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STATUTORY INSTRUMENTS

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**2016 No. 299**

**TRADE MARKS**

**The European Union Trade Mark Regulations 2016**

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| <i>Made</i>                   | - - - - | <i>3rd March 2016</i> |
| <i>Laid before Parliament</i> |         | <i>7th March 2016</i> |
| <i>Coming into force</i>      | - -     | <i>6th April 2016</i> |

The Secretary of State has been designated<sup>(1)</sup> for the purposes of section 2(2) of the European Communities Act 1972<sup>(2)</sup> in relation to intellectual property (including both registered and unregistered rights).

The Secretary of State makes these Regulations in exercise of the powers conferred by that section, by sections 52 and 78 of the Trade Marks Act 1994<sup>(3)</sup> and by the Department of Trade and Industry (Fees) Order 1988<sup>(4)</sup>.

**Citation, commencement, extent and interpretation**

1.—(1) These Regulations may be cited as the European Union Trade Mark Regulations 2016 and come into force on 6th April 2016.

(2) These Regulations extend to England and Wales, Scotland and Northern Ireland.

(3) In these Regulations “the 1994 Act” means the Trade Marks Act 1994.

**Amendments to the 1994 Act**

2. The 1994 Act is amended as follows.

3. In the heading of Part II and in the italic heading before section 51, for “Community” substitute “European Union”.

4. For section 51, substitute—

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(1) [S.I. 2006/608](#).

(2) [1972 c.68](#); section 2(2) was amended by the Legislative and Regulatory Reform Act [2006 \(c.51\)](#), section 27(1) and the European Union (Amendment) Act [2008 \(c.7\)](#), section 3(3) and Part I of the Schedule.

(3) [1994 c.26](#); section 52(3) was amended by the Legal Services Act [2007 \(c.29\)](#), section 208, Schedule 21, paragraphs 109 and 110.

(4) [S.I. 1988/93](#) as amended by [S.I. 1990/1473](#), which was made under section 102 of the Finance Act (No. 2) Act [1987 \(c. 51\)](#). The relevant provisions of the Order are article 5 and Part II of Schedule 1.

**“51. Meaning of “European Union trade mark”**

In this Act—

“European Union trade mark” has the meaning given by Article 1(1) of the European Union Trade Mark Regulation; and

“the European Union Trade Mark Regulation” means Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union Trade Mark(5).”

5.—(1) Section 52 is amended as follows.

(2) In the heading, for “Community”, substitute “European Union”.

(3) In subsections (1) to (3), for “Community” in each place substitute “European Union”.

(4) Omit subsection (2)(a).

(5) In subsection (3)(b), for “Article 89” substitute “Article 93”.

(6) After subsection (3) insert—

“(3A) The reference in subsections (1) and (2)(d) to the European Union Trade Mark Regulation includes a reference to Council Regulation (EC) No 40/94 of 20th December 1993 on the Community trade mark(6).”.

**Amendments to the Community Trade Mark Regulations 2006**

6. The Community Trade Mark Regulations 2006(7) are amended as follows.

7. In regulations 2(1) and 5, for “Community trade mark court” substitute “EU trade mark court”.

8. In regulations 2(2), 3 and 5 to 11 and in the heading of regulation 9—

(a) for “Community trade mark” in each place substitute “European Union trade mark”, and

(b) for “Community Trade Mark Regulation” in each place substitute “European Union Trade Mark Regulation”.

9. In regulation 5(1), for “Article 98(1)” substitute “Article 102(1)”.

10.—(1) Regulation 10 is amended as follows.

(2) In paragraph (1), for “Article 108” substitute “Article 112”.

(3) In paragraph (1)(b), for “Article 154(1)(a)” substitute “Article 159(1)(a)”.

(4) In paragraph (2), for “Article 109(3)” substitute “Article 113(3)”.

11. In regulation 11(3), for “Article 89” substitute “Article 93”.

12.—(1) Regulation 12 is amended as follows.

(2) In the heading, for “Community trade mark courts” substitute “EU trade mark courts”.

(3) In paragraph (1) for “For the purposes of Article 91 of the Community Trade Mark Regulation, the following courts are designated as Community trade mark courts” substitute “For the purposes of Article 95 of the European Union Trade Mark Regulation, the following courts are designated as EU trade mark courts”.

(5) OJ No. L78, 24.3.2009, p1; as amended by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16th December 2015, OJ No. L341, 24.12.2015, p21.

(6) OJ No. L11, 14.1.1994, p1.

(7) S.I. 2006/1027, amended by S.I. 2008/1959 and S.I. 2001/1043.

### **Transitional Provisions**

**13.**—(1) Anything done or having effect as if done under, for the purposes of, or in reliance on the old Regulation or a provision of the old Regulation has effect, so far as necessary for continuing its effect after the coming into force of these Regulations, as if done under, for the purposes of, or in reliance on the current Regulation or the corresponding provision of that Regulation.

