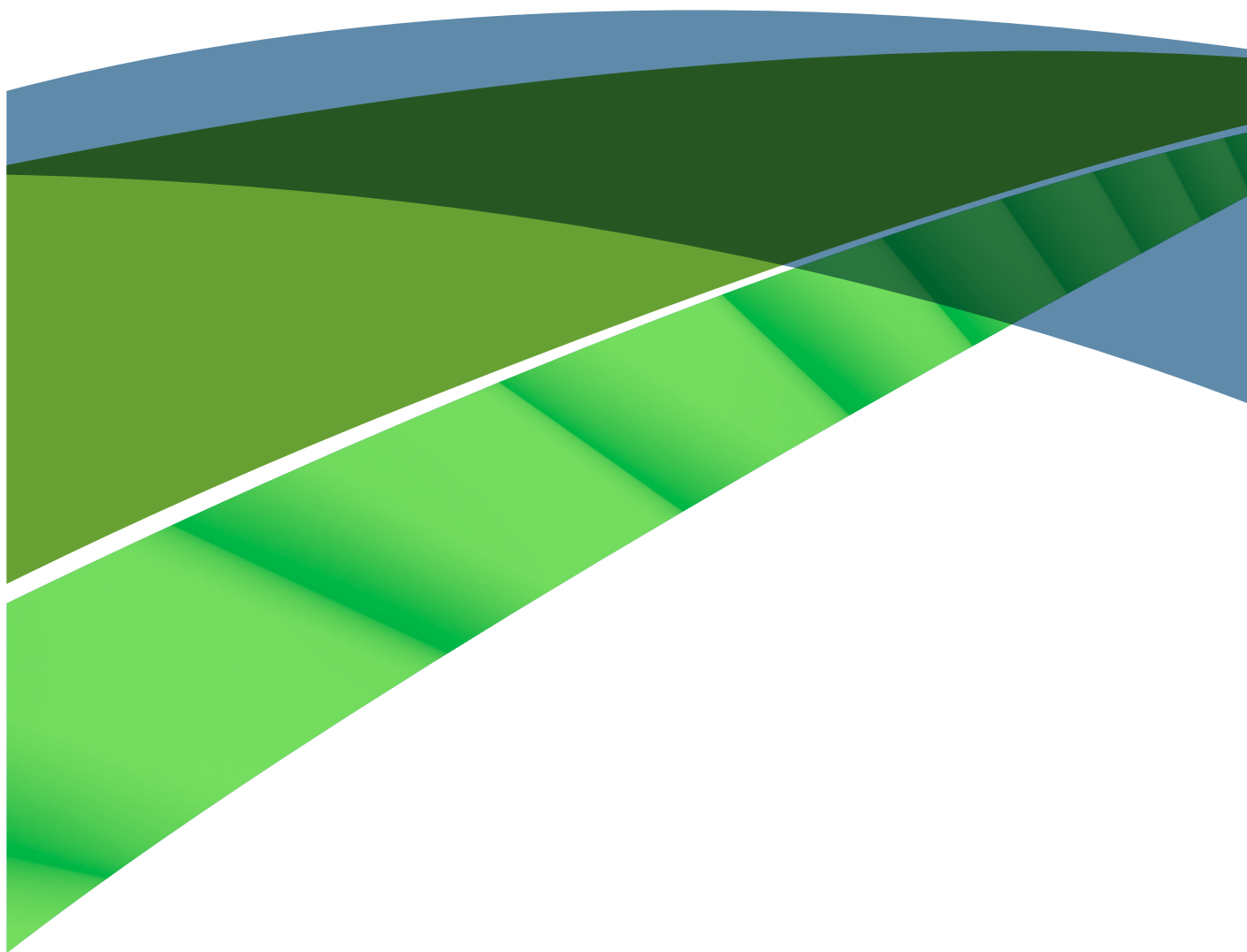




Intellectual  
Property  
Office

# Implementation of the EU Trade Mark Directive 2015





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## Introduction

1. The Intellectual Property Office (IPO) is responsible for the trade mark system in the UK. This includes examination of trade mark applications and the registration of trade marks for those applications which comply with the requirements of the Trade Marks Act 1994 (“TMA”) and the Trade Mark Rules 2008 (the “Rules”). The Rules set out the procedural and administrative requirements which apply to trade marks and trade mark applications.
2. Trade mark protection is governed by an EU legislative framework, which consists of an EU-wide trade mark covering all Member States (governed by a Regulation), together with national marks covering each individual Member State (harmonised by a Directive). In 2015 that framework was revised by a new (amending) Regulation<sup>1</sup> and a new Trade Mark Directive<sup>2</sup> (“the Directive”). They aim to ensure that the system overall continues to remain effective in meeting the needs of business as technology develops, updating it rather than introducing fundamental changes. The Directive is required to be implemented into UK law by 14th January 2019.
3. This document sets out the proposed amendments required to be made to UK trade mark law arising from the Directive. These amendments are set out in a draft Statutory Instrument (“SI”) which amends the TMA, and the Rules. Part 4 of the SI also contains some minor amendments to certain other secondary legislation<sup>3</sup>.
4. The changes are largely technical in nature, but are likely to impact on anyone who applies for or owns trade marks and anyone who has an interest in other people’s trade marks. We are therefore keen to get responses to this consultation from as wide a cross-section of users of the trade mark system as possible.

## Relevance of UK withdrawal from the EU

5. The implementation of the Directive is required as part of the United Kingdom’s obligations arising from its membership of the European Union and until the UK formally leaves the European Union all of its obligations remain in force. This will make it easier and cheaper for businesses to use, as a result of fewer differences in procedure for registration of trade marks in national offices.

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1 Now codified by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 <http://eur-lex.europa.eu/legal-content/EN/TXT/?qid=1497603909400&uri=CELEX:32017R1001>

2 Directive 2015/2436: <http://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32015L2436>

3 Community Trade Mark Regulations 2006, <http://www.legislation.gov.uk/ukSI/2006/1027/contents/made>; Trade Marks (International Registration) Order 2008, <http://www.legislation.gov.uk/ukSI/2008/2206/contents/made>

## Our approach to implementation

6. The Directive updates and replaces Directive 2008/95/EC (the “2008 Directive”) (which codified the amendments made to the original Trade Mark Directive<sup>4</sup>) by further harmonising the conditions for obtaining and continuing to hold a registered trade mark, so that they are, in general, identical in Member States<sup>5</sup>. The Directive replicates certain provisions contained in the 2008 Directive, for example, Article 15 is the same as Article 7 of the 2008 Directive, although obviously renumbered. Other articles have been amended, such as Article 4 which is an amended version of Article 3 of the 2008 Directive. Other provisions are entirely new, such as Article 12, which deals with the reproduction of trade marks in dictionaries.
7. Our approach to implementation has been to limit our amendments to the TMA to those we consider necessary. This means that where a provision, such as Article 15, has already been implemented (see TMA section 12), we have not sought to re-implement it, even though in certain circumstances, the language used in the TMA does not adopt exactly the same language as that used in the Directive.
8. Further changes to trade mark law arising from the UK’s withdrawal from the EU are not part of this consultation.

## About this consultation

9. This consultation concerns the substantive changes to trade mark law introduced by the Directive and amendments to domestic law required in order to implement the Directive into UK Law. It will run for 8 weeks until 16 April 2018. It is an opportunity for interested parties to comment on the drafting of the SI that will enact the necessary legal changes.
10. The Government invites comments on:
  - The drafting of the SI that is published with this consultation [see Annex B]
  - The likely costs and benefits associated with the changes to UK law, as described in the impact assessment published alongside this consultation.
11. The Government is seeking evidence that is open and transparent in its approach and methodology. Unsupported responses (e.g. “yes” or “no” answers) are unlikely to assist in forming a view. However, the Government is aware that some individuals and small businesses and organisations face particular challenges in assembling evidence. Those contributions will be assessed accordingly. The IPO has published a guide to evidence for policy<sup>6</sup> which sets out the Government’s aspiration that evidence used to inform public policy is clear, verifiable and able to be peer-reviewed.

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4 Council Directive 89/104/EEC of 21 December 1988.

5 Recital (12) of the Directive.

6 [https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/388238/consult-2011copyright-evidence.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/388238/consult-2011copyright-evidence.pdf)

## Proposed amendments in detail

12. The table at Annex A gives an overview of the Directive, Article by Article. Where no changes to domestic law are proposed, or the changes are either minor or self-explanatory, no further commentary is included in this consultation. Where there are issues which we believe need further explanation, or on which we are specifically seeking views, these are discussed below, and will usually be accompanied by specific questions. However, we are not seeking to limit the issues on which consultees may comment, and would welcome comments on the proposed implementation of any provision of the Directive.
13. In relation to those Articles whose implementation is optional for Member States, Government policy concerning transposition is that we should implement directives to the minimum extent required. As such, we will only implement an optional provision if there is an advantage to the UK in doing so. However, for many of the optional Articles contained in the Directive equivalent provisions already exist in UK law. We are proposing to retain those provisions and, where appropriate, we are proposing to take the opportunity to update those provisions in line with changes in the Directive.
14. In this document, references to a
  - section or a schedule are to a section or a schedule of the TMA;
  - rule are to a rule of the Rules; and to a
  - regulation are to a regulation contained in the draft SI.

### Article 3: Signs of which a trade mark may consist

(Regulation 3)

#### Article 3: Removal of requirement for 'graphic representation' in section 1 - new file formats

(Regulation 3)

15. The limitation on trade marks which required them to be represented graphically has been removed in favour of a requirement that marks be represented in a clear and precise manner. This change opens up the possibility for marks to be filed in any way the technology of the day will allow. The focus of discussions on this issue has tended to be on non-standard mark types, such as sounds, movements and smells, and the ability to represent them more accurately than before, but the change applies equally to more frequently filed mark types too, including shapes. Overall, there seems to be a myriad of mark types, which might benefit from digital presentation in the future (and where technological developments permit a type of sign to be represented in the register in a clear and precise way), such as:

- Sound
- Movement (animation)
- Hologram
- 3 Dimensional
- Colour
- Patterns
- Shape mark
- Smell
- Combinations of these, such as:
  - Movement (animation) and sound
  - Word and sound
  - Figurative and sound
  - Figurative and smell
  - Word and smell

16. In the longer term, the IPO is proposing to ensure that a wider range of digital file formats can be used to file marks, but in the short term it is likely to ensure that formats are compatible with those proposed by the EU Intellectual Property Office (“EUIPO”). For non-standard mark types this includes .mp3, .mp4, and .jpg, which will be accessible for searching purposes and on the register<sup>7</sup>.

