

Transposition Table

Implementation of the Directive to approximate the laws of the Member States relating to trade marks

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 (Recast)

This transposition table has been prepared by the Intellectual Property Office to accompany the Trade Marks Regulations 2018 which transpose the above directive into UK law.

In this table:

references to “the Act” are to the Trade Marks Act 1994, references to a section are to sections of the Act and references to a Schedule are to Schedules to the Act.

references to “the Regulations” are to the Trade Marks Regulations 2018 and references to a regulation are to regulations of the Regulations.

references to the TM Rules are to the Trade Marks Rules 2008 and references to a rule are to rules of the TM Rules.

Articles of the Directive	Copy Out (Y/N)	National Provision	Reasons for elaboration/comments on implementation
CHAPTER 1 GENERAL PROVISIONS			
Article 1 Scope	N		Express implementation not required. It is implicit from the definition of a “trade mark” in section 1 of the Act that the provisions of the Act apply to trade marks in respect of goods and services which are registered or the subject of an application for registration in the UK and includes collective and certification marks
Article 2 Definitions	Y	Rule 2(1) TM Rules defines “the Office”	Implementation required

		Section 63(1) defines the “Register”	
CHAPTER 2 SUBSTANTIVE LAW ON TRADE MARKS			
SECTION 1			
SIGNS OF WHICH A TRADE MARK MAY CONSIST			
Article 3 Signs of which a trade mark may consist	Y	Section 1(1) as amended by Regulation 3	Implementation required
SECTION 2			
FOUNDATIONS FOR REFUSAL OR INVALIDITY			
Article 4 Absolute grounds for refusal or invalidity	Y	Section 3 (Absolute grounds for refusal of registration) and section 47 (Grounds for invalidity of registration)	Implementation required
Article 4.1(a)	N	Section 3(1)(a)	Implementation required. The existing provision is retained as it is identical in substance to Article 4.1(a)
Article 4.1(b)	Y	Section 3(1)(b)	Implementation required
Article 4.1(c)	Y	Section 3(1)(c)	Implementation required
Article 4.1(d)	Y	Section 3(1)(d)	Implementation required
Article 4.1(e)	Y	Section 3(2) as amended by Regulation 4(2)	Implementation required
Article 4.1(f)	Y	Section 3(3)(a)	Implementation required
Article 4.1(g)	Y	Section 3(3)(b)	Implementation required
Article 4.1(h)	Y	Sections 3(5), 4(3), 57 and 58	Implementation required. Sections 57 and 58 implement Article 6ter of the Paris Convention which is referred to in Article 4.1(h)
Article 4.1(i)	N	Section 3 as amended by Regulation 4(4)	Implementation required. The drafting has been adjusted to be

			consistent with the existing provision and so copy-out has not been adopted.
Article 4.1(j)	N	Section 3 as amended by Regulation 4(4)	Implementation required. The drafting has been adjusted to be consistent with the existing provision and so copy-out has not been adopted.
Article 4.1(k)	N	Section 3 as amended by Regulation 4(4)	Implementation required. The drafting has been adjusted to be consistent with the existing provision and so copy-out has not been adopted.
Article 4.1(l)	N	Section 3 as amended by Regulation 4(4)	Implementation required. The drafting has been adjusted to be consistent with the existing provision and so copy-out has not been adopted.
Article 4.2	Y	Sections 3(6) and 47(1)	The first sentence of Article 4.2 requires implementation (this is implemented by section 47(1)). The second sentence is a Member State option, which is implemented by section 3(6)
Article 4.3(a)	Y	Section 3(4) as amended by Regulation 4(3) and section 47(1)	Member State option implemented
Article 4.3(b)	N	Section 4(5)	Member State option which permits a Member State to refuse to register a trade mark which includes a sign of high symbolic value. Existing section 4(5) implements this by restricting the right to register Trade Marks consisting of controlled representations within the meaning of the

			Olympic Symbol etc (Protection) Act 1995
Article 4.3(c)	N	Section 4(1) and (4) and Rule 10	Member State option which permits Member States to refuse to register Trade Marks which include badges, emblems and escutcheons which are of public interest. Existing section 4(1) and (4) and Rule 10 implements this by restricting the right to register Trade Marks consisting of the Royal (or other) arms etc
Article 4.4, first sentence	Y	The proviso to section 3(1)	Implementation required
Article 4.4, second sentence	Y	Section 47(1)	Implementation required
Article 4.5	N		Member State option – not being implemented
Article 5 Relative Grounds for refusal or invalidity	Y	Section 5 (Relative grounds for refusal of registration) and section 47 (Grounds for invalidity of registration)	Implementation required
Article 5.1(a)	Y	Section 5(1) and 47(2)(a)	Implementation required
Article 5.1(b)	N	Section 5(2) and 47(2)(a)	Implementation required. Existing Section 5(2) is retained as it is identical in substance to Article 5.1(b)
Article 5.2(a)	N	Section 6(1)(a)	Implementation required. Existing Section 6(1)(a) is retained as it is identical in substance to Article 5.2(a)
Article 5.2(b)	Y	Section 6(1)(b) as amended by Regulation 7(2)	Implementation required
Article 5.2(c)	N	Section 6(2)	Implementation required. Existing section 6(2) is retained as it is identical in

