications referred to in paragraph 2 which reach the Office more than two months after filing shall be deemed to have been filed on the date on which the application reached the Office.

Ten years after the entry into force of Regulation (EC) No 40/94, the Commission shall draw up a report on the operation of the system of filing applications for Community trade marks, together with any proposals for modifying this system.

### Article 26

Conditions with which applications must comply

An application for a Community trade mark shall contain:

a request for the registration of a Community trade mark;

information identifying the applicant;

a list of the goods or services in respect of which the registration is requested;

a representation of the trade mark.

The application for a Community trade mark shall be subject to the payment of the application fee and, when appropriate, of one or more class fees.

An application for a Community trade mark must comply with the conditions laid down in the Implementing Regulation referred to in Article 162(1), hereinafter referred to as the "Implementing Regulation".

#### Article 27

##### Date of filing

The date of filing of a Community trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Office by the applicant or, if the application has been filed with the central office of a Member State or with the Benelux Office for Intellectual Property, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents.

#### Article 28

##### Classification

Goods and services in respect of which Community trade marks are applied for shall be classified in conformity with the system of classification specified in the Implementing Regulation.

## SECTION 2

##### Priority

#### Article 29

##### Right of priority

A person who has duly filed an application for a trade mark in or in respect of any State party to the Paris Convention or to the Agreement establishing the World Trade Organisation, or his successors in title, shall enjoy, 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 or contained within those for which the application has been filed, a right of priority during a period of six months from the date of filing of the first application.

Every filing that 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.

By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

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 in respect of the same State shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

If the first filing has been made in a State which is not a party to the Paris Convention or to the Agreement establishing the World Trade Organisation, paragraphs 1 to 4 shall apply only in so far as that State, according to published findings, grants, on the basis of the first filing made at the Office and subject to conditions equivalent to those laid down in this Regulation, a right of priority having equivalent effect.

## Article 30

### Claiming priority

An applicant desiring to take advantage of the priority of a previous application shall file a declaration of priority and a copy of the previous application. If the language of the latter is not one of the languages of the Office, the applicant shall file a translation of the previous application in one of those languages.

## Article 31

### Effect of priority right

The right of priority shall have the effect that the date of priority shall count as the date of filing of the Community trade mark application for the purposes of establishing which rights take precedence.

## Article 32

### Equivalence of Community filing with national filing

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, where appropriate with the priority claimed for the Community trade mark application.

### SECTION 3

Exhibition priority

Article 33

Exhibition priority

If an applicant for a Community trade mark has displayed goods or services under the mark applied for, at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972, he may, if he files the application within a period of six months from the date of the first display of the goods or services under the mark applied for, claim a right of priority from that date within the meaning of Article 31.

An applicant who wishes to claim priority pursuant to paragraph 1 must file evidence of the display of goods or services under the mark applied for under the conditions laid down in the Implementing Regulation.

An exhibition priority granted in a Member State or in a third country does not extend the period of priority laid down in Article 29.

### SECTION 4

Claiming the seniority of a national trade mark

Article 34

Claiming the seniority of a national trade mark

The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, who applies for an identical trade mark for registration as a Community trade mark for goods or services which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the Community trade mark the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

Seniority shall have the sole effect under this Regulation that, where the proprietor of the Community trade mark surrenders the earlier trade mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.

The seniority claimed for the Community trade mark shall lapse if the earlier trade mark the seniority of which is claimed is declared to have been revoked or to be invalid or if it is surrendered prior to the registration of the Community trade mark.

#### Article 35

Claiming seniority after registration of the Community trade mark

The proprietor of a Community trade mark who is the proprietor of an earlier identical trade mark registered in a Member State, including a trade mark registered in the Benelux countries or of an earlier identical trade mark, with an international registration effective in a Member State, for goods or services which are identical to those for which the earlier trade mark has been registered, or contained within them, may claim the seniority of the earlier trade mark in respect of the Member State in or for which it was registered.

Article 34(2) and (3) shall apply.

### TITLE IV

#### REGISTRATION PROCEDURE

##### SECTION 1

Examination of applications

#### Article 36

Examination of the conditions of filing

The Office shall examine whether:

the Community trade mark application satisfies the requirements for the accordane of a date of filing in accordance with Article 27;

the Community trade mark application complies with the conditions laid down in this Regulation and with the conditions laid down in the Implementing Regulation;

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

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

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

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

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

Failure to satisfy the requirements concerning the claim to priority shall result in loss of the right of priority for the application.

Failure to satisfy the requirements concerning the claiming of seniority of a national trade mark shall result in loss of that right for the application.

## Article 37

### Examination as to absolute grounds for refusal

Where, under Article 7, a trade mark is ineligible for registration in respect of some or all of the goods or services covered by the Community trade mark application, the application shall be refused as regards those goods or services.

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

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

## SECTION 2

### Search

#### Article 38

### Search

Once the Office has accorded a date of filing, it shall draw up a Community search report citing those earlier Community trade marks or Community trade mark applications discovered which may be invoked under Article 8 against the registration of the Community trade mark applied for.

Where, at the time of filing a Community trade mark application, the applicant requests that a search report also be prepared by the central industrial property offices of the Member States and where the appropriate search fee has been paid within the time limit for the payment of the filing fee, the Office shall, as soon as a Community trade mark application has been accorded a date of filing, transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks in respect of Community trade mark applications.

Each of the central industrial property offices referred to in paragraph 2 shall communicate to the Office within two months as from the date on which it received the Community trade mark application a search report which shall either cite those earlier national trade marks or trade mark applications discovered which may be invoked under Article 8 against the registration of the Community trade mark applied for, or state that the search has revealed no such rights.

The search reports referred to in paragraph 3 shall be prepared on a standard form drawn up by the Office, after consulting the Administrative Board provided for in Article 126(1), hereinafter referred to as "the Administrative Board". The essential contents of this form shall be set out in the Implementing Regulation.

An amount shall be paid by the Office to each central industrial property office for each search report provided by that office in accordance with paragraph 3. The amount, which shall be the same for each office, shall be fixed by the Budget Committee by means of a decision adopted by a majority of three-quarters of the representatives of the Member States.

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

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

### SECTION 3

Publication of the application

Article 39

Publication of the application

If the conditions which the application for a Community trade mark must satisfy have been fulfilled and if the period referred to in Article 38(7) has expired, the application shall be published to the extent that it has not been refused pursuant to Article 37.

Where, after publication, the application is refused under Article 37, the decision that it has been refused shall be published upon becoming final.

### SECTION 4

Observations by third parties and opposition

Article 40

Observations by third parties

Following the publication of the Community trade mark application, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds under Article 7, in particular, the trade mark shall not be registered ex officio. They shall not be parties to the proceedings before the Office.

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

Article 41

## Opposition

Within a period of three months following the publication of a Community trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8:

by the proprietors of earlier trade marks referred to in Article 8(2) as well as licensees authorised by the proprietors of those trade marks, in respect of Article 8(1) and (5);

by the proprietors of trade marks referred to in Article 8(3);

by the proprietors of earlier marks or signs referred to in Article 8(4) and by persons authorised under the relevant national law to exercise these rights.

Notice of opposition to registration of the trade mark may also be given, subject to the conditions laid down in paragraph 1, in the event of the publication of an amended application in accordance with the second sentence of Article 43(2).

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

## Article 42

### Examination of opposition

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

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

examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

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

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

The decision refusing the application shall be published upon becoming final.

## SECTION 5

Withdrawal, restriction, amendment and division of the application

### Article 43

Withdrawal, restriction and amendment of the application

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

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

### Article 44

Division of the application

The applicant may divide the application by declaring that some of the goods or services included in the original application will be the subject of one or more divisional applications. The goods or services in the divisional application shall not overlap with the goods or services

which remain in the original application or those which are included in other divisional applications.

The declaration of division shall not be admissible:

if, where an opposition has been entered against the original application, such a divisional application has the effect of introducing a division amongst the goods or services against which the opposition has been directed, until the decision of the Opposition Division has become final or the opposition proceedings are finally terminated otherwise;

during the periods laid down in the Implementing Regulation.

The declaration of division must comply with the provisions set out in the Implementing Regulation.

The declaration of division shall be subject to a fee. The declaration shall be deemed not to have been made until the fee has been paid.

The division shall take effect on the date on which it is recorded in the files kept by the Office concerning the original application.

All requests and applications submitted and all fees paid with regard to the original application prior to the date on which the Office receives the declaration of division are deemed also to have been submitted or paid with regard to the divisional application or applications. The fees for the original application which have been duly paid prior to the date on which the declaration of division is received shall not be refunded.

The divisional application shall preserve the filing date and any priority date and seniority date of the original application.

## SECTION 6

### Registration

#### Article 45

### Registration

Where an application meets the requirements of this Regulation and where no notice of opposition has been given within the period referred to in Article 41(1) or where opposition has been rejected by a definitive decision, the trade mark shall be registered as a Community

trade mark, provided that the registration fee has been paid within the period prescribed. If the fee is not paid within this period the application shall be deemed to be withdrawn.

## TITLE V

### DURATION, RENEWAL, ALTERATION AND DIVISION OF COMMUNITY TRADE MARKS

#### Article 46

##### Duration of registration

Community trade marks shall be registered for a period of 10 years from the date of filing of the application. Registration may be renewed in accordance with Article 47 for further periods of 10 years.

#### Article 47

##### Renewal

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

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

The request for renewal shall be submitted within a period of six months ending on the last day of the month in which protection ends. The fees shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the day referred to in the first sentence, provided that an additional fee is paid within this further period.

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

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

## Article 48

### Alteration

The Community trade mark shall not be altered in the Register during the period of registration or on renewal thereof.

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

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

## Article 49

### Division of the registration

The proprietor of the Community trade mark may divide the registration by declaring that some of the goods or services included in the original registration will be the subject of one or more divisional registrations. The goods or services in the divisional registration shall not overlap with the goods or services which remain in the original registration or those which are included in other divisional registrations.

The declaration of division shall not be admissible:

if, where an application for revocation of rights or for a declaration of invalidity has been entered at the Office against the original registration, such a divisional declaration has the effect of introducing a division amongst the goods or services against which the application for revocation of rights or for a declaration of invalidity is directed, until the decision of the Cancellation Division has become final or the proceedings are finally terminated otherwise;

if, where a counterclaim for revocation or for a declaration of invalidity has been entered in a case before a Community trade mark court, such a divisional declaration has the effect of introducing a division amongst the goods or services against which the counterclaim is directed, until the mention of the Community trade mark court's judgment is recorded in the Register pursuant to Article 100(6).

The declaration of division must comply with the provisions set out in the Implementing Regulation.

The declaration of division shall be subject to a fee. The declaration shall be deemed not to have been made until the fee has been paid.

The division shall take effect on the date on which it is entered in the Register.

All requests and applications submitted and all fees paid with regard to the original registration prior to the date on which the Office receives the declaration of division shall be deemed also to have been submitted or paid with regard to the divisional registration or registrations. The fees for the original registration which have been duly paid prior to the date on which the declaration of division is received shall not be refunded.

The divisional registration shall preserve the filing date and any priority date and seniority date of the original registration.

## TITLE VI

### SURRENDER, REVOCATION AND INVALIDITY

#### SECTION 1

##### Surrender

##### Article 50

##### Surrender

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

The surrender shall be declared to the Office in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register.

Surrender shall be entered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender shall be entered in the Register only if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of the period prescribed by the Implementing Regulation.

#### SECTION 2

##### Grounds for revocation

##### Article 51

## Grounds for revocation

The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:

if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, 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 or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;

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

if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

## SECTION 3

### Grounds for invalidity

#### Article 52

##### Absolute grounds for invalidity

A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

where the Community trade mark has been registered contrary to the provisions of Article 7;

where the applicant was acting in bad faith when he filed the application for the trade mark.

Where the Community trade mark has been registered in breach of the provisions of Article 7(1)(b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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

## Article 53

### Relative grounds for invalidity

A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled;

where there is a trade mark as referred to in Article 8(3) and the conditions set out in that paragraph are fulfilled;

where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled.

A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the Community legislation or national law governing its protection, and in particular:

a right to a name;

a right of personal portrayal;

a copyright;

an industrial property right.

A Community trade mark may not be declared invalid where the proprietor of a right referred to in paragraphs 1 or 2 consents expressly to the registration of the Community trade mark before submission of the application for a declaration of invalidity or the counterclaim.

Where the proprietor of one of the rights referred to in paragraphs 1 or 2 has previously applied for a declaration that a Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the said rights which he could have invoked in support of his first application or counterclaim.

5. Article 52(3) shall apply.

#### Article 54

##### Limitation in consequence of acquiescence

1. Where the proprietor of a Community trade mark has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Community while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.

2. Where the proprietor of an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.

3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later Community trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later Community trade mark.

#### SECTION 4

##### Consequences of revocation and invalidity

#### Article 55

##### Consequences of revocation and invalidity

1. The Community trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

2. The Community trade mark shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that the trade mark has been declared invalid.

3. Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the proprietor of the trade mark, or to unjust enrichment, the retroactive effect of revocation or invalidity of the trade mark shall not affect:

(a) any decision on infringement which has acquired the authority of a final decision and been enforced prior to the revocation or invalidity decision;

(b) any contract concluded prior to the revocation or invalidity decision, in so far as it has been performed before that decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract, may be claimed on grounds of equity.

## SECTION 5

Proceedings in the Office in relation to revocation or invalidity

### Article 56

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 51 and 52 apply, by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, which under the terms of the law governing it has the capacity in its own name to sue and be sued;

(b) where Article 53(1) applies, by the persons referred to in Article 41(1);

(c) where Article 53(2) applies, by the owners of the earlier rights referred to in that provision or by the persons who are entitled under the law of the Member State concerned to exercise the rights in question.

2. The application shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the fee has been paid.

3. An application for revocation or for a declaration of invalidity shall be inadmissible 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 and has acquired the authority of a final decision.

## Article 57

### Examination of the application

1. On the examination of the application for revocation of rights or for a declaration of invalidity, the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.

2. If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 42(2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

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

5. If the examination of the application for revocation of rights or for a declaration of invalidity reveals that the trade mark should not have been registered in respect of some or all of the goods or services for which it is registered, the rights of the proprietor of the Community trade mark shall be revoked or it shall be declared invalid in respect of those goods or services. Otherwise the application for revocation of rights or for a declaration of invalidity shall be rejected.

6. A record of the Office's decision on the application for revocation of rights or for a declaration of invalidity shall be entered in the Register once it has become final.

## TITLE VII

### APPEALS

#### Article 58

##### Decisions subject to appeal

1. An appeal shall lie from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Divisions and Cancellation Divisions. It shall have suspensive effect.

2. A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

#### Article 59

##### Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

#### Article 60

##### Time limit and form of appeal

Notice of appeal must be filed in writing at the Office within two months after the date of notification of the decision appealed from. The notice shall be deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

#### Article 61

##### Revision of decisions in ex parte cases

1. If the party which has lodged the appeal is the sole party to the procedure, and if the department whose decision is contested considers the appeal to be admissible and well founded, the department shall rectify its decision.
2. If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

#### Article 62

##### Revision of decisions in inter partes cases

1. Where the party which has lodged the appeal is opposed by another party and if the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision.
2. The decision may be rectified only if the department whose decision is contested notifies the other party of its intention to rectify it, and that party accepts it within two months of the date on which it received the notification.
3. If, within two months of receiving the notification referred to in paragraph 2, the other party does not accept that the contested decision is to be rectified and makes a declaration to that effect or does not make any declaration within the period laid down, the appeal shall be remitted to the Board of Appeal without delay, and without comment as to its merit.
4. However, if the department whose decision is contested does not consider the appeal to be admissible and well founded within one month after receipt of the statement of grounds, it shall, instead of taking the measures provided for in paragraphs 2 and 3, remit the appeal to the Board of Appeal without delay, and without comment as to its merit.

#### Article 63

## Examination of appeals

1. If the appeal is admissible, the Board of Appeal shall examine whether the appeal is allowable.
2. In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

## Article 64

### Decisions in respect of appeals

1. Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
2. If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same.
3. The decisions of the Boards of Appeal shall take effect only as from the date of expiration of the period referred to in Article 65(5) or, if an action has been brought before the Court of Justice within that period, as from the date of dismissal of such action.

## Article 65

### Actions before the Court of Justice

1. Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.
2. The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.
3. The Court of Justice has jurisdiction to annul or to alter the contested decision.
4. The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision.

5. The action shall be brought before the Court of Justice within two months of the date of notification of the decision of the Board of Appeal.

6. The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.

## TITLE VIII

### COMMUNITY COLLECTIVE MARKS

#### Article 66

##### Community collective marks

1. A Community collective mark shall be a Community trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for Community collective marks.

2. In derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute Community collective marks within the meaning of paragraph 1. A collective mark shall 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.

3. The provisions of this Regulation shall apply to Community collective marks, unless Articles 67 to 74 provide otherwise.

#### Article 67

##### Regulations governing use of the mark

1. An applicant for a Community collective mark must submit regulations governing its use within the period prescribed.

2. The regulations governing use shall specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including sanctions. The regulations governing use of a mark referred to in Article 66(2) must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark.

## Article 68

### Refusal of the application

1. In addition to the grounds for refusal of a Community trade mark application provided for in Articles 36 and 37, an application for a Community collective mark shall be refused where the provisions of Articles 66 or 67 are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

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

3. An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

## Article 69

### Observations by third parties

Apart from the cases mentioned in Article 40, any person, group or body referred to in that Article may submit to the Office written observations based on the particular grounds on which the application for a Community collective mark should be refused under the terms of Article 68.

## Article 70

### Use of marks

Use of a Community collective mark by any person who has authority to use it shall satisfy the requirements of this Regulation, provided that the other conditions which this Regulation imposes with regard to the use of Community trade marks are fulfilled.

## Article 71

### Amendment of the regulations governing use of the mark

1. The proprietor of a Community collective mark must submit to the Office any amended regulations governing use.
2. The amendment shall not be mentioned in the Register if the amended regulations do not satisfy the requirements of Article 67 or involve one of the grounds for refusal referred to in Article 68.
3. Article 69 shall apply to amended regulations governing use.
4. For the purposes of applying this Regulation, amendments to the regulations governing use shall take effect only from the date of entry of the mention of the amendment in the Register.

## Article 72

### Persons who are entitled to bring an action for infringement

1. The provisions of Article 22(3) and (4) concerning the rights of licensees shall apply to every person who has authority to use a Community collective mark.
2. The proprietor of a Community collective mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorised use of the mark.

## Article 73

### Grounds for revocation

Apart from the grounds for revocation provided for in Article 51, the rights of the proprietor of a Community collective mark shall be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings, if:

- (a) the proprietor does not take reasonable steps to prevent the mark being used in a manner incompatible with the conditions of use, where these exist, laid down in the regulations governing use, amendments to which have, where appropriate, been mentioned in the Register;
- (b) the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 68(2);
- (c) an amendment to the regulations governing use of the mark has been mentioned in the Register in breach of the provisions of Article 71(2), unless the proprietor of the mark, by

further amending the regulations governing use, complies with the requirements of those provisions.

#### Article 74

##### Grounds for invalidity

Apart from the grounds for invalidity provided for in Articles 52 and 53, a Community collective mark which is registered in breach of the provisions of Article 68 shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings, unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of those provisions.

### TITLE IX

#### PROCEDURE

##### SECTION 1

##### General provisions

#### Article 75

##### Statement of reasons on which decisions are based

Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

#### Article 76

##### Examination of the facts by the Office of its own motion

1. In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

#### Article 77

##### Oral proceedings

1. If the Office considers that oral proceedings would be expedient they shall be held either at the instance of the Office or at the request of any party to the proceedings.
2. Oral proceedings before the examiners, the Opposition Division and the Administration of Trade Marks and Legal Division shall not be public.
3. Oral proceedings, including delivery of the decision, shall be public before the Cancellation Division and the Boards of Appeal, in so far as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

## Article 78

### 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) the production of documents and items of evidence;
  - (d) hearing witnesses;
  - (e) opinions by experts;
  - (f) statements in writing sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.
2. The relevant department may commission one of its members to examine the evidence adduced.
3. If the Office considers it necessary for a party, witness or expert to give evidence orally, it shall issue a summons to the person concerned to appear before it.
4. The parties shall be informed of the hearing of a witness or expert before the Office. They shall have the right to be present and to put questions to the witness or expert.

## Article 79

### Notification

The Office shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of the Implementing Regulation, or of which notification has been ordered by the President of the Office.

## Article 80

### Revocation of decisions

1. Where the Office has made an entry in the Register or taken a decision which contains an obvious procedural error attributable to the Office, it shall ensure that the entry is cancelled or the decision is revoked. Where there is only one party to the proceedings and the entry or the act affects its rights, cancellation or revocation shall be determined even if the error was not evident to the party.
2. Cancellation or revocation as referred to in paragraph 1 shall be determined, ex officio or at the request of one of the parties to the proceedings, by the department which made the entry or took the decision. Cancellation or revocation shall be determined within six months from the date on which the entry was made in the Register or the decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the Community trade mark in question that are entered in the Register.
3. This Article shall be without prejudice to the right of the parties to submit an appeal under Articles 58 and 65, or to the possibility, under the procedures and conditions laid down by the Implementing Regulation, of correcting any linguistic errors or errors of transcription and obvious errors in the Office's decisions or errors attributable to the Office in registering the trade mark or in publishing its registration.

## Article 81

### Restitutio in integrum

1. The applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to comply with a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the obstacle to compliance has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any right or means of redress.

2. The application must be filed in writing within two months from the removal of the obstacle to compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided in Article 47(3), third sentence, shall be deducted from the period of one year.
3. The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until the fee for re-establishment of rights has been paid.
4. The department competent to decide on the omitted act shall decide upon the application.
5. This Article shall not be applicable to the time limits referred to in paragraph 2 of this Article, Article 41(1) and (3) and Article 82.
6. Where the applicant for or proprietor of a Community trade mark has his rights re-established, he may not invoke his rights vis-à-vis a third party who, in good faith, has put goods on the market or supplied services under a sign which is identical with, or similar to, the Community trade mark in the course of the period between the loss of rights in the application or in the Community trade mark and publication of the mention of re-establishment of those rights.
7. A third party who may avail himself of the provisions of paragraph 6 may bring third party proceedings against the decision re-establishing the rights of the applicant for or proprietor of a Community trade mark within a period of two months as from the date of publication of the mention of re-establishment of those rights.
8. Nothing in this Article shall limit the right of a Member State to grant *restitutio in integrum* in respect of time limits provided for in this Regulation and to be observed vis-à-vis the authorities of such State.

## Article 82

### Continuation of proceedings

1. An applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who has omitted to observe a time limit vis-à-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made

the omitted act has been carried out. The request for continuation of proceedings shall be admissible only if it is presented within two months following the expiry of the unobserved time limit. The request shall not be deemed to have been filed until the fee for continuation of the proceedings has been paid.

2. This Article shall not be applicable to the time limits laid down in Article 25(3), Article 27, Article 29(1), Article 33(1), Article 36(2), Article 41, Article 42, Article 47(3), Article 60, Article 62, Article 65(5), Article 81, Article 112, or to the time limits laid down in this Article or the time limits laid down by the Implementing Regulation for claiming, after the application has been filed, priority within the meaning of Article 30, exhibition priority within the meaning of Article 33 or seniority within the meaning of Article 34.

3. The department competent to decide on the omitted act shall decide upon the application.

4. If the Office accepts the application, the consequences of having failed to observe the time limit shall be deemed not to have occurred.

5. If the Office rejects the application, the fee shall be refunded.

## Article 83

### Reference to general principles

In the absence of procedural provisions in this Regulation, the Implementing Regulation, the fees regulations or the rules of procedure of the Boards of Appeal, the Office shall take into account the principles of procedural law generally recognised in the Member States.

## Article 84

### Termination of financial obligations

1. Rights of the Office to the payment of a fee shall be extinguished after four years from the end of the calendar year in which the fee fell due.

2. Rights against the Office for the refunding of fees or sums of money paid in excess of a fee shall be extinguished after four years from the end of the calendar year in which the right arose.

3. The period laid down in paragraphs 1 and 2 shall be interrupted, in the case covered by paragraph 1, by a request for payment of the fee, and in the case covered by paragraph 2, by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at

the latest six years after the end of the year in which it originally began, unless, in the meantime, judicial proceedings to enforce the right have begun; in this case the period shall end at the earliest one year after the judgment has acquired the authority of a final decision.

## SECTION 2

### Costs

#### Article 85

### Costs

1. The losing party in opposition proceedings, proceedings for revocation, proceedings for a declaration of invalidity or appeal proceedings shall bear the fees incurred by the other party as well as all costs, without prejudice to Article 119(6), incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of the scales set for each category of costs under the conditions laid down in the Implementing Regulation.
2. However, where each party succeeds on some and fails on other heads, or if reasons of equity so dictate, the Opposition Division, Cancellation Division or Board of Appeal shall decide a different apportionment of costs.
3. The party who terminates the proceedings by withdrawing the Community trade mark application, the opposition, the application for revocation of rights, the application for a declaration of invalidity or the appeal, or by not renewing registration of the Community trade mark or by surrendering the Community trade mark, shall bear the fees and the costs incurred by the other party as stipulated in paragraphs 1 and 2.
4. Where a case does not proceed to judgment the costs shall be at the discretion of the Opposition Division, Cancellation Division or Board of Appeal.
5. Where the parties conclude before the Opposition Division, Cancellation Division or Board of Appeal a settlement of costs differing from that provided for in the preceding paragraphs, the department concerned shall take note of that agreement.
6. The Opposition Division or Cancellation Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs when the costs to be paid are limited to the fees paid to the Office and the representation costs. In all other cases, the registry of the Board of Appeal or a member of the staff of the Opposition Division or

Cancellation Division shall fix the amount of the costs to be reimbursed on request. The request is admissible only within two months of the date on which the decision for which an application was made for the costs to be fixed became final. The amount so determined may be reviewed by a decision of the Opposition Division or Cancellation Division or Board of Appeal on a request filed within the prescribed period.

## Article 86

### Enforcement of decisions fixing the amount of costs

1. Any final decision of the Office fixing the amount of costs shall be enforceable.
2. Enforcement shall be governed by the rules of civil procedure in force in the State in the territory of which it is carried out. The order for its enforcement shall be appended to the decision, without other formality than verification of the authenticity of the decision, by the national authority which the Government of each Member State shall designate for this purpose and shall make known to the Office and to the Court of Justice.
3. When these formalities have been completed on application by the party concerned, the latter may proceed to enforcement in accordance with the national law, by bringing the matter directly before the competent authority.
4. Enforcement may be suspended only by a decision of the Court of Justice. However, the courts of the country concerned shall have jurisdiction over complaints that enforcement is being carried out in an irregular manner.

## SECTION 3

Information which may be made available to the public and of the authorities of the Member States

## Article 87

### Register of Community trade marks

The Office shall keep a register to be known as the Register of Community trade marks, which shall contain those particulars the registration or inclusion of which is provided for by this Regulation or by the Implementing Regulation. The Register shall be open to public inspection.

## Article 88

## Inspection of files

1. The files relating to Community trade mark applications which have not yet been published shall not be made available for inspection without the consent of the applicant.
2. Any person who can prove that the applicant for a Community trade mark has stated that after the trade mark has been registered he will invoke the rights under it against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.
3. Subsequent to the publication of the Community trade mark application, the files relating to such application and the resulting trade mark may be inspected on request.
4. However, where the files are inspected pursuant to paragraphs 2 or 3, certain documents in the file may be withheld from inspection in accordance with the provisions of the Implementing Regulation.

## Article 89

### Periodical publications

The Office shall periodically publish:

- (a) a Community Trade Marks Bulletin containing entries made in the Register of Community trade marks as well as other particulars the publication of which is prescribed by this Regulation or by the Implementing Regulation;
- (b) an Official Journal containing notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation.

## Article 90

### Administrative cooperation

Unless otherwise provided in this Regulation or in national laws, the Office and the courts or authorities of the Member States shall on request give assistance to each other by communicating information or opening files for inspection. Where the Office lays files open to inspection by courts, Public Prosecutors' Offices or central industrial property offices, the inspection shall not be subject to the restrictions laid down in Article 88.

## Article 91

## Exchange of publications

1. The Office and the central industrial property offices of the Member States shall despatch to each other on request and for their own use one or more copies of their respective publications free of charge.
2. The Office may conclude agreements relating to the exchange or supply of publications.

## SECTION 4

### Representation

#### Article 92

##### General principles of representation

1. Subject to the provisions of paragraph 2, no person shall be compelled to be represented before the Office.
2. Without prejudice to paragraph 3, second sentence, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 93(1) in all proceedings established by this Regulation, other than in filing an application for a Community trade mark; the Implementing Regulation may permit other exceptions.
3. Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee. An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community.
4. The Implementing Regulation shall specify whether and under what conditions an employee must file with the Office a signed authorisation for insertion on the file.

#### Article 93

##### Professional representatives

1. Representation of natural or legal persons before the Office may only be undertaken by:

(a) any legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in trade mark matters;

(b) professional representatives whose names appear on the list maintained for this purpose by the Office. The Implementing Regulation shall specify whether and under what conditions the representatives before the Office must file with the Office a signed authorisation for insertion on the file.

Representatives acting before the Office must file with it a signed authorisation for insertion on the files, the details of which are set out in the Implementing Regulation.

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) he must have his place of business or employment in the Community;

(c) he must be entitled to represent natural or legal persons in trade mark matters before the central industrial property office of a Member State. Where, in that State, the entitlement is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act in trade mark matters before the central industrial property office of the said State must have habitually so acted for at least five years. However, persons whose professional qualification to represent natural or legal persons in trade mark matters before the central industrial property office of one of the Member States is officially recognised in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession.

3. Entry shall be effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions laid down in paragraph 2 are fulfilled.

4. The President of the Office may grant exemption from:

(a) the requirement of paragraph 2(c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way;

(b) the requirement of paragraph 2(a) in special circumstances.

5. The conditions under which a person may be removed from the list of professional representatives shall be laid down in the Implementing Regulation.

## TITLE X

### JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO COMMUNITY TRADE MARKS

#### SECTION 1

Application of Regulation (EC) No 44/2001

##### Article 94

Application of Regulation (EC) No 44/2001

1. Unless otherwise specified in this Regulation, Regulation (EC) No 44/2001 shall apply to proceedings relating to Community trade marks and applications for Community trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of Community trade marks and national trade marks.

2. In the case of proceedings in respect of the actions and claims referred to in Article 96:

(a) Articles 2 and 4, points 1, 3, 4 and 5 of Article 5 and Article 31 of Regulation (EC) No 44/2001 shall not apply;

(b) Articles 23 and 24 of Regulation (EC) No 44/2001 shall apply subject to the limitations in Article 97(4) of this Regulation;

(c) the provisions of Chapter II of Regulation (EC) No 44/2001 which are applicable to persons domiciled in a Member State shall also be applicable to persons who do not have a domicile in any Member State but have an establishment therein.

#### SECTION 2

Disputes concerning the infringement and validity of Community trade marks

##### Article 95

Community trade mark courts

1. The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as

"Community trade mark courts", which shall perform the functions assigned to them by this Regulation.

2. Each Member State shall communicate to the Commission within three years of the entry into force of Regulation (EC) No 40/94 a list of Community trade mark courts indicating their names and their territorial jurisdiction.

3. Any change made after communication of the list referred to in paragraph 2 in the number, names or territorial jurisdiction of the courts shall be notified without delay by the Member State concerned to the Commission.

4. The information referred to in paragraphs 2 and 3 shall be notified by the Commission to the Member States and published in the Official Journal of the European Union.

5. As long as a Member State has not communicated the list as stipulated in paragraph 2, jurisdiction for any proceedings resulting from an action or application covered by Article 96, and for which the courts of that State have jurisdiction under Article 97, shall lie with that court of the State in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national trade mark registered in that State.

## Article 96

### Jurisdiction over infringement and validity

The Community trade mark courts shall have exclusive jurisdiction:

- (a) for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to Community trade marks;
- (b) for actions for declaration of non-infringement, if they are permitted under national law;
- (c) for all actions brought as a result of acts referred to in Article 9(3), second sentence;
- (d) for counterclaims for revocation or for a declaration of invalidity of the Community trade mark pursuant to Article 100.

## Article 97

### International jurisdiction

1. Subject to the provisions of this Regulation as well as to any provisions of Regulation (EC) No 44/2001 applicable by virtue of Article 94, proceedings in respect of the actions and claims referred to in Article 96 shall be brought in the courts of the Member State in which

the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

2. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

3. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

4. Notwithstanding the provisions of paragraphs 1, 2 and 3:

(a) Article 23 of Regulation (EC) No 44/2001 shall apply if the parties agree that a different Community trade mark court shall have jurisdiction;

(b) Article 24 of Regulation (EC) No 44/2001 shall apply if the defendant enters an appearance before a different Community trade mark court.

5. Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9(3), second sentence, has been committed.

## Article 98

### Extent of jurisdiction

1. A Community trade mark court whose jurisdiction is based on Article 97(1) to (4) shall have jurisdiction in respect of:

(a) acts of infringement committed or threatened within the territory of any of the Member States;

(b) acts within the meaning of Article 9(3), second sentence, committed within the territory of any of the Member States.

2. A Community trade mark court whose jurisdiction is based on Article 97(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

## Article 99

### Presumption of validity — Defence as to the merits

1. The Community trade mark courts shall treat the Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity.
2. The validity of a Community trade mark may not be put in issue in an action for a declaration of non-infringement.
3. In the actions referred to in Article 96(a) and (c) a plea relating to revocation or invalidity of the Community trade mark submitted otherwise than by way of a counterclaim shall be admissible in so far as the defendant claims that the rights of the proprietor of the Community trade mark could be revoked for lack of use or that the Community trade mark could be declared invalid on account of an earlier right of the defendant.

## Article 100

### Counterclaims

1. A counterclaim for revocation or for a declaration of invalidity may only be based on the grounds for revocation or invalidity mentioned in this Regulation.
2. A Community trade mark court shall reject a counterclaim for revocation or for a declaration of invalidity if a decision taken by the Office relating to the same subject matter and cause of action and involving the same parties has already become final.
3. If the counterclaim is brought in a legal action to which the proprietor of the trade mark is not already a party, he shall be informed thereof and may be joined as a party to the action in accordance with the conditions set out in national law.
4. The Community trade mark court with which a counterclaim for revocation or for a declaration of invalidity of the Community trade mark has been filed shall inform the Office of the date on which the counterclaim was filed. The latter shall record this fact in the Register of Community trade marks.
5. Article 57(2) to (5) shall apply.
6. Where a Community trade mark court has given a judgment which has become final on a counterclaim for revocation or for invalidity of a Community trade mark, a copy of the

judgment shall be sent to the Office. Any party may request information about such transmission. The Office shall mention the judgment in the Register of Community trade marks in accordance with the provisions of the Implementing Regulation.

7. The Community trade mark court hearing a counterclaim for revocation or for a declaration of invalidity may stay the proceedings on application by the proprietor of the Community trade mark and after hearing the other parties and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office within a time limit which it shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 104(3) shall apply.

## Article 101

### Applicable law

1. The Community trade mark courts shall apply the provisions of this Regulation.
2. On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.
3. Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located.

## Article 102

### Sanctions

1. Where a Community trade mark court finds that the defendant has infringed or threatened to infringe a Community trade mark, it shall, unless there are special reasons for not doing so, issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark. It shall also take such measures in accordance with its national law as are aimed at ensuring that this prohibition is complied with.
2. In all other respects the Community trade mark court shall apply the law of the Member State in which the acts of infringement or threatened infringement were committed, including the private international law.

## Article 103

### Provisional and protective measures

1. Application may be made to the courts of a Member State, including Community trade mark courts, for such provisional, including protective, measures in respect of a Community trade mark or Community trade mark application as may be available under the law of that State in respect of a national trade mark, even if, under this Regulation, a Community trade mark court of another Member State has jurisdiction as to the substance of the matter.

2. A Community trade mark court whose jurisdiction is based on Article 97(1), (2), (3) or (4) shall have jurisdiction to grant provisional and protective measures which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of Regulation (EC) No 44/2001, are applicable in the territory of any Member State. No other court shall have such jurisdiction.

#### Article 104

##### Specific rules on related actions

1. A Community trade mark court hearing an action referred to in Article 96, other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue before another Community trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office.

2. The Office, when hearing an application for revocation or for a declaration of invalidity shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue on account of a counterclaim before a Community trade mark court. However, if one of the parties to the proceedings before the Community trade mark court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

3. Where the Community trade mark court stays the proceedings it may order provisional and protective measures for the duration of the stay.

#### Article 105

##### Jurisdiction of Community trade mark courts of second instance — Further appeal

1. An appeal to the Community trade mark courts of second instance shall lie from judgments of the Community trade mark courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 96.

2. The conditions under which an appeal may be lodged with a Community trade mark court of second instance shall be determined by the national law of the Member State in which that court is located.

3. The national rules concerning further appeal shall be applicable in respect of judgments of Community trade mark courts of second instance.

### SECTION 3

#### Other disputes concerning Community trade marks

##### Article 106

#### Supplementary provisions on the jurisdiction of national courts other than Community trade mark courts

1. Within the Member State whose courts have jurisdiction under Article 94(1) those courts shall have jurisdiction for actions other than those referred to in Article 96, which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to a national trade mark registered in that State.

2. Actions relating to a Community trade mark, other than those referred to in Article 96, for which no court has jurisdiction under Article 94(1) and paragraph 1 of this Article may be heard before the courts of the Member State in which the Office has its seat.

##### Article 107

#### Obligation of the national court

A national court which is dealing with an action relating to a Community trade mark, other than the action referred to in Article 96, shall treat the trade mark as valid.

### SECTION 4

#### Transitional provision

##### Article 108

Transitional provision relating to the application of the Convention on Jurisdiction and Enforcement

The provisions of Regulation (EC) No 44/2001 which are rendered applicable by the preceding Articles shall have effect in respect of any Member State solely in the text of the Regulation which is in force in respect of that State at any given time.

## TITLE XI

### EFFECTS ON THE LAWS OF THE MEMBER STATES

#### SECTION 1

Civil actions on the basis of more than one trade mark

##### Article 109

Simultaneous and successive civil actions on the basis of Community trade marks and national trade marks

1. Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of a Community trade mark and the other seized on the basis of a national trade mark:

(a) the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested;

(b) the court other than the court first seized may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.

2. The court hearing an action for infringement on the basis of a Community trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical national trade mark valid for identical goods or services.

3. The court hearing an action for infringement on the basis of a national trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action

and between the same parties on the basis of an identical Community trade mark valid for identical goods or services.

4. Paragraphs 1, 2 and 3 shall not apply in respect of provisional, including protective, measures.

## SECTION 2

Application of national laws for the purpose of prohibiting the use of Community trade marks

### Article 110

Prohibition of use of Community trade marks

1. This Regulation shall, unless otherwise provided for, not affect the right existing under the laws of the Member States to invoke claims for infringement of earlier rights within the meaning of Article 8 or Article 53(2) in relation to the use of a later Community trade mark. Claims for infringement of earlier rights within the meaning of Article 8(2) and (4) may, however, no longer be invoked if the proprietor of the earlier right may no longer apply for a declaration that the Community trade mark is invalid in accordance with Article 54(2).

2. This Regulation shall, unless otherwise provided for, not affect the right to bring proceedings under the civil, administrative or criminal law of a Member State or under provisions of Community law for the purpose of prohibiting the use of a Community trade mark to the extent that the use of a national trade mark may be prohibited under the law of that Member State or under Community law.

### Article 111

Prior rights applicable to particular localities

1. The proprietor of an earlier right which only applies to a particular locality may oppose the use of the Community trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.

2. Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the Community trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless 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 though that right may no longer be invoked against the Community trade mark.

## SECTION 3

Conversion into a national trade mark application

Article 112

Request for the application of national procedure

1. The applicant for or proprietor of a Community trade mark may request the conversion of his Community trade mark application or Community trade mark into a national trade mark application:

(a) to the extent that the Community trade mark application is refused, withdrawn, or deemed to be withdrawn;

(b) to the extent that the Community trade mark ceases to have effect.

2. Conversion shall not take place:

(a) where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;

(b) for the purpose of protection in a Member State in which, in accordance with the decision of the Office or of the national court, grounds for refusal of registration or grounds for revocation or invalidity apply to the Community trade mark application or Community trade mark.

3. The national trade mark application resulting from the conversion of a Community trade mark application or a Community trade mark shall enjoy in respect of the Member State concerned the date of filing or the date of priority of that application or trade mark and, where appropriate, the seniority of a trade mark of that State claimed under Articles 34 or 35.

4. In cases where a Community trade mark application is deemed to be withdrawn, the Office shall send to the applicant a communication fixing a period of three months from the date of that communication in which a request for conversion may be filed.

5. Where the Community trade mark application is withdrawn or the Community trade mark ceases to have effect as a result of a surrender being recorded or of failure to renew the registration, the request for conversion shall be filed within three months after the date on which the Community trade mark application has been withdrawn or on which the Community trade mark ceases to have effect.

6. Where the Community trade mark application is refused by decision of the Office or where the Community trade mark ceases to have effect as a result of a decision of the Office or of a Community trade mark court, the request for conversion shall be filed within three months after the date on which that decision acquired the authority of a final decision.

7. The effect referred to in Article 32 shall lapse if the request is not filed in due time.

#### Article 113

##### Submission, publication and transmission of the request for conversion

1. A request for conversion shall be filed with the Office and shall specify the Member States in which application of the procedure for registration of a national trade mark is desired. The request shall not be deemed to be filed until the conversion fee has been paid.

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

3. The Office shall check whether the conversion requested fulfils the conditions set out in this Regulation, in particular Article 112(1), (2), (4), (5) and (6), and paragraph 1 of this Article, together with the formal conditions laid down in the Implementing Regulation. If these conditions are fulfilled, the Office shall transmit the request for conversion to the industrial property offices of the Member States specified therein.

#### Article 114

##### Formal requirements for conversion

1. Any central industrial property office to which the request for conversion is transmitted may obtain from the Office any additional information concerning the request enabling that office to make a decision regarding the national trade mark resulting from the conversion.

2. A Community trade mark application or a Community trade mark transmitted in accordance with Article 113 shall not be subjected to formal requirements of national law

which are different from or additional to those provided for in this Regulation or in the Implementing Regulation.

3. Any central industrial property office to which the request is transmitted may require that the applicant shall, within not less than two months:

(a) pay the national application fee;

(b) file a translation in one of the official languages of the State in question of the request and of the documents accompanying it;

(c) indicate an address for service in the State in question;

(d) supply a representation of the trade mark in the number of copies specified by the State in question.

## TITLE XII

### THE OFFICE

#### SECTION 1

##### General provisions

##### Article 115

##### Legal status

1. The Office shall be a body of the Community. It shall have legal personality.

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.

3. The Office shall be represented by its President.

##### Article 116

##### Staff

1. The Staff Regulations of officials of the European Communities, hereinafter referred to as "the Staff Regulations", the Conditions of Employment of other servants of the European Communities, and the rules adopted by agreement between the Institutions of the European Communities for giving effect to those Staff Regulations and Conditions of Employment shall

apply to the staff of the Office, without prejudice to the application of Article 136 to the members of the Boards of Appeal.

2. Without prejudice to Article 125, 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 respect of its staff.

#### Article 117

##### Privileges and immunities

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

#### Article 118

##### Liability

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

2. The Court of Justice shall be competent to give judgment pursuant to any arbitration clause contained in a contract concluded by the Office.

3. In the case of 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 by its servants in the performance of their duties.

4. The Court of Justice shall have jurisdiction in disputes relating to compensation for the damage referred to in paragraph 3.

5. The personal liability of its servants towards the Office shall be governed by the provisions laid down in their Staff Regulations or in the Conditions of Employment applicable to them.

#### Article 119

##### Languages

1. The application for a Community trade mark shall be filed in one of the official languages of the European Community.

2. The languages of the Office shall be English, French, German, Italian and Spanish.

3. The applicant must indicate a second language which shall be a language of the Office the use of which he accepts as a possible language of proceedings for opposition, revocation or invalidity proceedings.

If the application was filed in a language which is not one of the languages of the Office, the Office shall arrange to have the application, as described in Article 26(1), translated into the language indicated by the applicant.

4. Where the applicant for a Community trade mark is the sole party to proceedings before the Office, the language of proceedings shall be the language used for filing the application for a Community trade mark. If the application was made in a language other than the languages of the Office, the Office may send written communications to the applicant in the second language indicated by the applicant in his application.

5. The notice of opposition and an application for revocation or invalidity shall be filed in one of the languages of the Office.

6. If the language chosen, in accordance with paragraph 5, for the notice of opposition or the application for revocation or invalidity is the language of the application for a trade mark or the second language indicated when the application was filed, that language shall be the language of the proceedings.

If the language chosen, in accordance with paragraph 5, for the notice of opposition or the application for revocation or invalidity is neither the language of the application for a trade mark nor the second language indicated when the application was filed, the opposing party or the party seeking revocation or invalidity shall be required to produce, at his own expense, a translation of his application either into the language of the application for a trade mark, provided that it is a language of the Office, or into the second language indicated when the application was filed. The translation shall be produced within the period prescribed in the Implementing Regulation. The language into which the application has been translated shall then become the language of the proceedings.

7. Parties to opposition, revocation, invalidity or appeal proceedings may agree that a different official language of the European Community is to be the language of the proceedings.

Article 120

Publication and entries in the Register

1. An application for a Community trade mark, as described in Article 26(1), and all other information the publication of which is prescribed by this Regulation or the Implementing Regulation, shall be published in all the official languages of the European Community.
2. All entries in the Register of Community trade marks shall be made in all the official languages of the European Community.
3. In cases of doubt, the text in the language of the Office in which the application for the Community trade mark was filed shall be authentic. If the application was filed in an official language of the European Community other than one of the languages of the Office, the text in the second language indicated by the applicant shall be authentic.

#### Article 121

The translation services required for the functioning of the Office shall be provided by the Translation Centre for the Bodies of the European Union.

#### Article 122

##### Control of legality

1. The Commission shall check the legality of those acts of the President of the Office in respect of which Community law does not provide for any check on legality by another body and of acts of the Budget Committee attached to the Office pursuant to Article 138.
2. It shall require that any unlawful acts as referred to in paragraph 1 be altered or annulled.
3. Member States and any person directly and individually concerned may refer to the Commission any act as referred to in paragraph 1, whether express or implied, for the Commission to examine the legality of that act. Referral shall be made to the Commission within one month of the day on which the party concerned first became aware of the act in question. The Commission shall take a decision within three months. If no decision has been taken within this period, the case shall be deemed to have been dismissed.

#### Article 123

##### Access to documents

1. Regulation (EC) No 1049/2001 of the European Parliament and of the Council of 30 May 2001 regarding public access to European Parliament, Council and Commission documents [9] shall apply to documents held by the Office.

2. The Administrative Board shall adopt the practical arrangements for Implementing Regulation (EC) No 1049/2001 with regard to this Regulation.

3. Decisions taken by the Office pursuant to Article 8 of Regulation (EC) No 1049/2001 may give rise to the lodging of a complaint to the Ombudsman or form the subject of an action before the Court of Justice, under the conditions laid down in Articles 195 and 230 of the Treaty respectively.

## SECTION 2

### Management of the Office

#### Article 124

##### Powers of the President

1. The Office shall be managed by the President.

2. To this end the President shall have in particular 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 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 and any other rules applying to Community trade marks after consulting the Administrative Board and, in the case of the fees regulations and the budgetary provisions of this Regulation, the Budget Committee;

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

(d) he shall submit a management report to the Commission, the European Parliament and the Administrative Board each year;

(e) he shall exercise in respect of the staff the powers laid down in Article 116(2);

(f) he may delegate his powers.

3. The President shall be assisted by one or more Vice-Presidents. If the President is absent or indisposed, the Vice-President or one of the Vice-Presidents shall take his place in accordance with the procedure laid down by the Administrative Board.

## Article 125

### Appointment of senior officials

1. The President of the Office shall be appointed by the Council from a list of at most three candidates, which shall be prepared by the Administrative Board. Power to dismiss the President shall lie with the Council, acting on a proposal from the Administrative Board.
2. The term of office of the President shall not exceed five years. This term of office shall be renewable.
3. The Vice-President or Vice-Presidents of the Office shall be appointed or dismissed as in paragraph 1, after consultation of the President.
4. The Council shall exercise disciplinary authority over the officials referred to in paragraphs 1 and 3.

## SECTION 3

### Administrative Board

## Article 126

### Creation and powers

1. An Administrative Board is hereby set up, attached to the Office. Without prejudice to the powers attributed to the Budget Committee in Section 5 — budget and financial control — the Administrative Board shall have the powers defined below.
2. The Administrative Board shall draw up the lists of candidates provided for in Article 125.
3. It shall advise the President on matters for which the Office is responsible.
4. It shall be consulted before adoption of the guidelines for examination in the Office and in the other cases provided for in this Regulation.
5. It may deliver opinions and requests for information to the President and to the Commission where it considers that this is necessary.

## Article 127

### Composition

1. The Administrative Board shall be composed of one representative of each Member State and one representative of the Commission and their alternates.
2. The members of the Administrative Board may, subject to the provisions of its rules of procedure, be assisted by advisers or experts.

#### Article 128

##### Chairmanship

1. The Administrative Board shall elect a chairman and a deputy chairman from among its members. The deputy chairman shall ex officio replace the chairman in the event of his being prevented from attending to his duties.
2. The duration of the terms of office of the chairman and the deputy chairman shall be three years. The terms of office shall be renewable.

#### Article 129

##### Meetings

1. Meetings of the Administrative Board shall be convened by its chairman.
2. The President of the Office shall take part in the deliberations, unless the Administrative Board decides otherwise.
3. The Administrative Board shall hold an ordinary meeting once a year; in addition, it shall meet on the initiative of its chairman or at the request of the Commission or of one-third of the Member States.
4. The Administrative Board shall adopt rules of procedure.
5. The Administrative Board shall take its decisions by a simple majority of the representatives of the Member States. However, a majority of three-quarters of the representatives of the Member States shall be required for the decisions which the Administrative Board is empowered to take under Article 125(1) and (3). In both cases each Member State shall have one vote.
6. The Administrative Board may invite observers to attend its meetings.
7. The Secretariat for the Administrative Board shall be provided by the Office.

#### SECTION 4

## Implementation of procedures

### Article 130

#### Competence

For taking decisions in connection with the procedures laid down in this Regulation, the following shall be competent:

- (a) examiners;
- (b) Opposition Divisions;
- (c) an Administration of Trade Marks and Legal Division;
- (d) Cancellation Divisions;
- (e) Boards of Appeal.

### Article 131

#### Examiners

An examiner shall be responsible for taking decisions on behalf of the Office in relation to an application for registration of a Community trade mark, including the matters referred to in Articles 36, 37 and 68, except in so far as an Opposition Division is responsible.

### Article 132

#### Opposition Divisions

1. An Opposition Division shall be responsible for taking decisions on an opposition to an application to register a Community trade mark.
2. The decisions of the Opposition Divisions shall be taken by three-member groups. At least one member shall be legally qualified. In certain specific cases provided for in the Implementing Regulation, the decisions shall be taken by a single member.

### Article 133

#### Administration of Trade Marks and Legal Division

1. The Administration of Trade Marks and Legal Division shall be responsible for those decisions required by this Regulation which do not fall within the competence of an examiner,

an Opposition Division or a Cancellation Division. It shall in particular be responsible for decisions in respect of entries in the Register of Community trade marks.

2. It shall also be responsible for keeping the list of professional representatives which is referred to in Article 93.

3. A decision of the Division shall be taken by one member.

#### Article 134

##### Cancellation Divisions

1. A Cancellation Division shall be responsible for taking decisions in relation to an application for the revocation or declaration of invalidity of a Community trade mark.

2. The decisions of the Cancellation Divisions shall be taken by three-member groups. At least one member shall be legally qualified. In certain specific cases provided for in the Implementing Regulation, the decisions shall be taken by a single member.

#### Article 135

##### Boards of Appeal

1. The Boards of Appeal shall be responsible for deciding on appeals from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Division and Cancellation Divisions.

2. The decisions of the Boards of Appeal shall be taken by three members, at least two of whom are legally qualified. In certain specific cases, decisions shall be taken by an enlarged Board chaired by the President of the Boards of Appeal or by a single member, who must be legally qualified.

3. In order to determine the special cases which fall under the jurisdiction of the enlarged Board, account should be taken of the legal difficulty or the importance of the case or of special circumstances which justify it. Such cases may be referred to the enlarged Board:

(a) by the authority of the Boards of Appeal set up in accordance with the rules of procedure of the Boards referred to in Article 162(3); or

(b) by the Board handling the case.

4. The composition of the enlarged Board and the rules on referrals to it shall be laid down pursuant to the rules of procedure of the Boards referred to in Article 162(3).

5. To determine which specific cases fall under the authority of a single member, account should be taken of the lack of difficulty of the legal or factual matters raised, the limited importance of the individual case or the absence of other specific circumstances. The decision to confer a case on one member in the cases referred to shall be adopted by the Board handling the case. Further details shall be laid down in the rules of procedure of the Boards referred to in Article 162(3).

#### Article 136

##### Independence of the members of the Boards of Appeal

1. The President of the Boards of Appeal and the chairmen of the Boards shall be appointed, in accordance with the procedure laid down in Article 125 for the appointment of the President of the Office, for a term of five years. They may not be removed from office during this term, unless there are serious grounds for such removal and the Court of Justice, on application by the institution which appointed them, takes a decision to this effect. The term of office of the President of the Boards of Appeal and the chairmen of the Boards may be renewed for additional five-year periods, or until retirement age if this age is reached during the new term of office.

The President of the Boards of Appeal shall, inter alia, have managerial and organisational powers, principally to:

- (a) chair the authority of the Boards of Appeal responsible for laying down the rules and organising the work of the Boards, which authority is provided for in the rules of procedure of the Boards referred to in Article 162(3);
- (b) ensure the implementation of the authority's decisions;
- (c) allocate cases to a Board on the basis of objective criteria determined by the authority of the Boards of Appeal;
- (d) forward to the President of the Office the Boards' expenditure requirements, with a view to drawing up the expenditure estimates.

The President of the Boards of Appeal shall chair the enlarged Board.

Further details shall be laid down in the rules of procedure of the Boards referred to in Article 162(3).

2. The members of the Boards of Appeal shall be appointed by the Administrative Board for a term of five years. Their term of office may be renewed for additional five-year periods, or until retirement age if that age is reached during the new term of office.
3. The members of the Boards of Appeal may not be removed from office unless there are serious grounds for such removal and the Court of Justice, after the case has been referred to it by the Administrative Board on the recommendation of the President of the Boards of Appeal, after consulting the chairman of the Board to which the member concerned belongs, takes a decision to this effect.
4. The President of the Boards of Appeal and the chairmen and members of the Boards of Appeal shall be independent. In their decisions they shall not be bound by any instructions.
5. The President of the Boards of Appeal and the chairmen and members of the Boards of Appeal may not be examiners or members of the Opposition Divisions, Administration of Trade Marks and Legal Division or Cancellation Divisions.

#### Article 137

##### Exclusion and objection

1. Examiners and members of the Divisions set up within the Office or of the Boards of Appeal may not take part in any proceedings if they have any personal interest therein, or if they have previously been involved as representatives of one of the parties. Two of the three members of an Opposition Division shall not have taken part in examining the application. Members of the Cancellation Divisions may not take part in any proceedings if they have participated in the final decision on the case in the proceedings for registration or opposition proceedings. Members of the Boards of Appeal may not take part in appeal proceedings if they participated in the decision under appeal.
2. If, for one of the reasons mentioned in paragraph 1 or for any other reason, a member of a Division or of a Board of Appeal considers that he should not take part in any proceedings, he shall inform the Division or Board accordingly.
3. Examiners and members of the Divisions or of a Board of Appeal may be objected to by any party for one of the reasons mentioned in paragraph 1, or if suspected of partiality. An objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step. No objection may be based upon the nationality of examiners or members.

4. The Divisions and the Boards of Appeal shall decide as to the action to be taken in the cases specified in paragraphs 2 and 3 without the participation of the member concerned. For the purposes of taking this decision the member who withdraws or has been objected to shall be replaced in the Division or Board of Appeal by his alternate.

## SECTION 5

### Budget and financial control

#### Article 138

##### Budget Committee

1. A Budget Committee is hereby set up, attached to the Office. The Budget Committee shall have the powers assigned to it in this Section and in Article 38(4).
2. Articles 126(6), 127, 128 and 129(1) to (4), (6) and (7) shall apply to the Budget Committee *mutatis mutandis*.
3. The Budget Committee shall take its decisions by a simple majority of the representatives of the Member States. However, a majority of three-quarters of the representatives of the Member States shall be required for the decisions which the Budget Committee is empowered to take under Articles 38(4), 140(3) and 143. In both cases each Member State shall have one vote.

#### Article 139

##### 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 shall comprise, without prejudice to other types of income, total fees payable under the fees regulations, total fees payable under the Madrid Protocol referred to in Article 140 of this Regulation for an international registration designating the European Community and other payments made to Contracting Parties to the Madrid Protocol, total fees payable under the Geneva Act referred to in Article 106c of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs [10] for an international registration designating the

European Community and other payments made to Contracting Parties to the Geneva Act, and, to the extent necessary, a subsidy entered against a specific heading of the general budget of the European Communities, Commission section.

#### Article 140

##### 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 Budget Committee not later than 31 March in each year, together with a list of posts.
2. Should the budget estimates provide for a Community subsidy, the Budget Committee shall immediately forward the estimate to the Commission, which shall forward it to the budget authority of the Communities. The Commission may attach an opinion on the estimate along with an alternative estimate.
3. The Budget Committee shall adopt the budget, which shall include the Office's list of posts. Should the budget estimates contain a subsidy from the general budget of the Communities, the Office's budget shall, if necessary, be adjusted.

#### Article 141

##### Audit and control

1. An internal audit function shall be set up within the Office, to be performed in compliance with the relevant international standards. The internal auditor, appointed by the President, shall be responsible to him for verifying the proper operation of budget implementation systems and procedures of the Office.
2. The internal auditor shall advise the President on dealing with risks, by issuing independent opinions on the quality of management and control systems and by issuing recommendations for improving the conditions of implementation of operations and promoting sound financial management.
3. The responsibility for putting in place internal control systems and procedures suitable for carrying out his tasks shall lie with the authorising officer.

#### Article 142

##### Auditing of accounts

1. Not later than 31 March in each year the President shall transmit to the Commission, the European Parliament, the Budget Committee and the Court of Auditors accounts of the Office's total revenue and expenditure for the preceding financial year. The Court of Auditors shall examine them in accordance with Article 248 of the Treaty.

2. The Budget Committee shall give a discharge to the President of the Office in respect of the implementation of the budget.

#### Article 143

##### Financial provisions

The Budget Committee shall, after consulting the Court of Auditors of the European Communities and the Commission, adopt internal financial provisions specifying, in particular, the procedure for establishing and implementing the Office's budget. As far as is compatible with the particular nature of the Office, the financial provisions shall be based on the financial regulations adopted for other bodies set up by the Community.

#### Article 144

##### 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 at such a level as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Office to be balanced.

3. The fees regulations shall be adopted and amended in accordance with the procedure referred to in Article 163(2).

### TITLE XIII

#### INTERNATIONAL REGISTRATION OF MARKS

##### SECTION I

##### General provisions

#### Article 145

##### Application of provisions

Unless otherwise specified in this title, this Regulation and its Implementing Regulations shall apply to applications for international registrations under the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989 (hereafter referred to as "international applications" and "the Madrid Protocol" respectively), based on an application for a Community trade mark or on a Community trade mark and to registrations of marks in the international register maintained by the International Bureau of the World Intellectual Property Organisation (hereafter referred to as "international registrations" and "the International Bureau", respectively) designating the European Community.

## SECTION 2

International registration on the basis of applications for a Community trade mark and of Community trade marks

### Article 146

Filing of an international application

1. International applications pursuant to Article 3 of the Madrid Protocol based on an application for a Community trade mark or on a Community trade mark shall be filed at the Office.
2. Where an international application is filed before the mark on which the international registration is to be based has been registered as a Community trade mark, the applicant for the international registration must indicate whether the international registration is to be based on a Community trade mark application or registration. Where the international registration is to be based on a Community trade mark once it is registered, the international application shall be deemed to have been received at the Office on the date of registration of the Community trade mark.

### Article 147

Form and contents of the international application

1. The international application shall be filed in one of the official languages of the European Community, using a form provided by the Office. Unless otherwise specified by the applicant on that form when he files the international application, the Office shall correspond with the applicant in the language of filing in a standard form.

2. If the international application is filed in a language which is not one of the languages allowed under the Madrid Protocol, the applicant must indicate a second language from among those languages. This shall be the language in which the Office submits the international application to the International Bureau.
3. Where the international application is filed in a language other than one of the languages allowed under the Madrid Protocol for the filing of international applications, the applicant may provide a translation of the list of goods or services in the language in which the international application is to be submitted to the International Bureau pursuant to paragraph 2.
4. The Office shall forward the international application to the International Bureau as soon as possible.
5. The filing of an international application shall be subject to the payment of a fee to the Office. In the cases referred to in the second sentence of Article 146(2), the fee shall be due on the date of registration of the Community trade mark. The application shall be deemed not to have been filed until the required fee has been paid.
6. The international application must fulfil the relevant conditions laid down in the Implementing Regulation.

#### Article 148

##### Recordal in the files and in the Register

1. The date and number of an international registration based on a Community trade mark application, shall be recorded in the files of that application. When the application results in a Community trade mark, the date and number of the international registration shall be entered in the Register.
2. The date and number of an international registration based on a Community trade mark shall be entered in the Register.

#### Article 149

##### Request for territorial extension subsequent to the international registration

A request for territorial extension made subsequent to the international registration pursuant to Article 3ter(2) of the Madrid Protocol may be filed through the intermediary of the Office.

The request must be filed in the language in which the international application was filed pursuant to Article 147.

## Article 150

### International fees

Any fees payable to the International Bureau under the Madrid Protocol shall be paid direct to the International Bureau.

## SECTION 3

### International registrations designating the European Community

## Article 151

### Effects of international registrations designating the European Community

1. An international registration designating the European Community shall, from the date of its registration pursuant to Article 3(4) of the Madrid Protocol or from the date of the subsequent designation of the European Community pursuant to Article 3ter(2) of the Madrid Protocol, have the same effect as an application for a Community trade mark.
2. If no refusal has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the international registration of a mark designating the European Community shall, from the date referred to in paragraph 1, have the same effect as the registration of a mark as a Community trade mark.
3. For the purposes of applying Article 9(3), publication of the particulars of the international registration designating the European Community pursuant to Article 152(1) shall take the place of publication of a Community trade mark application, and publication pursuant to Article 152(2) shall take the place of publication of the registration of a Community trade mark.

## Article 152

### Publication

1. The Office shall publish the date of registration of a mark designating the European Community pursuant to Article 3(4) of the Madrid Protocol or the date of the subsequent designation of the European Community pursuant to Article 3ter(2) of the Madrid Protocol, the language of filing of the international application and the second language indicated by

the applicant, the number of the international registration and the date of publication of such registration in the Gazette published by the International Bureau, a reproduction of the mark and the numbers of the classes of the goods or services in respect of which protection is claimed.

2. If no refusal of protection of an international registration designating the European Community has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the Office shall publish this fact, together with the number of the international registration and, where applicable, the date of publication of such registration in the Gazette published by the International Bureau.

#### Article 153

##### Seniority

1. The applicant for an international registration designating the European Community may claim, in the international application, the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 34.

2. The holder of an international registration designating the European Community may, as from the date of publication of the effects of such registration pursuant to Article 152(2), claim at the Office the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 35. The Office shall notify the International Bureau accordingly.

#### Article 154

##### Examination as to absolute grounds for refusal

1. International registrations designating the European Community shall be subject to examination as to absolute grounds for refusal in the same way as applications for Community trade marks.

2. Protection of an international registration shall not be refused before the holder of the international registration has been allowed the opportunity to renounce or limit the protection in respect of the European Community or of submitting his observations.

3. Refusal of protection shall take the place of refusal of a Community trade mark application.

4. Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the protection in respect of the European Community pursuant to paragraph 2, the Office shall refund the holder of the international registration a part of the individual fee to be laid down in the Implementing Regulation.

## Article 155

### Search

1. Once the Office has received a notification of an international registration designating the European Community, it shall draw up a Community search report as provided for in Article 38(1).

2. As soon as the Office has received a notification of an international registration designating the European Community, the Office shall transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks as provided for in Article 38(2).

3. Article 38(3) to (6) shall apply *mutatis mutandis*.

4. The Office shall inform the proprietors of any earlier Community trade marks or Community trade mark applications cited in the Community search report of the publication of the international registration designating the European Community as provided for in Article 152(1).

## Article 156

### Opposition

1. International registration designating the European Community shall be subject to opposition in the same way as published Community trade mark applications.

2. Notice of opposition shall be filed within a period of three months which shall begin six months following the date of the publication pursuant to Article 152(1). The opposition shall not be treated as duly entered until the opposition fee has been paid.

3. Refusal of protection shall take the place of refusal of a Community trade mark application.

4. Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the

protection in respect of the European Community prior to a decision under this Article which has become final, the Office shall refund the holder of the international registration a part of the individual fee to be laid down in the Implementing Regulation.

#### Article 157

##### Replacement of a Community trade mark by an international registration

The Office shall, upon request, enter a notice in the Register that a Community trade mark is deemed to have been replaced by an international registration in accordance with Article 4bis of the Madrid Protocol.

#### Article 158

##### Invalidation of the effects of an international registration

1. The effects of an international registration designating the European Community may be declared invalid.
2. The application for invalidation of the effects of an international registration designating the European Community shall take the place of an application for a declaration of revocation as provided for in Article 51 or for a declaration of invalidity as provided for in Article 52 or Article 53.

#### Article 159

##### Conversion of a designation of the European Community through an international registration into a national trade mark application or into a designation of Member States

1. Where a designation of the European Community through an international registration has been refused or ceases to have effect, the holder of the international registration may request the conversion of the designation of the European Community:

(a) into a national trade mark application pursuant to Articles 112, 113 and 114;

(b) into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 14 April 1891, as revised and amended (hereafter referred to as the "Madrid Agreement"), provided that on the date when conversion was requested it was possible to have designated that Member State directly under the Madrid Protocol or the Madrid Agreement. Articles 112, 113 and 114 shall apply.

2. The national trade mark application or the designation of a Member State party to the Madrid Protocol or the Madrid Agreement resulting from the conversion of the designation of the European Community through an international registration shall enjoy, in respect of the Member State concerned, the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date of the extension to the European Community pursuant to Article 3ter(2) of the Madrid Protocol if the latter was made subsequently to the international registration, or the date of priority of that registration and, where appropriate, the seniority of a trade mark of that State claimed under Article 153.

3. The request for conversion shall be published.

#### Article 160

##### Use of a mark subject of an international registration

For the purposes of applying Article 15(1), Article 42(2), Article 51(1)(a) and Article 57(2), the date of publication pursuant to Article 152(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the European Community must be put to genuine use in the Community.

#### Article 161

##### Transformation

1. Subject to paragraph 2, the provisions applicable to Community trade mark applications shall apply mutatis mutandis to applications for transformation of an international registration into a Community trade mark application pursuant to Article 9quinquies of the Madrid Protocol.

2. When the application for transformation relates to an international registration designating the European Community the particulars of which have been published pursuant to Article 152(2), Articles 37 to 42 shall not apply.

#### TITLE XIV

#### FINAL PROVISIONS

#### Article 162

##### Community implementing provisions

1. The rules implementing this Regulation shall be adopted in an Implementing Regulation.
2. In addition to the fees provided for in the preceding Articles, fees shall be charged, in accordance with the detailed rules of application laid down in the Implementing Regulation, in the cases listed below:
  - (a) late payment of the registration fee;
  - (b) issue of a copy of the certificate of registration;
  - (c) registration of a licence or another right in respect of a Community trade mark;
  - (d) registration of a licence or another right in respect of an application for a Community trade mark;
  - (e) cancellation of the registration of a licence or another right;
  - (f) alteration of a registered Community trade mark;
  - (g) issue of an extract from the Register;
  - (h) inspection of the files;
  - (i) issue of copies of file documents;
  - (j) issue of certified copies of the application;
  - (k) communication of information in a file;
  - (l) review of the determination of the procedural costs to be refunded.
3. The Implementing Regulation and the rules of procedure of the Boards of Appeal shall be adopted and amended in accordance with the procedure referred to in Article 163(2).

#### Article 163

##### Establishment of a committee and procedure for the adoption of implementing regulations

1. The Commission shall be assisted by a committee referred to as the "Committee on Fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonisation in the Internal Market (trade marks and designs)".
2. Where reference is made to this paragraph, Articles 5 and 7 of Decision 1999/468/EC shall apply.

The period laid down in Article 5(6) of Decision 1999/468/EC shall be set at three months.

## Article 164

### Compatibility with other Community legal provisions

This Regulation shall not affect Council Regulation (EC) No 510/2006, and in particular Article 14 thereof.

## Article 165

### Provisions relating to the enlargement of the Community

1. As from the date of accession of Bulgaria, the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Romania, Slovenia and Slovakia (hereinafter referred to as "new Member State(s)"), a Community trade mark registered or applied for pursuant to this Regulation before the respective dates of accession shall be extended to the territory of those Member States in order to have equal effect throughout the Community.

2. The registration of a Community trade mark which is under application at the date of accession may not be refused on the basis of any of the absolute grounds for refusal listed in Article 7(1), if these grounds became applicable merely because of the accession of a new Member State.

3. Where an application for the registration of a Community trade mark has been filed during the six months prior to the date of accession, notice of opposition may be given pursuant to Article 41 where an earlier trade mark or another earlier right within the meaning of Article 8 was acquired in a new Member State prior to accession, provided that it was acquired in good faith and that the filing date or, where applicable, the priority date or the date of acquisition in the new Member State of the earlier trade mark or other earlier right precedes the filing date or, where applicable, the priority date of the Community trade mark applied for.

4. A Community trade mark as referred to in paragraph 1 may not be declared invalid:

(a) pursuant to Article 52 if the grounds for invalidity became applicable merely because of the accession of a new Member State;

(b) pursuant to Article 53(1) and (2) if the earlier national right was registered, applied for or acquired in a new Member State prior to the date of accession.

5. The use of a Community trade mark as referred to in paragraph 1 may be prohibited pursuant to Articles 110 and 111, if the earlier trade mark or other earlier right was registered,

applied for or acquired in good faith in the new Member State prior to the date of accession of that State; or, where applicable, has a priority date prior to the date of accession of that State.

## Article 166

### Repeal

Regulation (EC) No 40/94, as amended by the instruments set out in Annex I, is repealed.

References to the repealed Regulation shall be construed as references to this Regulation and shall be read in accordance with the correlation table in Annex II.

## Article 167

### Entry into force

1. This Regulation shall enter into force on the 20th day following its publication in the Official Journal of the European Union.

2. The Member States shall within three years following entry into force of Regulation (EC) No 40/94 take the necessary measures for the purpose of implementing Articles 95 and 114.

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

Done at Brussels, 26 February 2009.

For the Council

The President

I. Langer

[1] OJ C 146 E, 12.6.2008, p. 79.

[2] OJ L 11, 14.1.1994, p. 1.

[3] See Annex I.

[4] OJ L 12, 16.1.2001, p. 1.

[5] OJ L 184, 17.7.1999, p. 23.