### Questions

1. How do you think the removal of the graphical representation requirement will change the demand for unusual mark types? Would you or your clients be more likely to register an unusual mark? If so how will you/they benefit from this?
2. Are there any other mark types, other than those identified, which may benefit from the ability to file representations in a digital format? Which formats (apart from .mp3, .mp4, .jpg mentioned above), do you think applicants would like to be able to use to file their trade mark applications?

## Article 3 (and Article 39.2): ‘Competent authorities’

(Regulation 3)

17. The definition of a trade mark in Section 1(1) has been amended to reflect the wording of Article 3 of the Directive, and in particular make reference to the ability of ‘the competent authorities’ (and the public) to be able to determine the subject matter of the protection conferred by the trade mark. The nature of the competent authorities is not specified in the Directive, and so in the interests of clarity we have drafted Regulation 3 to use a term appropriate to the UK, namely ‘the registrar’. In practice we consider that it will be for the registrar to assess whether the application for a trade mark has met the requisite standard for registration, as required by section 1. The registrar is, at this point, the sole competent authority. This approach of defining the term has been taken in the light of previous criticism of the use of the term ‘competent authorities’ in other legislation, by the committee which scrutinises statutory instruments and reports to both Houses of Parliament, the Joint Committee on Statutory Instruments (JCSI)<sup>8</sup>.

<sup>7</sup> See Annex of the EUIPO’s Common Communication of 4 December 2017 <https://euipo.europa.eu/ohimportal/en/web/guest/news/-/action/view/3941045>

<sup>8</sup> The relevant JCSI report is their 24th of session 2001-2002 (available at: <https://publications.parliament.uk/pa/jt200102/jtselect/jtstatin/104/10402.htm#a2>)



18. We have also considered whether the term ‘competent authority’ might also include an appointed person and the courts. Our initial view was that it would be inappropriate to build into the meaning of ‘trade mark’ in section 1 references to these bodies, which deal with appeals. However, by referencing ‘the registrar’ only, this might appear to exclude the appeal courts from taking a view, for example, where the matter arises by way of an application to the court for a declaration of invalidity. In such a case, with the current drafting, it would appear to be necessary for the registrar to be called as a witness. This would seem to add another layer of complexity to the situation. We would therefore welcome views on this.

#### Question

3. What is your view on how we should treat the term ‘competent authorities’? Please explain your answer.

19. Similar arguments also apply in relation to use of the term ‘the registrar’ in the implementation of Article 39.2, via Regulation 35, which amends Rule 8. In line with our initial views above, we considered that Rule 8 concerns the contents of an application, at which point it is necessary for the registrar, not an appointed person or the courts, to be satisfied that the description of the goods is sufficiently clear and precise. Any changes to Regulation 3 arising from the response to the question above, will need to be reflected in Regulation 35.

## Article 4: Absolute grounds for refusal

### Article 4.1(i),(j),(k) & (l) – specific references to geographical indications, traditional terms for wine, etc

(Regulation 4(4))

20. New provisions are included in the absolute grounds for refusal which require that trade marks shall not be registered where their registration is prohibited by certain other legislation/international agreements which protect geographical indications, traditional terms for wine, traditional specialities guaranteed and plant variety rights.
21. Section 3(4) (as amended by Regulation 4(3)) implements optional Article 4(3)(a). It covers similar ground to Article 4.1(i),(j),(k) and (l) (insofar as it provides that a Member State may provide that a trade mark shall not be registered if or to the extent that its “use” is prohibited pursuant to domestic or EU law). However, section 3(4) does not cover those aspects of Article 4.1(i),(j),(k) and (l) which relate to international agreements to which the EU or the UK is a party. This could have been addressed by amending section 3(4) to include references to international agreements, but we recognised that this would then mean that section 3(4) was wider than the scope of the provision permitted under Article 4(3)(a). For this reason, we propose incorporating specific grounds for refusal in new sections 3(4A), (4B) and (4C). Section 3(4) (as amended) will continue to be appropriate for objections relating to other non-trade mark issues, such as the tobacco regulations.

### Article 4.5: distinctive character acquired after application date, but before registration date (optional)

22. Article 4.5 is an optional provision which permits the use made of a mark between the application and registration dates to be taken into account when considering whether the mark has acquired distinctive character. This could lead to a situation in which, in opposition proceedings, a trade mark which already has a level of distinctive character would be at a disadvantage: it could be opposed, and possibly refused, on the basis of an earlier mark that had not, at the date of application, acquired any distinctive character, but may have done so in the intervening period between its application and the point at which opposition was filed. This has the potential to create some uncertainty.
23. Initial soundings about the desirability of implementing this Article were taken with a small group of IP experts, who felt that the current situation was better, as parties were not greatly prejudiced. We concluded that the implementation of this optional Article would not necessarily provide any advantage to the UK, and therefore we would not implement it.

#### Questions

4. If you support implementation of this optional article, please explain why and provide evidence of the advantage that implementation would provide.

## Article 5: Relative Grounds for refusal or invalidity

### Article 5.2 – definition of earlier trade marks

(Regulations 7(3) and 41)

24. Article 5.2 provides an exhaustive list of what constitutes an ‘earlier trade mark’ for the purposes of relative grounds for refusal. While it covers registered marks and applications, it does not appear to cover marks which were registered and which have since expired through failure to renew.
25. Section 6(3) deals specifically with the position of expired marks. It requires them to be taken into account for one year after expiry when considering the registrability of a later mark. There is a proviso which means that the expired marks should have been put to bona fide use in the 2 years preceding expiry.
26. Section 6(3) implemented an optional provision in the 2008 Directive<sup>9</sup> which has not been carried forward to the current Directive. Furthermore, it appears to be incompatible with the Directive for two reasons: expired marks are not included in Article 5(2); and the 2 year period is inconsistent with the proof of use provisions in the Directive, which specify a 5 year period. It therefore seems that in order to ensure compliance with the Directive, section 6(3) should be repealed (see Regulation 7(3)).
27. This would mean a change in the notifications that an applicant receives to advise them if there are any earlier rights with which their mark may conflict. At present, such notifications include marks in their first year of expiry, on the

<sup>9</sup> Article 4.4(f) of Directive 2008/95

assumption that they could be renewed, or restored to the register. Having been notified of any expired marks, the applicant could choose to pursue their application, and potentially run the risk that the owner of the earlier mark may restore their own mark and then oppose the application. This may have implications for the applicant in terms of, for example, launching new products and services. Alternatively, as most often happens, the applicant could simply choose to wait until the expired mark can no longer be restored to the register before filing their application.

28. If section 6(3) is repealed this notification would no longer be issued. Without such notification, an applicant could, in good faith, start to use their mark only to find at a later point that such use becomes the subject of a dispute with the proprietor of a restored earlier mark.
29. To help prevent such situations arising, we propose to amend the Rules (Rule 37 – see Regulation 41) by introducing provisions similar to those which already exist within UK patents and designs law<sup>10</sup> and in relation to EU trade marks under the EU Trade Mark Regulation<sup>11</sup>. These protect the activities of a third party who has acted legitimately to use an identical or similar sign in the period between the expiry of the registration and its restoration. To ensure that the UK trade mark system remains as compatible as possible with the EU system, we are proposing to use language akin to that of Article 104(6) of the EU TM Regulation.
30. In relation to the restoration of an expired mark, we do not believe the current test, in Rule 37(1), which the registrar applies to consider restoring a mark (whether it is ‘just to do so’) aligns with this approach, and are, as a consequence, proposing to amend the test to one of whether the failure to renew is ‘unintentional’. This has the benefit of bringing the test for restoration into line with that for patents and designs. It also has the effect of making the decision-making process one which falls between the registrar and the owner of the expired mark. We consider that this approach aligns better with the notion that any third party rights are accounted for by the new provision in Rule 37.
31. The overall effect of these changes is that the IPO would no longer notify applicants of any expired marks, and owners of an expired mark could not rely on it to form the basis for objecting to the registration of a later, similar or identical mark on relative grounds. However, we consider that the law would be clear about the position of third parties.

### Questions

5. Do you agree with our conclusion that section 6(3) is contrary to the Directive? Please explain your answer.
6. Do you agree with our approach to dealing with the potential gap left by the repeal of section 6(3)? Please explain your answer.

<sup>10</sup> Patents Act 1977, sections 28 & 28A, Patent Rules 2007, rule 40; Designs Act 1949, sections 8A & 8B

<sup>11</sup> EU Regulation 2017/1001 (codified), Article 104(6): <http://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>

### **Article 5.3(b): applying for, or registration of, a trade mark in the name of a representative**

(Regulation 5(7))

32. Article 5.3(b) incorporates within the relative grounds for refusal/grounds for invalidity the situation where an agent or representative makes an application, or obtains a registration in their own name, without the consent of the proprietor. Whilst we do not consider this article raises any particular points in relation to the drafting of the SI, it is closely related to Article 13, which is considered in more detail at paragraph 47.

### **Article 5.4(b)(i) and (ii): protection given to earlier rights consisting of the right to a name and a right of personal portrayal (optional)**

33. Article 5.4 contains optional provisions which permit various rights to be considered as potential relative grounds for refusal or invalidity. In some cases, provisions in UK law already exist in relation to these rights (see section 5(4)(b)), and where necessary, amendments to those provisions have been incorporated in the draft SI.

### **Article 5.4(b)(iv): earlier rights being ‘industrial property’ (optional)**

34. Subparagraph (b)(iv) of Article 5.4 permits earlier ‘industrial property’ rights to be included as potential grounds for refusing an application or invalidating a registration. Section 5(4)(b) currently refers to earlier rights “by virtue of the law of ...design right or registered designs”, which we consider implements the reference to “an industrial property right” and so we do not propose to amend this provision.

#### **Question**

7. Do you consider that the reference to “industrial property right” in this context might include rights other than a design right or registered designs? Please explain your answer.

### **Article 5.4(c): earlier marks protected abroad (optional)**

35. This subparagraph of Article 5.4 provides a safeguard for earlier marks which are protected abroad, where an applicant acts in bad faith. However, a mechanism for pursuing grounds based upon bad faith (whether by the owners of marks protected overseas or not) is provided under section 3(6) of the Act. Therefore, we do not consider it necessary to also provide a provision to cover a narrower set of circumstances that is already a sub-set of the circumstances covered by section 3(6).

#### **Question**

8. If you support implementation of this optional article, please provide evidence of the advantage that implementation would provide.

