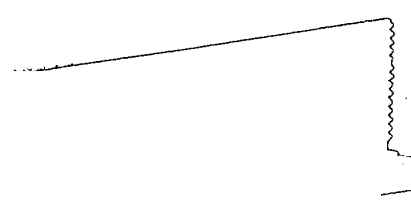


COMMISSION OF THE EUROPEAN COMMUNITIES

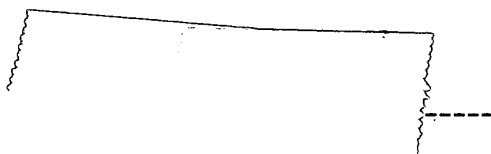


COM(85) 793 final

Brussels, 17 December 1985

Amended
Proposal for a
FIRST COUNCIL DIRECTIVE

to approximate the laws of the Member States relating to
trade marks



the Commission pursuant to the
Article 149 of the EEC Treaty)

COM(85) 793 final

EXPLANATORY MEMORANDUM

Introduction

In November 1980, the Commission presented to the Council its proposal for a first Council Directive to approximate the laws of the Member States relating to trade marks (1).

The Economic and Social Committee delivered an opinion on the proposal in September 1981 (2).

The European Parliament discussed the proposal in detail in its committees and at its plenary sitting in October 1983, when it adopted its opinion (3).

The amended proposal is intended primarily to take account of those opinions. In addition, the provisions of the Directive have, where necessary, been brought into line with the amended proposal for a Council Regulation on the Community trade mark (4).

(1) OJ No. C 351, 31.12.1980, p. 1; Bull. EC, Supplement 5/1980.

(2) OJ No. C 310, 30.11.1981, p. 22.

(3) OJ No. C 307, 14.11.1983, p. 60.

(4) OJ No. C 230, 31.8.1984, p. 1.

COMMENTARY ON THE RECITALS

Second recital

The third sentence has been amended, since a number of provisions in the Directive are also applicable to trade marks which have not been registered (e.g. applications). In addition, the last sentence has been deleted so as to make it clear that existing protection for national trade marks of wide repute is not excluded by the introduction of protection for Community trade marks of wide repute.

Third recital

Parliament's proposed amendment to the first sentence has been incorporated, since other provisions in the Member States, such as those relating to fair competition, may apply, so long as the degree of trade mark protection for registered national trade marks laid down in the Directive is not extended.

Fourth, fifth and sixth recitals

It has been made clear that the reference in these recitals is to "registered" trade marks.

Seventh recital

A fuller explanation is given of what is meant by the possibility of confusion, in line with Parliament's proposed amendment.

Eighth recital

This recital has had to be amended in order to take account of the fact that the Commission has decided not to require Member States to introduce the principle of international exhaustion into their national laws.

Ninth recital

The last sentence has been deleted in line with the amendment to the seventh recital in the proposal for a Regulation on the Community trade mark (hereinafter called "a Regulation").

COMMENTARY ON THE ARTICLES

Article 1

The words "registration or of" have been added in line with Parliament's proposal.

Article 2

In paragraph 1, "in a Member State" has been amended to "in that Member State" so as to make it clear that the competent national authorities are not required to take account of the fact that a trade mark lacks any distinctive character in another Member State.

Paragraphs 2(b) and (c) have been aligned on Article 6(2) of the proposal for a Regulation.

Paragraphs 3 and 4 have been deleted, as suggested by the Economic and Social Committee and Parliament. The exceptions laid down by the Court of Justice of the European Communities to the principle that different trade marks may be used in different Member States (1) require no express enactment.

Article 3

Paragraphs 1 and 2 have been aligned on Article 8 of the proposal for a Regulation.

Paragraph 4 is a new paragraph which has been added in line with Parliament's proposal. It takes account of the particular legal situation in Member States which grant trade mark protection only for those goods in respect of which the application for registration of the trade mark was made. Since Article 3 of this proposal extends protection to similar goods, it was necessary to include a provision ensuring that the Directive would not impair existing rights.

*/

(1) Case 3/78 Centrafarm v. American Home Products Corporation, 1978 ECR 1823.

