

Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) (Text with EEA relevance) (repealed)

TITLE II

**THE LAW RELATING TO TRADE MARKS**

SECTION 4

**Community trade marks as objects of property**

*Article 16*

**Dealing with Community trade marks as national trade marks**

1 Unless Articles 17 to 24 provide otherwise, a Community trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national trade mark registered in the Member State in which, according to the Register of Community trade marks:

- a the proprietor has his seat or his domicile on the relevant date;
- b where point (a) does not apply, the proprietor has an establishment on the relevant date.

2 In cases which are not provided for by paragraph 1, the Member State referred to in that paragraph shall be the Member State in which the seat of the Office is situated.

3 If two or more persons are mentioned in the Register of Community trade marks as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply.

*Article 17*

**Transfer**

1 A Community trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.

2 A transfer of the whole of the undertaking shall include the transfer of the Community trade mark except where, in accordance with the law governing the transfer, there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

3 Without prejudice to paragraph 2, an assignment of the Community trade mark shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

4 Where it is clear from the transfer documents that because of the transfer the Community trade mark is likely to mislead the public concerning the nature, quality or geographical origin of the goods or services in respect of which it is registered, the Office shall

not register the transfer unless the successor agrees to limit registration of the Community trade mark to goods or services in respect of which it is not likely to mislead.

5 On request of one of the parties a transfer shall be entered in the Register and published.

6 As long as the transfer has not been entered in the Register, the successor in title may not invoke the rights arising from the registration of the Community trade mark.

7 Where there are time limits to be observed vis-à-vis the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office.

8 All documents which require notification to the proprietor of the Community trade mark in accordance with Article 79 shall be addressed to the person registered as proprietor.

#### *Article 18*

### **Transfer of a trade mark registered in the name of an agent**

Where a Community trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment in his favour of the said registration, unless such agent or representative justifies his action.

#### *Article 19*

### **Rights *in rem***

1 A Community trade mark may, independently of the undertaking, be given as security or be the subject of rights *in rem*.

2 On request of one of the parties, rights mentioned in paragraph 1 shall be entered in the Register and published.

#### *Article 20*

### **Levy of execution**

1 A Community trade mark may be levied in execution.

2 As regards the procedure for levy of execution in respect of a Community trade mark, the courts and authorities of the Member States determined in accordance with Article 16 shall have exclusive jurisdiction.

3 On request of one the parties, levy of execution shall be entered in the Register and published.

## Article 21

### Insolvency proceedings

1 The only insolvency proceedings in which a Community trade mark may be involved are those opened in the Member State in the territory of which the debtor has his centre of main interests.

However, where the debtor is an insurance undertaking or a credit institution as defined in Directive 2001/17/EC of the European Parliament and of the Council of 19 March 2001 on the reorganisation and winding-up of insurance undertakings<sup>(1)</sup> and Directive 2001/24/EC of the European Parliament and of the Council of 4 April 2001 on the reorganisation and winding up of credit institutions<sup>(2)</sup>, respectively, the only insolvency proceedings in which a Community trademark may be involved are those opened in the Member State where that undertaking or institution has been authorised.

2 In the case of joint proprietorship of a Community trade mark, paragraph 1 shall apply to the share of the joint proprietor.

3 Where a Community trade mark is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the Register and published in the Community Trade Marks Bulletin referred to in Article 89.

## Article 22

### Licensing

1 A Community trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Community. A licence may be exclusive or non-exclusive.

2 The proprietor of a Community trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to:

- a its duration;
- b the form covered by the registration in which the trade mark may be used;
- c the scope of the goods or services for which the licence is granted;
- d the territory in which the trade mark may be affixed; or
- e the quality of the goods manufactured or of the services provided by the licensee.

3 Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community trade mark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

4 A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor of the Community trade mark.

5 On request of one of the parties the grant or transfer of a licence in respect of a Community trade mark shall be entered in the Register and published.

### *Article 23*

#### **Effects vis-à-vis third parties**

1 Legal acts referred to in Articles 17, 19 and 22 concerning a Community trade mark shall have effects vis-à-vis third parties in all the Member States only after entry in the Register. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired.

2 Paragraph 1 shall not apply in the case of a person who acquires the Community trade mark or a right concerning the Community trade mark by way of transfer of the whole of the undertaking or by any other universal succession.

3 The effects vis-à-vis third parties of the legal acts referred to in Article 20 shall be governed by the law of the Member State determined in accordance with Article 16.

4 Until such time as common rules for the Member States in the field of bankruptcy enter into force, the effects vis-à-vis third parties of bankruptcy or like proceedings shall be governed by the law of the Member State in which such proceedings are first brought within the meaning of national law or of conventions applicable in this field.

### *Article 24*

#### **The application for a Community trade mark as an object of property**

Articles 16 to 23 shall apply to applications for Community trade marks.

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*Status: This is the original version (as it was originally adopted).*

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- (1) OJ L 110, 20.4.2001, p. 28.
- (2) OJ L 125, 5.5.2001, p. 15.