			substance to Article 5.2(c)
Article 5.2(d)	N	Section 6(1)(c)	Implementation required. Existing section 6(1)(c) is retained as it is identical in substance to Article 5.2(d)
Article 5.3(a)	Y	Section 5(3) as amended by Regulation 5(2) and section 47(2)(a)	Implementation required
Article 5.3(b)	Y	Section 5 as amended by Regulation 5(7) and Section 47(2) as amended by Regulation 23(3)	Implementation required.
Article 5.3(c)	Y	Section 5 as amended by Regulation 5(4) and (6) and section 47(2)(b)	Implementation required.
Article 5.4(a)	Y	Section 5(4)(a) as amended by Regulation 5(3) and (4) and section 47(2)(b)	Member State option – implemented
Article 5.4(b)(i) and (ii)	N		Member State option – not being implemented
Article 5.4(b)(iii) and (iv)	N	Section 5(4)(b) as amended by Regulation 5(5) and section 47(2)(b)	Member State option. Existing section 5(4)(b) as amended is identical in substance to Article 5.4(b)(iii) and (iv)
Article 5.4(c)	N		Member State option – not being implemented
Article 5.5	N	Section 5(5) and section 47(2)	Implementation required. Existing section 5(5) and 47(2) are retained as they are identical in substance to Article 5.5
Article 5.6	N		Member State option – not being implemented
Article 6 Establishment a posteriori of invalidity or revocation of a trade mark	Y	Section 52(2)(b) and the Community Trade Mark Regulations 2006, Regulation 3(3) as amended by Regulation 45	Implementation required
Article 7 Grounds for refusal or invalidity relating to only some	Y	New Section 5A as inserted by Regulation 6 and Section 47(5)	Implementation required

of the goods or services			
Article 8 Lack of distinctive character or of reputation of an earlier trade mark precluding a declaration of invalidity of a registered trade mark			
Article 8(a)	Y	Section 47 as amended by Regulation 23(8)	Implementation required
Article 8(b)	Y	Section 47 as amended by Regulation 23(8)	Implementation required
Article 8(c)	Y	Section 47 as amended by Regulation 23(8)	Implementation required
Article 9 Preclusion of a declaration of invalidity due to acquiescence			
Article 9.1	N	Section 48(1)	Implementation required. Existing section 48(1)(a) is retained as it is identical in substance to Article 9.1
Article 9.2	N	Section 48(1)	Member State option implemented in existing section 48(1)
Article 9.3	N	Section 48(2)	Implementation required. Existing section 48(2) is retained as it is identical in substance to Article 9.3
SECTION 3			
RIGHTS CONFERRED AND LIMITATIONS			
Article 10 Rights conferred by a trade mark			
Article 10.1	N	Section 9(1)	Implementation required. Existing section 9(1) is retained as the first part is identical in substance to Article 10(1)
Article 10.2	N	Section 9(1) as amended by Regulation 9(3)	Implementation required. The drafting has been adjusted to be consistent with the existing provision and so

			copy-out has not been adopted.
Article 10.2(a)	N	Section 10(1)	Implementation required. Existing section 10(1) is retained as it is identical in substance to Article 10(2)(a)
Article 10.2(b)	N	Section 10(2)	Implementation required. Existing section 10(2) is retained as it is identical in substance to Article 10.2(b)
Article 10.2(c)	Y	Section 10(3) as amended by Regulation 10(2)	Implementation required
Article 10.3(a)	Y	Section 10(4)(a)	Member State option
Article 10.3(b)	N	Section 10(4)(b)	Member State option. Existing section 10(4)(b) is retained as it is identical in substance to Article 10(3)(b)
Article 10.3(c)	Y	Section 10(4)(c)	Member State option
Article 10.3(d)	Y	Section 10(4) as amended by Regulation 10(4)	Member State option
Article 10.3(e)	Y	Section 10(4) as amended by Regulation 10(5)	Member State option
Article 10.3(f)	N	Section 10(4) as amended by Regulation 10(6)	Member State option. This provision is copied out subject to the substitution of a reference to the domestic implementing regulations for Directive 2006/114/EC.
Article 10.4	N	Regulation 11 (inserting new section 10A)	Implementation required. This provision is copied out subject to the substitution of a reference to the Customs territory of the EU for “third countries”
Article 10.5	N		Not applicable under UK law
Article 10.6			Implementation not required