Articles 4 and 5

The wording of Article 4(1) has been aligned on Article 9(1) of the proposal for a Regulation and that of Article 5 on Article 10 of the proposal for a Regulation.

Article 6

In line with the proposals made by the Economic and Social Committee and Parliament, the Commission has decided not to introduce international exhaustion (cf. explanatory comments on Article 11 of the proposal for a Regulation).

Article 7

This Article has been brought into line with Article 21(2) of the proposal for a Regulation (see explanatory comments on that Article).

Article 8

Paragraph 1 has been brought into line with Article 3(1).

In paragraph 2, the Commission has incorporated Parliament's proposed amendment and, in line with Article 7(2) of the proposal for a Regulation, has drawn up a list of earlier rights which may be used to oppose the registration or continued holding of a national trade mark.

Article 9

The adjective "serious", in relation to the likelihood of confusion has been deleted.

Article 10

The conditions under which, because of limitation in consequence of acquiescence, earlier rights within the meaning of Article 8(2)(a) to (d) may not be used to oppose a later national trade mark have been brought into line with Article 44 of the proposal for a Regulation. In addition, paragraph 1 has been amended in such a way as to make it clear that the limitation of rights through acquiescence in one Member State does not automatically result in the loss of parallel national rights in another Member State.

Articles 11 and 12

Article 11 has been aligned on Article 13 of the proposal for a Regulation and Article 12 on Article 35 (2) of the proposal for a Regulation.

Article 13

This Article had to be deleted since, in line with Article 37 of the proposal for a Regulation, it has been decided not to require the production of a declaration of user when applying for renewal of registration of a trade mark.

Article 14

Paragraph 1 has been brought into line with Article 39(1)(a) of the proposal for a Regulation, and paragraph 2(a) into line with Article 39(1)(b) of the proposal for a Regulation.

Article 17a

This new Article has been added so as to make a symbol indicating a registered national trade mark available to the proprietors of trade marks (see Article 98a of the proposal for a Regulation).

AMENDED PROPOSAL FOR A FIRST COUNCIL DIRECTIVE
TO APPROXIMATE THE LAWS OF THE MEMBER STATES
RELATING TO TRADE MARKS

(presented by the Commission to the Council
pursuant to the second paragraph of Article 149
of the EEC Treaty)

ORIGINAL PROPOSAL

AMENDED PROPOSAL

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,

Having regard to the opinion
of the European Parliament,

Having regard to the opinion
of the Economic and Social
Committee,

Whereas:

The trade mark laws at present
applicable in the Member States
contain disparities which may
impede the free movement of
goods and freedom to provide
services, may distort competition
within the common market and may
therefore directly affect the
establishment and functioning
of that market.

Unchanged

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:

Unchanged

(1) OJ No. C 351, 31.12.1980, p. 1.
(2) OJ No. C 307, 14.11.1983, p. 60.
(3) OJ No. C 310, 30.11.1981, p. 22.

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It does not appear to be necessary at present to undertake full-scale harmonization 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 free movement of goods and services. It follows that this Directive does not deprive Member States of the right to continue to protect trade marks acquired through use but takes them into account only in regard to the relationship between them and trade marks acquired by registration, the only marks which it covers. It is, further, important not to disregard the solutions and advantages which the Community trade mark system affords to undertakings wishing to acquire trade marks. Under this system there is no point in requiring the Member States, inter alia, to authorize the registration of additional categories of signs or to recognize service marks. For the same reason, there is no justification for increasing the protection of marks which enjoy a particular reputation.

AMENDED PROPOSAL

It does not appear to be necessary at present to undertake full-scale harmonization 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 free movement of goods and services. This Directive does not deprive Member States of the right to continue to protect trade marks acquired through use but takes them into account only in regard to the relationship between them and trade marks acquired by registration. It is, further, important not to disregard the solutions and advantages which the Community trade mark system affords to undertakings wishing to acquire trade marks. Under this system there is no point in requiring the Member States, inter alia, to authorize the registration of additional categories of signs or to recognize service marks.

