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STATUTORY INSTRUMENTS

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**2018 No. 825**

**TRADE MARKS**

**The Trade Marks Regulations 2018**

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| <i>Made</i>                   | - - - - | <i>9th July 2018</i>     |
| <i>Laid before Parliament</i> |         | <i>10th July 2018</i>    |
| <i>Coming into force</i>      | - -     | <i>14th January 2019</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 and by sections 52, 54 and 78 of the Trade Marks Act 1994<sup>(3)</sup>.

**PART 1**

**General**

**Citation, commencement and interpretation**

1.—(1) These Regulations may be cited as the Trade Marks Regulations 2018 and come into force on 14th January 2019.

(2) In these Regulations—

“the 1994 Act” means the Trade Marks Act 1994;

“the CTM Regulations” means the Community Trade Mark Regulations 2006<sup>(4)</sup>;

“the International Registration Order” means the Trade Marks (International Registration) Order 2008<sup>(5)</sup>;

“the Rules” means the Trade Marks Rules 2008<sup>(6)</sup>.

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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 1 of the Schedule.

(3) 1994 c. 26.

(4) S.I. 2006/1027, amended by S.I. 2008/1959, 2011/1043, 2016/299 and by the Intellectual Property (Unjustified Threats) Act 2017 (c.14) section 3.

(5) S.I. 2008/2206 to which there are amendments not relevant to these Regulations.

(6) S.I. 2008/1797, amended by S.I. 2009/2089, 2013/2235; there are other amending instruments but none is relevant.

## PART 2

### Amendments to the 1994 Act

#### Amendments to the 1994 Act

2. The 1994 Act is amended in accordance with regulations 3 to 33.

#### Trade Marks

3. In section 1, for subsection (1) substitute—

“(1) In this Act “trade mark” means any sign which is capable—

- (a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and
- (b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”.

#### Absolute grounds for refusal of registration

- 4.—(1) Section 3 is amended as follows.

(2) In subsection (2), after “the shape” in each place insert “, or another characteristic,”.

(3) In subsection (4)(7), after “EU law” insert “other than law relating to trade marks”.

- (4) After subsection (4), insert—

“(4A) A trade mark is not to be registered if its registration is prohibited by or under—

- (a) any enactment or rule of law,
- (b) any provision of EU law, or
- (c) any international agreement to which the United Kingdom or the EU is a party,

providing for the protection of designations of origin or geographical indications.

(4B) A trade mark is not to be registered if its registration is prohibited by or under—

- (a) any provision of EU law, or
- (b) any international agreement to which the EU is a party,

providing for the protection of traditional terms for wine or traditional specialities guaranteed.

(4C) A trade mark is not to be registered if it—

- (a) consists of, or reproduces in its essential elements, an earlier plant variety denomination registered as mentioned in subsection (4D), and
- (b) is in respect of plant varieties of the same or closely related species.

(4D) Subsection (4C)(a) refers to registration in accordance with any—

- (a) enactment or rule of law,
- (b) provision of EU law, or
- (c) international agreement to which the United Kingdom or the EU is a party,

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(7) Section 3(4) was amended by [S.I. 2011/1043](#), article 6(2)(a).

providing for the protection of plant variety rights.”

### **Relative grounds for refusal of registration**

5.—(1) Section 5(8) is amended as follows.

(2) After subsection (3), insert—

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”.

(3) In subsection (4)(a), for “trade, or” substitute “trade, where the condition in subsection (4A) is met,”.

(4) In subsection (4), after paragraph (a) insert—

“(aa) by virtue of any provision of EU law, or any enactment or rule of law, providing for protection of designations of origin or geographical indications, where the condition in subsection (4B) is met, or”.

(5) In subsection (4)(b)—

(a) after “paragraph (a)” insert “or (aa)”; and

(b) omit “, design right or registered designs” and substitute “or the law relating to industrial property rights”.

(6) After subsection (4), insert—

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

(4B) The condition mentioned in subsection 4(aa) is that—

(a) an application for a designation of origin or a geographical indication has been submitted prior to the date of application for registration of the trade mark or the date of the priority claimed for that application, and

(b) the designation of origin or (as the case may be) geographical indication is subsequently registered.”.