[6] OJ L 93, 31.3.2006, p. 12.

[7] OJ L 110, 20.4.2001, p. 28.

[8] OJ L 125, 5.5.2001, p. 15.

[9] OJ L 145, 31.5.2001, p. 43.

[10] OJ L 3, 5.1.2002, p. 1.

-----  
ANNEX I

Repealed Regulation with list of its successive amendments

(referred to in Article 166)

Council Regulation (EC) No 40/94 (OJ L 11, 14.1.1994, p. 1) ||

Council Regulation (EC) No 3288/94 (OJ L 349, 31.12.1994, p. 83) ||

Council Regulation (EC) No 807/2003 (OJ L 122, 16.5.2003, p. 36) | Only point 48 of Annex III |

Council Regulation (EC) No 1653/2003 (OJ L 245, 29.9.2003, p. 36) ||

Council Regulation (EC) No 1992/2003 (OJ L 296, 14.11.2003, p. 1) ||

Council Regulation (EC) No 422/2004 (OJ L 70, 9.3.2004, p. 1) ||

Council Regulation (EC) No 1891/2006 (OJ L 386, 29.12.2006, p. 14) | Only Article 1 |

Annex II, Part 4 (C)(I) of the 2003 Act of Accession (OJ L 236, 23.9.2003, p. 342) ||

Annex III, Point 1.I of the 2005 Act of Accession (OJ L 157, 21.6.2005, p. 231) ||

**2.1.2. Commission Regulation (EC) implementing Council Regulation (EC) No 40/94 on the Community trade mark <sup>5</sup> No 2868/95**

of 13 December 1995

COMMISSION REGULATION (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community

---

<sup>5</sup> *Official Journal L 303*, 15/12/1995 P. 0001 – 0032

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (1) as amended by Regulation (EC) No 3288/94 (2), and in particular Article 140 thereof,

Whereas Regulation (EC) No 40/94 (hereinafter 'the Regulation') creates a new trade mark system allowing a trade mark having effect throughout the Community to be obtained on the basis of an application to the Office for Harmonization in the Internal Market (trade marks and designs) ('the Office');

Whereas for this purpose, the Regulation contains the necessary provisions for a procedure leading to the registration of a Community trade mark, as well as for the administration of Community trade marks, for appeals against decisions of the Office and for proceedings for the revocation or invalidation of a Community trade mark;

Whereas Article 140 of the Regulation provides that the rules implementing the Regulation shall be adopted in an implementing regulation;

Whereas the implementing regulation is to be adopted in accordance with the procedure laid down in Article 141 of the Regulation;

Whereas this implementing regulation therefore lays down the rules necessary for implementing the provisions of the Regulation on the Community trade mark;

Whereas these rules should ensure the smooth and efficient operating of trade mark proceedings before the Office;

Whereas in accordance with Article 116 (1) of the Regulation, all the elements of the application for a Community trade mark specified in its Article 26 (1) as well as any other information the publication of which is prescribed by this implementing regulation should be published in all the official languages of the Community;

Whereas, however, it is not appropriate for the trade mark itself, names, addresses, dates and any other similar data to be translated and published in all the official languages of the Community;

Whereas the Office should make available standard forms for proceedings before the Office in all official languages of the Community;

Whereas the measures envisaged in this Regulation are in accordance with the opinion of the Committee established under Article 141 of the Regulation,

**HAS ADOPTED THIS REGULATION:**

## Article 1

The rules implementing the Regulation shall be as follows:

### TITLE I

#### APPLICATION PROCEDURE

##### Rule 1

###### Content of the application

The application for a Community trade mark shall contain:

a request for registration of the mark as a Community trade mark;

the name, address and nationality of the applicant and the State in which he is domiciled or has his seat or an establishment. Names of natural persons shall be indicated by the person's family name and given name(s). Names of legal entities, as well as bodies falling under Article 3 of the Regulation, shall be indicated by their official designation, which may be abbreviated in a customary manner; furthermore, the law of the State governing them shall be indicated. The telegraphic and teletype address, telephone as well as fax numbers and details of other data communications links may be given. Only one address shall, in principle, be indicated for each applicant; where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service;

a list of the goods and services for which the trade mark is to be registered, in accordance with Rule 2;

a representation of the mark in accordance with Rule 3;

if the applicant has appointed a representative, his name and the address of his place of business in accordance with point (b); if the representative has more than one business address or if there are two or more representatives with different business addresses, the application shall indicate which address shall be used as an address for service; where such an indication is not made, only the first-mentioned address shall be taken into account as an address for service;

where the priority of a previous application is claimed pursuant to Article 30 of the Regulation, a declaration to that effect, stating the date on which and the country in or for which the previous application was filed;

where exhibition priority is claimed pursuant to Article 33 of the Regulation, a declaration to that effect, stating the name of the exhibition and the date of the first display of the goods or services;

where the seniority of one or more earlier trade marks, registered in a Member State, including a trade mark registered in the Benelux countries or registered under international arrangements having effect in a Member State (hereinafter referred to as 'earlier registered trade marks, as referred to in Article 34 of the Regulation`) is claimed pursuant to Article 34 of the Regulation, a declaration to that effect, stating the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the mark is registered;

where applicable, a statement that the application is for registration of a Community collective mark pursuant to Article 64 of the Regulation;

specification of the language in which the application has been filed, and of the second language pursuant to Article 115 (3) of the Regulation;

the signature of the applicant or his representative.

The application for a Community collective mark may include the regulations governing its use.

The application may include a statement by the applicant that he disclaims any exclusive right to an element of the trade mark which is not distinctive, to be specified by the applicant.

If there is more than one applicant, the application may contain the appointment of one applicant or representative as common representative.

## Rule 2

### List of goods and services

The common classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, shall be applied to the classification of the goods and services.

The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.

The goods and services shall, in principle, be grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes under that Classification.

The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

### Rule 3

#### Representation of the mark

If the applicant does not wish to claim any special graphic feature or colour, the mark shall be reproduced in normal script, as for example, by typing the letters, numerals and signs in the application. The use of small letters and capital letters shall be permitted and shall be followed accordingly in publications of the mark and in the registration by the Office.

In cases other than those referred to in paragraph 1, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears. The sheet on which the mark is reproduced shall not exceed DIN A4 size (29,7 cm high, 21 cm wide) and the space used for the reproduction (type-area) shall not be larger than 26,2 cm × 17 cm. A margin of at least 2,5 cm shall be left on the left-hand side. Where it is not obvious, the correct position of the mark shall be indicated by adding the word 'top` to each reproduction. The reproduction of the mark shall be of such quality as to enable it to be reduced or enlarged to a size not more than 8 cm wide by 16 cm high for publication in the Community Trade Mark Bulletin. The separate sheet shall also indicate the name and address of the applicant. Four copies of the separate sheet carrying the reproduction shall be filed.

In cases to which paragraph 2 applies, the application shall contain an indication to that effect. The application may contain a description of the mark.

Where registration of a three-dimensional mark is applied for, the application shall contain an indication to that effect. The representation shall consist of a photographic reproduction or a graphic representation of the mark. The representation may contain up to six different perspectives of the mark.

Where registration in colour is applied for, the application shall contain an indication to that effect. The colours making up the mark shall also be indicated. The reproduction under paragraph 2 shall consist of the colour reproduction of the mark.

The President of the Office may determine that, as far as the requirements of paragraph 2 are concerned, the mark may be reproduced in the text of the application itself and not on a separate sheet of paper and that the the number of copies of the reproduction of the mark may be less than four.

#### Rule 4

##### Fees for the application

The fees payable for the application shall be:

the basic fee;

and

(b) a class fee for each class exceeding three to which the goods or services belong according to Rule 2.

#### Rule 5

##### Filing of the application

The Office shall mark the documents making up the application with the date of its receipt and the file number of the application. The Office shall issue to the applicant without delay a receipt which shall include at least the file number, a representation, description or other identification of the mark, the nature and the number of the documents and the date of their receipt.

If the application is filed with the central industrial property office of a Member State or at the Benelux Trade Mark Office in accordance with Article 25 of the Regulation, the office of filing shall number all the pages of the application with arabic numerals. Before forwarding, the office of filing shall mark the documents making up the application with the date of receipt and the number of pages. The office of filing shall issue to the applicant without delay a receipt which shall include at least the nature and the number of the documents and the date of their receipt.

If the Office receives an application forwarded by the central industrial property office of a Member State or the Benelux Trade Mark Office, it shall mark the application with the date of receipt and the file number and shall issue to the applicant without delay a receipt in

accordance with the second sentence of paragraph 1, indicating the date of receipt at the Office.

## Rule 6

### Claiming priority

Where the priority of one or more previous applications pursuant to Article 30 of the Regulation is claimed in the application, the applicant shall indicate the file number of the previous application and file a copy of it within three months from the filing date. The copy shall be certified to be an exact copy of the previous application by the authority which received the previous application, and shall be accompanied by a certificate issued by that authority stating the date of filing of the previous application.

Where the applicant wishes to claim the priority of one or more previous applications pursuant to Article 30 of the Regulation subsequent to the filing of the application, the declaration of priority, stating the date on which and the country in or for which the previous application was made, shall be submitted within a period of two months from the filing date. The indications and evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of priority.

If the language of the previous application is not one of the languages of the Office, the Office shall require the applicant to file, within a period specified by the Office, which shall be not less than three months, a translation of the previous application into one of these languages.

The President of the Office may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

## Rule 7

### Exhibition priority

Where the exhibition priority pursuant to Article 33 of the Regulation has been claimed in the application, the applicant shall, within three months from the filing date, file a certificate issued at the exhibition by the authority responsible for the protection of industrial property at the exhibition. This certificate shall declare that the mark was in fact used for the goods or services, and shall state the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of such first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the abovementioned authority.

Where the applicant wishes to claim an exhibition priority subsequently to the filing of the application, the declaration of priority, indicating the name of the exhibition and the date of the first display of the goods or services, shall be submitted within a period of two months from the filing date. The indications and evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of priority.

#### Rule 8

##### Claiming the seniority of a national trade mark

Where the seniority of one or more earlier registered trade marks, as referred to in Article 34 of the Regulation, has been claimed in the application, the applicant shall, within three months from the filing date, submit a copy of the relevant registration. The copy must be certified by the competent authority to be an exact copy of the relevant registration.

Where the applicant wishes to claim the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, subsequent to the filing of the application, the declaration of seniority, indicating the Member State or Member States in or for which the mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the mark is registered, shall be submitted within a period of two months from the filing date. The evidence required under paragraph 1 shall be submitted to the Office within a period of three months from receipt of the declaration of seniority.

The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the effective claiming of seniority.

The President of the Office may determine that the evidence to be provided by the applicant may consist of less than is required under paragraph 1, provided that the information required is available to the Office from other sources.

#### Rule 9

##### Examination of requirements for a filing date and of formal requirements

If the application fails to meet the requirements for according a filing date because:

the application does not contain:

a request for registration of the mark as a Community trade mark;

information identifying the applicant;

a list of the goods and services for which the mark is to be registered;

iv) a representation of the trade mark; or

(b) the basic fee for the application has not been paid within one month of the filing of the application with the Office or, if the application has been filed with the central industrial property office of a Member State or with the Benelux Trade Mark Office, with that office, the Office shall notify the applicant that a date of filing cannot be accorded in view of those deficiencies.

(2) If the deficiencies referred to under paragraph 1 are remedied within two months of receipt of the notification, the date on which all the deficiencies are remedied shall determine the date of filing. If the deficiencies are not remedied before the time limit expires, the application shall not be dealt with as a Community trade mark application. Any fees paid shall be refunded.

(3) Where, although a date of filing has been accorded, the examination reveals that the requirements of Rules 1, 2 and 3 or the other formal requirements governing applications laid down in the Regulation or in these Rules are not complied with;

the full amount of the class fees payable under Rule 4 (b), read in conjunction with Commission Regulation (EC) No 2869/95 (3) (hereinafter 'the Fees Regulation') has not been received by the Office;

where priority has been claimed pursuant to Rules 6 and 7, either in the application itself or within two months after the date of filing, the other requirements of the said Rules are not complied with; or

where seniority has been claimed pursuant to Rule 8, either in the application itself or within two months after the date of filing, the other requirements of Rule 8 are not complied with, the Office shall invite the applicant to remedy the deficiencies noted within such period as it may specify.

(4) If the deficiencies referred to in paragraph 3 (a) are not remedied before the time limit expires, the Office shall reject the application.

(5) If the outstanding class fees are not paid before the time limit expires, the application shall be deemed to have been withdrawn, unless it is clear which class or classes the amount paid is intended to cover. In the absence of other criteria to determine which classes are intended to be covered, the Office shall take the classes in the order of the classification. The application

shall be deemed to have been withdrawn with regard to those classes for which the class fees have not been paid or have not been paid in full.

(6) If the deficiencies referred to in paragraph 3 concern the claim to priority, the right of priority for the application shall be lost.

(7) If the deficiencies referred to in paragraph 3 concern the claim to seniority, the right of seniority in respect of that application shall be lost.

(8) If the deficiencies referred to in paragraph 3 concern only some of the goods and services, the Office shall refuse the application, or the right of priority or the right of seniority shall be lost, only in so far as those goods and services are concerned.

#### Rule 10

Examination of the conditions relating to the entitlement to be proprietor

Where, pursuant to Article 5 of the Regulation, the applicant is not entitled to be the proprietor of a Community trade mark, the Office shall notify the applicant thereof. The Office shall specify a period within which the applicant may withdraw the application or submit his observations. Where the applicant fails to overcome the objections to registration, the Office shall refuse the application.

#### Rule 11

Examination as to absolute grounds for refusal

Where, pursuant to Article 7 of the Regulation, the trade mark may not be registered for all or any part of the goods or services applied for, the office shall notify the applicant of the grounds for refusing registration. The Office shall specify a period within which the applicant may withdraw or amend the application or submit his observations.

Where, pursuant to Article 38 (2) of the Regulation, registration of the Community trade mark is subject to the applicant's stating that he disclaims any exclusive right in the non-distinctive elements in the mark, the Office shall notify the applicant thereof, stating the reasons, and shall invite him to submit the relevant statement within such period as it may specify.

Where the applicant fails to overcome the ground for refusing registration or to comply with the condition laid down in paragraph 2 within the time limit, the Office shall refuse the application in whole or in part.

#### Rule 12

Publication of the application

The publication of the application shall contain:

the applicant's name and address;

where applicable, the name and business address of the representative appointed by the applicant other than a representative falling within the first sentence of Article 88 (3) of the Regulation; if there is more than one representative with the same business address, only the name and business address of the first-named representative shall be published and it shall be followed by the words 'and others`; if there are two or more representatives with different business addresses, only the address for service determined pursuant to Rule 1 (1) (e) shall be published; where an association of representatives is appointed under Rule 76 (9), only the name and business address of the association shall be published;

the reproduction of the mark, together with the indications and descriptions pursuant to Rule 3; where registration in colour is applied for, the publication shall contain the indication 'in colour` and indicate the colour or colours making up the mark;

the list of goods and services, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs, and presented in the order of the classes of that classification;

the date of filing and the file number;

where applicable, particulars of the claim of priority pursuant to Article 30 of the Regulation;

where applicable, particulars of the claim of exhibition priority pursuant to Article 33 of the Regulation;

where applicable, particulars of the claim of seniority pursuant to Article 34 of the Regulation;

where applicable, a statement that the mark has become distinctive in consequence of the use which has been made of it, pursuant to Article 7 (3) of the Regulation;

where applicable, a statement that the application is for a Community collective mark;

where applicable, a statement by the applicant disclaiming any exclusive right to an element of the mark pursuant to Rule 1 (3) or Rule 11 (2);

the language in which the application was filed and the second language which the applicant has indicated pursuant to Article 115 (3) of the Regulation.

Rule 13

Amendment of the application

An application for amendment of the application under Article 44 of the Regulation shall contain:

the file number of the application;

the name and the address of the applicant in accordance with Rule 1 (1) (b);

where the applicant has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);

the indication of the element of the application to be corrected or amended, and that element in its corrected or amended version;

where the amendment relates to the representation of the mark, a representation of the mark as amended, in accordance with Rule 3.

Where the application for amendment is subject to the payment of a fee, the application shall not be deemed to have been filed until the required fee has been paid. If the fee has not been paid or has not been paid in full, the Office shall inform the applicant accordingly.

If the requirements governing the amendment of the application are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application for amendment.

Where the amendment is published pursuant to Article 44 (2) of the Regulation, Rules 15 to 22 shall apply *mutatis mutandis*.

A single application for amendment may be made for the amendment of the same element in two or more applications of the same applicant. Where the application for amendment is subject to the payment of a fee, the required fee shall be paid in respect of each application to be amended.

Paragraphs 1 to 5 shall apply *mutatis mutandis* for applications to correct the name or the business address of a representative appointed by the applicant. Such applications shall not be subject to the payment of a fee.

#### Rule 14

##### Correction of mistakes and errors in publications

Where the publication of the application contains a mistake or error attributable to the Office, the Office shall correct the mistake or error acting of its own motion or at the request of the applicant.

Where a request as referred to in paragraph 1 is made by the applicant, Rule 13 shall apply mutatis mutandis. The request shall not be subject to the payment of a fee.

The corrections effected under this Rule shall be published.

Article 42 (2) of the Regulation and Rules 15 to 22 shall apply mutatis mutandis where the correction concerns the list of goods or services or the representation of the mark.

## TITLE II

### PROCEDURE FOR OPPOSITION AND PROOF OF USE

#### Rule 15

##### Contents of the notice of opposition

Opposition may be entered on the basis of one or more earlier marks within the meaning of Article 8 (2) of the Regulation ('earlier marks') or of one or more other earlier rights within the meaning of Article 8 (4) of the Regulation ('earlier rights').

The notice of opposition shall contain:

as concerns the application against which opposition is entered:

the file number of the application against which opposition is entered;

an indication of the goods and services listed in the Community trade mark application against which opposition is entered;

the name of the applicant for the Community trade mark;

as concerns the earlier mark or the earlier right on which the opposition is based:

where the opposition is based on an earlier mark, a statement to that effect and an indication that the earlier mark is a Community mark or an indication of the Member State or Member States including, where applicable, the Benelux, where the earlier mark has been registered or applied for, or, where the earlier mark is an internationally registered mark, an indication of the Member State or Member States including, where applicable, the Benelux, to which protection of that earlier mark has been extended;

where available, the file number or the registration number and the filing date, including the priority date of the earlier mark;

where the opposition is based on an earlier mark which is a well-known mark within the meaning of Article 8 (2) (c) of the Regulation, an indication to that effect and an indication of the Member State or Member States in which the earlier mark is well-known;

where the opposition is based on an earlier mark having a reputation within the meaning of Article 8 (5) of the Regulation, an indication to that effect, and an indication of where that earlier mark is registered or applied for in accordance with subparagraph (i);

where the opposition is based on an earlier right, an indication to that effect, and an indication of the Member State or Member States where that earlier right exists;

a representation and, where appropriate, a description of the earlier mark or earlier right;

the goods and services in respect of which the earlier mark has been registered or applied for or in respect of which the earlier mark is well-known within the meaning of Article 8 (2) (c) of the Regulation or has a reputation within the meaning of Article 8 (5) of the Regulation; the opposing party shall, when indicating all the goods and services for which the earlier mark is protected, also indicate those goods and services on which the opposition is based;

as concerns the opposing party:

where the opposition is entered by the proprietor of the earlier mark or of the earlier right, his name and address in accordance with Rule 1 (1) (b) and an indication that he is the proprietor of such mark or right;

where opposition is entered by a licensee, the name of the licensee and his address in accordance with Rule 1 (1) (b) and an indication that he has been authorized to enter the opposition;

where the opposition is entered by the successor in title to the registered proprietor of a Community trade mark who has not yet been registered as new proprietor, an indication to that effect, the name and address of the opposing party in accordance with Rule 1 (1) (b), and an indication of the date on which the application for registration of the new proprietor was received by the Office or, where this information is not available, was sent to the Office;

where opposition is entered on the basis of an earlier right by a person who is not the proprietor of that right, the name of the person and his address in accordance with Rule 1 (1) (b) and an indication that he is entitled under the relevant national law to exercise that right;

where the opposing party has appointed a representative, the name of the representative and his business in accordance with Rule 1 (1) (e);

a specification of the grounds on which the opposition is based.

Paragraphs 1 and 2 shall apply mutatis mutandis to an opposition entered pursuant to Article 8 (3) of the Regulation.

## Rule 16

### Facts, evidence and arguments presented in support of the opposition

Every notice of opposition may contain particulars of the facts, evidence and arguments presented in support of the opposition, accompanied by the relevant supporting documents.

If the opposition is based on an earlier mark which is not a Community trade mark, the notice of opposition shall preferably be accompanied by evidence of the registration or filing of that earlier mark, such as a certificate of registration. If the opposition is based on a well-known mark as referred to in Article 8 (2) (c) of the Regulation or on a mark having a reputation as referred to in Article 8 (5) of the Regulation, the notice of opposition shall in principle be accompanied by evidence attesting that it is well-known or that it has a reputation. If the opposition is entered on the basis of any other earlier right, the notice of opposition shall in principle be accompanied by appropriate evidence on the acquisition and scope of protection of that right.

The particulars of the facts, evidence and arguments and other supporting documents as referred to in paragraphs 1, and the evidence referred to in paragraph 2 may, if they are not submitted together with the notice of opposition or subsequent thereto, be submitted within such period after commencement of the opposition proceedings as the Office may specify pursuant to Rule 20 (2).

## Rule 17

### Use of languages in opposition proceedings

Where the notice of opposition is not filed in the language of the application for registration of the Community trade mark, if that language is one of the languages of the Office, or in the second language indicated when the application was filed, the opposing party shall file a translation of the notice of opposition in one of those languages within a period of one month from the expiry of the opposition period.

Where the evidence in support of the opposition as provided for in Rule 16 (1) and (2) is not filed in the language of the opposition proceedings, the opposing party shall file a translation of that evidence into that language within a period of one month from the expiry of the opposition period or, where applicable, within the period specified by the Office pursuant to Rule 16 (3).

Where the opposing party or the applicant informs the Office, before the date on which the opposition proceedings shall be deemed to commence pursuant to Rule 19 (1), that the

applicant and the opposing party have agreed on a different language for the opposition proceeding pursuant to Article 115 (7) of the Regulation, the opposing party shall, where the notice of opposition has not been filed in that language, file a translation of the notice of opposition in that language within a period of one month from the said date.

#### Rule 18

##### Rejection of notice of opposition as inadmissible

If the Office finds that the notice of opposition does not comply with the provisions of Article 42 of the Regulation, or where the notice of opposition does not clearly identify the application against which opposition is entered or the earlier mark or the earlier right on the basis of which the opposition is being entered, the Office shall reject the notice of opposition as inadmissible unless those deficiencies have been remedied before expiry of the opposition period. If the opposition fee has not been paid within the opposition period, the notice of opposition shall be deemed not to have been entered. If the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.

If the Office finds that the notice of opposition does not comply with other provisions of the Regulation or of these Rules, it shall inform the opposing party accordingly and shall call upon him to remedy the deficiencies noted within a period of two months. If the deficiencies are not remedied before the time limit expires, the Office shall reject the notice of opposition as inadmissible.

Any decision to reject a notice of opposition as inadmissible under paragraphs 1 or 2 shall be communicated to the applicant.

#### Rule 19

##### Commencement of opposition proceedings

If the Office does not reject the notice of opposition in accordance with Rule 18, it shall communicate the opposition to the applicant and shall invite him to file his observations within such period as it may specify. The Office shall draw the applicant's attention to the fact that the opposition proceedings shall be deemed to commence two months after receipt of the communication, unless the applicant informs the Office, before the expiry of this period, that he withdraws his application or restricts the application to goods and services against which the opposition is not directed.

The Office may, pursuant to Rule 71, grant an extension of the period referred to in the second sentence of paragraph 1 where such request is presented jointly by the applicant and the opposing party.

There the application is withdrawn or restricted within the period specified in the second sentence of paragraph 1 or within any extension of that period granted under paragraph 2, the Office shall inform the opposing party accordingly and shall refund the opposition fee.

## Rule 20

### Examination of opposition

If the application is not withdrawn or restricted pursuant to Rule 19, the applicant shall file his observations within the period specified by the Office in its communication referred to in the first sentence of Rule 19 (1).

Where the notice of opposition does not contain particulars of the facts, evidence and arguments as referred to in Rule 16 (1) and (2), the Office shall call upon the opposing party to submit such particulars within a period specified by the Office. Any submission by the opposing party shall be communicated to the applicant who shall be given an opportunity to reply within a period specified by the Office.

If the applicant files no observations, the Office may give a ruling on the opposition on the basis of the evidence before it.

The observations filed by the applicant shall be communicated to the opposing party who shall be called upon by the Office, if it considers it necessary to do so, to reply within a period specified by the Office.

If, pursuant to Article 44 (1) of the Regulation, the applicant restricts the list of goods and services, the Office shall communicate this to the opposing party and call upon him, within such period as it may specify, to submit observations stating whether he maintains the opposition and, if so, against which of the remaining goods and services.

The Office may suspend any opposition proceeding where the opposition is based on an application for registration pursuant to Article 8 (2) (b) of the Regulation until a final decision is taken in that proceeding, or where other circumstances are such that such suspension is appropriate.

## Rule 21

### Multiple oppositions

Where a number of oppositions have been entered in respect of the same application for a Community trade mark, the Office may deal with them in one set of proceedings. The Office may subsequently decide to no longer deal with them in this way.

If a preliminary examination of one or more oppositions reveals that the Community trade mark for which an application for registration has been filed is possibly not eligible for registration in respect of some or all of the goods or services for which registration is sought, the Office may suspend the other opposition proceedings. The Office shall inform the remaining opposing parties of any relevant decisions taken during those proceedings which are continued.

Once a decision rejecting the application has become final, the oppositions on which a decision was deferred in accordance with paragraph 2 shall be deemed to have been disposed of and the opposing parties concerned shall be informed accordingly. Such disposition shall be considered to constitute a case which has not proceeded to judgment within the meaning of Article 81 (4) of the Regulation.

The Office shall refund 50 % of the opposition fee paid by each opposing party whose opposition is deemed to have been disposed of in accordance with paragraphs 1, 2 and 3.

## Rule 22

### Proof of use

Where, pursuant to Article 43 (2) or (3) of the Regulation, the opposing party has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time limit expires, the Office shall reject the opposition.

The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 3.

The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76 (1) (f) of the Regulation.

Where the evidence supplied pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opposing party to submit a translation of that evidence in that language, within a period specified by the Office.

## TITLE III

### REGISTRATION PROCEDURE

#### Rule 23

##### Registration of the trade mark

The registration fee provided for in Article 45 of the Regulation shall consist of a basic fee;

and

(b) a class fee for each class exceeding three in respect of which the mark is to be registered.

(2) Where no opposition has been entered or where any opposition entered has been finally disposed of by withdrawal, rejection or other disposition, the Office shall request the applicant to pay the registration fee within two months of receipt of the request.

(3) If the registration fee is not paid within due time, it may still be validly paid within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this period the additional fee specified in the Fees Regulations is paid.

(4) On receipt of the registration fee the mark applied for and the particulars referred to in Rule 84 (2) shall be recorded in the Register of Community trade marks.

(5) The registration shall be published in the Community Trade Marks Bulletin.

(6) The registration fee shall be refunded if the trade mark applied for is not registered.

#### Rule 24

##### Certificate of registration

The Office shall issue to the proprietor of the trade mark a certificate of registration which shall contain the entries in the Register provided for in Rule 84 (2) and a statement to the effect that those entries have been recorded in the Register.

The proprietor of the trade mark may request that certified or uncertified copies of the certificate of registration be supplied to him upon payment of a fee.

#### Rule 25

##### Alteration of the registration

An application for alteration of the registration pursuant to Article 48 (2) of the Regulation shall contain:

the registration number,

the name and the address of the proprietor of the mark in accordance with Rule 1 (1) (b);  
where the proprietor has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);  
the indication of the element in the representation of the mark to be altered and that element in its altered version;  
a representation of the mark as altered, in accordance with Rule 3.

The application shall be deemed not to have been filed until the required fee has been paid. If the fee has not been paid or has not been paid in full, the Office shall inform the applicant accordingly.

If the requirements governing the alteration of the registration are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application.

Where the registration of the alteration is challenged pursuant to Article 48 (3) of the Regulation, the provisions on opposition contained in the Regulation and in these Rules shall apply *mutatis mutandis*.

A single application may be made for the alteration of the same element in two or more registrations of the same proprietor. The required fee shall be paid in respect of each registration to be altered.

#### Rule 26

Change of the name or address of the proprietor of the Community trade mark or of his registered representative

A change of the name or address of the proprietor of the Community trade mark which is not an alteration of the Community trade mark pursuant to Article 48 (2) of the Regulation and which is not the consequence of a whole or partial transfer of the registered mark shall, at the request of the proprietor, be recorded in the register.

An application for the change of the name or address of the proprietor of the registered mark shall contain:

the registration number of the mark;  
the name and the address of the proprietor of the mark as recorded in the register;  
the indication of the name and address of the proprietor of the mark, as amended, in accordance with Rule 1 (1) (e).

where the proprietor has appointed a representative, the name and the business address of the representative, in accordance with Rule 1 (1) (e).

The application shall not be subject to payment of a fee.

A single application may be made for the change of the name or address in respect of two or more registrations of the same proprietor.

If the requirements governing the recording of a change are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period to be specified by the Office, the Office shall reject the application.

Paragraphs 1 to 5 shall apply *mutatis mutandis* to a change of the name or address of the registered representative.

Paragraphs 1 to 6 shall apply *mutatis mutandis* to applications for Community trade marks. The change shall be recorded in the files kept by the Office on the Community trade mark application.

#### Rule 27

Correction of mistakes and errors in the register and in the publication of the registration

Where the registration of the mark or the publication of the registration contains a mistake or error attributable to the Office, the Office shall correct the error or mistake of its own motion or at the request of the proprietor.

Where such a request is made by the proprietor, Rule 26 shall apply *mutatis mutandis*. The request shall not be subject to payment of a fee.

The Office shall publish the corrections made under this Rule.

#### Rule 28

Claiming seniority after registration of the Community trade mark

An application pursuant to Article 35 of the Regulation to obtain the seniority of one or more earlier registered trade marks as referred to in Article 34 of the Regulation, shall contain:

the registration number of the Community trade mark;

the name and address of the proprietor of the Community trade mark in accordance with Rule 1 (1) (b);

where the proprietor has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);

an indication of the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration, and the goods and services for which the earlier mark is registered;

an indication of the goods and services in respect of which seniority is claimed;

a copy of the relevant registration; the copy must be certified as an exact copy of the relevant registration by the competent authority.

If the requirements governing the claiming of seniority are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within a period specified by the Office, the Office shall reject the application.

The Office shall inform the Benelux Trade Mark Office or the central industrial property office of the Member State concerned of the effective claiming of seniority.

The President of the Office may determine that the material to be provided by the applicant may consist of less than is required under paragraph 1 (f), provided that the information required is available to the Office from other sources.

#### TITLE IV

#### RENEWAL

##### Rule 29

##### Notification of expiry

At least six months before expiry of the registration the Office shall inform the proprietor of the Community trade mark, and any person having a registered right, including a licence, in respect of the Community trade mark, that the registration is approaching expiry. Failure to give such notification shall not affect the expiry of the registration.

##### Rule 30 Renewal of registration

An application for renewal shall contain:

where the application is filed by the proprietor of the trade mark, his name and address in accordance with Rule 1 (1) (b);

where the application is filed by a person expressly authorized to do so by the proprietor of the mark, the name and address of that person and evidence that he is authorized to file the application;

where the applicant has appointed a representative, the name and business address of the representative in accordance with Rule 1 (1) (e);

the registration number;

an indication that renewal is requested for all the goods and services covered by the registration or, if the renewal is not requested for all the goods and services for which the mark is registered, an indication of those classes or those goods and services for which renewal is requested or those classes or those goods and services for which renewal is not requested, grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that classification to which that group of goods or services belongs and presented in the order of the classes of that classification.

The fees payable under Article 47 of the Regulation for the renewal of a Community trade mark shall consist of:

a basic fee;

a class fee for each class exceeding three in the list of classes in respect of which renewal is applied for as shown in paragraph 1 (e); and

where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 47 (3) of the Regulation, as specified in the Fees Regulation.

Where the application for renewal is filed within the time periods provided for in Article 47 (3) of the Regulation, but the other conditions governing renewal provided for in Article 47 of the Regulation and these Rules are not satisfied, the Office shall inform the applicant of the deficiencies found. If the application is filed by a person whom the proprietor of the trade mark has expressly authorized to do so, the proprietor of the trade mark shall receive a copy of the notification.

Where an application for renewal is not submitted or is submitted after expiry of the period provided for in the third sentence of Article 47 (3) of the Regulation, or if the fees are not paid or are paid only after the period in question has expired, or if the deficiencies are not remedied within that period, the Office shall determine that the registration has expired and shall so notify the proprietor of the Community trade mark and, where appropriate, the applicant and the person recorded in the Register as having rights in the mark. Where the fees paid are insufficient to cover all the classes of goods and services for which renewal is requested, such a determination shall not be made if it is clear which class or classes are to be covered. In the absence of other criteria, the Office shall take the classes into account in the order of classification.

Where the determination made pursuant to paragraph 4 has become final, the Office shall cancel the mark from the register. The cancellation shall take effect from the day following the day on which the existing registration expired.

Where the renewal fees provided for in paragraph 2 have been paid but the registration is not renewed, those fees shall be refunded.

## TITLE V

### TRANSFER, LICENCES AND OTHER RIGHTS, CHANGES

#### Rule 31

##### Transfer

An application for registration of a transfer under Article 17 of the Regulation shall contain:

the registration number of the Community trade mark;

particulars of the new proprietor in accordance with Rule 1 (1) (b);

where not all the registered goods or services are included in the transfer, particulars of the registered goods or services to which the transfer relates;

documents duly establishing the transfer in accordance with Article 17 (2) and (3) of the Regulation;

The application may contain, where applicable, the name and business address of the representative of the new proprietor, to be set out in accordance with Rule 1 (1) (e).

Transfers to any natural or legal persons who cannot be proprietors of Community trade marks pursuant to Article 5 of the Regulation shall not be registered.

The application shall not be deemed to have been filed until the required fee has been paid. If the fee is not paid or is not paid in full, the Office shall so notify the applicant.

It shall constitute sufficient proof of transfer under paragraph 1 (d):

that the application for registration of the transfer is signed by the registered proprietor or his representative and by the successor in title or his representative; or,

that the application, if submitted by the successor in title, is accompanied by a declaration, signed by the registered proprietor or his representative, that he agrees to the registration of the successor in title; or

that the application is accompanied by a completed transfer form or document, as specified in Rule 83 (1) (d), signed by the registered proprietor or his representative and by the successor in title or his representative.

Where the conditions applicable to the registration of a transfer, as laid down in Article 17 (1) to (4) of the Regulation, in paragraphs 1 to 4 above, and in other applicable Rules are not fulfilled, the Office shall notify the applicant of the deficiencies. If the deficiencies are not remedied within a period specified by the Office, it shall reject the application for registration of the transfer.

A single application for registration of a transfer may be submitted for two or more marks, provided that the registered proprietor and the successor in title are the same in each case.

Paragraphs 1 to 7 shall apply *mutatis mutandis* to applications for Community trade marks. The transfer shall be recorded in the files kept by the Office concerning the Community trade mark application.

## Rule 32

### Partial Transfers

Where the application for registration of a transfer relates only to some of the goods and services for which the mark is registered, the application shall contain an indication of the goods and services to which the partial transfer relates.

The goods and services in the original registration shall be distributed between the remaining registration and the new registration so that the goods and services in the remaining registration and the new registration shall not overlap.

Rule 31 shall apply *mutatis mutandis* to applications for registrations of a partial transfer.

The Office shall establish a separate file for the new registration, which shall consist of a complete copy of the file of the original registration and the application for registration of the partial transfer; a copy of that application shall be included in the file of the remaining registration. The Office shall also assign a new registration number to the new registration.

Any application made by the original proprietor pending with regard to the original registration shall be deemed to be pending with regard to the remaining registration and the new registration. Where such application is subject to the payment of fees and these fees have been paid by the original proprietor, the new proprietor shall not be liable to pay any additional fees with regard to such application.

## Rule 33

### Registration of licences and other rights

Rule 31 (1) (a) (b) and (c), (2), (4) and (7) shall apply mutatis mutandis to the registration of the grant or transfer of a licence, to registration of the creation or transfer of a right in rem in respect of a Community trade mark, and to registration of enforcement measures. However, where a Community trade mark is involved in bankruptcy or like proceedings, the request of the competent national authority for an entry in the register to this effect shall not be subject to payment of a fee.

Where the Community trade mark is licensed for only part of the goods and services for which the mark is registered, or for only a part of the Community, or for a limited period of time, the application for registration shall indicate the goods and services or the part of the Community or the time period for which the licence is granted.

Where the conditions applicable to registration, as laid down in Articles 19, 20 or 22 of the Regulation, in paragraphs 1 and 2 above, and the other applicable Rules are not fulfilled, the Office shall notify the applicant of the irregularity. If the irregularity is not corrected within a period specified by the Office, it shall reject the application for registration.

Paragraphs 1, 2 and 3 shall apply mutatis mutandis to applications for Community trade marks. Licences, rights in rem and enforcement measures shall be recorded in the files kept by the Office concerning the Community trade mark application.

#### Rule 34

##### Special provisions for the registration of a licence

A licence in respect of a Community trade mark shall be recorded in the Register as an exclusive licence if the proprietor of the trade mark or the licensee so request.

A licence in respect of a Community trade mark shall be recorded in the Register as a sub-licence where it is granted by a licensee whose licence is recorded in the Register.

A licence in respect of a Community trade mark shall be recorded in the Register as a licence limited as to the goods and services or as a territorially limited licence if it is granted for only a part of the goods or services for which the mark is registered or if it is granted only for a part of the Community.

A licence in respect of a Community trade mark shall be recorded in the Register as a temporary licence if it is granted for a limited period of time.

#### Rule 35

##### Cancellation or modification of the registration of licences and other rights

A registration effected under Rule 33 (1) shall be cancelled at the request of one of the persons concerned.

The application shall contain:

the registration number of the Community trade mark;

and

(b) particulars of the right whose registration is to be cancelled.

(3) Application for cancellation of the registration of a licence or another right shall not be deemed to have been filed until the required fee has been paid. If the fee is not paid or is not paid in full, the Office shall so notify the applicant. However, the request of the competent national authority for the cancellation of an entry where a Community trade mark is involved in bankruptcy or like proceedings shall not be subject to payment of a fee.

(4) The application shall be accompanied by documents showing that the registered right no longer exists or by a statement by the licensee or the holder of another right, to the effect that he consents to cancellation of the registration.

(5) Where the requirements for cancellation of the registration are not satisfied, the Office shall notify the applicant of the irregularity. If the irregularity is not corrected within a period specified by the Office, it shall reject the application for cancellation of the registration.

(6) Paragraphs 1, 2, 4 and 5 shall apply mutatis mutandis to a request for the modification of a registration effected under Rule 33 (1).

(7) Paragraphs 1 to 6 shall apply mutatis mutandis to entries made in the files pursuant to Rule 33 (4).

## TITLE VI

### SURRENDER

#### Rule 36

##### Surrender

A declaration of surrender pursuant to Article 49 of the Regulation shall contain:

the registration number of the Community trade mark;

the name and address of the proprietor in accordance with Rule 1 (1) (b);

where a representative has been appointed, the name and business address of the representative in accordance with Rule 1 (1) (e);

where surrender is declared only for some of the goods and services for which the mark is registered, the goods and services for which the surrender is declared or the goods and services for which the mark is to remain registered.

Where a right of a third party relating to the Community trade mark is entered in the register, it shall be sufficient proof of his agreement to the surrender that a declaration of consent to the surrender is signed by the proprietor of that right or his representative. Where a licence has been registered, surrender shall be registered three months after the date on which the proprietor of the Community trade mark satisfies the Office that he has informed the licensee of his intention to surrender it. If the proprietor proves to the Office before the expiry of that period that the licensee has given his consent, the surrender shall be registered forthwith.

If the requirements governing surrender are not fulfilled, the Office shall communicate the deficiencies to the declarant. If the deficiencies are not remedied within a period to be specified by the Office, the Office shall reject the entry of the surrender in the Register.

## TITLE VII

### REVOCATION AND INVALIDITY

#### Rule 37

##### Application for revocation or for a declaration of invalidity

An application to the Office for revocation or for a declaration of invalidity pursuant to Article 55 of the Regulation shall contain:

as concerns the registration in respect of which revocation or a declaration of invalidity is sought;

the registration number of the Community trade mark in respect of which revocation or a declaration of invalidity is sought;

the name and address of the proprietor of the Community trade mark in respect of which revocation or a declaration of invalidity is sought;

a statement of the registered goods and services in respect of which revocation or a declaration of invalidity is sought;

as regards the grounds on which the application is based,

in the case of an application pursuant to Article 50 or Article 51 of the Regulation, a statement of the grounds on which the application for revocation or a declaration of invalidity is based;

in the case of an application pursuant to Article 52 (1) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and if necessary particulars showing that the applicant is entitled to adduce the earlier right as grounds for invalidity;

in the case of an application pursuant to Article 52 (2) of the Regulation, particulars of the right on which the application for a declaration of invalidity is based and particulars showing that the applicant is the proprietor of an earlier right as referred to in Article 52 (2) of the Regulation or that he is entitled under the national law applicable to lay claim to that right;

an indication of the facts, evidence and arguments presented in support of those grounds;

as concerns the applicant,

his name and address in accordance with Rule 1 (1) (b);

if the applicant has appointed a representative, the name and the business address of the representative, in accordance with Rule 1 (1) (e).

#### Rule 38

##### Languages used in revocation or invalidity proceedings

Where the application for revocation or for a declaration of invalidity is not filed in the language of the application for the registration of the Community trade mark, if that language is one of the languages of the Office, or in the second language indicated when the application was filed, the applicant for revocation or for a declaration of invalidity shall file a translation of his application in one of those two languages within a period of one month from the filing of his application.

Where the evidence in support of the application is not filed in the language of the revocation or invalidity proceedings, the applicant shall file a translation of that evidence into that language within a period of two months after the filing of such evidence.

Where the applicant for revocation or for a declaration of invalidity or the proprietor of the Community trade mark inform the Office before the expiry of a period of two months from receipt by the Community trade mark proprietor of the communication referred to in Rule 40 (1), that they have agreed on a different language of proceedings pursuant to Article 115 (7) of the Regulation, the applicant shall, where the application was not filed in that language, file a translation of the application in that language within a period of one month from the said date.

#### Rule 39

Rejection of the application for revocation or for declaration of invalidity as inadmissible

If the Office finds that the application does not comply with Article 55 of the Regulation, Rule 37 or any other provision of the Regulation or these Rules, it shall inform the applicant accordingly and shall call upon him to remedy the deficiencies found within such period as it may specify. If the deficiencies are not remedied before expiry of the time limit, the Office shall reject the application as inadmissible.

Where the Office finds that the required fees have not been paid, it shall inform the applicant accordingly and shall inform him that the application will be deemed not to have been filed if the required fees are not paid within a period specified by the Office. If the required fees are paid after expiry of the period specified by the Office, they shall be refunded to the applicant.

Any decision to reject an application for revocation or for a declaration of invalidity under paragraph 1 shall be communicated to the applicant. Where the application is considered not to have been filed pursuant to paragraph 2, the applicant shall be informed accordingly.

Rule 40

Examination of the application for revocation or for a declaration of invalidity

If the Office does not reject the application in accordance with Rule 39, it shall communicate such application to the proprietor of the Community trade mark and shall request him to file his observations within such period as it may specify.

If the proprietor of the Community trade mark files no observations, the Office may decide on the revocation or invalidity on the basis of the evidence before it.

Any observations filed by the proprietor of the Community trade mark shall be communicated to the applicant, who shall be requested by the Office, if it sees fit, to reply within a period specified by the Office.

All communications under Article 56 (1) of the Regulation and all observations filed in this respect shall be sent to the parties concerned.

If the applicant, under Article 56 (2) or (3) of the Regulation, has to furnish proof of use or proof that there are proper reasons for non-use, Rule 22 shall apply *mutatis mutandis*.

Rule 41

Multiple applications for revocation or for a declaration of invalidity

Where a number of applications for revocation or for a declaration of invalidity have been filed relating to the same Community trade mark, the Office may deal with them in one set of proceedings. The Office may subsequently decide no longer to deal with them in this way.

Rule 21 (2) (3) and (4) shall apply mutatis mutandis.

## TITLE VIII

### COMMUNITY COLLECTIVE MARKS

#### Rule 42

##### Application of provisions

The provisions of these Rules shall apply to Community collective marks, subject to Rule 43.

#### Rule 43

##### Regulation governing Community collective marks

Where the application for a Community collective trade mark does not contain the regulations governing its use pursuant to Article 65 of the Regulation, those regulations shall be submitted to the Office within a period of two months after the date of filing.

The regulations governing Community collective marks shall specify:

the name of the applicant and his office address;

the object of the association or the object for which the legal person governed by public law is constituted;

the bodies authorized to represent the association or the said legal person;

the conditions for membership;

the persons authorized to use the mark;

where appropriate, the conditions governing use of the mark, including sanctions;

where appropriate, the authorization referred to in the second sentence of Article 65 (2) of the Regulation.

## TITLE IX

### CONVERSION

#### Rule

#### 44

##### Application for conversion

An application for conversion of a Community trade mark application or a registered Community trade mark into a national trademark application pursuant to Article 108 of the Regulation shall contain:

the name and the address of the applicant for conversion in accordance with Rule 1 (1) (b);

where the applicant for conversion has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);

the filing number of the Community trade mark application or the registration number of the Community trade mark;

the date of filing of the Community trade mark application or the Community trade mark and, where applicable, particulars of the claim to priority for the Community trade mark application or the Community trade mark pursuant to Articles 30 and 33 of the Regulation and particulars of the claim to seniority pursuant to Articles 34 and 35 of the Regulation;

a representation of the mark as contained in the application or as registered;

the specification of the Member State or the Member States in respect of which conversion is requested;

where the request does not relate to all of the goods and services for which the application has been filed or for which the trade mark has been registered, an indication of the goods and services for which conversion is requested, and, where conversion is requested in respect of more than one Member State and the list of goods and services is not the same for all Member States, an indication of the respective goods and services for each Member State;

where conversion is requested pursuant to Article 108 (4) of the Regulation, an indication to that effect;

where conversion is requested pursuant to Article 108 (5) of the Regulation following a withdrawal of an application for registration, an indication to that effect, and the date on which the application for registration was withdrawn;

where conversion is requested pursuant to Article 108 (5) of the Regulation following a failure to renew the registration, an indication to that effect, and the date on which the period of protection has expired, the period of three months provided for in Article 108 (5) of the Regulation shall begin to run on the day following the last day on which the request for renewal can be presented pursuant to Article 47 (3) of the Regulation;

where conversion is requested pursuant to article 108 (6) of the Regulation, an indication to that effect, the date on which the decision of the national court has become final, and a copy of that decision.

Where a copy of a court decision pursuant to paragraph 1 (k) is required, that copy may be submitted in the language in which the decision was given.

#### Rule 45

##### Examination of application for conversion

Where the application for conversion does not comply with the requirements of Article 108 (1) of the Regulation or was not filed within the relevant period of three months, the Office shall reject it.

Where the conversion fee has not been paid within the relevant period of three months, the Office shall inform the applicant that the application for conversion shall be deemed not to have been filed.

Where the other requirements governing conversion as provided for in Rule 44 and in other Rules governing such applications are not fulfilled, the Office shall inform the applicant accordingly and invite him to remedy the deficiency within a period specified by the Office. If the deficiencies are not remedied within that period, the Office shall reject the application for conversion.

#### Rule 46

##### Publication of application for conversion

Where the application for conversion relates to a Community trade mark application which has already been published in the Community Trade Mark Bulletin pursuant to Article 40 of the Regulation or where the application for conversion relates to a Community trade mark, the application for conversion shall be published in the Community Trade Marks Bulletin.

The publication of the application for conversion shall contain:

the filing number or the registration number of the trade mark in respect of which conversion is requested;

a reference to the previous publication of the application or the registration in the Community Trade marks Bulletin;

an indication of the Member State or Member States in respect of which conversion has been requested;

where the request does not relate to all of the goods and services for which the application has been filed or for which the trade mark has been registered, an indication of the goods and services for which conversion is requested;

where conversion is requested in respect of more than one Member State and the list of goods and services is not the same for all Member States, an indication of the respective goods and services for each Member State;

the date of the application for conversion.

#### Rule 47

##### Transmission to central industrial property offices of the Member States

Where the application for conversion complies with the requirements of the Regulation and these Rules, the Office shall transmit without delay the application for conversion to the central industrial property offices of the Member States specified therein, including the Benelux Trade Mark Office. The Office shall inform the applicant of the date of transmission.

## TITLE X

### APPEALS

#### Rule 48

##### Content of the notice of appeal

The notice of appeal shall contain:

the name and address of the appellant in accordance with rule 1 (1) (b);

where the appellant has appointed a representative, the name and the business address of the representative in accordance with Rule 1 (1) (e);

a statement identifying the decision which is contested and the extent to which amendment or cancellation of the decision is requested.

The notice of appeal shall be filed in the language of the proceedings in which the decision subject to the appeal was taken.

#### Rule 49

##### Rejection of the appeal as inadmissible

If the appeal does not comply with Articles 57, 58 and 59 of the Regulation and Rule 48 (1) (c) and (2), the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 59 of the Regulation has expired.

If the Board of Appeal finds that the appeal does not comply with other provisions of the Regulation or other provisions of these Rules, in particular Rule 48 (1) (a) and (b), it shall inform the appellant accordingly and shall request him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible.

If the fee for appeal has been paid after expiry of the period for the filing of appeal pursuant to Article 59 of the Regulation, the appeal shall be deemed not to have been filed and the appeal fee shall be refunded to the appellant.

## Rule 50

### Examination of appeals

Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.

The Board of Appeal's decision shall contain:

a statement that it is delivered by the Board;

the date when the decision was taken;

the names of the Chairman and of the other members of the Board of Appeal taking part;

the name of the competent employee of the registry;

the names of the parties and of their representatives;

a statement of the issues to be decided;

a summary of the facts;

the reasons;

the order of the Board of Appeal, including, where necessary, a decision on costs.

The decision shall be signed by the Chairman and the other members of the Board of Appeal and by the employee of the registry of the Board of Appeal.

## Rule 51

### Reimbursement of appeal fees

The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the event of interlocutory

revision, reimbursement shall be ordered by the department whose decision has been impugned, and in other cases by the Board of Appeal.

## TITLE XI

### GENERAL PROVISIONS

#### Part A

##### Decisions and communications of the Office

##### Rule 52

###### Form of decisions

Decisions of the Office shall be in writing and shall state the reasons on which they are based. Where oral proceedings are held before the Office, the decision may be given orally. Subsequently, the decision in writing shall be notified to the parties.

Decisions of the Office which are open to appeal shall be accompanied by a written communication indicating that notice of appeal must be filed in writing at the Office within two months of the date of notification of the decision from which appeal is to be made. The communications shall also draw the attention of the parties to the provisions laid down in Articles 57, 58 and 59 of the Regulation. The parties may not plead any failure to communicate the availability proceedings.

##### Rule 53

###### Correction of errors in decisions

In decisions of the Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected. They shall be corrected by the department which took the decision, acting of its own motion or at the request of an interested party.

##### Rule 54

###### Noting of loss of rights

If the Office finds that the loss of any rights results from the Regulation or these Rules without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 77 of the Regulation, and shall draw his attention to the substance of paragraph 2 of this Rule.

If the person concerned considers that the finding of the Office is inaccurate, he may, within two months after notification of the communication referred to in paragraph 1, apply for a decision on the matter by the Office. Such decision shall be given only if the Office disagrees

with the person requesting it; otherwise the Office shall amend its finding and inform the person requesting the decision.

#### Rule 55

Signature, name, seal

Any decision, communication or notice from the Office shall indicate the department or division of the Office as well as the name or the names of the official or officials responsible. They shall be signed by the official or officials, or, instead of a signature, carry a printed or stamped seal of the Office.

The President of the Office may determine that other means of identifying the department or division of the Office and the name of the official or officials responsible or an identification other than a seal may be used where decisions, communications or notices are transmitted by telecopier or any other technical means of communication.

#### Part B

Oral proceedings and taking of evidence

#### Rule 56

Summons to oral proceedings

The parties shall be summoned to oral proceedings provided for in Article 75 of the Regulation and their attention shall be drawn to paragraph 3 of this Rule. At least one month's, notice of the summons shall be given unless the parties agree to a shorter period.

When issuing the summons, the Office shall draw attention to the points which in its opinion need to be discussed in order for the decision to be taken.

If a party who has been duly summoned to oral proceedings before the Office does not appear as summoned, the proceedings may continue without him.

#### Rule 57

Taking of evidence by the Office

Where the Office considers it necessary to hear the oral evidence of parties, of witnesses or of experts or to carry out an inspection, it shall take a decision to that end, stating the means by which it intends to obtain evidence, the relevant facts to be proved and the date, time and place of hearing or inspection. If oral evidence of witnesses and experts is requested by a party, the decision of the Office shall determine the period of time within which the party

filing the request must make known to the Office the names and addresses of the witnesses and experts whom the party wishes to be heard.

The period of notice given in the summons of a party, witness or expert to give evidence shall be at least one month, unless they agree to a shorter period. The summons shall contain:

an extract from the decision mentioned in paragraph 1, indicating in particular the date, time and place of the hearing ordered and stating the facts regarding which the parties, witnesses and experts are to be heard;

the names of the parties to proceedings and particulars of the rights which the witnesses or experts may invoke under Rule 59 (2) to (5).

## Rule 58

### Commissioning of experts

The Office shall decide in what form the report made by an expert whom it appoints shall be submitted.

The terms of reference of the expert shall include:

a precise description of his task;

the time limit laid down for the submission of the expert report;

the names of the parties to the proceedings;

particulars of the claims which he may invoke under Rule 59 (2), (3) and (4).

A copy of any written report shall be submitted to the parties.

The parties may object to an expert on grounds of incompetence or on the same grounds as those on which objection may be made to an examiner or to a member of a Division or Board of Appeal pursuant to Article 132 (1) and (3) of the Regulation. The department of the Office concerned shall rule on the objection.

## Rule 59

### Costs of taking of evidence

The taking of evidence by the Office may be made conditional upon deposit with it, by the party who has requested the evidence to be taken, of a sum which shall be fixed by reference to an estimate of the costs.

Witnesses and experts who are summoned by and appear before the Office shall be entitled to reimbursement of reasonable expenses for travel and subsistence. An advance for these expenses may be granted to them by the Office. The first sentence shall apply also to

witnesses and experts who appear before the Office without being summoned by it and are heard as witnesses or experts.

Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. These payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks, where such witnesses and experts have been summoned by the Office of its own initiative.

The amounts and the advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the President of the Office and shall be published in the Official Journal of the Office. The amounts shall be calculated on the same basis as the compensation and salaries received by officials in grades A4 to A8 as laid down in the Staff Regulations of Officials of the European Communities and Annex VII thereto.

Final liability for the amounts due or paid pursuant to paragraphs 1 to 4 shall lie with:

the Office where the Office, at its own initiative, considered it necessary to hear the oral evidence of witnesses or experts;

or

(b) the party concerned where that party requested the giving of oral evidence by witnesses or experts, subject to the decision on apportionment and fixing of costs pursuant to Articles 81 and 82 of the Regulation and Rule 94. Such party shall reimburse the Office for any advances duly paid.

#### Rule 60

##### Minutes of oral proceedings and of evidence

Minutes of oral proceedings or the taking of evidence shall be drawn up, containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.

The minutes of the testimony of a witness, expert or party shall be read out or submitted to him so that he may examine them. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. Where his approval is not given, his objections shall be noted.

The minutes shall be signed by the employee who drew them up and by the employee who conducted the oral proceedings or taking of evidence.

The parties shall be provided with a copy of the minutes.

Upon request, the Office shall make available to the parties transcripts of recordings of the oral proceedings, in typescript or in any other machine-readable form. The release under the first sentence of the oral proceedings shall be subject to the payment of the costs incurred by the Office in making such transcript. The amount to be charged shall be determined by the President of the Office.

## Part C

### Notifications

#### Rule 61

##### General provisions on notifications

In proceedings before the Office, any notifications to be made by the Office shall take the form of the original document, of a copy thereof certified by, or bearing the seal of, the Office or of a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.

Notifications shall be made

by post in accordance with Rule 62;

by hand delivery in accordance with Rule 63;

by deposit in a post box at the Office in accordance with Rule 64;

by telecopier and other technical means in accordance with Rule 65;

by public notification in accordance with Rule 66.

#### Rule 62

##### Notification by post

Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of the Office shall be notified by registered letter with advice of delivery. Decisions and communications subject to some other time limit shall be notified by registered letter, unless the President of the Office determines otherwise. All other communications shall be ordinary mail.

Notifications in respect of addresses having neither their domicile nor their principal place of business nor an establishment in the Community and who have not appointed a representative in accordance with Article 88 (2) of the Regulation shall be effected by posting the document

requiring notification by ordinary mail to the last address of the addressee known to the Office. Notification shall be deemed to have been effected when the posting has taken place.

Where notification is effected by registered letter, whether or not with advice of delivery, this shall be deemed to be delivered to the addressee on the 10th day following that of its posting, unless the letter has failed to reach the addressee or has reached him at a later date. In the event of any dispute, it shall be for the Office to establish that the letter has reached its destination or to establish the date on which it was delivered to the addressee, as the case may be.

Notification by registered letter, with or without advice of delivery, shall be deemed to have been effected even if the addressee refuses to accept the letter.

To the extent that notification by post is not covered by paragraphs 1 to 4, the law of the State on the territory of which notification is made shall apply.

#### Rule 63

##### Notification by hand delivery

Notification may be effected on the premises of the Office by hand delivery of the document to the addressee, who shall on delivery acknowledge its receipt.

#### Rule 64

##### Notification by deposit in a post box at the Office

Notification may also be effected to addressees who have been provided with a post box at the Office, by depositing the document therein. A written notification of deposit shall be inserted in the files. The date of deposit shall be recorded on the document. Notification shall be deemed to have taken place on the fifth day following deposit of the document in the post box at the Office.

#### Rule 65

##### Notification by telecopier and other technical means

Notification by telecopier shall be effected by transmitting either the original or a copy, as provided for in Rule 61 (1), of the document to be notified. The details of such transmission shall be determined by the President of the Office.

Details of notification by other technical means of communication shall be determined by the President of the Office.

#### Rule 66

## Public notification

If the address of the addressee cannot be established, or if notification in accordance with Rule 62 (1) has proved to be impossible even after a second attempt by the Office, notification shall be effected by public notice. Such notice shall be published at least in the Community Trade Marks Bulletin.

The President of the Office shall determine how the public notice is to be given and shall fix the beginning of the one-month period on the expiry of which the document shall be deemed to have been notified.

## Rule 67

### Notification to representatives

If a representative has been appointed or where the applicant first named in a common application is considered to be the common representative pursuant to Rule 75 (1), notifications shall be addressed to that appointed or common representative.

If several representatives have been appointed for a single interested party, notification to any one of them shall be sufficient, unless a specific address for service has been indicated in accordance with Rule 1 (1) (e).

If several interested parties have appointed a common representative, notification of a single document to the common representative shall be sufficient.

## Rule 68

### Irregularities in notification

Where a document has reached the addressee, if the Office is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the Office as the date of receipt.

## Rule 69

### Notification of documents in the case of several parties

Documents emanating from parties which contain substantive proposals, or a declaration of withdrawal of a substantive proposal, shall be notified to the other parties as a matter of course. Notification may be dispensed with where the document contains no new pleadings and the matter is ready for decision.

## Part D

## Timelimits

### Rule 70

#### Calculation of time limits

Periods shall be laid down in terms of full years, months, weeks or days.

Calculation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where that procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.

Where a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred. Where the relevant month has no day with the same number the period shall expire on the last day of that month.

Where a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred. Where the day on which the said event occurred was the last day of a month or where the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

Where a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred.

### Rule 71

#### Duration of time limits

Where the Regulation or these Rules provide for a period to be specified by the Office, such period shall, when the party concerned has its domicile or its principal place of business or an establishment within the Community, be not less than one month, or, when those conditions are not fulfilled, not less than two months, and no more than six months. The Office may, when this is appropriate under the circumstances, grant an extension of a period specified if such extension is requested by the party concerned and the request is submitted before the original period expired.

Where there are two or more parties, the Office may extend a period subject to the agreement of the other parties.

## Rule 72

### Expiry of time limits in special cases

If a time limit expires on a day on which the Office is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered in the locality in which the Office is located, the time limit shall extend until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered. The days referred to in the first sentence shall be as determined by the President of the Office before the commencement of each calendar year.

If a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Member State or between a Member State and the Office, the time limit shall extend until the first day following the end of the period of interruption or dislocation, for parties having their residence or registered office in the State concerned or who have appointed representatives with a place of business in that State. In the event of the Member State concerned being the State in which the Office is located, this provision shall apply to all parties. The duration of the abovementioned period shall be as determined by the President of the Office.

Paragraphs 1 and 2 shall apply *mutatis mutandis* to the time limits provided for in the Regulation or these Rules in the case of transactions to be carried out with the competent authority within the meaning of Article 25 (1) (b) of the Regulation.

If an exceptional occurrence such as natural disaster or strike interrupts or dislocates the proper functioning of the Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month after the notification of the delayed communication. The date of commencement and the end of any such interruption or dislocation shall be as determined by the President of the Office.

## Part E

### Interruption of proceedings

## Rule 73

### Interruption of proceedings

Proceedings before the Office shall be interrupted:

in the event of the death or legal incapacity of the applicant for or proprietor of a Community trade mark or of the person authorized by national law to act on his behalf. To the extent that

the above events do not affect the authorization of a representative appointed under Article 89 of the Regulation, proceedings shall be interrupted only on application by such representative; in the event of the applicant for or proprietor of a Community trade mark, as a result of some action taken against his property, being prevented for legal reasons from continuing the proceedings before the Office;

in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a Community trade mark or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the Office.

When, in the cases referred to in paragraph 1 (a) and (b), the Office has been informed of the identity of the person authorized to continue the proceedings before the Office, the Office shall communicate to such person and to any interested third parties that the proceedings shall be resumed as from a date to be fixed by the Office.

In the case referred to in paragraph 1 (c), the proceedings shall be resumed when the Office has been informed of the appointment of a new representative of the applicant or when the Office has notified to the other parties the communication of the appointment of a new representative of the proprietor of the Community trade mark. If, three months after the beginning of the interruption of the proceedings, the Office has not been informed of the appointment of a new representative, it shall inform the applicant for or proprietor of the Community trade mark:

where Article 88 (2) of the Regulation is applicable, that the Community trade mark application will be deemed to be withdrawn if the information is not submitted within two months after this communication is notified; or

where Article 88 (2) of the Regulation is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the Community trade mark as from the date on which this communication is notified.

The time limits, other than the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the Community trade mark at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed.

## Part F

### Waiving of enforced recovery procedures

#### Rule 74

### Waiving of enforced recovery procedures

The President of the Office may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain.

## Part G

### Representation

#### Rule 75

##### Appointment of a common representative

If there is more than one applicant and the application for a Community trade mark does not name a common representative, the applicant first named in the application shall be considered to be the common representative. However, if one of the applicants is obliged to appoint a professional representative, such representative shall be considered to be the common representative unless the applicant named first in the application has appointed a professional representative. The same shall apply *mutatis mutandis* to third parties acting in common in filing notice of opposition or applying for revocation or for a declaration of invalidity, and to joint proprietors of a Community trade mark.

If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a common representative, paragraph 1 shall apply. If such application is not possible, the Office shall require such persons to appoint a common representative within two months. If this request is not complied with, the Office shall appoint the common representative.

#### Rule 76

##### Authorizations

Representatives acting before the Office must file with it a signed authorization for inclusion in the files. The authorization may cover one or more applications or one or more registered trade marks.

A general authorization enabling a representative to act in respect of all trade mark transactions of the party giving the authorization may be filed.

The authorization may be filed in any language of the Office and in the language of the proceedings if that language is not one of the languages of the Office.

Where the appointment of a representative is communicated to the Office, the necessary authorization shall be filed within a period specified by the Office. If the authorization is not filed in due time, proceedings shall be continued with the represented person. Any procedural

steps other than the filing of the application taken by the representative shall be deemed not to have been taken if the represented person does not approve them. The application of Article 88 (2) of the Regulation shall remain unaffected.

Paragraphs 1 to 3 shall apply *mutatis mutandis* to a document withdrawing an authorization.

Any representative who has ceased to be authorized shall continue to be regarded as the representative until the termination of his authorization has been communicated to the Office.

Subject to any provisions to the contrary contained therein, an authorization shall not terminate *vis-à-vis* the Office upon the death of the person who gave it.

Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorizations, act either jointly or singly.

The authorization of an association of representatives shall be deemed to be an authorization of any representative who can establish that he practises within that association.

#### Rule 77

##### Representation

Any notification or other communication addressed by the Office to the duly authorized representative shall have the same effect as if it had been addressed to the represented person.

Any communication addressed to the Office by the duly authorized representative shall have the same effect as if it originated from the represented person.

#### Rule 78

##### Amendment of the list of professional representatives

The entry of a professional representative in the list of professional representatives, as referred to in Article 89 of the Regulation, shall be deleted at his request.

The entry of a professional representative shall be deleted automatically:

in the event of the death or legal incapacity of the professional representative;

where the professional representative is no longer a national of a Member State, unless the President of the Office has granted an exemption under Article 89 (4) (b) of the Regulation;

where the professional representative no longer has his place of business or employment in the Community;

where the professional representative no longer possesses the entitlement referred to in the first sentence of Article 89 (2) (c) of the Regulation.

The entry of a professional representative shall be suspended of the Office's own motion where his entitlement to represent natural or legal persons before the central industrial property office of the Member State as referred to in the first sentence of Article 89 (2) (c) has been suspended.

A person whose entry has been deleted shall, upon request pursuant to Article 89 (3) of the Regulation, be reinstated in the list of professional representatives if the conditions for deletion no longer exist.

The Benelux Trade Mark Office and the central industrial property offices of the Member States concerned shall, where they are aware thereof, promptly inform the Office of any relevant events under paragraphs 2 and 3.

The amendments of the list of professional representatives shall be published in the Official Journal of the Office.

## Part H

### Written communications and forms

#### Rule 79

##### Communication in writing or by other means

Applications for the registration of a Community trade mark as well as any other application provided for in the Regulation and all other communications addressed to the Office shall be submitted as follows:

by submitting a signed original of the document in question at the Office, such as by post, personal delivery, or by any other means; annexes to documents submitted need not be signed;

by transmitting a signed original by telecopier in accordance with Rule 80;

by telex or telegram in accordance with Rule 81;

by transmitting the contents of the communication by electronic means in accordance with Rule 82.

#### Rule 80

##### Communication by telecopier

Where an application for registration of a trade mark is submitted to the Office by telecopier and the application contains a reproduction of the mark pursuant to Rule 3 (2) which does not satisfy the requirements of that Rule, the required number of original reproductions shall be

submitted to the Office in accordance with Rule 79 (a). Where the reproductions are received by the Office within a period of one month from the date of the receipt of the telecopy by the Office, the application shall be deemed to have been received by the Office on the date on which the telecopy was received by the Office. Where the reproductions are received by the Office after the expiry of that period and the reproduction is necessary for the obtaining of a filing date, the application shall be deemed to have been received by the Office on the date on which the reproductions were received by the Office.

Where a communication received by telecopier is incomplete or illegible, or where the Office has reasonable doubts as to the accuracy of the transmission, the Office shall inform the sender accordingly and shall invite him, within a period to be specified by the Office, to retransmit the original by telecopy or to submit the original in accordance with Rule 79 (a). Where this request is complied with within the period specified, the date of the receipt of the retransmission or of the original shall be deemed to be the date of the receipt of the original communication, provided that where the deficiency concerns the granting of a filing date for an application to register a trade mark, the provisions on the filing date shall apply. Where the request is not complied with within the period specified, the communication shall be deemed not to have been received.

Any communication submitted to the Office by telecopier shall be considered to be duly signed if the reproduction of the signature appears on the printout produced by the telecopier.

The President of the Office may determine additional requirements of communication by telecopier, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

## Rule 81

### Communication by telex or telegram

Where an application for registration of a trade mark is submitted to the Office by telex or by telegram and the application contains a reproduction of the mark pursuant to Rule 3 (2), Rule 80 (1) shall apply *mutatis mutandis*.

Where a communication is submitted by telex or telegram, Rule 80 (2) shall apply *mutatis mutandis*.

Where a communication is submitted by telex or telegram, the indication of the name of the sender shall be deemed equivalent to the signature.

## Rule 82

## Communication by electronic means

Where an application for registration of a trademark is submitted by electronic means and the application contains a reproduction of the mark pursuant to Rule 3 (2), Rule 80 (1) shall apply *mutatis mutandis*.

Where a communication is sent by electronic means, Rule 80 (2) shall apply *mutatis mutandis*.

Where a communication is sent to the Office by electronic means, the indication of the name of the sender shall be deemed to be equivalent to the signature.

The President of the Office shall determine the requirements as to communication by electronic means, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

## Rule 83

### Forms

The Office shall make available free of charge forms for the purpose of:

filing an application for a Community trade mark;

entering opposition to registration of a Community trade mark;

applying for an amendment of an application or a registration, for correction of names and addresses and of mistakes and errors;

applying for the registration of a transfer and the transfer form and transfer document provided for in Rule 31 (5);

applying for the registration of a licence;

applying for renewal of the registration of a Community trade mark;

applying for revocation or for a declaration of invalidity of a Community trade mark;

applying for *restitutio in integrum*;

making an appeal;

authorizing a representative, in the form of an individual authorization and in the form of a general authorization.

The Office may make other forms available free of charge.

The Office shall make available the forms referred to in paragraphs 1 and 2 in all the official languages of the Community.

The Office shall place the forms at the disposal of the Benelux Trade Mark Office and the Member States' central industrial property offices free of charge.

The Office may also make available the forms in machine-readable form.

Parties to proceedings before the Office shall use the forms provided by the Office, or copies of these forms, or forms with the same content and format as these forms, such as forms generated by means of electronic data processing.

Forms shall be completed in such a manner as to permit an automated input of the content into a computer, such as by character recognition or scanning.

## Part I

### Information of the public

#### Rule 84

##### Register of Community Trade Marks

The Register of Community Trade Marks may be maintained in the form of an electronic database.

The Register of Community Trade Marks shall contain the following entries:

the date of filing the application;

the file number of the application;

the date of the publication of the application;

the name, the address and the nationality of the applicant and the State in which he is domiciled or has his seat or establishment;

the name and business address of the representative, other than a representative falling within the first sentence of Article 88 (3) of the Regulation; where there is more than one representative, only the name and business address of the first named representative, followed by the words and others, shall be recorded; where an association of representatives is appointed, only the name and address of the association shall be recorded;

the reproduction of the mark, with indications as to its nature, unless it is a mark falling under Rule 3 (1); where the registration of the mark is in colour, the indication 'in colour' with an indication of the colour or colours making up the mark; where applicable, a description of the mark;

an indication of the goods and services by their names, grouped according to the classes of the Nice Classification; each group shall be preceded by the number of the class of that

classification to which that group of goods and services belongs and shall be presented in the order of the classes of that classification

particulars of claims of priority pursuant to Article 30 of the Regulation;

particulars of claims of exhibition priority pursuant to Article 33 of the Regulation;

particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34 of the Regulation;

a statement that the mark has become distinctive in consequence of the use which has been made of it, pursuant to Article 7 (3) of the Regulation;

a declaration by the applicant disclaiming any exclusive right to some element of the mark pursuant to Article 38 (2) of the Regulation;

an indication that the mark is a collective mark;

the language in which the application was filed and the second language which the applicant has indicated in his application, pursuant to Article 115 (3) of the Regulation;

the date of registration of the mark in the Register and the registration number.