ORIGINAL PROPOSAL

This Directive excludes the application to trade marks of other rules of law of the Member States, such as the provisions relating to fair competition. Moreover, as it only partially approximates the laws of the Member States, Article 36 of the Treaty continues to apply.

Attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a trade mark are, in general, identical in all Member States.

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 that the trade marks be actually used.

The principal purpose of the Directive is to ensure that henceforth trade marks enjoy uniform protection under the legal systems of all the Member States.

The protection afforded by the trade mark is bound up with the concept of similarity of signs, similarity of goods and services and the possibility of confusion

AMENDED PROPOSAL

This Directive does not exclude the application to trade marks of other rules of law of the Member States such as the provisions relating to fair competition. Moreover, as it only partially approximates the laws of the Member States, Article 36 of the Treaty continues to apply.

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 are, in general, identical in all Member States.

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 that the registered trade marks be actually used.

The principal purpose of the Directive is to ensure that henceforth registered trade marks enjoy uniform protection under the legal systems of all the Member States.

The protection afforded by the registered trade mark is bound up with the concept of similarity of a sign and the goods and services in connection with which it is used,

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arising therefrom. The purpose of protection is to guarantee the trade mark's function as an indicator of origin. It is essential to give strict interpretation to the above-mentioned concepts so as not to impede the free movement of goods and the freedom to provide services beyond the limits required for the protection of trade marks. The current case law in several of the Member States affords to trade marks a degree of protection which is to some extent inconsistent with the specific purpose of trade mark law. The Directive therefore requires that the case law be examined. It is necessary, in particular, that by simultaneous comparison of signs, goods and services it be certain in each case that customers are likely to be confused as to the goods or services which are identified by the signs. Where a trade mark consists of several elements it must be considered in its entirety in determining whether the sign which is alleged to infringe it is so similar to it that the sign may be confused with the trade mark. It is no longer possible, in determining whether, in a particular Member State, two verbal signs are homophones or are, at any rate, phonetically similar, to disregard the existence of the Community

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to the registered trade mark and the goods or services for which it is registered, and with the possibility of confusion between the sign and the registered trade mark. The purpose of protection is to guarantee the trade mark's function as an indicator of origin. It is essential to give strict interpretation to the abovementioned concepts so as not to impede the free movement of goods and the freedom to provide services beyond the limits required for the protection of registered trade marks. The current case law in several of the Member States affords to trade marks degrees of protection which may to some extent go beyond the specific subject matter of trade marks. The Directive therefore requires that the case law be examined. It is necessary, in particular, by simultaneous comparison of the sign and the goods or services in connection with which it is used and the registered trade mark and the goods or services for which it is registered, to establish clearly in each case that customers are likely to be confused as to the sign and the goods and services which are identified by the sign on the one hand and the registered trade mark and the goods or services for which it is registered on the other. Where a trade mark consists of several

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and the fact that the public is increasingly aware of the correct pronunciation of words in the languages which are spoken therein.

The function of indicating origin which is fulfilled by a trade mark implies that it is not, in principle, possible to prohibit its use by a third party in respect of goods marketed within or outside the Community under the trade mark by the proprietor or with his consent, or to prohibit its use, for reasons based on trade mark law, by a licensee supplying goods or providing services under the trade mark outside the territory covered by the licence.

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elements it must be considered in its entirety in determining whether the sign which is alleged to infringe it is so similar to the registered trade mark that it is clear that the sign is likely to be confused with the registered trade mark. It is no longer possible, in determining whether, in a particular Member State, two verbal signs are homophones or are, at any rate, phonetically similar, to disregard the existence of the Community and the fact that the public is increasingly aware of the correct pronunciation of words in the languages which are spoken therein.

It follows from the principle of free flow of goods that the proprietor of a registered trade mark must not be entitled to prohibit its use by a third party in relation to goods which have been put on the market in the Community, under that trade mark, by him or with his consent, nor to prohibit its use, for reasons based on trade mark law, by a licensee who supplies the goods or services under the trade mark outside the territory covered by the licence.