(7) After subsection (5) insert—

“(6) Where an agent or representative (“R”) of the proprietor of a trade mark applies, without the proprietor’s consent, for the registration of the trade mark in R’s own name, the application is to be refused unless R justifies that action.”.

### **Grounds for refusal relating to only some of the goods or services**

6. After section 5 insert—

#### **“5A Grounds for refusal relating to only some of the goods or services**

Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”.

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(8) Section 5 was amended by [S.I. 2004/946](#), regulations 3 and 7(1), [S.I. 2004/2332](#), regulations 2 and 3, [S.I. 2011/1043](#), article 4(1) and [S.I. 2016/299](#), the Schedule, paragraph 1.

**Meaning of “earlier trade mark”**

7.—(1) Section 6(9) is amended as follows.

(2) In subsection (1)(b) after “international trade mark (UK)” insert “even where the earlier trade mark has been surrendered or its registration has expired”.

(3) Omit subsection (3).

**Raising of relative grounds in opposition proceedings in case of non-use**

8.—(1) Section 6A(10) is amended as follows.

(2) In subsection (1)(c), for the words from “period” to the end substitute “relevant period”.

(3) After subsection (1) insert—

“(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.”.

(4) In subsection (3)(a) for “period of five years ending with the date of publication of the application” substitute “relevant period”.

(5) In subsection (4)(a)—

(a) after “a form” insert “(the “variant form”);”;

(b) after “registered” insert “(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)”.

(6) After subsection (5) insert—

“(5A) In relation to an international trade mark (EC) the reference in subsection (1) (c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.”.

**Rights conferred by registered trade mark**

9.—(1) Section 9 is amended as follows.

(2) In subsection (1) before “section 10” insert “subsections (1) to (3) of”.

(3) After subsection (1) insert—

“(1A) See subsection (3B) of section 10 for provision about certain other acts amounting to infringement of a registered trade mark.

(1B) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of filing of the application for registration or (where applicable) the date of the priority claimed in respect of that application.”.

(4) In subsection (2)—

(a) omit “such”, and

(b) at the end insert “such as is mentioned in subsection (1) or (1A)”.

(9) Section 6 was amended by S.I. 1999/1899, regulation 13(1), S.I. 2004/2332, regulations 2 and 4 and S.I. 2016/299, the Schedule, paragraph 1.

(10) Section 6A was inserted by S.I. 2004/946, regulations 3 and 4 and amended by S.I. 2008/1067 regulations 3 and 4, S.I. 2011/1043, article 4(1) and S.I. 2016/299, the Schedule paragraph 1.

## **Infringement of registered trade mark**

10.—(1) Section 10(11) is amended as follows.

(2) After subsection (3) insert—

“(3A) Subsection (3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered.

(3B) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of the trade mark, a person infringes a registered trade mark if the person carries out in the course of trade any of the following acts—

- (a) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed; or
- (b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.”.

(3) In subsection (4)(c), after “under the sign;” omit “or”.

(4) After subsection (4)(c), insert—

“(ca) uses the sign as a trade or company name or part of a trade or company name;”.

(5) In subsection (4)(d)—

- (a) for “or” substitute “and”;
- (b) after “advertising” insert “; or”.

(6) After subsection (4)(d), insert—

“(e) uses the sign in comparative advertising in a manner that is contrary to the Business Protection from Misleading Marketing Regulations 2008(12).”.

(7) Omit subsections (5) and (6).

## **Right to prevent goods entering the UK without being released for free circulation and prohibition on the use of a trade mark registered in the name of an agent or representative**

11. After section 10, insert—

### **“10A Right to prevent goods entering the UK without being released for free circulation**

(1) The proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into the United Kingdom in the course of trade without being released for free circulation if they are goods for which the trade mark is registered which—

- (a) come from outside the customs territory of the EU; and
- (b) bear without authorisation a sign which is identical with the trade mark or cannot be distinguished in its essential aspects from the trade mark.

(2) In subsection (1) the reference to goods for which the trade mark is registered includes a reference to the packaging of goods for which the trade mark is registered.

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(11) Section 10 was amended by S.I. 2004/946, regulations 3 and 7(2).

