

Council Regulation (EC) No 40/94 of 20 December
1993 on the Community trade mark (repealed)

TITLE VI

SURRENDER, REVOCATION AND INVALIDITY

SECTION 1

SURRENDER

Article 49

Surrender

- 1 A Community trade mark may be surrendered in respect of some or all of the goods or services for which it is registered.
- 2 The surrender shall be declared to the Office in writing by the proprietor of the trade mark. It shall not have effect until it has been entered in the Register.
- 3 Surrender shall be entered only with the agreement of the proprietor of a right entered in the Register. If a licence has been registered, surrender shall only be entered in the Register if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry shall be made on expiry of the period prescribed by the Implementing Regulation.

SECTION 2

GROUND FOR REVOCATION

Article 50

Grounds for revocation

- 1 The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:
 - a if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where

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preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;

- b if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered;
- c if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services^[F1].

[F2(d)] ^{F2}

2 Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

Textual Amendments

- F1** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).
- F2** Deleted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

SECTION 3

GROUNDS FOR INVALIDITY

Article 51

Absolute grounds for invalidity

1 A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings,

- [F1a where the Community trade mark has been registered contrary to the provisions of Article 7;]
- b where the applicant was acting in bad faith when he filed the application for the trade mark.

2 Where the Community trade mark has been registered in breach of the provisions of Article 7 (1) (b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

3 Where the ground for invalidity exists in respect of only some of the goods or services for which the Community trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

Textual Amendments

- F1** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

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Article 52

Relative grounds for invalidity

1 A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

- a where there is an earlier trade mark as referred to in Article 8 (2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled;
- b where there is a trade mark as referred to in Article 8 (3) and the conditions set out in that paragraph are fulfilled;
- c where there is an earlier right as referred to in Article 8 (4) and the conditions set out in that paragraph are fulfilled.

[^{F12} A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right, and in particular:

- a a right to a name;
- b a right of personal portrayal;
- c a copyright;
- d an industrial property right;

under the Community legislation or national law governing the protection.]

3 A Community trade mark may not be declared invalid where the proprietor of a right referred to in paragraphs 1 or 2 consents expressly to the registration of the Community trade mark before submission of the application for a declaration of invalidity or the counterclaim.

4 Where the proprietor of one of the rights referred to in paragraphs 1 or 2 has previously applied for a declaration that a Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the said rights which he could have invoked in support of his first application or counterclaim.

5 Article 51 (3) shall apply.

Textual Amendments

- F1** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\)](#).

Article 53

Limitation in consequence of acquiescence

1 Where the proprietor of a Community trade mark has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Community while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark 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 registration of the later Community trade mark was applied for in bad faith.

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2 Where the proprietor of an earlier national trade mark as referred to in Article 8 (2) or of another earlier sign referred to in Article 8 (4) has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign 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 registration of the later Community trade mark was applied for in bad faith.

3 In the cases referred to in paragraphs 1 and 2, the proprietor of a later Community trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later Community trade mark.

SECTION 4

CONSEQUENCES OF REVOCATION AND INVALIDITY

Article 54

Consequences of revocation and invalidity

1 The Community trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

2 The Community trade mark shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that the trade mark has been declared invalid.

3 Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the proprietor of the trade mark, or to unjust enrichment, the retroactive effect of revocation or invalidity of the trade mark shall not affect:

- a any decision on infringement which has acquired the authority of a final decision and been enforced prior to the revocation or invalidity decision;
- b any contract concluded prior to the revocation or invalidity decision, in so far as it has been performed before that decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract, may be claimed on grounds of equity.

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SECTION 5

PROCEEDINGS IN THE OFFICE IN RELATION TO REVOCATION OR INVALIDITY

Article 55

Application for revocation or for a declaration of invalidity

- 1 An application for revocation of the rights of the proprietor of a Community trade mark or for a declaration that the trade mark is invalid may be submitted to the Office:
 - a where Articles 50 and 51 apply, by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, which under the terms of the law governing it has the capacity in its own name to sue and be sued;
 - b where Article 52 (1) applies, by the persons referred to in Article 42 (1);
 - c where Article 52 (2) applies, by the owners of the earlier rights referred to in that provision or by the persons who are entitled under the law of the Member State concerned to exercise the rights in question.
- 2 The application shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the fee has been paid.
- 3 An application for revocation or for a declaration of invalidity shall be inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a court in a Member State and has acquired the authority of a final decision.

Article 56

Examination of the application

- 1 On the examination of the application for revocation of rights or for a declaration of invalidity, the Office shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Office, on communications from the other parties or issued by itself.
- 2 If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 43 (2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

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3 Paragraph 2 shall apply to earlier national trade marks referred to in Article 8 (2) (a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

4 The Office may, if it thinks fit, invite the parties to make a friendly settlement.

5 If the examination of the application for revocation of rights or for a declaration of invalidity reveals that the trade mark should not have been registered in respect of some or all of the goods or services for which it is registered, the rights of the proprietor of the Community trade mark shall be revoked or it shall be declared invalid in respect of those goods or services. Otherwise the application for revocation of rights or for a declaration of invalidity shall be rejected.

[^{F16} A record of the Office's decision on the application for revocation of rights or for a declaration of invalidity shall be entered in the Register once it has become final.]

Textual Amendments

- F1** Substituted by [Council Regulation \(EC\) No 422/2004 of 19 February 2004 amending Regulation \(EC\) No 40/94 on the Community trade mark \(Text with EEA relevance\).](#)

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