
STATUTORY INSTRUMENTS

2004 No. 2332

TRADE MARKS

The Trade Marks (International Registrations Designating
the European Community, etc.) Regulations 2004

<i>Made</i>	- - - -	<i>7th September 2004</i>
<i>Laid before Parliament</i>		<i>9th September 2004</i>
<i>Coming into force</i>		
<i>Regulations 10 and 13</i>		<i>1st November 2004</i>
<i>Regulation 15</i>		<i>1st April 2005</i>
<i>Remainder</i>		<i>1st October 2004</i>

The Secretary of State, being a Minister designated⁽¹⁾ for the purposes of section 2(2) of the European Communities Act 1972⁽²⁾ in relation to measures relating to patents and to trade marks, in exercise of the powers conferred on her by that section and by section 52 of the Trade Marks Act 1994⁽³⁾, hereby makes the following Regulations:

PART 1

GENERAL

Citation, commencement and interpretation

1.—(1) These Regulations may be cited as the Trade Marks (International Registrations Designating the European Community, etc.) Regulations 2004.

(2) These Regulations (other than the regulations referred to in paragraph (3)) shall come into force on 1st October 2004.

(3) Regulations 10 and 13 shall come into force on 1st November 2004, and regulation 15 shall come into force on 1st April 2005.

(4) In these Regulations—

(1) S.I. 1995/2983.

(2) 1972 c. 68.

(3) 1994 c. 26; amendments of the Act relevant to these Regulations have been made by S.I. 2004/946.

- (a) “the 1994 Act” means the Trade Marks Act 1994 (and a reference to a numbered section is to a section of that Act);
- (b) “the 1996 Regulations” means the Community Trade Mark Regulations 1996(4) (and a reference to a numbered regulation is to a regulation of those Regulations).

PART 2

INTERNATIONAL REGISTRATIONS DESIGNATING THE EUROPEAN COMMUNITY

Amendment of the 1994 Act

- 2. The 1994 Act is amended as follows.
- 3. In section 5(3) (earlier trade marks with a reputation), after “Community trade mark” insert “or international trade mark (EC)”.
- 4. In section 6(1) (meaning of “earlier trade mark”)—
 - (a) in paragraph (a), for “or Community trade mark” substitute “, Community trade mark or international trade mark (EC)”; and
 - (b) for paragraph (b) substitute—
 - “(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),
 - (ba) a registered trade mark or international trade mark (UK) which—
 - (i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and
 - (ii) accordingly has the same claim to seniority, or”.
- 5. In section 53 (the Madrid Protocol), after the definition of “the International Bureau” insert—

““international trade mark (EC)” means a trade mark which is entitled to protection in the European Community under that Protocol;”.
- 6. In section 104 (index of defined expressions), after the entry for “the International Bureau”, insert—

“international trade mark (EC)section 53”.

Amendment of the 1996 Regulations

- 7. The 1996 Regulations are amended as follows.
- 8. In regulation 2 (interpretation), after the definition of “the Community Trade Mark Regulation” insert—

““the International Bureau”, “international trade mark (EC)”, “international trade mark (UK)” and “the Madrid Protocol” have the meanings given in section 53;

“international application” means an application to the International Bureau for registration of a trade mark in the International Register;

(4) S.I. 1996/1908, which has been amended by S.I. 2004/949.

“international application designating the European Community” means an international application in which a request has been made for extension of protection to the European Community under Article 3ter(1) of the Madrid Protocol;

“International Register” means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol;

“international registration” means the registration of a trade mark in the International Register;

“international registration designating the European Community” means an international registration in relation to which a request has been made (either in the relevant international application or subsequently) for extension of protection to the European Community under Article 3ter(1) or (2) of the Madrid Protocol;”.

9.—(1) In regulation 3(1) (determination *a posteriori* of invalidity and liability to revocation), after “Community trade mark” insert “or of an international trade mark (EC)”.