The Register of Community Trade Marks shall also contain the following entries, each accompanied by the date of recording of such entry:

changes in the name, the address or the nationality of the proprietor of a Community trade mark or in the State in which he is domiciled or has his seat or establishment;

changes in the name or business address of the representative, other than a representative falling within Article 88 (3), first sentence, of the Regulation;

when a new representative is appointed, the name and business address of that representative;

alterations of the mark pursuant to Article 48 of the Regulation and corrections of mistakes and errors;

notice of amendments to the regulations governing the use of the collective mark pursuant to Article 69 of the Regulation;

particulars of claims of seniority of an earlier registered trade mark as referred to in Article 34 of the Regulation, pursuant to Article 35 of the Regulation;

total or partial transfers pursuant to Article 17 of the Regulation;

the creation or transfer of a right in rem pursuant to Article 19 of the Regulation and the nature of the right in rem;

levy of execution pursuant to Article 20 of the Regulation and bankruptcy or like proceedings pursuant to Article 21 of the regulation;

the grant or transfer of a licence pursuant to Article 22 of the Regulation and, where applicable, the type of licence pursuant to Rule 34;

renewal of the registration pursuant to Article 47 of the Regulation, the date from which it takes effect and any restrictions pursuant to Article 47 (4) of the Regulation;

a record of the determination of the expiry of the registration pursuant to Article 47 of the Regulation;

a declaration of surrender by the proprietor of the mark pursuant to Article 49 of the Regulation;

the date of submission of an application pursuant to Article 55 of the Regulation or of the filing of a counterclaim pursuant to Article 96 (4) of the Regulation for revocation or for a declaration of invalidity;

the date and content of the decision on the application or counterclaim pursuant to Article 56 (6) or the third sentence of Article 96 (6) of the Regulation;

a record of the receipt of a request for conversion pursuant to Article 109 (2) of the Regulation;

the cancellation of the representative recorded pursuant to paragraph 2 (e);

the cancellation of the seniority of a national mark;

the modification or cancellation from the Register of the items referred to in subparagraphs (h), (i) and (j).

The President of the Office may determine that items other than those referred to in paragraphs 2 and 3 shall be entered in the Register.

The proprietor of the trade mark shall be notified of any change in the Register.

The Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee.

Part J

Community Trade Marks Bulletin and Official Journal of the Office

Rule 85

Community Trade Marks Bulletin

The Community Trade Marks Bulletin shall be published in periodic editions. The Office may make available to the public editions of the Bulletin on CD-ROM or in any other machine-readable form.

The Community Trade Marks Bulletin shall contain publications of applications and of entries made in the Register as well as other particulars relating to applications or registrations of trade marks whose publication is prescribed by the Regulation or by these Rules.

Where particulars whose publication is prescribed in the Regulation or in these Rules are published in the Community Trade Marks Bulletin, the date of issue shown on the Bulletin shall be taken as the date of publication of the particulars.

To the extent that the entries regarding the registration of a trade mark contain no changes as compared to the publication of the application, the publication of such entries shall be made by way of a reference to the particulars contained in the publication of the application.

The elements of the application for a Community trade mark, as set out in Article 26 (1) of the Regulation as well as any other information the publication of which is prescribed in Rule 12 shall, where appropriate, be published in all the official languages of the Community.

The Office shall take into account any translation submitted by the applicant. If the language of the application is not one of the languages of the Office, the translation into the second language indicated by the applicant shall be communicated to the applicant. The applicant may propose changes to the translation within a period to be specified by the Office. If the applicant does not respond within this period or if the Office considers the proposed changes to be inappropriate, the translation proposed by the Office shall be published.

#### Rule 86

##### Official Journal of the Office

The Official Journal of the Office shall be published in periodic editions. The Office may make available to the public editions of the Official Journal on CD-ROM or in any other machine-readable form.

The Official Journal shall be published in the languages of the Office. The President of the Office may determine that certain items shall be published in all the official languages of the Community.

#### Rule 87

##### Data bank

The Office shall maintain an electronic data bank with the particulars of applications for registration of trade marks and entries in the Register. The Office may also make available the contents of this data bank on CD-ROM or in any other machine-readable form.

The President of the Office shall determine the conditions of access to the data bank and the manner in which the contents of this data bank may be made available in machine-readable form, including the charges for these acts.

## Part K

### Inspection of files and keeping of files

#### Rule 88

##### Parts of the file excluded from inspection

The parts of the file which shall be excluded from inspection pursuant to Article 84 (4) of the Regulation shall be:

documents relating to exclusion or objection pursuant to Article 132 of the Regulation;

draft decisions and opinions, and all other internal documents used for the preparation of decisions and opinions;

parts of the file which the party concerned showed a special interest in keeping confidential before the application for inspection of the files was made, unless inspection of such part of the file is justified by overriding legitimate interests of the party seeking inspection.

#### Rule 89

##### Procedures for the inspection of files

Inspection of the files of Community trade mark applications and of registered Community trade marks shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way. The means of inspection shall be determined by the President of the Office. The request for inspection of the files shall not be deemed to have been made until the required fee has been paid.

Where inspection of the files of a Community trade mark application is requested, the request shall contain an indication and evidence to the effect that the applicant

has consented to the inspection; or

has stated that after the trade mark has been registered he will invoke the rights under it against the party requesting the inspection.

Inspection of the files shall take place on the premises of the Office.

On request, inspection of the files shall be effected by means of issuing copies of file documents. Such copies shall incur fees.

The office shall issue on request certified or uncertified copies of the application for a Community trade mark or of those file documents of which copies may be issued pursuant to paragraph 4 upon payment of a fee.

#### Rule 90

##### Communication of information contained in the files

Subject to the restrictions provided for in Article 84 of the Regulation and Rule 88, the Office may, upon request, communicate information from any file of a Community trade mark applied for or of a registered Community trade mark, subject to payment of a fee. However, the Office may require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

#### Rule 91

##### Keeping of files

The Office shall keep the files relating to Community trade mark applications and registered Community trade marks for at least five years from the end of the year in which:

the application is rejected or withdrawn or is deemed to be withdrawn;

the registration of the Community trade mark expires completely pursuant to Article 47 of the Regulation;

the complete surrender of the Community trade mark is registered pursuant to Article 49 of the Regulation;

the Community trade mark is completely removed from the Register pursuant to Article 56 (6) or Article 96 (6) of the Regulation.

The President of the Office shall determine the form in which the files shall be kept.

#### Part L

##### Administrative cooperation

#### Rule 92

##### Exchange of information and communications between the Office and the authorities of the Member States

The Office and the central industrial property offices of the Member States shall, upon request, communicate to each other relevant information about the filing of applications for

Community trade marks or national marks and about proceedings relating to such applications and the marks registered as a result thereof. Such communications shall not be subject to the restrictions provided for in Article 84 of the Regulation.

Communications between the Office and the courts or authorities of the Member States which arise out of the application of the Regulation or these Rules shall be effected directly between these authorities. Such communication may also be effected through the central industrial property offices of the Member States.

Expenditure in respect of communications under paragraphs 1 and 2 shall be chargeable to the authority making the communications, which shall be exempt from fees.

### Rule 93

Inspection of files by or via courts or authorities of the Member States

Inspection of files relating to Community trade marks applied for or registered Community trade marks by courts or authorities of the Member States be of the original documents or of copies thereof, otherwise Rule 89 shall not apply.

Courts or Public Prosecutors' Offices of the Member States may, in the course of proceedings before them, open files or copies thereof transmitted by the Office to inspection by third parties. Such inspection shall be subject to Article 84 of the Regulation. The Office shall not charge any fee for such inspection.

The Office shall, at the time of transmission of the files or copies thereof to the courts or Public Prosecutors' Offices of the Member States, indicate the restrictions to which the inspection of files relating to Community trade marks applied for or registered Community trade marks is subject pursuant to Article 84 of the Regulation and Rule 88.

### Part M

Costs

### Rule 94

Apportionment and fixing of costs

Apportionment of costs pursuant to Article 81 (1) and (2) of the Regulation shall be dealt with in the decision on the opposition, the decision on the application for revocation or for a declaration of invalidity of a Community trade mark, or the decision on the appeal.

Apportionment of costs pursuant to Article 81 (3) and (4) of the Regulation shall be dealt with in a decision on costs by the Opposition Division, the Cancellation Division or the Board of Appeal.

A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs provided for in the first sentence of Article 81 (6) of the Regulation. The request shall be admissible only if the decision in respect of which the fixing of costs is required has become final. Costs may be fixed once their credibility is established.

The request provided for in the second sentence of Article 81 (6) of the Regulation for a review of the decision of the registry on the fixing of costs, stating the reasons on which it is based, must be filed at the Office within one month after the date of notification of the awarding of costs. It shall not be deemed to be filed until the fee for reviewing the amount of the costs has been paid.

The Opposition Division, the Cancellation Division or the Board of Appeal, as the case may be, shall take a decision on the request referred to in paragraph 4 without oral proceedings.

The fees to be borne by the losing party pursuant to Article 81 (1) of the Regulation shall be limited to the fees incurred by the other party for opposition, for an application for revocation or for a declaration of invalidity of the Community trade mark and for appeal.

Cost essential to the proceedings and actually incurred by the successful party shall be borne by the losing party in accordance with Article 81 (1) of the Regulation on the basis of the following maximum rates:

travel expenses of one party for the outward and return journey between the place of residence or the place of business and the place where oral proceedings are held or where evidence is taken, as follows:

the cost of the first-class rail-fare including usual transport supplements where the total distance by rail does not exceed 800 km;

the cost of the tourist-class air-fare where the total distance by rail exceeds 800 km or the route includes a sea-crossing;

subsistence expenses by one party equal to the daily subsistence allowance for officials in grades A4 to A8 as laid down in Article 13 of Annex VII to the Staff Regulations of Officials of the European Communities;

travel expenses of representatives within the meaning of Article 89 (1) of the Regulation and of witnesses and of experts, at the rates provided for in subparagraph (a);

subsistence expenses of representatives within the meaning of Article 89 (1) of the Regulation and of witnesses and experts, at the rates provided for in subparagraph (b);

costs entailed in the taking of evidence in the form of examination of witnesses, opinions by experts or inspection

up to ECU 300 per proceedings;

f) cost of representation, within the meaning of Article 89 (1) of the Regulation, of the opposing party in opposition proceedings:

up to ECU 250;

of the applicant in opposition proceedings:

up to ECU 250;

of the applicant in proceedings relating to revocation or invalidity of a Community trade mark:

up to ECU 400;

of the proprietor of the trade mark in proceedings relating to revocation or invalidity of a Community trade mark:

up to ECU 400;

of the appellant in appeal proceedings:

up to ECU 500;

of the defendant in appeal proceedings:

up to ECU 500;

Where the taking of evidence in any of the abovementioned proceedings involves the examination of witnesses, opinions by experts or inspection, an additional amount shall be granted for representation costs of up to ECU 600 per proceedings;

(g) where the successful party is represented by more than one representative within the meaning of Article 89 (1) of the Regulation, the losing party shall bear the costs referred to in subparagraphs (c), (d) and (f) for one such person only;

(h) the losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in subparagraphs (a) to (g).

Part N

Languages

## Rule 95

### Applications and declarations

Without prejudice to Article 115 (5) of the Regulation,

any application or declaration relating to a Community trade mark application may be filed in the language used for filing the application for a Community trade mark or in the second language indicated by the applicant in his application;

any application or declaration relating to a registered Community trade mark may be filed in one of the languages of the Office. However, when the application is filed by using any of the forms provided by the Office pursuant to Rule 83, such forms may be used in any of the official languages of the Community, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

## Rule 96

### Written proceedings

Without prejudice to Article 115 (4) and (7) of the Regulation, and unless otherwise provided for in these Rules, in written proceedings before the Office any party may use any language of the Office. If the language chosen is not the language of the proceedings, the party shall supply a translation into that language within one month from the date of the submission of the original document. Where the applicant for a Community trade mark is the sole party to proceedings before the Office and the language used for the filing of the application for the Community trade mark is not one of the languages of the Office, the translation may also be filed in the second language indicated by the applicant in his application.

Unless otherwise provided for in these Rules, documents to be used in proceedings before the Office may be filed in any official language of the Community. Where the language of such documents is not the language of the proceedings the Office may require that a translation be supplied, within a period specified by it, in that language or, at the choice of the party to the proceeding, in any language of the Office.

## Rule 97

### Oral proceedings

Any party to oral proceedings before the Office may, in place of the language of proceedings, use one of the other official languages of the Community, on condition that he makes provision for interpretation into the language of proceedings. Where the oral proceedings are

held in a proceeding concerning the application for registration of a trade mark, the applicant may use either the language of the application or the second language indicated by him.

In oral proceedings concerning the application for registration of a trade mark, the staff of the Office may use either the language of the application or the second language indicated by the applicant. In all other oral proceedings, the staff of the Office may use, in place of the language of the proceedings, one of the other languages of the Office, on condition that the party or parties to the proceedings agree to such use.

In the case of taking of evidence, any party to be heard, witness or expert who is unable to express himself adequately in the language of proceedings, may use any of the official languages of the Community. Should the taking of evidence be decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express themselves in languages other than the language of proceedings may be heard only if the party who made the request makes provision for interpretation into that language. In proceedings concerning the application for registration of a trade mark, in place of the language of the application, the second language indicated by the applicant may be used. In any proceedings with only one party the Office may on request of the party concerned permit derogations from the provisions in this paragraph.

If the parties and Office so agree, any official language of the Community may be used in oral proceedings.

The Office shall, if necessary, make provision at its own expense for interpretation into the language of proceedings, or, where appropriate, into its other languages, unless this interpretation is the responsibility of one of the parties to the proceedings.

Statements by staff of the Office, by parties to the proceedings and by witnesses and experts, made in one of the languages of the Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the language of proceedings. Amendments to the text of the application for or the registration of a Community trade mark shall be entered in the minutes in the language of proceedings.

## Rule 98

### Certification of translations

When a translation of any document is to be filed, the Office may require the filing, within a period to be specified by it, of a certificate that the translation corresponds to the original text. Where the certificate relates to the translation of a previous application pursuant to Article 30

of the Regulation, such period shall not be less than three months after the date of filing of the application. Where the certificate is not filed within that period, the document shall be deemed not to have been received.

The President of the Office may determine the manner in which translations are certified.

#### Rule 99

##### Legal authenticity of translations

In the absence of evidence to the contrary, the Office may assume that a translation corresponds to the relevant original text.

#### Part O

##### Organization of the Office

#### Rule 100

##### Allocation of duties

The President of the Office shall determine the examiners and their number, the members of the Opposition Divisions and Cancellation Divisions, and the members of the Administration of Trade Marks and Legal Division. He shall allocate duties to the examiners and the Divisions.

The President of the Office may provide that examiners may also be members of the Opposition Divisions, Cancellation Divisions, and the Administration of Trade Marks and Legal Division, and that members of these Divisions may also be examiners.

In addition to the responsibilities vested in them under the Regulation, the President of the Office may allocate further duties to the examiners and the members of the Opposition Divisions, Cancellation Divisions and the Administration of Trade Marks and Legal Division.

The President of the Office may entrust to other members of the staff of the Office who are not examiners or members of any of the Divisions mentioned in paragraph 1 the execution of individual duties falling to the examiners, Opposition Divisions, Cancellation Divisions or the Administration of Trade Marks and Legal Division and involving no special difficulties.

## TITLE XII

### RECIPROCITY

#### Rule 101

##### Publication of reciprocity

If necessary, the President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention or to the Agreement establishing the World Trade Organization accords reciprocal treatment within the meaning of Article 5 (1) (d), Article 5 (3) and Article 29 (5) of the Regulation.

If the Commission determines that reciprocal treatment in accordance with paragraph 1 is accorded, it shall publish a communication to this effect in the Official Journal of the European Communities.

Article 5 (1) (d), Article 5 (3) and Article 29 (5) of the Regulation shall take effect for the nationals of the States concerned from the date of publication in the Official Journal of the European Communities of the communication referred to in paragraph 2, unless the communication states an earlier date from which it is applicable. They shall cease to be effective from the date of publication in the Official Journal of the European Communities of a communication of the Commission to the effect that reciprocal treatment is no longer accorded, unless the communication states an earlier date from which it is applicable.

Communications referred to in paragraphs 2 and 3 shall also be published in the Official Journal of the Office.

## Article 2

### Transitional Provisions

Any application for registration of a Community trade mark filed within three months prior to the date determined pursuant to Article 143 (3) of the Regulation shall be marked by the Office with the filing date determined pursuant to that provision and with the actual date of receipt of the application.

With regard to the application, the priority period of six months provided for in Articles 29 and 33 of the Regulation shall be calculated from the date determined pursuant to Article 143 (3) of the Regulation.

The Office may issue a receipt to the applicant prior to the date determined pursuant to Article 143 (3) of the Regulation.

The Office may examine the applications prior to the date determined pursuant to Article 143 (3) of the Regulation and communicate with the applicant with a view to remedying any deficiencies prior to that date. Any decisions with regard to such applications may be taken only after that date.

With regard to the application, the Office shall not carry out any search pursuant to Article 39 (1) of the Regulation, regardless of whether or not a priority was claimed for such application pursuant to Articles 29 or 33 of the Regulation.

Where the date of receipt of an application for the registration of a Community trade mark by the Office, by the central industrial property office of a Member State or by the Benelux Trade Mark Office is before the commencement of the three months period specified in Article 143 (4) of the Regulation the application shall be deemed not to have been filed. The application shall be informed accordingly and the application shall be sent back to him.

Article 3

Entry into force

This Regulation shall enter into force on the seventh day following that of its publication in the Official Journal of the European Communities.

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

Done at Brussels, 13 December 1995.

For the Commission

Mario MONTI

Member of the Commission

OJ No L 11, 14. 1. 1994, p. 1.

OJ No L 349, 31. 12. 1994, p. 83

See p. 33 of this Official Journal.

**2.1.3. Commission Regulation (EC) on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)<sup>6</sup> No 2869/95**

COMMISSION REGULATION (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

---

<sup>6</sup> *Official Journal L 303*, 15/12/1995 P. 0033 – 0038

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (1), as amended by Regulation (EC) No 3288/94 (2) and in particular Article 139 thereof,

Having regard to Commission Regulation (EC) No 2868/95 of 13 December 1995, implementing Council Regulation (EC) No 40/94 on the Community trade mark (3),

Whereas Article 139 (3) of Regulation (EC) No 40/94 (hereinafter 'the Regulation`) provides that the fees regulations shall be adopted in accordance with the procedure laid down in Article 141 of the Regulation;

Whereas Article 139 (1) of the Regulation provides that the fees regulations shall determine in particular the amount of the fees and the ways in which they are to be paid;

Whereas Article 139 (2) of the Regulation provides that the amounts of the fees shall be fixed at such a level as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Office for Harmonization in the Internal Market (trade marks and designs) ('the Office`) to be balanced;

Whereas, however, in the Office's start-up phase, balance can be achieved only if there is a subsidy from the general budget of the European Communities, in accordance with Article 134 (3) of the Regulation;

Whereas the basic fee for the application for a Community trade mark shall include the amount which the Office must pay to each central industrial property office of the Member States for each search report provided by such offices in accordance with Article 39 (4) of the Regulation;

Whereas to ensure the necessary flexibility, the President of the Office ('the President`) should be empowered, subject to certain conditions, to lay down the charges which may be payable to the Office in respect of services it may render, the charges for access to the Office's data bank and the making available of the contents of this data bank in machine-readable form, and to set charges for the sale of its publications;

Whereas, in order to facilitate the payment of fees and charges, the President should be empowered to authorize methods of payment which are additional to those explicitly provided for in this Regulation;

Whereas it is appropriate that the fees and charges payable to the Office should be fixed in the same currency unit as is used for the budget of the Office;

Whereas the budget of the Office is fixed in ecus;

Whereas, moreover, the fixing of these amounts in ecus avoids discrepancies that may result from exchange rate variations;

Whereas payments in cash should be made in the currency of the Member State where the Office has its seat;

Whereas the measures envisaged in this Regulation are in accordance with the opinion of the Committee established under Article 141 of the Regulation,

HAS ADOPTED THIS REGULATION:

Article 1

General

The following shall be levied in accordance with this Regulation:

fees to be paid to the Office as provided for in the Regulation and in Regulation (EC) No 2868/95;

charges laid down by the President pursuant to Article 3 (1) and (2)

Article 2

Fees provided for in the Regulation and Regulation (EC) No 2868/95

The fees to be paid to the Office under Article 1 (a) shall be as follows:

>TABLE>

Article 3

Charges laid down by the President

The President shall lay down the amount to be charged for any services rendered by the Office other than those specified in Article 2.

The President shall lay down the amount to be charged for the Community Trade Marks Bulletin and the Official Journal of the Office as well as any other publications issued by the Office.

The amounts of the charges shall be laid down in ecus.

The amounts of the charges laid down by the President in accordance with paragraphs 1 and 2 shall be published in the Official Journal of the Office.

Article 4

Due date for fees and charges

Fees and charges in respect of which the due date is not specified in the Regulation or in Regulation No 2868/95 shall be due on the date of receipt of the request for the service for which the fee or the charge is incurred.

The President may decide not to make services mentioned in paragraph 1 dependent upon the advance payment of the corresponding fees or charges.

#### Article 5

##### Payment of fees and charges

Fees and charges due to the Office shall be paid

by payment or transfer to a bank account held by the Office,

by delivery or remittance of cheques made payable to the Office, or

in cash.

The President may allow methods of payment other than those set out in paragraph 1, in particular by means of deposits in current accounts held with the Office.

Determinations made pursuant to paragraph 2 shall be published in the Official Journal of the Office.

#### Article 6

##### Currencies

Payments or transfers to a bank account referred to in Article 5 (1) (a), by delivery or remittance of cheques referred to in Article 5 (1) (b) or any other method of payment allowed by the President pursuant to Article 5 (2) shall be made in ecus.

The payments in cash referred to in Article 5 (1) (c) shall be made in the currency of the Member State where the Office has its seat. The President shall determine the ecus equivalents in that currency on the basis of the exchange rate in force, which are fixed daily by the Commission and published in the Official Journal of the European Communities in accordance with Council Regulation (EC) No 3320/94 (4).

#### Article 7

##### Particulars concerning payment

Every payment must indicate the name of the person making the payment and must contain the necessary information to enable the Office to establish immediately the purpose of the payment. In particular, the following information shall be provided:

when the application fee is paid, the purpose of the payment, namely 'application fee`;

when the registration fee is paid, the file number of the application which is the basis for the registration and the purpose of the payment, namely 'registration fee`;

when the opposition fee is paid, the file number of the application and the name of the applicant for the Community trade mark against which opposition is entered, and the purpose of the payment, namely 'opposition fee`;

when the revocation fee and the invalidity fee are paid, the registration number and the name of the proprietor of the Community trade mark against which the application is directed, and the purpose of the payment, namely 'revocation fee` or 'invalidity fee`.

If the purpose of the payment cannot immediately be established, the Office shall require the person making the payment to notify it in writing of this purpose within such period as it may specify. If the person does not comply with this request in due time, the payment shall be considered not to have been made. The amount which has been paid shall be refunded.

## Article 8

### Deemed date of payment

The date on which any payment shall be considered to have been made to the Office shall be as follows:

in the cases referred to in Article 5 (1) (a), the date on which the amount of the payment or of the transfer is actually entered in a bank account held by the Office;

in the case referred to in Article 5 (1) (b), the date of the receipt of the cheque at the Office, provided that the cheque is met;

in the cases referred to in Article 5 (1) (c), the date of receipt of the amount of the cash payment.

Where the President allows, in accordance with the provisions of Article 5 (2), other methods of paying fees than those set out in Article 5 (1), he shall also lay down the date on which such payments shall be considered to have been made.

Where, under the provisions of paragraphs 1 and 2, payment of a fee is not considered to have been made until after the expiry of the period in which it was due, it shall be considered that this period has been observed if evidence is provided to the Office that the person who made the payment -

in a Member State, within the period within which the payment should have been made:

effected the payment through a banking establishment;

duly gave an order to a banking establishment to transfer the amount of the payment; or  
dispatched at a post office or otherwise a letter bearing the address of the Office and  
containing a cheque within the meaning of Article 5 (1) (b), provided that the cheque is met;  
and -

paid a surcharge of 10 % on the relevant fee or fees, but not exceeding ECU 200; no  
surcharge is payable if a condition according to sub-paragraph (a) has been fulfilled not later  
than 10 days before the expiry of the period for payment.

The Office may request the person who made the payment to produce evidence as to the date  
on which a condition according to paragraph 3 (a) was fulfilled and, where required, to pay  
the surcharge referred to in paragraph 3 (b), within a period to be specified by it. If the person  
fails to comply with this request or if the evidence is insufficient, or if the required surcharge  
is not paid in due time, the period for payment shall be considered not to have been observed.

#### Article 9

##### Insufficiency of the amount paid

A time limit for payment shall, in principle, be considered to have been observed only if the  
full amount of the fee has been paid in due time. If the fee is not paid in full, the amount  
which has been paid shall be refunded after the period for payment has expired.

The Office may, however, in so far as this is possible within the time remaining before the  
end of the period, give the person making the payment the opportunity to pay the amount  
lacking or, where this is considered justified, overlook any small amounts lacking without  
prejudice to the rights of the person making the payment.

#### Article 10

##### Refund of insignificant amounts

Where an excessive sum is paid to cover a fee or a charge, the excess shall not be refunded if  
the amount is insignificant and the party concerned has not expressly requested a refund. The  
President shall determine what constitutes an insignificant amount.

Determinations by the President pursuant to paragraph 1 shall be published in the Official  
Journal of the Office.

#### Article 11

##### Entry into force

This Regulation shall enter into force on the seventh day following its publication in the Official Journal of the European Communities.

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

Done at Brussels, 13 December 1995.

For the Commission

MARIO MONTI

Member of the Commission

OJ No L 11, 14. 1. 1994, p. 1.

OJ No L 349, 31. 12. 1994, p. 83.

See p. 1 of this Official Journal.

OJ No L 350, 31. 12. 1994, p. 27.

#### **2.1.4. Commission Regulation (EC) No 216/96 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) <sup>7</sup>**

COMMISSION REGULATION (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 40/94 of 20 December 1994 on the Community trade mark (1), as amended by Regulation (EC) No 3288/94 (2), and in particular Article 140 (3) thereof,

Whereas Regulation (EC) No 40/94 (hereinafter 'the Regulation') creates a new trade mark system allowing a trade mark having effect throughout the Community to be obtained on the

---

<sup>7</sup> Official Journal L 028 , 06/02/1996 P. 0011 – 0013

basis of an application to the Office for Harmonization in the Internal Market (Trade Marks and Designs) ('the Office`);

Whereas for this purpose the Regulation contains in particular the necessary provisions for a procedure leading to the registration of a Community trade marks, as well as for the administration of Community trade marks, for appeals against decisions of the Office and for proceedings in relation to revocation or invalidity of a Community trade mark;

Whereas under Article 130 of the Regulation, the Boards of Appeal are to be responsible for deciding on appeals from decisions of the examiners, the Opposition Divisions, the Administration of Trade Marks and Legal Division and the Cancellation Divisions;

Whereas Title VII of the Regulation contains basic principles regarding appeals against decisions of examiners, the Opposition Divisions, the Administration of Trade Marks and Legal Division and the Cancellation Divisions;

Whereas Title X of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation No 40/94 on the Community Trade Mark (3) contains implementing rules to Title VII of the Regulation;

Whereas this Regulation supplements those other rules, in particular as regards the organization of the Boards and the oral procedure;

Whereas before the beginning of each working year a scheme should be established for the distribution of business between the Boards of Appeal by an Authority established for that purpose; whereas to this end the said Authority should apply objective criteria such as classes of products and services or initial letters of the names of applicants;

Whereas to facilitate the handling and disposal of appeals, a rapporteur should be designated for each case, who should be responsible inter alia for preparing communications with the parties and drafting decisions;

Whereas the parties to proceedings before the Boards of Appeal may not be in a position or may not be willing to bring questions of general relevance to a pending case to the attention of the Boards of Appeal; whereas, therefore, the Boards of Appeal should have the power, of their own motion or pursuant to a request by the President, to invite the President of the Office, to submit comments on questions of general interest in relation to a case pending before the Boards of Appeal;

Whereas the measures provided for in this Regulation are in accordance with the opinion of the Committee established under Article 141 of the Regulation,

## HAS ADOPTED THIS REGULATION:

### Article 1

#### Allocation of duties and Authority competent to allocate

Before the beginning of each working year, duties shall be allocated to the Boards of Appeal according to objective criteria, and the members of each of the Boards and their alternates shall be designated. Any member of a Board of Appeal may be designated for several Boards of Appeal as a member or an alternate. These measures may, where necessary, be amended during the working year in question.

The measures referred to in paragraph 1 shall be taken by an Authority composed of the President of the Office as Chairman, the Vice-President of the Office responsible for the Boards of Appeal, the Chairmen of the Boards of Appeal and three other members of the Boards of Appeal elected by the full membership of those Boards, except the Chairmen, for the working year in question. The Authority may validly deliberate only if at least five of its members are present, including the President or the Vice-President of the Office and two Chairmen of Boards of Appeal. Decisions shall be taken by majority vote. In the event of a tie, the vote of the Chairman shall be decisive. The Authority may lay down its internal rules of procedure.

The Authority provided for in paragraph 2 shall decide on conflicts regarding the allocation of duties among different Boards of Appeal.

Until more than three Boards of Appeal have been set up, the Authority referred to in paragraph 2 shall consist of the President of the Office, who shall act as Chairman, the Vice-President of the Office responsible for the Boards of Appeal, the Chairman or Chairmen of the Boards of Appeal which have already been set up and one other member of the Boards of Appeal elected by their full membership of the Board, except the Chairman or Chairmen, for the working year in question. The Authority may validly deliberate only if at least three of its members are present, including the President or the Vice-President of the Office.

### Article 2

#### Replacement of members

Reasons for replacement by alternates shall in particular include leave, sickness, inescapable commitments and the grounds of exclusion set out in Article 132 of the Regulation.

Any member asking to be replaced by an alternate shall without delay inform the Chairman of the Board concerned of his unavailability.

## Article 3

### Exclusion and objection

If a Board has knowledge of a possible reason for exclusion or objection under Article 132 (3) of the Regulation which does not originate from a member himself or from any party to the proceedings, the procedure of Article 132 (4) of the Regulation shall be applied.

The member concerned shall be invited to present his comments as to whether there is a reason for exclusion or objection.

Before a decision is taken on the action to be taken pursuant to Article 132 (4) of the Regulation, there shall be no further proceedings in the case.

## Article 4

### Rapporteurs

The Chairman of each Board shall for each appeal designate a member of his Board, or himself, as rapporteur.

The rapporteur shall carry out a preliminary study of the appeal. He may prepare communications to the parties subject to the direction of the Chairman of the Board. Communications shall be signed by the rapporteur on behalf of the Board.

The rapporteur shall prepare internal meetings of the Board and the oral proceedings.

The rapporteur shall draft decisions.

## Article 5

### Registries

Registries shall be established for the Boards of Appeal. Registrars shall be responsible for the discharge of the functions of the Registries. One of the Registrars may be designated Senior Registrar.

The Authority provided for in Article 1 (2) may entrust to the Registrars the performance of functions which involve no legal or technical difficulties, particularly with regard to representation, the submission of translations, inspection of files and notifications.

The Registrar shall submit to the Chairman of the Board concerned a report on the admissibility of each newly-filed appeal.

Minutes of oral proceedings and of the taking of evidence shall be drawn up by the Registrar or, if the President of the Office has agreed thereto, such other officer of the Office as the Chairman of the Board may designate.

## Article 6

### Change in the composition of a Board

If the composition of a Board is changed after oral proceedings, the parties to the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. Fresh oral proceedings shall also be held if so requested by the new member and if the other members of the Board have given their agreement.

The new member shall be bound to the same extent as the other members by an interim decision which has already been taken.

If, when a Board has already reached a final decision, a member is unable to act, he shall not be replaced by an alternate. If the Chairman is unable to act, then the member of the Board concerned having the longer service on the Board, or where members have the same length of service, the older member, shall sign the decision on behalf of the Chairman.

## Article 7

### Joinder of appeal proceedings

If several appeals are filed against a decision, those appeals shall be considered in the same proceedings.

If appeals are filed against separate decisions and all the appeals are designated to be examined by one Board having the same composition, that Board may deal with those appeals in joined proceedings with the consent of the parties.

## Article 8

### Remission to the department of first instance

Where the proceedings of the department of first instance whose decision is the subject of an appeal are vitiated by fundamental deficiencies, the Board shall set aside the decision and, unless there are reasons for not doing so, remit the case to that instance or decide the matter itself.

## Article 9

### Oral proceedings

If oral proceedings are to take place, the Board shall ensure that the parties have provided all relevant information and documents before the hearing.

The Board may, when issuing the summons to attend oral proceedings, add a communication drawing attention to matters which seem to be of special significance, or to the fact that

certain questions appear no longer to be contentious, or containing other observations that may help to concentrate on essentials during the oral proceedings.

The Board shall ensure that the case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary.

#### Article 10

##### Communications to the parties

If a Board deems it expedient to communicate with the parties regarding a possible appraisal of substantive or legal matters, such communication shall be made in such a way as not to imply that the Board is in any way bound by it.

#### Article 11

##### Comments on questions of general interest

The Board may, on its own initiative or at the written, reasoned request of the President of the Office, invite him to comment in writing or orally on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the President's comments.

#### Article 12

##### Deliberations preceding decisions

The rapporteur shall submit to the other members of the Board a draft of the decision to be taken and shall set a reasonable time-limit within which to oppose it or to ask for changes. The Board shall meet to deliberate on the decision to be taken if it appears that the members of a Board are not all of the same opinion. Only members of the Board shall participate in the deliberations; the Chairman of the Board concerned may, however, authorize other officers such as registrars or interpreters to attend. Deliberations shall be secret.

#### Article 13

##### Order of voting

During the deliberations between members of a Board, the opinion of the rapporteur shall be heard first, and, if the rapporteur is not the Chairman, the Chairman last.

If voting is necessary, votes shall be taken in the same sequence, save that if the Chairman is also the rapporteur, he shall vote last. Abstentions shall not be permitted.

#### Article 14

##### Entry into force

This Regulation shall enter into force the third day following its publication in the Official Journal of the European Communities.

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

Done at Brussels, 5 February 1996.

For the Commission

Mario MONTI

Member of the Commission

OJ No L 11, 14. 1. 1994, p. 1.

OJ No L 349, 31. 12. 1994, p. 83.

OJ No L 303, 15. 12. 1995, p. 1.

## **2.2. Directives and decisions**

### **2.2.1. Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Codified version) Text with EEA relevance 2008/95/EC<sup>8</sup>**

of 22 October 2008

(Codified version) (Text with EEA relevance)

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 95 thereof,

Having regard to the proposal from the Commission,

---

<sup>8</sup> *Official Journal L 299*, 08/11/2008 P. 0025 - 0033

Having regard to the opinion of the European Economic and Social Committee [1],

Acting in accordance with the procedure laid down in Article 251 of the Treaty [2],

Whereas:

The content of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [3] has been amended [4]. In the interests of clarity and rationality the said Directive should be codified.

The trade mark laws applicable in the Member States before the entry into force of Directive 89/104/EEC contained disparities which may have impeded the free movement of goods and freedom to provide services and may have distorted competition within the common market. It was therefore necessary to approximate the laws of the Member States in order to ensure the proper functioning of the internal market.

It is important not to disregard the solutions and advantages which the Community trade mark system may afford to undertakings wishing to acquire trade marks.

It does not appear to be necessary to undertake full-scale approximation of the trade mark laws of the Member States. It will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market.

This Directive should not deprive the Member States of the right to continue to protect trade marks acquired through use but should take them into account only in regard to the relationship between them and trade marks acquired by registration.

Member States should also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration. They can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both. Member States should remain free to determine the effects of revocation or invalidity of trade marks.

This Directive should not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection.

Attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark be, in general,

identical in all Member States. To this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. The grounds for refusal or invalidity concerning the trade mark itself, for example, the absence of any distinctive character, or concerning conflicts between the trade mark and earlier rights, should be listed in an exhaustive manner, even if some of these grounds are listed as an option for the Member States which should therefore be able to maintain or introduce those grounds in their legislation. Member States should be able to maintain or introduce into their legislation grounds of refusal or invalidity linked to conditions for obtaining and continuing to hold a trade mark for which there is no provision of approximation, concerning, for example, the eligibility for the grant of a trade mark, the renewal of the trade mark or rules on fees, or related to the non-compliance with procedural rules.

In order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation. It is necessary to provide that a trade mark cannot be invalidated on the basis of the existence of a non-used earlier trade mark, while the Member States should remain free to apply the same principle in respect of the registration of a trade mark or to provide that a trade mark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked. In all these cases it is up to the Member States to establish the applicable rules of procedure.

It is fundamental, in order to facilitate the free movement of goods and services, to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States. This should not, however, prevent the Member States from granting at their option extensive protection to those trade marks which have a reputation.

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, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services. It is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion. 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, the association which can be made with the used or registered sign, the degree of similarity between the trade

mark and the sign and between the goods or services identified, should constitute the specific condition for such protection. The ways in which likelihood of confusion may be established, and in particular the onus of proof, should be a matter for national procedural rules which should not be prejudiced by this Directive.

It is important, for reasons of legal certainty and without inequitably prejudicing the interests of a proprietor of an earlier trade mark, to provide that the latter may no longer request a declaration of invalidity nor may he oppose the use of a trade mark subsequent to his own of which he has knowingly tolerated the use for a substantial length of time, unless the application for the subsequent trade mark was made in bad faith.

All Member States are bound by the Paris Convention for the Protection of Industrial Property. It is necessary that the provisions of this Directive should be entirely consistent with those of the said Convention. The obligations of the Member States resulting from that Convention should not be affected by this Directive. Where appropriate, the second paragraph of Article 307 of the Treaty should apply.

This Directive should be without prejudice to the obligations of the Member States relating to the time limit for transposition into national law of Directive 89/104/EEC set out in Annex I, Part B,

HAVE ADOPTED THIS DIRECTIVE:

Article 1

Scope

This Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State.

Article 2

Signs of which a trade mark may consist

A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Article 3

## Grounds for refusal or invalidity

The following shall not be registered or, if registered, shall be liable to be declared invalid:

signs which cannot constitute a trade mark;

trade marks which are devoid of any distinctive character;

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

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

signs which consist exclusively of:

the shape which results from the nature of the goods themselves;

the shape of goods which is necessary to obtain a technical result;

the shape which gives substantial value to the goods;

trade marks which are contrary to public policy or to accepted principles of morality;

trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

trade marks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6 ter of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the "Paris Convention".

Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:

the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the Community;

the trade mark covers a sign of high symbolic value, in particular a religious symbol;

the trade mark includes badges, emblems and escutcheons other than those covered by Article 6 ter of the Paris Convention and which are of public interest, unless the consent of the competent authority to their registration has been given in conformity with the legislation of the Member State;

the application for registration of the trade mark was made in bad faith by the applicant.

A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.

Any Member State may provide that, by derogation from paragraphs 1, 2 and 3, the grounds of refusal of registration or invalidity in force in that State prior to the date of entry into force of the provisions necessary to comply with Directive 89/104/EEC, shall apply to trade marks for which application has been made prior to that date.

#### Article 4

Further grounds for refusal or invalidity concerning conflicts with earlier rights

A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

"Earlier trade marks" within the meaning of paragraph 1 means:

trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;

Community trade marks;

trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Office for Intellectual Property;

trade marks registered under international arrangements which have effect in the Member State;

Community trade marks which validly claim seniority, in accordance with Council Regulation (EC) No 40/94 [5] of 20 December 1993 on the Community trade mark, from a trade mark

referred to in (a)(ii) and (iii), even when the latter trade mark has been surrendered or allowed to lapse;

applications for the trade marks referred to in points (a) and (b), subject to their registration;

trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, 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.

A trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark.

Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;

the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraph 2 and point (b) of this paragraph and in particular:

a right to a name;

a right of personal portrayal;

a copyright;

an industrial property right;

the trade mark is identical with, or similar to, an earlier collective trade mark conferring a right which expired within a period of a maximum of three years preceding application;

the trade mark is identical with, or similar to, an earlier guarantee or certification mark conferring a right which expired within a period preceding application the length of which is fixed by the Member State;

the trade mark is identical with, or similar to, an earlier trade mark which was registered for identical or similar goods or services and conferred on them a right which has expired for failure to renew within a period of a maximum of two years preceding application, unless the proprietor of the earlier trade mark gave his agreement for the registration of the later mark or did not use his trade mark;

the trade mark is liable to be confused with a mark which was in use abroad on the filing date of the application and which is still in use there, provided that at the date of the application the applicant was acting in bad faith.

The Member States may permit that in appropriate circumstances registration need not be refused or the trade mark need not be declared invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.

Any Member State may provide that, by derogation from paragraphs 1 to 5, the grounds for refusal of registration or invalidity in force in that State prior to the date of the entry into force of the provisions necessary to comply with Directive 89/104/EEC, shall apply to trade marks for which application has been made prior to that date.

## Article 5

### Rights conferred by a trade mark

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

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

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; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.

Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

The following, inter alia, may be prohibited under paragraphs 1 and 2:

affixing the sign to the goods or to the packaging thereof;

offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

importing or exporting the goods under the sign;

using the sign on business papers and in advertising.

Where, under the law of the Member State, the use of a sign under the conditions referred to in paragraph 1(b) or paragraph 2 could not be prohibited before the date of entry into force of the provisions necessary to comply with Directive 89/104/EEC in the Member State concerned, the rights conferred by the trade mark may not be relied on to prevent the continued use of the sign.

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 distinctive character or the repute of the trade mark.

## Article 6

### Limitation of the effects of a trade mark

The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

his own name or address;

indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;

the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;

provided he uses them in accordance with honest practices in industrial or commercial matters.

The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Member State in question and within the limits of the territory in which it is recognised.

#### Article 7

##### Exhaustion of the rights conferred by a trade mark

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

Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

#### Article 8

##### Licensing

A trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Member State concerned. A licence may be exclusive or non-exclusive.

The proprietor of a trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to:

its duration;

the form covered by the registration in which the trade mark may be used;

the scope of the goods or services for which the licence is granted;

the territory in which the trade mark may be affixed; or

the quality of the goods manufactured or of the services provided by the licensee.

#### Article 9

##### Limitation in consequence of acquiescence

Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 4(2) has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, he shall no longer be entitled on the

basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.

Any Member State may provide that paragraph 1 shall apply *mutatis mutandis* to the proprietor of an earlier trade mark referred to in Article 4(4)(a) or an other earlier right referred to in Article 4(4)(b) or (c).

In the cases referred to in paragraphs 1 and 2, the proprietor of a later registered trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trade mark.

## Article 10

### Use of trade marks

If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Directive, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.

Use of the trade mark with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.

In relation to trade marks registered before the date of entry into force in the Member State concerned of the provisions necessary to comply with Directive 89/104/EEC:

where a provision in force prior to that date attached sanctions to non-use of a trade mark during an uninterrupted period, the relevant period of five years mentioned in the first subparagraph of paragraph 1 shall be deemed to have begun to run at the same time as any period of non-use which is already running at that date;

where there was no use provision in force prior to that date, the periods of five years mentioned in the first subparagraph of paragraph 1 shall be deemed to run from that date at the earliest.

## Article 11

### Sanctions for non-use of a trade mark in legal or administrative proceedings

A trade mark may not be declared invalid on the ground that there is an earlier conflicting trade mark if the latter does not fulfil the requirements of use set out in Article 10(1) and (2), or in Article 10(3), as the case may be.

Any Member State may provide that registration of a trade mark may not be refused on the ground that there is an earlier conflicting trade mark if the latter does not fulfil the requirements of use set out in Article 10(1) and (2) or in Article 10(3), as the case may be.

Without prejudice to the application of Article 12, where a counter-claim for revocation is made, any Member State may provide that a trade mark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked pursuant to Article 12(1).

If the earlier 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 applying paragraphs 1, 2 and 3, be deemed to be registered in respect only of that part of the goods or services.

## Article 12

### Grounds for revocation

A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

However, no person may claim that the proprietor's rights in a trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed.

The commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

Without prejudice to paragraph 1, a trade mark shall be liable to revocation if, after the date on which it was registered:

in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered;

in consequence of the use made of it by the proprietor of the trade mark or with his consent 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.

#### Article 13

Grounds for refusal or revocation or invalidity relating to only some of the goods or services

Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

#### Article 14

Establishment a posteriori of invalidity or revocation of a trade mark

Where the seniority of an earlier trade mark which has been surrendered or allowed to lapse is claimed for a Community trade mark, the invalidity or revocation of the earlier trade mark may be established a posteriori.

#### Article 15

Special provisions in respect of collective marks, guarantee marks and certification marks

Without prejudice to Article 4, Member States whose laws authorise the registration of collective marks or of guarantee or certification marks may provide that such marks shall not be registered, or shall be revoked or declared invalid, on grounds additional to those specified in Articles 3 and 12 where the function of those marks so requires.

By way of derogation from Article 3(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.

## Article 16

### Communication

Member States shall communicate to the Commission the text of the main provisions of national law adopted in the field governed by this Directive.

## Article 17

### Repeal

Directive 89/104/EEC, as amended by the Decision listed in Annex I, Part A, is repealed, without prejudice to the obligations of the Member States relating to the time limit for transposition into national law of that Directive, set out in Annex I, Part B.

References to the repealed Directive shall be construed as references to this Directive and shall be read in accordance with the correlation table in Annex II.

## Article 18

### Entry into force

This Directive shall enter into force on the 20th day following its publication in the Official Journal of the European Union.

## Article 19

### Addressees

This Directive is addressed to the Member States.

Done at Strasbourg, 22 October 2008.

For the European Parliament

The President

H.-G. Pöttering

For the Council

The President

J.-P. Jouyet

[1] OJ C 161, 13.7.2007, p. 44.

[2] Opinion of the European Parliament of 19 June 2007 (OJ C 146 E, 12.6.2008, p. 76) and Council Decision of 25 September 2008.

[3] OJ L 40, 11.2.1989, p. 1.

[4] See Annex I, Part A.

[5] OJ L 11, 14.1.1994, p. 1.

---

## ANNEX I

### PART A

Repealed Directive with its amendment

(referred to in Article 17)

Council Directive 89/104/EEC | (OJ L 40, 11.2.1989, p. 1) |

Council Decision 92/10/EEC | (OJ L 6, 11.1.1992, p. 35) |

### PART B

Time limit for transposition into national law

(referred to in Article 17)

Directive | Time limit for transposition |

89/104/EEC | 31 December 1992 |

## Chapter III. Industrial designs and utility models

### 3.1. Regulations

#### 3.1.1. Council Regulation (EC) No 6/2002<sup>9</sup>

of 12 December 2001

Council Regulation (EC) No 6/2002)

of 12 December 2001

on Community designs

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission(1),

Having regard to the opinion of the European Parliament(2),

Having regard to the opinion of the Economic and Social Committee(3),

Whereas:

A unified system for obtaining a Community design to which uniform protection is given with uniform effect throughout the entire territory of the Community would further the objectives of the Community as laid down in the Treaty.

Only the Benelux countries have introduced a uniform design protection law. In all the other Member States the protection of designs is a matter for the relevant national law and is confined to the territory of the Member State concerned. Identical designs may be therefore protected differently in different Member States and for the benefit of different owners. This inevitably leads to conflicts in the course of trade between Member States.

The substantial differences between Member States' design laws prevent and distort Community-wide competition. In comparison with domestic trade in, and competition

---

<sup>9</sup> *Official Journal L 003*, 05/01/2002 P. 0001 – 0024

between, products incorporating a design, trade and competition within the Community are prevented and distorted by the large number of applications, offices, procedures, laws, nationally circumscribed exclusive rights and the combined administrative expense with correspondingly high costs and fees for the applicant. Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs<sup>(4)</sup> contributes to remedying this situation.

The effect of design protection being limited to the territory of the individual Member States whether or not their laws are approximated, leads to a possible division of the internal market with respect to products incorporating a design which is the subject of national rights held by different individuals, and hence constitutes an obstacle to the free movement of goods.

This calls for the creation of a Community design which is directly applicable in each Member State, because only in this way will it be possible to obtain, through one application made to the Office for Harmonisation in the Internal Market (Trade Marks and Design) in accordance with a single procedure under one law, one design right for one area encompassing all Member States.

Since the objectives of the proposed action, namely, the protection of one design right for one area encompassing all the Member States, cannot be sufficiently achieved by the Member States by reason of the scale and the effects of the creation of a Community design and a Community design authority and can therefore, and can therefore be better achieved at Community level, the Community may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty. In accordance with the principle of proportionality, as set out in that Article, this Regulation does not go beyond what is necessary in order to achieve those objectives.

Enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production.

Consequently a more accessible design-protection system adapted to the needs of the internal market is essential for Community industries.

The substantive provisions of this Regulation on design law should be aligned with the respective provisions in Directive 98/71/EC.

Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does not entail that a design

must have an aesthetic quality. Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

The mechanical fittings of modular products may nevertheless constitute an important element of the innovative characteristics of modular products and present a major marketing asset, and therefore should be eligible for protection.

Protection should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character. Therefore, those features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

Full-scale approximation of the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance, where the design is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the protected design is dependent, could not be achieved through Directive 98/71/EC. Within the framework of the conciliation procedure on the said Directive, the Commission undertook to review the consequences of the provisions of that Directive three years after the deadline for transposition of the Directive in particular for the industrial sectors which are most affected. Under these circumstances, it is appropriate not to confer any protection as a Community design for a design which is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the design is dependent and which is used for the purpose of the repair of a complex product so as to restore its original appearance, until the Council has decided its policy on this issue on the basis of a Commission proposal.

The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the

industrial sector to which it belongs and the degree of freedom of the designer in developing the design.

A Community design should, as far as possible, serve the needs of all sectors of industry in the Community.

Some of those sectors produce large numbers of designs for products frequently having a short market life where protection without the burden of registration formalities is an advantage and the duration of protection is of lesser significance. On the other hand, there are sectors of industry which value the advantages of registration for the greater legal certainty it provides and which require the possibility of a longer term of protection corresponding to the foreseeable market life of their products.

This calls for two forms of protection, one being a short-term unregistered design and the other being a longer term registered design.

A registered Community design requires the creation and maintenance of a register in which will be registered all those applications which comply with formal conditions and which have been accorded a date of filing. This registration system should in principle not be based upon substantive examination as to compliance with requirements for protection prior to registration, thereby keeping to a minimum the registration and other procedural burdens on applicants.

A Community design should not be upheld unless the design is new and unless it also possesses an individual character in comparison with other designs.

It is also necessary to allow the designer or his successor in title to test the products embodying the design in the market place before deciding whether the protection resulting from a registered Community design is desirable. To this end it is necessary to provide that disclosures of the design by the designer or his successor in title, or abusive disclosures during a period of 12 months prior to the date of the filing of the application for a registered Community design should not be prejudicial in assessing the novelty or the individual character of the design in question.

The exclusive nature of the right conferred by the registered Community design is consistent with its greater legal certainty. It is appropriate that the unregistered Community design should, however, constitute a right only to prevent copying. Protection could not therefore extend to design products which are the result of a design arrived at independently by a

second designer. This right should also extend to trade in products embodying infringing designs.

The enforcement of these rights is to be left to national laws. It is necessary therefore to provide for some basic uniform sanctions in all Member States. These should make it possible, irrespective of the jurisdiction under which enforcement is sought, to stop the infringing acts.

Any third person who can establish that he has in good faith commenced use even for commercial purposes within the Community, or has made serious and effective preparations to that end, of a design included within the scope of protection of a registered Community design, which has not been copied from the latter, may be entitled to a limited exploitation of that design.

It is a fundamental objective of this Regulation that the procedure for obtaining a registered Community design should present the minimum cost and difficulty to applicants, so as to make it readily available to small and medium-sized enterprises as well as to individual designers.

Those sectors of industry producing large numbers of possibly short-lived designs over short periods of time of which only some may be eventually commercialised will find advantage in the unregistered Community design. Furthermore, there is also a need for these sectors to have easier recourse to the registered Community design. Therefore, the option of combining a number of designs in one multiple application would satisfy that need. However, the designs contained in a multiple application may be dealt with independently of each other for the purposes of enforcement of rights, licensing, rights in rem, levy of execution, insolvency proceedings, surrender, renewal, assignment, deferred publication or declaration of invalidity.

The normal publication following registration of a Community design could in some cases destroy or jeopardise the success of a commercial operation involving the design. The facility of a deferment of publication for a reasonable period affords a solution in such cases.

A procedure for hearing actions concerning validity of a registered Community design in a single place would bring savings in costs and time compared with procedures involving different national courts.

It is therefore necessary to provide safeguards including a right of appeal to a Board of Appeal, and ultimately to the Court of Justice. Such a procedure would assist the development of uniform interpretation of the requirements governing the validity of Community designs.

It is essential that the rights conferred by a Community design can be enforced in an efficient manner throughout the territory of the Community.

The litigation system should avoid as far as possible "forum shopping". It is therefore necessary to establish clear rules of international jurisdiction.

This Regulation does not preclude the application to designs protected by Community designs of the industrial property laws or other relevant laws of the Member States, such as those relating to design protection acquired by registration or those relating to unregistered designs, trade marks, patents and utility models, unfair competition or civil liability.

In the absence of the complete harmonisation of copyright law, it is important to establish the principle of cumulation of protection under the Community design and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred.

The measures necessary for the implementation of this Regulation should be adopted in accordance with Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission(5),

HAS ADOPTED THIS REGULATION:

TITLE I

GENERAL PROVISIONS

Article 1

Community design

A design which complies with the conditions contained in this Regulation is hereinafter referred to as a "Community design".

A design shall be protected:

by an "unregistered Community design", if made available to the public in the manner provided for in this Regulation;

by a "registered Community design", if registered in the manner provided for in this Regulation.

A Community design shall have a unitary character. It shall have equal effect throughout the Community. It shall not be registered, transferred or surrendered or be the subject of a decision declaring it invalid, nor shall its use be prohibited, save in respect of the whole

Community. This principle and its implications shall apply unless otherwise provided in this Regulation.

## Article 2

### Office

The Office for Harmonisation in the Internal Market (Trade Marks and Designs), hereinafter referred to as "the Office", instituted by Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark(6), hereinafter referred to as the "Regulation on the Community trade mark", shall carry out the tasks entrusted to it by this Regulation.

## TITLE II

### THE LAW RELATING TO DESIGNS

#### Section 1

##### Requirements for protection

#### Article 3

##### Definitions

For the purposes of this Regulation:

"design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

"product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

"complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

#### Article 4

##### Requirements for protection

A design shall be protected by a Community design to the extent that it is new and has individual character.

A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and

to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

"Normal use" within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

## Article 5

### Novelty

A design shall be considered to be new if no identical design has been made available to the public:

in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;

in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.

Designs shall be deemed to be identical if their features differ only in immaterial details.

## Article 6

### Individual character

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:

in the case of an unregistered Community design, before the date on which the design for which protection is claimed has first been made available to the public;

in the case of a registered Community design, before the date of filing the application for registration or, if a priority is claimed, the date of priority.

In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

## Article 7

### Disclosure

For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or

exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public:

by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and

during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority.

Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

#### Article 8

Designs dictated by their technical function and designs of interconnections

A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

Notwithstanding paragraph 2, a Community design shall under the conditions set out in Articles 5 and 6 subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

#### Article 9

Designs contrary to public policy or morality

A Community design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

#### Section 2

## Scope and term of protection

### Article 10

#### Scope of protection

The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.

In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

### Article 11

#### Commencement and term of protection of the unregistered Community design

A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the public within the Community.

For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the Community if it has been published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

### Article 12

#### Commencement and term of protection of the registered Community design

Upon registration by the Office, a design which meets the requirements under Section 1 shall be protected by a registered Community design for a period of five years as from the date of the filing of the application. The right holder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.

### Article 13

#### Renewal

Registration of the registered Community design shall be renewed at the request of the right holder or of any person expressly authorised by him, provided that the renewal fee has been paid.

The Office shall inform the right holder of the registered Community design and any person having a right entered in the register of Community designs, referred to in Article 72, hereafter referred to as the "register" in respect of the registered Community design, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office.

The request for renewal shall be submitted and the renewal fee paid within a period of six months ending on the last day of the month in which protection ends. Failing this, the request may be submitted and the fee paid within a further period of six months from the day referred to in the first sentence, provided that an additional fee is paid within this further period.

Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be entered in the register.

### Section 3

#### Right to the Community design

#### Article 14

#### Right to the Community design

The right to the Community design shall vest in the designer or his successor in title.

If two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly.

However, where a design is developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the Community design shall vest in the employer, unless otherwise agreed or specified under national law.

#### Article 15

#### Claims relating to the entitlement to a Community design

If an unregistered Community design is disclosed or claimed by, or a registered Community design has been applied for or registered in the name of, a person who is not entitled to it under Article 14, the person entitled to it under that provision may, without prejudice to any other remedy which may be open to him, claim to become recognised as the legitimate holder of the Community design.

Where a person is jointly entitled to a Community design, that person may, in accordance with paragraph 1, claim to become recognised as joint holder.

Legal proceedings under paragraphs 1 or 2 shall be barred three years after the date of publication of a registered Community design or the date of disclosure of an unregistered Community design. This provision shall not apply if the person who is not entitled to the Community design was acting in bad faith at the time when such design was applied for or disclosed or was assigned to him.

In the case of a registered Community design, the following shall be entered in the register:

the mention that legal proceedings under paragraph 1 have been instituted;

the final decision or any other termination of the proceedings;

any change in the ownership of the registered Community design resulting from the final decision.

#### Article 16

Effects of a judgement on entitlement to a registered Community design

Where there is a complete change of ownership of a registered Community design as a result of legal proceedings under Article 15(1), licences and other rights shall lapse upon the entering in the register of the person entitled.

If, before the institution of the legal proceedings under Article 15(1) has been registered, the holder of the registered Community design or a licensee has exploited the design within the Community or made serious and effective preparations to do so, he may continue such exploitation provided that he requests within the period prescribed by the implementing regulation a non-exclusive licence from the new holder whose name is entered in the register. The licence shall be granted for a reasonable period and upon reasonable terms.

Paragraph 2 shall not apply if the holder of the registered Community design or the licensee was acting in bad faith at the time when he began to exploit the design or to make preparations to do so.

#### Article 17

Presumption in favour of the registered holder of the design

The person in whose name the registered Community design is registered or, prior to registration, the person in whose name the application is filed, shall be deemed to be the person entitled in any proceedings before the Office as well as in any other proceedings.

#### Article 18

Right of the designer to be cited

The designer shall have the right, in the same way as the applicant for or the holder of a registered Community design, to be cited as such before the Office and in the register. If the design is the result of teamwork, the citation of the team may replace the citation of the individual designers.

#### Section 4

#### Effects of the Community design

#### Article 19

#### Rights conferred by the Community design

A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design.

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

Paragraph 2 shall also apply to a registered Community design subject to deferment of publication as long as the relevant entries in the register and the file have not been made available to the public in accordance with Article 50(4).

#### Article 20

#### Limitation of the rights conferred by a Community design

The rights conferred by a Community design shall not be exercised in respect of:

acts done privately and for non-commercial purposes;

acts done for experimental purposes;

acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

In addition, the rights conferred by a Community design shall not be exercised in respect of:

the equipment on ships and aircraft registered in a third country when these temporarily enter the territory of the Community;

the importation in the Community of spare parts and accessories for the purpose of repairing such craft;

the execution of repairs on such craft.

## Article 21

### Exhaustion of rights

The rights conferred by a Community design shall not extend to acts relating to a product in which a design included within the scope of protection of the Community design is incorporated or to which it is applied, when the product has been put on the market in the Community by the holder of the Community design or with his consent.

## Article 22

### Rights of prior use in respect of a registered Community design

A right of prior use shall exist for any third person who can establish that before the date of filing of the application, or, if a priority is claimed, before the date of priority, he has in good faith commenced use within the Community, or has made serious and effective preparations to that end, of a design included within the scope of protection of a registered Community design, which has not been copied from the latter.

The right of prior use shall entitle the third person to exploit the design for the purposes for which its use had been effected, or for which serious and effective preparations had been made, before the filing or priority date of the registered Community design.

The right of prior use shall not extend to granting a licence to another person to exploit the design.

The right of prior use cannot be transferred except, where the third person is a business, along with that part of the business in the course of which the act was done or the preparations were made.

## Article 23

### Government use

Any provision in the law of a Member State allowing use of national designs by or for the government may be applied to Community designs, but only to the extent that the use is necessary for essential defence or security needs.

## Section 5

### Invalidity

#### Article 24

##### Declaration of invalidity

A registered Community design shall be declared invalid on application to the Office in accordance with the procedure in Titles VI and VII or by a Community design court on the basis of a counterclaim in infringement proceedings.

A Community design may be declared invalid even after the Community design has lapsed or has been surrendered.

An unregistered Community design shall be declared invalid by a Community design court on application to such a court or on the basis of a counterclaim in infringement proceedings.

#### Article 25

##### Grounds for invalidity

A Community design may be declared invalid only in the following cases:

if the design does not correspond to the definition under Article 3(a);

if it does not fulfil the requirements of Articles 4 to 9;

if, by virtue of a court decision, the right holder is not entitled to the Community design under Article 14;

if the Community design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if a priority is claimed, the date of priority of the Community design, and which is protected from a date prior to the said date by a registered Community design or an application for such a design, or by a registered design right of a Member State, or by an application for such a right;

if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use;

if the design constitutes an unauthorised use of a work protected under the copyright law of a Member State;

if the design constitutes an improper use of any of the items listed in Article 6ter of the "Paris Convention" for the Protection of Industrial Property hereafter referred to as the "Paris

Convention", or of badges, emblems and escutcheons other than those covered by the said Article 6ter and which are of particular public interest in a Member State.

The ground provided for in paragraph (1)(c) may be invoked solely by the person who is entitled to the Community design under Article 14.

The grounds provided for in paragraph (1)(d), (e) and (f) may be invoked solely by the applicant for or holder of the earlier right.

The ground provided for in paragraph (1)(g) may be invoked solely by the person or entity concerned by the use.

Paragraphs 3 and 4 shall be without prejudice to the freedom of Member States to provide that the grounds provided for in paragraphs 1(d) and (g) may also be invoked by the appropriate authority of the Member State in question on its own initiative.

A registered Community design which has been declared invalid pursuant to paragraph (1)(b), (e), (f) or (g) may be maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. "Maintenance" in an amended form may include registration accompanied by a partial disclaimer by the holder of the registered Community design or entry in the register of a court decision or a decision by the Office declaring the partial invalidity of the registered Community design.

## Article 26

### Consequences of invalidity

A Community design shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that it has been declared invalid.

Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the holder of the Community design, or to unjust enrichment, the retroactive effect of invalidity of the Community design shall not affect:

any decision on infringement which has acquired the authority of a final decision and been enforced prior to the invalidity decision;

any contract concluded prior to the invalidity decision, in so far as it has been performed before the decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity.

## TITLE III

## COMMUNITY DESIGNS AS OBJECTS OF PROPERTY

### Article 27

#### Dealing with Community designs as national design rights

Unless Articles 28, 29, 30, 31 and 32 provide otherwise, a Community design as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national design right of the Member State in which:

the holder has his seat or his domicile on the relevant date; or

where point (a) does not apply, the holder has an establishment on the relevant date.

In the case of a registered Community design, paragraph 1 shall apply according to the entries in the register.

In the case of joint holders, if two or more of them fulfil the condition under paragraph 1, the Member State referred to in that paragraph shall be determined:

in the case of an unregistered Community design, by reference to the relevant joint holder designated by them by common agreement;

in the case of a registered Community design, by reference to the first of the relevant joint holders in the order in which they are mentioned in the register.

Where paragraphs 1, 2 and 3 do not apply, the Member State referred to in paragraph 1 shall be the Member State in which the seat of the Office is situated.

### Article 28

#### Transfer of the registered Community design

The transfer of a registered Community design shall be subject to the following provisions:

at the request of one of the parties, a transfer shall be entered in the register and published;

until such time as the transfer has been entered in the register, the successor in title may not invoke the rights arising from the registration of the Community design;

where there are time limits to be observed in dealings with the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office;

all documents which by virtue of Article 66 require notification to the holder of the registered Community design shall be addressed by the Office to the person registered as holder or his representative, if one has been appointed.

## Article 29

### Rights in rem on a registered Community design

A registered Community design may be given as security or be the subject of rights in rem.

On request of one of the parties, the rights mentioned in paragraph 1 shall be entered in the register and published.

## Article 30

### Levy of execution

A registered Community design may be levied in execution.

As regards the procedure for levy of execution in respect of a registered Community design, the courts and authorities of the Member State determined in accordance with Article 27 shall have exclusive jurisdiction.

On request of one of the parties, levy of execution shall be entered in the register and published.

## Article 31

### Insolvency proceedings

The only insolvency proceedings in which a Community design may be involved shall be those opened in the Member State within the territory of which the centre of a debtor's main interests is situated.

In the case of joint proprietorship of a Community design, paragraph 1 shall apply to the share of the joint proprietor.

Where a Community design is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the register and published in the Community Designs Bulletin referred to in Article 73(1).

## Article 32

### Licensing

A Community design may be licensed for the whole or part of the Community. A licence may be exclusive or non-exclusive.

Without prejudice to any legal proceedings based on the law of contract, the holder may invoke the rights conferred by the Community design against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form in which the design

may be used, the range of products for which the licence is granted and the quality of products manufactured by the licensee.

Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community design only if the right holder consents thereto. However, the holder of an exclusive licence may bring such proceedings if the right holder in the Community design, having been given notice to do so, does not himself bring infringement proceedings within an appropriate period.

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 right holder in a Community design.

In the case of a registered Community design, the grant or transfer of a licence in respect of such right shall, at the request of one of the parties, be entered in the register and published.

### Article 33

#### Effects vis-à-vis third parties

The effects vis-à-vis third parties of the legal acts referred to in Articles 28, 29, 30 and 32 shall be governed by the law of the Member State determined in accordance with Article 27.

However, as regards registered Community designs, legal acts referred to in Articles 28, 29 and 32 shall only have effect vis-à-vis third parties in all the Member States after entry in the register. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the registered Community design after the date of that act but who knew of the act at the date on which the rights were acquired.

Paragraph 2 shall not apply to a person who acquires the registered Community design or a right concerning the registered Community design by way of transfer of the whole of the undertaking or by any other universal succession.

Until such time as common rules for the Member States in the field of insolvency enter into force, the effects vis-à-vis third parties of insolvency proceedings shall be governed by the law of the Member State in which such proceedings are first brought under the national law or the regulations applicable in this field.

### Article 34

The application for a registered Community design as an object of property

An application for a registered Community design as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national design right of the Member State determined in accordance with Article 27.

Articles 28, 29, 30, 31, 32 and 33 shall apply mutatis mutandis to applications for registered Community designs. Where the effect of one of these provisions is conditional upon an entry in the register, that formality shall be performed upon registration of the resulting registered Community design.

#### TITLE IV

#### APPLICATION FOR A REGISTERED COMMUNITY DESIGN

##### Section 1

Filing of applications and the conditions which govern them

##### Article 35

Filing and forwarding of applications

An application for a registered Community design shall be filed, at the option of the applicant:  
at the Office; or  
at the central industrial property office of a Member State; or  
in the Benelux countries, at the Benelux Design Office.

Where the application is filed at the central industrial property office of a Member State or at the Benelux Design Office, that office shall take all steps to forward the application to the Office within two weeks after filing. It may charge the applicant a fee which shall not exceed the administrative costs of receiving and forwarding the application.

As soon as the Office has received an application which has been forwarded by a central industrial property office of a Member State or by the Benelux Design Office, it shall inform the applicant accordingly, indicating the date of its receipt at the Office.

No less than 10 years after the entry into force of this Regulation, the Commission shall draw up a report on the operation of the system of filing applications for registered Community designs, accompanied by any proposals for revision that it may deem appropriate.

##### Article 36

Conditions with which applications must comply

An application for a registered Community design shall contain:

a request for registration;

information identifying the applicant;

a representation of the design suitable for reproduction. However, if the object of the application is a two-dimensional design and the application contains a request for deferment of publication in accordance with Article 50, the representation of the design may be replaced by a specimen.

The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

In addition, the application may contain:

a description explaining the representation or the specimen;

a request for deferment of publication of the registration in accordance with Article 50;

information identifying the representative if the applicant has appointed one;

the classification of the products in which the design is intended to be incorporated or to which it is intended to be applied according to class;

the citation of the designer or of the team of designers or a statement under the applicant's responsibility that the designer or the team of designers has waived the right to be cited.

The application shall be subject to the payment of the registration fee and the publication fee. Where a request for deferment under paragraph 3(b) is filed, the publication fee shall be replaced by the fee for deferment of publication.

The application shall comply with the conditions laid down in the implementing regulation.

The information contained in the elements mentioned in paragraph 2 and in paragraph 3(a) and (d) shall not affect the scope of protection of the design as such.

## Article 37

### Multiple applications

Several designs may be combined in one multiple application for registered Community designs. Except in cases of ornamentation, this possibility is subject to the condition that the products in which the designs are intended to be incorporated or to which they are intended to be applied all belong to the same class of the International Classification for Industrial Designs.

Besides the fees referred to in Article 36(4), the multiple application shall be subject to payment of an additional registration fee and an additional publication fee. Where the

multiple application contains a request for deferment of publication, the additional publication fee shall be replaced by the additional fee for deferment of publication. The additional fees shall correspond to a percentage of the basic fees for each additional design.

The multiple application shall comply with the conditions of presentation laid down in the implementing regulation.

Each of the designs contained in a multiple application or registration may be dealt with separately from the others for the purpose of applying this Regulation. It may in particular, separately from the others, be enforced, licensed, be the subject of a right in rem, a levy of execution or insolvency proceedings, be surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid. A multiple application or registration may be divided into separate applications or registrations only under the conditions set out in the implementing regulation.

#### Article 38

##### Date of filing

The date of filing of an application for a registered Community design shall be the date on which documents containing the information specified in Article 36(1) are filed with the Office by the applicant, or, if the application has been filed with the central industrial property office of a Member State or with the Benelux Design Office, with that office.

By derogation from paragraph 1, the date of filing of an application filed with the central industrial property office of a Member State or with the Benelux Design Office and reaching the Office more than two months after the date on which documents containing the information specified in Article 36(1) have been filed shall be the date of receipt of such documents by the Office.

#### Article 39

##### Equivalence of Community filing with national filing

An application for a registered Community design which has been accorded a date of filing shall, in the Member States, be equivalent to a regular national filing, including where appropriate the priority claimed for the said application.

#### Article 40

##### Classification

For the purpose of this Regulation, use shall be made of the Annex to the Agreement establishing an International Classification for Industrial Designs, signed at Locarno on 8 October 1968.