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It is necessary for the functioning of the common market to approximate national procedural rules only in so far as this will contribute to the settlement of disputes between the proprietors of trade marks or between the latter and holders of other private rights. For the present, provision is made for an amicable settlement procedure only. It may, however, be proper at some later stage, depending in particular on the degree of integration then achieved by the Community, to contemplate new measures which would enable such conflicts to be resolved more easily.

has adopted this Directive:

AMENDED PROPOSAL

It is necessary for the functioning of the common market to approximate national procedural rules only in so far as this will contribute to the settlement of disputes between the proprietors of trade marks or between the latter and holders of other private rights. Consequently, provision is made for an amicable settlement procedure only.

has adopted this Directive:

ORIGINAL PROPOSAL

Article 1

This Directive applies to every trade mark in respect of goods or services which is the subject of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee mark or which is the subject of an international registration having effect in a Member State.

Article 2

(1) Trade marks shall be refused registration or shall be invalidated if, on the date of application therefor, they consist of signs which, under the law of the Member State concerned, cannot constitute a trade mark or be held as such by the applicant, or if, on that date, they are devoid of distinctive character in a Member State, and in particular:

- a) those which consist solely of signs or indications which in trade may be requisite for the purpose of showing the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of

AMENDED PROPOSAL

Article 1

This Directive applies 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 mark, or which is the subject of an international registration having effect in a Member State.

Article 2

(1) Trade marks shall be refused registration or shall be invalidated if, on the date of application therefor, they consist of signs which, under the law of the Member State concerned, cannot constitute a trade mark or be held as such by the applicant, or if, on that date, they are devoid of distinctive character in that Member State, and in particular:

- a) Unchanged.

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rendering of the service or other characteristics of the goods or service, unless those marks have acquired distinctive character in consequence of the use made of them;

- b) those which consist solely of signs or indications which are customarily used to designate the goods or service in the current language of the trade or in the bona fide and established practices thereof.

(2) Trade marks shall also be refused registration or shall be invalidated if, on the date of application therefor,

- a) they consist of a shape which is determined by the nature of the goods or which has some technical consequence, or they consist of the shape of the goods and this affects their intrinsic value, to the extent that, in the Member State concerned, a shape may constitute a trade mark;
- b) they include signs or indications liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services;

- b) Unchanged

(2) Trade marks shall also be refused registration or shall be invalidated if, on the date of application therefor,

- a) Unchanged

- b) they are liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services;

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c) they are contrary to public order or to accepted principles of morality or are covered by Article 6 ter of the Paris Convention for the Protection of Industrial Property, hereinafter referred to as the "Paris Convention".

(3) A trade mark shall also be invalidated where the goods for which it is registered in the Member State concerned have been marketed in another Member State under another trade mark by the proprietor or with his consent, unless there are legitimate grounds which justify the use of different marks for those goods in those Member States; but this provision shall not apply if the proprietor decides to surrender, in respect of the goods in question, the trade mark that exists in the other Member State and furnishes proof, within the period laid down by the authority to which the application for invalidation is submitted, that the trade mark has been properly surrendered.

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c) they are contrary to public policy or to accepted principles of morality, or have not been authorized 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".

(3) Deleted

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(4) Trade marks for which application has been made prior to the date laid down in Article 18(1) or which are registered before that date shall be invalidated if any of the grounds specified in paragraphs 1 to 3 apply to them.

Article 3

(1) The trade mark confers on the proprietor thereof an exclusive right. That right entitles him to prohibit any third party from using, without his consent, in the course of trade a sign which is identical with or similar to the trade mark in relation of goods or services identical with or similar to those in respect of which application was made, where such use creates a serious likelihood of confusion on the part of the public.

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(4) Deleted.

Article 3

(1) The registered trade mark confers on the proprietor exclusive rights therein. The proprietor shall be entitled to prohibit any third party from using in the course of trade, save with his consent:

- a) 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;
- b) any sign which is identical with the trade mark in relation to goods or services which are similar to those for which the trade mark is registered, where, because of the similarity of the goods or services, such use involves a likelihood of confusion between the sign and the trade mark on the part of the public

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c) any sign which is similar to the trade mark in relation to goods or services which are identical with or similar to those for which the trade mark is registered, where, because of the similarity of the sign and the identity or similarity of the goods or services, such use involves a likelihood of confusion between the sign and the trade mark on the part of the public.

