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*(Acts whose publication is obligatory)*

# COUNCIL REGULATION (EC) No 422/2004
## of 19 February 2004
## amending Regulation (EC) No 40/94 on the Community trade mark
**(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]),

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

Whereas:

(1) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ([3]), set up a unitary system of protection of trade marks throughout the Member States via Community registration. This system has generally fulfilled users' expectations satisfactorily. It has also had a positive effect on the effective achievement of the internal market.

(2) The functioning of the system has made it possible to identify other aspects which could clarify and further supplement it, thereby making it possible to improve the effectiveness of the system, increase the value it adds and anticipate, as of now, the consequences of additional members in future, without it being necessary to change the substance of the system, which has proven itself to be perfectly valid with regard to the objectives set.

(3) The Community trade mark system should be made accessible to all, without any requirement of reciprocity, equivalence and/or nationality. This would also encourage trade on the world market. Such requirements make the system complex, inflexible and ineffective. In addition, in the context of the new Community design system, the Council took a flexible line on this question.

(4) In order to rationalise the procedure, the search system should be amended. It should remain compulsory for Community trade marks, but it should be made optional, subject to the payment of a fee, for searches in the trade mark registers of the Member States which notified their own decision to carry out such a search. Furthermore, measures should be provided with a view to improving the quality of the search reports, ensuring greater uniformity by using a standard form and laying down their essential contents.

(5) Certain measures should be taken in order to give the Boards of Appeal additional means of speeding up their decisions and improving their operation.

(6) The experience acquired in the application of the system highlighted the possibility of improving certain aspects of the procedure. Consequently, certain points should be amended and others inserted in order to offer users a higher-quality product which is still competitive,

HAS ADOPTED THIS REGULATION:

*Article 1*

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

1. Article 5 shall be replaced by the following:

   '*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.';

2. in Article 7(1), the following point shall be added:

   '(k) trade marks which contain or consist of a designation of origin or a geographical indication registered in accordance with Regulation (EEC) No 2081/92 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.';

([1]) Opinion delivered on 23 September 2003 (not yet published in the Official Journal).
([2]) OJ C 208, 3.9.2003, p. 7.
([3]) OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 1992/2003 (OJ L 296, 14.11.2003, p. 1).

3. In Article 8(4), the introductory subparagraph shall be replaced by the following:

'4. 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:';

4. Article 21 shall be replaced by the following:

'*Article 21*

**Insolvency proceedings**

1. 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 Directives 2001/17/EC (*) and 2001/24/EC (**), 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.

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

3. 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 85.

(*) 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 (OJ L 110, 20.4.2001, p. 28).

(**) 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 (OJ L 125, 5.5.2001, p. 15).';

5. Article 25(3) shall be replaced by the following:

'3. 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.';

6. Article 35(1) shall be replaced by the following:

'1. 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.';

7. Article 36(1)(b) shall be replaced by the following:

'(b) the Community trade mark application complies with the conditions laid down in this Regulation and with the conditions laid down in the Implementing Regulation.';

8. Article 37 shall be deleted;

9. Article 39 shall be replaced by the following:

'*Article 39*

**Search**

1. 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.

2. 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.

3. 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.

4. 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. The essential contents of this form shall be set out in the Implementing Regulation provided for in Article 157(1).

5. 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.

6. 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.

7. 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.';

10. Article 40 shall be replaced by the following:

'*Article 40*

**Publication of the application**

1. If the conditions which the application for a Community trade mark must satisfy have been fulfilled and if the period referred to in Article 39(7) has expired, the application shall be published to the extent that it has not been refused pursuant to Article 38.

2. Where, after publication, the application is refused under Article 38, the decision that it has been refused shall be published upon becoming final.';

11. in Title IV, the title of Section 5 shall be replaced by the following:

**'WITHDRAWAL, RESTRICTION, AMENDMENT AND DIVISION OF THE APPLICATION';**

12. the following Article shall be inserted:

'*Article 44a*

**Division of the application**

1. 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.

2. The declaration of division shall not be admissible:

(a) 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;

(b) during the periods laid down in the Implementing Regulation.

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

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

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

6. 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.

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

13. the title of Title V shall be replaced by the following:

**'DURATION, RENEWAL, ALTERATION AND DIVISION OF COMMUNITY TRADE MARKS';**

14. the following Article shall be inserted:

'*Article 48a*

**Division of the registration**

1. 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.

2. The declaration of division shall not be admissible:

(a) if, where an application for revocation of rights or for a declaration of invalidity has been entered 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;

(b) 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 judgement is recorded in the Register pursuant to Article 96(6).

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

4. 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.