(2) In this regulation—

“the old Regulation” means Council Regulation (EC) No 40/94 of 20th December 1993 on the Community Trade Mark;

“the current Regulation” means Council Regulation (EC) No 207/2009 of 26th February 2009 on the European Union Trade Mark.

### **Saving provision**

**14.** Subject to the amendments made by regulations 6 to 12, any regulations made under section 52 of the 1994 Act which have effect immediately before the coming into force of these Regulations have effect after then as if made under that section as amended by these Regulations.

### **Consequential amendments etc**

**15.** The Schedule (which contains amendments etc consequential on the amendments made by regulations 2 to 5) has effect.

3rd March 2016

*Neville-Rolfe*  
Parliamentary Under Secretary of State for  
Business, Innovation and Skills  
Department for Business, Innovation and Skills

## SCHEDULE

Regulation 15

## CONSEQUENTIAL AMENDMENTS ETC

**The 1994 Act**

1. In sections 5(3)(8), 6(1)(9), 6A(5)(10) and 47(2D)(11) of the 1994 Act, for “Community” in each place, substitute “European Union”.

2. In section 8(5) of the 1994 Act, for “the Community Trade Mark Regulation” substitute “Council Regulation (EC) No 40/94 of 20th December 1993 on the Community trade mark”.

3. In section 104 of the 1994 Act—

- (a) omit the entry in the table relating to “Community trade mark” and at the appropriate place insert—

|                            |              |
|----------------------------|--------------|
| “European Union trade mark | section 51”; |
|----------------------------|--------------|

and

- (b) omit the entry in the table relating to “Community Trade Mark Regulation” and at the appropriate place insert—

|                                       |             |
|---------------------------------------|-------------|
| “European Union Trade Mark Regulation | section 51” |
|---------------------------------------|-------------|

**The Community Trade Mark (Fees) Regulations 1995**

4. The Community Trade Mark (Fees) Regulations 1995(12) are revoked.

**The Trade Mark Rules 2008**

5. In rule 47(1) of the Trade Mark Rules 2008(13) for “Community” in each place substitute “European Union”.

**EXPLANATORY NOTE**

*(This note is not part of the Regulations)*

These Regulations amend sections 51 and 52 of the Trade Marks Act 1994 (“the Act”) and also amend the Community Trade Mark Regulations 2006 (S.I. 2006/1027) (“the CTM Regulations”).

(8) Section 5(3) was amended by S.I. 2004/946, regulations 3 and 7(1), S.I. 2004/2332, regulations 2 and 3 and S.I. 2011/1043, article 4(1).

(9) Section 6(1) was amended by S.I. 2004/2332, regulations 2 and 4 and S.I. 1999/1899, regulation 13(1).

(10) Section 6A(5) was inserted into the Act by S.I. 2004/946, regulations 3 and 4 was amended by S.I. 2008/1067, regulations 3 and 4(1) and (3) and S.I. 2011/1043, article 4(1).

(11) Section 47(2D) was inserted into the Act by S.I. 2004/946, regulations 3 and 6 and amended by S.I. 2008/1067, regulations 3 and 5(1) and (2), and S.I. 2011/1043, article 4(1).

(12) S.I. 1995/3175.

(13) S.I. 2008/1797.

The CTM Regulations make provision for the operation of Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community Trade Mark (OJNo. L11, 14.1.1994, p1) (“the Old Regulation”).

The amendments are necessitated by the repeal of the Old Regulation and its replacement by the codified Council Regulation (EC) No. 207/2009 on the European Union Trade Mark (OJ No. L78, 24.3.2009, p1) as amended by Regulation (EU) No. 2015/2424 of the European Parliament and of the Council of 16th December 2015 (OJ No. L341, 24.12.2015, p21) (“the New Regulation”).

The amendments to the Act and CTM Regulations reflect the change in terminology adopted in the New Regulation with the substitution of references to European Union trade marks for Community trade marks and also substitute references to Articles of the New Regulation for the corresponding Articles of the Old Regulation.

As a consequential matter, the Community Trade Mark (Fees) Regulations 1995 (S.I. 1995/3175) are revoked. Under the Old Regulation it was possible to file an application for a Community trade mark with either the Intellectual Property Office or the Office for Harmonisation in the Internal Market. The fee prescribed under the 1995 fees Regulations applied where an application was filed at the Intellectual Property Office. Under the New Regulation an application for a European Union Trade Mark may only be filed at the EU Intellectual Property Office and so applications may no longer be filed with the Intellectual Property Office, hence the revocation of the relevant fee regulation.

A full impact assessment has not been produced for this instrument as no impact on the private or voluntary sectors is foreseen.

An Explanatory Memorandum is available alongside the instrument on [www.legislation.gov.uk](http://www.legislation.gov.uk).