

SCHEDULE 2

Article 3(3)(i)

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

1.—(1) Section 25 (registration of transactions affecting registered trade mark) is modified as follows.

(2) Omit paragraph (a) of subsection (1) and substitute—

“(a) a person claiming to be entitled to any security interest (whether fixed or floating) over a protected international trade mark (UK) or any right in or under it, or”.

(3) Omit paragraphs (a), (b) and (c) of subsection (2) and substitute—

“(a) a change to the ownership of a registration recorded by the International Bureau in the International Register pursuant to article 9 of the Madrid Protocol;

(b) the grant of a licence recorded by the International Bureau in the International Register pursuant to rule 20 *bis* of the Common Regulations;”.

(4) After subsection (2)(e) insert—

“(f) any matter other than as is referred to in paragraphs (a) and (b) above that is recorded in the International Register pursuant to article 9 *bis* of the Madrid Protocol.”.

(5) In subsection (3) omit “Until an application has been made for registration of the prescribed particulars of a registrable transaction” and substitute “Until an application for registration of a matter in the supplementary register pursuant to subsection (1) has been made or an application for registration of a registrable transaction in the International Register (in accordance with Article 9 *bis* of the Madrid Protocol and rule 20 *bis* of the Common Regulations) has been made”.

(6) In subsection (4)(a) omit “the prescribed particulars of the transaction” and substitute “a transaction in the International Register (in accordance with Article 9 *bis* of the Madrid Protocol and rule 20 *bis* of the Common Regulations)”.

2. In section 33 (date of filing), for subsection (1), substitute—

“33.—(1) The date of filing of a request for extension shall be the date of the international registration except—

(a) where at the time protection is conferred on an international trade mark (UK) there is a concurrent registered trade mark, the date of filing shall be the date of filing of the registered trade mark; and

(b) where a request for extension is made in accordance with Article 3*ter*(2) of the Madrid Protocol, the date of filing shall be the date that the request for extension was recorded in the International Register.”.

3. In section 35 (claim to priority of convention application), for subsection (5), substitute—

“(5) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.”.

4. In section 37 (examination of application) omit subsections (3) to (5) and substitute—

“(3) If it appears to the registrar that the requirements for registration are not met, the registrar shall give notice of provisional refusal to the International Bureau.

(4) Where the International Bureau notifies the registrar or the registrar considers that a particular term used to indicate any of the goods or services included in the international registration is—

(a) too vague for the purposes of classification; or

(b) incomprehensible or linguistically incorrect,

*Status: This is the original version (as it was originally made). This item of legislation is currently only available in its original format.*

the registrar may give notice of provisional refusal to the International Bureau in respect of that term.

(5) Where a decision of the registrar has been notified to the International Bureau pursuant to subsection (3) or (4), the registrar shall give the holder of the international registration an opportunity, within such period as the registrar may specify, to make representations or amend the request for extension by limiting the goods and services.”

5. In section 38(2) (publication, opposition proceedings and observations) after “opposition to the registration” insert “in which event the registrar shall give notice of provisional refusal to the International Bureau”.

6. After section 38, insert—

**“38A. Notices of provisional refusal**

(1) A notice of provisional refusal must set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.

(2) Except as provided in subsection (3), a notice of provisional refusal may not be given after the expiry of the relevant period.

(3) Where before the expiry of the relevant period the registrar has given notice to the International Bureau—

- (a) that the period prescribed for the purposes of section 38(2) expires after the end of the relevant period; or
- (b) that the period prescribed for the purposes of section 38(2) expires less than one month before the end of the relevant period;

a notice of provisional refusal may be given after the expiry of the relevant period provided that it is given before the end of the period of one month beginning immediately after the period prescribed for the purposes of section 38(2).

(4) Where the registrar sends the International Bureau a notice of provisional refusal, the registrar must notify the International Bureau as to the final decision (meaning a decision from which no appeal may be brought) on whether the refusal should be upheld.

(5) The relevant period is the period of 18 months beginning with the date the International Bureau sent the registrar the request for extension.

**38B. Protection**

(1) Where no notice of provisional refusal is given to the International Bureau following publication under section 38(1), the international registration which is the subject of the request for extension shall be protected as a protected international trade mark (UK) with effect from the first day immediately following the end of the period prescribed for the purposes of section 38(2).

(2) Where notice of provisional refusal is given following publication under section 38(1), the international registration which is the subject of the request for extension shall be protected as a protected international trade mark (UK) with effect from the date on which the registrar notifies the International Bureau that the final decision is that the provisional refusal should not be upheld in accordance with section 38A(4).

(3) The reference to the completion of the registration procedure in section 46(1) shall be construed as a reference to the conferring of protection on an international registration in accordance with this section.

(4) When an international registration becomes protected as a protected international trade mark (UK), the registrar shall—

- (a) notify the International Bureau that the international registration is protected in the United Kingdom; and
- (b) publish a notice specifying the number of the international registration in respect of that trade mark, the date on which protection is conferred and the date and place of publication of the request for extension under section 38(1) in relation to that trade mark.”.

7. In section 39 (Withdrawal, restriction or amendment of application) for subsection (1) substitute—

“(1) The goods and services covered by a request for extension may be restricted at any time by the applicant provided that if the request for extension has been published, the restriction must also be published in the Journal and recorded in the supplementary register.

8.—(1) Section 63 (the register) shall be modified as follows.

(2) For subsection (1) substitute—

“(1) The registrar shall maintain a register for the purpose of entering transactions under section 25(1) (as modified by paragraph 1 of Schedule 2 to the Trade Marks International Registration) Order 2008) and disclaimers and limitations relating to international trade marks (UK).”.

(3) In subsection (3) for the words “shall be kept in such manner as may be prescribed” substitute “need not be kept in documentary form”.

(4) After subsection (3) insert—

“(4) Following notification from the International Bureau under rule 28(2) of the Common Regulations the registrar may correct an error or omission in the information entered in the register required to be maintained under subsection (1).”.

9. In section 67(2)(a) (Information about applications and registered trade marks) before “in such cases” insert “any information recorded in the International Register or”.