Article 11 The right to prohibit preparatory acts in relation to the use of packaging or other means	Y	Section 10 as amended by Regulations 10(2) and (7)	Implementation required
Article 12 Reproduction of trade marks in dictionaries	Y	Regulation 31 (inserting new section 99A)	Implementation required
Article 13 Prohibition of the use of a trade mark registered in the name of an agent or representative	N	Regulation 11 (inserting new section 10B) and Regulation 28 (which repeals section 60)	Implementation required. Currently Section 60 regulates the application for and registration of trade marks in the name of an agent or representative and implements Article 6septies of the Paris Convention. Section 60(3)(b) provides that where a trade mark is registered in the name of an agent or representative, the person who is the proprietor of the mark may apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark unless the agent/representative justifies his action. Article 13(1)(a) provides that in such circumstances the proprietor may demand the assignment of the trade mark in his favour. In implementing Article 13 we have retained the right of the proprietor to apply for rectification of the register as we regard it as being equivalent in effect to the right to demand an assignment.
Article 14 Limitation of the effects of a trade mark			

Article 14.1(a)	N	Section 11(2)(a) as amended by Regulation 12(4)	Implementation required. Existing section 11(2)(a) is retained subject to a minor amendment as it is identical in substance to Article 14.1(a)
Article 14.1(b)	Y	Section 11(2)(b) as amended by Regulation 12(5)	Implementation required
Article 14.1(c)	Y	Section 11(2)(c) as amended by Regulation 12(6)	Implementation required
Article 14.2	Y	Section 11(2) proviso	Implementation required
Article 14.3	N	Section 11(3)	Implementation required. Article 14(3) applies to “earlier rights which only apply in a particular locality” where that right is recognised by the law of that MS. Section 11(3) sets out the domestic requirements which an earlier right must satisfy for this purpose.
Article 15 Exhaustion of the rights conferred by a trade mark			
Article 15.1	N	Section 12(1)	Implementation required. Existing section 12(1) is retained as it is identical in substance to Article 15.1
Article 15.2	N	Section 12(2)	Implementation required. Existing section 12(2) is retained as it is identical in substance to Article 15.2
Article 16 Use of trade marks			
Article 16.1 Use of trade marks (insofar as it relates to Article 17 Non-use as defence to infringement proceedings)	N	New Section 11A as inserted by Regulation 13	Implementation required. The drafting has been adjusted to be consistent with the existing provisions of the Act and so copy-out has not been adopted.
Article 16.1 Use of trade marks (insofar as	N	Section 46(1)(a) and Section 46(1)(b) as	Implementation required. Existing

it relates to Article 19(1) Revocation)		qualified by Section 46(2) as amended by Regulation 22	sections 46(1)(a) and 46(1)(b) are retained subject to a minor amendment to section 46(2) as they are identical in substance to Article 16.1 insofar as it relates to Article 19(1)
Article 16.1 Use of trade marks (insofar as it relates to Articles 44(1) and (2) Non-use as defence in opposition proceedings)	N	Section 6A(1) to (3) and 38 and Rules 17(5)(d), 20(3)(c) and (3)(b)	Implementation required. Existing section 6A(1) to (3) and 38 and Rules 17(5)(d), 20(3)(c) and 3(b) are retained as they are identical in substance to Article 16.1 insofar as it relates to Articles 44(1) and (2)
Article 16.1 Use of trade marks (insofar as it relates to Articles 46(3) and (4) Non-use as defence in invalidity proceedings)	N	Section 47(2A) and (2E)	Implementation required. Existing section 47(2A) and (2E) are retained as they are identical in substance to Article 16.1 insofar as it relates to Articles 46(3) and (4)
Article 16.2			Not applicable under UK law
Article 16.3	N	Article 3(3)(e) of and schedule 2 paragraph 6 to the Trade marks (International Registration) Order 2008 as amended by Regulation 52 and section 6A as amended by Regulation 8(6) and New section 11A as inserted by Regulation 13 and section 47 as amended by Regulation 23(7)	Implementation required. Article 16.3 applies the provisions relating to use to International trade marks (UK) and international trade marks (EC). The provisions cited in the 3 rd column provide a gloss on the references to “completion of the registration procedure” so that the rules can apply to international trade marks.
Article 16.4	N	Rule 47(b)	Implementation required. Rule 47(b) is identical in substance to Article 16.4
Article 16.5(a)	Y	Section 6A(4)(a) as amended by Regulation 8(5) and Section 46(2)	Implementation required

