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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.

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[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.