

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1993 on the Community trade mark (repealed)

TITLE XI

EFFECTS ON THE LAWS OF THE MEMBER STATES

SECTION 1

CIVIL ACTIONS ON THE BASIS OF MORE THAN ONE TRADE MARK

Article 105

**Simultaneous and successive civil actions on the basis
of Community trade marks and national trade marks**

1 Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of a Community trade mark and the other seized on the basis of a national trade mark:

- a the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested;
- b the court other than the court first seized may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.

2 The court hearing an action for infringement on the basis of a Community trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical national trade mark valid for identical goods or services.

3 The court hearing an action for infringement on the basis of a national trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical Community trade mark valid for identical goods or services.

4 Paragraphs 1, 2 and 3 shall not apply in respect of provisional, including protective, measures.

Status: Point in time view as at 25/07/2005.

Changes to legislation: There are currently no known outstanding effects for the Council Regulation (EC) No 40/94 (repealed), TITLE XI. (See end of Document for details)

SECTION 2

APPLICATION OF NATIONAL LAWS FOR THE PURPOSE OF PROHIBITING THE USE OF COMMUNITY TRADE MARKS

Article 106

Prohibition of use of Community trade marks

1 This Regulation shall, unless otherwise provided for, not affect the right existing under the laws of the Member States to invoke claims for infringement of earlier rights within the meaning of Article 8 or Article 52 (2) in relation to the use of a later Community trade mark. Claims for infringement of earlier rights within the meaning of Article 8 (2) and (4) may, however, no longer be invoked if the proprietor of the earlier right may no longer apply for a declaration that the Community trade mark is invalid in accordance with Article 53 (2).

2 This Regulation shall, unless otherwise provided for, not affect the right to bring proceedings under the civil, administrative or criminal law of a Member State or under provisions of Community law for the purpose of prohibiting the use of a Community trade mark to the extent that the use of a national trade mark may be prohibited under the law of that Member State or under Community law.

Article 107

Prior rights applicable to particular localities

1 The proprietor of an earlier right which only applies to a particular locality may oppose the use of the Community trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.

2 Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the Community trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the Community trade mark was applied for in bad faith.

3 The proprietor of the Community trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though that right may no longer be invoked against the Community trade mark.

SECTION 3

CONVERSION INTO A NATIONAL TRADE MARK APPLICATION

Article 108

Request for the application of national procedure

1 The applicant for or proprietor of a Community trade mark may request the conversion of his Community trade mark application or Community trade mark into a national trade mark application

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- a to the extent that the Community trade mark application is refused, withdrawn, or deemed to be withdrawn;
 - b to the extent that the Community trade mark ceases to have effect.
- 2 Conversion shall not take place:
- a where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;
 - b for the purpose of protection in a Member State in which, in accordance with the decision of the Office or of the national court, grounds for refusal of registration or grounds for revocation or invalidity apply to the Community trade mark application or Community trade mark.
- 3 The national trade mark application resulting from the conversion of a Community trade mark application or a Community trade mark shall enjoy in respect of the Member State concerned the date of filing or the date of priority of that application or trade mark and, where appropriate, the seniority of a trade mark of that State claimed under Article 34 or 35.
- [^{F14} In cases where a Community trade mark application is deemed to be withdrawn, the Office shall send to the applicant a communication fixing a period of three months from the date of that communication in which a request for conversion may be filed.
- 5 Where the Community trade mark application is withdrawn or the Community trade mark ceases to have effect as a result of a surrender being recorded or of failure to renew the registration, the request for conversion shall be filed within three months after the date on which the Community trade mark application has been withdrawn or on which the Community trade mark ceases to have effect.
- 6 Where the Community trade mark application is refused by decision of the Office or where the Community trade mark ceases to have effect as a result of a decision of the Office or of a Community trade mark court, the request for conversion shall be filed within three months after the date on which that decision acquired the authority of a final decision.]
- 7 The effect referred to in Article 32 shall lapse if the request is not filed in due time.

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 109

Submission, publication and transmission of the request for conversion

- 1 A request for conversion shall be filed with the Office and shall specify the Member States in which application of the procedure for registration of a national trade mark is desired. The request shall not be deemed to be filed until the conversion fee has been paid.
- 2 If the Community trade mark application has been published, receipt of any such request shall be recorded in the Register of Community trade marks and the request for conversion shall be published.

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[^{F13} The Office shall check whether the conversion requested fulfils the conditions set out in this Regulation, in particular Article 108(1), (2), (4), (5) and (6), and paragraph 1 of this Article, together with the formal conditions laid down in the Implementing Regulation. If these conditions are fulfilled, the Office shall transmit the request for conversion to the industrial property offices of the Member States specified therein.]

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 110

Formal requirements for conversion

[^{F11} Any central industrial property office to which the request for conversion is transmitted may obtain from the Office any additional information concerning the request enabling that office to make a decision regarding the national trade mark resulting from the conversion.]

2 A Community trade mark application or a Community trade mark transmitted in accordance with Article 109 shall not be subjected to formal requirements of national law which are different from or additional to those provided for in this Regulation or in the Implementing Regulation.

3 Any central industrial property office to which the request is transmitted may require that the applicant shall, within not less than two months:

- a pay the national application fee;
- b file a translation in one of the official languages of the State in question of the request and of the documents accompanying it;
- c indicate an address for service in the State in question;
- d supply a representation of the trade mark in the number of copies specified by the State in question.

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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