
STATUTORY INSTRUMENTS

1996 No. 714

The Trade Marks (International Registration) Order 1996

**INTERNATIONAL REGISTRATIONS
DESIGNATING THE UNITED KINGDOM**

Entitlement to protection

3.—(1) An international registration designating the United Kingdom shall be entitled to become protected subject to the provisions of articles 9 to 12 where, if the particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration (including any imposed by the Rules).

(2) For that purpose, sections 32 to 34, rules 5 to 8 and rules 10 and 11 shall be disregarded.

Effects of Protected International Trade Mark (UK)

4.—(1) The proprietor of a protected international trade mark (UK) has, subject to the provisions of this Order, the same rights and remedies as are given by or under sections 9 to 12 and 14 to 20 to the proprietor of a registered trade mark, subject to the limits on effect and to the provisions relating to exhaustion which are applicable to a registered trade mark by virtue of section 11 and section 12 respectively.

(2) For the purposes of section 9 (rights conferred by registered trade mark)—

- (a) the rights of the proprietor shall have effect as of the date on which it is to be treated as registered pursuant to article 12 or article 21;
- (b) a protected international trade mark (UK) shall be treated as being in fact registered when it becomes protected pursuant to article 12.

(3) References in sections 10 and 11 to goods or services in respect of which a trade mark is registered are to goods or services in respect of which a protected international trade mark (UK) confers protection in the United Kingdom.

(4) Where the holder of an international registration designating the United Kingdom by notice in writing sent to the registrar—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark, or
- (b) agrees that the rights conferred in the United Kingdom by the international registration shall be subject to a specified territorial or other limitation,

the registrar shall enter the disclaimer or limitation in the supplementary register and shall publish the disclaimer or limitation.

(5) Where a protected international trade mark (UK) is subject to a disclaimer or limitation, the rights conferred in relation to it by the application of section 9 are restricted accordingly.

(6) The remedy for groundless threats of infringement proceedings given by section 21 applies in relation to a protected international trade mark (UK) as in relation to a registered trade mark; 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 protection of a protected international trade mark (UK); 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 a protected international trade mark (UK) or is the subject of an international application or international registration designating the United Kingdom.

International Trade mark (UK) as an object of property

5. The provisions of sections 22, 23, 24 (except subsection (2)(b)) and 26 (which relate to a registered trade mark as an object of property) apply, with the necessary modifications, in relation to an international trade mark (UK) as in relation to a registered trade mark.

Notification of transactions

6.—(1) The following are notifiable transactions for the purposes of this article—

- (a) the grant of a licence under a protected international trade mark (UK);
- (b) the granting of any security interest (whether fixed or floating) over an international trade mark (UK) or any right in or under it.

(2) On application being made to the registrar by—

- (a) a person claiming to be entitled to an interest in or under an international trade mark (UK) by virtue of a notifiable transaction, or
- (b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the supplementary register.

(3) The following are relevant transactions for the purposes of this article—

- (a) a notifiable transaction;
- (b) an assignment of an international trade mark (UK) or any right in it;
- (c) the making by personal representatives of an assent in relation to an international trade mark (UK) or any right in or under it;
- (d) an order of a court or other competent authority transferring an international trade mark (UK) or any right in or under it.

(4) Until (in the case of a notifiable transaction) an application has been made for registration of the prescribed particulars or (in the case of any other relevant transaction) the transaction has been recorded in the International Register—

- (a) the transaction is ineffective as against a person acquiring an interest in or under the international trade mark (UK) in ignorance of it, and
- (b) a person claiming to be a licensee by virtue of the transaction does not have the protection of section 30 or 31 (rights and remedies of licensee in relation to infringement).

(5) Where a person becomes the proprietor or a licensee of an international trade mark (UK) by virtue of a relevant transaction, then unless—

- (a) an application for registration of the transaction (in the case of a notifiable transaction) is made, or (in the case of any other relevant transaction) a request for recordal in the International Register is made, before the end of a period of six months beginning with its date, or
- (b) the court is satisfied that it was not practicable for such an application or request for recordal to be made before the end of that period and that an application or request for recordal (as the case may be) was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the international trade mark (UK) occurring after the date of the transaction and before (in the case of a notifiable transaction) the prescribed particulars of the transaction are registered or (in the case of any other relevant transaction) the transaction is recorded in the International Register.

(6) “Prescribed particulars” means the particulars prescribed by rule 34.

Licensing

7.—(1) The provisions of sections 28 to 31 apply, with the necessary modifications, in relation to licences to use a protected international trade mark (UK).

(2) The reference in section 28(1) to goods or services for which a trade mark is registered shall be treated as a reference to goods or services in respect of which the trade mark is protected in the United Kingdom.

Priority

8.—(1) The provisions of section 35 (claim to priority of Convention application) apply, subject as mentioned below, so as to confer a right to priority in relation to protection of an international registration designating the United Kingdom as they apply in relation to registering a trade mark under the Act.