(2) Where the conditions specified in paragraph 1 are satisfied, the following types of use, in particular, may be prohibited:

- a) affixing the sign to the goods or to the packaging thereof;
- b) putting the goods on the market under that sign, or supplying services thereunder;
- c) using the sign on business correspondence or invoices.

(3) The Member States shall determine under what conditions compensation may be obtained for loss or damage caused by the acts mentioned in paragraph 1, and the rules of procedure which are to apply.

(2) Where the conditions specified in paragraph 1 are satisfied, the following in particular may be prohibited:

- a) Unchanged
- b) Unchanged
- c) using the sign on business papers.

(3) Unchanged

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Article 4

(1) The publisher of a dictionary, encyclopaedia or similar work shall ensure that any reproduction of a trade mark therein is accompanied by an indication that an application has been made for registration of the trade mark.

(2) Where the publisher fails to comply with the requirements of paragraph 1 he shall, at the request of the proprietor of the trade mark, correct the matter at his own expense in the next edition of the publication.

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(4) Where, under the law of the Member State, the use of an identical or similar sign in relation to similar goods could not be prohibited before the date referred to in Article 18(1), the rights conferred by the trade mark may not be relied on to prevent the continued use of the sign in relation to the goods concerned.

Article 4

(1) The publisher of a dictionary, encyclopaedia or similar work shall ensure that any reproduction of a trade mark therein is accompanied by an indication that the trade mark is registered, where the reproduction of this trade mark in such works gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered.

(2) Unchanged

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Article 5

The trade mark shall not entitle the proprietor thereof to prohibit a third party from using, in the course of trade,

- a) his surname or address;
- b) 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;
- c) the trade mark for the purpose of indicating the intended purpose of accessories or spare parts,

provided he does not use them as a trade mark.

Article 6

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

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Article 5

The trade mark shall not entitle the proprietor thereof to prohibit a third party from using, in the course of trade,

- a) his own name and address;
- b) Unchanged
- c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular accessories or spare parts,

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

Article 6

(1) The trade mark shall not entitle the proprietor thereof 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.

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(2) Paragraph 1 shall not apply:

- a) where there are legitimate grounds for opposing importation into the Community of goods put on the market outside it;
- b) where the condition of the goods is changed or impaired after they have been put on the market;
- c) where the goods are repackaged by a third party.

Article 7

The trade mark may be invoked against a licensee only if he contravenes a limitation with regard to a part of the goods or services in respect of which application has been made for registration of the trade mark, or contravenes the proprietor's instructions concerning the quality of

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(2) Paragraph 1 shall not apply where the condition of the goods is changed or impaired after they have been put on the market.

- a) Deleted
- b) Deleted
- c) Deleted

Article 7

The rights conferred by a trade mark may be invoked against a licensee only if he contravenes the limits on his licence with regard to its duration or to the licensed scope of the goods or services for which the trade mark is registered or does not comply with the proprietor's instructions in respect of the quality of the goods or services.

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Article 8

(1) A trade mark shall be refused registration or shall be invalidated:

a) on the ground that an earlier trade mark exists where those marks are likely to create confusion within the meaning of Article 3(1);

b) on the ground that some other exclusive prior right exists, where there is a serious likelihood of confusion on the part of the public between the trade mark and that right, unless the latter is a portrait, a surname or a work protected by copyright or by an industrial design or model.

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Article 8

(1) Unchanged

a) if it is identical with an earlier right, and the goods or services are identical with those for which the earlier right was registered in the cases referred to in paragraph 2(a) or (b) or has been used in the cases referred to in paragraph 2(c) or (d);

b) if it is identical with an earlier right, and the goods or services are similar to those for which the earlier right was registered in the cases referred to in paragraph 2(a) or (b) or has been used in the cases referred to in paragraph 2(c) or (d), with the result that there arises a likelihood of confusion between the trade mark applied for and the earlier right on the part of the public in the territory in which the earlier right has effect;

c) if it is similar to an earlier right, and the goods or services are identical with or similar to those for which the earlier right was registered in the cases referred to in paragraph 2(a) or (b)

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(2) Paragraph 1(b) shall also apply to prohibition of the use of a trade mark based on the existence of another exclusive prior right.

