

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1993 on the Community trade mark (repealed)

TITLE X

**JURISDICTION AND PROCEDURE IN LEGAL ACTIONS  
RELATING TO COMMUNITY TRADE MARKS**

SECTION 1

**APPLICATION OF THE CONVENTION  
ON JURISDICTION AND ENFORCEMENT**

*Article 90*

**Application of the Convention on Jurisdiction and Enforcement**

1 Unless otherwise specified in this Regulation, the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, signed in Brussels on 27 September 1968, as amended by the Conventions on the Accession to that Convention of the States acceding to the European Communities, the whole of which Convention and of which Conventions of Accession are hereinafter referred to as the 'Convention on Jurisdiction and Enforcement', shall apply to proceedings relating to Community trade marks and applications for Community trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of Community trade marks and national trade marks.

- 2 In the case of proceedings in respect of the actions and claims referred to in Article 92:
- a Articles 2, 4, 5 (1), (3), (4) and (5) and Article 24 of the Convention on Jurisdiction and Enforcement shall not apply;
  - b Articles 17 and 18 of that Convention shall apply subject to the limitations in Article 93 (4) of this Regulation;
  - c the provisions of Title II of that Convention which are applicable to persons domiciled in a Member State shall also be applicable to persons who do not have a domicile in any Member State but have an establishment therein.

SECTION 2

**DISPUTES CONCERNING THE INFRINGEMENT  
AND VALIDITY OF COMMUNITY TRADE MARKS**

*Article 91*

**Community trade mark courts**

1 The Member States shall designate in their territories as limited a number as possible of national courts and tribunals of first and second instance, hereinafter referred to as 'Community trade mark courts', which shall perform the functions assigned to them by this Regulation.

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2 Each Member State shall communicate to the Commission within three years of the entry into force of this Regulation a list of Community trade mark courts indicating their names and their territorial jurisdiction.

3 Any change made after communication of the list referred to in paragraph 2 in the number, names or territorial jurisdiction of the courts shall be notified without delay by the Member State concerned to the Commission.

4 The information referred to in paragraphs 2 and 3 shall be notified by the Commission to the Member States and published in the *Official Journal of the European Communities*.

5 As long as a Member State has not communicated the list as stipulated in paragraph 2, jurisdiction for any proceedings resulting from an action or application covered by Article 92, and for which the courts of that State have jurisdiction under Article 93, shall lie with that court of the State in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national trade mark registered in that State.

#### Article 92

### Jurisdiction over infringement and validity

The Community trade mark courts shall have exclusive jurisdiction:

- (a) for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to Community trade marks;
- (b) for actions for declaration of non-infringement, if they are permitted under national law;
- (c) for all actions brought as a result of acts referred to in Article 9 (3), second sentence;
- (d) for counterclaims for revocation or for a declaration of invalidity of the Community trade mark pursuant to Article 96.

#### Article 93

### International jurisdiction

1 Subject to the provisions of this Regulation as well as to any provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 90, proceedings in respect of the actions and claims referred to in Article 92 shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

2 If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

3 If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

4 Notwithstanding the provisions of paragraphs 1, 2 and 3:

- a Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a different Community trade mark court shall have jurisdiction;

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- b Article 18 of that Convention shall apply if the defendant enters an appearance before a different Community trade mark court.

5 Proceedings in respect of the actions and claims referred to in Article 92, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9 (3), second sentence, has been committed.

#### *Article 94*

### **Extent of jurisdiction**

1 A Community trade mark court whose jurisdiction is based on Article 93 (1) to (4) shall have jurisdiction in respect of:

- acts of infringement committed or threatened within the territory of any of the Member States,
- acts within the meaning of Article 9 (3), second sentence, committed within the territory of any of the Member States.

2 A Community trade mark court whose jurisdiction is based on Article 93 (5) shall have jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which that court is situated.

#### *Article 95*

### **Presumption of validity — Defence as to the merits**

1 The Community trade mark courts shall treat the Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity.

2 The validity of a Community trade mark may not be put in issue in an action for a declaration of non-infringement.

3 In the actions referred to in Article 92 (a) and (c) a plea relating to revocation or invalidity of the Community trade mark submitted otherwise than by way of a counterclaim shall be admissible in so far as the defendant claims that the rights of the proprietor of the Community trade mark could be revoked for lack of use or that Community trade mark could be declared invalid on account of an earlier right of the defendant.

#### *Article 96*

### **Counterclaims**

1 A counterclaim for revocation or for a declaration of invalidity may only be based on the grounds for revocation or invalidity mentioned in this Regulation.