(2) Subsection (5) of that section does not apply and the manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.

Examination

9.—(1) Upon receiving from the International Bureau notification of an international registration designating the United Kingdom, the registrar shall examine whether it satisfies the requirements of article 3.

(2) For that purpose, he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) If it appears to the registrar that the requirements referred to in paragraph (1) above are not met, or are met only in relation to some of the goods or services in respect of which protection in the United Kingdom has been requested, he shall give notice of refusal to the International Bureau.

(4) Notice of refusal shall specify a period within which the holder may make representations.

(5) A holder making representations shall file an address for service in the United Kingdom on Form TM33.

Publication, opposition proceedings and observations

10.—(1) Where following examination pursuant to article 9 it appears to the registrar that the requirements of article 3 are met in relation to all or some of the goods or services comprised in the international registration, the registrar shall publish a notice specifying particulars of the international registration and specifying the goods or services for which protection will be conferred.

(2) Any person may, within three months of the date of publication pursuant to paragraph (1) above, give notice to the registrar of opposition to the conferring of protection.

The notice shall be given in writing in the manner prescribed by rule 13, shall include a statement of the grounds of opposition and shall where opposition is based on an earlier trade mark indicate the goods or services on which the opposition is based.

(3) The registrar shall, upon notice of opposition being given, and in any event within four months of publication pursuant to paragraph (1) above, give notice of refusal to the International Bureau stating the matters relating to the opposition referred to in paragraph (2) above.

(4) Within three months of the date on which notice of refusal based on opposition is given to the International Bureau, the holder may file a counter-statement, in conjunction with notice of the same on Form TM8 and an address for service in the United Kingdom.

(5) Subject to the provisions of this article, rules 13 and 14 shall apply in relation to opposition proceedings, with the substitution of the holder for the applicant.

(6) Where a notice has been published pursuant to paragraph (1) above, any person may, at any time before the trade mark has become protected in accordance with article 12, make observations in writing to the registrar as to whether the trade mark should be protected.

A person who makes observations does not thereby become a party to proceedings in relation to the request for protection.

Notices of refusal

11.—(1) Except where refusal is based on an opposition, notice of refusal shall not be given after the expiry of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom.

(2) The registrar shall inform the International Bureau that oppositions may be filed after the expiry of the period of 18 months referred to in paragraph (1) above unless, at least four months before the expiry of the said period, he has published the notice referred to in article 10(1).

(3) Notices of refusal shall set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.

(4) Where—

- (a) notice of refusal has been given pursuant to article 9(3), and
 - (i) the holder makes representations within the period specified under article 9(4), or
 - (ii) the holder makes no representations within that period, or informs the registrar that he does not intend to make any representations; or
- (b) notice of refusal based on an opposition has been given pursuant to article 10(3) and
 - (i) the holder files a counter-statement within the period specified in article 10(4), or
 - (ii) the holder files no counter-statement within that period or informs the registrar that he does not intend to file a counter-statement,

the registrar shall inform the International Bureau of that fact.

(5) Where—

- (a) after notice of refusal has been given pursuant to article 9(3), the holder makes representations within the period specified under article 9(4); or
- (b) after notice of refusal based on an opposition, the holder files a counter-statement within the period specified in article 10(4),

the registrar shall, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(6) For the purposes of paragraph (5) above, a final decision shall be regarded as being made where—

- (a) the registrar, or the appointed person or the court on appeal or further appeal from the registrar, decides whether the refusal shall be upheld, in whole or in relation to some only

- of the goods or services in relation to which protection in the United Kingdom is requested, and any right of appeal against that decision expires or is exhausted;
- (b) the representations or counter-statement are withdrawn; or
 - (c) the proceedings relating to the refusal are discontinued or abandoned.

Protection

12.—(1) Where—

- (a) following examination and publication pursuant to articles 9 and 10—
 - (i) the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom has not expired, but the period for giving notice of refusal based on an opposition in accordance with article 10(3) expires without notice of refusal (whether based on opposition or otherwise) having been given,
 - (ii) the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom has expired, and the period for giving notice of opposition in accordance with article 10(2) expires without notice of opposition having been given,
 - (iii) notice of refusal has been given in respect of some only of the goods or services in respect of which protection in the United Kingdom has been requested and the registrar informs the International Bureau in accordance with article 11(4) that the holder has made no representations within the period specified in article 9(4) or has filed no counter-statement within the period specified in article 10(4) (as the case may be) or that the holder has informed the registrar that he does not intend to make such representations or file such a counter-statement, or
 - (iv) notice of refusal has been given in respect of all or some of the goods or services in respect of which protection in the United Kingdom has been requested and the registrar notifies the International Bureau in accordance with article 11(5) that a final decision has been made that the refusal is withdrawn, or is withdrawn in respect of some of the goods or services in respect of which protection in the United Kingdom has been requested; or
- (b) the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom expires without any notice of refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period,

the trade mark which is the subject of the request for protection shall thereupon be protected as a protected international trade mark (UK); and in a case where a refusal subsists in respect of some of the goods or services in respect of which protection in the United Kingdom has been requested, protection shall apply only as regards the remaining goods or services.