		as amended by Regulation 22	
Article 16.5(b)	Y	Section 46(2)	Implementation required. Latter part of s.46(2) identical in substance to Article 16.5(b)
Article 16.6	N	Section 46(1)(a)	Implementation required. Existing section 46(1)(a) refers to “use by the proprietor or with his consent ”. This is retained as it is identical in substance to Article 16.6
Article 17 Non-use as defence in infringement proceedings	Y	Regulation 13 (inserting new section 11A)	Implementation required
Article 18 Intervening right of the proprietor of a later registered trade mark as defence in infringement proceedings			
Article 18.1	Y	Section 11 as amended by Regulation 12(2)	Implementation required
Article 18.2	Y	Section 11 as amended by Regulation 12(3)	Implementation required
Article 18.3	Y	Section 11 as amended by Regulation 12(3)	Implementation required
SECTION 4			
REVOCAION OF TRADE MARK RIGHTS			
Article 19 Absence of genuine use as ground for revocation			
Article 19.1	N	Section 46(1)(a) and (b)	This is retained as it is identical in substance to Article 19.1
Article 19.2	N	Section 46(3)	This is retained as it is identical in substance to Article 19.2
Article 19.3	N	The proviso to section 46(3)	This is retained as it is identical in substance to Article 19.3
Article 20 Trade Mark having become generic or misleading indication as grounds for revocation			

Article 20(a)	N	Section 46(1)(c)	Implementation required. Existing section 46(1)(c) is retained as it is identical in substance to Article 20(a)
Article 20(b)	N	Section 46(1)(d)	Implementation required. Existing section 46(1)(d) is retained as it is identical in substance to Article 20(b)
Article 21 Revocation relating to only some of the goods or services	Y	Section 46(5)	Implementation required
SECTION 5			
TRADE MARKS AS OBJECTS OF PROPERTY			
Article 22 Transfer of registered trade marks			
Article 22.1	N	Section 24(1) and (2)(a)	Implementation required. Existing section 24(1) and (2)(a) are retained as they are identical in substance to Article 22.1
Article 22.2	N	Section 24 as amended by Regulation 14	Implementation required
Article 22.3	N	Section 25	Implementation required. Article 22.3 requires Member States to have procedures in place to allow for the recordal of transfers in their registers. Section 25 provides that assignments of registered trade marks shall be entered in the register.
Article 23 Rights in rem			
Article 23.1	N	Section 24(1) and 24(5)	Implementation required. Section 24(1) does not refer to “rights in rem” but provides that trade marks may be transmissible “in the same way as other personal or moveable

			property” so we consider that it is identical in substance
Article 23.2	N	Section 25	Implementation required. Article 23.2 requires Member States to have procedures in place to allow for the recordal of rights in rem in their registers. Section 25 provides that various transactions (which create rights in rem) relating to registered trade marks shall be entered in the register.
Article 24 Levy of execution			
Article 24.1	N	Section 37 Senior Courts Act 1981 and Section 107 County Courts Act 1984 (as supplemented by Civil Procedure Rules Part 69)	Implementation required. See Annex below
Article 24.2	N	Section 25(2)(a)	Implementation required. As noted in the Annex referred to above, the Court may order that an assignment be executed in levy of execution and such assignments are registrable under section 25(2)(a)
Article 25 Licensing			
Article 25.1	N	Section 28(1) and Section 29	Implementation required. Existing sections 28(1) and 29 are retained as they are identical in substance to Article 25.1
Article 25.2	Y	Section 28 as amended by Regulation 16	Implementation required
Article 25.3	N	Section 30 as amended by Regulation 17(2) (for non-exclusive licences) and Section 30(2) and (3) as amended by Regulation 17(3) and	Implementation required. The drafting has been adjusted to be consistent with the existing provision and so copy-out has not been adopted.