## Article 10: Rights conferred by a trade mark

### Article: 10.3(f): comparative advertising

(Regulations 10(6) and 10(7))

36. Article 10.3(f) prohibits use of a sign in comparative advertising if it is contrary to the Misleading and Comparative Advertising Directive 2006/114/EC. To ensure correct implementation, the wording has essentially been copied out in the SI. The reference to Directive 2006/114/EC has been replaced with a reference to the UK's domestic implementing regulations, since it is the latter which impose obligations on UK businesses rather than the 2006 Directive. (Regulation 10(6))
37. Implementation of this Article caused us to consider section 10(6), which was initially treated as providing a home grown exception to certain comparative advertising. However, in the light of the Court of Justice of the European Union's (CJEU) decisions which exclude lawful comparative advertising from trade mark infringement, it is generally accepted that section 10(6) provides no useful function. In view of this, and now that implementation of the Directive means that unlawful comparative advertising is specifically defined as an infringement activity, section 10(6) serves no apparent purpose, so we propose to repeal it (Regulation 10(7)).

#### Question

9. Do you agree with our view that section 10(6) would serve no apparent purpose and can therefore be repealed? If not, please explain your answer.

### Article 10.4: 'goods in transit'

(Regulation 11)

38. Article 10(4), as implemented by new section 10A, provides for potentially fake or counterfeit goods to be detained by customs authorities where they are passing through the UK, en route to third countries. To have the goods released, the owner of the detained goods will need to demonstrate in legal proceedings that the trade mark owner seeking detention of their goods is not entitled to stop those goods being marketed in the third country. This article addresses the problem established by prior case law that it was necessary to prove that the potentially counterfeit goods would be placed on sale in the country in which they were detained.
39. This article mirrors Article 9.4 of the EU Trade Mark Regulation<sup>12</sup>, which was brought into force, and took effect in the UK for EU trade marks, in March 2016. Initial indications from Her Majesty's Revenue and Customs suggest that the changes in the law which are already in place for EU trade marks have had little impact to date. The procedures they use in relation to goods in transit are still initiated in accordance with EU regulations<sup>13</sup>; procedures preventing the

<sup>12</sup> EU Regulation 2017/1001 on the European Trade Mark (codification) <http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017R1001&from=EN>

<sup>13</sup> EU Regulation 608/2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) 1383/2003 <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2013:181:0015:0034:en:PDF>

importation into the UK of infringing goods continue to be governed by section 89.

40. Experience to date therefore suggests that incorporating this article into UK law is likely to have little impact in practice. We would however be interested to hear of any changes which rights holders and their legal advisors have experienced, or feel they are likely to experience in future (see question 12 below).
41. In relation to the drafting of new section 10A, we consider that the reference in the Directive to 'third countries' does not provide sufficient clarity. We therefore propose that we define the relevant area from which the goods in question come as being 'outside the EU' (rather than 'outside the EEA' as in section 89). This is in line with Government policy concerning transposition which directs that we should implement directives to the minimum extent required. Further, we note that it is not clear at present whether the Directive will be extended beyond the EU to include the EEA, and that EU customs policies are not incorporated within the EEA agreement<sup>14</sup>.

#### Question

10. Do you agree with our view that new section 10A should apply to goods originating outside the EU (rather than outside the EEA)? Please explain your answer.

## Article 11: The right to prohibit preparatory acts in relation to the use of packaging or other means

(Regulations 9, 10(2) and (7))

42. Article 11 enables trade mark owners to take action to stop acts preparatory to counterfeiting in relation to a broad range of items associated with packaging, labels or other materials to which a trade mark is applied. Although this ground is to some extent covered by section 10(5), there are sufficient differences between the Directive and UK law to indicate that it is not feasible to amend section 10(5).
43. The differences we have identified are as follows:
  - Section 10(5) applies in relation to "materials" intended to be used for "labelling or packaging goods" whereas Article 11 applies to an arguably wider category which includes "tags, security or authenticity features or devices or any other means to which the Trade Mark is affixed"
  - Article 11 applies "where the risk exists" that the packaging "could be used in relation to goods or services" whereas section 10(5) applies where the material "is intended to be used" for packaging
  - Article 11 applies to both goods and services, whereas section 10(5) is limited to marks applied to packaging for goods
  - Under section 10(5) an infringement is only committed if the person applying the mark to such packaging "knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a

<sup>14</sup> <http://www.efta.int/eea/eea-agreement>

licensee” whereas Article 11 requires no knowledge on the part of the person committing the preparatory acts.

44. We therefore propose to repeal section 10(5) and introduce new section 10(3B)-(3D) together with certain amendments to section 9, which ensure that the preparatory acts in Article 11 are treated as infringements.

### Questions

11. Do you agree with our proposal to implement Article 11 by, in effect, replacing section 10(5) with new provisions? Please explain your answer.
12. Will the changes made by Articles 10.4 (goods in transit) and 11 (preparatory acts), which are intended to help tackle counterfeit goods, allow your business or that of your clients to more effectively protect its products? If so, can you explain or quantify these benefits in more detail? Are there any associated costs? If so, can you explain or quantify these?
13. What, if any, impact has the change in the ‘goods in transit’ rules for EU trade marks already had on the transit of legitimate goods to third countries?

## Article 12: Reproduction of trade marks in dictionaries

(Regulation 30)

45. Article 12 introduces a new provision which protects against the misidentification of a registered trade mark as a generic term in dictionaries or other similar publications. It is implemented by new section 99A. Although the Directive does not prescribe any mechanism for the enforcement of this right, we consider that for new section 99A to be effective, it is necessary to introduce a means for the trade mark proprietor to enforce this section if the publisher does not comply with requests to amend the dictionary entries. We therefore propose to introduce a provision, similar to section 15, permitting a court order to be granted for the amendment or destruction of the relevant publications.

### Question

14. Do you agree that a specific enforcement mechanism is required, and that the mechanism proposed is the correct approach? Please explain your answer.

## Article 13: Prohibition of the use of a trade mark registered in the name of an agent or representative

(Regulations 11 and 28)

46. Article 13 contains a prohibition on the use of a trade mark registered in the name of an agent or representative without the proprietor’s consent. Article 5.3(b) is a similar provision relating to relative grounds for refusal.



47. Section 60 covers similar ground: it implements Article 6<sup>septies</sup> of the Paris Convention and therefore regulates the acts of agents or representatives of proprietors of marks in 'Convention Countries' (which excludes the UK). To ensure that the section 60 approach covers UK proprietors, we initially considered amending section 60 to remove the reference to Convention countries. However, the resulting provision would no longer sit comfortably within Part II of the TMA, which deals specifically with EU trade marks and international matters. We have therefore decided to repeal section 60 and create a new provision (section 10B), which reflects the actions available to the proprietor under Article 13 of the Directive. We have however retained the reference to a right to apply for the 'rectification' of the register (as opposed to a right to "demand an assignment" as referred to in Article 13(1)(b)) as we consider that in this context this meets the requirements of the Directive – to provide a mechanism for the proprietor to be substituted on the register – and in a cost-effective manner. It is noted that the EUIPO appears to take a similar approach in its implementation of Article 21 of the EU TM Regulation notwithstanding the reference there to the entitlement of the proprietor to "demand an assignment".
48. In drafting new section 10B, we consider that, for clarity, it is more appropriate to use the words 'prevent the use' rather than 'oppose the use'. Such a formulation also has the benefit of suggesting an appropriate legal remedy for the proprietor, namely an injunction, and maintains internal consistency within the Act in line with, for example, section 5(4).

### Questions

15. What are the
- cost implications and
  - consequences (negative or positive) for taking this approach in implementing Article 13?
16. Do you agree that a specific enforcement mechanism is required, and that the mechanism proposed is the correct approach? Please explain your answer.

## Article 14: Limitation of the effects of a trade mark

### Article 14.1(a): 'own name defence'

(Regulation 12(4))

49. Article 14.1(a) changes the scope of the 'own name defence' against infringement. It restricts the defence to use by a 'natural person' of his/her name or address, and therefore removes the defence which was previously also available to companies. We have implemented this by substituting the reference to 'a person' (which as a matter of statutory interpretation includes companies<sup>15</sup>) with a reference to 'an individual'. This reflects a change in law implemented by the EU Trade Mark Regulation<sup>16</sup> which already applies to EU trade marks valid in the UK.

<sup>15</sup> Interpretation Act 1978, Schedule 1 <http://www.legislation.gov.uk/ukpga/1978/30>

<sup>16</sup> EU Regulation 2017/1001 on the European Trade Mark (codification) <http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017R1001&from=EN>



## Article 17: Non-use as defence in infringement proceedings

(Regulation 13)

50. Article 17 introduces the principle that during infringement proceedings the proprietor of a trade mark cannot seek to prevent use of a sign if his mark is liable to be revoked for non-use. This provides a third party with a defence against infringement, who may require the proprietor of the mark to prove he has been using it. If the proprietor cannot do so, the infringement proceedings will not succeed. This will simplify the process and reduce costs compared to the current position, whereby the proprietor's use of its mark can only be challenged by commencing non-use proceedings. Although the principle of a non-use defence is new to infringement proceedings, similar provisions already exist in relation to opposition proceedings (see section 6A) and invalidation proceedings (see section 47(2A) – (2F)). New section 11A (as inserted by regulation 13) implements Article 17.

### Question

17. The introduction of the non-use as a defence has been discussed in the impact assessment as having beneficial effects, by preventing trade mark owners from using old unused rights in infringement cases, and removing the need for use to be challenged by way of separate proceedings. Does this benefit yourself/ your business? If so, can you explain and/or quantify further?

## Article 24: Levy of execution

(No new regulation)

51. Article 24 provides that trade marks may be levied in execution, that is they may be regarded as assets in enforcement proceedings, and may therefore be subject to court orders. This Article requires that Member States shall have procedures in place for the recordal of levy of execution in the register. We consider that there is no need to make specific provision within trade mark law to implement this Article. Section 37 of the Senior Courts Act 1981, and section 107 of the County Courts Act 1984 give the courts powers to appoint a receiver by way of equitable execution, and case law has established the circumstances in which this is appropriate. The court has the powers to authorise the appointment of a receiver together with an order compelling the judgement debtor to assign a trade mark to the receiver. Where there is no compliance, section 39 of the Senior Courts Act 1981 may be used to ensure that another nominated person be required to carry out that assignment if the debtor either cannot, or will not, do so.
52. Although these measures are not specifically directed at the levy of execution on trade marks, we consider they provide a means by which enforcement measures may be taken against the assets of a judgement debtor which consist of trade marks. Section 25(2) completes the picture insofar as it provides for the registration of assignments of trade marks and of particulars of any court order transferring a trade mark.

**Question**

18. Do you agree that our interpretation of this non-trade mark law means that we do not require specific reference in the TMA to levy of execution? Please explain your answer.