(2) After that paragraph insert—

“(1A) Where such a proprietor claims the seniority of an international trade mark (UK) which has been removed from the International Register or surrendered, application may be made to the registrar or to the court by any person for a declaration that, if the international trade mark (UK) had not been so removed or surrendered, its protection would have been liable to be revoked under section 46 or declared invalid under section 47 (as applied by article 13 of the Trade Marks (International Registration) Order 1996(5)).”.

(3) In regulation 3(2), for “a registered” substitute “the”, and after “paragraph (1)” insert “or (1A)”.

(4) In regulation 3(3) and in regulation 3(4), after “paragraph (1)” insert “or (1A)”.

10. For regulation 4 substitute—

“Groundless threats of infringement proceedings

4.—(1) The provisions of section 21 apply in relation to a Community trade mark as in relation to a registered trade mark.

(2) Those provisions apply in relation to an international trade mark (EC), and for this purpose—

(a) the reference in section 21(3) to the registration of the trade mark shall be treated as a reference to the protection of the international trade mark (EC); and

(b) the reference in section 21(4) to notification that a trade mark is registered, or that an application for registration has been made, shall be treated as a reference to notification that a trade mark is an international trade mark (EC), or is the subject of an international application or international registration designating the European Community.”.

11. In regulation 6 (importation of infringing goods, material or articles), after both occurrences of “Community trade mark” insert “or an international trade mark (EC)”.

12. In regulation 7 (offences and forfeiture)—

(a) after “in relation to goods),” insert “section 92A (search warrants)(6),”;

(b) after each of the first two occurrences of “Community trade mark” insert “or an international trade mark (EC)”;

(5) S.I. 1996/714; article 13 was amended by S.I. 2000/138 and 2004/948.

(6) Section 92A was inserted by section 6 of the Copyright, etc. and Trade Marks (Offences and Enforcement) Act 2002 (c. 25).

- (c) after “a Community trade mark is registered” insert “or in respect of which an international trade mark (EC) confers protection in the European Community”.

13. After regulation 8 (falsely representing trade mark as a Community trade mark) insert—

“Falsely representing trade mark as an international trade mark (EC)

8A.—(1) It is an offence for a person—

- (a) falsely to represent that a mark is an international trade mark (EC), or
- (b) to make a false representation as to the goods or services in respect of which an international trade mark (EC) confers protection in the European Community,

knowing or having reason to believe that the representation is false.

(2) A person guilty of an offence under this regulation is liable on summary conviction to a fine not exceeding level 3 on the standard scale.”.

14. For regulation 10 substitute—

“Conversion

10.—(1) This regulation applies where, pursuant to Article 108 of the Community Trade Mark Regulation(7)—

- (a) the applicant for or the proprietor of a Community trade mark requests the conversion of his Community trade mark application or Community trade mark into an application for registration of a trade mark under the Act; or
- (b) the holder of an international registration designating the European Community requests (in accordance with Article 154(1)(a) of that Regulation) the conversion of that designation into an application for registration of a trade mark under the Act.

(2) Where the request has been transmitted to the registrar under Article 109(3) of the Community Trade Mark Regulation, it shall be treated as an application for registration of a trade mark under the Act.

(3) A decision of the registrar in relation to the request shall be treated as a decision of the registrar under the Act.”.

PART 3

DESIGNATION OF COMMUNITY TRADE MARK COURTS

Further amendment of the 1996 Regulations

15.—(1) The 1996 Regulations are further amended as follows.

(2) For regulation 9 substitute—

“Designation of Community trade mark courts

9.—(1) For the purposes of Article 91 of the Community Trade Mark Regulation, the following courts are designated as Community trade mark courts—

(7) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ No L 11, 14.1.1994, p. 1), to which amendments relevant to these Regulations have been made by Council Regulation (EC) No 1992/2003 of 27 October 2003 (OJ No L 296, 14.11.2003, p. 1) and Council Regulation (EC) No 422/2004 of 19 February 2004 (OJ No L 70, 9.3.2004, p. 1).

