

**EXPLANATORY MEMORANDUM TO**  
**THE TRADE MARKS (EARLIER TRADE MARKS) REGULATIONS**

**2008 No. 1067**

**1.** 1.1 This explanatory memorandum has been prepared by the Department for Innovation, Universities and Skills and is laid before Parliament by Command of Her Majesty.

1.2 This memorandum contains information for the Joint Committee on Statutory Instruments.

**2. Description**

2.1 These Regulations correct errors in, and omissions from, sections 6A and 47(2A)-(2E) of the Trade Marks Act 1994 (“the Act”). The errors arose as a result of changes made to the Act by the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) (“the first regulations”) and the Trade Marks (International Registrations Designating the European Community, etc.) Regulations 2004 (SI 2004/2332) (“the second regulations”).

**3. Matters of special interest to the Joint Committee on Statutory Instruments**

3.1 These Regulations are being issued free of charge to anyone who has purchased the first or second regulations as they correct errors in those regulations. These errors were not previously reported by the Joint Committee.

**4. Legislative Background**

4.1 These Regulations are made under section 2(2) of the European Communities Act 1972, as were the first and second regulations.

**5. Territorial Extent and Application**

5.1 This instrument applies to all of the United Kingdom.

**6. European Convention on Human Rights**

The Parliamentary Under Secretary of State for Intellectual Property and Quality, Baroness Morgan, has made the following statement:

“In my view the provisions of the Trade Marks (Earlier Trade Marks) Regulations 2008 are compatible with the European Convention on Human Rights”.

**7. Policy background**

7.1 The first regulations introduced a requirement that where existing trade marks are used as the basis for opposing the registration of, or seeking the invalidation of, a later trade mark, the proprietor of the earlier trade mark must be able to show that the earlier mark has been used or that there are proper reasons for non-use. This requirement

implemented the provisions of articles 11(1) and (2) of European Directive 89/104/EEC (“the Directive”), which provides that a registered trade mark shall not be invalidated and may not be opposed on the basis of an earlier registered trade mark which is itself liable to revocation for non-use.

7.2 The first regulation applied this use requirement to “earlier trade marks”, which are defined in section 6(1) of the Act as including various forms of registered trade mark and “well known trade marks” protected under article 6*bis* of the Paris Convention for the Protection of Industrial Property or the WTO agreement. Article 4(2)(d) of the Directive requires the UK to protect well known marks against later conflicting national marks whether or not the well known mark is registered or in use in the UK. Consequently, to the extent that the first regulation made protection of well known marks in opposition or invalidation proceedings subject to a condition that the mark is in use in the UK, it introduced a requirement that was inconsistent with Community law. Regulations 4(2) and 5(3) of these Regulations correct this error in the first regulation.

7.3 The transitional provisions in Regulations 6 and 8 protect the legitimate expectations of a person who may have applied to register a national trade mark after the date that the first regulation came into force (5<sup>th</sup> May 2004), but before the date that these Regulations come into force. Such a person may have expected that well known marks could not be used as a basis for opposing or invalidating a national trade mark unless the well known mark was used in the UK. Consequently, Regulations 4(2) and 5(3) of these Regulations will not apply to trade marks filed in this period.

7.4 The second regulations introduced changes to sections 5 and 6 of the Act which were linked to changes made around the same time to the Community Trade Mark Regulation 40/94 (“CTMR”) when the European Community (“EC”) acceded to the Protocol to the Madrid Agreement Concerning the International Registration of Marks (“The Protocol”). The Protocol provides for a system of international trade mark registration administered by the World Intellectual Property Organisation. Under the Protocol, holders of international trade mark registrations can designate contracting states or territories for the protection of international trade marks. The effect of the EC joining the Protocol in 2004 was that, for the first time, holders of international trade marks could designate the EC as a whole for protection. The changes made to the CTMR created a new category of protected trade marks with exclusive legal rights in the EC.

7.5 The changes to the Act introduced by the second regulations recognised this new category of trade marks, which are described in the amended Act as “international trade marks (EC)”, by protecting them against later filed conflicting national trade marks.

7.6 The CTMR requires that in order to qualify for continuing protection both Community trade marks as such, and international trade marks protected in the EC, must be used “in the Community”. The first regulations introduced requirements as to the territorial scope of the required use, which was expressed in sections 6A(3)(a) and 47(2B) of the Act as being “in the United Kingdom”. However, consistent with Community law, sections 6A(5) and 47(2D) contained exceptions with regard to Community trade marks for which the requirement was for “use in the European Community”.

7.7 The second regulation introducing international trade marks (EC) made no amendments to sections 6A or 47. Consequently, although these trade marks became

“earlier trade marks”, these trade marks were not added to the exception listed in sections 6A(5) and 47(2D) so as to make their continued protection subject to “use in the European Community”. Consequently, by default, they became subject to the general use requirements in sections 6A(3)(a) and 47(2B) for “use in the United Kingdom”. This is inconsistent with the CTMR and therefore with Community law.

7.8 Regulations 4(3) and 5(2) of these Regulations corrects this error by putting international trade marks (EC) on the same footing as Community trade marks. The use required to maintain protection for both types of marks will in future be “use in the European Community”.

7.9 There is a qualifying period of 5 years before protection of any kind of registered trade mark can be refused because of its non-use. International trade marks (EC) only came into existence at the end of 2004. Consequently no UK applicant can yet have applied to register a national trade mark with a legitimate expectation that an earlier conflicting international trade mark (EC) could not be invoked against it because of its non-use. This is why there are no transitional provisions with regard to Regulations 4(3) and 5(2).

## **8. Impact**

8.1 These Regulations simply remove the unintended effects of the earlier instruments. The intended effects of those instruments were covered by Regulatory Impact Assessments. Consequently, no separate impact assessment has been prepared for this instrument.

## **9. Contact**

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