

QUESTION 66

The European trade mark

Yearbook 1974/I, pages 113 - 114
Executive Committee and Council of Presidents of Melbourne,
February 24 - March 2, 1974

Q66

Question Q66

Convention for a European trademark

Resolution

1. The IAPIP adopts the following resolution:

The IAPIP affirms that a convention establishing a European mark should be based upon the following principles:

Possibility of adherence

The convention should comprise the countries of the European Economic Community (EEC) and should retain the possibility of adherence by countries having close economic ties with the EEC.

Accessibility

Nationals of all countries party to the Paris Convention should be entitled to file applications for European marks.

Unitary character of the mark

The European mark shall be granted only for the whole of the territories of the contracting States.

- First alternative: It should produce in these territories an identical effect deriving from the convention itself.

- Second alternative: But it should in the territory of each contracting State produce the same effect as a national registration in that State.

Coexistence of European and national law

The convention should, for practical reasons, preserve the possibility of obtaining national registrations whose effect is controlled by national law, but should encourage trademark owners to file applications for the registration of European marks. In particular, the convention should provide that a European mark granted to a person having one or more national registrations of the identical mark should, after a reasonable period of time, be deemed to replace the national registration(s) without prejudice to the rights acquired by means of the latter.

Service marks

The European mark should be capable of registration for services as well as for goods.

Examination by the European Trademarks Office

The European Office should examine an application for a European mark for conflicting prior marks, without however the possibility of rejection *ex officio* on the ground of anticipation. The Office should inform the applicant of conflicting prior marks and the owners of the latter of the mark applied for.

Opposition

The convention should provide for the right of an interested third party to file opposition to an application for a European mark on any of the grounds on which the European Trademarks Office may, under this and the Paris Convention, reject an application. Such grounds should include conflict with prior rights acquired under national law, such as the right to a mark in use but not registered.

Incontestability

The registration of an European mark which has been used should, after a period of five years, be incontestable on the ground of prior private rights. Incontestability should not be made conditional upon the use of a marking indicating registration. The term within which the mark remains contestable should be capable of reduction as against a third party who has been notified by the owner of the mark: in such a case, the incontestability of the mark is not subject to its use.

Standing to assert prior rights

Only the owner of prior rights, or a person to whom such owner has delegated authority for this purpose, may assert the same against a subsequent mark.

User requirements

The IAPIP believes that the maintenance of the right to a European mark should be made conditional upon the serious and effective use of the mark. Whether the use of the mark is serious and effective should not depend primarily upon the number of countries in which it has taken place. Failure, without just cause independent of the will of the owner of the mark, to begin such use within five years of the date of registration or to resume such use within five years of an interruption of such use, shall make a registration subject to cancellation on the ground of non-use, *provided that* the cancellation action is filed before commencement or resumption of serious and effective use.

Conversion into national application or registration

1. A person whose application for a European mark has been rejected, or whose registration of a European mark has been cancelled, should have the right to file, within a reasonable period of time from the rejection or cancellation, an application under national law in any of the contracting States with a claim to the priority date of the rejected or cancelled European mark.
2. The IAPIP charges the Special Committee with the formulation, on the basis of the above resolution, of detailed observations to be presented on behalf on the IAPIP to the Commission of the EEC.
3. The IAPIP decides to continue the study of this question.

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QUESTION 66

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Yearbook 1978/II, pages 148 - 150
30th Congress of Munich, May 15 - 19, 1978

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Question Q66

The European Trademark

Resolution

The IAPIP,

after a first discussion of the question by the Council of Presidents at Paris, and having presented its first comments on the Memorandum of the Commission of the EEC concerning the creation of a trademark for the Common Market (Yearbook 1977/II, p. 358) and on the principles contained in the two initial parts of the Preliminary Draft of the Regulation Relating to the Community Trademark (Yearbook 1978/I, p. 63); having continued the study on this question during the Munich Congress,

I. reaffirms its former position on the utility of the creation of a mark for the Common Market, not only in the interests of the inhabitants of the Common Market but also of third countries, provided that the new legislation does not interfere with the legitimate interests of owners of prior rights;

II. expresses the wish that the Common Market mark shall be instituted by way of a treaty, which offers many advantages as against a regulation by the EEC;

III. confirms its prior comments, especially on the following specific questions:

1. Registration procedure and search for prior rights

(a) The examiner may consider absolute grounds of refusal

(b) As to the relative grounds of refusal:

- the Office shall carry out a search for prior rights and shall notify the results thereof for purposes of information:

- to the applicant,

- to interested third parties.