(12) S.I. 2008/1276 amended by S.I. 2013/2701.

(3) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of application for registration of the trade mark, or (where applicable) the date of the priority claimed in respect of that application.

(4) The entitlement of the proprietor under subsection (1) is to lapse if—

- (a) proceedings are initiated in accordance with the European Customs Enforcement Regulation to determine whether the trade mark has been infringed; and
- (b) during those proceedings evidence is provided by the declarant or the holder of the goods that the proprietor of the trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

(5) References in this Act to the “European Customs Enforcement Regulation” are references to Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights<sup>(13)</sup>.

### **10B Prohibition on the use of a trade mark registered in the name of an agent or representative**

(1) Subsection (2) applies where a trade mark is registered in the name of an agent or representative of a person (“P”) who is the proprietor of the trade mark, without P’s consent.

(2) Unless the agent or representative justifies the action mentioned in subsection (1), P may do either or both of the following—

- (a) prevent the use of the trade mark by the agent or representative (notwithstanding the rights conferred by this Act in relation to a registered trade mark);
- (b) apply for the rectification of the register so as to substitute P’s name as the proprietor of the registered trade mark.”.

### **Limits on effect of registered trade mark**

**12.**—(1) Section 11 is amended as follows.

(2) In subsection (1) omit “another registered trade mark in relation to goods and services for which the latter is registered (but see section 47(6) (effect of declaration of invalidity of registration))” and substitute “a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1)”.

(3) After subsection (1) insert—

“(1A) A registered trade mark is not infringed by the use of a later registered European Union trade mark where that later European Union trade mark would not be declared invalid as a result of Article 60(1), (3), (4), 61(1), (2) or 64(2) of the European Union Trade Mark Regulation.

(1B) Where subsection (1) or (1A) applies, the later registered trade mark is not infringed by the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later registered trade mark.”.

(4) In subsection (2)(a) for “a person” substitute “an individual”.

(5) In subsection (2)(b) for “indications concerning” substitute “signs or indications which are not distinctive or which concern”.

(6) In subsection (2)(c) for “where it” substitute “for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use”.

## **Non-use as defence in infringement proceedings**

13. After section 11, insert—

### **“11A Non-use as defence in infringement proceedings**

(1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1) (a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.

(2) Subsection (3) applies in relation to an action for infringement of a registered trade mark where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought.

(3) If the defendant so requests, the proprietor of the trade mark must furnish proof—

(a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in the United Kingdom by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action, or

(b) that there are proper reasons for non-use.

(4) Nothing in subsections (2) and (3) overrides any provision of section 46, as applied by subsection (1) (including the words from “Provided that” to the end of subsection (3)).”.

## **Assignment, &c of registered trade mark**

14. In section 24 after subsection (1) insert—

“(1A) A contractual obligation to transfer a business is to be taken to include an obligation to transfer any registered trade mark, except where there is agreement to the contrary or it is clear in all the circumstances that this presumption should not apply.”.

## **Application for registration of trade mark as an object of property**

15. In section 27(1) after “sections 22 to 26 (which relate to a registered trade mark as an object of property)” insert “and sections 28 to 31 (which relate to licensing)”.

## **Licensing of registered trade mark**

16. In section 28 after subsection (4) insert—

“(5) The proprietor of a registered trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in the licence 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.”.

## **General provisions as to rights of licensees in case of infringement**

17.—(1) Section 30 is amended as follows.

(2) After subsection (1) insert—

“(1A) Except so far as the licence provides otherwise a licensee may only bring proceedings for infringement of the registered trade mark with the consent of the proprietor (but see subsections (2) and (3)).”.

(3) In subsection (2), for “A licensee is entitled, unless his licence or any licence through which his interest is derived, provides otherwise, to” substitute “An exclusive licensee may”.

(4) In subsection (3) after “If the proprietor” insert “mentioned in subsection (2)” and before “licensee” insert “exclusive”.

(5) In subsection (4), after “by virtue of this section” insert “or with the consent of the proprietor or pursuant to the licence”.

(6) After subsection (6), insert—

“(6A) Where the proprietor of a registered trade mark brings infringement proceedings, a licensee who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.”.