(2) For the purposes of application by this Order of provisions of the Act, subject to article 21, a trade mark so protected shall be treated as being registered under the Act as of the following date:—

- (a) where the request for extension of protection to the United Kingdom is mentioned in the international application, or is made subsequently, but on or before the date of the international registration, the date of that international registration;
- (b) where the request for such extension is made subsequently to the international registration, the date on which the request is recorded in the International Register.

(3) When a trade mark becomes protected pursuant to this article, the registrar shall publish particulars of the international registration specifying the date on which, and the goods or services in respect of which, protection is conferred.

Revocation and Invalidity

13.—(1) The provisions of section 46 (revocation of registration) and section 47 (grounds for invalidity of registration) shall apply, subject to the adaptations set out below, so as to permit the protection of a protected international trade mark (UK) to be revoked, or declared invalid.

(2) The reference in section 46(1) to the date of completion of the registration procedure shall be construed as a reference to the date of the protected international trade mark (UK) becoming protected; the reference in section 46(2) to the form in which a trade mark was registered shall be construed as reference to the form in which it is protected; and the references in section 46(5) and section 47(5) to goods or services for which the trade mark is registered shall be construed as references to those in respect of which it is protected.

(3) The references in section 46 to the registration of a trade mark being revoked and the references in section 47 to the registration of a trade mark being declared invalid shall be construed as references to the protection of a protected international trade mark (UK) being revoked or declared invalid, as the case may be.

(4) The provisions of rule 31, with necessary modifications, apply in relation to the procedure on application for revocation and declaration of invalidity of protection of a protected international trade mark (UK).

(5) Where the protection of a protected international trade mark (UK) is revoked or declared invalid to any extent, the registrar shall notify the International Bureau, and

- (a) in the case of a revocation, the rights of the proprietor shall be deemed to have ceased to exist to that extent as from the date on which the revocation is recorded in the International Register;
- (b) in the case of a declaration of invalidity, the trade mark shall to that extent be deemed never to have been a protected international trade mark (UK):

Provided that this shall not affect transactions past and closed as at the date when the invalidity is recorded in the International Register.

Effect of acquiescence

14. Section 48 (effect of acquiescence) applies where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a protected international trade mark (UK); and for that purpose—

- (a) the reference to a registered trade mark shall be construed as including a protected international trade mark (UK);
- (b) the references to registration shall include references to protection of a protected international trade mark (UK).

Proceedings relating to invalidity and revocation of protection

15.—(1) The provisions of section 73 (certificate of validity of contested registration) apply, with the necessary modifications, in relation to proceedings before the court in which the validity of the protection of a protected international trade mark (UK) is contested.

(2) The provisions of section 74 (registrar's appearance in proceedings involving the registrar) apply, with the necessary modifications, in relation to proceedings before the court involving an application for—

- (a) the revocation of the protection of a protected international trade mark (UK);
- (b) a declaration of the invalidity of the protection of a protected international trade mark (UK);

- (c) the rectification of the supplementary register.

Importation of infringing goods, materials or articles

16. The provisions of section 89 (infringing goods, material or articles may be treated as prohibited goods) section 90 and section 91 of the Act (power of Commissioners of Customs and Excise to disclose information) apply in relation to goods which are, in relation to a protected international trade mark (UK), infringing goods, materials or articles, and for the purposes of those provisions—

- (a) references to a registered trade mark shall be to a protected international trade mark (UK);
(b) the Trade Marks (Customs) Regulations 1994⁽¹⁾ shall apply in relation to notices given under the provisions of section 89.

Offences and forfeiture

17.—(1) The provisions of section 92 (unauthorised use of trade mark, etc, in relation to goods), section 93 (enforcement function of local weights and measures authority), section 97 (forfeiture: England and Wales) and section 98 (forfeiture: Scotland) apply in relation to a protected international trade mark (UK).

(2) For the purposes of the provisions referred to in paragraph (1) above—

- (a) references to a registered trade mark shall be treated as references to a protected international trade mark (UK);
(b) references to goods in respect of which a trade mark is registered shall be treated as references to goods in respect of which a protected international trade mark (UK) confers protection in the United Kingdom.

(3) No offence under section 92 in relation to a protected international trade mark is committed by anything done before the date of publication pursuant to article 12(3).

Falsely representing trade mark as a protected international trade mark (UK)

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

- (a) falsely to represent that a mark is a protected international trade mark (UK), or
(b) to make a false representation as to the goods or services for which a protected international trade mark (UK) confers protection in the United Kingdom

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

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

(1) S.I.1994/2625.