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(Acts whose publication is obligatory)

COUNCIL REGULATION (EC) No 1992/2003

of 27 October 2003

amending Regulation (EC) No 40/94 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989

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 European Economic and Social Committee ⁽³⁾,

Whereas:

- (1) Regulation (EC) No 40/94 ⁽⁴⁾ (the Community trade mark Regulation), which is based on Article 308 of the Treaty, is designed to create a 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, the said Regulation created the Community trade mark system 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 European Community.
- (2) The Diplomatic Conference for the conclusion of a Protocol relating to the Madrid Agreement concerning the international registration of marks adopted the Protocol relating to the Madrid Agreement concerning the international registration of marks (hereafter referred to as the Madrid Protocol) on 27 June 1989, at Madrid.
- (3) The Madrid Protocol was adopted in order to introduce certain new features into the system of the international registration of marks existing under the Madrid Agreement concerning the international registration of marks of 14 April 1891 as amended (hereafter referred to as the Madrid Agreement) ⁽⁵⁾.
- (4) As compared to the Madrid Agreement, the Madrid Protocol introduced, in its Article 14, as one of the main innovations the possibility that an intergovernmental

organisation which has a regional office for the purpose of registering marks with effect in the territory of the organisation may become party to the Madrid Protocol.

- (5) The Madrid Protocol entered into force on 1 December 1995 and became operational on 1 April 1996 and the Community trade mark system also became operational on the latter date.
- (6) The Community trade mark system and the international registration system as established by the Madrid Protocol are complementary. Therefore, in order to enable firms to benefit from the advantages of the Community trade mark through the Madrid Protocol and vice versa, it is necessary to allow Community trade mark applicants and holders of such trade marks to apply for international protection of their trade marks through the filing of an international application under the Madrid Protocol and, conversely, holders of international registrations under the Madrid Protocol to apply for protection of their trade marks under the Community trade mark system.
- (7) Moreover, the establishment of a link between the Community trade mark system and the international registration system under the Madrid Protocol would promote a harmonious development of economic activities, will eliminate distortions of competition, will be cost efficient and will increase the level of integration and functioning of the internal market. Therefore, the accession of the Community to the Madrid Protocol is necessary in order for the Community trade mark system to become more attractive.
- (8) For the above reasons, the Council, acting on a proposal from the Commission ⁽⁶⁾, approved the Madrid Protocol and authorised the President of the Council to deposit the instrument of accession with the Director-General of the World Intellectual Property Organisation (WIPO) as from the date on which the Council has adopted the measures which are necessary to give effect to the accession of the European Community to the Madrid Protocol. This Regulation contains these measures.

⁽¹⁾ OJ C 300, 10.10.1996, p. 11.

⁽²⁾ OJ C 127, 2.6.1997, p. 251.

⁽³⁾ OJ C 89, 19.3.1997, p. 14.

⁽⁴⁾ OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 1653/2003 (OJ L 245, 29.9.2003, p. 36).

⁽⁵⁾ The Madrid Agreement concerning the international registration of marks as revised last at Stockholm on 14 July 1967 and as amended on 2 October 1979.

⁽⁶⁾ Commission proposal for a Council Decision approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on June 27, 1989 (OJ C 293, 5.10.1996, p. 11).

- (9) These measures should be incorporated in the Community trade mark Regulation through the inclusion of a new title on 'International registration of marks'. For this reason, the legal basis of this proposal should be the same as the legal basis of the Community trade mark Regulation, i.e. Article 308 of the Treaty.
- (10) Furthermore, it is necessary to provide for rules applying to the filing of an international application at the International Bureau of WIPO through the intermediary of the Office for Harmonisation in the Internal Market (trade marks and designs) (the Office).
- (11) Where an international application is filed, on the basis of a Community trade mark application, in a language other than one of the languages allowed under the Madrid Protocol for the filing of international applications, the Office should make its best efforts to arrange for the translation of the list of goods or services into the language indicated by the applicant in order for the application to be forwarded to the International Bureau in time to maintain the date of priority.
- (12) There is nothing in the Madrid Protocol or in the Regulations adopted under the Madrid Protocol which would determine the language regime to be applied by the Office when processing an international application or an international registration.
- (13) Finally, the rules and procedures relating to international registrations designating the European Community should, in principle, be the same as the rules and procedures which apply to Community trade mark applications and the protection of Community trade marks. According to this principle, international registrations designating the European Community should be subject to examination as to absolute grounds for refusal, searches in the Register of Community trade marks and the registers of trade marks of those Member States which have informed the Office of their decision to operate such a search and should be subject to opposition in the same way as published Community trade marks. Likewise international registrations designating the European Community should be subject to the same rules on use and invalidation as Community trade marks. Furthermore the designation of the European Community through international registrations may be converted into national trade mark applications or into the designation of Member States which are party to the Madrid Protocol or the Madrid Agreement where the designation of the European Community through such international registrations is refused or ceases to have effect,

HAS ADOPTED THIS REGULATION:

Article 1

Regulation (EC) No 40/94 is hereby amended as follows:

1. The following subparagraph shall be added to Article 8(2)(a):
 - (iv) trade marks registered under international arrangements which have effect in the Community;

2. Article 134(3) shall be replaced by the following:

'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 for an international registration designating the European Communities and other payments made to Contracting Parties to the Madrid Protocol, and, to the extent necessary, a subsidy entered against a specific heading of the general budget of the European Communities, Commission section.'

3. The following title shall be inserted after title XII:

'TITLE XIII

INTERNATIONAL REGISTRATION OF MARKS

SECTION I

GENERAL PROVISIONS

Article 140

Application of provisions

Unless otherwise specified in this title, this Regulation and any regulations implementing this Regulation adopted pursuant to Article 158 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 141

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 142***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 141(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 referred to in Article 157.

*Article 143***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 144***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 142.

*Article 145***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 146***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 147(1) shall take the place of publication of a Community trade mark application, and publication pursuant to Article 147(2) shall take the place of publication of the registration of a Community trade mark.

*Article 147***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 148

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 147(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 149

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 150

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 39(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 39(2).

3. Article 39(3), (4) and (5) 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 147(1).

Article 151

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 147(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 152

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 153

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 50 or for invalidation as provided for in Article 51 or Article 52.

Article 154

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 108 to 110 or

(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 108 to 110 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 148.

3. The request for conversion shall be published.

Article 155

Use of a mark subject of an international registration

For the purposes of applying Article 15(1), Article 43(2), Article 50(1)(a) and Article 56(2), the date of publication pursuant to Article 147(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 156

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 147(2), Articles 38 to 43 shall not apply.'

4. Title XIII becomes Title XIV.

5. Articles 140, 141, 142 and 143 shall be renumbered as follows:

Article 140 becomes Article 157

Article 141 becomes Article 158

Article 142 becomes Article 159

Article 143 becomes Article 160.

6. The reference to Article 140 in Article 26(3) shall be replaced by a reference to Article 157.

7. The reference to Article 141 in Article 139(3) and Article 140(3) shall be replaced by a reference to Article 158.

Article 2

This Regulation shall enter into force on the date on which the Madrid Protocol enters into force with respect to the European Community. The date of entry into force of this Regulation shall be published 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 Luxembourg, 27 October 2003.

For the Council

The President

A. MATTEOLI