
STATUTORY INSTRUMENTS

2018 No. 825

The Trade Marks Regulations 2018

PART 2

Amendments to the 1994 Act

Grounds for invalidity of registration

- 23.**—(1) Section 47(1) is amended as follows.
- (2) At the beginning of subsection (2) insert “Subject to subsections (2A) and (2G),”.
- (3) After subsection (2) insert—
- “(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).”
- (4) In subsection (2A) omit “But”.
- (5) In subsection (2B) for paragraph (a) substitute—
- “(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—
- (i) within the period of 5 years ending with the date of application for the declaration, and
- (ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or”.
- (6) In subsection (2C)(a)—
- (a) after “a form” insert “(the “variant form”);
- (b) after “in which it was registered” insert “(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)”.
- (7) After subsection (2D) insert—
- “(2DA) In relation to an international trade mark (EC), the reference in subsection (2A) (a) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.”.
- (8) After subsection (2F) insert—
- “(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in

(1) Section 47 was amended by [S.I. 2004/946](#), regulations 3 and 6, [S.I. 2008/1067](#), regulations 3 and 5, [S.I. 2011/1043](#) article 4(1) and [S.I. 2016/299](#), the Schedule paragraph 1.

subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));
- (b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);
- (c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).”.

(9) After subsection (5) insert—

“(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.”.