## Section 2

### Priority

#### Article 41

##### Right of priority

A person who has duly filed an application for a design right or for a utility model in or for any State party to the Paris Convention for the Protection of Industrial Property, or to the Agreement establishing the World Trade Organisation, or his successors in title, shall enjoy, for the purpose of filing an application for a registered Community design in respect of the same design or utility model, a right of priority of six months from the date of filing of the first application.

Every filing that 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.

"Regular national filing" means any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

A subsequent application for a design which was the subject of a previous first application, and which is filed in or in respect of the same State, shall be considered as the first application for the purpose of determining priority, provided that, at the date of the filing of the subsequent application, the previous application has been withdrawn, abandoned or refused without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

If the first filing has been made in a State which is not a party to the Paris Convention, or to the Agreement establishing the World Trade Organisation, paragraphs 1 to 4 shall apply only in so far as that State, according to published findings, grants, on the basis of a filing made at the Office and subject to conditions equivalent to those laid down in this Regulation, a right of priority having equivalent effect.

#### Article 42

##### Claiming priority

An applicant for a registered Community design desiring to take advantage of the priority of a previous application shall file a declaration of priority and a copy of the previous application. If the language of the latter is not one of the languages of the Office, the Office may require a translation of the previous application in one of those languages.

#### Article 43

##### Effect of priority right

The effect of the right of priority shall be that the date of priority shall count as the date of the filing of the application for a registered Community design for the purpose of Articles 5, 6, 7, 22, 25(1)(d) and 50(1).

#### Article 44

##### Exhibition priority

If an applicant for a registered Community design has disclosed products in which the design is incorporated, or to which it is applied, at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions signed in Paris on 22 November 1928 and last revised on 30 November 1972, he may, if he files the application within a period of six months from the date of the first disclosure of such products, claim a right of priority from that date within the meaning of Article 43.

An applicant who wishes to claim priority pursuant to paragraph 1, under the conditions laid down in the implementing regulation, must file evidence that he has disclosed at an exhibition the products in or to which the design is incorporated or applied.

An exhibition priority granted in a Member State or in a third country does not extend the period of priority laid down in Article 41.

## TITLE V

### REGISTRATION PROCEDURE

#### Article 45

##### Examination as to formal requirements for filing

The Office shall examine whether the application complies with the requirements laid down in Article 36(1) for the accordancy of a date of filing.

The Office shall examine whether:

the application complies with the other requirements laid down in Article 36(2), (3), (4) and (5) and, in the case of a multiple application, Article 37(1) and (2);

the application meets the formal requirements laid down in the implementing regulation for the implementation of Articles 36 and 37;

the requirements of Article 77(2) are satisfied;

the requirements concerning the claim to priority are satisfied, if a priority is claimed.

The conditions for the examination as to the formal requirements for filing shall be laid down in the implementing regulation.

## Article 46

### Remediable deficiencies

Where, in carrying out the examination under Article 45, the Office notes that there are deficiencies which may be corrected, the Office shall request the applicant to remedy them within the prescribed period.

If the deficiencies concern the requirements referred to in Article 36(1) and the applicant complies with the Office's request within the prescribed period, the Office shall accord as the date of filing the date on which the deficiencies are remedied. If the deficiencies are not remedied within the prescribed period, the application shall not be dealt with as an application for a registered Community design.

If the deficiencies concern the requirements, including the payment of fees, as referred to in Article 45(2)(a), (b) and (c) and the applicant complies with the Office's request within the prescribed period, the Office shall accord as the date of filing the date on which the application was originally filed. If the deficiencies or the default in payment are not remedied within the prescribed period, the Office shall refuse the application.

If the deficiencies concern the requirements referred to in Article 45(2)(d), failure to remedy them within the prescribed period shall result in the loss of the right of priority for the application.

## Article 47

### Grounds for non-registrability

If the Office, in carrying out the examination pursuant to Article 45, notices that the design for which protection is sought:

does not correspond to the definition under Article 3(a); or

is contrary to public policy or to accepted principles of morality, it shall refuse the application.

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

#### Article 48

##### Registration

If the requirements that an application for a registered Community design must satisfy have been fulfilled and to the extent that the application has not been refused by virtue of Article 47, the Office shall register the application in the Community design Register as a registered Community design. The registration shall bear the date of filing of the application referred to in Article 38.

#### Article 49

##### Publication

Upon registration, the Office shall publish the registered Community design in the Community Designs Bulletin as mentioned in Article 73(1). The contents of the publication shall be set out in the implementing regulation.

#### Article 50

##### Deferment of publication

The applicant for a registered Community design may request, when filing the application, that the publication of the registered Community design be deferred for a period of 30 months from the date of filing the application or, if a priority is claimed, from the date of priority.

Upon such request, where the conditions set out in Article 48 are satisfied, the registered Community design shall be registered, but neither the representation of the design nor any file relating to the application shall, subject to Article 74(2), be open to public inspection.

The Office shall publish in the Community Designs Bulletin a mention of the deferment of the publication of the registered Community design. The mention shall be accompanied by information identifying the right holder in the registered Community design, the date of filing the application and any other particulars prescribed by the implementing regulation.

At the expiry of the period of deferment, or at any earlier date on request by the right holder, the Office shall open to public inspection all the entries in the register and the file relating to the application and shall publish the registered Community design in the Community Designs Bulletin, provided that, within the time limit laid down in the implementing regulation:

the publication fee and, in the event of a multiple application, the additional publication fee are paid;

where use has been made of the option pursuant to Article 36(1)(c), the right holder has filed with the Office a representation of the design.

If the right holder fails to comply with these requirements, the registered Community design shall be deemed from the outset not to have had the effects specified in this Regulation.

In the case of multiple applications, paragraph 4 need only be applied to some of the designs included therein.

The institution of legal proceedings on the basis of a registered Community design during the period of deferment of publication shall be subject to the condition that the information contained in the register and in the file relating to the application has been communicated to the person against whom the action is brought.

## TITLE VI

### SURRENDER AND INVALIDITY OF THE REGISTERED COMMUNITY DESIGN

#### Article 51

##### Surrender

The surrender of a registered Community design shall be declared to the Office in writing by the right holder. It shall not have effect until it has been entered in the register.

If a Community design which is subject to deferment of publication is surrendered it shall be deemed from the outset not to have had the effects specified in this Regulation.

A registered Community design may be partially surrendered provided that its amended form complies with the requirements for protection and the identity of the design is retained.

Surrender shall be registered only with the agreement of the proprietor of a right entered in the register. If a licence has been registered, surrender shall be entered in the register only if the right holder in the registered Community design proves that he has informed the licensee of his intention to surrender. This entry shall be made on expiry of the period prescribed by the implementing regulation.

If an action pursuant to Article 14 relating to the entitlement to a registered Community design has been brought before a Community design court, the Office shall not enter the surrender in the register without the agreement of the claimant.

#### Article 52

## Application for a declaration of invalidity

Subject to Article 25(2), (3), (4) and (5), any natural or legal person, as well as a public authority empowered to do so, may submit to the Office an application for a declaration of invalidity of a registered Community design.

The application shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the fee for an application for a declaration of invalidity has been paid.

An application for a declaration of invalidity shall not be admissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a Community design court and has acquired the authority of a final decision.

## Article 53

### Examination of the application

If the Office finds that the application for a declaration of invalidity is admissible, the Office shall examine whether the grounds for invalidity referred to in Article 25 prejudice the maintenance of the registered Community design.

In the examination of the application, which shall be conducted in accordance with the implementing regulation, the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.

The decision declaring the registered Community design invalid shall be entered in the register upon becoming final.

## Article 54

### Participation in the proceedings of the alleged infringer

In the event of an application for a declaration of invalidity of a registered Community design being filed, and as long as no final decision has been taken by the Office, any third party who proves that proceedings for infringement of the same design have been instituted against him may be joined as a party in the invalidity proceedings on request submitted within three months of the date on which the infringement proceedings were instituted.

The same shall apply in respect of any third party who proves both that the right holder of the Community design has requested that he cease an alleged infringement of the design and that

he has instituted proceedings for a court ruling that he is not infringing the Community design.

The request to be joined as a party shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the invalidity fee, referred to in Article 52(2), has been paid. Thereafter the request shall, subject to any exceptions laid down in the implementing regulation, be treated as an application for a declaration of invalidity.

## TITLE VII

### APPEALS

#### Article 55

##### Decisions subject to appeal

An appeal shall lie from decisions of the examiners, the Administration of Trade Marks and Designs and Legal Division and Invalidity Divisions. It shall have suspensive effect.

A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

#### Article 56

##### Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

#### Article 57

##### Time limit and form of appeal

Notice of appeal must be filed in writing at the Office within two months after the date of notification of the decision appealed from. The notice shall be deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

#### Article 58

##### Interlocutory revision

If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings.

If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal without delay and without comment as to its merits.

#### Article 59

##### Examination of appeals

If the appeal is admissible, the Board of Appeal shall examine whether the appeal is to be allowed.

In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

#### Article 60

##### Decisions in respect of appeals

Following the examination as to the merits of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed against or remit the case to that department for further prosecution.

If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same.

The decisions of the Boards of Appeal shall take effect only from the date of expiry of the period referred to in Article 61(5) or, if an action has been brought before the Court of Justice within that period, from the date of rejection of such action.

#### Article 61

##### Actions before the Court of Justice

Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.

The Court of Justice has jurisdiction to annul or to alter the contested decision.

The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision.

The action shall be brought before the Court of Justice within two months of the date of notification of the decision of the Board of Appeal.

The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.

## TITLE VIII

### PROCEDURE BEFORE THE OFFICE

#### Section 1

##### General provisions

#### Article 62

##### Statement of reasons on which decisions are based

Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

#### Article 63

##### 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. However, in proceedings relating to a declaration of invalidity, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

#### Article 64

##### Oral proceedings

If the Office considers that oral proceedings would be expedient, they shall be held either at the instance of the Office or at the request of any party to the proceedings.

Oral proceedings, including delivery of the decision, shall be public, unless the department before which the proceedings are taking place decides otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

## Article 65

### Taking of evidence

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

hearing the parties;

requests for information;

the production of documents and items of evidence;

hearing witnesses;

opinions by experts;

statements in writing, sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.

The relevant department of the Office may commission one of its members to examine the evidence adduced.

If the Office considers it necessary for a party, witness or expert to give evidence orally, it shall issue a summons to the person concerned to appear before it.

The parties shall be informed of the hearing of a witness or expert before the Office. They shall have the right to be present and to put questions to the witness or expert.

## Article 66

### Notification

The Office shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of the implementing regulation, or of which notification has been ordered by the President of the Office.

## Article 67

### Restitutio in integrum

The applicant for or holder of a registered Community design or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the non-observance in question has the direct

consequence, by virtue of the provisions of this Regulation, of causing the loss of any rights or means of redress.

The application must be filed in writing within two months of the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided for in the second sentence of Article 13(3) shall be deducted from the period of one year.

The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until the fee for the re-establishment of rights has been paid.

The department competent to decide on the omitted act shall decide upon the application.

The provisions of this Article shall not be applicable to the time limits referred to in paragraph 2 and Article 41(1).

Where the applicant for or holder of a registered Community design has his rights re-established, he may not invoke his rights vis-à-vis a third party who, in good faith, in the course of the period between the loss of rights in the application for or registration of the registered Community design and publication of the mention of re-establishment of those rights, has put on the market products in which a design included within the scope of protection of the registered Community design is incorporated or to which it is applied.

A third party who may avail himself of the provisions of paragraph 6 may bring third party proceedings against the decision re-establishing the rights of the applicant for or holder of the registered Community design within a period of two months as from the date of publication of the mention of re-establishment of those rights.

Nothing in this Article shall limit the right of a Member State to grant *restitutio in integrum* in respect of time limits provided for in this Regulation and to be complied with vis-à-vis the authorities of such State.

## Article 68

### Reference to general principles

In the absence of procedural provisions in this Regulation, the implementing regulation, the fees regulation or the rules of procedure of the Boards of Appeal, the Office shall take into account the principles of procedural law generally recognised in the Member States.

## Article 69

### Termination of financial obligations

Rights of the Office to the payment of fees shall be barred four years from the end of the calendar year in which the fee fell due.

Rights against the Office for the refunding of fees or sums of money paid in excess of a fee shall be barred after four years from the end of the calendar year in which the right arose.

The periods laid down in paragraphs 1 and 2 shall be interrupted, in the case covered by paragraph 1, by a request for payment of the fee and, in the case covered by paragraph 2, by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at the latest six years after the end of the year in which it originally began, unless in the meantime judicial proceedings to enforce the right have begun. In this case the period shall end at the earliest one year after the judgment has acquired the authority of a final decision.

## Section 2

### Costs

## Article 70

### Apportionment of costs

The losing party in proceedings for a declaration of invalidity of a registered Community design or appeal proceedings shall bear the fees incurred by the other party as well as all costs incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of scales set for each category of costs under the conditions laid down in the implementing regulation.

However, where each party succeeds on some and fails on other heads, or if reasons of equity so dictate, the Invalidity Division or Board of Appeal shall decide a different apportionment of costs.

A party who terminates the proceedings by surrendering the registered Community design or by not renewing its registration or by withdrawing the application for a declaration of invalidity or the appeal, shall bear the fees and the costs incurred by the other party as stipulated in paragraphs 1 and 2.

Where a case does not proceed to judgment, the costs shall be at the discretion of the Invalidity Division or Board of Appeal.

Where the parties conclude before the Invalidation Division or Board of Appeal a settlement of costs differing from that provided for in paragraphs 1, 2, 3 and 4, the body concerned shall take note of that agreement.

On request, the registry of the Invalidation Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs. The amount so determined may be reviewed by a decision of the Invalidation Division or Board of Appeal on a request filed within the period prescribed by the implementing regulation.

#### Article 71

##### Enforcement of decisions fixing the amount of costs

Any final decision of the Office fixing the amount of costs shall be enforceable.

Enforcement shall be governed by the rules of civil procedure in force in the State in the territory of which it is carried out. The order for its enforcement shall be appended to the decision, without any other formality than verification of the authenticity of the decision, by the national authority which the government of each Member State shall designate for this purpose and shall make known to the Office and to the Court of Justice.

When these formalities have been completed on application by the party concerned, the latter may proceed to enforcement in accordance with the national law, by bringing the matter directly before the competent authority.

Enforcement may be suspended only by a decision of the Court of Justice. However, the courts of the Member State concerned shall have jurisdiction over complaints that enforcement is being carried out in an irregular manner.

#### Section 3

##### Informing the public and the official authorities of the Member States

#### Article 72

##### Register of Community designs

The Office shall keep a register to be known as the register of Community designs, which shall contain those particulars of which the registration is provided for by this Regulation or by the implementing regulation. The register shall be open to public inspection, except to the extent that Article 50(2) provides otherwise.

#### Article 73

##### Periodical publications

This Office shall periodically publish a Community Designs Bulletin containing entries open to public inspection in the register as well as other particulars the publication of which is prescribed by this Regulation or by the implementing regulation.

Notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation, shall be published in the Official Journal of the Office.

#### Article 74

##### Inspection of files

The files relating to applications for registered Community designs which have not yet been published or the files relating to registered Community designs which are subject to deferment of publication in accordance with Article 50 or which, being subject to such deferment, have been surrendered before or on the expiry of that period, shall not be made available for inspection without the consent of the applicant for or the right holder in the registered Community design.

Any person who can establish a legitimate interest may inspect a file without the consent of the applicant for or holder of the registered Community design prior to the publication or after the surrender of the latter in the case provided for in paragraph 1.

This shall in particular apply if the interested person proves that the applicant for or the holder of the registered Community design has taken steps with a view to invoking against him the right under the registered Community design.

Subsequent to the publication of the registered Community design, the file may be inspected on request.

However, where a file is inspected pursuant to paragraph 2 or 3, certain documents in the file may be withheld from inspection in accordance with the provisions of the implementing regulation.

#### Article 75

##### Administrative cooperation

Unless otherwise provided in this Regulation or in national laws, the Office and the courts or authorities of the Member States shall on request give assistance to each other by communicating information or opening files for inspection.

Where the Office opens files to inspection by courts, public prosecutors' offices or central industrial property offices, the inspection shall not be subject to the restrictions laid down in Article 74.

## Article 76

### Exchange of publications

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

The Office may conclude agreements relating to the exchange or supply of publications.

## Section 4

### Representation

## Article 77

### General principles of representation

Subject to paragraph 2, no person shall be compelled to be represented before the Office.

Without prejudice to the second subparagraph of paragraph 3, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 78(1) in all proceedings before the Office established by this Regulation, other than in filing an application for a registered Community design; the implementing regulation may permit other exceptions.

Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by one of their employees, who must file with it a signed authorisation for inclusion in the files, the details of which are set out in the implementing regulation.

An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community.

## Article 78

### Professional representation

Representation of natural or legal persons in proceedings before the Office under this Regulation may only be undertaken by:

any legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in industrial property matters; or

any professional representatives whose name has been entered on the list of professional representatives referred to in Article 89(1)(b) of the Regulation on the Community trade mark; or

persons whose names are entered on the special list of professional representatives for design matters referred to in paragraph 4.

The persons referred to in paragraph 1(c) shall only be entitled to represent third persons in proceedings on design matters before the Office.

The implementing regulation shall provide whether and under what conditions representatives must file with the Office a signed authorisation for insertion on the files.

Any natural person may be entered on the special list of professional representatives in design matters, if he fulfils the following conditions:

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

he must have his place of business or employment in the Community;

he must be entitled to represent natural or legal persons in design matters before the central industrial property office of a Member State or before the Benelux Design Office. Where, in that State, the entitlement to represent in design matters is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list must have habitually acted in design matters before the central industrial property office of the said State for at least five years. However, persons whose professional qualification to represent natural or legal persons in design matters before the central industrial property office of one of the Member States is officially recognised in accordance with the regulations laid by such State shall not be subject to the condition of having exercised the profession.

Entry on the list referred to in paragraph 4 shall be effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions laid down in the said paragraph are fulfilled.

The President of the Office may grant exemption from:

the requirement of paragraph 4(a) in special circumstances;

the requirement of paragraph 4(c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way.

The conditions under which a person may be removed from the list shall be laid down in the implementing regulation.

## TITLE IX

### JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO COMMUNITY DESIGNS

#### Section 1

#### Jurisdiction and enforcement

#### Article 79

#### Application of the Convention on Jurisdiction and Enforcement

Unless otherwise specified in this Regulation, the Convention on Jurisdiction and the Enforcement of Judgements in Civil and Commercial Matters, signed in Brussels on 27 September 1968(7), hereinafter referred to as the "Convention on Jurisdiction and Enforcement", shall apply to proceedings relating to Community designs and applications for registered Community designs, as well as to proceedings relating to actions on the basis of Community designs and national designs enjoying simultaneous protection.

The provisions of the Convention on Jurisdiction and Enforcement which are rendered applicable by the paragraph 1 shall have effect in respect of any Member State solely in the text which is in force in respect of that State at any given time.

In the event of proceedings in respect of the actions and claims referred to in Article 85:

Articles 2, 4, 5(1), (3), (4) and (5), 16(4) and 24 of the Convention on Jurisdiction and Enforcement shall not apply;

Articles 17 and 18 of that Convention shall apply subject to the limitations in Article 82(4) of this Regulation;

the provisions of Title II of that Convention which are applicable to persons domiciled in a Member State shall also be applicable to persons who do not have a domicile in any Member State but have an establishment therein.

The provisions of the Convention on Jurisdiction and Enforcement shall not have effect in respect of any Member State for which that Convention has not yet entered into force. Until

such entry into force, proceedings referred to in paragraph 1 shall be governed in such a Member State by any bilateral or multilateral convention governing its relationship with another Member State concerned, or, if no such convention exists, by its domestic law on jurisdiction, recognition and enforcement of decisions.

## Section 2

Disputes concerning the infringement and validity of Community designs

### Article 80

Community design courts

The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance (Community design courts) which shall perform the functions assigned to them by this Regulation.

Each Member State shall communicate to the Commission not later than 6 March 2005 a list of Community design courts, indicating their names and their territorial jurisdiction.

Any change made after communication of the list referred to in paragraph 2 in the number, names or territorial jurisdiction of the Community design courts shall be notified without delay by the Member State concerned to the Commission.

The information referred to in paragraphs 2 and 3 shall be notified by the Commission to the Member States and published in the Official Journal of the European Communities.

As long as a Member State has not communicated the list as stipulated in paragraph 2, jurisdiction for any proceedings resulting from an action covered by Article 81 for which the courts of that State have jurisdiction pursuant to Article 82 shall lie with that court of the State in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national design right of that State.

### Article 81

Jurisdiction over infringement and validity

The Community design courts shall have exclusive jurisdiction:

for infringement actions and - if they are permitted under national law - actions in respect of threatened infringement of Community designs;

for actions for declaration of non-infringement of Community designs, if they are permitted under national law;

for actions for a declaration of invalidity of an unregistered Community design;

for counterclaims for a declaration of invalidity of a Community design raised in connection with actions under (a).

## Article 82

### International jurisdiction

Subject to the provisions of this Regulation and to any provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 79, proceedings in respect of the actions and claims referred to in Article 81 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

Notwithstanding paragraphs 1, 2 and 3:

Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a different Community design court shall have jurisdiction;

Article 18 of that Convention shall apply if the defendant enters an appearance before a different Community design court.

Proceedings in respect of the actions and claims referred to in Article 81(a) and (d) may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened.

## Article 83

### Extent of jurisdiction on infringement

A Community design court whose jurisdiction is based on Article 82(1), (2) (3) or (4) shall have jurisdiction in respect of acts of infringement committed or threatened within the territory of any of the Member States.

A Community design court whose jurisdiction is based on Article 82(5) shall have jurisdiction only in respect of acts of infringement committed or threatened within the territory of the Member State in which that court is situated.

## Article 84

### Action or counterclaim for a declaration of invalidity of a Community design

An action or a counterclaim for a declaration of invalidity of a Community design may only be based on the grounds for invalidity mentioned in Article 25.

In the cases referred to in Article 25(2), (3), (4) and (5) the action or the counterclaim may be brought solely by the person entitled under those provisions.

If the counterclaim is brought in a legal action to which the right holder of the Community design is not already a party, he shall be informed thereof and may be joined as a party to the action in accordance with the conditions set out in the law of the Member State where the court is situated.

The validity of a Community design may not be put in issue in an action for a declaration of non-infringement.

## Article 85

### Presumption of validity - defence as to the merits

In proceedings in respect of an infringement action or an action for threatened infringement of a registered Community design, the Community design court shall treat the Community design as valid. Validity may be challenged only with a counterclaim for a declaration of invalidity. However, a plea relating to the invalidity of a Community design, submitted otherwise than by way of counterclaim, shall be admissible in so far as the defendant claims that the Community design could be declared invalid on account of an earlier national design right, within the meaning of Article 25(1)(d), belonging to him.

In proceedings in respect of an infringement action or an action for threatened infringement of an unregistered Community design, the Community design court shall treat the Community design as valid if the right holder produces proof that the conditions laid down in Article 11 have been met and indicates what constitutes the individual character of his Community design. However, the defendant may contest its validity by way of a plea or with a counterclaim for a declaration of invalidity.

## Article 86

### Judgements of invalidity

Where in a proceeding before a Community design court the Community design has been put in issue by way of a counterclaim for a declaration of invalidity:

if any of the grounds mentioned in Article 25 are found to prejudice the maintenance of the Community design, the court shall declare the Community design invalid;

if none of the grounds mentioned in Article 25 is found to prejudice the maintenance of the Community design, the court shall reject the counterclaim.

The Community design court with which a counterclaim for a declaration of invalidity of a registered Community design has been filed shall inform the Office of the date on which the counterclaim was filed. The latter shall record this fact in the register.

The Community design court hearing a counterclaim for a declaration of invalidity of a registered Community design may, on application by the right holder of the registered Community design and after hearing the other parties, stay the proceedings and request the defendant to submit an application for a declaration of invalidity to the Office within a time limit which the court shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 91(3) shall apply.

Where a Community design court has given a judgment which has become final on a counterclaim for a declaration of invalidity of a registered Community design, a copy of the judgment shall be sent to the Office. Any party may request information about such transmission. The Office shall mention the judgment in the register in accordance with the provisions of the implementing regulation.

No counterclaim for a declaration of invalidity of a registered Community design may be made if an application relating to the same subject matter and cause of action, and involving the same parties, has already been determined by the Office in a decision which has become final.

#### Article 87

##### Effects of the judgement on invalidity

When it has become final, a judgment of a Community design court declaring a Community design invalid shall have in all the Member States the effects specified in Article 26.

#### Article 88

##### Applicable law

The Community design courts shall apply the provisions of this Regulation.

On all matters not covered by this Regulation, a Community design court shall apply its national law, including its private international law.

Unless otherwise provided in this Regulation, a Community design court shall apply the rules of procedure governing the same type of action relating to a national design right in the Member State where it is situated.

#### Article 89

##### Sanctions in actions for infringement

Where in an action for infringement or for threatened infringement a Community design court finds that the defendant has infringed or threatened to infringe a Community design, it shall, unless there are special reasons for not doing so, order the following measures:

an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the Community design;

an order to seize the infringing products;

an order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew the effect for which such use was intended or if such effect would have been obvious in the circumstances;

any order imposing other sanctions appropriate under the circumstances which are provided by the law of the Member State in which the acts of infringement or threatened infringement are committed, including its private international law.

The Community design court shall take such measures in accordance with its national law as are aimed at ensuring that the orders referred to in paragraph 1 are complied with.

#### Article 90

##### Provisional measures, including protective measures

Application may be made to the courts of a Member State, including Community design courts, for such provisional measures, including protective measures, in respect of a Community design as may be available under the law of that State in respect of national design rights even if, under this Regulation, a Community design court of another Member State has jurisdiction as to the substance of the matter.

In proceedings relating to provisional measures, including protective measures, a plea otherwise than by way of counterclaim relating to the invalidity of a Community design

submitted by the defendant shall be admissible. Article 85(2) shall, however, apply *mutatis mutandis*.

A Community design court whose jurisdiction is based on Article 82(1), (2), (3) or (4) shall have jurisdiction to grant provisional measures, including protective measures, which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of the Convention on Jurisdiction and Enforcement, are applicable in the territory of any Member State. No other court shall have such jurisdiction.

#### Article 91

##### Specific rules on related actions

A Community design court hearing an action referred to in Article 81, other than an action for a declaration of non-infringement, shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties, or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community design is already in issue before another Community design court on account of a counterclaim or, in the case of a registered Community design, where an application for a declaration of invalidity has already been filed at the Office.

The Office, when hearing an application for a declaration of invalidity of a registered Community design, shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties, or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the registered Community design is already in issue on account of a counterclaim before a Community design court. However, if one of the parties to the proceedings before the Community design court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

Where the Community design court stays the proceedings it may order provisional measures, including protective measures, for the duration of the stay.

#### Article 92

##### Jurisdiction of Community design courts of second instance - further appeal

An appeal to the Community design courts of second instance shall lie from judgments of the Community design courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 81.

The conditions under which an appeal may be lodged with a Community design court of second instance shall be determined by the national law of the Member State in which that court is located.

The national rules concerning further appeal shall be applicable in respect of judgments of Community design courts of second instance.

### Section 3

Other disputes concerning Community designs

#### Article 93

Supplementary provisions on the jurisdiction of national courts other than Community design courts

Within the Member State whose courts have jurisdiction under Article 79(1) or (4), those courts shall have jurisdiction for actions relating to Community designs other than those referred to in Article 81 which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to a national design right in that State.

Actions relating to a Community design, other than those referred to in Article 81, for which no court has jurisdiction pursuant to Article 79(1) and (4) and paragraph 1 of this Article may be heard before the courts of the Member State in which the Office has its seat.

#### Article 94

Obligation of the national court

A national court which is dealing with an action relating to a Community design other than the actions referred to in Article 81 shall treat the design as valid. Articles 85(2) and 90(2) shall, however, apply *mutatis mutandis*.

## TITLE X

### EFFECTS ON THE LAWS OF THE MEMBER STATES

#### Article 95

Parallel actions on the basis of Community designs and national design rights

Where actions for infringement or for threatened infringement involving the same cause of action and between the same parties are brought before the courts of different Member States, one seized on the basis of a Community design and the other seized on the basis of a national design right providing simultaneous protection, the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court. The court which would be

required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested.

The Community design court hearing an action for infringement or threatened infringement on the basis of a Community design shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of a design right providing simultaneous protection.

The court hearing an action for infringement or for threatened infringement on the basis of a national design right shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of a Community design providing simultaneous protection.

Paragraphs 1, 2 and 3 shall not apply in respect of provisional measures, including protective measures.

## Article 96

### Relationship to other forms of protection under national law

The provisions of this Regulation shall be without prejudice to any provisions of Community law or of the law of the Member States concerned relating to unregistered designs, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability and unfair competition.

A design protected by a Community design shall also be eligible for protection under the law of copyright of Member States as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.

## TITLE XI

### SUPPLEMENTARY PROVISIONS CONCERNING THE OFFICE

#### Section 1

#### General provisions

#### Article 97

#### General provision

Unless otherwise provided in this Title, Title XII of the Regulation on the Community trade mark shall apply to the Office with regard to its tasks under this Regulation.

#### Article 98

## Language of proceedings

The application for a registered Community design shall be filed in one of the official languages of the Community.

The applicant must indicate a second language which shall be a language of the Office the use of which he accepts as a possible language of proceedings before the Office.

If the application was filed in a language which is not one of the languages of the Office, the Office shall arrange to have the application translated into the language indicated by the applicant.

Where the applicant for a registered Community design is the sole party to proceedings before the Office, the language of proceedings shall be the language used for filing the application. If the application was made in a language other than the languages of the Office, the Office may send written communications to the applicant in the second language indicated by the applicant in his application.

In the case of invalidity proceedings, the language of proceedings shall be the language used for filing the application for a registered Community design if this is one of the languages of the Office. If the application was made in a language other than the languages of the Office, the language of proceedings shall be the second language indicated in the application.

The application for a declaration of invalidity shall be filed in the language of proceedings.

Where the language of proceedings is not the language used for filing the application for a registered Community design, the right holder of the Community design may file observations in the language of filing. The Office shall arrange to have those observations translated into the language of proceedings.

The implementing regulation may provide that the translation expenses to be borne by the Office may not, subject to a derogation granted by the Office where justified by the complexity of the case, exceed an amount to be fixed for each category of proceedings on the basis of the average size of statements of case received by the Office. Expenditure in excess of this amount may be allocated to the losing party in accordance with Article 70.

Parties to invalidity proceedings may agree that a different official language of the Community is to be the language of the proceedings.

## Article 99

### Publication and register

All information the publication of which is prescribed by this Regulation or the implementing regulation shall be published in all the official languages of the Community.

All entries in the Register of Community designs shall be made in all the official languages of the Community.

In cases of doubt, the text in the language of the Office in which the application for a registered Community design was filed shall be authentic. If the application was filed in an official language of the Community other than one of the languages of the Office, the text in the second language indicated by the applicant shall be authentic.

#### Article 100

##### Supplementary powers of the President

In addition to the functions and powers conferred on the President of the Office by Article 119 of the Regulation on the Community trade mark, the President may place before the Commission any proposal to amend this Regulation, the implementing regulation, the fees regulation and any other rule to the extent that they apply to registered Community designs, after consulting the Administrative Board and, in the case of the fees regulation, the Budget Committee.

#### Article 101

##### Supplementary powers of the Administrative Board

In addition to the powers conferred on it by Article 121 et seq of the Regulation on the Community trade mark or by other provisions of this Regulation, the Administrative Board; shall set the date for the first filing of applications for registered Community designs pursuant to Article 111(2);

shall be consulted before adoption of the guidelines for examination as to formal requirements, examination as to grounds for refusal of registration and invalidity proceedings in the Office and in the other cases provided for in this Regulation.

#### Section 2

##### Procedures

#### Article 102

##### Competence

For taking decisions in connection with the procedures laid down in this Regulation the following shall be competent:

examiners;

the Administration of Trade Marks and Designs and Legal Division;

Invalidity Divisions;

Boards of Appeal.

Article 103

Examiners

An examiner shall be responsible for taking decisions on behalf of the Office in relation to an application for a registered Community design.

Article 104

The Administration of Trade Marks and Designs and Legal Division

The Administration of Trade Marks and Legal Division provided for by Article 128 of the Regulation on the Community trade mark shall become the Administration of Trade Marks and Designs and Legal Division.

In addition to the powers conferred upon it by the Regulation on the Community trade mark, it shall be responsible for taking those decisions required by this Regulation which do not fall within the competence of an examiner or an Invalidation Division. It shall in particular be responsible for decisions in respect of entries in the register.

Article 105

Invalidation Divisions

An Invalidation Division shall be responsible for taking decisions in relation to applications for declarations of invalidity of registered Community designs.

An Invalidation Division shall consist of three members. At least one of the members must be legally qualified.

Article 106

Boards of Appeal

In addition to the powers conferred upon it by Article 131 of the Regulation on the Community trade mark, the Boards of Appeal instituted by that Regulation shall be responsible for deciding on appeals from decisions of the examiners, the Invalidation Divisions and from the decisions of the Administration of Trade Marks and Designs and Legal Division as regards their decisions concerning Community designs.

## TITLE XII

### FINAL PROVISIONS

#### Article 107

##### Implementing regulation

The rules implementing this Regulation shall be adopted in an implementing regulation.

In addition to the fees already provided for in this Regulation, fees shall be charged, in accordance with the detailed rules of application laid down in the implementing regulation and in a fees regulation, in the cases listed below:

late payment of the registration fee;

late payment of the publication fee;

late payment of the fee for deferment of publication;

late payment of additional fees for multiple applications;

issue of a copy of the certificate of registration;

registration of the transfer of a registered Community design;

registration of a licence or another right in respect of a registered Community design;

cancellation of the registration of a licence or another right;

issue of an extract from the register;

inspection of the files;

issue of copies of file documents;

communication of information in a file;

review of the determination of the procedural costs to be refunded;

issue of certified copies of the application.

The implementing regulation and the fees regulation shall be adopted and amended in accordance with the procedure laid down in Article 109(2).

#### Article 108

##### Rules of procedure of the Boards of Appeal

The rules of procedure of the Boards of Appeal shall apply to appeals heard by those Boards under this Regulation, without prejudice to any necessary adjustment or additional provision, adopted in accordance with the procedure laid down in Article 109(2).

## Article 109

### Committee

The Commission shall be assisted by a Committee.

Where reference is made to this paragraph, Articles 5 and 7 of Decision 1999/468/EC shall apply.

The period laid down in Article 5(6) of Decision 1999/468/EC shall be set at three months.

The Committee shall adopt its rules of procedure

## Article 110

### Transitional provision

Until such time as amendments to this Regulation enter into force on a proposal from the Commission on this subject, protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance.

The proposal from the Commission referred to in paragraph 1 shall be submitted together with, and take into consideration, any changes which the Commission shall propose on the same subject pursuant to Article 18 of Directive 98/71/EC.

## Article 111

### Entry into force

This Regulation shall enter into force on the 60th day following its publication in the Official Journal of the European Communities.

Applications for registered Community designs may be filed at the Office from the date fixed by the Administrative Board on the recommendation of the President of the Office.

Applications for registered Community designs filed within three months before the date referred to in paragraph 2 shall be deemed to have been filed on that date.

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

Done at Brussels, 12 December 2001.

For the Council

The President

M. Aelvoet

OJ C 29, 31.1.1994, p. 20 and OJ C 248, 29.8.2000, p. 3.

OJ C 67, 1.3.2001, p. 318.

OJ C 110, 2.5.1995 and OJ C 75, 15.3.2000, p. 35.

OJ L 289, 28.10.1998, p. 28.

OJ L 184, 17.7.1999, p. 23.

OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 3288/94 (OJ L 349, 31.12.1994, p. 83).

OJ L 299, 31.12.1972, p. 32. Convention as amended by the Conventions on the Accession to that Convention of the States acceding to the European Communities.

### **3.1.2. Commission Regulation (EC) implementing Council Regulation (EC) No 6/2002 on Community designs No 2245/2002<sup>10</sup>**

of 21 October 2002

Commission Regulation (EC) No 2245/2002

of 21 October 2002

implementing Council Regulation (EC) No 6/2002 on Community designs

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs(1), and in particular Article 107(3) thereof,

Whereas:

---

<sup>10</sup> *Official Journal L 341* , 17/12/2002 P. 0028 – 0053

Regulation (EC) No 6/2002 creates a system enabling a design having effect throughout the Community to be obtained on the basis of an application to the Office for Harmonisation in the Internal Market (trade marks and designs) (hereinafter "the Office").

For this purpose, Regulation (EC) No 6/2002 contains the necessary provisions for a procedure leading to the registration of a Community design, as well as for the administration of registered Community designs, for appeals against decisions of the Office and for proceedings for the invalidation of a Community design.

The present Regulation lays down the necessary measures for implementing the provisions of Regulation (EC) No 6/2002.

This Regulation should ensure the smooth and efficient operation of design proceedings before the Office.

The measures provided for in this Regulation are in accordance with the opinion of the Committee established under Article 109 of Regulation (EC) No 6/2002,

HAS ADOPTED THIS REGULATION:

## CHAPTER I

### APPLICATION PROCEDURE

#### Article 1

##### Content of the application

The application for a registered Community design shall contain:

a request for registration of the design as a registered Community design;

the name, address and nationality of the applicant and the State in which the applicant is domiciled or in which it has its seat or establishment. Names of natural persons shall take the form of the family name and the given name(s). Names of legal entities shall be indicated by their official designation, which may be abbreviated in a customary manner; furthermore, the State whose law governs such entities shall be indicated.

The telephone numbers as well as fax numbers and details of other data-communications links, such as electronic mail, may be given. Only one address shall, in principle, be indicated for each applicant; where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service. If the Office has given the applicant an identification number, it shall be sufficient to mention that number together with the name of the applicant;

a representation of the design in accordance with Article 4 of this Regulation or, if the application concerns a two-dimensional design and contains a request for deferment of publication in accordance with Article 50 of Regulation (EC) No 6/2002, a specimen in accordance with Article 5 of this Regulation;

an indication, in accordance with Article 3(3), of the products in which the design is intended to be incorporated or to which it is intended to be applied;

if the applicant has appointed a representative, the name of that representative and the address of his/her place of business in accordance with point (b); if the representative has more than one business address or if there are two or more representatives with different business addresses, the application shall indicate which address shall be used as an address for service; where no such indication is made, only the first-mentioned address shall be taken into account as an address for service. If there is more than one applicant, the application may indicate the appointment of one applicant or representative as common representative. If an appointed representative has been given an identification number by the Office, it shall be sufficient to mention that number together with the name of the representative;

if applicable, a declaration that priority of a previous application is claimed pursuant to Article 42 of Regulation (EC) No 6/2002, stating the date on which the previous application was filed and the country in which or for which it was filed;

if applicable, a declaration that exhibition priority is claimed pursuant to Article 44 of Regulation (EC) No 6/2002, stating the name of the exhibition and the date of the first disclosure of the products in which the design is incorporated or to which it is applied;

a specification of the language in which the application is filed, and of the second language pursuant to Article 98(2) of Regulation (EC) No 6/2002;

the signature of the applicant or his/her representative in accordance with Article 65.

The application may contain:

a single description per design not exceeding 100 words explaining the representation of the design or the specimen; the description must relate only to those features which appear in the reproductions of the design or the specimen; it shall not contain statements as to the purported novelty or individual character of the design or its technical value;

a request for deferment of publication of registration in accordance with Article 50(1) of Regulation (EC) No 6/2002;

an indication of the "Locarno classification" of the products contained in the application, that is to say, of the class or classes and the subclass or subclasses to which they belong in accordance with the Annex to the Agreement establishing an international classification for industrial designs, signed at Locarno on 8 October 1968 (hereinafter "the Locarno Agreement"), referred to in Article 3 and subject to Article 2(2);

the citation of the designer or of the team of designers or a statement signed by the applicant to the effect that the designer or team of designers has waived the right to be cited under Article 36(3)(e) of Regulation (EC) No 6/2002.

## Article 2

### Multiple application

An application may be a multiple application requesting the registration of several designs.

When several designs other than ornamentation are combined in a multiple application, the application shall be divided if the products in which the designs are intended to be incorporated or to which they are intended to be applied belong to more than one class of the Locarno Classification.

For each design contained in the multiple application the applicant shall provide a representation of the design in accordance with Article 4 and the indication of the product in which the design is intended to be incorporated or to be applied.

The applicant shall number the designs contained in the multiple application consecutively, using arabic numerals.

## Article 3

### Classification and indication of products

Products shall be classified in accordance with Article 1 of the Locarno Agreement, as amended and in force at the date of filing of the design.

The classification of products shall serve exclusively administrative purposes.

The indication of products shall be worded in such a way as to indicate clearly the nature of the products and to enable each product to be classified in only one class of the Locarno classification, preferably using the terms appearing in the list of products set out therein.

The products shall be grouped according to the classes of the Locarno classification, each group being preceded by the number of the class to which that group of products belongs and presented in the order of the classes and subclasses under that classification.

## Article 4

### Representation of the design

The representation of the design shall consist in a graphic or photographic reproduction of the design, either in black and white or in colour. It shall meet the following requirements:

save where the application is filed by electronic means pursuant to Article 67, the representation must be filed on separate sheets of paper or reproduced on the page provided for that purpose in the form made available by the Office pursuant to Article 68;

in the case of separate sheets of paper, the design shall be reproduced on opaque white paper and either pasted or printed directly on it. Only one copy shall be filed and the sheets of paper shall not be folded or stapled;

the size of the separate sheet shall be DIN A4 size (29,7 cm x 21 cm) and the space used for the reproduction shall be no larger than 26,2 cm x 17 cm. A margin of at least 2,5 cm shall be left on the left-hand side; at the top of each sheet of paper the number of views shall be indicated pursuant to paragraph 2 and, in the case of a multiple application, the consecutive number of the design; no explanatory text, wording or symbols, other than the indication "top" or the name or address of the applicant, may be displayed thereon;

where the application is filed by electronic means, the graphic or photographic reproduction of the designs shall be in a data format determined by the President of the Office; the manner of identifying the different designs contained in a multiple application, or the different views, shall be determined by the President of the Office;

the design shall be reproduced on a neutral background and shall not be retouched with ink or correcting fluid. It shall be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Register of Community Designs provided for in Article 72 of Regulation (EC) No 6/2002, hereinafter "the Register", and for direct publishing in the Community Designs Bulletin referred to in Article 73 of that Regulation.

The representation may contain no more than seven different views of the design. Any one graphic or photographic reproduction may contain only one view. The applicant shall number each view using arabic numerals. The number shall consist of separate numerals separated by a point, the numeral to the left of the point indicating the number of the design, that to the right indicating the number of the view.

In cases where more than seven views are provided, the Office may disregard for registration and publication any of the extra views. The Office shall take the views in the consecutive order in which the views are numbered by the applicant.

Where an application concerns a design that consists in a repeating surface pattern, the representation of the design shall show the complete pattern and a sufficient portion of the repeating surface.

The size limits set out in paragraph 1(c) shall apply.

Where an application concerns a design consisting in a typographic typeface, the representation of the design shall consist in a string of all the letters of the alphabet, in both upper and lower case, and of all the arabic numerals, together with a text of five lines produced using that typeface, both letters and numerals being in the size pitch 16.

## Article 5

### Specimens

Where the application concerns a two-dimensional design and contains a request for a deferment of publication, in accordance with Article 50(1) of Regulation (EC) No 6/2002, the representation of the design may be replaced by a specimen pasted on a sheet of paper.

Applications for which a specimen is submitted must be sent by a single mail or directly delivered to the office of filing.

Both the application and the specimen shall be submitted at the same time.

The specimens shall not exceed 26,2 cm x 17 cm in size, 50 grams in weight or 3 mm in thickness. The specimen shall be capable of being stored, unfolded, alongside documents of the size prescribed in Article 4(1)(c).

Specimens that are perishable or dangerous to store shall not be filed.

The specimen shall be filed in five copies; in the case of a multiple application, five copies of the specimen shall be filed for each design.

Where the design concerns a repeating surface pattern, the specimen shall show the complete pattern and a sufficient portion of the repeating surface in length and width. The limits set out in paragraph 2 shall apply.

## Article 6

### Fees for the application

The following fees shall be paid at the time when the application is submitted to the Office:

the registration fee;

the publication fee or a deferment fee if deferment of publication has been requested;

an additional registration fee in respect of each additional design included in a multiple application;

an additional publication fee in respect of each additional design included in a multiple application, or an additional deferment fee in respect of each additional design included in a multiple application if deferment of publication has been requested.

Where the application includes a request for deferment of publication of registration, the publication fee and any additional publication fee in respect of each additional design included in a multiple application shall be paid within the time limits specified in Article 15(4).

## Article 7

### Filing of the application

The Office shall mark the documents making up the application with the date of its receipt and the file number of the application.

Each design contained in a multiple application shall be numbered by the Office in accordance with a system determined by the President.

The Office shall issue to the applicant without delay a receipt which shall specify the file number, the representation, description or other identification of the design, the nature and the number of the documents and the date of their receipt.

In the case of a multiple application, the receipt issued by the Office shall specify the first design and the number of designs filed.

If the application is filed with the central industrial property office of a Member State or at the Benelux Design Office in accordance with Article 35 of Regulation (EC) No 6/2002, the office of filing shall number each page of the application, using arabic numerals. The office of filing shall mark the documents making up the application with the date of receipt and the number of pages before forwarding the application to the Office.

The office of filing shall issue to the applicant without delay a receipt specifying the nature and the number of the documents and the date of their receipt.

If the Office receives an application forwarded by the central industrial property office of a Member State or the Benelux Design Office, it shall mark the application with the date of

receipt and the file number and shall issue to the applicant without delay a receipt in accordance with the third and fourth subparagraphs of paragraph 1, indicating the date of receipt at the Office.

## Article 8

### Claiming priority

Where the priority of one or more previous applications is claimed in the application pursuant to Article 42 of Regulation (EC) No 6/2002, the applicant shall indicate the file number of the previous application and file a copy of it within three months of the filing date referred to in Article 38 of that Regulation. The President of the Office shall determine the evidence to be provided by the applicant.

Where, subsequent to the filing of the application, the applicant wishes to claim the priority of one or more previous applications pursuant to Article 42 of Regulation (EC) No 6/2002, he/she shall submit, within one month of the filing date, the declaration of priority, stating the date on which and the country in or for which the previous application was made.

The applicant shall submit to the Office the indications and evidence referred to in paragraph 1 within three months of receipt of the declaration of priority.

## Article 9

### Exhibition priority

Where exhibition priority has been claimed in the application pursuant to Article 44 of Regulation (EC) No 6/2002, the applicant shall, together with the application or at the latest within three months of the filing date, file a certificate issued at the exhibition by the authority responsible for the protection of industrial property at the exhibition.

That certificate shall declare that the design was incorporated in or applied to the product and disclosed at the exhibition, and shall state the opening date of the exhibition and, where the first disclosure of the product did not coincide with the opening date of the exhibition, the date of such first disclosure. The certificate shall be accompanied by an identification of the actual disclosure of the product, duly certified by that authority.

Where the applicant wishes to claim an exhibition priority subsequent to the filing of the application, the declaration of priority, indicating the name of the exhibition and the date of the first disclosure of the product in which the design was incorporated or to which it was applied, shall be submitted within one month of the filing date. The indications and evidence

referred to in paragraph 1 shall be submitted to the Office within three months of receipt of the declaration of priority.

## Article 10

### Examination of requirements for a filing date and of formal requirements

The Office shall notify the applicant that a date of filing cannot be granted if the application does not contain:

a request for registration of the design as a registered Community design;

information identifying the applicant;

a representation of the design pursuant to Article 4(1)(d) and (e) or, where applicable, a specimen.

If the deficiencies indicated in paragraph 1 are remedied within two months of receipt of the notification, the date on which all the deficiencies are remedied shall determine the date of filing.

If the deficiencies are not remedied before the time limit expires, the application shall not be dealt with as a Community design application. Any fees paid shall be refunded.

The Office shall call upon the applicant to remedy the deficiencies noted within a time limit specified by it where, although a date of filing has been granted, the examination reveals that:

the requirements set out in Articles 1, 2, 4 and 5 or the other formal requirements for applications laid down in the Regulation (EC) No 6/2002 or in this Regulation have not been complied with;

the full amount of the fees payable pursuant to Article 6(1), read in conjunction with Commission Regulation (EC) No 2246/2002(2), has not been received by the Office;

where priority has been claimed pursuant to Articles 8 and 9, either in the application itself or within one month after the date of filing, the other requirements set out in those Articles have not been complied with;

in the case of a multiple application, the products in which the designs are intended to be incorporated or to which they are intended to be applied belong to more than one class of the Locarno classification.

In particular, the Office shall call upon the applicant to pay the required fees within two months of the date of notification, together with the late payment fees provided for in Article

107(2)(a) to (d) of Regulation (EC) No 6/2002 and as set out in Regulation (EC) No 2246/2002.

In the case of the deficiency referred to in point (d) of the first subparagraph, the Office shall call upon the applicant to divide the multiple application in order to ensure compliance with the requirements under Article 2(2). It shall also call upon the applicant to pay the total amount of the fees for all the applications resulting from the separation of the multiple application, within such a time limit as it may specify.

After the applicant has complied with the request to divide the application within the time limit set, the date of filing of the resulting application or applications shall be the date of filing granted to the multiple application initially filed.

If the deficiencies referred to in paragraph 3(a) and (d) are not remedied before the time limit expires, the Office shall reject the application.

If the fees payable pursuant to Article 6(1)(a) and (b) are not paid before the time limit expires, the Office shall reject the application.

If any additional fees payable pursuant to Article 6(1)(c) or (d) in respect of multiple applications are not paid or not paid in full before the time limit expires, the Office shall reject the application in respect of all the additional designs which are not covered by the amount paid.

In the absence of any criteria for determining which designs are intended to be covered, the Office shall take the designs in the numerical order in which they are represented in accordance with Article 2(4). The Office shall reject the application in so far as it concerns designs for which additional fees have not been paid or have not been paid in full.

If the deficiencies referred to in paragraph 3(c) are not remedied before the time limit expires, the right of priority for the application shall be lost.

If any of the deficiencies referred to in paragraph 3 is not remedied before the time limit expires and such deficiency concerns only some of the designs contained in a multiple application, the Office shall reject the application, or the right of priority shall be lost, only in so far as those designs are concerned.

## Article 11

### Examination of grounds for non-registrability

Where, pursuant to Article 47 of Regulation (EC) No 6/2002, the Office finds, in the course of carrying out the examination under Article 10 of this Regulation, that the design for which

protection is sought does not correspond to the definition of design provided in Article 3(a) of Regulation (EC) No 6/2002 or that the design is contrary to public policy or to accepted principles of morality, it shall inform the applicant that the design is non-registrable, specifying the ground for non-registrability.

The Office shall specify a time limit within which the applicant may submit his/her observations, withdraw the application or amend it by submitting an amended representation of the design, provided that the identity of the design is retained.

Where the applicant fails to overcome the grounds for non-registrability within the time limit, the Office shall refuse the application. If those grounds concern only some of the designs contained in a multiple application, the Office shall refuse the application only in so far as those designs are concerned.

## Article 12

### Withdrawal or correction of the application

The applicant may at any time withdraw a Community design application or, in the case of a multiple application, withdraw some of the designs contained in the application.

Only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant and provided that such correction does not change the representation of the design.

An application for the correction of the application pursuant to paragraph 2 shall contain:

the file number of the application;

the name and the address of the applicant in accordance with Article 1(1)(b);

where the applicant has appointed a representative, the name and the business address of the representative in accordance with Article 1(1)(e);

the indication of the element of the application to be corrected and that element in its corrected version.

If the requirements for the correction of the application are not fulfilled, the Office shall communicate the deficiency to the applicant. If the deficiency is not remedied within the time limits specified by the Office, the Office shall reject the application for correction.

A single application may be made for the correction of the same element in two or more applications submitted by the same applicant.

Paragraphs 2 to 5 shall apply mutatis mutandis to applications to correct the name or the business address of a representative appointed by the applicant.

## CHAPTER II

### REGISTRATION PROCEDURE

#### Article 13

##### Registration of the design

If the application satisfies the requirements referred to in Article 48 of Regulation (EC) No 6/2002, the design contained in that application and the particulars set out in Article 69(2) of this Regulation shall be recorded in the Register.

If the application contains a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002, that fact and the date of expiry of the period of deferment shall be recorded.

The fees payable pursuant to Article 6(1) shall not be refunded even if the design applied for is not registered.

#### Article 14

##### Publication of the registration

The registration of the design shall be published in the Community Designs Bulletin.

Subject to paragraph 3, the publication of the registration shall contain:

the name and address of the holder of the Community design (hereinafter "the holder");

where applicable, the name and business address of the representative appointed by the holder other than a representative falling within the first subparagraph of Article 77(3) of Regulation (EC) No 6/2002; if more than one representative has the same business address, only the name and business address of the first-named representative shall be published, the name being followed by the words "et al"; if there are two or more representatives with different business addresses, only the address for service determined pursuant to Article 1(1)(e) of this Regulation shall be published; where an association of representatives is appointed pursuant to Article 62(9) only the name and business address of the association shall be published;

the representation of the design pursuant to Article 4; where the representation of the design is in colour, the publication shall be in colour;

where applicable, an indication that a description has been filed pursuant to Article 1(2)(a);

an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied, preceded by the number of the relevant classes and subclasses of the Locarno classification, and grouped accordingly;

where applicable, the name of the designer or the team of designers;

the date of filing and the file number and, in the case of a multiple application, the file number of each design;

where applicable, particulars of the claim of priority pursuant to Article 42 of Regulation (EC) No 6/2002;

where applicable, particulars of the claim of exhibition priority pursuant to Article 44 of Regulation (EC) No 6/2002;

the date and the registration number and the date of the publication of the registration;

the language in which the application was filed and the second language indicated by the applicant pursuant to Article 98(2) of Regulation (EC) No 6/2002.

If the application contains a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002, a mention of the deferment shall be published in the Community Designs Bulletin, together with the name of the holder, the name of the representative, if any, the date of filing and registration, and the file number of the application. Neither the representation of the design nor any particulars identifying its appearance shall be published.

## Article 15

### Deferment of publication

Where the application contains a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002, the holder shall, together with the request or at the latest three months before the 30-month deferment period expires:

pay the publication fee referred to in Article 6(1)(b);

in the case of a multiple registration, pay the additional publication fees, referred to in Article 6(1)(d);

in cases where a representation of the design has been replaced by a specimen in accordance with Article 5, file a representation of the design in accordance with Article 4. This applies to all the designs contained in a multiple application for which publication is requested;

in the case of a multiple registration, clearly indicate which of the designs contained therein is to be published or which of the designs are to be surrendered, or, if the period of deferment has not yet expired, for which designs deferment is to be continued.

Where the holder requests publication before the expiry of the 30-month deferment period, he/she shall, at the latest three months before the requested date of publication, comply with the requirements set out in points (a) to (d) of the first paragraph.

If the holder fails to comply with the requirements set out in paragraph 1(c) or (d), the Office shall call upon him/her to remedy the deficiencies within a specified time limit which shall in no case expire after the 30-month deferment period.

If the holder fails to remedy the deficiencies referred to in paragraph 2 within the applicable time limit:

the registered Community design shall be deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002;

where the holder has requested earlier publication as provided for under the second subparagraph of paragraph 1, the request shall be deemed not to have been filed.

If the holder fails to pay the fees referred to in paragraph 1(a) or (b), the Office shall call upon him/her to pay those fees together with the fees for late payment provided for in Article 107(2)(b) or (d) of Regulation (EC) No 6/2002 and as set out in Regulation (EC) No 2246/2002, within a specified time limit which shall in no case expire after the 30-month deferment period.

If no payment has been made within that time limit, the Office shall notify the holder that the registered Community design has from the outset not had the effects specified in Regulation (EC) No 6/2002.

If, in respect of a multiple registration, a payment is made within that time limit but is insufficient to cover all the fees payable pursuant to paragraph 1(a) and (b), as well as the applicable fee for late payment, all the designs in respect of which the fees have not been paid shall be deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002.

Unless it is clear which designs the amount paid is intended to cover, and in the absence of other criteria for determining which designs are intended to be covered, the Office shall take the designs in the numerical order in which they are represented in accordance with Article 2(4).

All designs for which the additional publication fee has not been paid or has not been paid in full, together with the applicable fee for late payment, shall be deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002.

## Article 16

### Publication after the period for deferment

Where the holder has complied with the requirements laid down in Article 15, the Office shall, at the expiry of the period for deferment or in the case of a request for earlier publication, as soon as is technically possible:

publish the registered Community design in the Community Designs Bulletin, with the indications set out in Article 14(2), together with an indication of the fact that the application contained a request for deferment of publication pursuant to Article 50 of Regulation (EC) No 6/2002 and, where applicable, that a specimen was filed in accordance with Article 5 of this Regulation;

make available for public inspection any file relating to the design;

open to public inspection all the entries in the Register, including any entries withheld from inspection pursuant to Article 73.

Where Article 15(4) applies, the actions referred to in paragraph 1 of this Article shall not take place in respect of those designs contained in the multiple registration which are deemed from the outset not to have had the effects specified in Regulation (EC) No 6/2002.

## Article 17

### Certificate of registration

After publication, the Office shall issue to the holder a certificate of registration which shall contain the entries in the Register provided for in Article 69(2) and a statement to the effect that those entries have been recorded in the Register.

The holder may request that certified or uncertified copies of the certificate of registration be supplied to him/her upon payment of a fee.

## Article 18

### Maintenance of the design in an amended form

Where, pursuant to Article 25(6) of Regulation (EC) No 6/2002, the registered Community design is maintained in an amended form, the Community design in its amended form shall be entered in the Register and published in the Community Designs Bulletin.

Maintenance of a design in an amended form may include a partial disclaimer, not exceeding 100 words, by the holder or an entry in the Register of Community Designs of a court decision or a decision by the Office declaring the partial invalidity of the design right.

#### Article 19

Change of the name or address of the holder or of his/her registered representative

A change of the name or address of the holder which is not the consequence of a transfer of the registered design shall, at the request of the holder, be recorded in the Register.

An application for a change of the name or address of the holder shall contain:

the registration number of the design;

the name and the address of the holder as recorded in the Register. If the holder has been given an identification number by the Office, it shall be sufficient to indicate that number together with the name of the holder;

the indication of the name and address of the holder, as changed, in accordance with Article 1(1)(b);

where the holder has appointed a representative, the name and business address of the representative, in accordance with Article 1(1)(e).

The application referred to in paragraph 2 shall not be subject to payment of a fee.

A single application may be made for a change of the name or address in respect of two or more registrations of the same holder.

If the requirements set out in paragraphs 1 and 2 are not fulfilled, the Office shall communicate the deficiency to the applicant.

If the deficiency is not remedied within the time limits specified by the Office, the Office shall reject the application.

Paragraphs 1 to 5 shall apply *mutatis mutandis* to a change of the name or address of the registered representative.

Paragraphs 1 to 6 shall apply *mutatis mutandis* to applications for Community designs. The change shall be recorded in the files kept by the Office concerning the Community design application.

#### Article 20

Correction of mistakes and errors in the Register and in the publication of the registration

Where the registration of a design or the publication of the registration contains a mistake or error attributable to the Office, the Office shall correct the error or mistake of its own motion or at the request of the holder.

Where such a request is made by the holder, Article 19 shall apply *mutatis mutandis*. The request shall not be subject to payment of a fee.

The Office shall publish the corrections made pursuant to this Article.

## CHAPTER III

### RENEWAL OF REGISTRATION

#### Article 21

##### Notification of expiry of registration

At least six months before expiry of the registration, the Office shall inform the holder, and any person having a right entered in the Register, including a licence, in respect of the Community design, that the registration is approaching expiry. Failure to give notification shall not affect the expiry of the registration.

#### Article 22

##### Renewal of registration

An application for renewal of registration shall contain:

where the application is filed by the holder, his/her name and address in accordance with Article 1(1)(b);

where the application is filed by a person expressly authorised to do so by the holder, the name and address of that person and evidence that he/she is authorised to file the application;

where the applicant has appointed a representative, the name and business address of the representative in accordance with Article 1(1)(e);

the registration number;

where applicable, an indication that renewal is requested for all the designs covered by a multiple registration or, if the renewal is not requested for all such designs, an indication of those designs for which renewal is requested.

The fees payable pursuant to Article 13 of Regulation (EC) No 6/2002 for the renewal of a registration shall consist of:

a renewal fee, which, in cases where several designs are covered by a multiple registration, shall be proportionate to the number of designs covered by the renewal;

where applicable, the additional fee for late payment of the renewal fee or late submission of the request for renewal, pursuant to Article 13 of Regulation (EC) No 6/2002, as specified in Regulation (EC) No 2246/2002.

Where the application for renewal is filed within the time limits provided for in Article 13(3) of Regulation (EC) No 6/2002, but the other conditions for renewal provided for in Article 13 thereof and in this Regulation are not satisfied, the Office shall inform the applicant of the deficiencies.

If the application is filed by a person whom the holder has expressly authorised to do so, the holder of the design shall receive a copy of the notification.

Where an application for renewal is not submitted or is submitted after expiry of the time limit provided for in the second sentence of Article 13(3) of Regulation (EC) No 6/2002, or if the fees are not paid or are paid only after expiry of the relevant time limit, or if the deficiencies are not remedied within the time limit specified by the Office, the Office shall determine that the registration has expired and shall notify accordingly the holder and, where appropriate, the applicant for renewal and the person recorded in the Register as having rights in the design.

In the case of a multiple registration, where the fees paid are insufficient to cover all the designs for which renewal is requested, such a determination shall be made only after the Office has established which designs the amount paid is intended to cover.

In the absence of other criteria for determining which designs are intended to be covered, the Office shall take the designs in the numerical order in which they are represented in accordance with Article 2(4).

The Office shall determine that the registration has expired with regard to all designs for which the renewal fees have not been paid or have not been paid in full.

Where the determination made pursuant to paragraph 4 has become final, the Office shall cancel the design from the Register with effect from the day following the day on which the existing registration expired.

Where the renewal fees provided for in paragraph 2 have been paid but the registration is not renewed, those fees shall be refunded.

## CHAPTER IV

### TRANSFER, LICENCES AND OTHER RIGHTS, CHANGES

#### Article 23

## Transfer

An application for registration of a transfer pursuant to Article 28 of Regulation (EC) No 6/2002 shall contain:

the registration number of the Community design;

particulars of the new holder in accordance with Article 1(1)(b);

where not all of the designs covered by a multiple registration are included in the transfer, particulars of the registered designs to which the transfer relates;

documents duly establishing the transfer.

The application may contain, where applicable, the name and business address of the representative of the new holder, to be set out in accordance with Article 1(1)(e).

The application shall not be deemed to have been filed until the required fee has been paid. If the fee is not paid or is not paid in full, the Office shall notify the applicant accordingly.

The following shall constitute sufficient proof of transfer under paragraph 1(d):

the application for registration of the transfer is signed by the registered holder or his/her representative and by the successor in title or his/her representative; or

the application, if submitted by the successor in title, is accompanied by a declaration, signed by the registered holder or his/her representative, that he/she agrees to the registration of the successor in title; or

the application is accompanied by a completed transfer form or document, signed by the registered holder or his/her representative and by the successor in title or his/her representative.

Where the conditions applicable to the registration of a transfer are not fulfilled, the Office shall notify the applicant of the deficiencies.

If the deficiencies are not remedied within the time limit specified by the Office, it shall reject the application for registration of the transfer.

A single application for registration of a transfer may be submitted for two or more registered Community designs, provided that the registered holder and the successor in title are the same in each case.

Paragraphs 1 to 6 shall apply *mutatis mutandis* to the transfer of applications for registered Community designs. The transfer shall be recorded in the files kept by the Office concerning the Community design application.

## Article 24

### Registration of licences and other rights

Article 23(1)(a), (b) and (c) and Article 23(2), (3), (5) and (6) shall apply *mutatis mutandis* to the registration of the grant or transfer of a licence, to registration of the creation or transfer of a right in rem in respect of a registered Community design, and to registration of enforcement measures. However, where a registered Community design is involved in insolvency proceedings, the request of the competent national authority for an entry in the Register to this effect shall not be subject to payment of a fee.

In the case of a multiple registration, each registered Community design may, separately from the others, be licensed, the subject of a right in rem, levy of execution or insolvency proceedings.

Where the registered Community design is licensed for only a part of the Community, or for a limited period of time, the application for registration of the licence shall indicate the part of the Community or the period of time for which the licence is granted.

Where the conditions applicable to registration of licences and other rights, set out in Articles 29, 30 or 32 of Regulation (EC) No 6/2002, in paragraph 1 of this Article, and in the other applicable Articles of this Regulation are not fulfilled, the Office shall notify the applicant of the deficiencies.

If the deficiencies are not remedied within a time limit specified by the Office, it shall reject the application for registration.

Paragraphs 1, 2 and 3 shall apply *mutatis mutandis* to licences and other rights concerning applications for registered Community designs. Licences, rights in rem and enforcement measures shall be recorded in the files kept by the Office concerning the Community design application.

The request for a non-exclusive licence pursuant to Article 16(2) of Regulation (EC) No 6/2002 shall be made within three months of the date of the entry in the Register of the newly entitled holder.

## Article 25

### Special provisions for the registration of a licence

A licence in respect of a registered Community design shall be recorded in the Register as an exclusive licence if the holder of the design or the licensee so requests.

A licence in respect of a registered Community design shall be recorded in the Register as a sub-licence where it is granted by a licensee whose licence is recorded in the Register.

A licence in respect of a registered Community design shall be recorded in the Register as a territorially limited licence if it is granted for a part of the Community.

A licence in respect of a registered Community design shall be recorded in the Register as a temporary licence if it is granted for a limited period of time.

## Article 26

### Cancellation or modification of the registration of licences and other rights

A registration effected under Article 24 shall be cancelled upon application by one of the persons concerned.

The application shall contain:

the registration number of the registered Community design, or in the case of a multiple registration, the number of each design; and

particulars of the right whose registration is to be cancelled.

Application for cancellation of the registration of a licence or other right shall not be deemed to have been filed until the required fee has been paid.

If the fee is not paid or is not paid in full, the Office shall notify the applicant accordingly. A request from a competent national authority for cancellation of an entry where a registered Community design is involved in insolvency proceedings shall not be subject to payment of a fee.

The application shall be accompanied by documents showing that the registered right no longer exists or by a statement by the licensee or the holder of another right to the effect that he/she consents to cancellation of the registration.

Where the requirements for cancellation of the registration are not satisfied, the Office shall notify the applicant of the deficiencies. If the deficiencies are not remedied within the time limit specified by the Office, it shall reject the application for cancellation of the registration.

Paragraphs 1, 2, 4 and 5 shall apply *mutatis mutandis* to a request for modification of a registration effected pursuant to Article 24.

Paragraphs 1 to 6 shall apply *mutatis mutandis* to entries made in the files pursuant to Article 24(4).

## CHAPTER V

## SURRENDER AND INVALIDITY

### Article 27

#### Surrender

A declaration of surrender pursuant to Article 51 of Regulation (EC) No 6/2002 shall contain:

the registration number of the registered Community design;

the name and address of the holder in accordance with Article 1(1)(b);

where a representative has been appointed, the name and business address of the representative in accordance with Article 1(1)(e);

where surrender is declared only for some of the designs contained in a multiple registration, an indication of the designs for which the surrender is declared or the designs which are to remain registered;

where, pursuant to Article 51(3) of Regulation (EC) No 6/2002, the registered Community design is partially surrendered, a representation of the amended design in accordance with Article 4 of this Regulation.

Where a right of a third party relating to the registered Community design is entered in the Register, it shall be sufficient proof of his/her agreement to the surrender that a declaration of consent to the surrender is signed by the holder of that right or his/her representative.

Where a licence has been registered, surrender of the design shall be registered three months after the date on which the holder satisfies the Office that he/she has informed the licensee of his/her intention to surrender it. If the holder proves to the Office before the expiry of that period that the licensee has given his/her consent, the surrender shall be registered forthwith.

Where a claim relating to the entitlement to a registered Community design has been brought before a court pursuant to Article 15 of Regulation (EC) No 6/2002, a declaration of consent to the surrender, signed by the claimant or his/her representative, shall be sufficient proof of his/her agreement to the surrender.

If the requirements governing surrender are not fulfilled, the Office shall communicate the deficiencies to the declarant. If the deficiencies are not remedied within the time limit specified by the Office, the Office shall reject the entry of the surrender in the Register.

### Article 28

#### Application for a declaration of invalidity

An application to the Office for a declaration of invalidity pursuant to Article 52 of Regulation (EC) No 6/2002 shall contain:

as concerns the registered Community design for which the declaration of invalidity is sought:  
its registration number;

the name and address of its holder;

as regards the grounds on which the application is based:

a statement of the grounds on which the application for a declaration of invalidity is based;

additionally, in the case of an application pursuant to Article 25(1)(d) of Regulation (EC) No 6/2002, the representation and particulars identifying the prior design on which the application for a declaration of invalidity is based and showing that the applicant is entitled to invoke the earlier design as a ground for invalidity pursuant to Article 25(3) of that Regulation;

additionally, in the case of an application pursuant to Article 25(1)(e) or (f) of Regulation (EC) No 6/2002, the representation and particulars identifying the distinctive sign or the work protected by copyright on which the application for a declaration of invalidity is based and particulars showing that the applicant is the holder of the earlier right pursuant to Article 25(3) of that Regulation;

additionally, in the case of an application pursuant to Article 25(1)(g) of the Regulation (EC) No 6/2002, the representation and particulars of the relevant item as referred to in that Article and particulars showing that the application is filed by the person or entity concerned by the improper use pursuant to Article 25(4) of that Regulation;

where the ground for invalidity is that the registered Community design does not fulfil the requirements set out in Article 5 or 6 of Regulation (EC) No 6/2002, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs;

an indication of the facts, evidence and arguments submitted in support of those grounds;

as concerns the applicant:

his/her name and address in accordance with Article 1(1)(b);

if the applicant has appointed a representative, the name and the business address of the representative, in accordance with Article 1(1)(e);

additionally, in the case of an application pursuant to Article 25(1)(c) of Regulation (EC) No 6/2002, particulars showing that the application is made by a person or by persons duly entitled pursuant to Article 25(2) of that Regulation.

The application shall be subject to the fee referred to in Article 52(2) of Regulation (EC) No 6/2002.

The Office shall inform the holder that an application for declaration of invalidity has been filed.

## Article 29

### Languages used in invalidity proceedings

The application for a declaration of invalidity shall be filed in the language of proceedings pursuant to Article 98(4) of Regulation (EC) No 6/2002.

Where the language of proceedings is not the language used for filing the application and the holder has filed his/her observations in the language of filing, the Office shall arrange to have those observations translated into the language of proceedings.

Three years after the date fixed in accordance with Article 111(2) of Regulation (EC) No 6/2002, the Commission will submit to the Committee mentioned in Article 109 of Regulation (EC) No 6/2002 a report on the application of paragraph 2 of this Article and, if appropriate, proposals for fixing a limit for the expenses borne by the Office in this respect as provided for in the fourth subparagraph of Article 98(4) of Regulation (EC) No 6/2002.

The Commission may decide to submit the report and possible proposals referred to in paragraph 3 at an earlier date, and the Committee shall discuss them as a matter of priority if the facilities in paragraph 2 lead to disproportionate expenditure.

Where the evidence in support of the application is not filed in the language of the invalidity proceedings, the applicant shall file a translation of that evidence into that language within two months of the filing of such evidence.