		(4) (for exclusive licences)	
Article 25.4	Y	Section 30 as amended by Regulation 17(6)	Implementation required
Article 25.5	N	Section 25(2)(b)	Implementation required. Article 25.5 requires Member States to have procedures in place to allow for the recordal of licences in their registers. Section 25(2)(b) provides that the grant of licences of registered trade marks shall be entered in the register.
Article 26 Applications for a trade mark as an object of property	Y	Section 27(1) as amended by Regulation 15	Implementation required
SECTION 6			
GUARANTEE OR CERTIFICATION MARKS AND COLLECTIVE MARKS			
Article 27 Definitions			
Article 27(a)	N	Section 50(1) as amended by Regulation 25 and Schedule 2 paragraph 2	Implementation required. The drafting has been adjusted to be consistent with the existing provisions and so copy-out has not been adopted.
Article 27(b)	Y	Section 49(1) as amended by Regulation 24	Implementation required
Article 28 Guarantee or certification marks			
Article 28.1	N	Section 50	Member State option. This is implemented by section 50 which provides for the registration of certification marks.
Article 28.2 First sentence	N	Section 50(2) and Schedule 2 paragraphs 4 and 7(1)(b)	Implementation required. The TMA does not restrict the categories of person who may apply for the registration of a trade mark. Section 50(2) provides that The

			provisions of the TMA apply to certification marks subject to the provisions of Schedule 2. Existing section 50(2) and Schedule 2, Paragraph 4 and 7(1)(b) are retained as they are identical in substance to Article 28.2
Article 28.2 second sentence	Y	Schedule 2, paragraph 7(1)(b)	Member State option – implemented.
Article 28.3	Y	Schedule 2, paragraphs 5,7,15 and 16	Member State option – implemented.
Article 28.4	N	Schedule 2, paragraph 3	Member State option – implemented. Existing Schedule 2, paragraph 3 is retained as it is identical in substance to Article 28.4
Article 28.5	N	Schedule 2, paragraph 6 and Section 46(1)(a)	Implementation required. Existing Schedule 2, paragraph 6 requires the applicant for a certification mark to specify “who is authorised to use the mark” which, combined with the reference in Section 46(1)(a) to the trade mark being put to genuine use “by the proprietor or with his consent ”, is substantively the same as Article 28.5
Article 29 Collective marks			
Article 29.1	N	Section 49	Implementation required. Article 29 provides that Member States shall provide for the registration of collective marks. Section 49 makes such provision
Article 29.2	Y	Section 49(1) as amended by Regulation 24	Implementation required
Article 29.3	N	Schedule 1, paragraph 3	Member State option. Existing Schedule 1, paragraph 3 is retained

			as it is identical in substance to Article 29.3
Article 30 Regulations governing use of a collective mark			
Article 30.1	N	Schedule 1, paragraph 5(1)	Implementation required. Existing Schedule 1, paragraph 5(1) is retained as it is identical in substance to Article 30.1
Article 30.2 first sentence	Y	Schedule 1, paragraph 5(2) as amended by Regulation 33(2)	Implementation required
Article 30.2 second sentence	Y	Schedule 1, paragraph 5 as amended by Regulation 33(2)(c)	Implementation required
Article 31 Refusal of application			
Article 31.1	N	Section 49 as amended by Regulation 24	Implementation required. Section 49(2) provides that the provisions of the TMA apply to collective marks (subject to the provisions of Schedule 1) and so the provisions of Articles 4 (section 3) and 5 (sections 5 and 6) will apply. As regards the reference to Article 27(b), this is implemented by section 49(1)(b) and Schedule 1, paragraph 2. The reference to Article 29 is implemented by the amendment to section 49. The reference to Article 30 is implemented by Schedule 1 paragraph 6(1).
Article 31.2	Y	Schedule 1, paragraph 4(1)	Implementation required
Article 31.3	N	Section 49 as amended by Regulation 24 and Schedule 1, paragraph 7(1), 7(2) and 7(4)	Implementation required. Existing Schedule 1, paragraph 7(2) provides that the registrar shall give the applicant the

			opportunity to amend the regulations in order to meet the requirements in paragraph 6(1). This is identical in substance to Article 31.3
Article 32 Use of collective marks	N	Schedule 1, paragraph 5(2) and Section 6A, new section 11A (as inserted by Regulation 13), section 46(1)(a) and section 47	Implementation required. Existing Schedule 1, paragraph 5 requires the applicant for a collective mark to specify “who is authorised to use the mark” which, combined with the references in Section 6A, the cross reference to section 46(1)(a) in new Section 11A, section 46(1)(a) and 47 to the trade mark being put to genuine use “by the proprietor or with his consent”, is substantively the same as Article 32
Article 33 Amendments to the regulations governing use of a collective mark			
Article 33.1	N	Schedule 1, paragraph 10	Implementation required. Existing Schedule 1 paragraph 10 is retained as it is identical in substance to Article 33
Article 33.2	N	Schedule 1, paragraph 10	Implementation required
Article 33.3	N	Rule 47 as amended by Regulation 43 and Schedule 1, paragraph 10	Implementation required
Article 34 Persons entitled to bring an action for infringement			
Article 34.1	N	Schedule 1, paragraph 12 as amended by Regulation 33(4)	Implementation required
Article 34.2	N	Schedule 1, paragraph 12(6)	Implementation required. Existing