2. Opposition

(a) According to what is provided in the Preliminary Draft of the EEC, an opposition should be permissible on the basis of absolute grounds of refusal.

(b) As to relative grounds of refusal:

- Opposition should be available to the proprietors:

1. of registrations or applications of Community Marks or national marks;

2. of well-known marks within the meaning of Article 6^{bis}, i.e. marks known in the interested trade circles;

3. of well-known trade names (having a national scope); and in exceptional cases, if there are such, of well-known business designations [enseignes notoires] (having a national scope).

- Opposition should not be available to proprietors of rights based on use (marks, trade names, "enseignes"), having a national scope, provided that the proprietors of these rights can enforce them before their national courts

- by a direct action for invalidity; or

- by means of a counterclaim; or

- by way of a defense in an infringement action.

3. Conciliation procedure

This procedure can be accepted under the following conditions:

(a) conciliation as an optional procedure;

(b) results not to be binding;

(c) carried out by the examiner acting as mediator;

(d) guarantee that the agreements thus reached are lawful under Article 85 of the EEC Treaty.

4. Effects of prior rights

Regional or local rights which have previously been acquired must be protected, but only within the territorial limits of the prior rights.

5. Commencement of protection

One must distinguish two questions:

(a) for the duration of the registration of the mark, the filing date must be taken as the commencement of protection;

(b) for the effect of the mark vis-à-vis a third party which unlawfully uses it, it seems that in a registration system the date which must be taken into consideration should be the registration date or even the date of the publication of this registration. However one may consider granting additional rights to the applicants: provided that registration was in fact granted, damages could be awarded, beginning

- either from the date of notification by the proprietor;

- or from the date of publication of the application.

6. Incontestability

The doctrine of incontestability is approved, but the system proposed in the Preliminary Draft should be replaced by simpler rules.

7. Prior national rights acquired subsequent to the entering into force of the Community law

These rights should be fully maintained, because one cannot allow an erosion of these rights once the coexistence of national marks and the European mark is accepted.

8. Competent authority to decide on the validity of the Community Trademark

(a) The system proposed by the Commission in Articles 156seq., and its attempted justification in Working Document No.9, raises difficulties of a practical nature, so that it cannot be accepted.

This system consists of reserving to the European Office all litigation concerning the validity and maintenance in force of the trademark, which would thus be removed from the judgement of the national court, who nevertheless would still be charged with suppressing infringements.

It seems indispensable that the competence of deciding in infringement matters not be separated from that of evaluating the validity of the mark and its scope of protection, which requires a single jurisdiction.

(b) The solution proposed by the EEC also lacks coherence because it leaves it up to the national court to decide upon the necessity of staying the action (Art. 159).

(c) It is necessary that the national courts have the power, in the course of an infringement action, to pass on the defense of invalidity or lapse of the trademark.

(d) It ought at the very least to be provided that the national courts can determine the scope of protection of the mark.

(e) Finally, the unification of interpretation of Community trademark law must be in the hands of a specialized court.

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QUESTION 66

The European trade mark

Yearbook 1980/I, page 118

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Executive Committee and Council of Presidents of Toronto, September 23 - 29, 1979

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The European Trademark

Resolution

The IAPIP

a) *Approves* the observations of its Committee* dealing with the Draft Council Directive on the Approximation of Member States' Trademark Laws, and

b) *Agrees* to its representatives with the Authorities entrusted with the preparation of the Regulation on the Community Trademark (Article 55) supporting the creation of a system of incontestability of the trademark, in accordance with the following guidelines, which can be alleviated depending on the circumstances:

The owner of a prior trademark shall no longer be entitled to exercise his right against the owner of a later registered trademark provided that both the following conditions are fulfilled:

i) that the latter owner has made a known (F: "notoire") use of his trademark in a substantial part of the Common Market, including the area where the owner of the prior trademark is established;

ii) that *such* use has lasted *five* years.

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