Where the applicant for a declaration of invalidity or the holder informs the Office, within two months of receipt by the holder of the communication referred to in Article 31(1) of this Regulation, that they have agreed on a different language of proceedings pursuant to Article 98(5) of Regulation (EC) No 6/2002, the applicant shall, where the application was not filed in that language, file a translation of the application in that language within one month of the said date.

## Article 30

## Rejection of the application for declaration of invalidity as inadmissible

If the Office finds that the application for declaration of invalidity does not comply with Article 52 of Regulation (EC) No 6/2002, Article 28(1) of this Regulation or any other provision of Regulation (EC) No 6/2002 or this Regulation, it shall inform the applicant accordingly and shall call upon him/her to remedy the deficiencies within such time limit as it may specify.

If the deficiencies are not remedied within the specified time limit, the Office shall reject the application as inadmissible.

Where the Office finds that the required fees have not been paid, it shall inform the applicant accordingly and shall inform him/her that the application will be deemed not to have been filed if the required fees are not paid within a specified time limit.

If the required fees are paid after the expiry of the time limit specified, they shall be refunded to the applicant.

Any decision to reject an application for a declaration of invalidity pursuant to paragraph 1 shall be communicated to the applicant.

Where, pursuant to paragraph 2, an application is deemed not to have been filed, the applicant shall be informed accordingly.

## Article 31

### Examination of the application for a declaration of invalidity

If the Office does not reject the application for declaration of invalidity in accordance with Article 30, it shall communicate such application to the holder and shall request him/her to file his/her observations within such time limits as it may specify.

If the holder files no observations, the Office may base its decision concerning invalidity on the evidence before it.

Any observations filed by the holder shall be communicated to the applicant, who may be called upon by the Office to reply within specified time limits.

All communications pursuant to Article 53(2) of Regulation (EC) No 6/2002 and all observations filed in that respect shall be sent to the parties concerned.

The Office may call upon the parties to make a friendly settlement.

## Article 32

### Multiple applications for a declaration of invalidity

Where a number of applications for a declaration of invalidity have been filed relating to the same registered Community design, the Office may deal with them in one set of proceedings.

The Office may subsequently decide no longer to deal with them in that way.

If a preliminary examination of one or more applications reveals that the registered Community design may be invalid, the Office may suspend the other invalidity proceedings.

The Office shall inform the remaining applicants of any relevant decisions taken during such proceedings as are continued.

Once a decision declaring the invalidity of the design has become final, the applications in respect of which the proceedings have been suspended in accordance with paragraph 2 shall be deemed to have been disposed of and the applicants concerned shall be informed accordingly. Such disposition shall be considered to constitute a case which has not proceeded to judgment for the purposes of Article 70(4) of Regulation (EC) No 6/2002.

The Office shall refund 50 % of the invalidity fee referred to in Article 52(2) of Regulation (EC) No 6/2002 paid by each applicant whose application is deemed to have been disposed of in accordance with paragraphs 1, 2 and 3 of this Article.

## Article 33

### Participation of an alleged infringer

Where, pursuant to Article 54 of Regulation (EC) No 6/2002, an alleged infringer seeks to join the proceedings, he/she shall be subject to the relevant provisions of Articles 28, 29 and 30 of this Regulation, and shall in particular file a reasoned statement and pay the fee referred to in Article 52(2) of Regulation (EC) No 6/2002.

## CHAPTER VI

### APPEALS

#### Article 34

##### Content of the notice of appeal

The notice of appeal shall contain:

the name and address of the appellant in accordance with Article 1(1)(b);

where the appellant has appointed a representative, the name and the business address of the representative in accordance with Article 1(1)(e);

a statement identifying the decision which is contested and the extent to which amendment or cancellation of the decision is requested.

The notice of appeal shall be filed in the language of the proceedings in which the decision subject to the appeal was taken.

#### Article 35

##### Rejection of the appeal as inadmissible

If the appeal does not comply with Articles 55, 56 and 57 of Regulation (EC) No 6/2002 and Article 34(1)(c) and (2) of this Regulation, the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 57 of Regulation (EC) No 6/2002 has expired.

If the Board of Appeal finds that the appeal does not comply with other provisions of Regulation (EC) No 6/2002 or other provisions of this Regulation, in particular with Article 34(1)(a) and (b), it shall inform the appellant accordingly and shall request him/her to remedy the deficiencies noted within such time limit as it may specify. If the deficiencies are not remedied in good time, the Board of Appeal shall reject the appeal as inadmissible.

If the fee for appeal has been paid after expiry of the time limits for the filing of an appeal pursuant to Article 57 of Regulation (EC) No 6/2002, the appeal shall be deemed not to have been filed and the appeal fee shall be refunded to the appellant.

#### Article 36

##### Examination of appeals

Save as otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.

The Board of Appeal's decision shall contain:

- a statement that it is delivered by the Board;
- the date when the decision was taken;
- the names of the Chairman and the other members of the Board of Appeal taking part;
- the name of the competent employee of the registry;
- the names of the parties and of their representatives;
- a statement of the issues to be decided;
- a summary of the facts;
- the reasons;

the order of the Board of Appeal, including, where necessary, a decision on costs.

The decision shall be signed by the Chairman and the other members of the Board of Appeal and by the employee of the registry of the Board of Appeal.

#### Article 37

##### Reimbursement of appeal fees

The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the event of interlocutory revision, reimbursement shall be ordered by the department whose decision has been impugned, and in other cases by the Board of Appeal.

### CHAPTER VII

#### DECISIONS AND COMMUNICATIONS OF THE OFFICE

#### Article 38

##### Form of decisions

Decisions of the Office shall be in writing and shall state the reasons on which they are based.

Where oral proceedings are held before the Office, the decision may be given orally. Subsequently, the decision in writing shall be notified to the parties.

Decisions of the Office which are open to appeal shall be accompanied by a written communication indicating that notice of appeal must be filed in writing at the Office within two months of the date of notification of the decision from which appeal is to be made. The communications shall also draw the attention of the parties to the provisions laid down in Articles 55, 56 and 57 of Regulation (EC) No 6/2002.

The parties may not plead any failure to communicate the availability of such appeal proceedings.

#### Article 39

##### Correction of errors in decisions

In decisions of the Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected. They shall be corrected by the department which took the decision, acting of its own motion or at the request of an interested party.

#### Article 40

##### Noting of loss of rights

If the Office finds that the loss of any rights results from Regulation (EC) No 6/2002 or this Regulation without any decision having been taken, it shall communicate this to the person concerned in accordance with Article 66 of Regulation (EC) No 6/2002, and shall draw his/her attention to the legal remedies set out in paragraph 2 of this Article.

If the person concerned considers that the finding of the Office is inaccurate, he/she may, within two months of notification of the communication referred to in paragraph 1, apply for a decision on the matter by the Office.

Such decision shall be given only if the Office disagrees with the person requesting it; otherwise the Office shall amend its finding and inform the person requesting the decision.

#### Article 41

##### Signature, name, seal

Any decision, communication or notice from the Office shall indicate the department or division of the Office as well as the name or the names of the official or officials responsible. They shall be signed by the official or officials, or, instead of a signature, carry a printed or stamped seal of the Office.

The President of the Office may determine that other means of identifying the department or division of the Office and the name of the official or officials responsible or an identification other than a seal may be used where decisions, communications or notices are transmitted by fax or any other technical means of communication.

### CHAPTER VIII

#### ORAL PROCEEDINGS AND TAKING OF EVIDENCE

##### Article 42

##### Summons to oral proceedings

The parties shall be summoned to oral proceedings provided for in Article 64 of Regulation (EC) No 6/2002 and their attention shall be drawn to paragraph 3 of this Article. At least one month's notice of the summons shall be given unless the parties agree to a shorter time limit.

When issuing the summons, the Office shall draw attention to the points which in its opinion need to be discussed in order for the decision to be taken.

If a party who has been duly summoned to oral proceedings before the Office does not appear as summoned, the proceedings may continue without him/her.

##### Article 43

## Taking of evidence by the Office

Where the Office considers it necessary to hear the oral evidence of parties, of witnesses or of experts or to carry out an inspection, it shall take a decision to that end, stating the means by which it intends to obtain evidence, the relevant facts to be proved and the date, time and place of the hearing or inspection.

If oral evidence from witnesses and experts is requested by a party, the decision of the Office shall determine the period of time within which the party filing the request must make known to the Office the names and addresses of the witnesses and experts whom the party wishes to be heard.

The period of notice given in the summons of a party, witness or expert to give evidence shall be at least one month, unless they agree to a shorter time limit.

The summons shall contain:

an extract from the decision mentioned in the first subparagraph of paragraph 1, indicating in particular the date, time and place of the hearing ordered and stating the facts regarding which the parties, witnesses and experts are to be heard;

the names of the parties to proceedings and particulars of the rights which the witnesses or experts may invoke pursuant to Article 45(2) to (5).

## Article 44

### Commissioning of experts

The Office shall decide in what form the report made by an expert whom it appoints shall be submitted.

The terms of reference of the expert shall include:

a precise description of his/her task;

the time limit laid down for the submission of the expert's report;

the names of the parties to the proceedings;

particulars of the claims which the expert may invoke pursuant to Article 45(2), (3) and (4).

A copy of any written report shall be submitted to the parties.

The parties may object to an expert on grounds of incompetence or on the same grounds as those on which objection may be made to an examiner or to a member of a Division or Board of Appeal pursuant to Article 132(1) and (3) of Council Regulation (EC) No 40/94(3). The department of the Office concerned shall rule on the objection.

## Article 45

### Costs of taking of evidence

The taking of evidence by the Office may be made conditional upon deposit with it, by the party who has requested the evidence to be taken, of a sum which shall be fixed by reference to an estimate of the costs.

Witnesses and experts who are summoned by and appear before the Office shall be entitled to reimbursement of reasonable expenses for travel and subsistence. An advance for those expenses may be granted to them by the Office. The first sentence shall apply also to witnesses and experts who appear before the Office without being summoned by it and who are heard as witnesses or experts.

Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts shall be entitled to fees for their services. Those payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks, where such witnesses and experts have been summoned by the Office on its own initiative.

The amounts and the advances for expenses to be paid pursuant to paragraphs 1, 2 and 3 shall be determined by the President of the Office and shall be published in the Official Journal of the Office.

The amounts shall be calculated on the same basis as the compensation and salaries received by officials in grades A 4 to A 8 as laid down in the Staff Regulations of officials of the European Communities and in Annex VII thereto.

Final liability for the amounts due or paid pursuant to paragraphs 1 to 4 shall lie with:

the Office where the Office, on its own initiative, considered it necessary to hear the oral evidence of witnesses or experts; or

the party concerned where that party requested the giving of oral evidence by witnesses or experts, subject to the decision on apportionment and fixing of costs pursuant to Articles 70 and 71 of Regulation (EC) No 6/2002 and Article 79 of this Regulation.

The party referred to in point (b) of the first subparagraph shall reimburse the Office for any advances duly paid.

## Article 46

### Minutes of oral proceedings and of evidence

Minutes of oral proceedings or the taking of evidence shall be drawn up, containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.

The minutes of the testimony of a witness, expert or party shall be read out or submitted to him/her so that he/she may examine them. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. Where his/her approval is not given, his/her objections shall be noted.

The minutes shall be signed by the employee who drew them up and by the employee who conducted the oral proceedings or taking of evidence.

The parties shall be provided with a copy of the minutes.

Upon request, the Office shall make available to the parties transcripts of recordings of the oral proceedings, in typescript or in any other machine-readable form.

The release of transcripts of those recordings shall be subject to the payment of the costs incurred by the Office in making such transcript. The amount to be charged shall be determined by the President of the Office.

## CHAPTER IX

### NOTIFICATIONS

#### Article 47

##### General provisions on notifications

In proceedings before the Office, any notifications to be made by the Office shall take the form of the original document, of a copy thereof certified by, or bearing the seal of, the Office or of a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.

Notifications shall be made:

by post in accordance with Article 48;

by hand delivery in accordance with Article 49;

by deposit in a post box at the Office in accordance with Article 50;

by fax and other technical means in accordance with Article 51;

by public notification in accordance with Article 52.

#### Article 48

## Notification by post

Decisions subject to a time limit for appeal, summonses and other documents as determined by the President of the Office shall be notified by registered letter with acknowledgement of delivery.

Decisions and communications subject to another time limit shall be notified by registered letter, unless the President of the Office determines otherwise.

All other communications shall be ordinary mail.

Notifications to addressees having neither their domicile nor their principal place of business nor an establishment in the Community and who have not appointed a representative in accordance with Article 77(2) of Regulation (EC) No 6/2002 shall be effected by posting the document requiring notification by ordinary mail to the last address of the addressee known to the Office.

Notification shall be deemed to have been effected when the posting has taken place.

Where notification is effected by registered letter, whether or not with acknowledgement of delivery, it shall be deemed to be delivered to the addressee on the 10th day following that of its posting, unless the letter has failed to reach the addressee or has reached him/her at a later date.

In the event of any dispute, it shall be for the Office to establish that the letter has reached its destination or to establish the date on which it was delivered to the addressee, as the case may be.

Notification by registered letter, with or without acknowledgement of delivery, shall be deemed to have been effected even if the addressee refuses to accept the letter.

To the extent that notification by post is not covered by paragraphs 1 to 4, the law of the State on the territory of which notification is made shall apply.

## Article 49

### Notification by hand delivery

Notification may be effected on the premises of the Office by hand delivery of the document to the addressee, who shall on delivery acknowledge its receipt.

## Article 50

Notification by deposit in a post box at the Office

Notification may also be effected to addressees who have been provided with a post box at the Office, by depositing the document therein. A written notification of deposit shall be inserted in the files. The date of deposit shall be recorded on the document. Notification shall be deemed to have taken place on the fifth day following deposit of the document in the post box at the Office.

#### Article 51

##### Notification by fax and other technical means

Notification by fax shall be effected by transmitting either the original or a copy, as provided for in Article 47(1), of the document to be notified. The details of such transmission shall be determined by the President of the Office.

Details of notification by other technical means of communication shall be determined by the President of the Office.

#### Article 52

##### Public notification

If the address of the addressee cannot be established, or if notification in accordance with Article 48(1) has proved to be impossible even after a second attempt by the Office, notification shall be effected by public notice.

Such notice shall be published at least in the Community Designs Bulletin.

The President of the Office shall determine how the public notice is to be given and shall fix the beginning of the time limit of one month on the expiry of which the document shall be deemed to have been notified.

#### Article 53

##### Notification to representatives

If a representative has been appointed or where the applicant first named in a common application is considered to be the common representative pursuant to Article 61(1), notifications shall be addressed to that appointed or common representative.

If several representatives have been appointed for a single interested party, notification to any one of them shall be sufficient, unless a specific address for service has been indicated in accordance with Article 1(1)(e).

If several interested parties have appointed a common representative, notification of a single document to the common representative shall be sufficient.

## Article 54

### Irregularities in notification

Where a document has reached the addressee, if the Office is unable to prove that it has been duly notified or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the Office as the date of receipt.

## Article 55

### Notification of documents in the case of several parties

Documents emanating from parties which contain substantive proposals, or a declaration of withdrawal of a substantive proposal, shall be notified to the other parties as a matter of course. Notification may be dispensed with where the document contains no new pleadings and the matter is ready for decision.

## CHAPTER X

### TIME LIMITS

## Article 56

### Calculation of time limits

Time limits shall be laid down in terms of full years, months, weeks or days.

The beginning of any time limit shall be calculated starting on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another time limit. Where that procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.

Where a time limit is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the relevant event occurred. Where the relevant month has no day with the same number the time limit shall expire on the last day of that month.

Where a time limit is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the relevant event occurred. Where the day on which the relevant event occurred was the last day of a month or where the relevant subsequent month has no day with the same number the time limit shall expire on the last day of that month.

Where a time limit is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the relevant event occurred.

#### Article 57

##### Duration of time limits

Where Regulation (EC) No 6/2002 or this Regulation provide for a time limit to be specified by the Office, such time limit shall, when the party concerned has its domicile or its principal place of business or an establishment within the Community, be not less than one month, or, when those conditions are not fulfilled, not less than two months, and no more than six months.

The Office may, when this is appropriate under the circumstances, grant an extension of a time limit specified if such extension is requested by the party concerned and the request is submitted before the original time limit expires.

Where there are two or more parties, the Office may make the extension of a time limit subject to the agreement of the other parties.

#### Article 58

##### Expiry of time limits in special cases

If a time limit expires on a day on which the Office is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered in the locality in which the Office is located, the time limit shall extend until the first day thereafter on which the Office is open for receipt of documents and on which ordinary mail is delivered.

The days on which the Office is not open for receipt of documents shall be determined by the President of the Office before the commencement of each calendar year.

If a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Member State or between a Member State and the Office, the time limit shall extend until the first day following the end of the period of interruption or dislocation, for parties having their residence or registered office in the State concerned or who have appointed representatives with a place of business in that State.

In the event of the Member State concerned being the State in which the Office is located, the first subparagraph shall apply to all parties.

The period referred to in the first subparagraph shall be as determined by the President of the Office.

Paragraphs 1 and 2 shall apply *mutatis mutandis* to the time limits provided for in Regulation (EC) No 6/2002 or this Regulation in the case of transactions to be carried out with the competent authority within the meaning of Article 35(1)(b) and (c) of Regulation (EC) No 6/2002.

If an exceptional occurrence such as natural disaster or strike interrupts or dislocates the proper functioning of the Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month of the notification of the delayed communication.

The date of commencement and the end of any such interruption or dislocation shall be as determined by the President of the Office.

## CHAPTER XI

### INTERRUPTION OF PROCEEDINGS AND WAIVING OF ENFORCED RECOVERY PROCEDURES

#### Article 59

##### Interruption of proceedings

Proceedings before the Office shall be interrupted:

in the event of the death or legal incapacity of the applicant for or holder of a registered Community design or of the person authorised by national law to act on his/her behalf;

in the event that the applicant for or holder of a registered Community design is, as a result of some action taken against his/her property, prevented for legal reasons from continuing the proceedings before the Office;

in the event of the death or legal incapacity of the representative of an applicant for or holder of a registered Community design or of his/her being prevented for legal reasons resulting from action taken against his/her property from continuing the proceedings before the Office.

To the extent that the events referred to in point (a) of the first subparagraph do not affect the authorisation of a representative appointed under Article 78 of Regulation (EC) No 6/2002, proceedings shall be interrupted only on application by such representative.

When, in the cases referred to in points (a) and (b) of the first subparagraph of paragraph 1, the Office has been informed of the identity of the person authorised to continue the proceedings before the Office, the Office shall communicate to such person and to any interested third parties that the proceedings shall be resumed as from a date to be fixed by the Office.

In the case referred to in paragraph 1(c), the proceedings shall be resumed when the Office has been informed of the appointment of a new representative of the applicant or when the Office has notified to the other parties the communication of the appointment of a new representative of the holder of the design.

If, three months after the beginning of the interruption of the proceedings, the Office has not been informed of the appointment of a new representative, it shall communicate that fact to the applicant for or holder of the registered Community design:

where Article 77(2) of Regulation (EC) No 6/2002 is applicable, that the Community design application will be deemed to be withdrawn if the information is not submitted within two months after that communication is notified; or

where Article 77(2) of Regulation (EC) No 6/2002 is not applicable, that the proceedings will be resumed with the applicant for or holder as from the date on which that communication is notified.

The time limits, other than the time limit for paying the renewal fees, in force as regards the applicant for or holder of the Community design at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed.

## Article 60

### Waiving of enforced recovery procedures

The President of the Office may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain.

## CHAPTER XII

### REPRESENTATION

## Article 61

### Appointment of a common representative

If there is more than one applicant and the application for a registered Community design does not name a common representative, the applicant first named in the application shall be considered to be the common representative.

However, if one of the applicants is obliged to appoint a professional representative, such representative shall be considered to be the common representative unless the applicant named first in the application has also appointed a professional representative.

The first and second subparagraphs shall apply *mutatis mutandis* to third parties acting in common in applying for a declaration of invalidity, and to joint holders of a registered Community design.

If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a common representative, paragraph 1 shall apply.

If such application is not possible, the Office shall require such persons to appoint a common representative within two months. If this request is not complied with, the Office shall appoint the common representative.

## Article 62

### Authorisations

Legal practitioners and professional representatives entered on the lists maintained by the Office pursuant to Article 78(1)(b) or (c) of Regulation (EC) No 6/2002 may file with the Office a signed authorisation for inclusion in the files.

Such authorisation shall be filed if the Office expressly requires it or, where there are several parties to the proceedings in which the representative acts before the Office, one of the parties expressly request it.

Employees acting on behalf of natural or legal persons pursuant to Article 77(3) of Regulation (EC) No 6/2002 shall file with the Office a signed authorisation for insertion in the files.

The authorisation may be filed in any of the official languages of the Community. It may cover one or more applications or registered Community designs or may be in the form of a general authorisation allowing the representative to act in respect of all proceedings before the Office to which the person who has issued it is a party.

Where, pursuant to paragraphs 1 or 2, an authorisation has to be filed, the Office shall specify a time limit within which such authorisation shall be filed. If the authorisation is not filed in due time, proceedings shall be continued with the represented person. Any procedural steps other than the filing of the application taken by the representative shall be deemed not to have

been taken if the represented person does not approve them. The application of Article 77(2) of Regulation (EC) No 6/2002 shall remain unaffected.

Paragraphs 1, 2 and 3 shall apply *mutatis mutandis* to a document withdrawing an authorisation.

Any representative who has ceased to be authorised shall continue to be regarded as the representative until the termination of his/her authorisation has been communicated to the Office.

Subject to any provisions to the contrary contained therein, an authorisation shall not terminate *vis-à-vis* the Office upon the death of the person who gave it.

Where several representatives are appointed by the same party, they may, notwithstanding any provisions to the contrary in their authorisations, act either collectively or individually.

The authorisation of an association of representatives shall be deemed to be an authorisation of any representative who can establish that he/she practises within that association.

#### Article 63

##### Representation

Any notification or other communication addressed by the Office to the duly authorised representative shall have the same effect as if it had been addressed to the represented person.

Any communication addressed to the Office by the duly authorised representative shall have the same effect as if it originated from the represented person.

#### Article 64

##### Amendment of the special list of professional representatives for design matters

The entry of a professional representative in the special list of professional representatives for design matters, as referred to in Article 78(4) of Regulation (EC) No 6/2002, shall be deleted at his/her request.

The entry of a professional representative shall be deleted automatically:

in the event of the death or legal incapacity of the professional representative;

where the professional representative is no longer a national of a Member State, unless the President of the Office has granted an exemption pursuant to Article 78(6)(a) of Regulation (EC) No 6/2002;

where the professional representative no longer has his/her place of business or employment in the Community;

where the professional representative no longer possesses the entitlement referred to in the first sentence of Article 78(4)(c) of Regulation (EC) No 6/2002.

The entry of a professional representative shall be suspended of the Office's own motion where his/her entitlement to represent natural or legal persons before the Benelux Design Office or the central industrial property office of the Member State as referred to in the first sentence of Article 78(4)(c) of Regulation (EC) No 6/2002 has been suspended.

A person whose entry has been deleted shall, upon request pursuant to Article 78(5) of Regulation (EC) No 6/2002, be reinstated in the list of professional representatives if the conditions for deletion no longer exist.

The Benelux Design Office and the central industrial property offices of the Member States concerned shall, where they are aware thereof, promptly inform the Office of any relevant events referred to in paragraphs 2 and 3.

The amendments of the special list of professional representatives for design matters shall be published in the Official Journal of the Office.

## CHAPTER XIII

### WRITTEN COMMUNICATIONS AND FORMS

#### Article 65

##### Communication in writing or by other means

Subject to paragraph 2, applications for the registration of a Community design as well as any other application or declaration provided for in Regulation (EC) No 6/2002 and all other communications addressed to the Office shall be submitted as follows:

by submitting a signed original of the document in question to the Office, by post, personal delivery, or by any other means; annexes to documents submitted need not be signed;

by transmitting a signed original by fax in accordance with Article 66; or

by transmitting the contents of the communication by electronic means in accordance with Article 67.

Where the applicant avails himself of the possibility provided for in Article 36(1)(c) of Regulation (EC) No 6/2002 of filing a specimen of the design, the application and the specimen shall be submitted to the Office by a single mail in the form prescribed in paragraph 1(a) of this Article. If the application and the specimen, or specimens in the case of a multiple

application, are not submitted by a single mail the Office shall not give a filing date until the last item has been received pursuant to Article 10(1) of this Regulation.

## Article 66

### Communication by fax

Where an application for registration of a Community design is submitted by fax and the application contains a reproduction of the design pursuant to Article 4(1) which does not satisfy the requirements of that Article, the required reproduction suitable for registration and publication shall be submitted to the Office in accordance with Article 65(1)(a).

Where the reproduction is received by the Office within a time limit of one month from the date of the receipt of the fax, the application shall be deemed to have been received by the Office on the date on which the fax was received.

Where the reproduction is received by the Office after the expiry of that time limit, the application shall be deemed to have been received by the Office on the date on which the reproduction was received.

Where a communication received by fax is incomplete or illegible, or where the Office has reasonable doubts as to the accuracy of the transmission, the Office shall inform the sender accordingly and shall call upon him/her, within a time limit to be specified by the Office, to retransmit the original by fax or to submit the original in accordance with Article 65(1)(a).

Where that request is complied with within the time limit specified, the date of the receipt of the retransmission or of the original shall be deemed to be the date of the receipt of the original communication, provided that where the deficiency concerns the granting of a filing date for an application to register a Community design, the provisions on the filing date shall apply.

Where the request is not complied with within the time limit specified, the communication shall be deemed not to have been received.

Any communication submitted to the Office by fax shall be considered to be duly signed if the reproduction of the signature appears on the printout produced by the fax.

The President of the Office may determine additional requirements for communication by fax, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

## Article 67

## Communication by electronic means

Applications for registration of a Community design may be submitted by electronic means, including the representation of the design, and notwithstanding Article 65(2) in the case of filing a specimen.

The conditions shall be laid down by the President of the Office.

The President of the Office shall determine the requirements for communication by electronic means, such as the equipment to be used, technical details of communication, and methods of identifying the sender.

Where a communication is sent by electronic means, Article 66(2) shall apply *mutatis mutandis*.

Where a communication is sent to the Office by electronic means, the indication of the name of the sender shall be deemed to be equivalent to the signature.

## Article 68

### Forms

The Office shall make available free of charge forms for the purpose of:

filing an application for a registered Community design;

applying for the correction of an application or a registration;

applying for the registration of a transfer and the transfer form and transfer document referred to in Article 23(4);

applying for the registration of a licence;

applying for renewal of registration of a registered Community design;

applying for a declaration of invalidity of a registered Community design;

applying for *restitutio in integrum*;

taking an appeal;

authorising a representative, in the form of an individual authorisation and in the form of a general authorisation.

The Office may make other forms available free of charge.

The Office shall make available the forms referred to in paragraphs 1 and 2 in all the official languages of the Community.

The Office shall place the forms at the disposal of the Benelux Design Office and of the Member States' central industrial property offices free of charge.

The Office may also make available the forms in machine-readable form.

Parties to proceedings before the Office should use the forms provided by the Office, or copies of those forms, or forms with the same content and format as those forms, such as forms generated by means of electronic data processing.

Forms shall be completed in such a manner as to permit an automated input of the content into a computer, such as by character recognition or scanning.

## CHAPTER XIV

### INFORMATION TO THE PUBLIC

#### Article 69

##### Register of Community Designs

The Register may be maintained in the form of an electronic database.

The Register shall contain the following entries:

the date of filing the application;

the file number of the application and the file number of each individual design included in a multiple application;

the date of the publication of the registration;

the name, the address and the nationality of the applicant and the State in which he/she is domiciled or has his/her seat or establishment;

the name and business address of the representative, other than an employee acting as representative in accordance with the first subparagraph of Article 77(3) of Regulation (EC) No 6/2002; where there is more than one representative, only the name and business address of the first named representative, the name being followed by the words "et al", shall be recorded; where an association of representatives is appointed, only the name and address of the association shall be recorded;

the representation of the design;

an indication of the products by their names, preceded by the numbers of the classes and subclasses of the Locarno classification, and grouped accordingly;

particulars of claims of priority pursuant to Article 42 of Regulation (EC) No 6/2002;

particulars of claims of exhibition priority pursuant to Article 44 of Regulation (EC) No 6/2002;

where applicable, the citation of the designer or of the team of designers pursuant to Article 18 of Regulation (EC) No 6/2002, or a statement that the designer or the team of designers has waived the right to be cited;

the language in which the application was filed and the second language which the applicant has indicated in his/her application, pursuant to Article 98(2) of Regulation (EC) No 6/2002;

the date of registration of the design in the Register and the registration number;

a mention of any request for deferment of publication pursuant to Article 50(3) of Regulation (EC) No 6/2002, specifying the date of expiry of the period of deferment;

a mention that a specimen was filed pursuant to Article 5;

a mention that a description was filed pursuant to Article 1(2)(a).

In addition to the entries set out in paragraph 2 the Register shall contain the following entries, each accompanied by the date of recording such entry:

changes in the name, the address or the nationality of the holder or in the State in which he/she is domiciled or has his/her seat or establishment;

changes in the name or business address of the representative, other than a representative falling within the first subparagraph of Article 77(3) of Regulation (EC) No 6/2002;

when a new representative is appointed, the name and business address of that representative;

a mention that a multiple application or registration has been divided into separate applications or registrations pursuant to Article 37(4) of Regulation (EC) No 6/2002;

the notice of an amendment to the design pursuant to Article 25(6) of Regulation (EC) No 6/2002, including, if applicable, a reference to the disclaimer made or the court decision or the decision by the Office declaring the partial invalidity of the design right, as well as corrections of mistakes and errors pursuant to Article 20 of this Regulation;

a mention that entitlement proceedings have been instituted under Article 15(1) of Regulation (EC) No 6/2002 in respect of a registered Community design;

the final decision or other termination of proceedings pursuant to Article 15(4)(b) of Regulation (EC) No 6/2002 concerning entitlement proceedings;

a change of ownership pursuant to Article 15(4)(c) of Regulation (EC) No 6/2002;

transfers pursuant to Article 28 of Regulation (EC) No 6/2002;

the creation or transfer of a right in rem pursuant to Article 29 of Regulation (EC) No 6/2002 and the nature of the right in rem;

levy of execution pursuant to Article 30 of Regulation (EC) No 6/2002 and insolvency proceedings pursuant to Article 31 of that Regulation;

the grant or transfer of a licence pursuant to Article 16(2) or Article 32 of Regulation (EC) No 6/2002 and, where applicable, the type of licence pursuant to Article 25 of this Regulation;

renewal of the registration pursuant to Article 13 of Regulation (EC) No 6/2002 and the date from which it takes effect;

a record of the determination of the expiry of the registration;

a declaration of total or partial surrender by the holder pursuant to Article 51(1) and (3) of Regulation (EC) No 6/2002;

the date of submission of an application or of the filing of a counterclaim for a declaration of invalidity pursuant, respectively, to Article 52 or Article 86(2) of Regulation (EC) No 6/2002;

the date and content of the decision on the application or counterclaim for declaration of invalidity or any other termination of proceedings pursuant, respectively, to Article 53 or Article 86(4) of Regulation (EC) No 6/2002;

a mention pursuant to Article 50(4) of Regulation (EC) No 6/2002 that the registered Community design is deemed from the outset not to have had the effects specified in that Regulation;

the cancellation of the representative recorded pursuant to paragraph 2(e);

the modification or cancellation from the Register of the items referred to in points (j), (k) and (l).

The President of the Office may determine that items other than those referred to in paragraphs 2 and 3 shall be entered in the Register.

The holder shall be notified of any change in the Register.

Subject to Article 73, the Office shall provide certified or uncertified extracts from the Register on request, on payment of a fee.

## CHAPTER XV

### COMMUNITY DESIGNS BULLETIN AND DATA BASE

#### Article 70

##### Community Designs Bulletin

The Office shall determine the frequency of the publication of the Community Designs Bulletin and the manner in which such publication shall take place.

Without prejudice to the provisions of Article 50(2) of Regulation (EC) No 6/2002 and subject to Articles 14 and 16 of this Regulation relating to deferment of publication, the Community Designs Bulletin shall contain publications of registration and of entries made in the Register as well as other particulars relating to registrations of designs whose publication is prescribed by Regulation (EC) No 6/2002 or by this Regulation.

Where particulars whose publication is prescribed in Regulation (EC) No 6/2002 or in this Regulation are published in the Community Designs Bulletin, the date of issue shown on the Bulletin shall be taken as the date of publication of the particulars.

The information the publication of which is prescribed in Articles 14 and 16 shall, where appropriate, be published in all the official languages of the Community.

#### Article 71

##### Database

The Office shall maintain an electronic database with the particulars of applications for registration of Community designs and entries in the Register. The Office may, subject to the restrictions prescribed by Article 50(2) and (3) of Regulation (EC) No 6/2002, make available the contents of that database for direct access or on CD-ROM or in any other machine-readable form.

The President of the Office shall determine the conditions of access to the database and the manner in which the contents of this database may be made available in machine-readable form, including the charges for those acts.

#### CHAPTER XVI

##### INSPECTION OF FILES AND KEEPING OF FILES

#### Article 72

##### Parts of the file excluded from inspection

The parts of the file which shall be excluded from inspection pursuant to Article 74(4) of Regulation (EC) No 6/2002 shall be:

documents relating to exclusion or objection pursuant to Article 132 of Regulation (EC) No 40/94, the provisions of that Article being considered for this purpose as applying *mutatis mutandis* to registered Community designs and to applications for these;

draft decisions and opinions, and all other internal documents used for the preparation of decisions and opinions;

parts of the file which the party concerned showed a special interest in keeping confidential before the application for inspection of the files was made, unless inspection of such part of the file is justified by overriding legitimate interests of the party seeking inspection.

#### Article 73

##### Inspection of the Register of Community Designs

Where the registration is subject to a deferment of publication pursuant to Article 50(1) of Regulation (EC) No 6/2002:

access to the Register to persons other than the holder shall be limited to the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred;

the certified or uncertified extracts from the Register shall contain only the name of the holder, the name of any representative, the date of filing and registration, the file number of the application and the mention that publication is deferred, except where the request has been made by the holder or his/her representative.

#### Article 74

##### Procedures for the inspection of files

Inspection of the files of registered Community designs shall either be of the original document, or of copies thereof, or of technical means of storage if the files are so stored.

The request for inspection of the files shall not be deemed to have been made until the required fee has been paid.

The means of inspection shall be determined by the President of the Office.

Where inspection of the files relates to an application for a registered Community design or to a registered Community design which is subject to deferment of publication, which, being subject to such deferment, has been surrendered before or on the expiry of that period or which, pursuant to Article 50(4) of Regulation (EC) No 6/2002, is deemed from the outset not to have had the effects specified in that Regulation, the request shall contain an indication and evidence to the effect that:

the applicant for or holder of the Community design has consented to the inspection; or

the person requesting the inspection has established a legitimate interest in the inspection of the file, in particular where the applicant for or holder of the Community design has stated that after the design has been registered he/she will invoke the rights under it against the person requesting the inspection.

Inspection of the files shall take place on the premises of the Office.

On request, inspection of the files shall be effected by means of issuing copies of file documents. Such copies shall incur fees.

The Office shall issue on request certified or uncertified copies of the application for a registered Community design or of those file documents of which copies may be issued pursuant to paragraph 4 upon payment of a fee.

#### Article 75

Communication of information contained in the files

Subject to the restrictions provided for in Article 74 of Regulation (EC) No 6/2002 and Articles 72 and 73 of this Regulation, the Office may, upon request, communicate information from any file of a Community design applied for or of a registered Community design, subject to payment of a fee.

However, the Office may require the applicant to inspect the file in situ, should it deem that to be appropriate in view of the quantity of information to be supplied.

#### Article 76

Keeping of files

The Office shall keep the files relating to Community design applications and to registered Community designs for at least five years from the end of the year in which:

the application is rejected or withdrawn;

the registration of the registered Community design expires definitively;

the complete surrender of the registered Community design is registered pursuant to Article 51 of Regulation (EC) No 6/2002;

the registered Community design is definitively removed from the Register;

the registered Community design is deemed not to have had the effects specified in Regulation (EC) No 6/2002 pursuant to Article 50(4) thereof.

The President of the Office shall determine the form in which the files shall be kept.

## CHAPTER XVII

## ADMINISTRATIVE COOPERATION

### Article 77

Exchange of information and communications between the Office and the authorities of the Member States

The Office and the central industrial property offices of the Member States and the Benelux Design Office shall, upon request, communicate to each other relevant information about the filing of applications for registered Community designs, Benelux designs or national registered designs and about proceedings relating to such applications and the designs registered as a result thereof. Such communications shall not be subject to the restrictions provided for in Article 74 of Regulation (EC) No 6/2002.

Communications between the Office and the courts or authorities of the Member States which arise out of the application of Regulation (EC) No 6/2002 or this Regulation shall be effected directly between those authorities.

Such communication may also be effected through the central industrial property offices of the Member States or the Benelux Design Office.

Expenditure in respect of communications pursuant to paragraphs 1 and 2 shall be chargeable to the authority making the communications, which shall be exempt from fees.

### Article 78

Inspection of files by or via courts or authorities of the Member States

Inspection of files relating to Community designs applied for or registered Community designs by courts or authorities of the Member States shall if so requested be of the original documents or of copies thereof. Article 74 shall not apply.

Courts or public prosecutors' offices of the Member States may, in the course of proceedings before them, open files or copies thereof transmitted by the Office to inspection by third parties. Such inspection shall be subject to Article 74 of Regulation (EC) No 6/2002.

The Office shall not charge any fee for inspections pursuant to paragraphs 1 and 2.

The Office shall, at the time of transmission of the files or copies thereof to the courts or public prosecutors' offices of the Member States, indicate the restrictions to which the inspection of files relating to Community designs applied for or registered Community designs is subject pursuant to Article 74 of Regulation (EC) No 6/2002 and Article 72 of this Regulation.

## CHAPTER XVIII

### COSTS

#### Article 79

##### Apportionment and fixing of costs

Apportionment of costs pursuant to Article 70(1) and (2) of Regulation (EC) No 6/2002 shall be dealt with in the decision on the application for a declaration of invalidity of a registered Community design, or in the decision on the appeal.

Apportionment of costs pursuant to Article 70(3) and (4) of Regulation (EC) No 6/2002 shall be dealt with in a decision on costs by the Invalidity Division or the Board of Appeal.

A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs provided for in the first sentence of Article 70(6) of Regulation (EC) No 6/2002.

The request shall be admissible only if the decision in respect of which the fixing of costs is required has become final. Costs may be fixed once their credibility is established.

The request provided for in the second sentence of Article 70(6) of Regulation (EC) No 6/2002 for a review of the decision of the registry on the fixing of costs, stating the reasons on which it is based, must be filed at the Office within one month of the date of notification of the awarding of costs.

It shall not be deemed to be filed until the fee for reviewing the amount of the costs has been paid.

The Invalidity Division or the Board of Appeal, as the case may be, shall take a decision on the request referred to in paragraph 4 without oral proceedings.

The fees to be borne by the losing party pursuant to Article 70(1) of Regulation (EC) No 6/2002 shall be limited to the fees incurred by the other party for the application for a declaration of invalidity and/or for the appeal.

Costs essential to the proceedings and actually incurred by the successful party shall be borne by the losing party in accordance with Article 70(1) of Regulation (EC) No 6/2002 on the basis of the following maximum rates:

travel expenses of one party for the outward and return journey between the place of residence or the place of business and the place where oral proceedings are held or where evidence is taken, as follows:

the cost of the first-class rail fare including usual transport supplements where the total distance by rail does not exceed 800 km;

the cost of the tourist-class air fare where the total distance by rail exceeds 800 km or the route includes a sea crossing;

subsistence expenses of one party equal to the daily subsistence allowance for officials in grades A 4 to A 8 as laid down in Article 13 of Annex VII to the Staff Regulations of officials of the European Communities;

travel expenses of representatives within the meaning of Article 78(1) of Regulation (EC) No 6/2002 and of witnesses and of experts, at the rates provided for in point (a);

subsistence expenses of representatives within the meaning of Article 78(1) of Regulation (EC) No 6/2002 and of witnesses and experts, at the rates referred to in point (b);

costs entailed in the taking of evidence in the form of examination of witnesses, opinions by experts or inspection, up to EUR 300 per proceedings;

costs of representation, within the meaning of Article 78(1) of Regulation (EC) No 6/2002:

of the applicant in proceedings relating to invalidity of a registered Community design up to EUR 400;

of the holder in proceedings relating to invalidity of a registered Community design up to EUR 400;

of the appellant in appeal proceedings up to EUR 500;

of the defendant in appeal proceedings up to EUR 500;

where the successful party is represented by more than one representative within the meaning of Article 78(1) of the Regulation (EC) No 6/2002, the losing party shall bear the costs referred to in points (c), (d) and (f) for one such person only;

the losing party shall not be obliged to reimburse the successful party for any costs, expenses and fees other than those referred to in points (a) to (g).

Where the taking of evidence in any of the proceedings referred to in point (f) of the first subparagraph involves the examination of witnesses, opinions by experts or inspection, an additional amount shall be granted for representation costs of up to EUR 600 per proceedings.

## CHAPTER XIX

### LANGUAGES

#### Article 80

## Applications and declarations

Without prejudice to Article 98(4) of Regulation (EC) No 6/2002:

any application or declaration relating to an application for a registered Community design may be filed in the language used for filing the application or in the second language indicated by the applicant in his/her application;

any application or declaration other than an application for declaration of invalidity pursuant to Article 52 of Regulation (EC) No 6/2002, or declaration of surrender pursuant to Article 51 of that Regulation relating to a registered Community design may be filed in one of the languages of the Office;

when any of the forms provided by the Office pursuant to Article 68 is used, such forms may be used in any of the official languages of the Community, provided that the form is completed in one of the languages of the Office, as far as textual elements are concerned.

## Article 81

### Written proceedings

Without prejudice to Article 98(3) and (5) of Regulation (EC) No 6/2002 and save as otherwise provided in this Regulation, in written proceedings before the Office a party may use any language of the Office.

If the language chosen is not the language of the proceedings, the party shall supply a translation into that language within one month of the date of the submission of the original document.

Where the applicant for a registered Community design is the sole party to proceedings before the Office and the language used for the filing of the application for the registered Community design is not one of the languages of the Office, the translation may also be filed in the second language indicated by the applicant in his/her application.

Save as otherwise provided in this Regulation, documents to be used in proceedings before the Office may be filed in any official language of the Community.

Where the language of such documents is not the language of the proceedings the Office may require that a translation be supplied, within a time limit specified by it, in that language or, at the choice of the party to the proceeding, in any language of the Office.

## Article 82

### Oral proceedings

Any party to oral proceedings before the Office may, in place of the language of proceedings, use one of the other official languages of the Community, on condition that he/she makes provision for interpretation into the language of proceedings.

Where the oral proceedings are held in a proceeding concerning the application for registration of a design the applicant may use either the language of the application or the second language indicated by him/her.

In oral proceedings concerning the application for registration of a design, the staff of the Office may use either the language of the application or the second language indicated by the applicant.

In all other oral proceedings, the staff of the Office may use, in place of the language of the proceedings, one of the other languages of the Office, on condition that the party or parties to the proceedings agree(s) to such use.

With regard to the taking of evidence, any party to be heard, witness or expert who is unable to express himself/herself adequately in the language of proceedings, may use any of the official languages of the Community.

Where the taking of evidence is decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express themselves in languages other than the language of proceedings may be heard only if the party who made the request makes provision for interpretation into that language.

In proceedings concerning the application for registration of a design, in place of the language of the application, the second language indicated by the applicant may be used.

In any proceedings with only one party, the Office may at the request of the party concerned permit derogation from the provisions in this paragraph.

If the parties and the Office so agree, any official language of the Community may be used in oral proceedings.

The Office shall, if necessary, make provision at its own expense for interpretation into the language of proceedings, or, where appropriate, into its other languages, unless this interpretation is the responsibility of one of the parties to the proceedings.

Statements by staff of the Office, by parties to the proceedings and by witnesses and experts, made in one of the languages of the Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the language of proceedings.

Corrections to the application for or the registration of a Community design shall be entered in the minutes in the language of proceedings.

#### Article 83

##### Certification of translations

When a translation of any document is to be filed, the Office may require the filing, within a time limit to be specified by it, of a certificate that the translation corresponds to the original text.

Where the certificate relates to the translation of a previous application pursuant to Article 42 of Regulation (EC) No 6/2002, such time limit shall not be less than three months after the date of filing of the application.

Where the certificate is not filed within that time limit, the document shall be deemed not to have been received.

The President of the Office may determine the manner in which translations are certified.

#### Article 84

##### Legal authenticity of translations

In the absence of evidence to the contrary, the Office may assume that a translation corresponds to the relevant original text.

## CHAPTER XX

### RECIPROCITY, TRANSITION PERIOD AND ENTRY INTO FORCE

#### Article 85

##### Publication of reciprocity

If necessary, the President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organisation grants reciprocal treatment within the meaning of Article 41(5) Regulation (EC) No 6/2002.

If the Commission determines that reciprocal treatment in accordance with paragraph 1 is granted, it shall publish a communication to that effect in the Official Journal of the European Communities.

Article 41(5) of Regulation (EC) No 6/2002 shall apply from the date of publication in the Official Journal of the European Communities of the communication referred to in paragraph 2, unless the communication states an earlier date from which it is applicable.

Article 41(5) of Regulation (EC) No 6/2002 shall cease to be applicable from the date of publication in the Official Journal of the European Communities of a communication of the Commission stating that reciprocal treatment is no longer granted, unless the communication states an earlier date from which it is applicable.

Communications referred to in paragraphs 2 and 3 shall also be published in the Official Journal of the Office.

## Article 86

### Transition period

Any application for registration of a Community design filed no more than three months before the date fixed pursuant to Article 111(2) of Regulation (EC) No 6/2002 shall be marked by the Office with the filing date determined pursuant to that provision and with the actual date of receipt of the application.

With regard to the application, the priority period of six months provided for in Articles 41 and 44 of Regulation (EC) No 6/2002 shall be calculated from the date fixed pursuant to Article 111(2) of that Regulation.

The Office may issue a receipt to the applicant prior to the date fixed pursuant to Article 111(2) of Regulation (EC) No 6/2002.

The Office may examine the applications prior to the date fixed pursuant to Article 111(2) of Regulation (EC) No 6/2002 and communicate with the applicant with a view to remedying any deficiencies prior to that date.

Any decisions with regard to such applications may be taken only after that date.

Where the date of receipt of an application for the registration of a Community design by the Office, by the central industrial property office of a Member State or by the Benelux Design Office is before the commencement of the three-month period specified in Article 111(3) of Regulation (EC) No 6/2002 the application shall be deemed not to have been filed.

The applicant shall be informed accordingly and the application shall be sent back to him/her.

## Article 87

### Entry into force

This Regulation shall enter into force on the seventh day following its publication in the Official Journal of the European Communities.

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

Done at Brussels, 21 October 2002.

For the Commission

Frederik Bolkestein

Member of the Commission

OJ L 3, 5.1.2002, p. 1.

See page 54 of this Official Journal.

OJ L 11, 14.1.1994, p. 1.

**3.1.3. Commission Regulation (EC) on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs No 2246/2002<sup>11</sup>**

of 16 December 2002

Commission Regulation (EC) No 2246/2002

of 16 December 2002

on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs(1) and in particular Article 107 thereof,

Whereas:

In the light of Article 139 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark(2), as amended by Regulation (EC) No 3288/94(3) which by virtue of Article 97 of Regulation (EC) No 6/2002 is also applicable to this Regulation the amounts of

---

<sup>11</sup> *Official Journal L 341* , 17/12/2002 P. 0054 – 0059

the fees should be fixed at such a level as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Office to be balanced.

Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs(4) also deals with the conditions under which the fees established by Regulation (EC) No 6/2002 have to be paid to the Office.

To ensure the necessary flexibility, the President of the Office should be empowered, subject to certain conditions, to lay down the charges which may be payable to the Office in respect of services it may render, the charges for access to the Office databases and the making available of the contents of these databases in machine-readable form, and to set charges for the sale of the Office's publications.

In order to facilitate the payment of fees and charges, the President should be empowered to authorise methods of payment which are additional to those explicitly provided for in this Regulation.

The measures provided for in this Regulation are in accordance with the opinion of the Committee established under Article 109 of Regulation (EC) No 6/2002,

HAS ADOPTED THIS REGULATION:

Article 1

Subject matter

This Regulation lays down the amounts and rules for payment of the following:

fees to be paid to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (hereinafter the Office) as provided for in Regulation (EC) No 6/2002 and in Regulation (EC) No 2245/2002;

charges laid down by the President of the Office pursuant to Article 3(1) and (2).

Article 2

Fees provided for in Regulation (EC) No 6/2002 and Regulation (EC) No 2245/2002

The fees provided for in Regulation (EC) No 6/2002 and Regulation (EC) No 2245/2002 to be paid to the Office are set out in the Annex.

Article 3

Charges laid down by the President

The President shall lay down the amount to be charged for any services rendered by the Office other than those specified in the Annex.

The President shall lay down the amount to be charged for the Community Designs Bulletin as well as any other publications issued by the Office.

The amounts of the charges shall be laid down in euro.

The amounts of the charges laid down by the President in accordance with paragraphs 1 and 2 shall be published in the Official Journal of the Office.

#### Article 4

##### Due date for fees and charges

Fees and charges in respect of which the due date is not specified in Regulation (EC) No 6/2002 or in Regulation (EC) No 2245/2002 shall be due on the date of receipt of the request for the service for which the fee or the charge is incurred.

The President may decide not to make services mentioned in paragraph 1 dependent upon the advance payment of the corresponding fees or charges.

#### Article 5

##### Payment of fees and charges

Fees and charges due to the Office shall be paid in euro:

by payment or transfer to a bank account held by the Office;

by delivery or remittance of cheques made payable to the Office;

in cash.

The President may determine methods of payment other than those set out in paragraph 1, in particular by means of deposits in current accounts held with the Office. Those methods shall be published in the Official journal of the Office.

#### Article 6

##### Particulars concerning payment

Every payment shall indicate the name of the person making the payment and shall contain the necessary information to enable the Office to establish immediately the purpose of the payment. In particular, the following information shall be provided:

when the registration fee is paid, the purpose of the payment, namely "registration fee" and, where appropriate, the reference provided by the applicant in the application for the registration of a Community design;

when the publication fee is paid, the purpose of the payment, namely "publication fee" and, where appropriate, the reference provided by the applicant in the application for the registration of a Community design;

when the publication fee is paid as provided for in Article 50(4) of Regulation (EC) No 6/2002, the purpose of the payment, namely "publication fee" and the registration number;

when the fee for the deferment of publication is paid, the purpose of the payment, namely "deferment fee" and, where appropriate, the reference provided by the applicant in the application for the registration of a Community design;

when the invalidity fee is paid, the registration number and the name of the holder of the registered Community design against which the application is directed, and the purpose of the payment, namely "invalidity fee".

If the purpose of the payment cannot immediately be established, the Office shall require the person making the payment to notify it in writing of this purpose within such period as it may specify. If the person does not comply with the request in due time, the payment shall be considered not to have been made. The amount which has been paid shall be refunded.

## Article 7

### Deemed date of payment

The date on which any payment shall be considered to have been made to the Office shall be as follows:

in the cases referred to in Article 5(1)(a), the date on which the amount of the payment is actually entered in a bank account held by the Office;

in the case referred to in Article 5(1)(b), the date of the receipt of the cheque at the Office, provided that the cheque is met;

in the cases referred to in Article 5(1)(c), the date of receipt of the amount of the cash payment.

Where the President allows, in accordance with the provisions of Article 5(2), other methods of paying fees than those set out in Article 5(1), he shall also lay down the date on which such payments shall be considered to have been made.

Where, pursuant to paragraphs 1 and 2, payment of a fee is not considered to have been made until after the expiry of the period in which it was due, it shall be considered that this period

has been observed if evidence is provided to the Office that the person who made the payment:

in a Member State, within the period within which the payment should have been made:

effected the payment through a banking establishment; or

duly gave an order to a banking establishment to transfer the amount of the payment; or

dispatched at a post office or otherwise a letter bearing the address of the Office and containing a cheque within the meaning of Article 5(1)(b), provided that the cheque is met; and

paid a surcharge of 10 % on the relevant fee or fees, but not exceeding EUR 200;

no surcharge is payable if a condition according to subparagraph a has been fulfilled not later than 10 days before the expiry of the period for payment.

The Office may request the person who made the payment to produce evidence as to the date on which a condition according to paragraph 3(a) was fulfilled and, where required, to pay the surcharge referred to in paragraph 3(b), within a period to be specified by it. If the person fails to comply with this request or if the evidence is insufficient, or if the required surcharge is not paid in due time, the period for payment shall be considered not to have been observed.

## Article 8

### Insufficiency of the amount paid

A time limit for payment shall, in principle, be considered to have been observed only if the full amount of the fee has been paid in due time. If the fee is not paid in full, the amount which has been paid shall be refunded after the period for payment has expired.

The Office may, however, in so far as this is possible within the time remaining before the end of the period, give the person making the payment the opportunity to pay the amount lacking or, where this is considered justified, forego any small amounts lacking without prejudice to the rights of the person making the payment.

## Article 9

### Refund of insignificant amounts

Where an excessive sum is paid to cover a fee or a charge, the excess shall not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund.

The President shall determine what constitutes an insignificant amount.

Determinations by the President pursuant to paragraph 1 shall be published in the Official Journal of the Office.

Article 10

Entry into force

This Regulation shall enter into force on the seventh day following its publication in the Official Journal of the European Communities.

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

Done at Brussels, 16 December 2002.

For the Commission

Frederik Bolkestein

Member of the Commission

OJ L 3, 5.1.2002, p. 1.

OJ L 11, 14.1.1994, p. 1.

OJ L 349, 31.12.1994, p. 83.

## **3.2. Directives and decisions**

### **3.2.1. Directive of the European Parliament and of the Council on the legal protection of designs 98/71/EC<sup>12</sup>**

DIRECTIVE 98/71/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 13 October 1998 on the legal protection of designs

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community and in particular Article 100a thereof,

---

<sup>12</sup> *Official Journal L 289*, 28/10/1998 P. 0028 – 0035 31998L0071

Having regard to the proposal by the Commission (1),

Having regard to the opinion of the Economic and Social Committee (2),

Acting in accordance with the procedure laid down in Article 189b of the Treaty (3), in the light of the joint text approved by the Conciliation Committee on 29 July 1998,

Whereas the objectives of the Community, as laid down in the Treaty, include laying the foundations of an ever closer union among the peoples of Europe, fostering closer relations between Member States of the Community, and ensuring the economic and social progress of the Community countries by common action to eliminate the barriers which divide Europe; whereas to that end the Treaty provides for the establishment of an internal market characterised by the abolition of obstacles to the free movement of goods and also for the institution of a system ensuring that competition in the internal market is not distorted; whereas an approximation of the laws of the Member States on the legal protection of designs would further those objectives;

Whereas the differences in the legal protection of designs offered by the legislation of the Member States directly affect the establishment and functioning of the internal market as regards goods embodying designs; whereas such differences can distort competition within the internal market;

Whereas it is therefore necessary for the smooth functioning of the internal market to approximate the design protection laws of the Member States;

Whereas, in doing so, it is important to take into consideration the solutions and the advantages with which the Community design system will provide undertakings wishing to acquire design rights;

Whereas it is unnecessary to undertake a full-scale approximation of the design laws of the Member States, and it will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market; whereas provisions on sanctions, remedies and enforcement should be left to national law; whereas the objectives of this limited approximation cannot be sufficiently achieved by the Member States acting alone;

Whereas Member States should accordingly remain free to fix the procedural provisions concerning registration, renewal and invalidation of design rights and provisions concerning the effects of such invalidity;

Whereas this Directive does not exclude the application to designs of national or Community legislation providing for protection other than that conferred by registration or publication as design, such as legislation relating to unregistered design rights, trade marks, patents and utility models, unfair competition or civil liability;

Whereas, in the absence of harmonisation of copyright law, it is important to establish the principle of cumulation of protection under specific registered design protection law and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred;

Whereas the attainment of the objectives of the internal market requires that the conditions for obtaining a registered design right be identical in all the Member States; whereas to that end it is necessary to give a unitary definition of the notion of design and of the requirements as to novelty and individual character with which registered design rights must comply;

Whereas it is essential, in order to facilitate the free movement of goods, to ensure in principle that registered design rights confer upon the right holder equivalent protection in all Member States;

Whereas protection is conferred by way of registration upon the right holder for those design features of a product, in whole or in part, which are shown visibly in an application and made available to the public by way of publication or consultation of the relevant file;

Whereas protection should not be extended to those component parts which are not visible during normal use of a product, or to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character; whereas features of design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection;

Whereas the assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design;

Whereas technological innovation should not be hampered by granting design protection to features dictated solely by a technical function; whereas it is understood that this does not

entail that a design must have an aesthetic quality; whereas, likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings; whereas features of a design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection;

Whereas the mechanical fittings of modular products may nevertheless constitute an important element of the innovative characteristics of modular products and present a major marketing asset and therefore should be eligible for protection;

Whereas a design right shall not subsist in a design which is contrary to public policy or to accepted principles of morality; whereas this Directive does not constitute a harmonisation of national concepts of public policy or accepted principles of morality;

Whereas it is fundamental for the smooth functioning of the internal market to unify the term of protection afforded by registered design rights;

Whereas the provisions of this Directive are without prejudice to the application of the competition rules under Articles 85 and 86 of the Treaty;

Whereas the rapid adoption of this Directive has become a matter of urgency for a number of industrial sectors; whereas full-scale approximation of the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance, where the product incorporating the design or to which the design is applied constitutes a component part of a complex product upon whose appearance the protected design is dependent, cannot be introduced at the present stage; whereas the lack of full-scale approximation of the laws of the Member States on the use of protected designs for such repair of a complex product should not constitute an obstacle to the approximation of those other national provisions of design law which most directly affect the functioning of the internal market; whereas for this reason Member States should in the meantime maintain in force any provisions in conformity with the Treaty relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance, or, if they introduce any new provisions relating to such use, the purpose of these provisions should be only to liberalise the market in such parts; whereas those Member States which, on the date of entry into force of this Directive, do not provide for protection for designs of component parts are not required to introduce registration of designs for such parts; whereas three years after the implementation date the Commission should submit an analysis of the consequences of the provisions of this Directive for Community

industry, for consumers, for competition and for the functioning of the internal market; whereas, in respect of component parts of complex products, the analysis should, in particular, consider harmonisation on the basis of possible options, including a remuneration system and a limited term of exclusivity; whereas, at the latest one year after the submission of its analysis, the Commission should, after consultation with the parties most affected, propose to the European Parliament and the Council any changes to this Directive needed to complete the internal market in respect of component parts of complex products, and any other changes which it considers necessary;

Whereas the transitional provision in Article 14 concerning the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance is in no case to be construed as constituting an obstacle to the free movement of a product which constitutes such a component part;

Whereas the substantive grounds for refusal of registration in those Member States which provide for substantive examination of applications prior to registration, and the substantive grounds for the invalidation of registered design rights in all the Member States, must be exhaustively enumerated,

HAVE ADOPTED THIS DIRECTIVE:

## Article 1

### Definitions

For the purpose of this Directive:

'design` means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

'product` means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

'complex product` means a product which is composed of multiple components which can be replaced permitting disassembly and reassembly of the product.

## Article 2

### Scope of application

This Directive shall apply to:

design rights registered with the central industrial property offices of the Member States;  
design rights registered at the Benelux Design Office;  
design rights registered under international arrangements which have effect in a Member State;  
applications for design rights referred to under (a), (b) and (c).

For the purpose of this Directive, design registration shall also comprise the publication following filing of the design with the industrial property office of a Member State in which such publication has the effect of bringing a design right into existence.

### Article 3

#### Protection requirements

Member States shall protect designs by registration, and shall confer exclusive rights upon their holders in accordance with the provisions of this Directive.

A design shall be protected by a design right to the extent that it is new and has individual character.

A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and

to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

'Normal use' within the meaning of paragraph (3)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

### Article 4

#### Novelty

A design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

### Article 5

#### Individual character

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority.

In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

## Article 6

### Disclosure

For the purpose of applying Articles 4 and 5, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community, before the date of filing of the application for registration or, if priority is claimed, the date of priority. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

A disclosure shall not be taken into consideration for the purpose of applying Articles 4 and 5 if a design for which protection is claimed under a registered design right of a Member State has been made available to the public:

by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title; and

during the 12-month period preceding the date of filing of the application or, if priority is claimed, the date of priority.

Paragraph 2 shall also apply if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

## Article 7

### Designs dictated by their technical function and designs of interconnections

A design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.

A design right shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the

design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

Notwithstanding paragraph 2, a design right shall, under the conditions set out in Articles 4 and 5, subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

#### Article 8

##### Designs contrary to public policy or morality

A design right shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

#### Article 9

##### Scope of protection

The scope of the protection conferred by a design right shall include any design which does not produce on the informed user a different overall impression.

In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

#### Article 10

##### Term of protection

Upon registration, a design which meets the requirements of Article 3(2) shall be protected by a design right for one or more periods of five years from the date of filing of the application. The right holder may have the term of protection renewed for one or more periods of five years each, up to a total term of 25 years from the date of filing.

#### Article 11

##### Invalidity or refusal of registration

A design shall be refused registration, or, if the design has been registered, the design right shall be declared invalid:

if the design is not a design within the meaning of Article 1(a); or

if it does not fulfil the requirements of Articles 3 to 8; or

if the applicant for or the holder of the design right is not entitled to it under the law of the Member State concerned; or

if the design is in conflict with a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, the date of priority, and which is protected from a date prior to the said date by a registered Community design or an application for a registered Community design or by a design right of the Member State concerned, or by an application for such a right.

Any Member State may provide that a design shall be refused registration, or, if the design has been registered, that the design right shall be declared invalid:

if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State concerned governing that sign confers on the right holder of the sign the right to prohibit such use; or

if the design constitutes an unauthorised use of a work protected under the copyright law of the Member State concerned; or

if the design constitutes an improper use of any of the items listed in Article 6b of the Paris Convention for the Protection of Industrial Property, or of badges, emblems and escutcheons other than those covered by Article 6b of the said Convention which are of particular public interest in the Member State concerned.

The ground provided for in paragraph 1(c) may be invoked solely by the person who is entitled to the design right under the law of the Member State concerned.

The grounds provided for in paragraph 1(d) and in paragraph 2(a) and (b) may be invoked solely by the applicant for or the holder of the conflicting right.

The ground provided for in paragraph 2(c) may be invoked solely by the person or entity concerned by the use.

Paragraphs 4 and 5 shall be without prejudice to the freedom of Member States to provide that the grounds provided for in paragraphs 1(d) and 2(c) may also be invoked by the appropriate authority of the Member State in question on its own initiative.

When a design has been refused registration or a design right has been declared invalid pursuant to paragraph 1(b) or to paragraph 2, the design may be registered or the design right maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. Registration or maintenance in an amended form may include registration accompanied by a partial disclaimer by the holder of the design right or entry in the design Register of a court decision declaring the partial invalidity of the design right.

Any Member State may provide that, by way of derogation from paragraphs 1 to 7, the grounds for refusal of registration or for invalidation in force in that State prior to the date on which the provisions necessary to comply with this Directive enter into force shall apply to design applications which have been made prior to that date and to resulting registrations.

A design right may be declared invalid even after it has lapsed or has been surrendered.

## Article 12

### Rights conferred by the design right

The registration of a design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

Where, under the law of a Member State, acts referred to in paragraph 1 could not be prevented before the date on which the provisions necessary to comply with this Directive entered into force, the rights conferred by the design right may not be invoked to prevent continuation of such acts by any person who had begun such acts prior to that date.

## Article 13

### Limitation of the rights conferred by the design right

The rights conferred by a design right upon registration shall not be exercised in respect of:

acts done privately and for non-commercial purposes;

acts done for experimental purposes;

acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

In addition, the rights conferred by a design right upon registration shall not be exercised in respect of:

the equipment on ships and aircraft registered in another country when these temporarily enter the territory of the Member State concerned;

the importation in the Member State concerned of spare parts and accessories for the purpose of repairing such craft;

the execution of repairs on such craft.

## Article 14

### Transitional provision

Until such time as amendments to this Directive are adopted on a proposal from the Commission in accordance with the provisions of Article 18, Member States shall maintain in force their existing legal provisions relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance and shall introduce changes to those provisions only if the purpose is to liberalise the market for such parts.

## Article 15

### Exhaustion of rights

The rights conferred by a design right upon registration shall not extend to acts relating to a product in which a design included within the scope of protection of the design right is incorporated or to which it is applied, when the product has been put on the market in the Community by the holder of the design right or with his consent.

## Article 16

### Relationship to other forms of protection

The provisions of this Directive shall be without prejudice to any provisions of Community law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability or unfair competition.

## Article 17

### Relationship to copyright

A design protected by a design right registered in or in respect of a Member State in accordance with this Directive shall also be eligible for protection under the law of copyright of that State as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.

## Article 18

### Revision

Three years after the implementation date specified in Article 19, the Commission shall submit an analysis of the consequences of the provisions of this Directive for Community

industry, in particular the industrial sectors which are most affected, particularly manufacturers of complex products and component parts, for consumers, for competition and for the functioning of the internal market. At the latest one year later the Commission shall propose to the European Parliament and the Council any changes to this Directive needed to complete the internal market in respect of component parts of complex products and any other changes which it considers necessary in light of its consultations with the parties most affected.

#### Article 19

##### Implementation

Member States shall bring into force the laws, regulations or administrative provisions necessary to comply with this Directive not later than 28 October 2001.

When Member States adopt these provisions, they shall contain a reference to this Directive or shall be accompanied by such reference on the occasion of their official publication. The methods of making such reference shall be laid down by Member States.

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

#### Article 20

##### Entry into force

This Directive shall enter into force on the 20th day following its publication in the Official Journal of the European Communities.

#### Article 21

##### Addressees

This Directive is addressed to the Member States.

Done at Luxembourg, 13 October 1998.

For the European Parliament

The President

J. M. GIL-ROBLES

For the Council

The President

C. EINEM

OJ C 345, 23. 12. 1993, p. 14 and OJ C 142, 14. 5. 1996, p. 7.

OJ C 388, 31. 12. 1994, p. 9 and OJ C 110, 2. 5. 1995, p. 12.

Opinion of the European Parliament of 12 October 1995 (OJ C 287, 30. 10. 1995, p. 157), common position of the Council of 17 June 1997 (OJ C 237, 4. 8. 1997, p. 1), Decision of the European Parliament of 22 October 1997 (OJ C 339, 10. 11. 1997, p. 52). Decision of the European Parliament of 15 September 1998. Decision of the Council of 24 September 1998.

Statement by the Commission

The Commission shares the European Parliament's concern about combating counterfeiting.

The Commission's intention is to present before the end of the year a Green Paper regarding piracy and counterfeiting in the internal market.

The Commission will include in this Green Paper Parliament's idea of creating an obligation for counterfeiters to provide holders of design rights with information on their illegal acts.

Statement by the Commission regarding Article 18

Immediately following the date of adoption of the Directive, and without prejudice to Article 18, the Commission proposes to launch a consultation exercise involving manufacturers of complex products and of component parts in the motor vehicles sector. The aim of this consultation will be to arrive at a voluntary agreement between the parties involved on the protection of designs in cases where the product incorporating the design or to which the design is applied constitutes a component part of a complex product upon whose appearance the protected design is dependent.

The Commission will coordinate the consultation exercise and will report regularly to the Parliament and the Council on its progress. The consulted parties will be invited by the Commission to consider a range of possible options on which to base a voluntary agreement, including a remuneration system and a system based on a limited period of design protection.

## Chapte IV. Topographies of semiconductor products

### 4.1. Directives and decisions

#### 4.1.1. Council Directive on the legal protection of topographies of semiconductor products 87/54/EEC<sup>13</sup>

of 16 December 1986

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community and in particular Article 100 thereof,

Having regard to the proposal from the Commission (1),

Having regard to the opinion of the European Parliament (2),

Having regard to the opinion of the Economic and Social Committee (3),

Whereas semiconductor products are playing an increasingly important role in a broad range of industries and semiconductor technology can accordingly be considered as being of fundamental importance for the Community's industrial development;

Whereas the functions of semiconductor products depend in large part on the topographies of such products and whereas the development of such topographies requires the investment of considerable resources, human, technical and financial, while topographies of such products can be copied at a fraction of the cost needed to develop them independently;

Whereas topographies of semiconductor products are at present not clearly protected in all Member States by existing legislation and such protection, where it exists, has different attributes;

Whereas certain existing differences in the legal protection of semiconductor products offered by the laws of the Member States have direct and negative effects on the functioning of the common market as regards semiconductor products and such differences could well become greater as Member States introduce new legislation on this subject;

---

<sup>13</sup> *Official Journal L 024* , 27/01/1987 P. 0036 – 0040 31987L0054

Whereas existing differences having such effects need to be removed and new ones having a negative effect on the common market prevented from arising;

Whereas, in relation to extension of protection to persons outside the Community, Member States should be free to act on their own behalf in so far as Community decisions have not been taken within a limited period of time;

Whereas the Community's legal framework on the protection of topographies of semiconductor products can, in the first instance, be limited to certain basic principles by provisions specifying whom and what should be protected, the exclusive rights on which protected persons should be able to rely to authorize or prohibit certain acts, exceptions to these rights and for how long the protection should last;

Whereas other matters can for the time being be decided in accordance with national law, in particular, whether registration or deposit is required as a condition for protection and, subject to an exclusion of licences granted for the sole reason that a certain period of time has elapsed, whether and on what conditions non-voluntary licences may be granted in respect of protected topographies;

Whereas protection of topographies of semiconductor products in accordance with this Directive should be without prejudice to the application of some other forms of protection;

Whereas further measures concerning the legal protection of topographies of semiconductor products in the Community can be considered at a later stage, if necessary, while the application of common basic principles by all Member States in accordance with the provisions of this Directive is an urgent necessity,

HAS ADOPTED THIS DIRECTIVE:

## CHAPTER 1

### Definitions

#### Article 1

1. For the purposes of this Directive:

(a) a 'semiconductor product' shall mean the final or an intermediate form of any product:

(i) consisting of a body of material which includes a layer of semiconducting material; and

(ii) having one or more other layers composed of conducting, insulating or semiconducting material, the layers being arranged in accordance with a predetermined three-dimensional pattern; and

(iii) intended to perform, exclusively or together with other functions, an electronic function;

(b) the 'topography' of a semiconductor product shall mean a series of related images, however fixed or encoded;

(i) representing the three-dimensional pattern of the layers of which a semiconductor product is composed; and

(ii) in which series, each image has the pattern or part of the pattern of a surface of the semiconductor product at any stage of its manufacture;

(c) 'commercial exploitation' means the sale, rental, leasing or any other method of commercial distribution, or an offer for these purposes. However, for the purposes of Articles 3 (4), 4 (1), 7 (1), (3) and (4) 'commercial exploitation' shall not include exploitation under conditions of confidentiality to the extent that no further distribution to third parties occurs, except where exploitation of a topography takes place under conditions of confidentiality required by a measure taken in conformity with Article 223 (1) (b) of the Treaty.

2. The Council acting by qualified majority on a proposal from the Commission, may amend paragraph 1 (a) (i) and (ii) in order to adapt these provisions in the light of technical progress.