### **Application for registration**

**18.** In section 32(2)(d) after “mark” insert “, which is capable of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor”.

### **Publication, opposition proceedings and observations**

**19.**—(1) Section 38 is amended as follows.

(2) After subsection (2) insert—

“(2A) Where a notice of opposition is filed on the basis of one or more earlier trade marks or other earlier rights—

- (a) the rights (if plural) must all belong to the same proprietor;
- (b) the notice may be filed on the basis of part, or the totality, of the goods or services in respect of which the earlier right is protected or applied for.

(2B) A notice of opposition may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.”.

### **Registration: supplementary provisions**

**20.**—(1) Section 41 is amended as follows.

(2) After section 41(1)(a) insert—

“(aa) the division of a registration of a trade mark into several registrations;”.

(3) In subsection (3)(b), after each reference to “application” insert “or registration” and after “applications” insert “or registrations”.

### **Renewal of registration**

**21.** In section 43 after subsection (3) insert—

“(3A) If a request for renewal is made or the renewal fee is paid in respect of only some of the goods or services for which the trade mark is registered, the registration is to be renewed for those goods or services only.”.



## Revocation of registration

22. In section 46(2)—

- (a) after “a form” insert “(the “variant form”);”;
- (b) after “in which it was registered” insert “(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)”.

## Grounds for invalidity of registration

23.—(1) Section 47(14) is amended as follows.

(2) At the beginning of subsection (2) insert “Subject to subsections (2A) and (2G),”.

(3) After subsection (2) insert—

“(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).”

(4) In subsection (2A) omit “But”.

(5) In subsection (2B) for paragraph (a) substitute—

“(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or”.

(6) In subsection (2C)(a)—

(a) after “a form” insert “(the “variant form”);”;

(b) after “in which it was registered” insert “(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)”.

(7) After subsection (2D) insert—

“(2DA) In relation to an international trade mark (EC), the reference in subsection (2A)

(a) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.”.

(8) After subsection (2F) insert—

“(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

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(14) Section 47 was amended by [S.I. 2004/946](#), regulations 3 and 6, [S.I. 2008/1067](#), regulations 3 and 5, [S.I. 2011/1043](#) article 4(1) and [S.I. 2016/299](#), the Schedule paragraph 1.

- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));
  - (b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);
  - (c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).”.
- (9) After subsection (5) insert—
- “(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.”.

### **Collective marks**

- 24.** In section 49, for subsection (1) substitute—
- “(1) A collective mark is a mark which is described as such when it is applied for and is capable of distinguishing the goods and services of members of the association which is the proprietor of the mark from those of other undertakings.
- (1A) The following may be registered as the proprietor of a collective mark—
- (a) an association of manufacturers, producers, suppliers of services or traders which has the capacity in its own name to enter into contracts and to sue or be sued; and
  - (b) a legal person governed by public law.”.

### **Certification marks**

- 25.** In section 50(1) for “indicating” substitute “which is described as such when the mark is applied for and indicates”.

### **Meaning of “European Union trade mark”**

- 26.** In section 51(15) omit “Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union Trade Mark” and substitute “Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark(16).”.

### **Power to make provision in connection with European Union Trade Mark Regulation**

- 27.**—(1) Section 52(17) is amended as follows.
- (2) In subsection (3)(b) omit “Article 93” and substitute “Article 120”.
- (3) In subsection (3A) omit “Council Regulation (EC) No 40/94 of 20th December 1993 on the Community trade mark” and substitute “Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union Trade Mark(18).”.

(15) Section 51 was amended by S.I. 2016/299, regulations 2 and 4.

(16) OJ No. L 154/1, 16.6.2017, p.1.

(17) Section 52 was amended by S.I. 2016/299, regulations 2 and 5.

(18) OJ No. L 78, 24.3.2009, p.1; as amended by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015, OJ No. L 341, 24.12.2015, p.21.

## **Acts of agent or representative: Article 6septies**

**28.** Omit section 60.

## **Similarity of goods and services**

**29.** At the end of Part 2 insert—  
“Nice Classification

### **60A Similarity of goods and services**

- (1) For the purposes of this Act goods and services—
  - (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;
  - (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979(19).”.