**Article 25: Licensing**

(Regulation 17(5) and (6))

53. Article 25 provides the conditions which apply to exclusive and non-exclusive licences, but is silent about whether a proprietor should be joined in an action for infringement either as a claimant or a defendant if the licensee brings proceedings for infringement in accordance with Article 25(3). Taking this into account and the requirement of the Directive that ‘not only provisions of substantive law but also procedural rules’ (as general principles) are ‘approximated’<sup>17</sup>, we consider that to comply with the Directive, sections 30(4) and (5) should be repealed.
54. Similar considerations apply to authorised users in the context of collective marks (Article 34.1 and regulation 32(4) refers).

**Question**

19. Do you agree with our interpretation of the Directive which requires the removal of references in the TMA to proprietors being joined in infringement proceedings taken by licensees (and in the case of collective marks, authorised users)? Please explain your answer.
20. What proportion of UK registered trade marks that you have, or deal with, are **licensed** to third parties on a non-exclusive basis? Of these, approximately how many have been subject to legal action?

**Article 29: Collective marks****Article 29.2: ‘legal persons governed by public law’**

(Regulation 24)

55. Article 29.2 specifies the nature of those ‘persons’ who are permitted to be the proprietors of collective marks. It includes ‘legal persons governed by public law’, the nature of which is not specified in the Directive.
56. In the interests of clarity, we initially considered defining ‘legal persons governed by public law’ as its meaning in UK law was not obvious. Our starting point was the similar term ‘bodies governed by public law’ contained in the Public Contracts Regulations 2015<sup>18</sup>. However, the context in which that definition is applied is somewhat different, requiring as it does a degree of control (financial or otherwise) by, for example, the State or local authorities. We consider that such a definition would not be helpful.

<sup>17</sup> Recital (9) of the Directive

<sup>18</sup> S.I. 2015/102

57. We further considered the extent to which ‘public law’ is a recognised concept within UK law implying, as it does, a distinction between ‘public’ and ‘private’ law. Although it is recognised by certain other EU member states, the same distinction is not generally recognised in the UK. We understand that the reference was incorporated to cover certain types of body which exist in certain member states. Without a meaningful distinction that can be applied in the context of trade mark law, we take the initial view that specific transposition is not required. This would therefore mean that those organisations eligible to apply for collective marks would have to fall within the definition of ‘association’ incorporated within newly amended section 49.

#### Question

21. Do you agree that the term ‘legal persons governed by public law’ cannot be meaningfully transposed into UK trade mark law? Please explain your answer.
22. Is the reference to ‘association’ incorporated within section 49 (as amended by Regulation 24) sufficiently broad to cover all those organisations for whom a collective mark may be appropriate? Please explain your answer.

## Article 34: Persons entitled to bring an action for infringement

### Article 34.1: cross-references to Article 25 licensing provisions

(Regulation 32(4))

58. Article 34.1, by reference to licensing provisions included in Article 25.3 and 25.4, permits the authorised users of collective marks to take, and intervene in, infringement proceedings under certain conditions. The conditions in Article 25.3 differ for exclusive and non-exclusive licensees. We consider that there is no scope for an authorised user to have the ‘exclusive’ right to use a collective mark i.e. to the exclusion of other members of the association which is the proprietor of the mark. Accordingly, we consider Article 34.1 in its reference to Article 25.3 confers on authorised users rights equivalent to those of non-exclusive licensees i.e. to bring infringement proceedings only with the consent of the proprietor of the collective mark, whereas Schedule 1, paragraph 12(3) permits authorised users to bring proceedings without such consent. It therefore seems that in order to ensure compliance with the Directive, paragraph 12(3) of Schedule 1 should be repealed.
59. In line with the approach we have taken in relation to the implementation of Article 25, we consider that to comply with the Directive, Schedule 1, paragraph 12(4) & (5) should also be repealed. (See paragraph 53)

#### Question

23. Do you agree with our interpretation of the interplay between Articles 34.1 and 25.3, that an authorised user of a collective mark should be treated in the same way as a non-exclusive licensee, rather than an exclusive licensee? Please explain your answer.

## Article 39: Designation and classification of goods and services

### Article 39.2: 'economic operators'

(Regulation 35(4))

60. Article 39.2 requires applicants to ensure sufficient clarity and precision in relation to the specification of goods and services for which a trade mark is applied. It couches this in terms of enabling 'competent authorities' and 'economic operators' to determine the extent of the protection sought. These terms are not defined in the Directive, but lack of clarity in the implementation into UK law of terms used in EU Law has previously been criticised.
61. 'Competent authorities' as a term also appears in Article 3(b) and we have proposed that it be transposed as 'the registrar' (Regulation 3 refers - see paragraph 17). In relation to 'economic operators', we take this to refer to any group of persons who have a pecuniary interest in being able to determine from the specification whether a mark owned by a third party conflicts with one they own and which could therefore lead to infringement, if used in the course of trade. Based loosely on the activities already mentioned in Section 10(4), we are proposing to define this term to mean 'any person or group of persons which in the course of trade, manufactures, supplies, imports or exports goods or services'.

## Article 41: Division of applications and registrations

(Regulations 20 and 38)

62. Alongside the existing requirement to provide for the division of applications, Article 41 requires the UK to introduce the ability to divide registrations. Section 41 is amended to provide a power to make provision by Rules for the division of a registration into several registrations. New rule 26A has been drafted along similar lines to existing rules 26 and 27 which govern the division of applications and the merger of registrations respectively. For example, as with rule 27, new rule 26A requires that any licences, security interests, etc, as well as disclaimers should apply to all the newly created divisional registrations. (See also paragraph 69 on disclaimers and limitations.)
63. A further consideration is the treatment of divisions in relation to potential disputes. Permitting the division of a registration under dispute would allow the proprietor to assign the unchallenged part of a registration, whilst retaining ownership of the part under dispute, or vice versa. This would have benefits for the proprietor and the third party assignee, as it would permit any transaction between the two to continue without unnecessary delay, and would permit legal certainty as to what rights each party would own. However, if the registration under dispute was divided in such a way that each divisional registration included some of the goods and services under dispute, the dispute would then

be against 2 (or more) registrations some of which could be assigned into the name of third parties. This would increase the number of parties involved in the dispute. It would require the dispute to be split along the lines of the divisions/new ownership and would increase time and cost for all concerned.

64. We therefore propose that the ability to divide a registration should be limited to that part of a registration which is not the subject of a dispute. This reflects the approach taken in relation to divisions of registrations in Article 56.2 of the EU TM Regulation, and to mergers in rule 27. We have accordingly suggested similar wording in Regulation 38 (new rule 26A), including a reference to 'counterclaims', to take into account the fact that revocations and invalidations may be dealt with before the courts, not just the registrar (see sections 46(4) and 47(3)).
65. We have also considered the necessity of making specific reference to the division of UK marks acting as base registrations for international registrations under the Madrid Protocol, and also to the division of international registrations (UK), which has recently been agreed by WIPO, and is due to take effect in February 2019. In both cases, the ability to divide a registration is (or will be) determined by the law of the UK (as the relevant Contracting Party), and therefore we do not consider a specific reference is required in this context<sup>19</sup>.

### Question

24. Do you agree with our proposed approach-

- a. In relation to the treatment of licences, security interests, etc, and disclaimers for the new divisional registrations? (See paragraph 62)
- b. That a division of a registration cannot split the contested goods and/or services? (See paragraphs 63 and 64)
- c. that there is no need to specifically reference the division of international marks? (See paragraph 65)

Please explain your answers.

25. Our approach to restricting the ability to divide registrations is based upon Article 56.2 of the EUTM Regulation and the treatment of mergers in Rule 27(3A)(a). Are there any other circumstances, e.g. when a trade mark is the subject of infringement proceedings, in which it would be appropriate to add similar restrictions?

<sup>19</sup> Common Regulations under the Madrid Agreement concerning the International Registration of Marks and the Protocol Relating to the Agreement, Chapter 4, Rule 23, [www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=442735](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=442735)

## **Article 45: Procedure for revocation or declaration of invalidity**

### **Article 45.1: requirement for an administrative procedure**

No new regulation

66. Article 45 requires national offices to have administrative procedures for invalidation proceedings) which may be implemented somewhat later than the general deadline for implementing the Directive. The UK already has such proceedings, and therefore isn't required to implement Article 45.1 for this reason, but there are some, relatively minor, changes arising from other aspects of Article 45 which we are proposing to make (See Annex). We do not intend to implement these at the later date: they will be implemented at the same time as the other changes required by the Directive.

## **Article 49: Renewal**

### **Article 49.2: notification of renewal**

Regulations 39(2) and 40

67. Article 49.2 requires notifications about renewing a registration to be sent at least six months before the renewal (or expiry) date. This contrasts with the current rules, and the associated practice of the IPO, which is to send out renewal notices approximately 4 months before the renewal date. We therefore propose to amend Rule 34 to reflect the earlier period for notification, and are considering amending Rule 35, as a consequence, to allow renewal fees to be paid as soon as the notification from the IPO has been received.

## Other amendments/issues

68. There are certain other measures included in the draft SI, which do not arise directly from implementation of the Directive. These are included in a table at the end of Annex A. Those that merit particular explanation are discussed below.

### Section 13: Disclaimers and limitations

69. Applicants or owners of trade marks are able to disclaim the rights in certain elements of their marks, or apply other limitations to their marks by reason of section 13. Contrary to the position under previous trade mark law, it appears that the IPO can no longer require a disclaimer or limitation as part of its examination process, but they can nevertheless fulfil a useful business function. They may be of assistance in resolving disputes by, for example, one or possibly both parties agreeing to use their marks in certain locations only, or perhaps to disclaim exclusive rights in a colour or word.
70. We have noted the provisional view of stakeholders that the UK system should, as far as possible, maintain parity with the EU system for as long as possible, and that the EU Regulation no longer permits disclaimers. We can see the difficulties of, for example, an EU registered mark with a disclaimed word which may be non-distinctive in German, but which is distinctive in English. However, this problem does not apply to national marks.
71. It is arguable (based upon whether these are considered to constitute procedural matters or whether they constitute substantive matters of trade mark law) whether continuing to permit disclaimers under UK law is fully compatible with the Directive, but we note recent case law which has brought the issue of the use of disclaimers to the fore<sup>20</sup>.
72. Taking these factors into account, our provisional view is that disclaimers serve a useful function for business, and will continue to do so. We believe it would be beneficial to business to be able to make use of them. We therefore propose to retain section 13.

