

2007 No. 1976

TRADE MARKS

The Trade Marks (Relative Grounds) Order 2007

Made - - - - *10th July 2007*

Coming into force - - *1st October 2007*

A draft of this instrument was laid before Parliament in accordance with section 8(5) of the Trade Marks Act 1994^(a) and approved by a resolution of each House of Parliament.

Accordingly the Secretary of State makes the following Order in exercise of the power conferred by section 8 of the Trade Marks Act 1994.

Citation and commencement

1. This Order may be cited as the Trade Marks (Relative Grounds) Order 2007 and shall come into force on 1st October 2007.

Refusing to register a mark on a ground mentioned in section 5 of the Trade Marks Act 1994

2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.

3. Section 37(2) of the Trade Marks Act 1994 (search of earlier trade marks) shall cease to have effect.

4. The registrar may, in connection with an examination under section 37(1) of the Trade Marks Act 1994, carry out a search of earlier trade marks for the purpose of notifying the applicant and other persons about the existence of earlier trade marks that might be relevant to the proposed registration.

5.—(1) Only the persons specified in paragraph (2) may make an application for a declaration of invalidity on the grounds in section 47(2) of the Trade Marks Act 1994 (relative grounds).

(2) Those persons are—

- (a) in the case of an application on the ground in section 47(2)(a) of that Act, the proprietor or a licensee of the earlier trade mark or, in the case of an earlier collective mark or certification mark, the proprietor or an authorised user of such collective mark or certification mark; and
- (b) in the case of an application on the ground in section 47(2)(b) of that Act, the proprietor of the earlier right.

^(a) 1994 c.26.

(3) So much of section 47(3) of that Act as provides that any person may make an application for a declaration of invalidity shall have effect subject to this article.

Transitional provisions

6.—(1) Articles 2 to 4 shall not apply to an application for registration of a trade mark which was published before the coming into force of this Order.

(2) Article 5 shall not apply to an application for a declaration of invalidity which relates to a trade mark the application for the registration of which was published before the coming into force of this Order.

10th July 2007

Ian Pearson
Minister of State for Science and Innovation
Department for Innovation, Universities and Schools

EXPLANATORY NOTE

(This note is not part of the Order)

Section 5 of the Trade Marks Act 1994 (“the Act”) (relative grounds for refusal) provides that a trade mark shall not be registered if it is identical with or similar to an earlier trade mark (defined in section 6) or earlier right.

Under section 37 of the Act the registrar is required to examine whether an application for registration of a trade mark satisfies the requirements of the Act and for that purpose, is required to carry out a search of earlier trade marks.

If it appears to the registrar that these requirements are not met he must inform the applicant and give him the opportunity to make representations or amend the application. However, if it appears that they are met, he must accept the application and publish it. Following publication, *any* person may, within a prescribed period, oppose the registration (section 38).

Section 8 of the Act confers power on the Secretary of State to make an Order in these terms following the expiry of a period of ten years beginning with the date on which applications for Community trade marks (“CTMs”) may first be filed in pursuance of the Community Trade Mark Regulation (Council Regulation 40/94/EEC). Applications for CTMs were first able to be filed on 1 April 1996 and so the ten year period has now elapsed.

This Order provides that the registrar shall no longer refuse to register a trade mark on relative grounds unless the proprietor of the earlier trade mark or other earlier right objects on any such ground in opposition proceedings. It also makes consequential provision with respect to the carrying out by the registrar of searches of earlier trade marks and as to the persons by whom an application for a declaration of invalidity may be made on the grounds specified in section 47(2) of the Act.

A full regulatory impact assessment of the effect that this instrument will have on the costs of business and the voluntary sector is available from the UK Intellectual Property Office, Room 2B36, Concept House, Cardiff Road, Newport, NP10 8QQ and is annexed to the Explanatory Memorandum which is available alongside the instrument on the OPSI website.

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