			Schedule 1, paragraph 12(6) is retained as it is identical in substance to Article 34.2
Article 35 Additional grounds for revocation			
Article 35(a) Additional grounds for revocation	Y	Schedule 1, paragraph 13(b) as amended by Regulation 33(5)(b)	Implementation required
Article 35(b)	Y	Schedule 1, paragraph 13(a) as amended by Regulation 33(5)(a)	Implementation required
Article 35(c)	Y	Schedule 1, paragraph 13(c) as amended by Regulation 33(5)(c)	Implementation required
Article 36 Additional grounds for invalidity	Y	Schedule 1, paragraph 14 as amended by Regulation 33(6)	Implementation required
CHAPTER 3 PROCEDURES			
SECTION 1			
APPLICATION AND REGISTRATION			
Article 37 Application requirements			
Article 37.1	N	Section 32(2) as amended by Regulation 18	Implementation required. Existing section 32(2)(a) to (c) are retained as they are identical in substance to Article 31.1(a) to (c)
Article 37.2	Y	Section 32(4)	Implementation required
Article 38 Date of filing			
Article 38.1	Y	Section 33(1)	Implementation required
Article 38.2			Member State option – not implemented
Article 39 Designation and classification of goods and services			
Article 39.1	N	Section 34(1) and rule 7	Implementation required. Existing Section 34(1) and Rule 7 retained as they are identical in substance to Article 39.1
Article 39.2	Y	Rule 8(2)(b) as amended by Regulation 36(2)	Implementation required

Article 39.3	Y	New rule 8(2A) as inserted by Regulation 36(3)	Implementation required
Article 39.4	Y	Rule 9 as amended by Regulation 37	Implementation required
Article 39.5	Y	New rule 8(2B) as inserted by Regulation 36(3)	Implementation required
Article 39.6	N	Rule 8(3)	Implementation required. Existing Rule 8(3) is retained as it is identical in substance to Article 39.6
Article 39.7	Y	New Section 60A as inserted by Regulation 29	Implementation required
Article 40 Observations by third parties			
Article 40.1	N	Section 38(3)	Member State option - implemented. Definition of a “person” as referred to in section 38(3) – which includes all of the categories specified in Article 40.1 - already provided in the Interpretation Act 1978
Article 40.2	N	Section 49(2) and Schedule 1, para. 7(4) and 8 (as regards collective marks) and Section 50(2) and Schedule 2, para. 8(4) and 9 (as regards certification marks)	Member state option – implemented. The existing provisions are retained as they are identical in substance to Article 40.2
Article 41 Division of applications and registrations	N	Section 41 as amended by Regulation 20 and new Rule 26A as inserted by Regulation 39	Implementation required The drafting has been adjusted to be consistent with the existing provisions and so copy-out has not been adopted
Article 42 Class Fees	N		Member State option – implemented. Article 42 permits Member States to charge an additional fee for each class of good/services beyond the first class. Additional class fees are provided

			for under Rule 5(1A) and (1B) and Trade Marks (Fees) Rules 2008
SECTION 2			
PROCEDURES FOR OPPOSITION, REVOCATION AND INVALIDITY			
Article 43 Opposition procedure			
Article 43.1	Not applicable	Section 38(2) and Rules 16 to 23	Implementation not required. Article 43.1 requires Member States to provide for an “efficient and expeditious administrative procedure before their offices for opposing the registration of a trade mark” on relative grounds. Section 38(2) and Rules 16 to 23 set out the procedural provisions relating to opposition proceedings
Article 43.2, first sentence	N	Section 38(2) and Article 2 of the Relative Grounds Order 2007 and Section 5 (as amended by Regulation 5(4) and (6)) and Section 6	Implementation required. The drafting has been adjusted to be consistent with the existing provisions and so copy-out has not been adopted.
Article 43.2, second sentence	Y	Section 38 as amended by Regulation 19(2)	Implementation required
Article 43.3	N	Rules 18(4), (5) and (6)	Implementation required. Article 43.3 provides for a minimum “cooling off” period of two months in opposition proceedings at the joint request of the parties. Rules 18(4), (5) and (6) provide for various cooling off periods ranging from 9 to 18 months
Article 44 Non-use as defence in opposition proceedings			

