
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.

Status: This is the original version (as it was originally made).

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.