## **Infringing goods, material or articles may be treated as prohibited goods**

**30.** In section 89(3) for “Article 5(1) of Council Regulation (EC) No 1383/2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights” substitute “Article 3 of the European Customs Enforcement Regulation”.

## **Reproduction of trade marks in dictionaries, encyclopaedias etc.**

**31.** After section 99, insert—

### **“99A Reproduction of trade marks in dictionaries, encyclopaedias etc.**

(1) Subsection (2) applies if the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered.

(2) The publisher of the work must, at the request in writing of the proprietor of the trade mark, ensure that the reproduction of the trade mark is accompanied by an indication that it is a registered trade mark.

(3) The action required by subsection (2) must be taken—

- (a) without delay, and
- (b) in the case of works in printed form, at the latest in the next edition of the publication.

(4) If the publisher fails to take any action required by subsection (2) the court may, on an application by the proprietor—

- (a) order the publisher to take the action concerned;

- (b) if the work is in printed form, order the publisher to erase or amend the reproduction of the trade mark or secure the destruction of copies of the work in the publisher's possession, custody or control; or
- (c) grant such other order as the court in the circumstances considers appropriate."

### **Index of defined expressions**

**32.**—(1) Section 104 is amended as follows.

(2) After the entry in the table for "earlier trade mark" insert—

|  |              |
|--|--------------|
| "European Customs Enforcement Regulation | section 10A" |
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### **Schedule 1 - Collective marks**

**33.**—(1) Schedule 1 is amended as follows.

(2) In paragraph 5—

- (a) in sub-paragraph (2) omit ", where they exist,";
- (b) the second sentence of sub-paragraph (2) is renumbered as sub-paragraph (4), and
- (c) before sub-paragraph (4) insert—

“(3) Where the regulations govern use of a mark referred to in paragraph 3(1), they must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.”.

(3) In paragraph 6(1)(a) after "paragraph 5(2)" insert "and (3)".

(4) In paragraph 12—

(a) for sub-paragraph (2), substitute—

“(2) Subject to any agreement to the contrary between the authorised user and the proprietor, an authorised user may only bring proceedings for infringement of a registered collective mark with the consent of the proprietor.”;

- (b) omit sub-paragraph (3);
- (c) in sub-paragraph (4), omit "Where infringement proceedings are brought by virtue of this paragraph" and substitute "Where proceedings are brought by an authorised user for infringement of a registered collective mark (with the consent of the proprietor or pursuant to any agreement referred to in sub-paragraph (2))";
- (d) after sub-paragraph (6), insert—

“(7) Where the proprietor of a registered collective mark brings infringement proceedings, an authorised user who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.”.

(5) In paragraph 13—

- (a) in sub-paragraph (a), for "proprietor" substitute "persons authorised to use it";
- (b) in sub-paragraph (b)—
  - (i) for "has failed to observe, or to secure the observance of," substitute "has not taken reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in"; and
  - (ii) after "mark" insert "(as amended from time to time)";
- (c) in sub-paragraph (c)(i), after "paragraph 5(2)" insert "and (3)".

- (6) In paragraph 14—
  - (a) for “may” substitute “shall”;
  - (b) after “the provisions of” insert “section 49(1A) (definition of who may be registered as the proprietor of a certification mark) or”;
  - (c) after “6(1)” insert “unless the breach was only of paragraph 6(1) and the proprietor of the mark, by amending the regulations governing use, complies with the requirements of paragraph 6(1)”.

## PART 3

### Amendments to the Rules

#### Amendments to the Rules

- 34. The Rules are amended in accordance with regulations 35 to 43.

#### Application for registration: section 32 (Form TM3)

- 35. For rule 5(6) substitute—
  - “(6) The Registrar may at any time—
    - (a) suspend the right of applicants to file a request for expedited examination under paragraph (2) (“the expedited examination service”) for such period as the registrar deems fit; and
    - (b) resume the expedited examination service.
  - (7) Where the registrar suspends or resumes the expedited examination service pursuant to paragraph (6), the registrar must publish a notice on the Office website—
    - (a) of the date from which the expedited examination service is suspended;
    - (b) of the date upon which the expedited examination service will resume.”.