Article 44.1	N	Section 6A(1) to (3) (as amended by Regulation 8(2)), Section 38 and Rules 17(5)(d) and 17A(6)(e) as amended by Regulation 38 and Rules 20(2)(c) and (3)(b) .	Implementation required. Existing section 6A(1) to (3)(as amended by Regulation 8(2)) and Rules 17(5)(d) and 17A(6)(e) (as amended by Regulation 38) and Rules 20(2)(c) and (3)(b) are substantively similar to Article 44.1
Article 44.2	N	Section 6A(6)	Implementation required. Existing section 6A(6) is retained as it is identical in substance to Article 44.2
Article 44.3	N	Section 6A(1) to(5)	Implementation required. Section 6A(1) to (5) applies to European Union trade marks and corresponds to the provisions contained in Article 15 of Council Regulation no 207/2009 on the European Union trade mark
Article 45 Procedure for revocation or declaration of invalidity			
Article 45.1	N	Section 46(4) and 47(3)	Implementation required. Article 45.1 requires Member States to provide for an “efficient and expeditious administrative procedure before their offices for the revocation or declaration of invalidity of a trade mark”. Sections 46(4) and 47(3) and Rules 38 to 43 set out the procedural provisions relating to Revocation and Invalidation proceedings before the Registrar

Article 45.2	N	Section 46(1)(a),(1)(b), (1)(c) and (1)(d)	Implementation required. Existing Section 46(1)(a),(1)(b), (1)(c) and (1)(d) are retained as they are identical in substance to Article 45.2
Article 45.3(a)	N	Section 47(1)	Implementation required. Existing Section 47(1) is retained as it is identical in substance to Article 45.3(a)
Article 45.3(b)	N	Section 47(2) as amended by Regulation 23(2)	Implementation required. The drafting has been adjusted to be consistent with the existing provision and so copy-out has not been adopted.
Article 45.4(a)	N		Implementation required. Definition of a person – which includes all of the categories specified in Article 40.1 - already provided through the Interpretation Act 1978
Article 45.4(b)	Y	Section 47(2) and Article 5(5) of the Relative Grounds Order	Implementation required
Article 45.5	N	Section 46(5) and Section 47(5)	Implementation required. Existing section 46(5) and Section 47(5) are retained as they are identical in substance to Article 45.5
Article 45.6	Y	Section 47 as amended by Regulation 23(9)	Implementation required
Article 46 Non-use as a defence in proceedings seeking a declaration of invalidity			
Article 46.1	N	Section 47(2A)(c) and Section 47(2B) as amended by Regulation 23(5)	Implementation required. Existing Section 47(2A)(c) and Section 47(2B)(as amended) are retained as they are identical in substance to Article 46.1

Article 46.2	N	Section 47 as amended by Regulation 23(5)	Implementation required. The drafting has been adjusted to be consistent with the existing provision and so copy-out has not been adopted.
Article 46.3	N	Section 47(2A)	Implementation required. This is implicit in the opening words of Section 47(2A) "The registration of a trade mark may not be declared invalid ...unless"
Article 46.4	Y	Section 47(2E)	Implementation required.
Article 46.5	N	Section 47(2D)	Implementation required. We have not copied out Article 46.5 as the provisions contained in Article 15 of Regulation 207/2009 on the European Union trade mark are mirrored in the Act.
Article 47 Consequences of revocation and invalidity			
Article 47.1	N	Section 46(6)	Implementation required. Existing Section 46(6) is retained as it is identical in substance to Article 47.1 – the registrar /Court would only "fix" the earlier date if it was satisfied following a "request of one of the parties" so it is implicit.
Article 47.2	N	Section 47(6)	Implementation required. Existing Section 47(6) is retained as it is identical in substance to Article 47.2, with the exception of the proviso which is retained as it is considered useful for clarification purposes

SECTION 3 DURATION AND RENEWAL OF REGISTRATION			
Article 48 Duration of registration			
Article 48.1	N	Section 42(1) and section 40(3)	Implementation required. Existing section 42(1) is retained (it provides that a trade mark shall be registered for 10 years from “the date of registration”) whilst Section 40(3) provides that the date of filing of an application shall be deemed to be the date of registration, so they are identical in substance to Article 48.1
Article 48.2	Y	Section 42(2)	Implementation required
Article 49 Renewal			
Article 49.1 (first sentence)	Y	Section 43 and Section 82	Implementation required
Article 49.1 (second sentence)	N		Member state option – not implemented
Article 49.2 (first sentence)	Y	Rule 34(1) as amended by Regulation 40(2)	Implementation required
Article 49.2 (second sentence)	N	New rule 34(2A) as inserted by Regulation 40(3)	The drafting follows the format in section 70 of the Act and is identical in substance to Article 49.2 (second sentence)
Article 49.3	N	Section 43(3) and Rules 35 and 36	Implementation required. Existing section 43(3) as supplemented by Rules 35 and 36 are retained as they are identical in substance to Article 49.3
Article 49.4	Y	Section 43 as amended by Regulation 21	Implementation required
Article 49.5	N	Section 43(4)	Implementation required. Article 49.5 and section 43(4) have the same substantive effect. Where a trade mark has been renewed it will continue to remain on the register, whereas when it is not renewed it