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or has been used in the cases referred to in paragraph 2(c) or (d), with the result that there arises a likelihood of confusion between the trade mark applied for and the earlier right on the part of the public in the territory in which the earlier right has effect.

(2) An "earlier right" means:

a) trade marks of the following kinds in respect of which the date of application for registration preceded 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,
- trade marks registered under international arrangements which have effect in the Member State;

b) application for the trade marks referred to in a), subject to their registration;

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- c) trade marks which, on the date of application for registration of the trade mark, are well known in the Member State, in the sense in which the words "well known" are used in Article 6a of the Paris Convention;
- d) any signs used in the business world before the application for registration of the trade mark which, under the law of the Member State governing them, confer on their proprietor the right to prohibit the use of subsequent trade marks;
- e) any signs containing:
- the name of a third person, where use of this name in relation to the goods or services for which the trade mark is applied for is liable to cause serious detriment to the honour, reputation or credit of that person,
 - a portrait of a third person,
 - a work of a third person protected by copyright or by an industrial model or design,
- so, however, that in any opposition, based on such a sign, to the registration of the trade mark or in proceedings to invalidate the trade mark the likelihood of confusion does not need to be established.

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Article 9

(1) Where, in the course of proceedings to oppose registration of a trade mark or to invalidate a trade mark or to prohibit the use of a trade mark, the authority seized of the matter considers that the conflict between that trade mark and another trade mark or other right is capable of being resolved amicably, it shall submit proposals to the parties for the purpose of imposing conditions on the use of the trade mark or of the other right in such manner that there will be no serious likelihood of confusion on the part of the public.

(2) Where the proprietor of the trade mark or of the other right is not party to the proceedings, the authority seized of the matter may order that he be summoned.

Article 10

(1) Where the proprietor of a trade mark or other exclusive right has for three consecutive years acquiesced in the use in

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Article 9

(1) Where, in the course of proceedings to oppose registration of a trade mark or to invalidate a trade mark or to prohibit the use of a trade mark, the authority seized of the matter considers that the conflict between that trade mark and another trade mark or other right is capable of being resolved amicably, it shall submit proposals to the parties for the purpose of imposing conditions on the use of the trade mark or of the other right in such manner that there will be no likelihood of confusion on the part of the public.

(2) Unchanged

Article 10

(1) Where, in a Member State, the proprietor of a registered trade mark or of any other earlier right referred to in Article 8 (2)

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a Member State of a later trade mark which is likely to create confusion with his trade mark or right, he shall not be entitled to apply for invalidation of the later trade mark or cause its use to be prohibited in that Member State or in another Member State except where the application for the later trade mark was made in bad faith.

(2) Paragraph 1 shall be without prejudice to the right of the proprietor of a trade mark which is well known in a Member State within the meaning of Article 6 bis of the Paris Convention to apply for the invalidation of a later trade mark or to cause its use to be prohibited in that State, within five years after the date of registration of the later trade mark.

Article 11

(1) A trade mark shall be put to serious use in the Member State concerned, consistently with the terms of this Directive, in connection with the goods or services in respect of which it is registered, unless there exist legitimate reasons for not doing so.

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a) to d) has acquiesced in the use of a later registered trade mark in that Member State for a period of three successive years, being aware of such use, he shall not be entitled 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 the later trade mark was applied for in bad faith.

(2) Unchanged

Article 11

(1) If, within a period of five years following registration, 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

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subject to the sanctions provided for in this Directive, unless there exist legitimate reasons for non-use.

(1a) The following shall also constitute use for the purposes of paragraph (1):

- a) 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;
- b) affixing of the trade mark to products or to the packaging thereof in the Member State solely for export purposes.

(2) Circumstances arising independently of the will of the proprietor of a trade mark are alone sufficient to constitute legitimate reasons for not using it.

(2) Unchanged

(3) Use of a trade mark by a licensee, by a person who is associated economically with the proprietor or by a person who is entitled to use a collective mark or guarantee mark shall be deemed to constitute use by the proprietor.