#### Application may relate to more than one class and shall specify the class (Form TM3A)

- 36.—(1) Rule 8 is amended as follows.
  - (2) In paragraph (2)(b) omit “in such a way as to indicate clearly the nature of those goods or services” and insert “with sufficient clarity and precision to enable the registrar and other competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought”.
  - (3) After paragraph (2) insert—
    - “(2A) For the purposes of paragraph (2)(b) an application may specify the general indications included in the class headings of the Nice Classification or other general terms provided that they satisfy the requirement that the goods or services be described with sufficient clarity and precision referred to in paragraph (2)(b).
    - (2B) Where the specification contained in the application describes the goods or services using general terms, including the general indications included in the class headings of the Nice Classification, the application shall be treated as including only the goods or services clearly covered by the literal meaning of the term or indication.”.
  - (4) After paragraph (4) insert—

“(5) In this rule “economic operators” means any person or group of persons which, in the course of trade, manufactures, supplies, imports, exports or otherwise deals in goods or services.”.

#### **Determination of classification**

**37.** In rule 9(3)—

- (a) after “under paragraph (2),” insert “the registrar must reject”; and
- (b) omit “, shall be treated as abandoned”.

#### **Opposition proceedings: filing of notice of opposition**

**38.** In rules 17(5)(d) and 17A(6)(e) for “date of publication” substitute “date of application for registration or, if any, the date of priority”.

#### **Division of registration**

**39.** After rule 26 insert—

##### **“26A Division of registration; section 41 (Form TM12R)**

(1) The proprietor of a trade mark may send to the registrar a request on Form TM12R to divide the specification of the registration (the original registration) into two or more separate trade marks (divisional registrations), indicating for each divisional registration the specification of goods or services.

(2) Each divisional registration must be treated as a separate registration with the same date of registration as the original registration.

(3) No request under paragraph (1) may be granted in respect of the registration of a trade mark which is the subject of proceedings for its revocation or invalidation, where the request would introduce a division amongst the goods or services in respect of which the proceedings are directed.

(4) Where the original registration is subject to a disclaimer or limitation, the divisional registrations must also be restricted accordingly.

(5) Where the original registration has had registered in relation to it particulars relating to—

- (a) the grant of a licence;
- (b) a security interest;
- (c) any right in or under that original registration; or
- (d) any memorandum or statement of the effect of a memorandum;

the registrar must enter in the register the same particulars in relation to each of the divisional registrations into which the original registration has been divided.”.

#### **Reminder of renewal of registration; section 43**

**40.—**(1) Rule 34 is amended as follows.

(2) In paragraph (1)—

- (a) omit “at any time not earlier than six months nor later than one month” and substitute “at least six months”;
- (b) omit “(except where renewal has already been affected under rule 35)”.

(3) After paragraph (2) insert—

“(2A) The registrar is not subject to any liability by reason of any failure to notify the proprietor in accordance with paragraph (1) and no proceedings lie against any officer of the registrar in respect of any such failure.”.

#### **Renewal of registration; section 43 (Form TM11)**

41. In rule 35, after “expiration of the registration” insert “or following receipt of a notice from the registrar pursuant to rule 34(1)”.

#### **Restoration of registration; section 43 (Form TM13)**

42.—(1) Rule 37 is amended as follows.

(2) In paragraph (1) omit “if, having regard to the circumstances of the failure to renew, the registrar is satisfied that it is just to do so” and substitute “if the registrar is satisfied that the failure to renew was unintentional”.

(3) After paragraph (1) insert—

“(1A) Where a mark is restored to the register, the proprietor of the mark may not bring an action for infringement against a third party who, in good faith, has put goods on the market or supplied services under a sign which is identical with or similar to the mark in respect of the period beginning with the date of expiration of the registration and ending on the date its restoration is published in accordance with paragraph (2).”.

#### **Entry in register of particulars of registered trade marks; section 63(2) (Form TM24)**

43. In Rule 47, after paragraph (l) insert—

“(m) where the mark is a collective mark and amended regulations have been accepted by the registrar, that fact, including the date of that entry.”.