			is removed from the register (Rule 36).
SECTION 4			
COMMUNICATION WITH THE OFFICE			
Article 50 Communication with the office	N	Rule 11	Implementation required. Article 50 requires that parties shall designate an official address for all communication with the Office. Rule 11 requires that an address for service shall be filed by the applicant for the registration of a trade mark, any person who opposes the registration and various other parties to proceedings. Rule 11(4) implements the optional provision in the final sentence that Member States may require that the official address be situated in the EEA.
CHAPTER 4			
ADMINISTRATIVE COOPERATION			
Article 51 Cooperation in the area of trade mark registration and administration	N/A		No need for express implementation. Article 51 provides that offices in each Member State “shall be free” to cooperate with each other and the EUIPO in order to promote convergence of practices etc
Article 52 Cooperation in other areas	N/A		No need for express implementation. Article 52 provides that offices in each Member State “shall be free” to cooperate with each other and the EUIPO in all other areas of their activities
CHAPTER 5			
FINAL PROVISIONS			

Article 53 Data Protection	N/A		No need for express implementation
Article 54 Transposition	N/A		Obligation on UK so no need to implement in the regulations.
Article 55 Repeal	N/A		No need to implement
Article 56 Entry into force	N/A		No need to implement
Article 57 Addressees	N/A		No need to implement
ANNEX – Correlation table	N/A		No need to implement

ANNEX - ARTICLE 24.1 – COMMENTS ON IMPLEMENTATION

Part 3 of The Tribunals, Courts and Enforcement Act 2007 (which is supplemented by the Civil Procedure Rules) sets out the procedure for the enforcement of Court judgements. In the High Court, writs of control (warrants of execution in the County Court) may be issued which provide authority for enforcement agents to seize and sell most forms of personal property owned by the judgement debtor in order to realise funds to discharge the debt. However, whilst the definition of “goods” for these purposes is seemingly wide enough to encompass trade marks (defined in Schedule 12 of the Act as “property of any description other than land”) its application to intangible property appears doubtful, as the process for seizure and sale of goods laid down in The Taking Control of Goods Regulation 2013 is framed in such a way that it could only apply in relation to physical goods – a trade mark cannot be physically seized or sold at auction as that would convey nothing to the purchaser.

As a creation of legislation, a trade mark is only transferable according to the statute which created it, which, under section 24(1) TMA is by “assignment, testamentary disposition or operation of law” and, by subsection (3), an assignment of a registered trade mark is not effective unless it is in writing signed by or on behalf of the assignor.

However, the Courts also have powers to appoint a receiver by way of equitable execution. These powers are contained in s.37 of the Senior Courts Act 1981 and s.107 of The County Courts Act 1984 (as supplemented by the Civil procedure Rules Part 69). Section 37 allows the Court to appoint a receiver in all cases in which it appears to the court to be “just and convenient” to do so and extends to the appointment of a receiver by way of equitable execution. Case law has established that the demands of justice are the overriding consideration. Justice demands that judgements of the English Courts should be complied with and, if necessary, enforced. Relevant considerations in determining what is “just and convenient” in the circumstances include a requirement for there to be some hindrance or difficulty in the normal processes of execution and for the Court to be satisfied that the appointment of a receiver is not fruitless.

In circumstances where a judgement debtor’s assets comprise trade marks in respect of which execution cannot be levied utilising writs of control, the court may authorise the appointment of a receiver together with an order compelling the judgement debtor to assign the trade mark(s) to the receiver. If the judgement debtor fails to comply with such an order then recourse may be had under section 39 of the Senior Courts Act. This provides that where the High Court has made an order directing a person to execute any conveyance, contract or other document then if that person neglects or refuses to comply with the judgement or order, or cannot be found, the Court may order that the conveyance, contract or other document shall be executed by such other person as the court may nominate for that purpose. It further provides that a conveyance etc. executed in pursuance of an

order shall operate and be for all purposes available as if it had been executed by the person originally directed to execute it.

Accordingly, these measures, whilst not specifically directed at the levy of execution on trade marks, provide a means by which enforcement measures may be taken in respect of assets of a judgement debtor which comprise trade marks and for the recordal in the register of the assignment of such trade marks pursuant to the levy of execution.