## CHAPTER 2

### Protection of topographies of semiconductor products

#### Article 2

1. Member States shall protect the topographies of semiconductor products by adopting legislative provisions conferring exclusive rights in accordance with the provisions of the Directive.

2. The topography of a semiconductor product shall be protected in so far as it satisfies the conditions that it is the result of its creator's own intellectual effort and is not commonplace in the semiconductor industry. Where the topography of a semiconductor product consists of elements that are commonplace in the semiconductor industry, it shall be protected only to the extent that the combination of such elements, taken as a whole, fulfils the abovementioned conditions.

### Article 3

1. Subject to paragraphs 2 to 5, the right to protection shall apply in favour of persons who are the creators of the topographies of semiconductor products.

2. Member States may provide that,

(a) where a topography is created in the course of the creator's employment, the right to protection shall apply in favour of the creator's employer unless the terms of employment provide to the contrary;

(b) where a topography is created under a contract other than a contract of employment, the right to protection shall apply in favour of a party to the contract by whom the topography has been commissioned, unless the contract provides to the contrary.

3. (a) As regards the persons referred to in paragraph 1, the right to protection shall apply in favour of natural persons who are nationals of a Member State or who have their habitual residence on the territory of a Member State.

(b) Where Member States make provision in accordance with paragraph 2, the right to protection shall apply in favour of:

(i) natural persons who are nationals of a Member State or who have their habitual residence on the territory of a Member State;

(ii) companies or other legal persons which have a real and effective industrial or commercial establishment on the territory of a Member State.

4. Where no right to protection exists in accordance with other provisions of this Article, the right to protection shall also apply in favour of the persons referred to in paragraph 3 (b) (i) and (ii) who:

(a) first commercially exploit within a Member State a topography which has not yet been exploited commercially anywhere in the world; and

(b) have been exclusively authorized to exploit commercially the topography throughout the Community by the person entitled to dispose of it.

5. The right to protection shall also apply in favour of the successors in title of the persons mentioned in paragraphs 1 to 4.

6. Subject to paragraph 7, Member States may negotiate and conclude agreements or understandings with third States and multilateral Conventions concerning the legal protection of topographies of semiconductor products whilst respecting Community law and in particular the rules laid down in this Directive.

7. Member States may enter into negotiations with third States with a view to extending the right to protection to persons who do not benefit from the right to protection according to the provisions of this Directive. Member States who enter into such negotiations shall inform the Commission thereof.

When a Member State wishes to extend protection to persons who otherwise do not benefit from the right to protection according to the provisions of this Directive or to conclude an agreement or understanding on the extension of protection with a non-Member State it shall notify the Commission. The Commission shall inform the other Member States thereof. The Member State shall hold the extension of protection or the conclusion of the agreement or understanding in abeyance for one month from the date on which it notifies the Commission. However, if within that period the Commission notifies the Member State concerned of its intention to submit a proposal to the Council for all Member States to extend protection in respect of the persons or non-Member State concerned, the Member State shall hold the extension of protection or the conclusion of the agreement or understanding in abeyance for a period of two months from the date of the notification by the Member State.

Where, before the end of this two-month period, the Commission submits such a proposal to the Council, the Member State shall hold the extension of protection or the conclusion of the agreement or understanding in abeyance for a further period of four months from the date on which the proposal was submitted.

In the absence of a Commission notification or proposal or a Council decision within the time limits prescribed above, the Member State may extend protection or conclude the agreement or understanding.

A proposal by the Commission to extend protection, whether or not it is made following a notification by a Member State in accordance with the preceding paragraphs shall be adopted by the Council acting by qualified majority.

A Decision of the Council on the basis of a Commission proposal shall not prevent a Member State from extending protection to persons, in addition to those to benefit from protection in

all Member States, who were included in the envisaged extension, agreement or understanding as notified, unless the Council acting by qualified majority has decided otherwise.

8. Commission proposals and Council decisions pursuant to paragraph 7 shall be published for information in the Official Journal of the European Communities.

#### Article 4

1. Member States may provide that the exclusive rights conferred in conformity with Article 2 shall not come into existence or shall no longer apply to the topography of a semiconductor product unless an application for registration in due form has been filed with a public authority within two years of its first commercial exploitation. Member States may require in addition to such registration that material identifying or exemplifying the topography or any combination thereof has been deposited with a public authority, as well as a statement as to the date of first commercial exploitation of the topography where it precedes the date of the application for registration.

2. Member States shall ensure that material deposited in conformity with paragraph 1 is not made available to the public where it is a trade secret. This provision shall be without prejudice to the disclosure of such material pursuant to an order of a court or other competent authority to persons involved in litigation concerning the validity or infringement of the exclusive rights referred to in Article 2.

3. Member States may require that transfers of rights in protected topographies be registered.

4. Member States may subject registration and deposit in accordance with paragraphs 1 and 3 to the payment of fees not exceeding their administrative costs.

5. Conditions prescribing the fulfilment of additional formalities for obtaining or maintaining protection shall not be admitted.

6. Member States which require registration shall provide for legal remedies in favour of a person having the right to protection in accordance with the provisions of this Directive who can prove that another person has applied for or obtained the registration of a topography without his authorization.

#### Article 5

1. The exclusive rights referred to in Article 2 shall include the rights to authorize or prohibit any of the following acts:

(a) reproduction of a topography in so far as it is protected under Article 2 (2);

(b) commercial exploitation or the importation for that purpose of a topography or of a semiconductor product manufactured by using the topography.

2. Notwithstanding paragraph 1, a Member State may permit the reproduction of a topography privately for non commercial aims.

3. The exclusive rights referred to in paragraph 1 (a) shall not apply to reproduction for the purpose of analyzing, evaluating or teaching the concepts, processes, systems or techniques embodied in the topography or the topography itself.

4. The exclusive rights referred to in paragraph 1 shall not extend to any such act in relation to a topography meeting the requirements of Article 2 (2) and created on the basis of an analysis and evaluation of another topography, carried out in conformity with paragraph 3.

5. The exclusive rights to authorize or prohibit the acts specified in paragraph 1 (b) shall not apply to any such act committed after the topography or the semiconductor product has been put on the market in a Member State by the person entitled to authorize its marketing or with his consent. 6. A person who, when he acquires a semiconductor product, does not know, or has no reasonable grounds to believe, that the product is protected by an exclusive right conferred by a Member State in conformity with this Directive shall not be prevented from commercially exploiting that product.

However, for acts committed after that person knows, or has reasonable grounds to believe, that the semiconductor product is so protected, Member States shall ensure that on the demand of the rightholder a tribunal may require, in accordance with the provisions of the national law applicable, the payment of adequate remuneration.

7. The provisions of paragraph 6 shall apply to the successors in title of the person referred to in the first sentence of that paragraph.

## Article 6

Member States shall not subject the exclusive rights referred to in Article 2 to licences granted, for the sole reason that a certain period of time has elapsed, automatically, and by operation of law.

## Article 7

1. Member States shall provide that the exclusive rights referred to in Article 2 shall come into existence:

(a) where registration is the condition for the coming into existence of the exclusive rights in accordance with Article 4, on the earlier of the following dates:

(i) the date when the topography is first commercially exploited anywhere in the world;

(ii) the date when an application or registration has been filed in due form; or

(b) when the topography is first commercially exploited anywhere in the world; or

(c) when the topography is first fixed or encoded.

2. Where the exclusive rights come into existence in accordance with paragraph 1 (a) or (b), the Member States shall provide, for the period prior to those rights coming into existence, legal remedies in favour of a person having the right to protection in accordance with the provisions of this Directive who can prove that another person has fraudulently reproduced or commercially exploited or imported for that purpose a topography. This paragraph shall be without prejudice to legal remedies made available to enforce the exclusive rights conferred in conformity with Article 2.

3. The exclusive rights shall come to an end 10 years from the end of the calendar year in which the topography is first commercially exploited anywhere in the world or, where registration is a condition for the coming into existence or continuing application of the exclusive rights, 10 years from the earlier of the following dates:

(a) the end of the calendar year in which the topography is first commercially exploited anywhere in the world;

(b) the end of the calendar year in which the application for registration has been filed in due form.

4. Where a topography has not been commercially exploited anywhere in the world within a period of 15 years from its first fixation or encoding, any exclusive rights in existence pursuant to paragraph 1 shall come to an end and no new exclusive rights shall come into existence unless an application for registration in due form has been filed within that period in those Member States where registration is a condition for the coming into existence or continuing application of the exclusive rights.

## Article 8

The protection granted to the topographies of semiconductor products in accordance with Article 2 shall not extend to any concept, process, system, technique or encoded information embodied in the topography other than the topography itself.

## Article 9

Where the legislation of Member States provides that semiconductor products manufactured using protected topographies may carry an indication, the indication to be used shall be a capital T as follows: T, 'T', [ T ], T , T \* or T .

## CHAPTER 3

Continued application of other legal provisions

### Article 10

1. The provisions of this Directive shall be without prejudice to legal provisions concerning patent and utility model rights.

2. The provisions of this Directive shall be without prejudice:

(a) to rights conferred by the Member States in fulfilment of their obligations under international agreements, including provisions extending such rights to nationals of, or residents in, the territory of the Member State concerned;

(b) to the law of copyright in Member States, restricting the reproduction of drawing or other artistic representations of topographies by copying them in two dimensions.

3. Protection granted by national law to topographies of semiconductor products fixed or encoded before the entry into force of the national provisions enacting the Directive, but no later than the date set out in Article 11 (1), shall not be affected by the provisions of this Directive. CHAPTER 4

Final provisions

### Article 11

1. Member States shall bring into force the laws, regulations or administrative provisions necessary to comply with this Directive by 7 November 1987.

2. Member States shall ensure that they communicate to the Commission the texts of the main provisions of national law which they adopt in the field covered by this Directive.

Article 12

This Directive is addressed to the Member States.

Done at Brussels, 16 December 1986.

For the Council

The President

G. HOWE

(1) OJ No C 360, 31. 12. 1985, p. 14.

(2) OJ No C 255, 13. 10. 1986, p. 249.

(3) OJ No C 189, 28. 7. 1986, p. 5.

#### **4.1.2. Council Decision on the extension of the legal protection of topographies of semiconductor products to persons from the United States of America and certain territories 93/16/EEC<sup>14</sup>**

of 21 December 1992

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community,

Having regard to Council Directive 87/54/EEC of 16 December 1986 on the legal protection of topographies of semiconductor products (1), and in particular Article 3 (7) thereof,

Having regard to the proposal from the Commission,

Whereas the right to legal protection of topographies of semiconductor products in the Community applies to persons qualifying for protection under Article 3 (1) to (5) of Directive 87/54/EEC;

---

<sup>14</sup> *Official Journal L 011* , 19/01/1993 P. 0020 – 0021 31993D0016

Whereas this right can be extended, by a Council Decision, to persons who do not benefit from protection under the said provisions;

Whereas the extension of the protection in question should, as far as possible, be decided upon for the Community as a whole;

Whereas such protection has previously been extended in respect of certain countries and territories, on an interim basis only, in accordance with Decision 90/511/EEC (2), which expires on 31 December 1992;

Whereas this protection has been extended to companies and other legal persons in respect of the United States of America, as Commission Decision 90/541/EEC (3), determined that the United States fulfils, until 31 December 1992, the condition of reciprocity laid down in Article 1 (2) of Decision 90/511/EEC;

Whereas the United States have an appropriate legislation and are expected to continue to protect topographies of semiconductor products under their national law and make this protection available to those persons from the Member States of the Community who benefit from the right to protection under Directive 87/54/EEC;

Whereas it is expected that certain territories which do not yet have appropriate legislation will provide it and will make it accessible as soon as possible to the said persons from Member States of the Community;

Whereas all Member States of the Community have now adopted national measures implementing Directive 87/54/EEC;

Whereas it is appropriate to continue to extend the protection in question to the United States for one year only, to allow time for the procedure for granting mutual unlimited protection to be completed;

Whereas it is also appropriate to continue to extend such protection on an interim basis to the abovementioned territories to allow further time for conditions for mutual unlimited protection to be established,

HAS ADOPTED THIS DECISION:

Article 1

1. Member States shall extend the legal protection provided for under Directive 87/54/EEC as follows:

(a) natural persons who are nationals of the United States of America or of a territory listed in the Annex to this Decision or who have their habitual residence in the territory of the United States of America or one of those territories shall be treated as if they were nationals of a Member State;

(b) companies or other legal persons of the United States of America or of a territory listed in the Annex which have a real and effective industrial or commercial establishment in such country or such a territory shall be treated as if they have a real and effective industrial or commercial establishment in the territory of a Member State.

2. The application of subparagraph 1 (b) shall be subject to the condition that companies or other legal persons of a Member State which have a right to protection under Directive 87/54/EEC benefit from protection in the United States or the territory in question.

3. The fulfilment by the United States of America or by territories listed in the Annex of the conditions laid down in paragraph 2 shall be determined by the Commission and communicated to the Member States.

## Article 2

This Decision shall apply from 1 January 1993.

Member States shall extend protection under this Decision to the persons referred to in Article 1 until 31 December 1994.

In respect of the United States of America, this date shall be 31 December 1993.

Any exclusive rights acquired under Decision 90/511/EEC or this Decision shall continue to produce their effect for the period laid down under Directive 87/54/EEC.

## Article 3

This Decision is addressed to the Member States.

Done at Brussels, 21 December 1992.

For the Council

The President

D. HURD

(1) OJ No L 24, 27. 1. 1987, p. 36.

(2) OJ No L 285, 17. 10. 1990, p. 31.

(3) OJ No L 307, 7. 11. 1990, p. 21. Decision as amended by Decision 92/20/EEC (OJ No L 9, 15. 1. 1992, p. 22).

ANNEX

Anguilla

Bermuda

British Indian Ocean Territory

British Virgin Islands

Cayman Islands

Channel Islands

Falkland Islands

Hong Kong

Isle of Man

Montserrat

Pitcairn

St Helena

St Helena Dependencies (Ascension, Tristan da Cunha)

South Georgia and the South Sandwich Islands

Turks and Caicos Islands.

**4.1.3. Council Decision on the extension of the legal protection of topographies of semiconductor products to persons from Canada 94/700/EC<sup>15</sup>**

of 24 October 1994

---

<sup>15</sup> *Official Journal L 284*, 01/11/1994 P. 0061 – 0062

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community,

Having regard to Council Directive 87/54/EEC of 16 December 1986 on the legal protection of topographies of semiconductor products (1), and in particular Article 3 (7) thereof,

Having regard to the proposal from the Commission,

Whereas the right to legal protection of topographies of semiconductor products in the Community applies to persons qualifying for protection pursuant to Article 3 (1) to (5) of Directive 87/54/EEC;

Whereas this right can be extended by Council decision to persons who do not benefit from protection pursuant to the said provisions;

Whereas the extension of the protection in question should, as far as possible, be decided by the Community as a whole;

Whereas protection has previously been granted on conditions of reciprocity to persons from certain countries and territories outside the Community, in some cases on a permanent basis in Decision 90/510/EEC (2), and in others on an interim basis in Decision 93/16/EEC (3);

Whereas Canada has regulations according suitable protection to designers of topographies and has announced that it plans to extend their applications, from 1 November 1994, to Community nationals and to natural and legal persons that have a real and effective establishment there for the purpose of designing topographies or manufacturing integrated circuits;

Whereas the Agreement on trade-related aspects of intellectual property rights, which forms part of the result of the Uruguay Round of multilateral trade negotiations embodied in the Marrakesh Final Act of 15 April 1994, requires Members to grant protection to integrated-circuit topographies in compliance with its own provisions and with those of the Treaty on Intellectual Property in Respect of Integrated Circuits to which it refers;

Whereas the Agreement, together with that establishing the World Trade Organization, will enter into force on 1 January 1995 or as soon as possible after that date; whereas the developed countries which are Members of the Agreement establishing the World Trade

Organization will have one year following the entry into force of that Agreement in which to implement the Agreement on trade related aspects of intellectual property rights;

Whereas, in view of the undertakings given by the Canadian authorities, the right to protection pursuant to Directive 87/54/EEC should be extended, from 1 November 1994 until the implementation of the Agreement on trade related aspects of intellectual property rights, to natural persons, companies and other legal persons from Canada,

HAS ADOPTED THIS DECISION:

#### Article 1

Member States shall extend the legal protection provided for pursuant to Directive 87/54/EEC as follows:

(a) natural persons who are nationals of Canada or who have their habitual residence in the territory of Canada shall be treated as if they were nationals of a Member State;

(b) companies and other legal persons of Canada which have a real and effective industrial or commercial establishment in that country shall be treated as if they had a real and effective industrial or commercial establishment in the territory of a Member State.

#### Article 2

This Decision shall apply from 1 November 1994.

#### Article 3

This Decision is addressed to the Member States.

Done at Luxembourg, 24 October 1994.

For the Council

The President

J. BORCHERT

(1) OJ No L 24, 27. 1. 1987, p. 36.

(2) OJ No L 285, 17. 10. 1990, p. 29. Decision as amended by Decision 93/17/EEC (OJ No L 11, 19. 1. 1993, p. 22).

(3) OJ No L 11, 19. 1. 1993, p. 20. Decision as amended by Decision 93/520/EEC (OJ No L 246, 2. 10. 1993, p. 31) which grants interim protection to persons from the United States of America (until 31. 12. 1993) and from certain territories (until 31. 12. 1994), and Decision 94/373/EC (OJ No L 170, 5. 7. 1994, p. 34), which extends until 1 July 1995 the protection in respect of the United States of America.

#### **4.1.4. Council Decision on the extension of the legal protection of topographies of semiconductor products to persons from the Isle of Man 96/644/EC<sup>16</sup>**

11 November 1996

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community,

Having regard to Council Directive 87/54/EEC (1) of 16 December 1986 on the legal protection of topographies of semiconductor products, and in particular Article 3 (7) thereof,

Having regard to the proposal from the Commission,

Whereas the right to legal protection of topographies of semiconductor products in the Community applies to persons qualifying for protection under Article 3 (1) to (5) of Directive 87/54/EEC;

Whereas this right can be extended by Council Decision to persons who do not benefit from protection under the said provisions;

Whereas the extension of the protection in question should be decided by the Community as a whole;

Whereas the Community has, since 7 November 1987, extended such protection to persons from the Isle of Man by successive Council Decisions taken on an interim basis, the latest of which is Decision 94/828/EC (2);

Whereas that Decision applied until 31 December 1995;

---

<sup>16</sup> *Official Journal L 293*, 16/11/1996 P. 0018 – 0019 31996D0644

Whereas the Isle of Man has appropriate legislation (3) on the protection of topographies of semiconductor products; whereas that legislation entered into force on 1 January 1994; whereas it applies Directive 87/54/EEC and gives effect to the Council's previous Decisions on the topic; whereas the Isle of Man extends application of the legislation to nationals of Member States of the Community;

Whereas the Agreement on trade-related aspects of intellectual property rights, concluded on 15 April 1994, requires Members of the World Trade Organization to grant protection to integrated-circuit topographies in compliance with its own provisions and with those of the Treaty on Intellectual Property in Respect of Integrated Circuits to which it refers;

Whereas the Agreement, together with that establishing the World Trade Organization, to which it is annexed, entered into force on 1 January 1995;

Whereas it is foreseeable that the Government of the United Kingdom will apply the Agreement establishing the World Trade Organization to the Isle of Man and that the Agreement on trade-related aspects of intellectual property rights will be implemented in respect of the Isle of Man;

Whereas the provisions guaranteeing protection of topographies in the Isle of Man for persons from the Community are still in force there;

Whereas protection should continue to be extended under Directive 87/54/EEC to the Isle of Man, with effect from 1 January 1996, until such time as the Isle of Man is bound by the provisions of the Agreement on trade-related aspects of intellectual property rights following the extension of the Agreement establishing the World Trade Organization to the Isle of Man,

HAS ADOPTED THIS DECISION:

#### Article 1

Member States shall extend the right to legal protection under Directive 87/54/EEC as follows:

(a) natural persons who are nationals of the Isle of Man or who have their habitual residence in the territory of the Isle of Man shall be treated in the same way as nationals of a Member State;

(b) companies or other legal persons from the Isle of Man which have a real and effective industrial or commercial establishment there shall be treated as if they had a real and effective industrial or commercial establishment in the territory of a Member State.

## Article 2

This Decision shall apply from 1 January 1996.

Member States shall extend the right to protection under this Decision to the persons referred to in Article 1 until such time as the Isle of Man is bound by the provisions of the Agreement on trade-related aspects of intellectual property rights following the extension of the Agreement establishing the World Trade Organization to the Isle of Man.

Any exclusive rights acquired under Decisions 87/532/EEC, 90/511/EEC, 94/828/EC or under this Decision shall continue to produce their effects for the period laid down under Directive 87/54/EEC.

## Article 3

This Decision is addressed to the Member States.

Done at Brussels, 11 November 1996.

For the Council

The President

R. QUINN

(1) OJ No L 24, 27. 1. 1987, p. 36.

(2) Council Decision 87/532/EEC of 26 October 1987 on the extension of legal protection of topographies of semiconductor products in respect of persons from certain countries and territories (OJ No L 313, 4. 11. 1987, p. 22); Council Decision 90/511/EEC of 9 October 1990 on the extension of the legal protection of topographies of semiconductor products to persons from certain countries and territories (OJ No L 285, 17. 10. 1990, p. 31); Council Decision 93/16/EEC of 21 December 1992 on the extension of the legal protection of topographies of semiconductor products to persons from the United States of America and certain territories (OJ No L 11, 19. 1. 1993, p. 20), as amended by Decision 93/520/EEC (OJ No L 246, 2. 10. 1993, p. 31); Council Decision 94/828/EC of 19 December 1994 on the extension of the legal

protection of topographies of semiconductor products to persons from certain territories (OJ No L 351, 31. 12. 1994, p. 12).

(3) Design Right (Semiconductor Topographies) Order of 14 December 1993 and Design Right (Semiconductor Topographies) Regulations of 18 January 1994.

## Chapter V. Office for Harmonization in the Internal Market

### 5.1. Regulations

#### 5.1.1. Council Regulation (EC) on the Community trade mark (codified version) Text with EEA relevance No 207/2009<sup>17</sup>

of 26 February 2009

(codified version)(Text with EEA relevance)

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Parliament [1],

Whereas:

Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [2] has been substantially amended several times [3]. In the interests of clarity and rationality the said Regulation should be codified.

---

<sup>17</sup> *Official Journal L 078*, 24/03/2009 P. 0001 - 0042

It is desirable to promote throughout the Community a harmonious development of economic activities and a continuous and balanced expansion by completing an internal 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 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.

For the purpose of pursuing the Community's said objectives it would appear necessary to provide for Community arrangements for trade marks whereby undertakings can by means of one procedural system obtain Community trade marks to which uniform protection is given and which produce their effects throughout the entire area of the Community. The principle of the unitary character of the Community trade mark thus stated should apply unless otherwise provided for in this Regulation.

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 order to open up unrestricted economic activity in the whole of the internal market for the benefit of undertakings, trade marks should be created which are governed by a uniform Community law directly applicable in all Member States.

Since the Treaty has not provided the specific powers to establish such a legal instrument, Article 308 of the Treaty should be applied.

The Community law relating to trade marks nevertheless does not replace the laws of the Member States on trade marks. It would not in fact appear to be justified to require undertakings to apply for registration of their trade marks as Community trade marks. National trade marks continue to be necessary for those undertakings which do not want protection of their trade marks at Community level.

The rights in a Community trade mark should not be obtained otherwise than by registration, and registration should be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights.

The protection afforded by a Community trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in cases of similarity between the mark and the sign and the goods or services. An interpretation should be given of the concept of similarity in relation to the likelihood of confusion. 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, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection.

It follows from the principle of free movement of goods that the proprietor of a Community trade mark 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, under the trade mark, by him or with his consent, save where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods.

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 undertakings whose goods or services are designated by it. Accordingly, it should be capable of being transferred, subject to the overriding need to prevent the public being misled as a result of the transfer. It should also be capable of being charged as security in favour of a third party and of being the subject matter of licences.

Administrative measures are necessary at Community level for implementing in relation to every trade mark the trade mark law created by this Regulation. It is therefore essential, while retaining the Community's existing institutional structure and balance of powers, to provide for an Office for Harmonisation in the Internal Market (trade marks and designs) which is independent in relation to technical matters and has legal, administrative and financial autonomy. To this end it is necessary and appropriate that that Office should be a body of the Community having legal personality and exercising the implementing powers which are conferred on it by this Regulation, and that it should operate within the framework of Community law without detracting from the competencies exercised by the Community institutions.

It is necessary to ensure that parties who are affected by decisions made by the Office are protected by the law in a manner which is suited to the special character of trade mark law. To that end provision is made for an appeal to lie from decisions of the examiners and of the various divisions of the Office. If the department whose decision is contested does not rectify its decision it is to remit the appeal to a Board of Appeal of the Office, which is to decide on it. Decisions of the Boards of Appeal are, in turn, amenable to actions before the Court of Justice of the European Communities, which has jurisdiction to annul or to alter the contested decision.

Under the first subparagraph of Article 225(1) of the EC Treaty the Court of First Instance of the European Communities has jurisdiction to hear and determine at first instance the actions referred to in particular in Article 230 of the EC Treaty with the exception of those assigned to a judicial panel and those reserved in the Statute to the Court of Justice. The jurisdiction which this Regulation confers on the Court of Justice to cancel and alter decisions of the Boards of Appeal should accordingly be exercised at first instance by the Court.

In order to strengthen the protection of Community trade marks the Member States should designate, having regard to their own national system, as limited a number as possible of national courts of first and second instance having jurisdiction in matters of infringement and validity of Community trade marks.

Decisions regarding the validity and infringement of Community trade marks must have effect and cover the entire area of the Community, as 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 provisions of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters [4] should apply to all actions at law relating to Community trade marks, save where this Regulation derogates from those rules.

Contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of a Community trade mark and parallel national trade marks. For this purpose, when the actions are brought in the same Member State, the way in which this is to be achieved is a matter for national procedural rules, which are not prejudiced by this Regulation, whilst when the actions are brought in different Member States, provisions modelled on the rules on *lis pendens* and related actions of Regulation (EC) No 44/2001 appear appropriate.

In order to guarantee the full autonomy and independence of the Office, it is considered necessary to grant it an autonomous budget whose revenue comes principally from fees paid by the users of the system. However, the Community budgetary procedure remains applicable as far as any subsidies chargeable to the general budget of the European Communities are concerned. Moreover, the auditing of accounts should be undertaken by the Court of Auditors. Measures necessary for the implementation of this Regulation should be adopted, particularly as regards fees regulations and an Implementing Regulation, in accordance with Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission [5],

HAS ADOPTED THIS REGULATION:

## TITLE I

### GENERAL PROVISIONS

#### Article 1

##### Community trade mark

A trade mark for goods or services which is registered in accordance with the conditions contained in this Regulation and in the manner herein provided is hereinafter referred to as a "Community trade mark".

A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle shall apply unless otherwise provided in this Regulation.

#### Article 2

##### Office

An Office for Harmonisation in the Internal Market (trade marks and designs), hereinafter referred to as "the Office", is hereby established.

#### Article 3

##### Capacity to act

For the purpose of implementing this Regulation, companies or firms and other legal bodies shall be regarded as legal persons if, under the terms of the law governing them, they have the

capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued.

## TITLE II

### THE LAW RELATING TO TRADE MARKS

#### SECTION 1

Definition of a Community trade mark and obtaining a Community trade mark

##### Article 4

Signs of which a Community trade mark may consist

A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

##### Article 5

Persons who can be proprietors of Community trade marks

Any natural or legal person, including authorities established under public law, may be the proprietor of a Community trade mark.

##### Article 6

Means whereby a Community trade mark is obtained

A Community trade mark shall be obtained by registration.

##### Article 7

Absolute grounds for refusal

The following shall not be registered:

signs which do not conform to the requirements of Article 4;

trade marks which are devoid of any distinctive character;

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

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

signs which consist exclusively of:

the shape which results from the nature of the goods themselves;

the shape of goods which is necessary to obtain a technical result;

the shape which gives substantial value to the goods;

trade marks which are contrary to public policy or to accepted principles of morality;

trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the "Paris Convention";

trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the competent authority to their registration has been given;

trade marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin;

trade marks which contain or consist of a designation of origin or a geographical indication registered in accordance with Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs [6] when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication.

Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

## Article 8

### Relative grounds for refusal

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

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

if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

For the purposes of paragraph 1, "earlier trade marks" means:

trade marks of the following kinds with a date of application for registration which is earlier than 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:

Community trade marks;

trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;

trade marks registered under international arrangements which have effect in a Member State;

trade marks registered under international arrangements which have effect in the Community;

applications for the trade marks referred to in subparagraph (a), subject to their registration;

trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words "well known" are used in Article 6bis of the Paris Convention.

Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

## SECTION 2

Effects of Community trade marks

### Article 9

Rights conferred by a Community trade mark

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

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

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

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 latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.

The following, inter alia, may be prohibited under paragraph 1:

affixing the sign to the goods or to the packaging thereof;  
offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;  
importing or exporting the goods under that sign;  
using the sign on business papers and in advertising.

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 acts occurring after the date of publication of a Community trade mark application, which acts would, after publication of the registration of the trade mark, be prohibited by virtue of that publication. The court seized of the case may not decide upon the merits of the case until the registration has been published.

#### Article 10

##### Reproduction of Community trade marks in dictionaries

If the reproduction of a Community trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the Community trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark.

#### Article 11

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

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

#### Article 12

##### Limitation of the effects of a Community trade mark

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

his own name or address;

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;

the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided he uses them in accordance with honest practices in industrial or commercial matters.

#### Article 13

##### Exhaustion of the rights conferred by a Community trade mark

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

Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

#### Article 14

##### Complementary application of national law relating to infringement

The effects of Community trade marks shall be governed solely by the provisions of this Regulation. In other respects, infringement of a Community trade mark shall be governed by the national law relating to infringement of a national trade mark in accordance with the provisions of Title X.

This Regulation shall not prevent actions concerning a Community trade mark being brought under the law of Member States relating in particular to civil liability and unfair competition.

The rules of procedure to be applied shall be determined in accordance with the provisions of Title X.

### SECTION 3

#### Use of Community trade marks

#### Article 15

##### Use of Community trade marks

If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or

services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first subparagraph:

use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes.

Use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

## SECTION 4

Community trade marks as objects of property

### Article 16

Dealing with Community trade marks as national trade marks

Unless Articles 17 to 24 provide otherwise, a Community trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national trade mark registered in the Member State in which, according to the Register of Community trade marks:

the proprietor has his seat or his domicile on the relevant date;

where point (a) does not apply, the proprietor has an establishment on the relevant date.

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 seat of the Office is situated.

If two or more persons are mentioned in the Register of Community trade marks as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply.

### Article 17

Transfer

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.

A transfer of the whole of the undertaking shall include the transfer of the Community trade mark except where, in accordance with the law governing the transfer, there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

Without prejudice to paragraph 2, an assignment of the Community trade mark shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

Where it is clear from the transfer documents that because of the transfer the Community trade mark is likely to 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 unless the successor agrees to limit registration of the Community trade mark to goods or services in respect of which it is not likely to mislead.

On request of one of the parties a transfer shall be entered in the Register and published.

As long as the transfer has not been entered in the Register, the successor in title may not invoke the rights arising from the registration of the Community trade mark.

Where there are time limits to be observed vis-à-vis the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office.

All documents which require notification to the proprietor of the Community trade mark in accordance with Article 79 shall be addressed to the person registered as proprietor.

#### Article 18

Transfer of a trade mark registered in the name of an agent

Where a Community trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment in his favour of the said registration, unless such agent or representative justifies his action.

#### Article 19

Rights in rem

A Community trade mark may, independently of the undertaking, be given as security or be the subject of rights in rem.

On request of one of the parties, rights mentioned in paragraph 1 shall be entered in the Register and published.

## Article 20

### Levy of execution

A Community trade mark may be levied in execution.

As regards the procedure for levy of execution in respect of a Community trade mark, the courts and authorities of the Member States determined in accordance with Article 16 shall have exclusive jurisdiction.

On request of one the parties, levy of execution shall be entered in the Register and published.

## Article 21

### Insolvency proceedings

The only insolvency proceedings in which a Community trade mark may be involved are those opened in the Member State in the territory of which the debtor has his centre of main interests.

However, where the debtor is an insurance undertaking or a credit institution as defined in Directive 2001/17/EC of the European Parliament and of the Council of 19 March 2001 on the reorganisation and winding-up of insurance undertakings [7] and Directive 2001/24/EC of the European Parliament and of the Council of 4 April 2001 on the reorganisation and winding up of credit institutions [8], respectively, the only insolvency proceedings in which a Community trademark may be involved are those opened in the Member State where that undertaking or institution has been authorised.

In the case of joint proprietorship of a Community trade mark, paragraph 1 shall apply to the share of the joint proprietor.

Where a Community trade mark is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the Register and published in the Community Trade Marks Bulletin referred to in Article 89.

## Article 22

### Licensing

A Community trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Community. A licence may be exclusive or non-exclusive.

The proprietor of a Community trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to:

its duration;

the form covered by the registration in which the trade mark may be used;

the scope of the goods or services for which the licence is granted;

the territory in which the trade mark may be affixed; or

the quality of the goods manufactured or of the services provided by the licensee.

Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community trade mark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

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

On request of one of the parties the grant or transfer of a licence in respect of a Community trade mark shall be entered in the Register and published.

## Article 23

### Effects vis-à-vis third parties

Legal acts referred to in Articles 17, 19 and 22 concerning a Community trade mark shall have effects vis-à-vis third parties in all the Member States only after entry in the Register. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired.

Paragraph 1 shall not apply in the case of a person who acquires the Community trade mark or a right concerning the Community trade mark by way of transfer of the whole of the undertaking or by any other universal succession.

The effects vis-à-vis third parties of the legal acts referred to in Article 20 shall be governed by the law of the Member State determined in accordance with Article 16.

Until such time as common rules for the Member States in the field of bankruptcy enter into force, the effects vis-à-vis third parties of bankruptcy or like proceedings shall be governed by

the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.

#### Article 24

The application for a Community trade mark as an object of property

Articles 16 to 23 shall apply to applications for Community trade marks.

### TITLE III

#### APPLICATION FOR COMMUNITY TRADE MARKS

##### SECTION 1

Filing of applications and the conditions which govern them

#### Article 25

Filing of applications

An application for a Community trade mark shall be filed, at the choice of the applicant:

at the Office;

at the central industrial property office of a Member State or at the Benelux Office for Intellectual Property. An application filed in this way shall have the same effect as if it had been filed on the same date at the Office.

Where the application is filed at the central industrial property office of a Member State or at the Benelux Office for Intellectual Property, that office shall take all steps to forward the application to the Office within two weeks after filing. It may charge the applicant a fee which shall not exceed the administrative costs of receiving and forwarding the application.

Applications referred to in paragraph 2 which reach the Office more than two months after filing shall be deemed to have been filed on the date on which the application reached the Office.

Ten years after the entry into force of Regulation (EC) No 40/94, the Commission shall draw up a report on the operation of the system of filing applications for Community trade marks, together with any proposals for modifying this system.

#### Article 26

Conditions with which applications must comply

An application for a Community trade mark shall contain:

a request for the registration of a Community trade mark;

information identifying the applicant;

a list of the goods or services in respect of which the registration is requested;

a representation of the trade mark.

The application for a Community trade mark shall be subject to the payment of the application fee and, when appropriate, of one or more class fees.

An application for a Community trade mark must comply with the conditions laid down in the Implementing Regulation referred to in Article 162(1), hereinafter referred to as the "Implementing Regulation".

#### Article 27

##### Date of filing

The date of filing of a Community trade mark application shall be the date on which documents containing the information specified in Article 26(1) are filed with the Office by the applicant or, if the application has been filed with the central office of a Member State or with the Benelux Office for Intellectual Property, with that office, subject to payment of the application fee within a period of one month of filing the abovementioned documents.

#### Article 28

##### Classification

Goods and services in respect of which Community trade marks are applied for shall be classified in conformity with the system of classification specified in the Implementing Regulation.

## SECTION 2

##### Priority

#### Article 29

##### Right of priority

A person who has duly filed an application for a trade mark in or in respect of any State party to the Paris Convention or to the Agreement establishing the World Trade Organisation, or his successors in title, shall enjoy, 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 or contained within those for which the application has been filed, a right of priority during a period of six months from the date of filing of the first application.

Every filing that 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.

By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

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 in respect of the same State shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

If the first filing has been made in a State which is not a party to the Paris Convention or to the Agreement establishing the World Trade Organisation, paragraphs 1 to 4 shall apply only in so far as that State, according to published findings, grants, on the basis of the first filing made at the Office and subject to conditions equivalent to those laid down in this Regulation, a right of priority having equivalent effect.

## Article 30

### Claiming priority

An applicant desiring to take advantage of the priority of a previous application shall file a declaration of priority and a copy of the previous application. If the language of the latter is not one of the languages of the Office, the applicant shall file a translation of the previous application in one of those languages.

## Article 31

### Effect of priority right

The right of priority shall have the effect that the date of priority shall count as the date of filing of the Community trade mark application for the purposes of establishing which rights take precedence.

## Article 32

### Equivalence of Community filing with national filing

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, where appropriate with the priority claimed for the Community trade mark application.

### SECTION 3

Exhibition priority

Article 33

Exhibition priority

If an applicant for a Community trade mark has displayed goods or services under the mark applied for, at an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972, he may, if he files the application within a period of six months from the date of the first display of the goods or services under the mark applied for, claim a right of priority from that date within the meaning of Article 31.

An applicant who wishes to claim priority pursuant to paragraph 1 must file evidence of the display of goods or services under the mark applied for under the conditions laid down in the Implementing Regulation.

An exhibition priority granted in a Member State or in a third country does not extend the period of priority laid down in Article 29.

### SECTION 4

Claiming the seniority of a national trade mark

Article 34

Claiming the seniority of a national trade mark

The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, who applies for an identical trade mark for registration as a Community trade mark for goods or services which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the Community trade mark the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

Seniority shall have the sole effect under this Regulation that, where the proprietor of the Community trade mark surrenders the earlier trade mark or allows it to lapse, he shall be

deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.

The seniority claimed for the Community trade mark shall lapse if the earlier trade mark the seniority of which is claimed is declared to have been revoked or to be invalid or if it is surrendered prior to the registration of the Community trade mark.

#### Article 35

Claiming seniority after registration of the Community trade mark

The proprietor of a Community trade mark who is the proprietor of an earlier identical trade mark registered in a Member State, including a trade mark registered in the Benelux countries or of an earlier identical trade mark, with an international registration effective in a Member State, for goods or services which are identical to those for which the earlier trade mark has been registered, or contained within them, may claim the seniority of the earlier trade mark in respect of the Member State in or for which it was registered.

Article 34(2) and (3) shall apply.

### TITLE IV

## REGISTRATION PROCEDURE

### SECTION 1

Examination of applications

#### Article 36

Examination of the conditions of filing

The Office shall examine whether:

the Community trade mark application satisfies the requirements for the accordance of a date of filing in accordance with Article 27;

the Community trade mark application complies with the conditions laid down in this Regulation and with the conditions laid down in the Implementing Regulation;

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

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

If the deficiencies or the default on payment established pursuant to paragraph 1(a) are not remedied within this period, the application shall not be dealt with as a Community trade

mark application. If the applicant complies with the Office's request, the Office shall accord as the date of filing of the application the date on which the deficiencies or the default on payment established are remedied.

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

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

Failure to satisfy the requirements concerning the claim to priority shall result in loss of the right of priority for the application.

Failure to satisfy the requirements concerning the claiming of seniority of a national trade mark shall result in loss of that right for the application.

#### Article 37

##### Examination as to absolute grounds for refusal

Where, under Article 7, a trade mark is ineligible for registration in respect of some or all of the goods or services covered by the Community trade mark application, the application shall be refused as regards those goods or services.

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

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

## SECTION 2

### Search

#### Article 38

### Search

Once the Office has accorded a date of filing, it shall draw up a Community search report citing those earlier Community trade marks or Community trade mark applications discovered

which may be invoked under Article 8 against the registration of the Community trade mark applied for.

Where, at the time of filing a Community trade mark application, the applicant requests that a search report also be prepared by the central industrial property offices of the Member States and where the appropriate search fee has been paid within the time limit for the payment of the filing fee, the Office shall, as soon as a Community trade mark application has been accorded a date of filing, transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks in respect of Community trade mark applications.

Each of the central industrial property offices referred to in paragraph 2 shall communicate to the Office within two months as from the date on which it received the Community trade mark application a search report which shall either cite those earlier national trade marks or trade mark applications discovered which may be invoked under Article 8 against the registration of the Community trade mark applied for, or state that the search has revealed no such rights.

The search reports referred to in paragraph 3 shall be prepared on a standard form drawn up by the Office, after consulting the Administrative Board provided for in Article 126(1), hereinafter referred to as "the Administrative Board". The essential contents of this form shall be set out in the Implementing Regulation.

An amount shall be paid by the Office to each central industrial property office for each search report provided by that office in accordance with paragraph 3. The amount, which shall be the same for each office, shall be fixed by the Budget Committee by means of a decision adopted by a majority of three-quarters of the representatives of the Member States.

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

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

### SECTION 3

Publication of the application

Article 39

Publication of the application

If the conditions which the application for a Community trade mark must satisfy have been fulfilled and if the period referred to in Article 38(7) has expired, the application shall be published to the extent that it has not been refused pursuant to Article 37.

Where, after publication, the application is refused under Article 37, the decision that it has been refused shall be published upon becoming final.

SECTION 4

Observations by third parties and opposition

Article 40

Observations by third parties

Following the publication of the Community trade mark application, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds under Article 7, in particular, the trade mark shall not be registered ex officio. They shall not be parties to the proceedings before the Office.

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

Article 41

Opposition

Within a period of three months following the publication of a Community trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8:

by the proprietors of earlier trade marks referred to in Article 8(2) as well as licensees authorised by the proprietors of those trade marks, in respect of Article 8(1) and (5);

by the proprietors of trade marks referred to in Article 8(3);

by the proprietors of earlier marks or signs referred to in Article 8(4) and by persons authorised under the relevant national law to exercise these rights.

Notice of opposition to registration of the trade mark may also be given, subject to the conditions laid down in paragraph 1, in the event of the publication of an amended application in accordance with the second sentence of Article 43(2).

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

## Article 42

### Examination of opposition

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

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

Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

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

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

The decision refusing the application shall be published upon becoming final.

## SECTION 5

### Withdrawal, restriction, amendment and division of the application

#### Article 43

##### Withdrawal, restriction and amendment of the application

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

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

#### Article 44

##### Division of the application

The applicant may divide the application by declaring that some of the goods or services included in the original application will be the subject of one or more divisional applications. The goods or services in the divisional application shall not overlap with the goods or services which remain in the original application or those which are included in other divisional applications.

The declaration of division shall not be admissible:

if, where an opposition has been entered against the original application, such a divisional application has the effect of introducing a division amongst the goods or services against which the opposition has been directed, until the decision of the Opposition Division has become final or the opposition proceedings are finally terminated otherwise;

during the periods laid down in the Implementing Regulation.

The declaration of division must comply with the provisions set out in the Implementing Regulation.

The declaration of division shall be subject to a fee. The declaration shall be deemed not to have been made until the fee has been paid.

The division shall take effect on the date on which it is recorded in the files kept by the Office concerning the original application.

All requests and applications submitted and all fees paid with regard to the original application prior to the date on which the Office receives the declaration of division are deemed also to have been submitted or paid with regard to the divisional application or applications. The fees for the original application which have been duly paid prior to the date on which the declaration of division is received shall not be refunded.

The divisional application shall preserve the filing date and any priority date and seniority date of the original application.

## SECTION 6

### Registration

#### Article 45

### Registration

Where an application meets the requirements of this Regulation and where no notice of opposition has been given within the period referred to in Article 41(1) or where opposition has been rejected by a definitive decision, the trade mark shall be registered as a Community trade mark, provided that the registration fee has been paid within the period prescribed. If the fee is not paid within this period the application shall be deemed to be withdrawn.

## TITLE V

### DURATION, RENEWAL, ALTERATION AND DIVISION OF COMMUNITY TRADE MARKS

#### Article 46

### Duration of registration

Community trade marks shall be registered for a period of 10 years from the date of filing of the application. Registration may be renewed in accordance with Article 47 for further periods of 10 years.

#### Article 47

### Renewal

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

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

The request for renewal shall be submitted within a period of six months ending on the last day of the month in which protection ends. The fees shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the day referred to in the first sentence, provided that an additional fee is paid within this further period.

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

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

#### Article 48

##### Alteration

The Community trade mark shall not be altered in the Register during the period of registration or on renewal thereof.

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

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

#### Article 49

##### Division of the registration

The proprietor of the Community trade mark may divide the registration by declaring that some of the goods or services included in the original registration will be the subject of one or more divisional registrations. The goods or services in the divisional registration shall not overlap with the goods or services which remain in the original registration or those which are included in other divisional registrations.

The declaration of division shall not be admissible:

if, where an application for revocation of rights or for a declaration of invalidity has been entered at the Office against the original registration, such a divisional declaration has the effect of introducing a division amongst the goods or services against which the application for revocation of rights or for a declaration of invalidity is directed, until the decision of the Cancellation Division has become final or the proceedings are finally terminated otherwise;

if, where a counterclaim for revocation or for a declaration of invalidity has been entered in a case before a Community trade mark court, such a divisional declaration has the effect of introducing a division amongst the goods or services against which the counterclaim is directed, until the mention of the Community trade mark court's judgment is recorded in the Register pursuant to Article 100(6).

The declaration of division must comply with the provisions set out in the Implementing Regulation.

The declaration of division shall be subject to a fee. The declaration shall be deemed not to have been made until the fee has been paid.

The division shall take effect on the date on which it is entered in the Register.

All requests and applications submitted and all fees paid with regard to the original registration prior to the date on which the Office receives the declaration of division shall be deemed also to have been submitted or paid with regard to the divisional registration or registrations. The fees for the original registration which have been duly paid prior to the date on which the declaration of division is received shall not be refunded.

The divisional registration shall preserve the filing date and any priority date and seniority date of the original registration.

## TITLE VI

### SURRENDER, REVOCATION AND INVALIDITY

#### SECTION 1

##### Surrender

##### Article 50

##### Surrender

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

The surrender shall be declared to the Office in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register.

Surrender shall be entered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender shall be entered in the Register only if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of the period prescribed by the Implementing Regulation.

## SECTION 2

Grounds for revocation

### Article 51

Grounds for revocation

The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:

if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, 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 or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;

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

if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

## SECTION 3

### Grounds for invalidity

#### Article 52

##### Absolute grounds for invalidity

A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

where the Community trade mark has been registered contrary to the provisions of Article 7;

where the applicant was acting in bad faith when he filed the application for the trade mark.

Where the Community trade mark has been registered in breach of the provisions of Article 7(1)(b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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

#### Article 53

##### Relative grounds for invalidity

A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled;

where there is a trade mark as referred to in Article 8(3) and the conditions set out in that paragraph are fulfilled;

where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled.

A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the Community legislation or national law governing its protection, and in particular:

a right to a name;

a right of personal portrayal;

a copyright;

an industrial property right.

A Community trade mark may not be declared invalid where the proprietor of a right referred to in paragraphs 1 or 2 consents expressly to the registration of the Community trade mark before submission of the application for a declaration of invalidity or the counterclaim.

Where the proprietor of one of the rights referred to in paragraphs 1 or 2 has previously applied for a declaration that a Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the said rights which he could have invoked in support of his first application or counterclaim.

Article 52(3) shall apply.

Article 54

Limitation in consequence of acquiescence

Where the proprietor of a Community trade mark has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Community while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.

Where the proprietor of an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.

In the cases referred to in paragraphs 1 and 2, the proprietor of a later Community trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later Community trade mark.

SECTION 4

Consequences of revocation and invalidity

## Article 55

### Consequences of revocation and invalidity

The Community trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

The Community trade mark shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that the trade mark has been declared invalid.

Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the proprietor of the trade mark, or to unjust enrichment, the retroactive effect of revocation or invalidity of the trade mark shall not affect:

any decision on infringement which has acquired the authority of a final decision and been enforced prior to the revocation or invalidity decision;

any contract concluded prior to the revocation or invalidity decision, in so far as it has been performed before that decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract, may be claimed on grounds of equity.

## SECTION 5

### Proceedings in the Office in relation to revocation or invalidity

## Article 56

### Application for revocation or for a declaration of invalidity

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:

where Articles 51 and 52 apply, by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, which under the terms of the law governing it has the capacity in its own name to sue and be sued;

where Article 53(1) applies, by the persons referred to in Article 41(1);

where Article 53(2) applies, by the owners of the earlier rights referred to in that provision or by the persons who are entitled under the law of the Member State concerned to exercise the rights in question.

The application shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the fee has been paid.

An application for revocation or for a declaration of invalidity shall be inadmissible 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 and has acquired the authority of a final decision.

#### Article 57

##### Examination of the application

On the examination of the application for revocation of rights or for a declaration of invalidity, the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.

If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 42(2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

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

If the examination of the application for revocation of rights or for a declaration of invalidity reveals that the trade mark should not have been registered in respect of some or all of the goods or services for which it is registered, the rights of the proprietor of the Community trade mark shall be revoked or it shall be declared invalid in respect of those goods or services. Otherwise the application for revocation of rights or for a declaration of invalidity shall be rejected.

A record of the Office's decision on the application for revocation of rights or for a declaration of invalidity shall be entered in the Register once it has become final.

## TITLE VII

### APPEALS

#### Article 58

##### Decisions subject to appeal

An appeal shall lie from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Divisions and Cancellation Divisions. It shall have suspensive effect.

A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

#### Article 59

##### Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right.

#### Article 60

##### Time limit and form of appeal

Notice of appeal must be filed in writing at the Office within two months after the date of notification of the decision appealed from. The notice shall be deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

#### Article 61

#### Revision of decisions in ex parte cases

If the party which has lodged the appeal is the sole party to the procedure, and if the department whose decision is contested considers the appeal to be admissible and well founded, the department shall rectify its decision.

If the decision is not rectified within one month after receipt of the statement of grounds, the appeal shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

#### Article 62

##### Revision of decisions in inter partes cases

Where the party which has lodged the appeal is opposed by another party and if the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision.

The decision may be rectified only if the department whose decision is contested notifies the other party of its intention to rectify it, and that party accepts it within two months of the date on which it received the notification.

If, within two months of receiving the notification referred to in paragraph 2, the other party does not accept that the contested decision is to be rectified and makes a declaration to that effect or does not make any declaration within the period laid down, the appeal shall be remitted to the Board of Appeal without delay, and without comment as to its merit.

However, if the department whose decision is contested does not consider the appeal to be admissible and well founded within one month after receipt of the statement of grounds, it shall, instead of taking the measures provided for in paragraphs 2 and 3, remit the appeal to the Board of Appeal without delay, and without comment as to its merit.

#### Article 63

##### Examination of appeals

If the appeal is admissible, the Board of Appeal shall examine whether the appeal is allowable.

In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

#### Article 64

## Decisions in respect of appeals

Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same.

The decisions of the Boards of Appeal shall take effect only as from the date of expiration of the period referred to in Article 65(5) or, if an action has been brought before the Court of Justice within that period, as from the date of dismissal of such action.

## Article 65

### Actions before the Court of Justice

Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals.

The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.

The Court of Justice has jurisdiction to annul or to alter the contested decision.

The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision.

The action shall be brought before the Court of Justice within two months of the date of notification of the decision of the Board of Appeal.

The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice.

## TITLE VIII

### COMMUNITY COLLECTIVE MARKS

#### Article 66

##### Community collective marks

A Community collective mark shall be a Community trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the

members of the association which is the proprietor of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for Community collective marks.

In derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute Community collective marks within the meaning of paragraph 1. A collective mark shall 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.

The provisions of this Regulation shall apply to Community collective marks, unless Articles 67 to 74 provide otherwise.

#### Article 67

##### Regulations governing use of the mark

An applicant for a Community collective mark must submit regulations governing its use within the period prescribed.

The regulations governing use shall specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including sanctions. The regulations governing use of a mark referred to in Article 66(2) must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark.

#### Article 68

##### Refusal of the application

In addition to the grounds for refusal of a Community trade mark application provided for in Articles 36 and 37, an application for a Community collective mark shall be refused where the provisions of Articles 66 or 67 are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

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

An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

#### Article 69

##### Observations by third parties

Apart from the cases mentioned in Article 40, any person, group or body referred to in that Article may submit to the Office written observations based on the particular grounds on which the application for a Community collective mark should be refused under the terms of Article 68.

#### Article 70

##### Use of marks

Use of a Community collective mark by any person who has authority to use it shall satisfy the requirements of this Regulation, provided that the other conditions which this Regulation imposes with regard to the use of Community trade marks are fulfilled.

#### Article 71

##### Amendment of the regulations governing use of the mark

The proprietor of a Community collective mark must submit to the Office any amended regulations governing use.

The amendment shall not be mentioned in the Register if the amended regulations do not satisfy the requirements of Article 67 or involve one of the grounds for refusal referred to in Article 68.

Article 69 shall apply to amended regulations governing use.

For the purposes of applying this Regulation, amendments to the regulations governing use shall take effect only from the date of entry of the mention of the amendment in the Register.

#### Article 72

##### Persons who are entitled to bring an action for infringement

The provisions of Article 22(3) and (4) concerning the rights of licensees shall apply to every person who has authority to use a Community collective mark.

The proprietor of a Community collective mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorised use of the mark.

## Article 73

### Grounds for revocation

Apart from the grounds for revocation provided for in Article 51, the rights of the proprietor of a Community collective mark shall be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings, if:

the proprietor does not take reasonable steps to prevent the mark being used in a manner incompatible with the conditions of use, where these exist, laid down in the regulations governing use, amendments to which have, where appropriate, been mentioned in the Register;

the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 68(2);

an amendment to the regulations governing use of the mark has been mentioned in the Register in breach of the provisions of Article 71(2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of those provisions.

## Article 74

### Grounds for invalidity

Apart from the grounds for invalidity provided for in Articles 52 and 53, a Community collective mark which is registered in breach of the provisions of Article 68 shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings, unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of those provisions.

## TITLE IX

### PROCEDURE

#### SECTION 1

##### General provisions

## Article 75

### Statement of reasons on which decisions are based

Decisions of the Office shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.

#### Article 76

##### 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; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

#### Article 77

##### Oral proceedings

If the Office considers that oral proceedings would be expedient they shall be held either at the instance of the Office or at the request of any party to the proceedings.

Oral proceedings before the examiners, the Opposition Division and the Administration of Trade Marks and Legal Division shall not be public.

Oral proceedings, including delivery of the decision, shall be public before the Cancellation Division and the Boards of Appeal, in so far as the department before which the proceedings are taking place does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings.

#### Article 78

##### Taking of evidence

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

hearing the parties;

requests for information;

the production of documents and items of evidence;

hearing witnesses;

opinions by experts;

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

The relevant department may commission one of its members to examine the evidence adduced.

If the Office considers it necessary for a party, witness or expert to give evidence orally, it shall issue a summons to the person concerned to appear before it.

The parties shall be informed of the hearing of a witness or expert before the Office. They shall have the right to be present and to put questions to the witness or expert.

#### Article 79

##### Notification

The Office shall, as a matter of course, notify those concerned of decisions and summonses and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Regulation or of the Implementing Regulation, or of which notification has been ordered by the President of the Office.

#### Article 80

##### Revocation of decisions

Where the Office has made an entry in the Register or taken a decision which contains an obvious procedural error attributable to the Office, it shall ensure that the entry is cancelled or the decision is revoked. Where there is only one party to the proceedings and the entry or the act affects its rights, cancellation or revocation shall be determined even if the error was not evident to the party.

Cancellation or revocation as referred to in paragraph 1 shall be determined, ex officio or at the request of one of the parties to the proceedings, by the department which made the entry or took the decision. Cancellation or revocation shall be determined within six months from the date on which the entry was made in the Register or the decision was taken, after consultation with the parties to the proceedings and any proprietor of rights to the Community trade mark in question that are entered in the Register.

This Article shall be without prejudice to the right of the parties to submit an appeal under Articles 58 and 65, or to the possibility, under the procedures and conditions laid down by the Implementing Regulation, of correcting any linguistic errors or errors of transcription and

obvious errors in the Office's decisions or errors attributable to the Office in registering the trade mark or in publishing its registration.

## Article 81

### Restitutio in integrum

The applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to comply with a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the obstacle to compliance has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any right or means of redress.

The application must be filed in writing within two months from the removal of the obstacle to compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided in Article 47(3), third sentence, shall be deducted from the period of one year.

The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until the fee for re-establishment of rights has been paid.

The department competent to decide on the omitted act shall decide upon the application.

This Article shall not be applicable to the time limits referred to in paragraph 2 of this Article, Article 41(1) and (3) and Article 82.

Where the applicant for or proprietor of a Community trade mark has his rights re-established, he may not invoke his rights vis-à-vis a third party who, in good faith, has put goods on the market or supplied services under a sign which is identical with, or similar to, the Community trade mark in the course of the period between the loss of rights in the application or in the Community trade mark and publication of the mention of re-establishment of those rights.

A third party who may avail himself of the provisions of paragraph 6 may bring third party proceedings against the decision re-establishing the rights of the applicant for or proprietor of a Community trade mark within a period of two months as from the date of publication of the mention of re-establishment of those rights.

Nothing in this Article shall limit the right of a Member State to grant restitutio in integrum in respect of time limits provided for in this Regulation and to be observed vis-à-vis the authorities of such State.

## Article 82

### Continuation of proceedings

An applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who has omitted to observe a time limit vis-à-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out. The request for continuation of proceedings shall be admissible only if it is presented within two months following the expiry of the unobserved time limit. The request shall not be deemed to have been filed until the fee for continuation of the proceedings has been paid.

This Article shall not be applicable to the time limits laid down in Article 25(3), Article 27, Article 29(1), Article 33(1), Article 36(2), Article 41, Article 42, Article 47(3), Article 60, Article 62, Article 65(5), Article 81, Article 112, or to the time limits laid down in this Article or the time limits laid down by the Implementing Regulation for claiming, after the application has been filed, priority within the meaning of Article 30, exhibition priority within the meaning of Article 33 or seniority within the meaning of Article 34.

The department competent to decide on the omitted act shall decide upon the application.

If the Office accepts the application, the consequences of having failed to observe the time limit shall be deemed not to have occurred.

If the Office rejects the application, the fee shall be refunded.

## Article 83

### Reference to general principles

In the absence of procedural provisions in this Regulation, the Implementing Regulation, the fees regulations or the rules of procedure of the Boards of Appeal, the Office shall take into account the principles of procedural law generally recognised in the Member States.

## Article 84

### Termination of financial obligations

Rights of the Office to the payment of a fee shall be extinguished after four years from the end of the calendar year in which the fee fell due.

Rights against the Office for the refunding of fees or sums of money paid in excess of a fee shall be extinguished after four years from the end of the calendar year in which the right arose.

The period laid down in paragraphs 1 and 2 shall be interrupted, in the case covered by paragraph 1, by a request for payment of the fee, and in the case covered by paragraph 2, by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at the latest six years after the end of the year in which it originally began, unless, in the meantime, judicial proceedings to enforce the right have begun; in this case the period shall end at the earliest one year after the judgment has acquired the authority of a final decision.

## SECTION 2

Costs

Article 85

Costs

The losing party in opposition proceedings, proceedings for revocation, proceedings for a declaration of invalidity or appeal proceedings shall bear the fees incurred by the other party as well as all costs, without prejudice to Article 119(6), incurred by him essential to the proceedings, including travel and subsistence and the remuneration of an agent, adviser or advocate, within the limits of the scales set for each category of costs under the conditions laid down in the Implementing Regulation.

However, where each party succeeds on some and fails on other heads, or if reasons of equity so dictate, the Opposition Division, Cancellation Division or Board of Appeal shall decide a different apportionment of costs.

The party who terminates the proceedings by withdrawing the Community trade mark application, the opposition, the application for revocation of rights, the application for a declaration of invalidity or the appeal, or by not renewing registration of the Community trade mark or by surrendering the Community trade mark, shall bear the fees and the costs incurred by the other party as stipulated in paragraphs 1 and 2.

Where a case does not proceed to judgment the costs shall be at the discretion of the Opposition Division, Cancellation Division or Board of Appeal.

Where the parties conclude before the Opposition Division, Cancellation Division or Board of Appeal a settlement of costs differing from that provided for in the preceding paragraphs, the department concerned shall take note of that agreement.

The Opposition Division or Cancellation Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs when the costs to be paid are limited to the fees paid to the Office and the representation costs. In all other cases, the registry of the Board of Appeal or a member of the staff of the Opposition Division or Cancellation Division shall fix the amount of the costs to be reimbursed on request. The request is admissible only within two months of the date on which the decision for which an application was made for the costs to be fixed became final. The amount so determined may be reviewed by a decision of the Opposition Division or Cancellation Division or Board of Appeal on a request filed within the prescribed period.

#### Article 86

##### Enforcement of decisions fixing the amount of costs

Any final decision of the Office fixing the amount of costs shall be enforceable.

Enforcement shall be governed by the rules of civil procedure in force in the State in the territory of which it is carried out. The order for its enforcement shall be appended to the decision, without other formality than verification of the authenticity of the decision, by the national authority which the Government of each Member State shall designate for this purpose and shall make known to the Office and to the Court of Justice.

When these formalities have been completed on application by the party concerned, the latter may proceed to enforcement in accordance with the national law, by bringing the matter directly before the competent authority.

Enforcement may be suspended only by a decision of the Court of Justice. However, the courts of the country concerned shall have jurisdiction over complaints that enforcement is being carried out in an irregular manner.

#### SECTION 3

Information which may be made available to the public and of the authorities of the Member States

#### Article 87

##### Register of Community trade marks

The Office shall keep a register to be known as the Register of Community trade marks, which shall contain those particulars the registration or inclusion of which is provided for by this Regulation or by the Implementing Regulation. The Register shall be open to public inspection.

## Article 88

### Inspection of files

The files relating to Community trade mark applications which have not yet been published shall not be made available for inspection without the consent of the applicant.

Any person who can prove that the applicant for a Community trade mark has stated that after the trade mark has been registered he will invoke the rights under it against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.

Subsequent to the publication of the Community trade mark application, the files relating to such application and the resulting trade mark may be inspected on request.

However, where the files are inspected pursuant to paragraphs 2 or 3, certain documents in the file may be withheld from inspection in accordance with the provisions of the Implementing Regulation.

## Article 89

### Periodical publications

The Office shall periodically publish:

a Community Trade Marks Bulletin containing entries made in the Register of Community trade marks as well as other particulars the publication of which is prescribed by this Regulation or by the Implementing Regulation;

an Official Journal containing notices and information of a general character issued by the President of the Office, as well as any other information relevant to this Regulation or its implementation.

## Article 90

### Administrative cooperation

Unless otherwise provided in this Regulation or in national laws, the Office and the courts or authorities of the Member States shall on request give assistance to each other by communicating information or opening files for inspection. Where the Office lays files open to inspection by courts, Public Prosecutors' Offices or central industrial property offices, the inspection shall not be subject to the restrictions laid down in Article 88.

## Article 91

### Exchange of publications

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

The Office may conclude agreements relating to the exchange or supply of publications.

## SECTION 4

### Representation

#### Article 92

##### General principles of representation

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

Without prejudice to paragraph 3, second sentence, natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be represented before the Office in accordance with Article 93(1) in all proceedings established by this Regulation, other than in filing an application for a Community trade mark; the Implementing Regulation may permit other exceptions.

Natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee. An employee of a legal person to which this paragraph applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community.

The Implementing Regulation shall specify whether and under what conditions an employee must file with the Office a signed authorisation for insertion on the file.

#### Article 93

##### Professional representatives

Representation of natural or legal persons before the Office may only be undertaken by:

any legal practitioner qualified in one of the Member States and having his place of business within the Community, to the extent that he is entitled, within the said State, to act as a representative in trade mark matters;

professional representatives whose names appear on the list maintained for this purpose by the Office. The Implementing Regulation shall specify whether and under what conditions the representatives before the Office must file with the Office a signed authorisation for insertion on the file.

Representatives acting before the Office must file with it a signed authorisation for insertion on the files, the details of which are set out in the Implementing Regulation.

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

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

he must have his place of business or employment in the Community;

he must be entitled to represent natural or legal persons in trade mark matters before the central industrial property office of a Member State. Where, in that State, the entitlement is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act in trade mark matters before the central industrial property office of the said State must have habitually so acted for at least five years. However, persons whose professional qualification to represent natural or legal persons in trade mark matters before the central industrial property office of one of the Member States is officially recognised in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession.

Entry shall be effected upon request, accompanied by a certificate furnished by the central industrial property office of the Member State concerned, which must indicate that the conditions laid down in paragraph 2 are fulfilled.

The President of the Office may grant exemption from:

the requirement of paragraph 2(c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way;

the requirement of paragraph 2(a) in special circumstances.

The conditions under which a person may be removed from the list of professional representatives shall be laid down in the Implementing Regulation.

## TITLE X

### JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO COMMUNITY TRADE MARKS

## SECTION 1

Application of Regulation (EC) No 44/2001

Article 94

Application of Regulation (EC) No 44/2001

Unless otherwise specified in this Regulation, Regulation (EC) No 44/2001 shall apply to proceedings relating to Community trade marks and applications for Community trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of Community trade marks and national trade marks.

In the case of proceedings in respect of the actions and claims referred to in Article 96:

Articles 2 and 4, points 1, 3, 4 and 5 of Article 5 and Article 31 of Regulation (EC) No 44/2001 shall not apply;

Articles 23 and 24 of Regulation (EC) No 44/2001 shall apply subject to the limitations in Article 97(4) of this Regulation;

the provisions of Chapter II of Regulation (EC) No 44/2001 which are applicable to persons domiciled in a Member State shall also be applicable to persons who do not have a domicile in any Member State but have an establishment therein.

## SECTION 2

Disputes concerning the infringement and validity of Community trade marks

Article 95

Community trade mark courts

The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as "Community trade mark courts", which shall perform the functions assigned to them by this Regulation.

Each Member State shall communicate to the Commission within three years of the entry into force of Regulation (EC) No 40/94 a list of Community trade mark courts indicating their names and their territorial jurisdiction.

Any change made after communication of the list referred to in paragraph 2 in the number, names or territorial jurisdiction of the courts shall be notified without delay by the Member State concerned to the Commission.

The information referred to in paragraphs 2 and 3 shall be notified by the Commission to the Member States and published in the Official Journal of the European Union.

As long as a Member State has not communicated the list as stipulated in paragraph 2, jurisdiction for any proceedings resulting from an action or application covered by Article 96, and for which the courts of that State have jurisdiction under Article 97, shall lie with that court of the State in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national trade mark registered in that State.

#### Article 96

##### Jurisdiction over infringement and validity

The Community trade mark courts shall have exclusive jurisdiction:

for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to Community trade marks;

for actions for declaration of non-infringement, if they are permitted under national law;

for all actions brought as a result of acts referred to in Article 9(3), second sentence;

for counterclaims for revocation or for a declaration of invalidity of the Community trade mark pursuant to Article 100.

#### Article 97

##### International jurisdiction

Subject to the provisions of this Regulation as well as to any provisions of Regulation (EC) No 44/2001 applicable by virtue of Article 94, proceedings in respect of the actions and claims referred to in Article 96 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

Notwithstanding the provisions of paragraphs 1, 2 and 3:

Article 23 of Regulation (EC) No 44/2001 shall apply if the parties agree that a different Community trade mark court shall have jurisdiction;

Article 24 of Regulation (EC) No 44/2001 shall apply if the defendant enters an appearance before a different Community trade mark court.

Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9(3), second sentence, has been committed.

## Article 98

### Extent of jurisdiction

A Community trade mark court whose jurisdiction is based on Article 97(1) to (4) shall have jurisdiction in respect of:

acts of infringement committed or threatened within the territory of any of the Member States;  
acts within the meaning of Article 9(3), second sentence, committed within the territory of any of the Member States.

A Community trade mark court whose jurisdiction is based on Article 97(5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

## Article 99

### Presumption of validity — Defence as to the merits

The Community trade mark courts shall treat the Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity.

The validity of a Community trade mark may not be put in issue in an action for a declaration of non-infringement.

In the actions referred to in Article 96(a) and (c) a plea relating to revocation or invalidity of the Community trade mark submitted otherwise than by way of a counterclaim shall be admissible in so far as the defendant claims that the rights of the proprietor of the Community trade mark could be revoked for lack of use or that the Community trade mark could be declared invalid on account of an earlier right of the defendant.

## Article 100

### Counterclaims

A counterclaim for revocation or for a declaration of invalidity may only be based on the grounds for revocation or invalidity mentioned in this Regulation.

A Community trade mark court shall reject a counterclaim for revocation or for a declaration of invalidity if a decision taken by the Office relating to the same subject matter and cause of action and involving the same parties has already become final.

If the counterclaim is brought in a legal action to which the proprietor of the trade mark is not already a party, he shall be informed thereof and may be joined as a party to the action in accordance with the conditions set out in national law.

The Community trade mark court with which a counterclaim for revocation or for a declaration of invalidity of the Community trade mark has been filed shall inform the Office of the date on which the counterclaim was filed. The latter shall record this fact in the Register of Community trade marks.

Article 57(2) to (5) shall apply.

Where a Community trade mark court has given a judgment which has become final on a counterclaim for revocation or for invalidity of a Community trade mark, a copy of the judgment shall be sent to the Office. Any party may request information about such transmission. The Office shall mention the judgment in the Register of Community trade marks in accordance with the provisions of the Implementing Regulation.

The Community trade mark court hearing a counterclaim for revocation or for a declaration of invalidity may stay the proceedings on application by the proprietor of the Community trade mark and after hearing the other parties and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office within a time limit which it shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 104(3) shall apply.

## Article 101

### Applicable law

The Community trade mark courts shall apply the provisions of this Regulation.

On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.

Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State in which the court is located.

## Article 102

### Sanctions

Where a Community trade mark court finds that the defendant has infringed or threatened to infringe a Community trade mark, it shall, unless there are special reasons for not doing so, issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark. It shall also take such measures in accordance with its national law as are aimed at ensuring that this prohibition is complied with.

In all other respects the Community trade mark court shall apply the law of the Member State in which the acts of infringement or threatened infringement were committed, including the private international law.

## Article 103

### Provisional and protective measures

Application may be made to the courts of a Member State, including Community trade mark courts, for such provisional, including protective, measures in respect of a Community trade mark or Community trade mark application as may be available under the law of that State in respect of a national trade mark, even if, under this Regulation, a Community trade mark court of another Member State has jurisdiction as to the substance of the matter.

A Community trade mark court whose jurisdiction is based on Article 97(1), (2), (3) or (4) shall have jurisdiction to grant provisional and protective measures which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of Regulation (EC) No 44/2001, are applicable in the territory of any Member State. No other court shall have such jurisdiction.

## Article 104

### Specific rules on related actions

A Community trade mark court hearing an action referred to in Article 96, other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue before another Community trade mark court on

account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office.

The Office, when hearing an application for revocation or for a declaration of invalidity shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue on account of a counterclaim before a Community trade mark court. However, if one of the parties to the proceedings before the Community trade mark court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

Where the Community trade mark court stays the proceedings it may order provisional and protective measures for the duration of the stay.