- (a) in England and Wales—
 - (i) the High Court;
 - (ii) any county court designated as a patents county court under section 287(1) of the Copyright, Designs and Patents Act 1988⁽⁸⁾; and
 - (iii) the county courts listed in paragraph (2);
 - (b) in Scotland, the Court of Session; and
 - (c) in Northern Ireland, the High Court.
- (2) The county courts referred to in paragraph (1)(a)(iii) are the county courts at—
- (a) Birmingham;
 - (b) Bristol;
 - (c) Cardiff;
 - (d) Leeds;
 - (e) Liverpool;
 - (f) Manchester; and
 - (g) Newcastle upon Tyne.”.

7th September 2004

Sainsbury of Turville,
Parliamentary Under-Secretary of State for
Science and Innovation,
Department of Trade and Industry

⁽⁸⁾ 1988 c. 48.

EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations amend the Trade Marks Act 1994 (“the 1994 Act”) and the Community Trade Mark Regulations 1996 (S.I. [1996/1908](#), amended by S.I. [2004/949](#)) (“the 1996 Regulations”). Part I of the 1994 Act implements First Council Directive [89/104/EEC](#) to approximate the laws of the Member States relating to trade marks (OJ No L 40, 11.2.1989, p.1) (“the First Directive”). The 1996 Regulations make provision for the operation of Council Regulation (EC) No 40/94 on the Community trade mark (OJ No 11, 14.1.1994, p.1) (“Regulation 40/94”).

Part 1 provides for citation, commencement and interpretation.

Part 2 makes amendments to the 1994 Act and the 1996 Regulations which are necessary as a result of the accession of the European Community to the Protocol to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on 27th June 1989 (“the Madrid Protocol”). For the purposes of the United Kingdom’s own ratification of the Madrid Protocol, the Protocol is given effect in the United Kingdom by the Trade Marks (International Registration) Order 1996 (S.I. [1996/714](#), amended by S.I. [2000/138](#), [2002/692](#) and [2004/948](#)). The Madrid Protocol is published as Cm 1601 Miscellaneous Series No 14 (1991).

Article 14 of the Madrid Protocol permits an intergovernmental organisation such as the European Community to sign or accede to the Protocol, provided that the organisation has a regional office for the purposes of registering marks with effect in the territory of the organisation. A Community trade mark registered at the Office for Harmonization in the Internal Market (trade marks and designs), under Regulation 40/94, does indeed have effect in the territory of the Community. The amendments to Regulation 40/94 which were necessary to give effect to the Community’s accession were made by Council Regulation (EC) No [1992/2003](#) (OJ No L 296, 14.11.2003, p.1), which enters into force on the date on which the Madrid Protocol enters into force with respect to the European Community (1st October 2004).

As a result of the Community’s accession to the Madrid Protocol, it will be possible for applicants for a Community trade mark, and proprietors of such trade marks, to apply for international protection of their marks by making an application under that Protocol; and, conversely, for holders of an international registration under the Madrid Protocol to apply for protection of their marks under the Community trade mark system. An international registration designating the Community has, from the date of its registration or of the subsequent designation of the Community, the same effect as an application for a Community trade mark; and if no refusal is notified in accordance with Article 5 of the Protocol, or any such refusal is withdrawn, the registration has the same effect as the registration of a mark as a Community trade mark.

These Regulations introduce into the 1994 Act, and into the 1996 Regulations, a definition of “international trade mark (EC)”: this is defined to be a trade mark which is entitled to protection in the European Community under the Madrid Protocol. Thus a new category of international trade mark having effect in the United Kingdom is given recognition alongside the category “international trade mark (UK)” as defined by section 53 of the 1994 Act.

Regulations 3 and 4 amend the 1994 Act to update the United Kingdom’s implementation of Article 4 of the First Directive, by taking into account the existence of that new category of trade mark in defining the meaning of “earlier trade mark”.