## **PART 4**

### **Amendments to the CTM Regulations and the International Registration Order**

#### **Amendments to the CTM Regulations**

44. The CTM Regulations are amended in accordance with regulations 45 to 49.

#### **Determination of invalidity and liability to revocation in relation to claims of seniority**

45. In regulation 3(3) after “liable” insert “as at the date of such removal or surrender”.

#### **Remedies in infringement proceedings**

46. In regulation 5(1), for “Article 102(1)” substitute “Article 130(1)”.

#### **Conversion**

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

(2) In paragraph (1), in the words before sub-paragraph (a), for “Article 112” substitute “Article 139”.

(3) In paragraph (1)(b), for “Article 159(1)(a)” substitute “Article 202(1)(a)”.

(4) In paragraph (2), for “Article 113(3)” substitute “Article 140(5)”.

**Privilege for communications with those on the list of professional trade marks representatives**

48. In regulation 11(3), for “Article 93” substitute “Article 120”.

**Designation of Community trade mark courts**

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

(2) In paragraph (1), for “Article 95” substitute “Article 123(1)”.

(3) At the end of paragraph (1)(a)(i) insert “and”.

(4) Omit paragraph (1)(a)(ii).

**Amendments to the International Registration Order**

50. The International Registration Order is amended in accordance with regulations 51 and 52.

**Provisions of the Act and Trade Mark Rules which do not apply to International Trade Marks (UK) or requests for extension**

51. In Part 2 of Schedule 1, after the entry in the table relating to “trade marks rule 13 (deficiencies in application; section 32)” insert—

“trade marks rule 28 (registration of a series of trade marks; section 41) (Form TM12).”.

**Modifications to provisions of the Act applied to International Trade Marks (UK)**

52. In paragraph 6 of Schedule 2 in the text relating to the modification of the 1994 Act by the insertion of section 38(B)(3) of the 1994 Act, omit “section 46(1)” and substitute “sections 6A, 11A, 46(1) and 47(2A)”.

## PART 5

### Transitional Provisions

**Transitional Provisions**

53.—(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—

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

(b) “the current Regulation” means Regulation (EU) No 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark.

54. Subject to the amendments made by regulations 45 to 49, any regulations made under section 52 of the 1994 Act which have effect immediately before the coming into force of these Regulations have effect on and after the day these Regulations come into force as if made under that section as amended by these Regulations.



9th July 2018

*Sam Gyimah*  
Minister of State for Universities, Science,  
Research and Innovation  
Department for Business, Energy and Industrial  
Strategy

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## EXPLANATORY NOTE

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

Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast) (OJNo. L 336, 23.12.2015, p.1) (“the Directive”) amends and replaces [Directive 2008/95/EC](#) of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ No. L 299, 8.11.2008, p.25) (“the former Directive”).

These Regulations amend the Trade Marks Act 1994 (“the 1994 Act”), the Trade Marks Rules 2008 (“the Rules”), the Community Trade Mark Regulations 2006 (“the CTM Regulations”) and the Trade Marks (International Registration) Order 2008 (“the International Registration Order”). The majority of the amendments implement those provisions of the Directive which had not already been implemented into UK law pursuant to the former Directive and are set out in Part 2 and regulations 36 to 41, 43 and 52.

Part 2 contains amendments to the 1994 Act which are made under section 2(2) of the European Communities Act 1972.

Regulation 3 amends the definition of a “trade mark”. In particular, it removes the requirement that the sign must be capable of being represented graphically.

Regulation 4 amends section 3 to provide additional absolute grounds for refusal of registration, including if the mark consists of a characteristic (in addition to the shape of the goods) which results from the goods themselves, or is necessary to obtain a technical result or which gives substantial value to the goods.

Regulation 5 amends section 5 (which sets out the relative grounds for refusal of registration). New subsection (6) provides an additional ground for refusal where an agent applies for registration of a trade mark in the agent’s own name without the proprietor’s consent, unless the agent justifies that action.