#### Article 105

##### Jurisdiction of Community trade mark courts of second instance — Further appeal

An appeal to the Community trade mark courts of second instance shall lie from judgments of the Community trade mark courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 96.

The conditions under which an appeal may be lodged with a Community trade mark court of second instance shall be determined by the national law of the Member State in which that court is located.

The national rules concerning further appeal shall be applicable in respect of judgments of Community trade mark courts of second instance.

#### SECTION 3

##### Other disputes concerning Community trade marks

#### Article 106

##### Supplementary provisions on the jurisdiction of national courts other than Community trade mark courts

Within the Member State whose courts have jurisdiction under Article 94(1) those courts shall have jurisdiction for actions other than those referred to in Article 96, which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to a national trade mark registered in that State.

Actions relating to a Community trade mark, other than those referred to in Article 96, for which no court has jurisdiction under Article 94(1) and paragraph 1 of this Article may be heard before the courts of the Member State in which the Office has its seat.

#### Article 107

##### Obligation of the national court

A national court which is dealing with an action relating to a Community trade mark, other than the action referred to in Article 96, shall treat the trade mark as valid.

#### SECTION 4

##### Transitional provision

#### Article 108

Transitional provision relating to the application of the Convention on Jurisdiction and Enforcement

The provisions of Regulation (EC) No 44/2001 which are rendered applicable by the preceding Articles shall have effect in respect of any Member State solely in the text of the Regulation which is in force in respect of that State at any given time.

#### TITLE XI

#### EFFECTS ON THE LAWS OF THE MEMBER STATES

#### SECTION 1

##### Civil actions on the basis of more than one trade mark

#### Article 109

Simultaneous and successive civil actions on the basis of Community trade marks and national trade marks

Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of a Community trade mark and the other seized on the basis of a national trade mark:

the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested;

the court other than the court first seized may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.

The court hearing an action for infringement on the basis of a Community trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical national trade mark valid for identical goods or services.

The court hearing an action for infringement on the basis of a national trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical Community trade mark valid for identical goods or services.

Paragraphs 1, 2 and 3 shall not apply in respect of provisional, including protective, measures.

## SECTION 2

Application of national laws for the purpose of prohibiting the use of Community trade marks

### Article 110

Prohibition of use of Community trade marks

This Regulation shall, unless otherwise provided for, not affect the right existing under the laws of the Member States to invoke claims for infringement of earlier rights within the meaning of Article 8 or Article 53(2) in relation to the use of a later Community trade mark. Claims for infringement of earlier rights within the meaning of Article 8(2) and (4) may, however, no longer be invoked if the proprietor of the earlier right may no longer apply for a declaration that the Community trade mark is invalid in accordance with Article 54(2).

This Regulation shall, unless otherwise provided for, not affect the right to bring proceedings under the civil, administrative or criminal law of a Member State or under provisions of Community law for the purpose of prohibiting the use of a Community trade mark to the extent that the use of a national trade mark may be prohibited under the law of that Member State or under Community law.

### Article 111

Prior rights applicable to particular localities

The proprietor of an earlier right which only applies to a particular locality may oppose the use of the Community trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.

Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the Community trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the Community trade mark was applied for in bad faith.

The proprietor of the Community trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though that right may no longer be invoked against the Community trade mark.

### SECTION 3

Conversion into a national trade mark application

Article 112

Request for the application of national procedure

The applicant for or proprietor of a Community trade mark may request the conversion of his Community trade mark application or Community trade mark into a national trade mark application:

to the extent that the Community trade mark application is refused, withdrawn, or deemed to be withdrawn;

to the extent that the Community trade mark ceases to have effect.

Conversion shall not take place:

where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;

for the purpose of protection in a Member State in which, in accordance with the decision of the Office or of the national court, grounds for refusal of registration or grounds for revocation or invalidity apply to the Community trade mark application or Community trade mark.

The national trade mark application resulting from the conversion of a Community trade mark application or a Community trade mark shall enjoy in respect of the Member State concerned

the date of filing or the date of priority of that application or trade mark and, where appropriate, the seniority of a trade mark of that State claimed under Articles 34 or 35.

In cases where a Community trade mark application is deemed to be withdrawn, the Office shall send to the applicant a communication fixing a period of three months from the date of that communication in which a request for conversion may be filed.

Where the Community trade mark application is withdrawn or the Community trade mark ceases to have effect as a result of a surrender being recorded or of failure to renew the registration, the request for conversion shall be filed within three months after the date on which the Community trade mark application has been withdrawn or on which the Community trade mark ceases to have effect.

Where the Community trade mark application is refused by decision of the Office or where the Community trade mark ceases to have effect as a result of a decision of the Office or of a Community trade mark court, the request for conversion shall be filed within three months after the date on which that decision acquired the authority of a final decision.

The effect referred to in Article 32 shall lapse if the request is not filed in due time.

#### Article 113

##### Submission, publication and transmission of the request for conversion

A request for conversion shall be filed with the Office and shall specify the Member States in which application of the procedure for registration of a national trade mark is desired. The request shall not be deemed to be filed until the conversion fee has been paid.

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

The Office shall check whether the conversion requested fulfils the conditions set out in this Regulation, in particular Article 112(1), (2), (4), (5) and (6), and paragraph 1 of this Article, together with the formal conditions laid down in the Implementing Regulation. If these conditions are fulfilled, the Office shall transmit the request for conversion to the industrial property offices of the Member States specified therein.

#### Article 114

##### Formal requirements for conversion

Any central industrial property office to which the request for conversion is transmitted may obtain from the Office any additional information concerning the request enabling that office to make a decision regarding the national trade mark resulting from the conversion.

A Community trade mark application or a Community trade mark transmitted in accordance with Article 113 shall not be subjected to formal requirements of national law which are different from or additional to those provided for in this Regulation or in the Implementing Regulation.

Any central industrial property office to which the request is transmitted may require that the applicant shall, within not less than two months:

pay the national application fee;

file a translation in one of the official languages of the State in question of the request and of the documents accompanying it;

indicate an address for service in the State in question;

supply a representation of the trade mark in the number of copies specified by the State in question.

## TITLE XII

### THE OFFICE

#### SECTION 1

##### General provisions

##### Article 115

##### Legal status

The Office shall be a body of the Community. It shall have legal personality.

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.

The Office shall be represented by its President.

##### Article 116

##### Staff

The Staff Regulations of officials of the European Communities, hereinafter referred to as "the Staff Regulations", the Conditions of Employment of other servants of the European

Communities, and the rules adopted by agreement between the Institutions of the European Communities for giving effect to those Staff Regulations and Conditions of Employment shall apply to the staff of the Office, without prejudice to the application of Article 136 to the members of the Boards of Appeal.

Without prejudice to Article 125, 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 respect of its staff.

#### Article 117

##### Privileges and immunities

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

#### Article 118

##### Liability

The contractual liability of the Office shall be governed by the law applicable to the contract in question.

The Court of Justice shall be competent to give judgment pursuant to any arbitration clause contained in a contract concluded by the Office.

In the case of 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 by its servants in the performance of their duties.

The Court of Justice shall have jurisdiction in disputes relating to compensation for the damage referred to in paragraph 3.

The personal liability of its servants towards the Office shall be governed by the provisions laid down in their Staff Regulations or in the Conditions of Employment applicable to them.

#### Article 119

##### Languages

The application for a Community trade mark shall be filed in one of the official languages of the European Community.

The languages of the Office shall be English, French, German, Italian and Spanish.

The applicant must indicate a second language which shall be a language of the Office the use of which he accepts as a possible language of proceedings for opposition, revocation or invalidity proceedings.

If the application was filed in a language which is not one of the languages of the Office, the Office shall arrange to have the application, as described in Article 26(1), translated into the language indicated by the applicant.

Where the applicant for a Community trade mark is the sole party to proceedings before the Office, the language of proceedings shall be the language used for filing the application for a Community trade mark. If the application was made in a language other than the languages of the Office, the Office may send written communications to the applicant in the second language indicated by the applicant in his application.

The notice of opposition and an application for revocation or invalidity shall be filed in one of the languages of the Office.

If the language chosen, in accordance with paragraph 5, for the notice of opposition or the application for revocation or invalidity is the language of the application for a trade mark or the second language indicated when the application was filed, that language shall be the language of the proceedings.

If the language chosen, in accordance with paragraph 5, for the notice of opposition or the application for revocation or invalidity is neither the language of the application for a trade mark nor the second language indicated when the application was filed, the opposing party or the party seeking revocation or invalidity shall be required to produce, at his own expense, a translation of his application either into the language of the application for a trade mark, provided that it is a language of the Office, or into the second language indicated when the application was filed. The translation shall be produced within the period prescribed in the Implementing Regulation. The language into which the application has been translated shall then become the language of the proceedings.

Parties to opposition, revocation, invalidity or appeal proceedings may agree that a different official language of the European Community is to be the language of the proceedings.

Article 120

Publication and entries in the Register

An application for a Community trade mark, as described in Article 26(1), and all other information the publication of which is prescribed by this Regulation or the Implementing Regulation, shall be published in all the official languages of the European Community.

All entries in the Register of Community trade marks shall be made in all the official languages of the European Community.

In cases of doubt, the text in the language of the Office in which the application for the Community trade mark was filed shall be authentic. If the application was filed in an official language of the European Community other than one of the languages of the Office, the text in the second language indicated by the applicant shall be authentic.

#### Article 121

The translation services required for the functioning of the Office shall be provided by the Translation Centre for the Bodies of the European Union.

#### Article 122

##### Control of legality

The Commission shall check the legality of those acts of the President of the Office in respect of which Community law does not provide for any check on legality by another body and of acts of the Budget Committee attached to the Office pursuant to Article 138.

It shall require that any unlawful acts as referred to in paragraph 1 be altered or annulled.

Member States and any person directly and individually concerned may refer to the Commission any act as referred to in paragraph 1, whether express or implied, for the Commission to examine the legality of that act. Referral shall be made to the Commission within one month of the day on which the party concerned first became aware of the act in question. The Commission shall take a decision within three months. If no decision has been taken within this period, the case shall be deemed to have been dismissed.

#### Article 123

##### Access to documents

Regulation (EC) No 1049/2001 of the European Parliament and of the Council of 30 May 2001 regarding public access to European Parliament, Council and Commission documents [9] shall apply to documents held by the Office.

The Administrative Board shall adopt the practical arrangements for Implementing Regulation (EC) No 1049/2001 with regard to this Regulation.

Decisions taken by the Office pursuant to Article 8 of Regulation (EC) No 1049/2001 may give rise to the lodging of a complaint to the Ombudsman or form the subject of an action before the Court of Justice, under the conditions laid down in Articles 195 and 230 of the Treaty respectively.

## SECTION 2

### Management of the Office

#### Article 124

##### Powers of the President

The Office shall be managed by the President.

To this end the President shall have in particular the following functions and powers:

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;

he may 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 and any other rules applying to Community trade marks after consulting the Administrative Board and, in the case of the fees regulations and the budgetary provisions of this Regulation, the Budget Committee;

he shall draw up the estimates of the revenue and expenditure of the Office and shall implement the budget;

he shall submit a management report to the Commission, the European Parliament and the Administrative Board each year;

he shall exercise in respect of the staff the powers laid down in Article 116(2);

he may delegate his powers.

The President shall be assisted by one or more Vice-Presidents. If the President is absent or indisposed, the Vice-President or one of the Vice-Presidents shall take his place in accordance with the procedure laid down by the Administrative Board.

#### Article 125

##### Appointment of senior officials

The President of the Office shall be appointed by the Council from a list of at most three candidates, which shall be prepared by the Administrative Board. Power to dismiss the President shall lie with the Council, acting on a proposal from the Administrative Board.

The term of office of the President shall not exceed five years. This term of office shall be renewable.

The Vice-President or Vice-Presidents of the Office shall be appointed or dismissed as in paragraph 1, after consultation of the President.

The Council shall exercise disciplinary authority over the officials referred to in paragraphs 1 and 3.

## SECTION 3

### Administrative Board

#### Article 126

##### Creation and powers

An Administrative Board is hereby set up, attached to the Office. Without prejudice to the powers attributed to the Budget Committee in Section 5 — budget and financial control — the Administrative Board shall have the powers defined below.

The Administrative Board shall draw up the lists of candidates provided for in Article 125.

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

It shall be consulted before adoption of the guidelines for examination in the Office and in the other cases provided for in this Regulation.

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

#### Article 127

##### Composition

The Administrative Board shall be composed of one representative of each Member State and one representative of the Commission and their alternates.

The members of the Administrative Board may, subject to the provisions of its rules of procedure, be assisted by advisers or experts.

#### Article 128

##### Chairmanship

The Administrative Board shall elect a chairman and a deputy chairman from among its members. The deputy chairman shall ex officio replace the chairman in the event of his being prevented from attending to his duties.

The duration of the terms of office of the chairman and the deputy chairman shall be three years. The terms of office shall be renewable.

#### Article 129

##### Meetings

Meetings of the Administrative Board shall be convened by its chairman.

The President of the Office shall take part in the deliberations, unless the Administrative Board decides otherwise.

The Administrative Board shall hold an ordinary meeting once a year; in addition, it shall meet on the initiative of its chairman or at the request of the Commission or of one-third of the Member States.

The Administrative Board shall adopt rules of procedure.

The Administrative Board shall take its decisions by a simple majority of the representatives of the Member States. However, a majority of three-quarters of the representatives of the Member States shall be required for the decisions which the Administrative Board is empowered to take under Article 125(1) and (3). In both cases each Member State shall have one vote.

The Administrative Board may invite observers to attend its meetings.

The Secretariat for the Administrative Board shall be provided by the Office.

#### SECTION 4

##### Implementation of procedures

#### Article 130

##### Competence

For taking decisions in connection with the procedures laid down in this Regulation, the following shall be competent:

examiners;

Opposition Divisions;

an Administration of Trade Marks and Legal Division;

Cancellation Divisions;

Boards of Appeal.

#### Article 131

## Examiners

An examiner shall be responsible for taking decisions on behalf of the Office in relation to an application for registration of a Community trade mark, including the matters referred to in Articles 36, 37 and 68, except in so far as an Opposition Division is responsible.

## Article 132

### Opposition Divisions

An Opposition Division shall be responsible for taking decisions on an opposition to an application to register a Community trade mark.

The decisions of the Opposition Divisions shall be taken by three-member groups. At least one member shall be legally qualified. In certain specific cases provided for in the Implementing Regulation, the decisions shall be taken by a single member.

## Article 133

### Administration of Trade Marks and Legal Division

The Administration of Trade Marks and Legal Division shall be responsible for those decisions required by this Regulation which do not fall within the competence of an examiner, an Opposition Division or a Cancellation Division. It shall in particular be responsible for decisions in respect of entries in the Register of Community trade marks.

It shall also be responsible for keeping the list of professional representatives which is referred to in Article 93.

A decision of the Division shall be taken by one member.

## Article 134

### Cancellation Divisions

A Cancellation Division shall be responsible for taking decisions in relation to an application for the revocation or declaration of invalidity of a Community trade mark.

The decisions of the Cancellation Divisions shall be taken by three-member groups. At least one member shall be legally qualified. In certain specific cases provided for in the Implementing Regulation, the decisions shall be taken by a single member.

## Article 135

### Boards of Appeal

The Boards of Appeal shall be responsible for deciding on appeals from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Division and Cancellation Divisions.

The decisions of the Boards of Appeal shall be taken by three members, at least two of whom are legally qualified. In certain specific cases, decisions shall be taken by an enlarged Board chaired by the President of the Boards of Appeal or by a single member, who must be legally qualified.

In order to determine the special cases which fall under the jurisdiction of the enlarged Board, account should be taken of the legal difficulty or the importance of the case or of special circumstances which justify it. Such cases may be referred to the enlarged Board:

by the authority of the Boards of Appeal set up in accordance with the rules of procedure of the Boards referred to in Article 162(3); or

by the Board handling the case.

The composition of the enlarged Board and the rules on referrals to it shall be laid down pursuant to the rules of procedure of the Boards referred to in Article 162(3).

To determine which specific cases fall under the authority of a single member, account should be taken of the lack of difficulty of the legal or factual matters raised, the limited importance of the individual case or the absence of other specific circumstances. The decision to confer a case on one member in the cases referred to shall be adopted by the Board handling the case. Further details shall be laid down in the rules of procedure of the Boards referred to in Article 162(3).

#### Article 136

##### Independence of the members of the Boards of Appeal

The President of the Boards of Appeal and the chairmen of the Boards shall be appointed, in accordance with the procedure laid down in Article 125 for the appointment of the President of the Office, for a term of five years. They may not be removed from office during this term, unless there are serious grounds for such removal and the Court of Justice, on application by the institution which appointed them, takes a decision to this effect. The term of office of the President of the Boards of Appeal and the chairmen of the Boards may be renewed for additional five-year periods, or until retirement age if this age is reached during the new term of office.

The President of the Boards of Appeal shall, inter alia, have managerial and organisational powers, principally to:

chair the authority of the Boards of Appeal responsible for laying down the rules and organising the work of the Boards, which authority is provided for in the rules of procedure of the Boards referred to in Article 162(3);

ensure the implementation of the authority's decisions;

allocate cases to a Board on the basis of objective criteria determined by the authority of the Boards of Appeal;

forward to the President of the Office the Boards' expenditure requirements, with a view to drawing up the expenditure estimates.

The President of the Boards of Appeal shall chair the enlarged Board.

Further details shall be laid down in the rules of procedure of the Boards referred to in Article 162(3).

The members of the Boards of Appeal shall be appointed by the Administrative Board for a term of five years. Their term of office may be renewed for additional five-year periods, or until retirement age if that age is reached during the new term of office.

The members of the Boards of Appeal may not be removed from office unless there are serious grounds for such removal and the Court of Justice, after the case has been referred to it by the Administrative Board on the recommendation of the President of the Boards of Appeal, after consulting the chairman of the Board to which the member concerned belongs, takes a decision to this effect.

The President of the Boards of Appeal and the chairmen and members of the Boards of Appeal shall be independent. In their decisions they shall not be bound by any instructions.

The President of the Boards of Appeal and the chairmen and members of the Boards of Appeal may not be examiners or members of the Opposition Divisions, Administration of Trade Marks and Legal Division or Cancellation Divisions.

#### Article 137

##### Exclusion and objection

Examiners and members of the Divisions set up within the Office or of the Boards of Appeal may not take part in any proceedings if they have any personal interest therein, or if they have previously been involved as representatives of one of the parties. Two of the three members

of an Opposition Division shall not have taken part in examining the application. Members of the Cancellation Divisions may not take part in any proceedings if they have participated in the final decision on the case in the proceedings for registration or opposition proceedings. Members of the Boards of Appeal may not take part in appeal proceedings if they participated in the decision under appeal.

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

Examiners and members of the Divisions or of a Board of Appeal may be objected to by any party for one of the reasons mentioned in paragraph 1, or if suspected of partiality. An objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step. No objection may be based upon the nationality of examiners or members.

The Divisions and the Boards of Appeal shall decide as to the action to be taken in the cases specified in paragraphs 2 and 3 without the participation of the member concerned. For the purposes of taking this decision the member who withdraws or has been objected to shall be replaced in the Division or Board of Appeal by his alternate.

## SECTION 5

### Budget and financial control

#### Article 138

##### Budget Committee

A Budget Committee is hereby set up, attached to the Office. The Budget Committee shall have the powers assigned to it in this Section and in Article 38(4).

Articles 126(6), 127, 128 and 129(1) to (4), (6) and (7) shall apply to the Budget Committee *mutatis mutandis*.

The Budget Committee shall take its decisions by a simple majority of the representatives of the Member States. However, a majority of three-quarters of the representatives of the Member States shall be required for the decisions which the Budget Committee is empowered to take under Articles 38(4), 140(3) and 143. In both cases each Member State shall have one vote.

#### Article 139

## Budget

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.

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

Revenue shall comprise, without prejudice to other types of income, total fees payable under the fees regulations, total fees payable under the Madrid Protocol referred to in Article 140 of this Regulation for an international registration designating the European Community and other payments made to Contracting Parties to the Madrid Protocol, total fees payable under the Geneva Act referred to in Article 106c of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs [10] for an international registration designating the European Community and other payments made to Contracting Parties to the Geneva Act, and, to the extent necessary, a subsidy entered against a specific heading of the general budget of the European Communities, Commission section.

### Article 140

#### Preparation of the budget

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 Budget Committee not later than 31 March in each year, together with a list of posts.

Should the budget estimates provide for a Community subsidy, the Budget Committee shall immediately forward the estimate to the Commission, which shall forward it to the budget authority of the Communities. The Commission may attach an opinion on the estimate along with an alternative estimate.

The Budget Committee shall adopt the budget, which shall include the Office's list of posts. Should the budget estimates contain a subsidy from the general budget of the Communities, the Office's budget shall, if necessary, be adjusted.

### Article 141

#### Audit and control

An internal audit function shall be set up within the Office, to be performed in compliance with the relevant international standards. The internal auditor, appointed by the President, shall be responsible to him for verifying the proper operation of budget implementation systems and procedures of the Office.

The internal auditor shall advise the President on dealing with risks, by issuing independent opinions on the quality of management and control systems and by issuing recommendations for improving the conditions of implementation of operations and promoting sound financial management.

The responsibility for putting in place internal control systems and procedures suitable for carrying out his tasks shall lie with the authorising officer.

#### Article 142

##### Auditing of accounts

Not later than 31 March in each year the President shall transmit to the Commission, the European Parliament, the Budget Committee and the Court of Auditors accounts of the Office's total revenue and expenditure for the preceding financial year. The Court of Auditors shall examine them in accordance with Article 248 of the Treaty.

The Budget Committee shall give a discharge to the President of the Office in respect of the implementation of the budget.

#### Article 143

##### Financial provisions

The Budget Committee shall, after consulting the Court of Auditors of the European Communities and the Commission, adopt internal financial provisions specifying, in particular, the procedure for establishing and implementing the Office's budget. As far as is compatible with the particular nature of the Office, the financial provisions shall be based on the financial regulations adopted for other bodies set up by the Community.

#### Article 144

##### Fees regulations

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

The amounts of the fees shall be fixed at such a level as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Office to be balanced.

The fees regulations shall be adopted and amended in accordance with the procedure referred to in Article 163(2).

## TITLE XIII

### INTERNATIONAL REGISTRATION OF MARKS

## SECTION I

### General provisions

#### Article 145

##### Application of provisions

Unless otherwise specified in this title, this Regulation and its Implementing Regulations shall apply to applications for international registrations under the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989 (hereafter referred to as "international applications" and "the Madrid Protocol" respectively), based on an application for a Community trade mark or on a Community trade mark and to registrations of marks in the international register maintained by the International Bureau of the World Intellectual Property Organisation (hereafter referred to as "international registrations" and "the International Bureau", respectively) designating the European Community.

## SECTION 2

### International registration on the basis of applications for a Community trade mark and of Community trade marks

#### Article 146

##### Filing of an international application

International applications pursuant to Article 3 of the Madrid Protocol based on an application for a Community trade mark or on a Community trade mark shall be filed at the Office.

Where an international application is filed before the mark on which the international registration is to be based has been registered as a Community trade mark, the applicant for the international registration must indicate whether the international registration is to be based on a Community trade mark application or registration. Where the international registration is to be based on a Community trade mark once it is registered, the international application shall be deemed to have been received at the Office on the date of registration of the Community trade mark.

#### Article 147

##### Form and contents of the international application

The international application shall be filed in one of the official languages of the European Community, using a form provided by the Office. Unless otherwise specified by the applicant

on that form when he files the international application, the Office shall correspond with the applicant in the language of filing in a standard form.

If the international application is filed in a language which is not one of the languages allowed under the Madrid Protocol, the applicant must indicate a second language from among those languages. This shall be the language in which the Office submits the international application to the International Bureau.

Where the international application is filed in a language other than one of the languages allowed under the Madrid Protocol for the filing of international applications, the applicant may provide a translation of the list of goods or services in the language in which the international application is to be submitted to the International Bureau pursuant to paragraph 2.

The Office shall forward the international application to the International Bureau as soon as possible.

The filing of an international application shall be subject to the payment of a fee to the Office. In the cases referred to in the second sentence of Article 146(2), the fee shall be due on the date of registration of the Community trade mark. The application shall be deemed not to have been filed until the required fee has been paid.

The international application must fulfil the relevant conditions laid down in the Implementing Regulation.

#### Article 148

##### Recordal in the files and in the Register

The date and number of an international registration based on a Community trade mark application, shall be recorded in the files of that application. When the application results in a Community trade mark, the date and number of the international registration shall be entered in the Register.

The date and number of an international registration based on a Community trade mark shall be entered in the Register.

#### Article 149

##### Request for territorial extension subsequent to the international registration

A request for territorial extension made subsequent to the international registration pursuant to Article 3ter(2) of the Madrid Protocol may be filed through the intermediary of the Office.

The request must be filed in the language in which the international application was filed pursuant to Article 147.

#### Article 150

##### International fees

Any fees payable to the International Bureau under the Madrid Protocol shall be paid direct to the International Bureau.

### SECTION 3

#### International registrations designating the European Community

#### Article 151

##### Effects of international registrations designating the European Community

An international registration designating the European Community shall, from the date of its registration pursuant to Article 3(4) of the Madrid Protocol or from the date of the subsequent designation of the European Community pursuant to Article 3ter(2) of the Madrid Protocol, have the same effect as an application for a Community trade mark.

If no refusal has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the international registration of a mark designating the European Community shall, from the date referred to in paragraph 1, have the same effect as the registration of a mark as a Community trade mark.

For the purposes of applying Article 9(3), publication of the particulars of the international registration designating the European Community pursuant to Article 152(1) shall take the place of publication of a Community trade mark application, and publication pursuant to Article 152(2) shall take the place of publication of the registration of a Community trade mark.

#### Article 152

##### Publication

The Office shall publish the date of registration of a mark designating the European Community pursuant to Article 3(4) of the Madrid Protocol or the date of the subsequent designation of the European Community pursuant to Article 3ter(2) of the Madrid Protocol, the language of filing of the international application and the second language indicated by the applicant, the number of the international registration and the date of publication of such registration in the Gazette published by the International Bureau, a reproduction of the mark

and the numbers of the classes of the goods or services in respect of which protection is claimed.

If no refusal of protection of an international registration designating the European Community has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the Office shall publish this fact, together with the number of the international registration and, where applicable, the date of publication of such registration in the Gazette published by the International Bureau.

#### Article 153

##### Seniority

The applicant for an international registration designating the European Community may claim, in the international application, the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 34.

The holder of an international registration designating the European Community may, as from the date of publication of the effects of such registration pursuant to Article 152(2), claim at the Office the seniority of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, as provided for in Article 35. The Office shall notify the International Bureau accordingly.

#### Article 154

##### Examination as to absolute grounds for refusal

International registrations designating the European Community shall be subject to examination as to absolute grounds for refusal in the same way as applications for Community trade marks.

Protection of an international registration shall not be refused before the holder of the international registration has been allowed the opportunity to renounce or limit the protection in respect of the European Community or of submitting his observations.

Refusal of protection shall take the place of refusal of a Community trade mark application.

Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the protection in respect of the European Community pursuant to paragraph 2, the Office shall

refund the holder of the international registration a part of the individual fee to be laid down in the Implementing Regulation.

#### Article 155

##### Search

Once the Office has received a notification of an international registration designating the European Community, it shall draw up a Community search report as provided for in Article 38(1).

As soon as the Office has received a notification of an international registration designating the European Community, the Office shall transmit a copy thereof to the central industrial property office of each Member State which has informed the Office of its decision to operate a search in its own register of trade marks as provided for in Article 38(2).

Article 38(3) to (6) shall apply *mutatis mutandis*.

The Office shall inform the proprietors of any earlier Community trade marks or Community trade mark applications cited in the Community search report of the publication of the international registration designating the European Community as provided for in Article 152(1).

#### Article 156

##### Opposition

International registration designating the European Community shall be subject to opposition in the same way as published Community trade mark applications.

Notice of opposition shall be filed within a period of three months which shall begin six months following the date of the publication pursuant to Article 152(1). The opposition shall not be treated as duly entered until the opposition fee has been paid.

Refusal of protection shall take the place of refusal of a Community trade mark application.

Where protection of an international registration is refused by a decision under this Article which has become final or where the holder of the international registration has renounced the protection in respect of the European Community prior to a decision under this Article which has become final, the Office shall refund the holder of the international registration a part of the individual fee to be laid down in the Implementing Regulation.

#### Article 157

Replacement of a Community trade mark by an international registration

The Office shall, upon request, enter a notice in the Register that a Community trade mark is deemed to have been replaced by an international registration in accordance with Article 4bis of the Madrid Protocol.

#### Article 158

##### Invalidation of the effects of an international registration

The effects of an international registration designating the European Community may be declared invalid.

The application for invalidation of the effects of an international registration designating the European Community shall take the place of an application for a declaration of revocation as provided for in Article 51 or for a declaration of invalidity as provided for in Article 52 or Article 53.

#### Article 159

Conversion of a designation of the European Community through an international registration into a national trade mark application or into a designation of Member States

Where a designation of the European Community through an international registration has been refused or ceases to have effect, the holder of the international registration may request the conversion of the designation of the European Community:

into a national trade mark application pursuant to Articles 112, 113 and 114;

into a designation of a Member State party to the Madrid Protocol or the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 14 April 1891, as revised and amended (hereafter referred to as the "Madrid Agreement"), provided that on the date when conversion was requested it was possible to have designated that Member State directly under the Madrid Protocol or the Madrid Agreement. Articles 112, 113 and 114 shall apply.

The national trade mark application or the designation of a Member State party to the Madrid Protocol or the Madrid Agreement resulting from the conversion of the designation of the European Community through an international registration shall enjoy, in respect of the Member State concerned, the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date of the extension to the European Community pursuant to Article 3ter(2) of the Madrid Protocol if the latter was made subsequently to the international registration, or the date of priority of that registration and, where appropriate, the seniority of a trade mark of that State claimed under Article 153.

The request for conversion shall be published.

#### Article 160

Use of a mark subject of an international registration

For the purposes of applying Article 15(1), Article 42(2), Article 51(1)(a) and Article 57(2), the date of publication pursuant to Article 152(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the European Community must be put to genuine use in the Community.

#### Article 161

Transformation

Subject to paragraph 2, the provisions applicable to Community trade mark applications shall apply mutatis mutandis to applications for transformation of an international registration into a Community trade mark application pursuant to Article 9quinquies of the Madrid Protocol.

When the application for transformation relates to an international registration designating the European Community the particulars of which have been published pursuant to Article 152(2), Articles 37 to 42 shall not apply.

### TITLE XIV

#### FINAL PROVISIONS

#### Article 162

Community implementing provisions

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

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

late payment of the registration fee;

issue of a copy of the certificate of registration;

registration of a licence or another right in respect of a Community trade mark;

registration of a licence or another right in respect of an application for a Community trade mark;

cancellation of the registration of a licence or another right;

alteration of a registered Community trade mark;  
issue of an extract from the Register;  
inspection of the files;  
issue of copies of file documents;  
issue of certified copies of the application;  
communication of information in a file;  
review of the determination of the procedural costs to be refunded.

The Implementing Regulation and the rules of procedure of the Boards of Appeal shall be adopted and amended in accordance with the procedure referred to in Article 163(2).

#### Article 163

Establishment of a committee and procedure for the adoption of implementing regulations

The Commission shall be assisted by a committee referred to as the "Committee on Fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonisation in the Internal Market (trade marks and designs)".

Where reference is made to this paragraph, Articles 5 and 7 of Decision 1999/468/EC shall apply.

The period laid down in Article 5(6) of Decision 1999/468/EC shall be set at three months.

#### Article 164

Compatibility with other Community legal provisions

This Regulation shall not affect Council Regulation (EC) No 510/2006, and in particular Article 14 thereof.

#### Article 165

Provisions relating to the enlargement of the Community

As from the date of accession of Bulgaria, the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Romania, Slovenia and Slovakia (hereinafter referred to as "new Member State(s)"), a Community trade mark registered or applied for pursuant to this Regulation before the respective dates of accession shall be extended to the territory of those Member States in order to have equal effect throughout the Community.

The registration of a Community trade mark which is under application at the date of accession may not be refused on the basis of any of the absolute grounds for refusal listed in

Article 7(1), if these grounds became applicable merely because of the accession of a new Member State.

Where an application for the registration of a Community trade mark has been filed during the six months prior to the date of accession, notice of opposition may be given pursuant to Article 41 where an earlier trade mark or another earlier right within the meaning of Article 8 was acquired in a new Member State prior to accession, provided that it was acquired in good faith and that the filing date or, where applicable, the priority date or the date of acquisition in the new Member State of the earlier trade mark or other earlier right precedes the filing date or, where applicable, the priority date of the Community trade mark applied for.

A Community trade mark as referred to in paragraph 1 may not be declared invalid:

pursuant to Article 52 if the grounds for invalidity became applicable merely because of the accession of a new Member State;

pursuant to Article 53(1) and (2) if the earlier national right was registered, applied for or acquired in a new Member State prior to the date of accession.

The use of a Community trade mark as referred to in paragraph 1 may be prohibited pursuant to Articles 110 and 111, if the earlier trade mark or other earlier right was registered, applied for or acquired in good faith in the new Member State prior to the date of accession of that State; or, where applicable, has a priority date prior to the date of accession of that State.

Article 166

Repeal

Regulation (EC) No 40/94, as amended by the instruments set out in Annex I, is repealed.

References to the repealed Regulation shall be construed as references to this Regulation and shall be read in accordance with the correlation table in Annex II.

Article 167

Entry into force

This Regulation shall enter into force on the 20th day following its publication in the Official Journal of the European Union.

The Member States shall within three years following entry into force of Regulation (EC) No 40/94 take the necessary measures for the purpose of implementing Articles 95 and 114.

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

Done at Brussels, 26 February 2009.

For the Council

The President

Langer

[1] OJ C 146 E, 12.6.2008, p. 79.

[2] OJ L 11, 14.1.1994, p. 1.

[3] See Annex I.

[4] OJ L 12, 16.1.2001, p. 1.

[5] OJ L 184, 17.7.1999, p. 23.

[6] OJ L 93, 31.3.2006, p. 12.

[7] OJ L 110, 20.4.2001, p. 28.

[8] OJ L 125, 5.5.2001, p. 15.

[9] OJ L 145, 31.5.2001, p. 43.

[10] OJ L 3, 5.1.2002, p. 1.

---

## ANNEX I

Repealed Regulation with list of its successive amendments

(referred to in Article 166)

Council Regulation (EC) No 40/94 (OJ L 11, 14.1.1994, p. 1) ||

Council Regulation (EC) No 3288/94 (OJ L 349, 31.12.1994, p. 83) ||

Council Regulation (EC) No 807/2003 (OJ L 122, 16.5.2003, p. 36) | Only point 48 of Annex III |

Council Regulation (EC) No 1653/2003 (OJ L 245, 29.9.2003, p. 36) ||

Council Regulation (EC) No 1992/2003 (OJ L 296, 14.11.2003, p. 1) ||

Council Regulation (EC) No 422/2004 (OJ L 70, 9.3.2004, p. 1) ||

Council Regulation (EC) No 1891/2006 (OJ L 386, 29.12.2006, p. 14) | Only Article 1 |

Annex II, Part 4 (C)(I) of the 2003 Act of Accession (OJ L 236, 23.9.2003, p. 342) ||

Annex III, Point 1.I of the 2005 Act of Accession (OJ L 157, 21.6.2005, p. 231) ||

**5.1.2. Regulation (EU) No 386/2012 of the European Parliament and of the Council on entrusting the Office for Harmonization in the Internal Market (Trade Marks and Designs) with tasks related to the enforcement of intellectual property rights, including the assembling of public and private-sector representatives as a European Observatory on Infringements of Intellectual Property Rights**

(Text with EEA relevance)

of 19 April 2012

THE EUROPEAN PARLIAMENT AND THE COUNCIL OF THE EUROPEAN UNION,  
Having regard to the Treaty on the Functioning of the European Union, and in particular Article 114 and the first paragraph of Article 118 thereof,  
Having regard to the proposal from the European Commission,  
After transmission of the draft legislative act to the national parliaments,  
Having regard to the opinion of the European Economic and Social Committee [1],  
Acting in accordance with the ordinary legislative procedure [2],

Whereas:

- (1) The economic well-being of the Union relies on sustained creativity and innovation. Therefore, measures for their effective protection are indispensable in ensuring its future prosperity.
- (2) Intellectual property rights are vital business assets that help to ensure that creators and innovators get a fair return for their work and that their investment in research and new ideas is protected.
- (3) A sound, harmonised and progressive approach to intellectual property rights is fundamental in the endeavour to fulfil the ambitions of the Europe 2020 Strategy including A Digital Agenda for Europe.
- (4) The constant increase in infringements of intellectual property rights constitutes a genuine threat not only to the Union economy, but also, in many cases, to the health and safety of Union consumers. Therefore, effective, immediate and coordinated action at national, European and global levels is needed to successfully combat this phenomenon.
- (5) In the context of the overall intellectual property rights strategy envisaged by the Council Resolution of 25 September 2008 on a comprehensive European anti-counterfeiting and anti-

piracy plan [3], the Council called on the Commission to set up a European Observatory on Counterfeiting and Piracy. The Commission therefore formed a network of experts from the public and the private sectors and described the tasks of that network in its Communication entitled "Enhancing the enforcement of intellectual property rights in the internal market". The name of the European Observatory on Counterfeiting and Piracy should be changed to the European Observatory on Infringements of Intellectual Property Rights ("the Observatory").

(6) That Communication stated that the Observatory should serve as the central resource for gathering, monitoring and reporting information and data related to all infringements of intellectual property rights. It should be used as a platform for cooperation between representatives from national authorities and stakeholders to exchange ideas and expertise on best practices and make recommendations to policymakers for joint enforcement strategies. The Communication specified that the Observatory would be hosted and managed by the services of the Commission.

(7) In its Resolution of 1 March 2010 on the enforcement of intellectual property rights in the internal market [4], the Council invited the Commission, the Member States and industry to provide the Observatory with available reliable and comparable data on counterfeiting and piracy and to jointly develop and agree, in the context of the Observatory, on plans to collect further information. The Council also invited the Observatory to publish each year a comprehensive annual report covering the scope, scale and principal characteristics of counterfeiting and piracy as well as its impact on the internal market. That annual report should be prepared using the relevant information provided in that regard by the authorities of the Member States, the Commission and the private sector within the limits of data protection law. The Council also recognised the importance of developing new competitive business models enlarging the legal offer of cultural and creative content and at the same time preventing and combating infringements of intellectual property rights as necessary means for fostering economic growth, employment and cultural diversity.

(8) In its Conclusions of 25 May 2010 on the future revision of the Trade Mark system in the European Union [5], the Council called on the Commission to establish a legal basis for the involvement of the Office for Harmonization in the Internal Market (Trade Marks and Designs) ("the Office") in enforcement-related activities, including the fight against counterfeiting, in particular through fostering its cooperation with the national trade mark offices and the Observatory. In that respect, Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [6]

provides, inter alia, for certain measures to promote cooperation, including the exchange of information, among Member States and between Member States and the Commission.

(9) In its Recommendation of 26 March 2009 on strengthening security and fundamental freedoms on the internet [7], the European Parliament recommended that the Council preserve full and safe access to the internet while encouraging private/public cooperation in enhancing law enforcement cooperation.

(10) In its Resolution of 22 September 2010 on enforcement of intellectual property rights in the internal market [8], the European Parliament called on the Member States and the Commission to extend the cooperation between the Office and national intellectual property offices so as to include the fight against infringements of intellectual property rights.

(11) In its Resolution of 12 May 2011 on unlocking the potential of cultural and creative industries [9], the European Parliament urged the Commission to take into account the specific problems encountered by small and medium-sized enterprises when it comes to asserting their intellectual property rights and to promote best practice and effective methods to respect those rights.

(12) In its Resolution of 6 July 2011 on a comprehensive approach on personal data protection in the European Union [10], the European Parliament called on the Commission to ensure full harmonisation and legal certainty, providing a uniform and high level of protection of individuals in all circumstances.

(13) In view of the range of tasks assigned to the Observatory, a solution is needed to ensure an adequate and sustainable infrastructure for the fulfilment of its tasks.

(14) Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [11] provides for administrative cooperation between the Office and the courts or authorities of the Member States, and the exchange of publications between the Office and the central industrial property offices of the Member States. On that basis, the Office has established cooperation with national offices that are active in the field of protection of intellectual property rights. Consequently, the Office already possesses, to a considerable extent, the necessary experience and expertise to provide an adequate and sustainable infrastructure in the field of the Observatory's tasks.

(15) The Office is therefore well placed to be entrusted with carrying out those tasks.

(16) Those tasks should relate to all intellectual property rights covered by Directive 2004/48/EC, since in many cases, infringing acts affect a bundle of intellectual property rights. Furthermore, data and the exchange of best practices are needed on the entire abovementioned range of intellectual property rights, in order to obtain a complete picture of

the situation and to enable comprehensive strategies to be devised with a view to reducing infringements of intellectual property rights.

(17) The tasks that the Office should carry out can be linked to the enforcement and reporting measures laid down by Directive 2004/48/EC. Thus, the Office should provide services to national authorities or operators which affect, in particular, the homogenous implementation of the Directive and which are likely to facilitate its application. The Office's tasks should therefore be considered as closely linked to the subject matter of acts approximating the laws, regulations and administrative provisions of the Member States.

(18) Assembled by the Office, the Observatory should become a centre of excellence on information and data relating to infringements of intellectual property rights, by benefiting from the Office's expertise, experience and resources.

(19) The Office should offer a forum that brings together public authorities and the private sector, ensuring the collection, analysis and dissemination of relevant objective, comparable and reliable data regarding the value of intellectual property rights and infringements of those rights, identifying and promoting best practices and strategies to enforce intellectual property rights, and raising public awareness of the impact of infringements of intellectual property rights. Furthermore, the Office should fulfil additional tasks, such as improving the understanding of the value of intellectual property rights, fostering the exchange of information on new competitive business models which enlarge the legal offer of cultural and creative content, enhancing the expertise of persons involved in the enforcement of intellectual property rights by appropriate training measures, increasing knowledge of techniques to prevent counterfeiting, and improving cooperation with third countries and international organisations. The Commission should be associated with the activities undertaken by the Office under this Regulation.

(20) The Office should thus facilitate and support the activities of national authorities, the private sector and the Union institutions relating to the enforcement of intellectual property rights and in particular their activities in the fight against infringements of those rights. The exercise by the Office of its powers under this Regulation does not prevent Member States from exercising their competences. The Office's tasks and activities under this Regulation do not extend to participation in individual operations or investigations carried out by the competent authorities.

(21) In order to fulfil those tasks in the most efficient manner, the Office should consult and cooperate with other authorities at national, European and, where appropriate, international

levels, create synergies with the activities carried out by such authorities and avoid any duplication of measures.

(22) The Office should implement the tasks and activities relating to the enforcement of intellectual property rights by making use of its own budgetary means.

(23) With regard to representatives of the private sector, the Office should, when assembling the Observatory in the context of its activities, involve a representative selection of the economic sectors — including the creative industries — most concerned by or most experienced in the fight against infringements of intellectual property rights, in particular representatives of right holders, including authors and other creators, as well as internet intermediaries. Also, a proper representation of consumers and of small and medium-sized enterprises should be ensured.

(24) The information obligations imposed by this Regulation on the Member States and on the private sector should not create unnecessary administrative burdens and should endeavour to avoid duplication as regards data already provided by Member States and private-sector representatives to Union institutions under existing Union reporting requirements.

(25) Since the objective of this Regulation, namely to entrust the Office with tasks related to the enforcement of intellectual property rights, cannot be sufficiently achieved by the Member States and can therefore, by reason of its effect, be better achieved at Union level, the Union may adopt measures, in accordance with the principle of subsidiarity as set out in Article 5 of the Treaty on European Union. In accordance with the principle of proportionality, as set out in that Article, this Regulation does not go beyond what is necessary in order to achieve that objective,

HAVE ADOPTED THIS REGULATION:

Article 1

Subject matter and scope

This Regulation entrusts the Office for Harmonization in the Internal Market (Trade Marks and Designs) ("the Office") with tasks aimed at facilitating and supporting the activities of national authorities, the private sector and the Union institutions in the fight against infringements of the intellectual property rights covered by Directive 2004/48/EC. In carrying out these tasks the Office shall organise, administer and support the gathering of experts, authorities and stakeholders assembled under the name "European Observatory on Infringements of Intellectual Property Rights" ("the Observatory").

The tasks and activities of the Office under this Regulation do not extend to participation in individual operations or investigations carried out by the competent authorities.

## Article 2

### Tasks and activities

1. The Office shall have the following tasks:

- (a) improving understanding of the value of intellectual property;
- (b) improving understanding of the scope and impact of infringements of intellectual property rights;
- (c) enhancing knowledge of best public and private sector practices to protect intellectual property rights;
- (d) assisting in raising citizens' awareness of the impact of infringements of intellectual property rights;
- (e) enhancing the expertise of persons involved in the enforcement of intellectual property rights;
- (f) enhancing knowledge of technical tools to prevent and tackle infringements of intellectual property rights, including tracking and tracing systems which help to distinguish genuine products from counterfeit ones;
- (g) providing mechanisms which help to improve the online exchange, between Member States' authorities working in the field of intellectual property rights, of information relating to the enforcement of such rights, and fostering cooperation with and between those authorities;
- (h) working, in consultation with Member States, to foster international cooperation with intellectual property offices in third countries so as to build strategies and develop techniques, skills and tools for the enforcement of intellectual property rights.

2. In the fulfilment of the tasks set out in paragraph 1, the Office shall carry out the following activities in accordance with the work programme adopted pursuant to Article 7, and in line with Union law:

- (a) establishing a transparent methodology for the collection, analysis and reporting of independent, objective, comparable and reliable data relating to infringements of intellectual property rights;
- (b) collecting, analysing and disseminating relevant objective, comparable and reliable data regarding infringements of intellectual property rights;
- (c) collecting, analysing and disseminating relevant objective, comparable and reliable data regarding the economic value of intellectual property and its contribution to economic growth, welfare, innovation, creativity, cultural diversity, the creation of high-quality jobs and the development of high quality products and services within the Union;

- (d) providing regular assessments and specific reports by economic sector, geographic area and type of intellectual property right infringed, which evaluate, inter alia, the impact of infringements of intellectual property rights on society and the economy, including an assessment of the effects on small and medium-sized enterprises, as well as on health, the environment, safety and security;
- (e) collecting, analysing and disseminating information regarding best practices between the representatives meeting as the Observatory, and, if applicable, making recommendations for strategies based on such practices;
- (f) drawing up reports and publications to raise awareness amongst Union citizens of the impact of infringements of intellectual property rights and to that end, organising conferences, events and meetings at European and international levels as well as assisting national and Europe-wide actions, including online and offline campaigns, principally by providing data and information;
- (g) monitoring the development of new competitive business models which enlarge the legal offer of cultural and creative content, and encouraging the exchange of information and raising consumer awareness in this respect;
- (h) developing and organising online and other forms of training for national officials involved in the protection of intellectual property rights;
- (i) organising ad hoc meetings of experts, including academic experts and relevant representatives of civil society, to support its work under this Regulation;
- (j) identifying and promoting technical tools for professionals and benchmark techniques, including tracking and tracing systems which help to distinguish genuine products from counterfeit ones;
- (k) working with national authorities and the Commission to develop an online network facilitating the exchange of information on infringements of intellectual property rights between public administrations, bodies and organisations in the Member States dealing with the protection and enforcement of those rights;
- (l) working in cooperation with, and building synergies between, the central industrial property offices of the Member States, including the Benelux Office for Intellectual Property and other Member States' authorities working in the field of intellectual property rights, with a view to developing and promoting techniques, skills and tools relating to the enforcement of intellectual property rights, including training programmes and awareness campaigns;
- (m) developing, in consultation with the Member States, programmes for the provision of technical assistance to third countries as well as developing and delivering specific training

programmes and events for officials from third countries who are involved in the protection of intellectual property rights;

(n) making recommendations to the Commission on issues falling within the scope of this Regulation, on the basis of a request from the Commission;

(o) carrying out similar activities necessary in order to enable the Office to fulfil the tasks set out in paragraph 1.

3. In carrying out the tasks and activities referred to in paragraphs 1 and 2, the Office shall comply with existing provisions of Union law on data protection.

### Article 3

#### Financing

The Office shall at all times ensure that the activities entrusted to it by this Regulation are carried out by making use of its own budgetary means.

### Article 4

#### Meetings of the Observatory

1. In order to carry out the activities referred to in Article 2(2), the Office shall at least once per year invite to meetings of the Observatory representatives from public administrations, bodies and organisations in the Member States dealing with intellectual property rights and representatives from the private sector, for the purpose of their participation in the Office's work under this Regulation.

2. Private-sector representatives invited to meetings of the Observatory shall include a broad, representative and balanced range of Union and national bodies representing the different economic sectors, including the creative industries, most concerned by or most experienced in the fight against infringements of intellectual property rights.

Consumer organisations, small and medium-sized enterprises, authors and other creators shall be properly represented.

3. The Office shall invite each Member State to send at least one representative from its public administration to meetings of the Observatory. In that context, Member States shall ensure continuity in the Observatory's work.

4. The meetings referred to in paragraph 1 may be complemented by working groups within the Observatory made up of representatives from Member States and representatives from the private sector.

5. Where appropriate, and in addition to the meetings referred to in paragraph 1, the Office shall organise meetings consisting of:

(a) representatives from the public administrations, bodies and organisations in the Member States; or

(b) private-sector representatives.

6. Members or other representatives of the European Parliament and representatives from the Commission shall be invited to any of the meetings covered by this Article, either as participants or observers, as appropriate.

7. The names of the representatives attending, the agenda and the minutes of the meetings referred to in this Article shall be published on the Office's website.

## Article 5

### Information obligations

1. As appropriate, in accordance with national law, including the law governing the processing of personal data, Member States shall, at the request of the Office or on their own initiative:

(a) inform the Office of their overall policies and strategies on the enforcement of intellectual property rights and any changes thereto;

(b) provide available statistical data on infringements of intellectual property rights;

(c) inform the Office of important case-law.

2. Without prejudice to the law governing the processing of personal data and to the protection of confidential information, private-sector representatives meeting as the Observatory shall, when possible, at the request of the Office:

(a) inform the Office of policies and strategies in their field of activity on the enforcement of intellectual property rights and any changes thereto;

(b) provide statistical data on infringements of intellectual property rights in their field of activity.

## Article 6

### The Office

1. The relevant provisions of Title XII of Regulation (EC) No 207/2009 shall apply to the carrying-out of the tasks and activities provided for under this Regulation.

2. Using the powers conferred by Article 124 of Regulation (EC) No 207/2009, the President of the Office shall adopt the internal administrative instructions and shall publish the notices that are necessary for the fulfilment of all the tasks entrusted to the Office by this Regulation.

## Article 7

### Content of the work programme and of the management report

1. The Office shall draw up an annual work programme that appropriately prioritises the activities under this Regulation and for the meetings of the Observatory, in line with the Union's policies and priorities in the field of protection of intellectual property rights and in cooperation with the representatives referred to in point (a) of Article 4(5).

2. The work programme referred to in paragraph 1 shall be submitted to the Office's Administrative Board for information.

3. The management report provided for in point (d) of Article 124(2) of Regulation (EC) No 207/2009 shall contain at least the following information concerning the Office's tasks and activities under this Regulation:

(a) a review of the main activities carried out during the preceding calendar year;

(b) the results achieved during the preceding calendar year, accompanied, where appropriate, by sectoral reports analysing the situation in the different industry and product sectors;

(c) an overall assessment of the fulfilment of the Office's tasks as provided for in this Regulation and in the work programme drawn up in accordance with paragraph 1;

(d) an overview of the activities that the Office intends to undertake in the future;

(e) observations on the enforcement of intellectual property rights and potential future policies and strategies, including on how to enhance effective cooperation with and between Member States;

(f) an overall assessment of the proper representation in the Observatory of all the actors mentioned in Article 4(2).

Before submitting the management report to the European Parliament, the Commission and the Administrative Board, the President of the Office shall consult the representatives referred to in point (a) of Article 4(5) on the relevant parts of the report.

## Article 8

### Evaluation

1. The Commission shall adopt a report evaluating the application of this Regulation by 6 June 2017.

2. The evaluation report shall assess the operation of this Regulation, in particular as regards its impact on the enforcement of intellectual property rights in the internal market.

3. The Commission shall, when preparing the evaluation report, consult the Office, the Member States and the representatives meeting as the Observatory on the issues referred to in paragraph 2.

4. The Commission shall transmit the evaluation report to the European Parliament, the Council and the European Economic and Social Committee and shall undertake a broad consultation among stakeholders on the evaluation report.

#### Article 9

##### Entry into force

This Regulation shall enter into force on the twentieth day following that of its publication in the Official Journal of the European Union.

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

Done at Strasbourg, 19 April 2012.

For the European Parliament

The President

M. Schulz

For the Council

The President

M. Bødskov

[1] OJ C 376, 22.12.2011, p. 62.

[2] Position of the European Parliament of 14 February 2012 (not yet published in the Official Journal) and decision of the Council of 22 March 2012 (not yet published in the Official Journal).

[3] OJ C 253, 4.10.2008, p. 1.

[4] OJ C 56, 6.3.2010, p. 1.

[5] OJ C 140, 29.5.2010, p. 22.

[6] OJ L 157, 30.4.2004, p. 45. Corrected version in OJ L 195, 2.6.2004, p. 16.

[7] OJ C 117 E, 6.5.2010, p. 206.

[8] OJ C 50 E, 21.2.2012, p. 48.

[9] Not yet published in the Official Journal.

[10] Not yet published in the Official Journal.

[11] OJ L 78, 24.3.2009, p. 1.

### **5.1.3. Decision taken by common Agreement between the Representatives of the Governments of the Member States, meeting at Head of State and**

**Government level, on the location of the seats of certain bodies and departments of the European Communities and of Europol<sup>18</sup>**

DECISION TAKEN BY COMMON AGREEMENT BETWEEN THE REPRESENTATIVES OF THE GOVERNMENTS OF THE MEMBER STATES, MEETING AT HEAD OF STATE AND GOVERNMENT LEVEL, ON THE LOCATION OF THE SEATS OF CERTAIN BODIES AND DEPARTMENTS OF THE EUROPEAN COMMUNITIES AND OF EUROPOL (93/C 323/01)

THE REPRESENTATIVES OF THE MEMBER STATES, MEETING AT HEAD OF STATE AND GOVERNMENT LEVEL,

Having regard to Article 216 of the Treaty establishing the European Economic Community, Article 77 of the Treaty establishing the European Coal and Steel Community and Article 189 of the Treaty establishing the European Atomic Energy Community,

Having regard to Council Regulation (EEC) No 1210/90 of 7 May 1990 on the establishment of the European Environment Agency and the European environment information and observation network (1), and in particular Article 21 thereof,

Having regard to Council Regulation (EEC) No 1360/90 of 7 May 1990 establishing a European Training Foundation (2), and in particular Article 19 thereof,

Having regard to the Decision of 18 December 1991 under which the Commission approved the establishment of the Office for Veterinary and Plant-Health Inspection and Control,

Having regard to Council Regulation (EEC) No 302/93 of 8 February 1993 on the establishment of a European Monitoring Centre for Drugs and Drug Addiction (3), and in particular Article 19 thereof,

Having regard to Council Regulation (EEC) No 2309/93 of 22 July 1993 establishing inter alia a European Agency for the Evaluation of Medicinal Products (4), and in particular Article 74 thereof,

Whereas, further to the action programme adopted by the Commission on 20 November 1989 relating to the implementation of the Community Charter of the Fundamental Social Rights of

---

<sup>18</sup> *Official Journal C 323*, 30/11/1993 P. 0001 - 0005

Workers, the European Council made provision for creating the Agency for Health and Safety at Work;

Whereas the Treaty on European Union, which was signed on 7 February 1992 and will enter into force on 1 November 1993, provides for the establishment of the European Monetary Institute and the European Central Bank;

Whereas the institutions of the European Communities envisage the establishment of an Office for Harmonization in the Internal Market (trade marks, designs and models);

Whereas, further to the conclusions of the Maastricht European Council, the Member States envisage concluding a Convention on Europol (European Police Office), which will create Europol and also replace the Ministerial Agreement of 2 June 1993, which set up the Europol Drugs Unit;

Whereas the location of the seats of these different bodies and departments should be determined;

Recalling the Decisions of 8 April 1965 and 12 December 1992,

HAVE DECIDED AS FOLLOWS:

#### Article 1

The European Environment Agency shall have its seat in the area of Copenhagen.

The European Training Foundation shall have its seat at Turin.

The Office for Veterinary and Plant-Health Inspection and Control shall have its seat in a town in Ireland to be determined by the Irish Government.

The European Monitoring Centre for Drugs and Drug Addiction shall have its seat at Lisbon.

The European Agency for the Evaluation of Medicinal Products shall have its seat at London.

The Agency for Health and Safety at Work shall have its seat in Spain, in a town to be determined by the Spanish Government.

The European Monetary Institute and the future European Central Bank shall have their seat at Frankfurt.

The Office for Harmonization in the Internal Market (trade marks, designs and models), including its Boards of Appeal, shall have its seat in Spain, in a town to be determined by the Spanish Government.

Europol, and the Europol Drugs Unit, shall have their seat at The Hague.

#### Article 2

This Decision, which will be published in the Official Journal of the European Communities, shall enter into force on this day.

Hecho en Bruselas, el veintinueve de octubre de mil novecientos noventa y tres.

Udfærdiget i Bruxelles den nioogtyvende oktober nitten hundrede og tre og halvfems.

Geschehen zu Brüssel am neunundzwanzigsten Oktober neunzehnhundertdreiundneunzig.

Ἐγένετο ἐν Βρυξελλῶν τῆς ἐποχῆς τοῦ δεκάτου ἑννεακοντατρίτου ὀκτωβρίου τοῦ ἑξακονταεπταεταίου καὶ τριῶν καὶ ἡμιτεταρτημυρίου.

Done at Brussels on the twenty-ninth day of October in the year one thousand nine hundred and ninety-three.

Fait à Bruxelles, le vingt-neuf octobre mil neuf cent quatre-vingt-treize.

Fatto a Bruxelles, addì ventinove ottobre millenovecentonovantatré.

Gedaan te Brussel, de negenentwintigste oktober negentienhonderd drieënnegentig.

Feito em Bruxelas, em vinte e nove de Outubro de mil novecentos e noventa e três.

Pour le gouvernement du royaume de Belgique

Voor de Regering van het Koninkrijk België

>REFERENCE TO A FILM>

For regeringen for Kongeriget Danmark

>REFERENCE TO A FILM>

Für die Regierung der Bundesrepublik Deutschland

>REFERENCE TO A FILM>

Ἐγένετο ἐν Βρυξελλῶν τῆς ἐποχῆς τοῦ δεκάτου ἑννεακοντατρίτου ὀκτωβρίου τοῦ ἑξακονταεπταεταίου καὶ τριῶν καὶ ἡμιτεταρτημυρίου.

>REFERENCE TO A FILM>

Por el Gobierno del Reino de España

>REFERENCE TO A FILM>

Pour la République française

>REFERENCE TO A FILM>

Thar ceann Rialtas na hÉireann

For the Government of Ireland

>REFERENCE TO A FILM>

Per il governo della Repubblica italiana

>REFERENCE TO A FILM>

Pour le gouvernement du grand-duché de Luxembourg

>REFERENCE TO A FILM>

Voor de Regering van het Koninkrijk der Nederlanden

>REFERENCE TO A FILM>

Pelo Governo da República Portuguesa

>REFERENCE TO A FILM>

For the Government of the United Kingdom of Great Britain and Northern Ireland

>REFERENCE TO A FILM>

OJ No L 120, 11. 5. 1990, p. 1.

OJ No L 131, 23. 5. 1990, p. 1.

OJ No L 36, 12. 2. 1993, p. 1.

OJ No L 214, 24. 8. 1993, p. 1.

#### DECLARATIONS

When adopting the above Decision on 29 October 1993, the Representatives of the Governments of the Member States adopted the following declarations by common agreement:

Under Council Regulation (EEC) No 337/75 of 10 February 1975, which was adopted unanimously by the Council on a proposal from the Commission and after consulting the European Parliament, the seat of the European Centre for the Development of Vocational Training was located in Berlin. The Representatives of the Governments of the Member States call upon the institution of the European Community to provide that that seat shall be determined, as soon as possible, in Thessaloniki.

The Commission stated that it was willing to submit a proposal to that effect in the very near future.

A Translation Centre for the bodies of the Union will be set up within the Commission's Translation Departments located in Luxembourg and will provide the necessary translation services for the operation of the bodies and departments whose seats have been determined by the above Decision of 29 October 1993, with the exception of the translators of the European Monetary Institute.

The Member States undertake to support the candidacy of Luxembourg as seat of the Common Appeal Court for Community patents as provided for in the Protocol on the settlement of litigation concerning the infringement and validity of Community patents annexed to the Community Patent Agreement of 15 December 1989.

At the conference of the Representatives of the Governments of the Member States the Commission confirmed that it intends to consolidate the establishment of those of its departments that are located in Luxembourg.

Finally, the Member States noted that budgetary resources are available to enable the European Foundation for the Improvement of Living and Working Conditions in Dublin to perform a number of new tasks.

## Chapter VI. International treaties (selection)

6.

### 6.1. Geneva Act of July 2, 1999

#### TABLE OF CONTENTS

#### INTRODUCTORY PROVISIONS

Article 1: Abbreviated Expressions

Article 2: Applicability of Other Protection Accorded by Laws of Contracting Parties and by Certain International Treaties

#### CHAPTER I: INTERNATIONAL APPLICATION AND INTERNATIONAL REGISTRATION

Article 3: Entitlement to File an International Application

Article 4: Procedure for Filing the International Application

Article 5: Contents of the International Application

Article 6: Priority

Article 7: Designation Fees

Article 8: Correction of Irregularities

Article 9: Filing Date of the International Application

Article 10: International Registration, Date of the International Registration, Publication and Confidential Copies of the International Registration

Article 11: Deferment of Publication

Article 12: Refusal

Article 13: Special Requirements Concerning Unity of Design

Article 14: Effects of the International Registration

Article 15: Invalidation

Article 16: Recording of Changes and Other Matters Concerning International Registrations

Article 17: Initial Term and Renewal of the International Registration and Duration of Protection

Article 18: Information Concerning Published International Registrations

#### CHAPTER II: ADMINISTRATIVE PROVISIONS

Article 19: Common Office of Several States

Article 20: Membership of the Hague Union

Article 21: Assembly

Article 22: International Bureau

Article 23: Finances

Article 24: Regulations

#### CHAPTER III: REVISION AND AMENDMENT

Article 25: Revision of This Act

Article 26: Amendment of Certain Articles by the Assembly

#### CHAPTER IV: FINAL PROVISIONS

Article 27: Becoming Party to This Act

Article 28: Effective Date of Ratifications and Accessions

Article 29: Prohibition of Reservations

Article 30: Declarations Made by Contracting Parties

Article 31: Applicability of the 1934 and 1960 Acts

Article 32: Denunciation of This Act

Article 33: Languages of This Act; Signature

Article 34: Depositary

#### INTRODUCTORY PROVISIONS

Article 1

Abbreviated Expressions

For the purposes of this Act:

- (i) “the Hague Agreement” means the Hague Agreement Concerning the International Deposit of Industrial Designs, henceforth renamed the Hague Agreement Concerning the International Registration of Industrial Designs;
- (ii) “this Act” means the Hague Agreement as established by the present Act;
- (iii) “Regulations” means the Regulations under this Act;
- (iv) “prescribed” means prescribed in the Regulations;
- (v) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, as revised and amended;
- (vi) “international registration” means the international registration of an industrial design effected according to this Act;
- (vii) “international application” means an application for international registration;
- (viii) “International Register” means the official collection of data concerning international registrations maintained by the International Bureau, which data this Act or the Regulations require or permit to be recorded, regardless of the medium in which such data are stored;
- (ix) “person” means a natural person or a legal entity;

- (x) “applicant” means the person in whose name an international application is filed;
- (xi) “holder” means the person in whose name an international registration is recorded in the International Register;
- (xii) “intergovernmental organization” means an intergovernmental organization eligible to become party to this Act in accordance with Article 27(1)(ii);
- (xiii) “Contracting Party” means any State or intergovernmental organization party to this Act;
- (xiv) “applicant’s Contracting Party” means the Contracting Party or one of the Contracting Parties from which the applicant derives its entitlement to file an international application by virtue of satisfying, in relation to that Contracting Party, at least one of the conditions specified in Article 3; where there are two or more Contracting Parties from which the applicant may, under Article 3, derive its entitlement to file an international application, “applicant’s Contracting Party” means the one which, among those Contracting Parties, is indicated as such in the international application;
- (xv) “territory of a Contracting Party” means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituent treaty of that intergovernmental organization applies;
- (xvi) “Office” means the agency entrusted by a Contracting Party with the grant of protection for industrial designs with effect in the territory of that Contracting Party;
- (xvii) “Examining Office” means an Office which ex officio examines applications filed with it for the protection of industrial designs at least to determine whether the industrial designs satisfy the condition of novelty;
- (xviii) “designation” means a request that an international registration have effect in a Contracting Party; it also means the recording, in the International Register, of that request;
- (xix) “designated Contracting Party” and “designated Office” means the Contracting Party and the Office of the Contracting Party, respectively, to which a designation applies;
- (xx) “1934 Act” means the Act signed at London on June 2, 1934, of the Hague Agreement;
- (xxi) “1960 Act” means the Act signed at The Hague on November 28, 1960, of the Hague Agreement;
- (xxii) “1961 Additional Act” means the Act signed at Monaco on November 18, 1961, additional to the 1934 Act;
- (xxiii) “Complementary Act of 1967” means the Complementary Act signed at Stockholm on July 14, 1967, as amended, of the Hague Agreement;

(xxiv) “Union” means the Hague Union established by the Hague Agreement of November 6, 1925, and maintained by the 1934 and 1960 Acts, the 1961 Additional Act, the Complementary Act of 1967 and this Act;

(xxv) “Assembly” means the Assembly referred to in Article 21(1)(a) or any body replacing that Assembly;

(xxvi) “Organization” means the World Intellectual Property Organization;

(xxvii) “Director General” means the Director General of the Organization;

(xxviii) “International Bureau” means the International Bureau of the Organization;

(xxix) “instrument of ratification” shall be construed as including instruments of acceptance or approval.

## Article 2

### Applicability of Other Protection Accorded by Laws of Contracting Parties and by Certain International Treaties

(1) [Laws of Contracting Parties and Certain International Treaties] The provisions of this Act shall not affect the application of any greater protection which may be accorded by the law of a Contracting Party, nor shall they affect in any way the protection accorded to works of art and works of applied art by international copyright treaties and conventions, or the protection accorded to industrial designs under the Agreement on Trade-Related Aspects of Intellectual Property Rights annexed to the Agreement Establishing the World Trade Organization.

(2) [Obligation to Comply with the Paris Convention] Each Contracting Party shall comply with the provisions of the Paris Convention which concern industrial designs.

## CHAPTER I

### INTERNATIONAL APPLICATION AND INTERNATIONAL REGISTRATION

## Article 3

### Entitlement to File an International Application

Any person that is a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, or that has a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application.

## Article 4

### Procedure for Filing the International Application

(1) [Direct or Indirect Filing] (a) The international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant’s Contracting Party.

(b) Notwithstanding subparagraph (a), any Contracting Party may, in a declaration, notify the Director General that international applications may not be filed through its Office.

(2) [Transmittal Fee in Case of Indirect Filing] The Office of any Contracting Party may require that the applicant pay a transmittal fee to it, for its own benefit, in respect of any international application filed through it.

## Article 5

### Contents of the International Application

(1) [Mandatory Contents of the International Application] The international application shall be in the prescribed language or one of the prescribed languages and shall contain or be accompanied by

- (i) a request for international registration under this Act;
- (ii) the prescribed data concerning the applicant;
- (iii) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with paragraph (5), the international application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design;
- (iv) an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, as prescribed;
- (v) an indication of the designated Contracting Parties;
- (vi) the prescribed fees;
- (vii) any other prescribed particulars.

(2) [Additional Mandatory Contents of the International Application] (a) Any Contracting Party whose Office is an Examining Office and whose law, at the time it becomes party to this Act, requires that an application for the grant of protection to an industrial design contain any of the elements specified in subparagraph (b) in order for that application to be accorded a filing date under that law may, in a declaration, notify the Director General of those elements.

(b) The elements that may be notified pursuant to subparagraph (a) are the following:

- (i) indications concerning the identity of the creator of the industrial design that is the subject of that application;
- (ii) a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application;
- (iii) a claim.

(c) Where the international application contains the designation of a Contracting Party that has made a notification under subparagraph (a), it shall also contain, in the prescribed manner, any element that was the subject of that notification.

(3) [Other Possible Contents of the International Application] The international application may contain or be accompanied by such other elements as are specified in the Regulations.

(4) [Several Industrial Designs in the Same International Application] Subject to such conditions as may be prescribed, an international application may include two or more industrial designs.

(5) [Request for Deferred Publication] The international application may contain a request for deferment of publication.

## Article 6

### Priority

(1) [Claiming of Priority] (a) The international application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.

(b) The Regulations may provide that the declaration referred to in subparagraph (a) may be made after the filing of the international application. In such case, the Regulations shall prescribe the latest time by which such declaration may be made.

(2) [International Application Serving as a Basis for Claiming Priority] The international application shall, as from its filing date and whatever may be its subsequent fate, be equivalent to a regular filing within the meaning of Article 4 of the Paris Convention.

## Article 7

### Designation Fees

(1) [Prescribed Designation Fee] The prescribed fees shall include, subject to paragraph (2), a designation fee for each designated Contracting Party.

(2)<sup>19</sup>[Individual Designation Fee] Any Contracting Party whose Office is an Examining Office and any Contracting Party that is an intergovernmental organization may, in a

---

<sup>19</sup> [WIPO Note]: Recommendation adopted by the Assembly of the Hague Union: "Contracting Parties that make, or that have made, a declaration under Article 7(2) of the 1999 Act or under Rule 36(1) of the Common Regulations are encouraged to indicate, in that declaration or in a new declaration, that for international applications filed by applicants whose sole entitlement is a connection with a Least Developed Country, in accordance with the list established by the United Nations, or with an intergovernmental organization the majority of whose member States are Least Developed Countries, the individual fee payable with respect to their designation is reduced to 10% of the fixed amount (rounded, where appropriate, to the nearest full figure). Those Contracting Parties are further encouraged to indicate that the reduction also applies in respect

declaration, notify the Director General that, in connection with any international application in which it is designated, and in connection with the renewal of any international registration resulting from such an international application, the prescribed designation fee referred to in paragraph (1) shall be replaced by an individual designation fee, whose amount shall be indicated in the declaration and can be changed in further declarations. The said amount may be fixed by the said Contracting Party for the initial term of protection and for each term of renewal or for the maximum period of protection allowed by the Contracting Party concerned. However, it may not be higher than the equivalent of the amount which the Office of that Contracting Party would be entitled to receive from an applicant for a grant of protection for an equivalent period to the same number of industrial designs, that amount being diminished by the savings resulting from the international procedure.

(3) [Transfer of Designation Fees] The designation fees referred to in paragraphs (1) and (2) shall be transferred by the International Bureau to the Contracting Parties in respect of which those fees were paid.

## Article 8

### Correction of Irregularities

(1) [Examination of the International Application] If the International Bureau finds that the international application does not, at the time of its receipt by the International Bureau, fulfill the requirements of this Act and the Regulations, it shall invite the applicant to make the required corrections within the prescribed time limit.