2 A Community trade mark court shall reject a counterclaim for revocation or for a declaration of invalidity if a decision taken by the Office relating to the same subject matter and cause of action and involving the same parties has already become final.

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3 If the counterclaim is brought in a legal action to which the proprietor of the trade mark is not already a party, he shall be informed thereof and may be joined as a party to the action in accordance with the conditions set out in national law.

4 The Community trade mark court with which a counterclaim for revocation or for a declaration of invalidity of the Community trade mark has been filed shall inform the Office of the date on which the counterclaim was filed. The latter shall record this fact in the Register of Community trade marks.

[<sup>F15</sup> Article 56(2) to (5) shall apply.]

6 Where a Community trade mark court has given a judgment which has become final on a counterclaim for revocation or for invalidity of a Community trade mark, a copy of the judgment shall be sent to the Office. Any party may request information about such transmission. The Office shall mention the judgment in the Register of Community trade marks in accordance with the provisions of the Implementing Regulation.

7 The Community trade mark court hearing a counterclaim for revocation or for a declaration of invalidity may stay the proceedings on application by the proprietor of the Community trade mark and after hearing the other parties and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office within a time limit which it shall determine. If the application is not made within the time limit, the proceedings shall continue; the counterclaim shall be deemed withdrawn. Article 100 (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 97

#### Applicable law

1 The Community trade mark courts shall apply the provisions of this Regulation.

2 On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.

3 Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State where it has its seat.

#### Article 98

#### Sanctions

1 Where a Community trade mark court finds that the defendant has infringed or threatened to infringe a Community trade mark, it shall, unless there are special reasons for not doing so, issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark. It shall also take such measures in accordance with its national law as are aimed at ensuring that this prohibition is complied with.

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2 In all other respects the Community trade mark court shall apply the law of the Member State to which the acts of infringement or threatened infringement were committed, including the private international law.

#### *Article 99*

### **Provisional and protective measures**

1 Application may be made to the courts of a Member State, including Community trade mark courts, for such provisional, including protective, measures in respect of a Community trade mark or Community trade mark application as may be available under the law of that State in respect of a national trade mark, even if, under this Regulation, a Community trade mark court of another Member State has jurisdiction as to the substance of the matter.

2 A Community trade mark court whose jurisdiction is based on Article 93 (1), (2), (3) or (4) shall have jurisdiction to grant provisional and protective measures which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of the Convention on Jurisdiction and Enforcement, are applicable in the territory of any Member State. No other court shall have such jurisdiction.

#### *Article 100*

### **Specific rules on related actions**

1 A Community trade mark court hearing an action referred to in Article 92, other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue before another Community trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office.

2 The Office, when hearing an application for revocation or for a declaration of invalidity shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue on account of a counterclaim before a Community trade mark court. However, if one of the parties to the proceedings before the Community trade mark court so requests, the court may, after hearing the other parties to these proceedings, stay the proceedings. The Office shall in this instance continue the proceedings pending before it.

3 Where the Community trade mark court stays the proceedings it may order provisional and protective measures for the duration of the stay.

#### *Article 101*

### **Jurisdiction of Community trade mark courts of second instance — Further appeal**

1 An appeal to the Community trade mark courts of second instance shall lie from judgments of the Community trade mark courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 92.

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2 The conditions under which an appeal may be lodged with a Community trade mark court of second instance shall be determined by the national law of the Member State in which that court is located.

3 The national rules concerning further appeal shall be applicable in respect of judgments of Community trade mark courts of second instance.

### SECTION 3

#### OTHER DISPUTES CONCERNING COMMUNITY TRADE MARKS

##### *Article 102*

#### **Supplementary provisions on the jurisdiction of national courts other than Community trade mark courts**

1 Within the Member State whose courts have jurisdiction under Article 90 (1) those courts shall have jurisdiction for actions other than those referred to in Article 92, which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to a national trade mark registered in that State.

2 Actions relating to a Community trade mark, other than those referred to in Article 92, for which no court has jurisdiction under Article 90 (1) and paragraph 1 of this Article may be heard before the courts of the Member State in which the Office has its seat.

##### *Article 103*

#### **Obligation of the national court**

A national court which is dealing with an action relating to a Community trade mark, other than the action referred to in Article 92, shall treat the trade mark as valid.

### SECTION 4

#### TRANSITIONAL PROVISION

##### *Article 104*

#### **Transitional provision relating to the application of the Convention on Jurisdiction and Enforcement**

The provisions of the Convention on Jurisdiction and Enforcement which are rendered applicable by the preceding Articles shall have effect in respect of any Member State solely in the text of the Convention which is in force in respect of that State at any given time.

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