



Council of the  
European Union

051208/EU XXVI. GP  
Eingelangt am 23/01/19

Brussels, 23 January 2019  
(OR. en)

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**Interinstitutional Files:**

1996/0190 (CNS)

1996/0198 (CNS)

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6294/98  
DCL 1

PI 9

**DECLASSIFICATION**

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of document: ST 6294/98 RESTREINT

dated: 25 February 1998

new status: Public

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Subject: Link between the Community Trade Mark and the Madrid Protocol  
-Proposal for a Council Decision approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27 June 1989  
-Proposal for a Council Regulation modifying Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted on 27 June 1989

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Delegations will find attached the declassified version of the above document.

The text of this document is identical to the previous version.

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6294/98  
RESTREINT  
PI 9

Interinstitutional  
File No 96/0190 (CNS)  
96/0198 (CNS)

NOTE

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from : Presidency  
to: Permanent Representatives Committee (Part 1)

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No. prev. doc.: 11719/97 PI 48 + ADD 1  
No. Cion prop.: 9497/96 PI 47 and 9530/96 PI 48

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**I. INTRODUCTION**

1. This matter was last discussed in the Permanent Representatives Committee on 12 November 1997 on the basis of Presidency reports in 11719/97 PI 48 + ADD 1. Following that meeting, the language questions (11719/97 ADD 1) and the second conversion option (11719/97, points 10 to 13) remain unresolved. With regard to the question of a Council minutes statement relating to the proposal for a Decision (11719/97, points 6 to 9), the Committee signified its approval of the statement as proposed by the Commission representatives (Annex I to this note).

2. The United States of America have raised a further question relating to voting rights under the Madrid Protocol (section V below).
3. The Presidency, which considers that the key issue is the language question, sets out below its suggestions for dealing with the issues outstanding.

## **II. LANGUAGE QUESTIONS**

4. The outstanding questions relating to languages concern Articles 142 (11719/97 ADD 1, points 3 to 5) and 157 (11719/97 ADD 1, points 6 to 7) of the proposal for a Regulation.
5. With regard to Article 142, there appears to be broad agreement on the text of this Article as set out in Annex II to 11719/97 ADD 1, subject to the resolution of the problem described in 11719/97 ADD 1, point 4. The Presidency suggests that the text in that Annex be supplemented by a new recital as follows:

"Whereas, with regard to an international application based on an application for a Community trade mark or on a Community trade mark, the Office should make its best efforts to send written communications to the applicant in the language of filing of the international application;"

6. With regard to Article 157, the Presidency considers that, since by virtue of Article 140 the provisions of Article 115 of Regulation No 40/94 will apply mutatis mutandis to international applications designating the Community unless otherwise specified in the proposal for a Regulation, Article 157 is not essential. The Presidency therefore suggests that Article 157 be deleted.

## **III. SECOND CONVERSION OPTION PROVIDED FOR IN ARTICLE 154 OF THE PROPOSED REGULATION**

7. The Presidency suggests that Article 154 be adopted as set out in Annex III to 11719/97, for the reasons given in 11719/97, point 12.

#### **IV. STATEMENT FOR THE COUNCIL MINUTES RELATING TO THE PROPOSAL FOR A DECISION**

8. The Presidency suggests that the Permanent Representatives Committee confirm its approval of the statement as set out in Annex I to this note.

#### **V. VOTING RIGHTS UNDER THE MADRID PROTOCOL**

9. Not only does the Madrid Protocol make provision for the Community as such to become party to the Protocol, it also provides that the Community, as a Contracting Party, will be entitled to a vote in its own right, in addition to the votes of the Member States, in the Assembly of the Madrid Union. This "additional" vote for the Community was sought and obtained on the grounds that, under the Community trade mark Regulation, the Community has its own trade mark system and trade mark office alongside those of the Member States and that the Community, as a Contracting Party, should enjoy the same rights and obligations as other Contracting Parties.

The United States of America have always been opposed as a matter of principle to the Community and its Member States being entitled to a greater number of votes in any international forum than the number of Community Member States. United States industry is strongly in favour of United States accession to the Madrid Protocol. However, the United States Government has opposed accession on the grounds of the Community "additional" vote. The United States authorities now propose an understanding between the United States and the European Community and its Member States which does not require revision of the Madrid Protocol, but would entail an undertaking on the Community side that its "additional" vote would not be exercised in certain circumstances (see Annex II to this note). Once agreement were reached on such an understanding, it could take the form of an exchange of letters.

10. The Presidency invites the Permanent Representatives Committee to consider how the Community should respond to the United States suggestions.

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**Draft statement**  
**by the Commission, the Council and the representatives**  
**of the Governments of the Member States meeting**  
**within the Council**

(to be entered in the minutes of the Council meeting at which the Decision is adopted)

In the event of matters coming under the shared competence of the Community and its Member States being involved in future negotiations in the Madrid Union Assembly, the Commission, the Council and the representatives of the Governments of the Member States reiterate the obligation for the Member States and the Community Institutions to cooperate which results from Opinion 1/94 of the Court of Justice.

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**Understanding proposed by the United States of America**

The United States of America and the European Community and its Member States affirm their commitment to a consensus-based decision process within the Assembly of the Madrid Union. However, if a vote is called for, the United States of America, the European Community and its Member States will undertake to consult each other with a view to finding a mutually satisfactory solution and will consult like-minded participants.

The vote of the European Community will not be used where a mutually satisfactory solution cannot be found.

The European Union and its Member States note that the United States of America's participation in the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks is without prejudice to the United States position regarding the European Community voting in international organizations.

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