(2) [Irregularities Not Corrected] (a) If the applicant does not comply with the invitation within the prescribed time limit, the international application shall, subject to subparagraph (b), be considered abandoned.

(b) In the case of an irregularity which relates to Article 5(2) or to a special requirement notified to the Director General by a Contracting Party in accordance with the Regulations, if the applicant does not comply with the invitation within the prescribed time limit, the international application shall be deemed not to contain the designation of that Contracting Party.

## Article 9

### Filing Date of the International Application

---

of an international application filed by an applicant whose entitlement is not solely a connection with such an intergovernmental organization, provided that any other entitlement of the applicant is a connection with a Contracting Party which is a Least Developed Country or, if not a Least Developed Country, is a member State of that intergovernmental organization and the international application is governed exclusively by the 1999 Act.”

(1) [International Application Filed Directly] Where the international application is filed directly with the International Bureau, the filing date shall, subject to paragraph (3), be the date on which the International Bureau receives the international application.

(2) [International Application Filed Indirectly] Where the international application is filed through the Office of the applicant's Contracting Party, the filing date shall be determined as prescribed.

(3) [International Application with Certain Irregularities] Where the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau.

#### Article 10

#### International Registration, Date of the International Registration, Publication and Confidential Copies of the International Registration

(1) [International Registration] The International Bureau shall register each industrial design that is the subject of an international application immediately upon receipt by it of the international application or, where corrections are invited under Article 8, immediately upon receipt of the required corrections. The registration shall be effected whether or not publication is deferred under Article 11.

(2) [Date of the International Registration] (a) Subject to subparagraph (b), the date of the international registration shall be the filing date of the international application. (b) Where the international application has, on the date on which it is received by the International Bureau, an irregularity which relates to Article 5(2), the date of the international registration shall be the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.

(3) [Publication] (a) The international registration shall be published by the International Bureau. Such publication shall be deemed in all Contracting Parties to be sufficient publicity, and no other publicity may be required of the holder.

(b) The International Bureau shall send a copy of the publication of the international registration to each designated Office.

(4) [Maintenance of Confidentiality Before Publication] Subject to paragraph (5) and Article 11(4)(b), the International Bureau shall keep in confidence each international application and each international registration until publication.

(5) [Confidential Copies] (a) The International Bureau shall, immediately after registration has been effected, send a copy of the international registration, along with any relevant statement, document or specimen accompanying the international application, to each Office that has notified the International Bureau that it wishes to receive such a copy and has been designated in the international application.

(b) The Office shall, until publication of the international registration by the International Bureau, keep in confidence each international registration of which a copy has been sent to it by the International Bureau and may use the said copy only for the purpose of the examination of the international registration and of applications for the protection of industrial designs filed in or for the Contracting Party for which the Office is competent. In particular, it may not divulge the contents of any such international registration to any person outside the Office other than the holder of that international registration, except for the purposes of an administrative or legal proceeding involving a conflict over entitlement to file the international application on which the international registration is based. In the case of such an administrative or legal proceeding, the contents of the international registration may only be disclosed in confidence to the parties involved in the proceeding who shall be bound to respect the confidentiality of the disclosure.

## Article 11

### Deferment of Publication

(1) [Provisions of Laws of Contracting Parties Concerning Deferment of Publication]

(a) Where the law of a Contracting Party provides for the deferment of the publication of an industrial design for a period which is less than the prescribed period, that Contracting Party shall, in a declaration, notify the Director General of the allowable period of deferment.

(b) Where the law of a Contracting Party does not provide for the deferment of the publication of an industrial design, the Contracting Party shall, in a declaration, notify the Director General of that fact.

(2) [Deferment of Publication] Where the international application contains a request for deferment of publication, the publication shall take place,

(i) where none of the Contracting Parties designated in the international application has made a declaration under paragraph (1), at the expiry of the prescribed period or,

(ii) where any of the Contracting Parties designated in the international application has made a declaration under paragraph (1)(a), at the expiry of the period notified in such declaration or, where there is more than one such designated Contracting Party, at the expiry of the shortest period notified in their declarations.

(3) [Treatment of Requests for Deferment Where Deferment Is Not Possible Under Applicable Law] Where deferment of publication has been requested and any of the Contracting Parties designated in the international application has made a declaration under paragraph (1)(b) that deferment of publication is not possible under its law,

(i) subject to item (ii), the International Bureau shall notify the applicant accordingly; if, within the prescribed period, the applicant does not, by notice in writing to the International Bureau, withdraw the designation of the said Contracting Party, the International Bureau shall disregard the request for deferment of publication;

(ii) where, instead of containing reproductions of the industrial design, the international application was accompanied by specimens of the industrial design, the International Bureau shall disregard the designation of the said Contracting Party and shall notify the applicant accordingly.

(4) [Request for Earlier Publication or for Special Access to the International Registration] (a) At any time during the period of deferment applicable under paragraph (2), the holder may request publication of any or all of the industrial designs that are the subject of the international registration, in which case the period of deferment in respect of such industrial design or designs shall be considered to have expired on the date of receipt of such request by the International Bureau.

(b) The holder may also, at any time during the period of deferment applicable under paragraph (2), request the International Bureau to provide a third party specified by the holder with an extract from, or to allow such a party access to, any or all of the industrial designs that are the subject of the international registration.

(5) [Renunciation and Limitation] (a) If, at any time during the period of deferment applicable under paragraph (2), the holder renounces the international registration in respect of all the designated Contracting Parties, the industrial design or designs that are the subject of the international registration shall not be published.

(b) If, at any time during the period of deferment applicable under paragraph (2), the holder limits the international registration, in respect of all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration, the other industrial design or designs that are the subject of the international registration shall not be published.

(6) [Publication and Furnishing of Reproductions] (a) At the expiration of any period of deferment applicable under the provisions of this Article, the International Bureau shall, subject to the payment of the prescribed fees, publish the international registration. If such

fees are not paid as prescribed, the international registration shall be canceled and publication shall not take place.

(b) Where the international application was accompanied by one or more specimens of the industrial design in accordance with Article 5(1)(iii), the holder shall submit the prescribed number of copies of a reproduction of each industrial design that is the subject of that application to the International Bureau within the prescribed time limit. To the extent that the holder does not do so, the international registration shall be canceled and publication shall not take place.

## Article 12

### Refusal

(1) [Right to Refuse] The Office of any designated Contracting Party may, where the conditions for the grant of protection under the law of that Contracting Party are not met in respect of any or all of the industrial designs that are the subject of an international registration, refuse the effects, in part or in whole, of the international registration in the territory of the said Contracting Party, provided that no Office may refuse the effects, in part or in whole, of any international registration on the ground that requirements relating to the form or contents of the international application that are provided for in this Act or the Regulations or are additional to, or different from, those requirements have not been satisfied under the law of the Contracting Party concerned.

(2) [Notification of Refusal] (a) The refusal of the effects of an international registration shall be communicated by the Office to the International Bureau in a notification of refusal within the prescribed period.

(b) Any notification of refusal shall state all the grounds on which the refusal is based.

(3) [Transmission of Notification of Refusal; Remedies] (a) The International Bureau shall, without delay, transmit a copy of the notification of refusal to the holder.

(b) The holder shall enjoy the same remedies as if any industrial design that is the subject of the international registration had been the subject of an application for the grant of protection under the law applicable to the Office that communicated the refusal. Such remedies shall at least consist of the possibility of a re-examination or a review of the refusal or an appeal against the refusal.

(4) [Withdrawal of Refusal] Any refusal may be withdrawn, in part or in whole, at any time by the Office that communicated it.

## Article 13

### Special Requirements Concerning Unity of Design

(1) [Notification of Special Requirements] Any Contracting Party whose law, at the time it becomes party to this Act, requires that designs that are the subject of the same application conform to a requirement of unity of design, unity of production or unity of use, or belong to the same set or composition of items, or that only one independent and distinct design may be claimed in a single application, may, in a declaration, notify the Director General accordingly. However, no such declaration shall affect the right of an applicant to include two or more industrial designs in an international application in accordance with Article 5(4), even if the application designates the Contracting Party that has made the declaration.

(2) [Effect of Declaration] Any such declaration shall enable the Office of the Contracting Party that has made it to refuse the effects of the international registration pursuant to Article 12(1) pending compliance with the requirement notified by that Contracting Party.

(3) [Further Fees Payable on Division of Registration] Where, following a notification of refusal in accordance with paragraph (2), an international registration is divided before the Office concerned in order to overcome a ground of refusal stated in the notification, that Office shall be entitled to charge a fee in respect of each additional international application that would have been necessary in order to avoid that ground of refusal.

#### Article 14

##### Effects of the International Registration

(1) [Effect as Application Under Applicable Law] The international registration shall, from the date of the international registration, have at least the same effect in each designated Contracting Party as a regularly-filed application for the grant of protection of the industrial design under the law of that Contracting Party.

(2) [Effect as Grant of Protection Under Applicable Law] (a) In each designated Contracting Party the Office of which has not communicated a refusal in accordance with Article 12, the international registration shall have the same effect as a grant of protection for the industrial design under the law of that Contracting Party at the latest from the date of expiration of the period allowed for it to communicate a refusal or, where a Contracting Party has made a corresponding declaration under the Regulations, at the latest at the time specified in that declaration.

(b) Where the Office of a designated Contracting Party has communicated a refusal and has subsequently withdrawn, in part or in whole, that refusal, the international registration shall, to the extent that the refusal is withdrawn, have the same effect in that Contracting Party as a grant of protection for the industrial design under the law of the said Contracting Party at the latest from the date on which the refusal was withdrawn.

(c) The effect given to the international registration under this paragraph shall apply to the industrial design or designs that are the subject of that registration as received from the International Bureau by the designated Office or, where applicable, as amended in the procedure before that Office.

(3) [Declaration Concerning Effect of Designation of Applicant's Contracting Party]

(a) Any Contracting Party whose Office is an Examining Office may, in a declaration, notify the Director General that, where it is the applicant's Contracting Party, the designation of that Contracting Party in an international registration shall have no effect.

(b) Where a Contracting Party having made the declaration referred to in subparagraph (a) is indicated in an international application both as the applicant's Contracting Party and as a designated Contracting Party, the International Bureau shall disregard the designation of that Contracting Party.

## Article 15

### Invalidation

(1) [Requirement of Opportunity of Defense] Invalidation, by the competent authorities of a designated Contracting Party, of the effects, in part or in whole, in the territory of that Contracting Party, of the international registration may not be pronounced without the holder having, in good time, been afforded the opportunity of defending his rights.

(2) [Notification of Invalidation] The Office of the Contracting Party in whose territory the effects of the international registration have been invalidated shall, where it is aware of the invalidation, notify it to the International Bureau.

## Article 16

### Recording of Changes and Other Matters

#### Concerning International Registrations

(1) [Recording of Changes and Other Matters] The International Bureau shall, as prescribed, record in the International Register

(i) any change in ownership of the international registration, in respect of any or all of the designated Contracting Parties and in respect of any or all of the industrial designs that are the subject of the international registration, provided that the new owner is entitled to file an international application under Article 3,

(ii) any change in the name or address of the holder,

(iii) the appointment of a representative of the applicant or holder and any other relevant fact concerning such representative,

(iv) any renunciation, by the holder, of the international registration, in respect of any or all of the designated Contracting Parties,

(v) any limitation, by the holder, of the international registration, in respect of any or all of the designated Contracting Parties, to one or some of the industrial designs that are the subject of the international registration,

(vi) any invalidation, by the competent authorities of a designated Contracting Party, of the effects, in the territory of that Contracting Party, of the international registration in respect of any or all of the industrial designs that are the subject of the international registration,

(vii) any other relevant fact, identified in the Regulations, concerning the rights in any or all of the industrial designs that are the subject of the international registration.

(2) [Effect of Recording in International Register] Any recording referred to in items (i), (ii), (iv), (v), (vi) and (vii) of paragraph (1) shall have the same effect as if it had been made in the Register of the Office of each of the Contracting Parties concerned, except that a Contracting Party may, in a declaration, notify the Director General that a recording referred to in item (i) of paragraph (1) shall not have that effect in that Contracting Party until the Office of that Contracting Party has received the statements or documents specified in that declaration.

(3) [Fees] Any recording made under paragraph (1) may be subject to the payment of a fee.

(4) [Publication] The International Bureau shall publish a notice concerning any recording made under paragraph (1). It shall send a copy of the publication of the notice to the Office of each of the Contracting Parties concerned.

## Article 17

### Initial Term and Renewal of the International Registration and Duration of Protection

(1) [Initial Term of the International Registration] The international registration shall be effected for an initial term of five years counted from the date of the international registration.

(2) [Renewal of the International Registration] The international registration may be renewed for additional terms of five years, in accordance with the prescribed procedure and subject to the payment of the prescribed fees.

(3) [Duration of Protection in Designated Contracting Parties] (a) Provided that the international registration is renewed, and subject to subparagraph (b), the duration of protection shall, in each of the designated Contracting Parties, be 15 years counted from the date of the international registration.

(b) Where the law of a designated Contracting Party provides for a duration of protection of more than 15 years for an industrial design for which protection has been granted under that

law, the duration of protection shall, provided that the international registration is renewed, be the same as that provided for by the law of that Contracting Party.

(c) Each Contracting Party shall, in a declaration, notify the Director General of the maximum duration of protection provided for by its law.

(4) [Possibility of Limited Renewal] The renewal of the international registration may be effected for any or all of the designated Contracting Parties and for any or all of the industrial designs that are the subject of the international registration.

(5) [Recording and Publication of Renewal] The International Bureau shall record renewals in the International Register and publish a notice to that effect. It shall send a copy of the publication of the notice to the Office of each of the Contracting Parties concerned.

## Article 18

### Information Concerning Published International Registrations

(1) [Access to Information] The International Bureau shall supply to any person applying therefor, upon the payment of the prescribed fee, extracts from the International Register, or information concerning the contents of the International Register, in respect of any published international registration.

(2) [Exemption from Legalization] Extracts from the International Register supplied by the International Bureau shall be exempt from any requirement of legalization in each Contracting Party.

## CHAPTER II

### ADMINISTRATIVE PROVISIONS

## Article 19

### Common Office of Several States

(1) [Notification of Common Office] If several States intending to become party to this Act have effected, or if several States party to this Act agree to effect, the unification of their domestic legislation on industrial designs, they may notify the Director General

(i) that a common Office shall be substituted for the national Office of each of them, and

(ii) that the whole of their respective territories to which the unified legislation applies shall be deemed to be a single Contracting Party for the purposes of the application of Articles 1, 3 to 18 and 31 of this Act.

(2) [Time at Which Notification Is to Be Made] The notification referred to in paragraph (1) shall be made,

(i) in the case of States intending to become party to this Act, at the time of the deposit of the instruments referred to in Article 27(2);

(ii) in the case of States party to this Act, at any time after the unification of their domestic legislation has been effected.

(3) [Date of Entry into Effect of the Notification] The notification referred to in paragraphs (1) and (2) shall take effect,

(i) in the case of States intending to become party to this Act, at the time such States become bound by this Act;

(ii) in the case of States party to this Act, three months after the date of the communication thereof by the Director General to the other Contracting Parties or at any later date indicated in the notification.

## Article 20

### Membership of the Hague Union

The Contracting Parties shall be members of the same Union as the States party to the 1934 Act or the 1960 Act.

## Article 21

### Assembly

(1) [Composition] (a) The Contracting Parties shall be members of the same Assembly as the States bound by Article 2 of the Complementary Act of 1967.

(b) Each member of the Assembly shall be represented in the Assembly by one delegate, who may be assisted by alternate delegates, advisors and experts, and each delegate may represent only one Contracting Party.

(c) Members of the Union that are not members of the Assembly shall be admitted to the meetings of the Assembly as observers.

(2) [Tasks] (a) The Assembly shall

(i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Act;

(ii) exercise such rights and perform such tasks as are specifically conferred upon it or assigned to it under this Act or the Complementary Act of 1967;

(iii) give directions to the Director General concerning the preparations for conferences of revision and decide the convocation of any such conference;

(iv) amend the Regulations;

(v) review and approve the reports and activities of the Director General concerning the Union, and give the Director General all necessary instructions concerning matters within the competence of the Union;

(vi) determine the program and adopt the biennial budget of the Union, and approve its final accounts;

(vii) adopt the financial regulations of the Union;

(viii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;

(ix) subject to paragraph (1)(c), determine which States, intergovernmental organizations and non-governmental organizations shall be admitted to its meetings as observers;

(x) take any other appropriate action to further the objectives of the Union and perform any other functions as are appropriate under this Act.

(b) With respect to matters which are also of interest to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) [Quorum] (a) One-half of the members of the Assembly which are States and have the right to vote on a given matter shall constitute a quorum for the purposes of the vote on that matter.

(b) Notwithstanding the provisions of subparagraph (a), if, in any session, the number of the members of the Assembly which are States, have the right to vote on a given matter and are represented is less than one-half but equal to or more than one-third of the members of the Assembly which are States and have the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly which are States, have the right to vote on the said matter and were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(4) [Taking Decisions in the Assembly] (a) The Assembly shall endeavor to take its decisions by consensus.

(b) Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such a case,

(i) each Contracting Party that is a State shall have one vote and shall vote only in its own name, and

(ii) any Contracting Party that is an intergovernmental organization may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Act, and no such intergovernmental organization shall participate in the vote if any one of its Member States exercises its right to vote, and vice versa.

(c) On matters concerning only States that are bound by Article 2 of the Complementary Act of 1967, Contracting Parties that are not bound by the said Article shall not have the right to vote, whereas, on matters concerning only Contracting Parties, only the latter shall have the right to vote.

(5) [Majorities] (a) Subject to Articles 24(2) and 26(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(b) Abstentions shall not be considered as votes.

(6) [Sessions] (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, either at the request of one-fourth of the members of the Assembly or on the Director General's own initiative.

(c) The agenda of each session shall be prepared by the Director General.

(7) [Rules of Procedure] The Assembly shall adopt its own rules of procedure.

## Article 22

### International Bureau

(1) [Administrative Tasks] (a) International registration and related duties, as well as all other administrative tasks concerning the Union, shall be performed by the International Bureau.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may be established by the Assembly.

(2) [Director General] The Director General shall be the chief executive of the Union and shall represent the Union.

(3) [Meetings Other than Sessions of the Assembly] The Director General shall convene any committee and working group established by the Assembly and all other meetings dealing with matters of concern to the Union.

(4) [Role of the International Bureau in the Assembly and Other Meetings] (a) The Director General and persons designated by the Director General shall participate, without the right to

vote, in all meetings of the Assembly, the committees and working groups established by the Assembly, and any other meetings convened by the Director General under the aegis of the Union.

(b) The Director General or a staff member designated by the Director General shall be ex officio secretary of the Assembly, and of the committees, working groups and other meetings referred to in subparagraph (a).

(5) [Conferences] (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for any revision conferences.

(b) The International Bureau may consult with intergovernmental organizations and international and national non-governmental organizations concerning the said preparations.

(c) The Director General and persons designated by the Director General shall take part, without the right to vote, in the discussions at revision conferences.

(6) [Other Tasks] The International Bureau shall carry out any other tasks assigned to it in relation to this Act.

## Article 23

### Finances

(1) [Budget] (a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union and its contribution to the budget of expenses common to the Unions administered by the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered to be expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) [Coordination with Budgets of Other Unions] The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) [Sources of Financing of the Budget] The budget of the Union shall be financed from the following sources:

(i) fees relating to international registrations;

(ii) charges due for other services rendered by the International Bureau in relation to the Union;

(iii) sale of, or royalties on, the publications of the International Bureau concerning the Union;

(iv) gifts, bequests and subventions;

(v) rents, interests and other miscellaneous income.

(4) [Fixing of Fees and Charges; Level of the Budget] (a) The amounts of the fees referred to in paragraph (3)(i) shall be fixed by the Assembly on the proposal of the Director General. Charges referred to in paragraph 3(ii) shall be established by the Director General and shall be provisionally applied subject to approval by the Assembly at its next session.

(b) The amounts of the fees referred to in paragraph (3)(i) shall be so fixed that the revenues of the Union from fees and other sources shall be at least sufficient to cover all the expenses of the International Bureau concerning the Union.

(c) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) [Working Capital Fund] The Union shall have a working capital fund which shall be constituted by the excess receipts and, if such excess does not suffice, by a single payment made by each member of the Union. If the fund becomes insufficient, the Assembly shall decide to increase it. The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General.

te on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such State shall grant advances. The amount of those advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such State and the Organization.

(b) The State referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(7) [Auditing of Accounts] The auditing of the accounts shall be effected by one or more of the States members of the Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

## Article 24

### Regulations

(1) [Subject Matter] The Regulations shall govern the details of the implementation of this Act. They shall, in particular, include provisions concerning

(i) matters which this Act expressly provides are to be prescribed;

(ii) further details concerning, or any details useful in the implementation of, the provisions of this Act;

(iii) any administrative requirements, matters or procedures.

(2) [Amendment of Certain Provisions of the Regulations] (a) The Regulations may specify that certain provisions of the Regulations may be amended only by unanimity or only by a four-fifths majority.

(b) In order for the requirement of unanimity or a four-fifths majority no longer to apply in the future to the amendment of a provision of the Regulations, unanimity shall be required.

(c) In order for the requirement of unanimity or a four-fifths majority to apply in the future to the amendment of a provision of the Regulations, a four-fifths majority shall be required.

(3) [Conflict Between This Act and the Regulations] In the case of conflict between the provisions of this Act and those of the Regulations, the former shall prevail.

## CHAPTER III

### REVISION AND AMENDMENT

#### Article 25

##### Revision of This Act

(1) [Revision Conferences] This Act may be revised by a conference of the Contracting Parties.

(2) [Revision or Amendment of Certain Articles] Articles 21, 22, 23 and 26 may be amended either by a revision conference or by the Assembly according to the provisions of Article 26.

#### Article 26

##### Amendment of Certain Articles by the Assembly

(1) [Proposals for Amendment] (a) Proposals for the amendment by the Assembly of Articles 21, 22, 23 and this Article may be initiated by any Contracting Party or by the Director General.

(b) Such proposals shall be communicated by the Director General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(2) [Majorities] Adoption of any amendment to the Articles referred to in paragraph (1) shall require a three-fourths majority, except that adoption of any amendment to Article 21 or to the present paragraph shall require a four-fifths majority.

(3) [Entry into Force] (a) Except where subparagraph (b) applies, any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of those Contracting Parties which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on that amendment.

(b) Any amendment to Article 21(3) or (4) or to this subparagraph shall not enter into force if, within six months of its adoption by the Assembly, any Contracting Party notifies the Director General that it does not accept such amendment.

(c) Any amendment which enters into force in accordance with the provisions of this paragraph shall bind all the States and intergovernmental organizations which are Contracting Parties at the time the amendment enters into force, or which become Contracting Parties at a subsequent date.

#### CHAPTER IV

#### FINAL PROVISIONS

##### Article 27

##### Becoming Party to This Act

(1) [Eligibility] Subject to paragraphs (2) and (3) and Article 28,

- (i) any State member of the Organization may sign and become party to this Act;
- (ii) any intergovernmental organization which maintains an Office in which protection of industrial designs may be obtained with effect in the territory in which the constituting treaty of the intergovernmental organization applies may sign and become party to this Act, provided that at least one of the member States of the intergovernmental organization is a member of the Organization and provided that such Office is not the subject of a notification under Article 19.

(2) [Ratification or Accession] Any State or intergovernmental organization referred to in paragraph (1) may deposit

- (i) an instrument of ratification if it has signed this Act, or
- (ii) an instrument of accession if it has not signed this Act.

(3) [Effective Date of Deposit] (a) Subject to subparagraphs (b) to (d), the effective date of the deposit of an instrument of ratification or accession shall be the date on which that instrument is deposited.

(b) The effective date of the deposit of the instrument of ratification or accession of any State in respect of which protection of industrial designs may be obtained only through the Office maintained by an intergovernmental organization of which that State is a member shall be the date on which the instrument of that intergovernmental organization is deposited if that date is later than the date on which the instrument of the said State has been deposited.

(c) The effective date of the deposit of any instrument of ratification or accession containing or accompanied by the notification referred to in Article 19 shall be the date on which the last

of the instruments of the States members of the group of States having made the said notification is deposited.

(d) Any instrument of ratification or accession of a State may contain or be accompanied by a declaration making it a condition to its being considered as deposited that the instrument of one other State or one intergovernmental organization, or the instruments of two other States, or the instruments of one other State and one intergovernmental organization, specified by name and eligible to become party to this Act, is or are also deposited. The instrument containing or accompanied by such a declaration shall be considered to have been deposited on the day on which the condition indicated in the declaration is fulfilled. However, when an instrument specified in the declaration itself contains, or is itself accompanied by, a declaration of the said kind, that instrument shall be considered as deposited on the day on which the condition specified in the latter declaration is fulfilled.

(e) Any declaration made under subparagraph (d) may be withdrawn, in its entirety or in part, at any time. Any such withdrawal shall become effective on the date on which the notification of withdrawal is received by the Director General.

## Article 28

### Effective Date of Ratifications and Accessions

(1) [Instruments to Be Taken into Consideration] For the purposes of this Article, only instruments of ratification or accession that are deposited by States or intergovernmental organizations referred to in Article 27(1) and that have an effective date according to Article 27(3) shall be taken into consideration.

(2) [Entry into Force of This Act] This Act shall enter into force three months after six States have deposited their instruments of ratification or accession, provided that, according to the most recent annual statistics collected by the International Bureau, at least three of those States fulfill at least one of the following conditions:

(i) at least 3,000 applications for the protection of industrial designs have been filed in or for the State concerned, or

(ii) at least 1,000 applications for the protection of industrial designs have been filed in or for the State concerned by residents of States other than that State.

(3) [Entry into Force of Ratifications and Accessions] (a) Any State or intergovernmental organization that has deposited its instrument of ratification or accession three months or more before the date of entry into force of this Act shall become bound by this Act on the date of entry into force of this Act.

(b) Any other State or intergovernmental organization shall become bound by this Act three months after the date on which it has deposited its instrument of ratification or accession or at any later date indicated in that instrument.

#### Article 29

##### Prohibition of Reservations

No reservations to this Act are permitted.

#### Article 30

##### Declarations Made by Contracting Parties

(1) [Time at Which Declarations May Be Made] Any declaration under Articles 4(1)(b), 5(2)(a), 7(2), 11(1), 13(1), 14(3), 16(2) or 17(3)(c) may be made

(i) at the time of the deposit of an instrument referred to in Article 27(2), in which case it shall become effective on the date on which the State or intergovernmental organization having made the declaration becomes bound by this Act, or

(ii) after the deposit of an instrument referred to in Article 27(2), in which case it shall become effective three months after the date of its receipt by the Director General or at any later date indicated in the declaration but shall apply only in respect of any international registration whose date of international registration is the same as, or is later than, the effective date of the declaration.

(2) [Declarations by States Having a Common Office] Notwithstanding paragraph (1), any declaration referred to in that paragraph that has been made by a State which has, with another State or other States, notified the Director General under Article 19(1) of the substitution of a common Office for their national Offices shall become effective only if that other State or those other States makes or make a corresponding declaration or corresponding declarations.

(3) [Withdrawal of Declarations] Any declaration referred to in paragraph (1) may be withdrawn at any time by notification addressed to the Director General. Such withdrawal shall take effect three months after the date on which the Director General has received the notification or at any later date indicated in the notification. In the case of a declaration made under Article 7(2), the withdrawal shall not affect international applications filed prior to the coming into effect of the said withdrawal.

#### Article 31

##### Applicability of the 1934 and 1960 Acts

(1) [Relations Between States Party to Both This Act and the 1934 or 1960 Acts] This Act alone shall be applicable as regards the mutual relations of States party to both this Act and the 1934 Act or the 1960 Act. However, such States shall, in their mutual relations, apply the

1934 Act or the 1960 Act, as the case may be, to industrial designs deposited at the International Bureau prior to the date on which this Act becomes applicable as regards their mutual relations.

(2) [Relations Between States Party to Both This Act and the 1934 or 1960 Acts and States Party to the 1934 or 1960 Acts Without Being Party to This Act] (a) Any State that is party to both this Act and the 1934 Act shall continue to apply the 1934 Act in its relations with States that are party to the 1934 Act without being party to the 1960 Act or this Act.

(b) Any State that is party to both this Act and the 1960 Act shall continue to apply the 1960 Act in its relations with States that are party to the 1960 Act without being party to this Act.

#### Article 32

##### Denunciation of This Act

(1) [Notification] Any Contracting Party may denounce this Act by notification addressed to the Director General.

(2) [Effective Date] Denunciation shall take effect one year after the date on which the Director General has received the notification or at any later date indicated in the notification. It shall not affect the application of this Act to any international application pending and any international registration in force in respect of the denouncing Contracting Party at the time of the coming into effect of the denunciation.

#### Article 33

##### Languages of This Act; Signature

(1) [Original Texts; Official Texts] (a) This Act shall be signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally authentic.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) [Time Limit for Signature] This Act shall remain open for signature at the headquarters of the Organization for one year after its adoption.

#### Article 34

##### Depositary

The Director General shall be the depositary of this Act.

**6.2. Uruguay Round of Multilateral Trade Negotiations (1986- 1994) - Annex 1  
- Annex 1C - Agreement on Trade-Related Aspects of Intellectual Property  
Rights (WTO) WTO<sup>20</sup>**

AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY  
RIGHTS

MEMBERS,

DESIRING to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade;

RECOGNIZING to this end, the need for new rules and disciplines concerning:

the applicability of the basic principles of GATT 1994 and of relevant international intellectual property agreements or conventions;

the provision of adequate standards and principles concerning the availability, scope and use of trade-related intellectual property rights;

the provision of effective and appropriate means for the enforcement of trade-related intellectual property rights, taking into account differences in national legal systems;

the provision of effective and expeditious procedures for the multilateral prevention and settlement of disputes between governments; and

transitional arrangements aiming at the fullest participation in the results of the negotiations;

RECOGNIZING the need for a multilateral framework of principles, rules and disciplines dealing with international trade in counterfeit goods;

RECOGNIZING that intellectual property rights are private rights;

RECOGNIZING the underlying public policy objectives of national systems for the protection of intellectual property, including developmental and technological objectives;

RECOGNIZING also the special needs of the least-developed country Members in respect of maximum flexibility in the domestic implementation of laws and regulations in order to enable them to create a sound and viable technological base;

---

<sup>20</sup> *Official Journal L 336* , 23/12/1994 P. 0214 – 0233 *Finnish special edition: Chapter 11 Volume 38 P. 0216 Swedish special edition: Chapter 11 Volume 38 P. 0216*

EMPHASIZING the importance of reducing tensions by reaching strengthened commitments to resolve disputes on trade-related intellectual property issues through multilateral procedures;

DESIRING to establish a mutually supportive relationship between the WTO and the World Intellectual Property Organization (referred to in this Agreement as 'WIPO') as well as other relevant international organizations;

HEREBY AGREE AS FOLLOWS:

## PART I GENERAL PROVISIONS AND BASIC PRINCIPLES

### Article 1

#### Nature and Scope of Obligations

Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.

For the purposes of this Agreement, the term 'intellectual property' refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.

Members shall accord the treatment provided for in this Agreement to the nationals of other Members (1). In respect of the relevant intellectual property right, the nationals of other Members shall be understood as those natural or legal persons that would meet the criteria for eligibility for protection provided for in the Paris Convention (1967), the Berne Convention (1971), the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits, were all Members of the WTO members of those conventions (2). Any Member availing itself of the possibilities provided in paragraph 3 of Article 5 or paragraph 2 of Article 6 of the Rome Convention shall make a notification as foreseen in those provisions to the Council for Trade-Related Aspects of Intellectual Property Rights (the 'Council for TRIPS').

### Article 2

#### Intellectual Property Conventions

In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967).

Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.

### Article 3

#### National Treatment

Each Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection (3) of intellectual property, subject to the exceptions already provided in, respectively, the Paris Convention (1967), the Berne Convention (1971), the Rome Convention or the Treaty on Intellectual Property in Respect of Integrated Circuits. In respect of performers, producers of phonograms and broadcasting organizations, this obligation only applies in respect of the rights provided under this Agreement. Any Member availing itself of the possibilities provided in Article 6 of the Berne Convention (1971) or paragraph 1(b) of Article 16 of the Rome Convention shall make a notification as foreseen in those provisions to the Council for TRIPS.

Members may avail themselves of the exceptions permitted under paragraph 1 in relation to judicial and administrative procedures, including the designation of an address for service or the appointment of an agent within the jurisdiction of a Member, only where such exceptions are necessary to secure compliance with laws and regulations which are not inconsistent with the provisions of this Agreement and where such practices are not applied in a manner which would constitute a disguised restriction on trade.

### Article 4

#### Most-Favoured-Nation Treatment

With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members. Exempted from this obligation are any advantage, favour, privilege or immunity accorded by a Member:

deriving from international agreements on judicial assistance or law enforcement of a general nature and not particularly confined to the protection of intellectual property;

granted in accordance with the provisions of the Berne Convention (1971) or the Rome Convention authorizing that the treatment accorded be a function not of national treatment but of the treatment accorded in another country;

in respect of the rights of performers, producers of phonograms and broadcasting organizations not provided under this Agreement;

deriving from international agreements related to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement, provided that such agreements are notified to the Council for TRIPS and do not constitute an arbitrary or unjustifiable discrimination against nationals of other Members.

#### Article 5

##### Multilateral Agreements on Acquisition or Maintenance of Protection

The obligations under Articles 3 and 4 do not apply to procedures provided in multilateral agreements concluded under the auspices of WIPO relating to the acquisition or maintenance of intellectual property rights.

#### Article 6

##### Exhaustion

For the purposes of dispute settlement under this Agreement, subject to the provisions of Articles 3 and 4 nothing in this Agreement shall be used to address the issue of the exhaustion of intellectual property rights.

#### Article 7

##### Objectives

The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

#### Article 8

##### Principles

Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement.

Appropriate measures, provided that they are consistent with provisions of this Agreement, may be needed to prevent the abuse of intellectual property rights by right holders or the

resort to practices which unreasonably restraint trade or adversely affect the international transfer of technology.

## PART II STANDARDS CONCERNING THE AVAILABILITY, SCOPE AND USE OF INTELLECTUAL PROPERTY RIGHTS

### Section 1 Copyright and Related Rights

#### Article 9

##### Relation to the Berne Convention

Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6bis of that Convention or of the rights derived therefrom.

Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.

#### Article 10

##### Computer Programs and Compilations of Data

Computer programs, whether in source or object code, shall be protected as literary works under the Berne Convention (1971).

Compilations of data or other material, whether in machine-readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected as such. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself.

#### Article 11

##### Rental Rights

In respect of at least computer programs and cinematographic works, a Member shall provide authors and their successors in title the right to authorize or to prohibit the commercial rental to the public of originals or copies of their copyright works. A Member shall be excepted from this obligation in respect of cinematographic works unless such rental has led to widespread copying of such works which is materially impairing the exclusive right of reproduction conferred in that Member on authors and their successors in title. In respect of computer programs, this obligation does not apply to rentals where the program itself is not the essential object of the rental.

## Article 12

### Term of Protection

Whenever the term of protection of a work, other than a photographic work or a work of applied art, is calculated on a basis other than the life of a natural person, such term shall be no less than 50 years from the end of the calendar year of authorized publication, or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of making.

## Article 13

### Limitations and Exceptions

Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder.

## Article 14

### Protection of Performers, Producers of Phonograms (Sound Recordings) and Broadcasting Organizations

In respect of a fixation of their performance on a phonogram, performers shall have the possibility of preventing the following acts when undertaken without their authorization: the fixation of their unfixed performance and the reproduction of such fixation. Performers shall also have the possibility of preventing the following acts when undertaken without their authorization: the broadcasting by wireless means and the communication to the public of their live performance.

Producers of phonograms shall enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms.

Broadcasting organizations shall have the right to prohibit the following acts when undertaken without their authorization: the fixation, the reproduction of fixations, and the re-broadcasting by wireless means of broadcasts, as well as the communication to the public of television broadcasts of the same. Where Members do not grant such rights to broadcasting organizations, they shall provide owners of copyright in the subject matter of broadcasts with the possibility of preventing the above acts, subject to the provisions of the Berne Convention (1971).

The provisions of Article 11 in respect of computer programs shall apply *mutatis mutandis* to producers of phonograms and any other right holders in phonograms as determined in a

Member's law. If on 15 April 1994 a Member has in force a system of equitable remuneration of right holders in respect of the rental of phonograms, it may maintain such system provided that the commercial rental of phonograms is not giving rise to the material impairment of the exclusive rights of reproduction of right holders.

The term of the protection available under this Agreement to performers and producers of phonograms shall last at least until the end of a period of 50 years computed from the end of the calendar year in which the fixation was made or the performance took place. The term of protection granted pursuant to paragraph 3 shall last for at least 20 years from the end of the calendar year in which the broadcast took place.

Any Member may, in relation to the rights conferred under paragraphs 1, 2 and 3, provide for conditions, limitations, exceptions and reservations to the extent permitted by the Rome Convention. However, the provisions of Article 18 of the Berne Convention (1971) shall also apply, *mutatis mutandis*, to the rights of performers and producers of phonograms in phonograms.

## Section 2 Trademarks

### Article 15

#### Protectable Subject Matter

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).

Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filling an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.

The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.

Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

## Article 16

### Rights Conferred

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.

Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

## Article 17

### Exceptions

Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.

## Article 18

### Term of Protection

Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.

#### Article 19

##### Requirement of Use

If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use.

When subject to the control of its owner, use of a trademark by another person shall be recognized as use of the trademark for the purpose of maintaining the registration.

#### Article 20

##### Other Requirements

The use of a trademark in the course of trade shall not be justifiably encumbered by special requirements, such as use with another trademark, use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings. This will not preclude a requirement prescribing the use of the trademark identifying the undertaking producing the goods or services along with, but without linking it to, the trademark distinguishing the specific goods or services in question of that undertaking.

#### Article 21

##### Licensing and Assignment

Members may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.

#### Section 3 Geographical Indications

#### Article 22

##### Protection of Geographical Indications

Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:

the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;

any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).

A Member shall, ex officio of its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.

The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

#### Article 23

##### Additional Protection for Geographical Indications for Wines and Spirits

Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like (4).

The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, ex officio if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.

In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.

#### Article 24

##### International Negotiations; Exceptions

Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23. The provisions of paragraphs 4 through 8 below shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.

The Council for TRIPS shall keep under review the application of the provisions of this Section; the first such review shall take place within two years of the entry into force of the WTO Agreement. Any matter affecting the compliance with the obligations under these provisions may be drawn to the attention of the Council, which, at the request of a Member, shall consult with any Member or Members in respect of such matter in respect of which it has not been possible to find a satisfactory solution through bilateral or plurilateral consultations between the Members concerned. The Council shall take such action as may be agreed to facilitate the operation and further the objectives of this Section.

In implementing this Section, a Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.

Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or

services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date.

Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:

before the date of application of these provisions in that Member as defined in Part VI; or

before the geographical indication is protected in its country of origin;

measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement.

A Member may provide that any request made under this Section in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in that Member or after the date of registration of the trademark in that Member provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in that Member, provided that the geographical indication is not used or registered in bad faith.

The provisions of this Section shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.

There shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

#### Section 4 Industrial Designs

##### Article 25

## Requirements for Protection

Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.

Each Member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.

## Article 26

### Protection

The owner of a protected industrial design shall have the right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.

The duration of protection available shall amount to at least 10 years.

## Section 5 Patents

### Article 27

#### Patentable Subject Matter

Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application (5). Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.

Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.

Members may also exclude from patentability:

diagnostic, therapeutic and surgical methods for the treatment of humans or animals;

plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, Members shall provide for the protection of plant varieties either by patents or by an effective sui generis system or by any combination thereof. The provisions of this subparagraph shall be reviewed four years after the date of entry into force of the WTO Agreement.

## Article 28

### Rights Conferred

A patent shall confer on its owner the following exclusive rights:

where the subject matter of a patent is a product, to prevent third parties not having the owner's consent from the acts of: making, using, offering for sale, selling, or importing (6) for these purposes that product;

where the subject matter of a patent is a process, to prevent third parties not having the owner's consent from the act of using the process, and from the acts of: using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.

Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts.

## Article 29

### Conditions on Patent Applicants

Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known

to the inventor at the filing date or, where priority is claimed, at the priority date of the application.

Members may require an applicant for a patent to provide information concerning the applicant's corresponding foreign applications and grants.

#### Article 30

##### Exceptions to Rights Conferred

Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.

#### Article 31

##### Other Use Without Authorization of the Right Holder

Where the law of a Member allows for other use (7) of the subject matter of a patent without the authorization of the right holder, including use by the government or third parties authorized by the government, the following provisions shall be respected:

authorization of such use shall be considered on its individual merits;

such use may only be permitted if, prior to such use, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time. This requirement may be waived by a Member in the case of a national emergency or other circumstances of extreme urgency or in cases of public non-commercial use. In situations of national emergency or other circumstances of extreme urgency, the right holder shall, nevertheless, be notified as soon as reasonably practicable. In the case of public non-commercial use, where the government or contractor, without making a patent search, knows or has demonstrable grounds to know that a valid patent is or will be used by or for the government, the right holder shall be informed promptly;

the scope and duration of such use shall be limited to the purpose for which it was authorized, and in the case of semi-conductor technology shall only be for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive;

such use shall be non-exclusive;

such use shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;

any such use shall be authorized predominantly for the supply of the domestic market of the Member authorizing such use;

authorization for such use shall be liable, subject to adequate protection of the legitimate interests of the persons so authorized, to be terminated if and when the circumstances which led to it cease to exist and are unlikely to recur. The competent authority shall have the authority to review, upon motivated request, the continued existence of these circumstances;

the right holder shall be paid adequate remuneration in the circumstances of each case, taking into account the economic value of the authorization;

the legal validity of any decision relating to the authorization of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member;

any decision relating to the remuneration provided in respect of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member;

Members are not obliged to apply the conditions set forth in subparagraphs (b) and (f) where such use is permitted to remedy a practice determined after judicial or administrative process to be anti-competitive. The need to correct anti-competitive practices may be taken into account in determining the amount of remuneration in such cases. Competent authorities shall have the authority to refuse termination of authorization if and when the conditions which led to such authorization are likely to recur;

where such use is authorized to permit the exploitation of a patent ('the second patent') which cannot be exploited without infringing another patent ('the first patent'), the following additional conditions shall apply:

the invention claimed in the second patent shall involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent;

the owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent; and

the use authorized in respect of the first patent shall be non-assignable except with the assignment of the second patent.

## Article 32

### Revocation/Forfeiture

An opportunity for judicial review of any decision to revoke or forfeit a patent shall be available.

#### Article 33

##### Term of Protection

The term of protection available shall not end before the expiration of a period of twenty years counted from the filing date (8).

#### Article 34

##### Process Patents: Burden of Proof

For the purposes of civil proceedings in respect of the infringement of the rights of the owner referred to in paragraph 1(b) of Article 28, if the subject matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process. Therefore, Members shall provide, in at least one of the following circumstances, that any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process:

if the product obtained by the patent process is new;

if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

Any Member shall be free to provide that the burden of proof indicated in paragraph 1 shall be on the alleged infringer only if the condition referred to in subparagraph (a) is fulfilled or only if the condition referred to in subparagraph (b) is fulfilled.

In the adduction of proof to the contrary, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be taken into account.

#### Section 6 Layout-Designs (Topographies) of Integrated Circuits

#### Article 35

##### Relation to the IPICT Treaty

Members agree to provide protection into the layout-designs (topographies) of integrated circuits (referred to in this Agreement as 'layout-designs') in accordance with Articles 2 through 7 (other than paragraph 3 of Article 6), Article 12 and paragraph 3 of Article 16 of

the Treaty on Intellectual Property in Respect of Integrated Circuits and, in addition, to comply with the following provisions.

#### Article 36

##### Scope of the Protection

Subject to the provisions of paragraph 1 of Article 37, Members shall consider unlawful the following acts if performed without the authorization of the right holder: (9) importing, selling, or otherwise distributing for commercial purposes a protected layout-design, an integrated circuit in which protected layout-design is incorporated, or an article incorporating such an integrated circuit only in so far as it continues to contain an unlawfully reproduced layout-design.

#### Article 37

##### Acts Not Requiring the Authorization of the Right Holder

Notwithstanding Article 36, no Member shall consider unlawful the performance of any of the acts referred to in that Article in respect of an integrated circuit incorporating an unlawfully reproduced layout-design or any article incorporating such an integrated circuit where the person performing or ordering such acts did not know and had no reasonable ground to know, when acquiring the integrated circuit or article incorporating such an integrated circuit, that it incorporated an unlawfully reproduced layout-design. Members shall provide that, after the time that such person has received sufficient notice that the layout-design was unlawfully reproduced, that person may perform any of the acts with respect to the stock on hand or ordered before such time, but shall be liable to pay to the right holder a sum equivalent to a reasonable royalty such as would be payable under a freely negotiated licence in respect of such a layout-design.

The conditions set out in subparagraphs (a) through (k) of Article 31 shall apply *mutatis mutandis* in the event of any non-voluntary licensing of a layout-design or of its use by or for the government with the authorization of the right holder.

#### Article 38

##### Term of Protection

In Members requiring registration as a condition of protection, the term of protection of layout-designs shall not end before the expiration of a period of 10 years counted from the date of filing an application for registration or from the first commercial exploitation wherever in the world it occurs.

In Members not requiring registration as a condition for protection, layout-designs shall be protected for a term of no less than 10 years from the date of the first commercial exploitation wherever in the world it occurs.

Notwithstanding paragraphs 1 and 2, a Member may provide that protection shall lapse 15 years after the creation of the layout-design.

## Section 7 Protection of Undisclosed Information

### Article 39

In the course of ensuring effective protection against unfair competition as provided in Article 10bis of the Paris Convention (1967), Members shall protect undisclosed information in accordance with paragraph 2 and data submitted to governments or governmental agencies in accordance with paragraph 3.

Natural and legal persons shall have the possibility of preventing information lawfully within their control from being disclosed to, acquired by, or used by others without their consent in a manner contrary to honest commercial practices (10) so long as such information:

is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;

has commercial value because it is secret; and

has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.

Members, when requiring, as a condition of approving the marketing of pharmaceutical or of agricultural chemical products which utilize new chemical entities, the submission of undisclosed test or other data, the origination of which involves a considerable effort, shall protect such data against unfair commercial use. In addition, Members shall protect such data against disclosure, except where necessary to protect the public, or unless steps are taken to ensure that the data are protected against unfair commercial use.

## Section 8 Control of Anti-Competitive Practices in Contractual Licences

### Article 40

Members agree that some licensing practices or conditions pertaining to intellectual property rights which restrain competition may have adverse effects on trade and may impede the transfer and dissemination of technology.

Nothing in this Agreement shall prevent Members from specifying in their legislation licensing practices or conditions that may in particular cases constitute an abuse of intellectual property rights having an adverse effect on competition in the relevant market. As provided above, a Member may adopt, consistently with the other provisions of this Agreement, appropriate measures to prevent or control such practices, which may include for example exclusive grantback conditions, conditions preventing challenges to validity and coercive package licensing, in the light of the relevant laws and regulations of that Member.

Each Member shall enter, upon request, into consultations with any other Member which has cause to believe that an intellectual property right owner that is a national or domiciliary of the Member to which the request for consultations has been addressed is undertaking practices in violation of the requesting Member's laws and regulations on the subject matter of this Section, and which wishes to secure compliance with such legislation, without prejudice to any action under the law and to the full freedom of an ultimate decision of either Member. The Member addressed shall accord full and sympathetic consideration to, and shall afford adequate opportunity for, consultations with the requesting Member, and shall cooperate through supply of publicly available non-confidential information of relevance to the matter in question and of other information available to the Member, subject to domestic law and to the conclusion of mutually satisfactory agreements concerning the safeguarding of its confidentiality by the requesting Member.

A Member whose nationals or domiciliaries are subject to proceedings in another Member concerning alleged violation of that other Member's laws and regulations on the subject matter of this Section shall, upon request, be granted an opportunity for consultations by other Member under the same conditions as those foreseen in paragraph 3.

### PART III ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

#### Section 1 General Obligations

##### Article 41

Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time limits or unwarranted delays.

Decisions on the merits of a case shall preferably be in writing and reasoned. They shall be made available at least to the parties to the proceeding without undue delay. Decisions on the merits of a case shall be based only on evidence in respect of which parties were offered the opportunity to be heard.

Parties to a proceeding shall have an opportunity for review by a judicial authority of final administrative decisions and, subject to jurisdictional provisions in a Member's law concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of a case. However, there shall be no obligation to provide an opportunity for review of acquittals in criminal cases.

It is understood that this Part does not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general.

## Section 2 Civil and Administrative Procedures and Remedies

### Article 42

#### Fair and Equitable Procedures

Members shall make available to right holders (11) civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement. Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims. Parties shall be allowed to be represented by independent legal counsel, and procedures shall not impose overly burdensome requirements concerning mandatory personal appearances. All parties to such procedures shall be duly entitled to substantiate their claims and to present all relevant evidence. The procedure shall provide a means to identify and protect confidential information, unless this would be contrary to existing constitutional requirements.

### Article 43

#### Evidence

The judicial authorities shall have the authority, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, to order that this evidence be produced by the opposing party, subject in appropriate cases to conditions which ensure the protection of confidential information.

In cases in which a party to a proceeding voluntarily and without good reason refuses access to, or otherwise does not provide necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, a Member may accord judicial authorities the authority to make preliminary and final determinations, affirmative or negative, on the basis of the information presented to them, including the complaint or the allegation presented by the party adversely affected by the denial of access to information, subject to providing the parties an opportunity to be heard on the allegations or evidence.

#### Article 44

##### Injunctions

The judicial authorities shall have the authority to order a party to desist from an infringement inter alia to prevent the entry into the channels of commerce in their jurisdiction of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods. Members are not obliged to accord such authority in respect of protected subject matter acquired or ordered by a person prior to knowing or having reasonable grounds to know that dealing in such subject matter would entail the infringement of an intellectual property right.

Notwithstanding the other provisions of this Part and provided that the provisions of Part II specifically addressing use by governments, or by third parties authorized by a government, without the authorization of the right holder are complied with, Members may limit the remedies available against such use to payment of remuneration in accordance with subparagraph (h) of Article 31. In other cases, the remedies under this Part shall apply or, where these remedies are inconsistent with a Member's law, declaratory judgments and adequate compensation shall be available.

#### Article 45

##### Damages

The judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an

infringement of that person's intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.

The judicial authorities shall also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees. In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.

#### Article 46

##### Other Remedies

In order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to avoid any harm caused to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed. The judicial authorities shall also have the authority to order that materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements. In considering such requests, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account. In regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.

#### Article 47

##### Right of Information

Members may provide that the judicial authorities shall have the authority, unless this would be out of proportion to the seriousness of the infringement, to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.

#### Article 48

##### Indemnification of the Defendant

The judicial organization shall have the authority to order a party at whose request measures were taken and who has abused enforcement procedures to provide to a party wrongfully

enjoined or restrained adequate compensation for the injury suffered because of such abuse. The judicial authorities shall also have the authority to order the applicant to pay the defendant expenses, which may include appropriate attorney's fees.

In respect of the administration of any law pertaining to the protection or enforcement of intellectual property rights. Members shall only exempt both public authorities and officials from liability to appropriate remedial measures where actions are taken or intended in good faith in the course of the administration of that law.

#### Article 49

##### Administrative Procedures

To the extent that any civil remedy can be ordered as a result of administrative procedures on the merits of a case, such procedures shall conform to principles equivalent in substance to those set forth in this Section.

#### Section 3 Provisional Measures

#### Article 50

The judicial authorities shall have the authority to order prompt and effective provisional measures:

to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;

to preserve relevant evidence in regard to the alleged infringement.

The judicial authorities shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.

The judicial authorities shall have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.

Where provisional measures have been adopted *inaudita altera parte*, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the defendant with a view to

deciding, within a reasonable period after the notification of the measures, whether these measures shall be modified, revoked or confirmed.

The applicant may be required to supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

Without prejudice to paragraph 4, provisional measures taken on the basis of paragraphs 1 and 2 shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority ordering the measures where a Member's law so permits or, in the absence of such a determination, not to exceed 20 working days or 31 calendar days, whichever is the longer.

Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.

To the extent that any provisional measure can be ordered as a result of administrative procedures, such procedures shall conform to principles equivalent in substance to those set forth in this Section.

## Section 4 Special Requirements Related to Border Measures (12)

### Article 51

#### Suspension of Release by Customs Authorities

Members shall, in conformity with the provisions set below, adopt procedures (13) to enable a right holder, who has valid grounds for suspecting that the importation of counterfeit trademark or pirated copyright goods (14) may take place, to lodge an application in writing with competent authorities, administrative or judicial, for the suspension by the customs authorities of the release into free circulation of such goods. Members may enable such an application to be made in respect of goods which involve other infringements of intellectual property rights, provided that the requirements of this Section are met. Members may also provide for corresponding procedures concerning the suspension by the customs authorities of the release of infringing goods destined for exportation from their territories.

### Article 52

#### Application

Any right holder initiating the procedures under Article 51 shall be required to provide adequate evidence to satisfy the competent authorities that, under the laws of the country of importation, there is prima facie an infringement of the right holder's intellectual property right and to supply a sufficiently detailed description of the goods to make them readily recognizable by the customs authorities. The competent authorities shall inform the applicant within a reasonable period whether they have accepted the application and, where determined by the competent authorities, the period for which the customs authorities will take action.

#### Article 53

##### Security or Equivalent Assurance

The competent authorities shall have the authority to require an applicant to provide a security or equivalent assurance sufficient to protect the defendant and the competent authorities and to prevent abuse. Such security or equivalent assurance shall not unreasonably deter recourse to these procedures.

Where pursuant to an application under this Section the release of goods involving industrial designs, patents, layout-designs or undisclosed information into free circulation has been suspended by customs authorities on the basis of a decision other than by a judicial or other independent authority, and the period provided for in Article 55 has expired without the granting of provisional relief by the duly empowered authority, and provided that all other conditions for importation have been complied with, the owner, importer, or consignee of such goods shall be entitled to their release on the posting of a security in an amount sufficient to protect the right holder for any infringement. Payment of such security shall not prejudice any other remedy available to the right holder, it being understood that the security shall be released if the right holder fails to pursue the right of action within a reasonable period of time.

#### Article 54

##### Notice of Suspension

The importer and the applicant shall be promptly notified of the suspension of the release of goods according to Article 51.

#### Article 55

##### Duration of Suspension

If, within a period not exceeding 10 working days after the applicant has been served notice of the suspension, the customs authorities have not been informed that proceedings leading to

a decision on the merits of the case have been initiated by a party other than the defendant, or that the duly empowered authority has taken provisional measures prolonging the suspension of the release of the goods, the goods shall be released, provided that all other conditions for importation or exportation have been complied with; in appropriate cases, this time-limit may be extended by another 10 working days. If proceedings leading to a decision on the merits of the case have been initiated, a review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable period, whether these measures shall be modified, revoked or confirmed. Notwithstanding the above, where the suspension of the release of goods is carried out or continued in accordance with a provisional judicial measure, the provisions of paragraph 6 of Article 50 shall apply.

#### Article 56

##### Indemnification of the Importer and of the Owner of the Goods

Relevant authorities shall have the authority to order the applicant to pay the importer, the consignee and the owner of the goods appropriate compensation for any injury caused to them through the wrongful detention of goods or through the detention of goods released pursuant to Article 55.

#### Article 57

##### Right of Inspection and Information

Without prejudice to the protection of confidential information, Members shall provide the competent authorities the authority to give the right holder sufficient opportunity to have any goods detained by the customs authorities inspected in order to substantiate the right holder's claims. The competent authorities shall also have authority to give the importer an equivalent opportunity to have any such goods inspected. Where a positive determination has been made on the merits of a case, Members may provide the competent authorities the authority to inform the right holder of the names and addresses of the consignor, the importer and the consignee and of the quantity of the goods in question.

#### Article 58

##### Ex Officio Action

Where Members require competent authorities to act upon their own initiative and to suspend the release of goods in respect of which they have acquired prima facie evidence that an intellectual property right is being infringed:

the competent authorities may at any time seek from the right holder any information that may assist them to exercise these powers;

the importer and the right holder shall be promptly notified of the suspension. Where the importer has lodged an appeal against the suspension with the competent authorities, the suspension shall be subject to the conditions, *mutatis mutandis*, set out at Article 55;

Members shall only exempt both public authorities and officials from liability to appropriate remedial measures where actions are taken or intended in good faith.

#### Article 59

##### Remedies

Without prejudice to other rights of action open to the right holder and subject to the right of the defendant to seek review by a judicial authority, competent authorities shall have the authority to order the destruction or disposal of infringing goods in accordance with the principles set out in Article 46. In regard to counterfeit trademark goods, the authorities shall not allow the re-exportation of the infringing goods in an unaltered state or subject them to a different customs procedure, other than in exceptional circumstances.

#### Article 60

##### De Minimis Imports

Members may exclude from the application of the above provisions small quantities of goods of a non-commercial nature contained in travellers' personal luggage or sent in small consignments.

#### Section 5 Criminal Procedures

##### Article 61

Members shall provide for criminal procedures and penalties to be applied at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale. Remedies available shall include imprisonment and/or monetary fines sufficient to provide a deterrent, consistently with the level of penalties applied for crimes of a corresponding gravity. In appropriate cases, remedies available shall also include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offence. Members may provide for criminal procedures and penalties to be applied in other cases of infringement of intellectual property rights, in particular where they are committed wilfully and on a commercial scale.

## PART IV ACQUISITION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS AND RELATED INTER-PARTES PROCEDURES

### Article 62

Members may require, as a condition of the acquisition or maintenance of the intellectual property rights provided for under Sections 2 through 6 of Part II, compliance with reasonable procedures and formalities. Such procedures and formalities shall be consistent with the provisions of this Agreement.

Where the acquisition of an intellectual property right is subject to the right being granted or registered, Members shall ensure that the procedures for grant or registration, subject to compliance with the substantive conditions for acquisition of the right, permit the granting or registration of the right within a reasonable period of time so as to avoid unwarranted curtailment of the period of protection.

Article 4 of the Paris Convention (1967) shall apply *mutatis mutandis* to service marks.

Procedures concerning the acquisition or maintenance of intellectual property rights and, where a Member's law provides for such procedures, administrative revocation and inter partes procedures such as opposition, revocation and cancellation, shall be governed by the general principles set out in paragraph 2 and 3 of Article 41.

Final administrative decisions in any of the procedures referred to under paragraph 4 shall be subject to review by a judicial or quasi-judicial authority. However, there shall be no obligation to provide an opportunity for such review of decisions in cases of unsuccessful opposition or administrative revocation, provided that the grounds for such procedures can be the subject of invalidation procedures.

## PART V DISPUTE PREVENTION AND SETTLEMENT

### Article 63

#### Transparency

Laws and regulations, and final judicial decisions and administrative rulings of general application, made effective by a Member pertaining to the subject matter of this Agreement (the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights) shall be published, or where such publication is not practicable made publicly available, in a national language, in such a manner as to enable governments and right holders to become acquainted with them. Agreements concerning the subject matter of this Agreement which are in force between the government or a governmental agency of a

Member and the government or a governmental agency of another Member shall also be published.

Members shall notify the laws and regulations referred to in paragraph 1 to the Council for TRIPS in order to assist that Council in its review of the operation of this Agreement. The Council shall attempt to minimize the burden on Members in carrying out this obligation and may decide to waive the obligation to notify such laws and regulations directly to the Council if consultations with WIPO on the establishment of a common register containing these laws and regulations are successful. The Council shall also consider in this connection any action required regarding notifications pursuant to the obligations under this Agreement stemming from the provisions of Article 6ter of the Paris Convention (1967).

Each Member shall be prepared to supply, in response to a written request from another Member, information of the sort referred to in paragraph 1. A Member, having reason to believe that a specific judicial decision or administrative ruling or bilateral agreement in the area of intellectual property rights affects its rights under this Agreement, may also request in writing to be given access to or be informed in sufficient detail of such specific judicial decisions or administrative rulings or bilateral agreements.

Nothing in paragraphs 1, 2 and 3 shall require Members to disclose confidential information which would impede law enforcement or otherwise be contrary to the public interest or would prejudice the legitimate commercial interests of particular enterprises, public or private.

#### Article 64

##### Dispute Settlement

The provisions of Articles XXII and XXIII of GATT 1994 as elaborated and applied by the Dispute Settlement Understanding shall apply to consultations and the settlement of disputes under this Agreement except as otherwise specifically provided herein.

Subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994 shall not apply to the settlement of disputes under this Agreement for a period of five years from the date of entry into force of the WTO Agreement.

During the time period referred to in paragraph 2, the Council for TRIPS shall examine the scope and modalities for complaints of the type provided for under subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994 made pursuant to this Agreement, and submit its recommendations to the Ministerial Conference for approval. Any decision of the Ministerial Conference to approve such recommendations or to extend the period in paragraph 2 shall be

made only by consensus, and approved recommendations shall be effective for all Members without further formal acceptance process.

## PART VI TRANSITIONAL ARRANGEMENTS

### Article 65

#### Transitional Arrangements

Subject to the provisions of paragraphs 2, 3 and 4, no Member shall be obliged to apply the provisions of this Agreement before the expiry of a general period of one year following the date of entry into force of the WTO Agreement.

A developing country Member is entitled to delay for a further period of four years the date of application, as defined in paragraph 1, of the provisions of this Agreement other than Articles 3, 4 and 5.

Any other Member which is in the process of transformation from a centrally-planned into a market, free-enterprise economy and which is undertaking structural reform of its intellectual property system and facing special problems in the preparation and implementation of intellectual property laws and regulations, may also benefit from a period of delay as foreseen in paragraph 2.

To the extent that a developing country Member is obliged by this Agreement to extend product patent protection to areas of technology not so protectable in its territory on the general date of application of this Agreement for that Member, as defined in paragraph 2, it may delay the application of the provisions on product patents of Section 5 of Part II to such areas of technology for an additional period of five years.

A Member availing itself of a transitional period under paragraphs 1, 2, 3 or 4 shall ensure that any changes in its laws, regulations and practice made during that period do not result in a lesser degree of consistency with the provisions of this Agreement.

### Article 66

#### Least-Developed Country Members

In view of the special needs and requirements of least-developed country Members, their economic, financial and administrative constraints, and their need for flexibility to create a viable technological base, such Members shall not be required to apply the provisions of this Agreement, other than Articles 3, 4 and 5, for a period of 10 years from the date of application as defined under paragraph 1 of Article 65. The Council for TRIPS shall, upon

duly motivated request by a least-developed country Member, accord extensions of this period.

Developed country Members shall provide incentives to enterprises and institutions in their territories for the purpose of promoting and encouraging technology transfer to least-developed country Members in order to enable them to create a sound and viable technological base.

#### Article 67

##### Technical Cooperation

In order to facilitate the implementation of this Agreement, developed country Members shall provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in favour of developing and least-developed country Members. Such cooperation shall include assistance in the preparation of laws and regulations on the protection and enforcement of intellectual property rights as well as on the prevention of their abuse, and shall include support regarding the establishment or reinforcement of domestic offices and agencies relevant to these matters, including the training of personnel.

### PART VII INSTITUTIONAL ARRANGEMENTS; FINAL PROVISIONS

#### Article 68

##### Council for Trade-Related Aspects of Intellectual Property Rights

The Council for TRIPS shall monitor the operation of this Agreement and, in particular, Members' compliance with their obligations hereunder, and shall afford Members the opportunity of consulting on matters relating to the trade-related aspects of intellectual property rights. It shall carry out such other responsibilities as assigned to it by the Members, and it shall, in particular, provide any assistance requested by them in the context of dispute settlement procedures. In carrying out its functions, the Council for TRIPS may consult with and seek information from any source it deems appropriate. In consultation with WIPO, the Council shall seek to establish, within one year of its first meeting, appropriate arrangements for cooperation with bodies of that Organization.

#### Article 69

##### International Cooperation

Members agree to cooperate with each other with a view to eliminating international trade in goods infringing intellectual property rights. For this purpose, they shall establish and notify contact points in their administrations and be ready to exchange information on trade in

infringing goods. They shall, in particular, promote the exchange of information and cooperation between customs authorities with regard to trade in counterfeit trademark goods and pirated copyright goods.

## Article 70

### Protection of Existing Subject Matter

This Agreement does not give rise to obligations in respect of acts which occurred before the date of application of the Agreement for the Member in question.

Except as otherwise provided for in this Agreement, this Agreement gives rise to obligations in respect of all subject matter existing at the date of application of this Agreement for the Member in question, and which is protected in that Member on the said date, or which meets or comes subsequently to meet the criteria for protection under the terms of this Agreement. In respect of this paragraph and paragraphs 3 and 4, copyright obligations with respect to existing works shall be solely determined under Article 18 of the Berne Convention (1971), and obligations with respect to the rights of producers of phonograms and performers in existing phonograms shall be determined solely under Article 18 of the Berne Convention (1971) as made applicable under paragraph 6 of Article 14 of this Agreement.

There shall be no obligation to restore protection to subject matter which on the date of application of this Agreement for the Member in question has fallen into the public domain.

In respect of any acts in respect of specific objects embodying protected subject matter which become infringing under the terms of legislation in conformity with this Agreement, and which were commenced, or in respect of which a significant investment was made, before the date of acceptance of the WTO Agreement by that Member, any Member may provide for a limitation of the remedies available to the right holder as to the continued performance of such acts after the date of application of this Agreement for that Member. In such cases the Member shall, however, at least provide for the payment of equitable remuneration.

A Member is not obliged to apply the provisions of Article 11 and of paragraph 4 of Article 14 with respect to originals or copies purchased prior to the date of application of this Agreement for that Member.

Members shall not be required to apply Article 31, or the requirement in paragraph 1 of Article 27 that patent rights shall be enjoyable without discrimination as to the field of technology, to use without the authorization of the right holder where authorization for such use was granted by the government before the date this Agreement became known.

In the case of intellectual property rights for which protection is conditional upon registration, applications for protection which are pending on the date of application of this Agreement for the Member in question shall be permitted to be amended to claim any enhanced protection provided under the provisions of this Agreement. Such amendments shall not include new matter.

Where a Member does not make available as of the date of entry into force of the WTO Agreement patent protection for pharmaceutical and agricultural chemical products commensurate with its obligations under Article 27, that Member shall:

notwithstanding the provisions of Part VI, provide as from the date of entry into force of the WTO Agreement a means by which applications for patents for such inventions can be filed; apply to these applications, as of the date of application of this Agreement, the criteria for patentability as laid down in this Agreement as if those criteria were being applied on the date of filing in that Member or, where priority is available and claimed, the priority date of the application; and

provide patent protection in accordance with this Agreement as from the grant of the patent and for the remainder of the patent term, counted from the filing date in accordance with Article 33 of this Agreement, for those of these applications that meet the criteria for protection referred to in subparagraph (b).

Where a product is the subject of a patent application in a Member in accordance with paragraph 8(a), exclusive marketing rights shall be granted, notwithstanding the provisions of Part VI, for a period of five years after obtaining marketing approval in that Member or until a product patent is granted or rejected in that Member, whichever period is shorter, provided that, subsequent to the entry into force of the WTO Agreement, a patent application has been filed and a patent granted for that product in another Member and marketing approval obtained in such other Member.

## Article 71

### Review and Amendment

The Council for TRIPS shall review the implementation of this Agreement after the expiration of the transitional period referred to in paragraph 2 of Article 65. The Council shall, having regard to the experience gained in its implementation, review it two years after that date, and at identical intervals thereafter. The Council may also undertake reviews in the

light of any relevant new developments which might warrant modification or amendment of this Agreement.

Amendments merely serving the purpose of adjusting to higher levels of protection of intellectual property rights achieved, and in force, in other multilateral agreements and accepted under those agreements by all Members of the WTO may be referred to the Ministerial Conference for action in accordance with paragraph 6 of Article X of the WTO Agreement on the basis of a consensus proposal from the Council for TRIPS.

#### Article 72

##### Reservations

Reservations may not be entered in respect of any of the provisions of this Agreement without the consent of the other Members.

#### Article 73

##### Security Exceptions

Nothing in this Agreement shall be construed:

to require a Member to furnish any information the disclosure of which it considers contrary to its essential security interests; or

to prevent a Member from taking any action which it considers necessary for the protection of its essential security interests;

relating to fissionable materials or the materials from which they are derived;

relating to the traffic in arms, ammunition and implements of war and to such traffic in other goods and materials as is carried on directly or indirectly for the purpose of supplying a military establishment;

taken in time of war or other emergency in international relations; or

to prevent a Member from taking any action in pursuance of its obligations under the United Nations Charter for the Maintenance of international peace and security.

When 'nationals' are referred to in this Agreement, they shall be deemed, in the case of a separate customs territory Member of the WTO, to mean persons, natural or legal, who are domiciled or who have a real and effective industrial or commercial establishment in that customs territory.

In this Agreement, 'Paris Convention' refers to the Paris Convention for the Protection of Industrial Property; 'Paris Convention (1967)' refers to the Stockholm Act of this Convention

of 14 July 1967. 'Berne Convention' refers to the Berne Convention for the Protection of Literary and Artistic Works; 'Berne Convention (1971)' refers to the Paris Act of this Convention of 24 July 1971. 'Rome Convention' refers to the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, adopted at Rome on 26 October 1961. 'Treaty on Intellectual Property in Respect of Integrated Circuits' (IPIC Treaty) refers to the Treaty on Intellectual Property in Respect of Integrated Circuits, adopted at Washington on 26 May 1989. 'WTO Agreement' refers to the Agreement Establishing the WTO.

For the purposes of Articles 3 and 4, 'protection' shall include matters affecting the availability, acquisition, scope, maintenance and enforcement of intellectual property rights as well as those matters affecting the use of intellectual property rights specifically addressed in this Agreement.

Notwithstanding the first sentence of Article 42, Members may, with respect to these obligations, instead provide for enforcement by administrative action.

For the purposes of this Article, the terms 'inventive step' and 'capable of industrial application' may be deemed by a Member to be synonymous with the terms 'non-obvious' and 'useful' respectively.

This right, like all other rights conferred under this Agreement in respect of the use, sale, importation or other distribution of goods, is subject to the provisions of Article 6.

'Other use' refers to use other than that allowed under Article 30.

It is understood that those Members which do not have a system of original grant may provide that the term of protection shall be computed from the filing date in the system of original grant.

The term 'right holder' in this Section shall be understood as having the same meaning as the term 'holder of the right' in the IPIC Treaty.

For the purpose of this provision, 'a manner contrary to honest commercial practices' shall mean at least practices such as breach of contract, breach of confidence and inducement to breach, and includes the acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that such practices were involved in the acquisition.

For the purpose of this Part, the term 'right holder' includes federations and associations having legal standing to assert such rights.

Where a Member has dismantled substantially all controls over movement of goods across its border with another Member with which it forms part of a customs union, it shall not be required to apply the provisions of this Section at that border.

It is understood that there shall be no obligation to apply such procedures to imports of goods put on the market in another country by or with the consent of the right holder, or to goods in transit.

For the purposes of this Agreement:

'counterfeit trademark goods' shall mean any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation;

'pirated copyright goods' shall mean any goods which are copies made without the consent of the right holder or person duly authorized by the right holder in the country of production and which are made directly or indirectly from an article where the making of that copy would have constituted an infringement of a copyright or a related right under the law of the country of importation.