(3) Use of the trade mark with the consent of the proprietor or by a third party who is entitled to use a collective mark or guarantee mark shall be deemed to constitute use by the proprietor.

(4) In relation to trade marks for which application was made in the Member State concerned before the date laid down in Article 18(1), the provisions of this Article shall apply with effect from that date only.

(4) Unchanged

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Article 12

Where the law of a Member State provides that the existence of a trade mark may be averred in opposition to the registration of a later trade mark, it shall provide that, at the request of the applicant for registration or the competent authority, the party opposing registration shall furnish proof that the earlier trade mark has been used in the manner required by Article 11 during the five years preceding publication of the application for the later trade mark, on condition that on that date the earlier trade mark has been registered for not less than five years. In the absence of such proof, the opposition shall be rejected. Where the earlier trade mark has been used only in respect of part of the goods or services for which it was registered, it shall, for the purposes of examining the opposition, be deemed to be registered in respect only of that part of the goods or services.

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Article 12

Where the law of a Member State provides that the existence of a trade mark may be averred in opposition to the registration of a later trade mark, it shall provide that, at the request of the applicant for registration or the competent authority, the party opposing registration shall furnish proof that, during the period of five years preceding the date of publication of the later trade mark application, the earlier trade mark has been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or that there exist legitimate reasons for non-use, provided the earlier 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 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 the examination of the opposition, be deemed to be registered in respect only of that part.

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Article 13

Article 13

(1) Renewal of registration of a trade mark shall be subject to the production of a declaration of user, indicating the goods or services in respect of which the trade mark has been used in manner required by Article 11 during the five years preceding expiry of the registration.

(1) Deleted

(2) Where the declaration of user is produced in respect of only part of the goods or services for which the trade mark is registered, registration shall be renewed only for that part of the goods or services.

(2) Deleted

(3) The laws of the Member States shall determine the procedure for presenting the declaration of user and the penalties applicable where a false declaration is made.

(3) Deleted

Article 14

Article 14

(1) A trade mark shall be invalidated if it has not been used in manner required by Article 11 for an unbroken period of five years; but a trade mark is not to be invalidated where, between the expiry of that period and the date on which the validity of the trade mark is

(1) A trade mark shall be invalidated if, within an uninterrupted 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, unless there exist legitimate reasons for non-use; but a trade mark shall

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contested, it has been used in good faith and in a manner required by Article 11.

(2) A trade mark shall also be invalidated if, after the date on which it was registered,

a) it has become, in consequence of acts of the proprietor, the common name for a product or service in respect whereof is registered;

b) it is liable, in consequence of the use made of it in respect of the goods or services for which it is registered, to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Article 15

Where a ground for refusal of registration or for invalidation of a trade mark exists in respect of only part of the goods or services for which that mark has been applied for or registered, refusal of registration or invalidation shall cover only the goods or services concerned.

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not be invalidated where, after the expiry of that period and before the date on which the validity of the trade mark is contested, use of the trade mark has been started or resumed in good faith.

(2) Unchanged

a) 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;

b) Unchanged

Article 15

Unchanged.

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Article 16

Article 16

Without prejudice to Article 8, Member States whose laws authorize the registration of collective marks or guarantee marks may provide that such marks be refused registration, or shall be invalidated, on other grounds than those specified in Articles 2 and 14 where the function of those marks so requires.

Unchanged

Article 17

Article 17

The laws of the Member State shall determine the procedure for registration and for invalidation of trade marks and the effects of invalidation. They may further provide that a trade mark to which one of the grounds for invalidation mentioned in this Directive applies shall not be capable of defeating the claims of third parties.

Unchanged

Article 17a

The symbol composed of a capital letter R contained within a circle, thus (R) may be used to indicate a registered trade mark.

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Article 18

Article 18

(1) The Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than...
They shall immediately inform the Commission thereof.

(1) Unchanged

(2) The Member States shall communicate to the Commission the text of the main provisions of national law which they adopt in the field governed by this Directive.

(2) Unchanged

Article 19

Article 19

This Directive is addressed to the Member States.

Unchanged