#### Question

26. Do you agree that the ability to disclaim or limit part of a trade mark is a useful mechanism, and that it should therefore be retained? Please explain your answer.
27. If disclaimers were removed what would be the impact of removing the ability to disclaim/limit the rights of a TM e.g. by restricting it to a particular locality?

<sup>20</sup> T-580/15 Flamagas SA v EUIPO. This case concerned a trade mark consisting of a 3-d representation of a lighter with a word appearing in small text near the neck of the lighter. In the past, such a mark may have been accepted if the word was distinctive. However, the court ruled that without any indication from the applicant that it wished to rely on the word element, the mark was not distinctive. This may well lead to proprietors seeking to add disclaimers to such marks to say they claim no exclusive rights in the shape of (in this case) a lighter.

## Rule 5(6): expedited examination

(Regulation 34)

73. The Rules require a fast track examination service to be provided if examination periods exceed 10 business days (Rule 5(6)). This has been suspended for a considerable period, partly due to low take up, but also because the IPO has generally been examining applications within 5-10 working days using the standard procedure, therefore making it difficult for businesses to justify the £300 premium for the accelerated service.
74. A consultation in 2014<sup>21</sup> concluded that due to lack of demand amongst users, the fast track service would not be reinstated at that time, but noted that the Rules would be amended in due course to provide greater flexibility as to when the service can and should be offered.
75. We are taking the opportunity presented here to amend Rule 5(6) to provide the registrar with a discretion as to when to suspend and resume the service.
76. The consultation also concluded that reinstatement of the fast track service would be reconsidered if the time to examination reached levels where a fast track procedure would be more attractive. Given that the standard period to examination generally continues to be within 5-10 days, we do not believe it necessary to reinstate the fast track service at this time.

## Regulatory, Economic Impact

77. We have undertaken an assessment of the regulatory impact of the proposed changes as detailed in the impact assessment ("IA") published alongside this consultation document. The IA sets out our initial assessment of the impact the new proposals will have on our users if they are implemented.
78. We would appreciate it if you would also read the IA and let us have any comments you may have on any aspect of its content. We will be interested to hear views from businesses, trade mark attorneys/agents and other stakeholders to help provide firmer evidence of potential costs, benefits and risks arising from the detail of the changes set out in the draft statutory instrument. As well as our current estimate that the changes will entail no significant cost to businesses, we also envisage that the changes will entail benefits and opportunities for businesses. We welcome challenge of our estimates of potential impacts.
79. Questions relating to the costs and benefits associated with implementing certain articles are included in the main body of this document, where those articles have warranted specific discussion. In addition, we are interested to hear your views on the following:

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21 <https://www.gov.uk/government/consultations/fast-track-examination-of-trade-marks>



### Questions

#### General

28. a. How would your business familiarise itself with the implications of these changes? Would you use in-house legal support, request legal advice or neither?
- b. How much time would it take for you/your staff/trade mark owners to familiarise yourself with the legal implications of the changes required by the Directive? To give us an indication of likely costs, could you indicate the job title or level of job of the members of staff who will be involved in this?
- c. Are there any costs to you/your business beyond staff time? For example, preparation of guidance or amending existing licence agreements. Can you quantify these in monetary terms?
29. The IA identified costs and benefits associated with implementing the Directive, including retaining closer alignment with the EU trade mark system. Can you explain and/or quantify the benefits/costs you foresee?

#### Specific

30. For IP/legal advisors, given the changes in the Directive, do you envisage any increases in work as trade mark owners try to explore the extent to which the current boundaries may have shifted slightly? This may be generally, or relate to specific changes, such as the removal of the need to graphically represent a mark. How much staff time do you think this might equate to, and in which roles?

80. After considering any comments we receive, and depending how we decide to implement the proposals, our assessment of the impacts will be finalised and will accompany the draft legislation being put forward for Ministerial approval.

## Next steps

81. Once the consultation period has closed, the Government will consider the comments received and issue a response document in due course. It is not clear when the SI (amended as appropriate) is likely to be laid in Parliament, especially in view of expected pressures on Parliamentary time as the UK nears its exit from the EU.
82. In line with Government policy, the intention is that the required changes to the law come into effect on time, at the deadline for implementing the Directive on 14 January 2019.
83. Business guidance will be issued before that date.

## Responding to this consultation

84. When responding, please state whether you are responding as an individual or representing the views of an organisation. If you are responding on behalf of an organisation, please make it clear who the organisation represents and, where applicable, how the views of members were assembled. Responses can be submitted by email or post to the details below:

Trade Mark Directive Transposition Consultation 2018  
Trade Marks and Designs Directorate  
Intellectual Property Office  
Room 2G05 Concept House  
Cardiff Road  
Newport  
NP10 8QQ

Email: [TMDirective@ipo.gov.uk](mailto:TMDirective@ipo.gov.uk)

Please let us have your comments by 16th April 2018

## Consultation principles

85. This consultation is being run in line with the Government's consultation principles, which are available at: [www.cabinetoffice.gov.uk/sites/default/files/resources/Consultation-Principles.pdf](http://www.cabinetoffice.gov.uk/sites/default/files/resources/Consultation-Principles.pdf)

## Confidentiality and data protection

86. This is a public consultation, the results or conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in your response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in your fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.

87. Information provided in response to this consultation, including personal information, may be subject to publication or release to other parties or to disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want information, including personal data that you provide to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.
88. In view of this it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. An automatic confidentiality disclaimer generated by your IT system will not, of itself, be regarded as binding on the Department. The IPO will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.

## Comments or complaints

89. Any comments or complaints about the way this consultation has been conducted should be sent to:

Angela Rabess  
Consultation Coordinator  
Better Regulations Team  
Department for Business, Energy and Industrial Strategy  
1 Victoria Street  
London  
SW1H 0ET

Email: [angela.rabess@beis.gov.uk](mailto:angela.rabess@beis.gov.uk)

Tel: 0207 2151661

## Annex A: Overview of the proposed amendments

The table below indicates the proposed handling of each Article of the Directive. The third column gives brief description, and if appropriate, indicates where in the body of the document the issue is discussed further. Text in colour indicates amendments to UK law.

| Articles of the Directive                                 | National Provision   | Description of the change   |
|---|--|---|
| <b>CHAPTER 1 GENERAL PROVISIONS</b>                       |  |   |
| Article 1: Scope  |  |   |
| 1   | Section 1  | No change: existing provision implicitly covers substance of Article 1.   |
| Article 2: Definitions                                    |  |   |
| 2   | Rule 2(1) TM Rules defines “the Office”<br><br>Section 63(1) defines the “Register”                              | No change   |
| <b>CHAPTER 2 SUBSTANTIVE LAW ON TRADE MARKS</b>           |  |   |
| <b>SECTION 1: SIGNS OF WHICH A TRADE MARK MAY CONSIST</b> |  |   |
| Article 3: Signs of which a trade mark may consist        |  |   |
| 3   | Section 1(1) as amended by Regulation 3  | Amendments to remove previous requirement for a trade mark to be ‘graphically’ represented, and adds a new requirement for a mark to be clearly and precisely defined.<br><br>See paragraph 16 for discussion about practicalities of new file formats.<br><br>See paragraph 17 for discussion about ‘competent authorities’. |
| <b>SECTION 2: GROUNDS FOR REFUSAL OR INVALIDITY</b>       |  |   |
| Article 4: Absolute grounds for refusal                   |  |   |
| 4   | Section 3 (Absolute grounds for refusal of registration) and section 47 (grounds for invalidity of registration) |   |
| 4.1(a)  | Section 3(1)(a)  | No change: existing provision (requirement to meet definition of a trade mark) is identical in substance to Article 4.1(a)  |

| Articles of the Directive | National Provision                         | Description of the change   |
|---------------------------|--|---|
| 4.1(b)                    | Section 3(1)(b)                            | No change: existing provision (distinctiveness) is identical in substance to Article 4.1(b).  |
| 4.1(c)                    | Section 3(1)(c)                            | No change: existing provision (descriptiveness) is identical in substance to Article 4.1(c).  |
| 4.1(d)                    | Section 3(1)(d)                            | No change: existing provision (customary signs) retained as it is identical in substance to Article 4.1(d).   |
| 4.1(e)                    | Section 3(2) as amended by Regulation 4(2) | Amendment to add to restrictions on the registration of non-standard signs (other than shapes, which are already accounted for) such as smell or taste marks, by adding 'another characteristic' to the restrictions. |
| 4.1(f)                    | Section 3(3)(a)                            | No change: existing provision (public policy/morality) is identical in substance to Article 4.1(f).   |
| 4.1(g)                    | Section 3(3)(b)                            | No change: existing provision (deceptiveness) is identical in substance to Article 4.1(g).  |
| 4.1(h)                    | Sections 3(5), 4(3) and Sections 57 and 58 | No change. Sections 57 and 58 implement Article 6ter of the Paris Convention which is referred to in Article 4.1(h)   |
| 4.1(i)                    | Section 3 as amended by Regulation 4(4)    | Amendment to specifically include designations of origin or geographical indications within absolute grounds for refusal. New section 3(4A).<br><br>See paragraph 21 re: links with section 3(4).                     |
| 4.1(j)                    | Section 3 as amended by Regulation 4(4)    | Amendment to specifically include traditional terms for wine within absolute grounds for refusal. New section 3(4B).<br><br>See paragraph 21 re: links with section 3(4).   |
| 4.1(k)                    | Section 3 as amended by Regulation 4(4)    | Amendment to specifically include traditional specialties guaranteed within absolute grounds for refusal. New section 3(4B).<br><br>See paragraph 21 re: links with section 3(4).                                     |

| Articles of the Directive | National Provision   | Description of the change  |
|---------------------------|--|--|
| 4.1(l)                    | Section 3 as amended by Regulation 4(4)                      | Amendment to specifically include plant variety rights within absolute grounds for refusal. New section 3(4C) and (4D).<br><br>See paragraph 21 re: links with section 3(4).   |
| 4.2                       | Sections 3(6) and 47(1)                                      | No change: existing provisions (bad faith) are identical in substance to Article 4.2.  |
| 4.3(a)                    | Section 3(4) as amended by Regulation 4(3) and Section 47(1) | Optional measure previously implemented in UK law: amendment to clarify that the ability to prohibit use of a trade mark under section 3(4) relates to non-trade mark law.<br><br>See paragraph 21 re: links between section 3(4) and Articles 4.1(i),(j),(k) & (l). |
| 4.3(b)                    | Section 4(5)   | Optional measure previously implemented in UK law: no change: considered to be implemented by restricting the right to register Olympic symbols as trade marks.  |
| 4.3 (c)                   | Section 4(1) and (4) and Rule 10                             | Optional measure previously implemented in UK law: no change: considered to be implemented by restricting the right to register e.g. royal arms, etc.  |
| 4.4, first sentence       | The proviso to section 3(1)                                  | No change: existing provision (acquired distinctiveness – absolute grounds) is identical in substance to Article 4.4.  |
| 4.4, second sentence      | Section 47(1)  | No change: existing provision (acquired distinctiveness – absolute grounds) is identical in substance to Article 4.4.  |
| 4.5                       |  | Optional: not being implemented. Permits consideration of distinctive character acquired after the date of application, but before registration date.<br><br>See paragraph 22 for discussion.  |