Regulations 9 and 10 amend sections 9 and 10 relating to the acts which amount to an infringement of a trade mark. New section 10(3B) provides a new act of infringement relating to the affixing of a trade mark to packaging, labels, tags etc or the offering, placing on the market etc of such items, and replaces existing section 10(5). In addition, section 10 is amended to insert a new act of infringement consisting of use of a trade mark as a trade or company name and also use in comparative advertising in breach of the Business Protection from Misleading Marketing Regulations 2008 ([S.I. 2008/1276](#)). Existing section 10(6) is repealed.

Regulation 11 inserts new sections 10A and 10B. Section 10A confers a right on a proprietor to prevent third parties from bringing infringing goods into the UK from outside the customs territory of the EU without being released for free circulation. Section 10B confers a right on a proprietor to prevent the use of a trade mark registered in the name of an agent or representative without the proprietor’s consent and to apply for rectification of the register to substitute the proprietor’s name for that of the agent/representative. This provision replaces the similar provisions in section 60, which is repealed by Regulation 28.

Regulation 13 inserts new section 11A which provides that a defendant to an infringement action may require the proprietor to furnish proof of use of the trade mark during the five-year period preceding the date of the infringement action or provide proper reasons for non-use.

Regulation 16 amends section 28 to provide that the proprietor of a licensed trade mark may treat a licensee who contravenes certain provisions in the licence as having infringed the mark.

Regulation 17 amends section 30 to provide that except where the licence provides otherwise, a licensee may only bring proceedings for infringement of the trade mark with the consent of the proprietor. However, in the case of an exclusive licence, where a proprietor fails to consent, an exclusive licensee may bring such proceedings.

Regulation 23 makes various amendments to section 47 regarding the grounds for invalidity of registration, including incorporating a new ground of where the trade mark was registered in the name of an agent without the consent of the proprietor and specifying certain requirements (including the use conditions) which apply where the application for invalidity is based upon an earlier trade mark.

Regulation 24 amends section 49 to provide that in addition to an association of manufacturers, producers etc, a legal person governed by public law may be registered as the proprietor of a collective mark.

Regulation 31 inserts new section 99A which provides a proprietor with certain rights against the publisher where the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it is a generic name of the goods or services.

Part 3 contains amendments to the Rules which are made under section 78 of the 1994 Act.

Regulation 35 provides a power for the registrar to suspend the expedited examination service in rule 5, for such period as the registrar deems fit, and to resume the service, subject to publishing a notice on the Office website.

Regulation 36 amends rule 8 relating to the requirement to specify the goods and services the subject of the trade mark application with sufficient clarity and provides that where the specification describes them using general terms (including the indications included in the class headings of the Nice Classification) such terms and indications will be construed according to their literal meaning.

Regulation 39 inserts new rule 26A which sets out the procedure for an application to divide the specification of a registered trade mark (to be filed on Form TM12R) and the conditions which apply to any divisional registration. A division is prohibited where the trade mark is subject to revocation or invalidation proceedings where it would introduce a division amongst the goods or services in respect of which the proceedings are directed.

Regulations 40 and 41 amend rules 34 and 35 relating to the renewal of registration to provide that the registrar must give at least six months' notice of the pending renewal.

Regulation 42 amends rule 37 to provide that where a mark has expired due to a failure to renew, the registrar may restore it if the registrar is satisfied that the failure to renew was unintentional and, where a mark is restored, the proprietor may not bring infringement proceedings against a third party who in good faith has used the mark during the period between it having expired and publication of its restoration.

Part 4 contains amendments to the CTM Regulations and the International Registration Order.

Regulations 44 to 49 are made under section 52 of the 1994 Act and make minor amendments to the CTM Regulations, in particular they update the references to the European Union Trade Mark Regulation as referred to in Regulations 26 and 27.

Regulations 50 to 52 are made under section 54 of the 1994 Act and make minor amendments to the International Registration Order.

Part 5 contains Transitional provisions arising out of the substitution of references to the European Union Trade Mark Regulation (EU) No 2017/1001 for the predecessor regulation.

A full impact assessment has not been produced for this instrument as no, or no significant impact on the private, voluntary or public sector is foreseen. A copy of this instrument and the Explanatory Memorandum (together with a transposition note) is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, NP10 8QQ. The Explanatory Memorandum (together with a transposition note) are also available alongside the instrument on [www.legislation.gov.uk](http://www.legislation.gov.uk).

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