Thus, by the amendment made to section 6(1)(a) by *regulation 4*, an international trade mark (EC) which has an earlier application date than another mark is defined to be an “earlier trade mark” for the

purposes of the Act (and hence in particular for the purposes of a refusal of registration of the other mark under section 5 or a declaration of invalidity under section 47(2)). This regulation also amends section 6(1) to make it clear that an international trade mark (EC) may enjoy the seniority of an earlier trade mark registered under the 1994 Act (or of an international trade mark (UK)) pursuant to the new Article 148 of Regulation 40/94, and that such seniority will be preserved on any subsequent conversion (under Article 154(1) of that Regulation) of the international trade mark (EC) into an international trade mark (UK) or a trade mark registered under the Act, as well as on the conversion of a Community trade mark. The seniority of a trade mark is an attribute which enables the rights attaching to an earlier identical trade mark to be preserved even where the latter is surrendered or allowed to lapse.

The amendment made to section 5(3) by *regulation 3* is a consequential amendment which ensures that the “reputation” of an earlier trade mark which is to be taken into account for the purposes of that subsection is, in the case of an international trade mark (EC), its reputation in the European Community.

Regulations 5 and 6 make provision for the definition in the 1994 Act of the expression “international trade mark (EC)”.

Regulations 8 to 14 make amendments to the 1996 Regulations which are necessary, in particular, to ensure that relevant provisions of those Regulations apply to an international trade mark (EC) as they apply to a Community trade mark.

Thus *regulation 9* amends regulation 3 of the 1996 Regulations to permit an application to be made to contest the seniority of an international trade mark (EC). It also amends that regulation to take into account the possibility of claiming seniority from an international trade mark (UK).

Regulation 10 extends the provisions of the 1994 Act relating to groundless threats, to threats to bring infringement proceedings in relation to an international trade mark (EC).

Regulations 11 and 12 similarly extend provisions relating to the control of the importation of infringing goods, and to offences and enforcement powers concerning counterfeit goods. Regulation 7 of the 1996 Regulations is also amended in order to take into account section 92A of the 1994 Act, which was inserted by the Copyright, etc. and Trade Marks (Offences and Enforcement) Act 2002.

Regulation 13 creates an offence of falsely representing a trade mark as an international trade mark (EC).

Regulation 14 substitutes a new version of regulation 10 in the 1996 Regulations, in order to provide for the conversion of an international registration designating the Community into an application for a trade mark under the 1994 Act, under the new Article 154(1)(a) of Regulation 40/94. The new version also takes into account the amendments to Article 109(3) and 110(1) of Regulation 40/94 made by Article 1 of Council Regulation (EC) No 422/2004 (OJ No L 70, 9.3.2004, p.1). Those amendments give to the Office for Harmonization in the Internal Market the competence to decide on the admissibility of a conversion application, both in the case of the conversion of a Community trade mark (or a Community trade mark application) and in that of the conversion of an international registration designating the Community. (Under the new Article 154(1)(b) of Regulation 40/94, it is also possible to request the conversion of an international registration designating the Community into an international registration designating the United Kingdom.)

Part 3 amends the 1996 Regulations by substituting a new version of regulation 9 designating the Patents County Court and seven other county courts as additional courts having jurisdiction in England and Wales over proceedings arising out of Regulation 40/94.

A partial regulatory impact assessment has been prepared for Part 2 and has been placed in the libraries of both Houses of Parliament.

A regulatory impact assessment has not been prepared for Part 3, but the change should assist small and medium size enterprises by providing improved access to justice.

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

A Transposition Note, setting out how these Regulations implement the First Directive and Regulation 40/94, has been placed in the libraries of both Houses of Parliament.

The Transposition Note and the partial regulatory impact assessment are also available from: Mark Bryant, Room 3B46, Trade Marks Directorate, The Patent Office, Concept House, Cardiff Road, Newport, NP10 8QQ.