| Articles of the Directive                             | National Provision   | Description of the change   |
|---|--|---|
| Article 5: Relative Grounds for refusal or invalidity |  |   |
| 5.1(a)  | Section 5(1) and 47(2)(a)  | No change: existing provisions (identical marks, goods & services) are identical in substance to Article 5.1(a).  |
| 5.1(b)  | Section 5(2) and 47(2)(a)  | No change: existing provisions (identical or similar marks, goods & services) are identical in substance to Article 5.1(b).   |
| 5.2(a)  | Section 6(1)(a)  | No change: existing provision (definition of earlier marks - registrations) is identical in substance to Article 5.2 (a).   |
| 5.2(b)  | Section 6(1)(b) as amended by Regulation 7(2)  | Amendment to clarify the status of earlier marks from which seniority is claimed.   |
| 5.2(c)  | Section 6(2)   | No change: existing provision (definition of earlier marks - applications) is identical in substance to Article 5.2(c).   |
| 5.2(d)  | Section 6(1)(c)  | No change: existing provision (definition of earlier marks claiming priority) is identical in substance to Article 5.2(d).  |
| 5.3(a)  | Section 5(3) as amended by Regulation 5(2) and Section 47(2)(a)                          | Amendment to clarify provisions about earlier marks with a reputation, to include specific reference to earlier trade marks where the goods/services are 'not similar to' those of the mark in question.  |
| 5.3(b)  | Section 5 as amended by Regulation 5(7) and Section 47(2) as amended by Regulation 23(3) | <p>New provisions to prevent an agent or representative of a proprietor registering a trade mark in their name, without the consent of the proprietor, or to permit a mark so registered to be invalidated, unless the agent justifies his or her actions.</p> <p>See paragraph 32 for brief overview and 47 for discussion of linked Article 13.</p> |
| 5.3(c)  | Section 5 as amended by Regulations 5(4) and (5) and Section 47(2)(b)                    | New relative ground for refusal to take into account earlier applications for designations of origin and geographical indications.  |

| Articles of the Directive   | National Provision  | Description of the change   |
|---|---|---|
| 5.4(a)  | Section 5(4)(a) as amended by Regulation 5(3) and 5(5) and section 47(2)(b)                                 | Optional measure previously implemented in UK law: amendment to existing provision to clarify that the rights to unregistered trade marks or signs were acquired prior to the date of application for registration or the priority claimed. |
| 5.4(b)(i) and (ii)  |   | Optional: not being implemented.<br>Gives protection to earlier rights consisting of a right to a name and a right of personal portrayal.<br><br>See paragraph 33 for discussion.   |
| 5.4(b)(iii) and (iv)  | Section 5(4)(b) and section 47(2)(b)  | Optional measure previously implemented in UK law: no change: (additional earlier rights) considered to be identical in substance to Articles 5.4(b)(iii) and (iv)<br><br>See paragraph 34 for discussion.                                  |
| 5.4(c )   |   | Optional: not being implemented.<br>Gives protection to earlier marks registered abroad where applicant acts in bad faith.<br><br>See paragraph 35 for discussion   |
| 5.5   | Section 5(5) and Section 47(2)  | No change: existing provisions (consent) are identical in substance to Article 5.5.   |
| 5.6   |   | Optional: not being implemented.<br>Derogation from absolute grounds for refusal if they did not apply prior to the original Trade Mark Directive.<br><br>Considered to have no impact in the UK.   |
| Article 6: Establishment a posteriori of invalidity or revocation of a trade mark |   |   |
| 6   | Section 52(2)(b) and the Community Trade Mark Regulations 2006, Regulation 3(3) as amended by Regulation 44 | Amendment to clarify the date from which a mark may be considered to have been invalidated or revoked, where that mark is one from which seniority is claimed and it has been surrendered or removed from the register .                    |



| Articles of the Directive  | National Provision   | Description of the change   |
|--|--|---|
| Article 7: Grounds for refusal or invalidity relating to only some of the goods or services  |  |   |
| 7  | New Section 5A as inserted by Regulation 6 and Section 47(5) | New provision to clarify that the refusal of an application may apply in respect of only some of the goods or services. New Section 5A. No change in relation to grounds for invalidity.  |
| Article 8: Lack of distinctive character or of reputation of an earlier trade mark precluding a declaration of invalidity of a registered trade mark |  |   |
| 8(a)   | Section 47 as amended by Regulation 23(8)                    | New provision specifying the circumstances under which invalidation may not succeed: where an earlier trade mark had not acquired a distinctive character. New Section 47(2G) and (2H)(a).  |
| 8(b)   | Section 47 as amended by Regulation 23(8)                    | New provision specifying the circumstances under which invalidation may not succeed: where an earlier trade mark had not become sufficiently distinctive to support a finding of likelihood of confusion. New Section 47(2G) and (2H)(b). |
| 8(c)   | Section 47 as amended by Regulation 23(8)                    | New provision specifying the circumstances under which invalidation may not succeed: earlier trade mark had not acquired a reputation. New Section 47(2G) and (2H)(c).  |
| Article 9: Preclusion of a declaration of invalidity due to acquiescence   |  |   |
| 9.1  | Section 48(1)  | No change: existing provision (acquiescence) is identical in substance to Article 9.1.  |
| 9.2  | Section 48(1)  | Optional measure previously implemented in UK law: no change: existing provision (acquiescence) is identical in substance to Article 9.2.   |
| 9.3  | Section 48(2)  | No change: existing provision (acquiescence) is identical in substance to Article 9.3.  |

| Articles of the Directive                           | National Provision                           | Description of the change   |
|---|--|---|
| <b>SECTION 3: RIGHTS CONFERRED AND LIMITATIONS</b>  |  |   |
| <b>Article 10: Rights conferred by a trade mark</b> |  |   |
| 10.1  | Section 9(1)                                 | No change: first part of existing provision (exclusive rights) is identical in substance to Article 10.1.   |
| 10.2  | Section 9(1) as amended by Regulation 9      | Amendment to clarify that the proprietor's exclusive rights begin at the filing, or priority, date.   |
| 10.2(a)   | Section 10(1)                                | No change: existing provision (infringement defined by reference to identical marks and identical goods or services) as it is identical in substance to Article 10.2(a).  |
| 10.2(b)   | Section 10(2)                                | No change: existing provision (infringement defined by reference to identical or similar marks and identical or similar goods or services) is identical in substance to Article 10.2(b).                                      |
| 10.2(c)   | Section 10(3) as amended by Regulation 10(2) | Amendment to clarify provisions about earlier marks with a reputation, to include specific reference to earlier trade marks where the goods/services are 'not similar to' those of the mark in question (new section 10(3A)). |
| 10.3(a)   | Section 10(4)(a)                             | Optional measure previously implemented in UK law: no change: existing provision (infringement) is identical in substance to Article 10.3(a).   |
| 10.3(b)   | Section 10(4)(b)                             | Optional measure previously implemented in UK law: no change: existing provision (infringement) is identical in substance to Article 10.3(b).   |
| 10.3(c)   | Section 10(4)(c)                             | Optional measure previously implemented in UK law: consequential amendment to the wording (infringement) to remove the word "or".   |
| 10.3(d)   | Section 10(4) as amended by Regulation 10(4) | Optional: new provision to ensure use of a sign (infringement) includes trade or company names.   |

| Articles of the Directive   | National Provision  | Description of the change  |
|---|---|--|
| 10.3(e)   | Section 10(4)(d) as amended by Regulation 10(5)   | Optional measure previously implemented in UK law: minor amendment to fully reflect wording of Directive ('or in advertising' changed to 'and in advertising, or').  |
| 10.3(f)   | Section 10(4) as amended by Regulation 10(6) and 10(7)  | Optional: new provision to ensure existing references considered to relate to comparative advertising (infringement) comply with the Directive. New Section 10(4)(e). Consequential repeal of section 10(6).<br><br>See paragraph 37 for discussion.   |
| 10.4  | Regulation 11 (inserting new section 10A)   | New provision to cover 'goods in transit'. New Section 10A.<br><br>See paragraph 39 for discussion.  |
| 10.5  |   | No change: not applicable under UK law. Provision to enable Member States laws, which pre-dated the original Trade Marks Directive, to continue to have effect in relation to registered rights.   |
| 10.6  |   | No change: implementation not required. Provision which enables Member States to retain laws which protect registered marks from being used in circumstances other than for the purposes of distinguishing goods or services where such use might take unfair advantage of or is detrimental to the distinctive character or repute of the mark. |
| Article 11: The right to prohibit preparatory acts in relation to the use of packaging or other means |   |  |
| 11  | Section 9 as amended by Regulation 9(3) and section 10 as amended by Regulation 10(2) and (7) | New provision to ensure the right to prohibit acts preparatory to e.g. counterfeiting activity is correctly incorporated into UK law (new sections (3B) to (3D)). Consequential repeal of existing UK provision (existing section 10(5)).<br><br>See paragraph 42 for discussion.  |

| Articles of the Directive   | National Provision   | Description of the change  |
|---|--|--|
| Article 12: Reproduction of trade marks in dictionaries   |  |  |
| 12  | Regulation 30(inserting new section 99A)   | New provision to require publishers to amend dictionary entries which wrongly suggest registered trade marks are generic terms, and to provide an enforcement mechanism.<br><br>See paragraph 46 for discussion.   |
| Article 13: Prohibition of the use of a trade mark registered in the name of an agent or representative |  |  |
| 13  | Regulation 11 (inserting new section 10B) and Regulation 28 (which repeals section 60) | New section 10B sets out the remedies available to the proprietor of a registered mark, where an agent/ representative registers the proprietor's trade mark in their own name, without the consent of the proprietor (unless the agent justifies his or her actions). This is based on the provisions currently contained in section 60 (which will be repealed).<br><br>See paragraph 47 for discussion. |
| Article 14: Limitation of the effects of a trade mark   |  |  |
| 14.1(a)   | Section 11(2)(a) as amended by Regulation 12(4)  | Amendment to clarify that the defence against infringement which deals with use by a 'person' of his own name or address does not extend to 'legal persons' i.e. company or business names.<br><br>See paragraph 49 for discussion.  |
| 14.1(b)   | Section 11(2)(b) as amended by Regulation 12(5)  | Amendment to the defences against infringement to include the use of signs or indications which are not distinctive.   |
| 14.1(c )  | Section 11(2)(c) as amended by Regulation 12(6)  | Amendment to the defences against infringement to ensure use of a trade mark is for the purpose of identifying, etc, the goods or services as those of the proprietor of the trade mark.   |
| 14.2  | Section 11(2) proviso  | No change: existing provision (honest practices) is identical in substance to Article 14.2.  |
| 14.3  | Section 11(3)  | No change: existing provision (earlier right in a locality) is considered to be compatible with Article 14.3, which defers to Member State law.  |

| Articles of the Directive   | National Provision   | Description of the change   |
|---|--|---|
| Article 15: Exhaustion of the rights conferred by a trade mark                                      |  |   |
| 15.1  | Section 12(1)  | No change: existing provision (exhaustion) is identical in substance to Article 15.1.   |
| 15.2  | Section 12(2)  | No change: existing provision (limitation on exhaustion) is identical in substance to Article 15.2.   |
| Article 16: Use of Trade Marks  |  |   |
| 16.1 (insofar as it relates to Article 17 Non-use as defence to infringement proceedings)           | New Section 11A as inserted by Regulation 13                         | New provision to provide a defence of non-use in an action for infringement – see also Article 17. (Reflects existing provision in section 6A relating to opposition and section 47(2A) to (2F).)<br><br>See paragraph 50 for discussion. |
| 16.1 (insofar as it relates to Article 19(1) Revocation)  | Section 46(1)(a) and Section 46(1)(b)                                | No change: existing provisions (grounds for revocation) are identical in substance to Article 16.1.   |
| 16.1 (insofar as it relates to Article 44(1) and (2) Non-use as defence in opposition proceedings)  | Sections 6A(1) to (3) and 38, and Rules 17(5)(d) 20(3)(c) and (3)(b) | No change: existing provisions (period of use - opposition) are identical in substance to Article 16.1. But see amendments arising under Article 44.  |
| 16.1 (insofar as it relates to Articles 46(3) and (4) Non-use as defence in invalidity proceedings) | Section 47(2A) and (2E)  | No change: existing provisions (period of use – invalidation) are identical in substance to Article 16.1. See also Article 46.  |
| 16.2  |  | No change: not applicable under UK law. Provision governing the period of (non) use, if opposition proceedings are permitted post registration.   |

| Articles of the Directive                                  | National Provision  | Description of the change  |
|--|---|--|
| 16.3   | Article 3(3)(e) of and schedule 2 paragraph 6 to the Trade marks (International Registration) Order 2008 as amended by Regulation 51 and section 6A as amended by Regulation 8(6) and section 47 as amended by Regulation 23(7) | Amendments provide a gloss on the references to “completion of the registration procedure” to clarify that provisions defining periods of (non) use also apply to international trade marks.   |
| 16.4   | Rule 47(b)  | No change: existing provision (entry in the register of date of completion of registration procedure) is identical in substance to Article 16.4.   |
| 16.5(a)  | Section 6A(4)(a) as amended by Regulation 8(5), section 46(2) as amended by Regulation 22, and section 47(2C)(a) as amended by Regulation 23(6)   | Amendment to clarify that for opposition, revocation and invalidation purposes, use of a trade mark includes uses in certain formats “regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor”. |
| 16.5(b)  | Section 46(2)   | No change: existing provision (‘use’ also covers exports in certain circumstances) is identical in substance to Article 16.5.  |
| 16.6   | Section 46(1)(a)  | No change: existing provision (‘use’ with consent) is identical in substance to Article 16.6.  |
| Article 17: Non-use as defence in infringement proceedings |   |  |
| 17   | Regulation 13 (inserting new section 11A)   | New provision to provide a defence of non-use in an action for infringement – see also Article 16.1. (Reflects existing provision in section 6A relating to opposition).<br><br>See paragraph 50 for discussion.   |

| Articles of the Directive   | National Provision                        | Description of the change   |
|---|---|---|
| Article 18: Intervening right of the proprietor of a later registered trade mark as defence in infringement proceedings |   |   |
| 18.1  | Section 11 as amended by Regulation 12(2) | <p>Amendment to clarify that, in certain circumstances, a registered mark is not infringed by the use of a <b>later</b> registered mark.</p> <p>This amendment effectively removes previous constraints which required a registered mark be revoked before infringement proceedings could take place.</p> |
| 18.2  | Section 11 as amended by Regulation 12(3) | New provision to ensure that, in certain circumstances, a registered trade mark is not infringed by the use of a later registered European Union trade mark. New section 11(1A).  |
| 18.3  | Section 11 as amended by Regulation 12(3) | New provision to ensure that, in certain circumstances, a later registered mark is not infringed by an earlier mark. New section 11(1B).  |
| SECTION 4: REVOCATION OF TRADE MARKS RIGHTS   |   |   |
| Article 19: Absence of genuine use as ground for revocation   |   |   |
| 19.1  | Section 46(1)(a) and (b)                  | No change: existing provisions (revocation - non-use) are identical in substance to Article 19.1.   |
| 19.2  | Section 46(3)                             | No change: existing provision (no revocation in certain circumstances) is identical in substance to Article 19.2.   |
| 19.3  | Section 46(3) proviso                     | No change: existing provision (proviso to 'no revocation' above) is identical in substance to Article 19.3.   |

| Articles of the Directive   | National Provision  | Description of the change   |
|---|---|---|
| Article 20: Trade Mark having become generic or misleading indication as grounds for revocation |   |   |
| 20(a)   | Section 46(1)(c )   | No change: existing provision (revocation where a trade mark has become a common name) is identical in substance to Article 20(a).  |
| 20(b)   | Section 46(1)(d)  | No change: existing provision (revocation where use of the trade mark has become misleading) is identical in substance to Article 20(b).  |
| Article 21: Revocation relating to only some of the goods or services                           |   |   |
| 21  | Section 46(5)   | No change: existing provision ('partial' revocation) is identical in substance to Article 21.   |
| SECTION 5: TRADE MARKS AS OBJECTS OF PROPERTY   |   |   |
| Article 22: Transfer of registered trade marks  |   |   |
| 22.1  | Section 24(1) and (2)(a)  | No change: existing provisions (assignment) are identical in substance to Article 22.1.   |
| 22.2  | Section 24 as amended by Regulation 14  | New provision to clarify that any registered trade marks are transferred with the business, unless there is agreement to the contrary etc. New section 24(1A).  |
| 22.3  | Section 25  | No change: existing provision (registrable transactions) is considered to comply with Article 22.3.   |
| Article 23: Rights in rem   |   |   |
| 23.1  | Section 24(1) and 24(5)   | No change: existing provisions (registered marks as property) are considered to comply with Article 23.1  |
| 23.2  | Section 25  | No change: existing provision (registrable transactions) is considered to comply with Article 23.2  |
| Article 24: Levy of execution   |   |   |
| 24.1  | Section 37 Senior Courts Act 1981 and Section 107 County Courts Act 1984 (as supplemented by Civil Procedure Rules Part 69) | No change: existing provisions are considered to 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 in accordance with the levy of execution. |
| 24.2  | Section 25(2)(a)  | No change: as above the Court may order that an assignment be executed in levy of execution and such assignments are registrable under section 25(2) as are orders of court transferring a registered trade mark.   |



| Articles of the Directive   | National Provision   | Description of the change   |
|---|--|---|
| <b>Article 25: Licensing</b>  |  |   |
| 25.1  | Section 28(1) and Section 29   | No change: existing provisions (licensing) are identical in substance to Article 25.1.  |
| 25.2  | Section 28 as amended by Regulation 16   | New provision for a trade mark proprietor to take action against a licensee who contravenes certain provisions in a licence. New section 28(5).   |
| 25.3  | 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 (4) (for exclusive licences) | New provision specifying that, subject to the licence, a (non-exclusive) licensee may only take infringement proceedings with the consent of the trade mark proprietor. New section 30(1A).<br><br>Other amendments include clarification that an exclusive licensee may bring proceedings if the proprietor fails to do so.<br><br>See paragraph 53 for discussion of repeal of section 30(4) and (5). |
| 25.4  | Section 30(6) as amended by Regulation 17(7)   | New provisions to permit licensees to intervene in proceedings in relation to harm suffered by them. New section 30(6A).  |
| 25.5  | Section 25(2)(b)   | No change: existing provision (registrable transactions) is considered to comply with Article 25.5.   |
| <b>Article 26: Applications for a trade mark as an object of property</b> |  |   |
| 26  | Section 27(1) as amended by Regulation 15  | Amendment to ensure licensing provisions apply to applications as well as to registrations.   |
| <b>SECTION 6: GUARANTEE OR CERTIFICATION MARKS AND COLLECTIVE MARKS</b>   |  |   |
| <b>Article 27: Definitions</b>  |  |   |
| 27(a)   | Section 50(1) as amended by Regulation 25 and Schedule 2 paragraph 2   | Amendment to clarify the definition of a certification mark by the addition of words 'which is described as such when the mark is applied for'.   |
| 27(b)   | Section 49(1) as amended by Regulation 24  | Amendment to clarify the definition of a collective mark by the addition of words 'which is described as such when the mark is applied for and is capable of'.  |

| Articles of the Directive                           | National Provision                           | Description of the change  |
|---|--|--|
| <b>Article 28: Guarantee or certification marks</b> |  |  |
| 28.1  | Section 50                                   | Optional measure previously implemented into UK law: no change: existing provision (certification mark definition) considered to meet Article 28.1.  |
| 28.2 first sentence                                 | Section 50(2) and Schedule 2 paragraph 4     | No change: existing provisions (who may apply for a certification mark) is identical in substance to Article 28.2.   |
| 28.2 second sentence                                | Schedule 2, paragraph 7(1)(b)                | Optional measure previously implemented into UK law: no change: existing provision (competency of certifying body) is identical in substance to Article 28.2 (second sentence).                                    |
| 28.3  | Schedule 2, paragraphs 5, 7, 15 and 16       | Optional measure previously implemented into UK law: no change: existing provisions (alternative grounds for refusals, revocation, etc) are considered to meet Article 28.3.                                       |
| 28.4  | Schedule 2, paragraph 3                      | Optional: no change: existing provision (indications of geographical origin) is identical in substance to Article 28.4.  |
| 28.5  | Schedule 2, paragraph 6 and Section 46(1)(a) | No change: existing provisions (use of a certification mark) are identical in substance to Article 28.5.   |
| <b>Article 29: Collective marks</b>                 |  |  |
| 29.1  | Section 49                                   | No change: existing provision (collective marks definition) is considered to meet Article 29.1.  |
| 29.2  | Section 49(1) as amended by Regulation 24    | <p><b>Amendment to clarify the nature of the association that can apply for a collective trade mark. New section 49(1A).</b></p> <p>See paragraph 55 for discussion of 'legal persons governed by public law'.</p> |
| 29.3  | Schedule 1, paragraph 3                      | Optional measure previously implemented into UK law: no change: existing provision (geographic descriptors may be registered as collective marks) is identical in substance to Article 29.3.                       |

| Articles of the Directive  | National Provision   | Description of the change   |
|--|--|---|
| Article 30: Regulations governing use of a collective mark                   |  |   |
| 30.1   | Schedule 1, paragraph 5(1)   | No change: existing provision (requirement to file regulations) is identical in substance to Article 30.1.  |
| 30.2 first sentence  | Schedule 1, paragraph 5(2) as amended by Regulation 32(2)(a)   | Amendment to make mandatory the inclusion of conditions of use within the regulations for collective marks.   |
| 30.2 second sentence   | Schedule 1, paragraph 5(2) as amended by Regulation 32(2)(c)   | Amendment to clarify that regulations covering collective marks designating geographical origin must, under certain conditions, authorise any person whose goods or services originate in the geographical area concerned to become a member of the proprietor association. |
| Article 31: Refusal of application   |  |   |
| 31.1   | Section 49 (as amended by Regulation 24) and Schedule 1, paragraphs 2, and 6   | No change specific to this Article: existing provisions are identical in substance to Article 31.1  |
| 31.2   | Schedule 1, paragraph 4(1)   | No change: existing provision (misleading collective marks) is identical in substance to Article 31.2.  |
| 31.3   | Section 49 (as amended by Regulation 24) and Schedule 1, paragraphs 7(1), 7(2) and 7(4)                                | No change specific to this Article: existing provisions are identical in substance to Article 31.1  |
| Article 32: Use of collective marks  |  |   |
| 32   | Schedule 1, paragraph 5(2) and Section 6A, new section 11A, as inserted by Regulation 13, and Sections 46(1)(a) and 47 | No change specific to this article: the existing provisions and new section 11A (use) are identical in substance to Article 32.   |
| Article 33: Amendments to the regulations governing use of a collective mark |  |   |
| 33.1   | Schedule 1, paragraph 10   | No change: existing provision (amendment of regulations) is identical in substance to Article 33.1.   |
| 33.2   | Rule 47 as amended by Regulation 42  | Amendment to require the registrar to include in the register, a record that an amendment of the regulations has been made.   |
| 33.3   | Schedule 1, paragraph 10 and Rule 47 as amended by Regulation 42   | Amendments to link acceptance of the amended regulations to the date the amendments were entered in the register.   |

| Articles of the Directive  | National Provision  | Description of the change  |
|--|---|--|
| Article 34: Persons entitled to bring an action for infringement |   |  |
| 34.1   | Schedule 1, paragraph 12 as amended by Regulation 32(4)       | Amendments to ensure that authorised users can only bring infringement proceedings with the consent of the proprietor, and that they may intervene in proceedings in relation to any compensation for damage suffered by them.<br><br>See paragraph 53 for parallel discussion of licensee provisions. |
| 34.2   | Schedule 1, paragraph 12(6)                                   | No change: existing provision (claiming compensation on behalf of users) is identical in substance to Article 34.2.  |
| Article 35: Additional grounds for revocation                    |   |  |
| 35   | Schedule 1, paragraph 13                                      | No change: existing provision (grounds for revocation of collective marks) is identical in substance to Article 35.  |
| 35(a)  | Schedule 1, paragraph 13(b) as amended by Regulation 32(5)(b) | Amendment to grounds for revocation to relax the existing threshold for proprietors to take action against use of the mark which is incompatible with the regulations.   |
| 35(b)  | Schedule 1, paragraph 13(a) as amended by Regulation 32(5)(a) | Amendment to grounds for revocation to ensure that misleading use provisions relate to 'persons authorised to use the mark'.   |
| 35(c )   | Schedule 1, paragraph 13(c )                                  | No change: existing provision (grounds for revocation relating to amendment of the regulations) is identical in substance to Article 35(c).  |
| Article 36: Additional grounds for invalidity                    |   |  |
| 36   | Schedule 1, paragraph 14 as amended by Regulation 32(6)       | Amendments to grounds for invalidity to make them mandatory, to cover the nature of the association that can apply for a collective trade mark, and to allow the regulations to be amended to comply with the law.   |

| Articles of the Directive  | National Provision   | Description of the change   |
|--|--|---|
| CHAPTER 3 PROCEDURES   |  |   |
| SECTION 1: APPLICATION AND REGISTRATION                          |  |   |
| Article 37: Application requirements                             |  |   |
| 37.1   | Section 32(2) as amended by regulation 18                        | Amendment to clarify that the representation of the mark must be clearly and precisely defined, in line with section 1(1).  |
| 37.2   | Section 32(4)  | No change: existing provision (application fee) is identical in substance to Article 37.2.  |
| Article 38: Date of filing                                       |  |   |
| 38.1   | Section 33(1)  | No change: existing provision (filing date) is identical in substance to Article 38.1.  |
| 38.2   |  | Optional: not being implemented.<br>Filing date to be subject to payment of fees.<br><br>Not considered necessary to change the existing system, and could create difficulties for payments arising out of current account funds. |
| Article 39: Designation and classification of goods and services |  |   |
| 39.1   | Section 34(1) and rule 7   | No change: existing provisions (use of the Nice classification system) are identical in substance to Article 39.1.  |
| 39.2   | Rule 8(2)(b) as amended by Regulation 35(2)                      | Amendment to ensure that UK rules about the clarity of the specification are compliant with the Directive.<br><br>See paragraph 60 for discussion of 'economic operators'.  |
| 39.3   | Rule 8 as amended by Regulation 35(3) (inserting new Rule 8(2A)) | Amendment to clarify handling of terms included within class headings of the Nice classification system. New Rule 8(2A).  |
| 39.4   | Rule 9(3) as amended by Regulation 36                            | Amendment to change the status of applications refused because of unclear specifications from 'abandoned' to 'rejected'.  |

| Articles of the Directive                              | National Provision   | Description of the change  |
|--|--|--|
| 39.5   | Rule 8 as amended by Regulation 35(3) (inserting new Rule 8(2B))                               | New provision to specify that general terms in specifications will be interpreted literally. (New Rule 8(2B)).   |
| 39.6   | Rule 8(3)  | No change: existing provision (classification requirements) is identical in substance to Article 39.6.   |
| 39.7   | Section 5 as amended by Regulation 5(5)  | New provision to clarify the handling of 'similar' goods and services in the same and differing classes of the Nice classification system (New section 5(4C)).                                   |
| Article 40: Observations by third parties              |  |  |
| 40.1   | Section 38(2)  | No change: existing provision (who may file observations) is identical in substance to Article 40.1.   |
| 40.2   | Section 49(2) (as regards collective marks) and Section 50(2) (as regards certification marks) | Optional measure previously implemented into UK law: no change: existing provisions (observations in relation to collective and certification marks) are identical in substance to Article 40.2. |
| Article 41: Division of applications and registrations |  |  |
| 41   | Section 41 as amended by Regulation 20 and new Rule 26A as inserted by Regulation 38           | Amendment to permit the division of a registration. New section 41(1)(aa) and new rule 26A.<br><br>See paragraph 62 for discussion.  |
| Article 42: Class Fees                                 |  |  |
| 42   | Rule 5(1A) and 5(1B) and Trade Mark (Fees) Rules 2008  | Optional measure previously implemented into UK law: no change: existing provisions (additional class fees) are identical in substance to Article 42.  |

| Articles of the Directive  | National Provision   | Description of the change  |
|--|--|--|
| <b>SECTION 2: PROCEDURES FOR OPPOSITION, REVOCATION AND INVALIDITY</b>   |  |  |
| <b>Article 43: Opposition procedure</b>                                  |  |  |
| 43.1   | Section 38(2) and Rules 16 to 23   | No change: existing provisions (administrative opposition procedure) considered to meet Article 43.1.  |
| 43.2 first sentence  | Section 38(2) and Article 2 of the Relative Grounds Order 2007 and Section 5, (as amended by Regulation 5(4), (5) and (6), and Section 6)                                  | No change specific to this article: existing provisions (as amended) ensure a 'person authorised...' in relation to geographical indications can file an opposition. |
| 43.2 second sentence   | Section 38 as amended by Regulation 19(2)  | Amendments to clarify the basis upon which an opposition based on earlier rights may be filed. New section 38(2A) and 38(2B).  |
| 43.3   | Rule 18(4), (5) and (6)  | No change: existing provisions ('cooling off' period) are identical in substance to Article 43.3.  |
| <b>Article 44: Non-use as defence in opposition</b>                      |  |  |
| 44.1   | Section 6A(1) to (3) (as amended by Regulation 8(2), 8(3) and 8(4)), Section 38 and Rules 17(5)(d) and 17(6)(e), as amended by Regulation 37 and Rules 20(2)(c) and (3)(b) | Amendments to change the relevant date for the non-use period in opposition proceedings from 'date of publication' to the 'date of application'.                     |
| 44.2   | Section 6A(6)  | No change: existing provision (non-use of only some goods/services in opposition proceedings) is identical in substance to Article 44.2.                             |
| 44.3   | Section 6A(1) to (5)   | No change: existing provisions (non-use in opposition proceedings) are identical in substance to Article 44.3.   |
| <b>Article 45: Procedure for revocation or declaration of invalidity</b> |  |  |
| 45.1   | Section 46(4) and 47(3)  | No change: existing provisions (administrative revocation and invalidity procedures) are considered to meet Article 45.1.  |
| 45.2   | Section 46(1)(a),(1)(b), (1)(c) and (1)(d)   | No change: existing provisions (grounds for revocation) are identical in substance to Article 45.2.  |
| 45.3(a)  | Section 47(1)  | No change: existing provision (grounds for invalidity) is identical in substance to Article 45.3.  |

| Articles of the Directive   | National Provision   | Description of the change  |
|---|--|--|
| 45.3(b)   | Section 47(2) as amended by Regulation 23(2)                           | Amendment to clarify the circumstances under which requests for invalidation may not succeed.  |
| 45.4(a)   | Section 46(4) and section 47(3)  | No change: existing provisions (who may apply to revoke a registered mark or request a declaration of invalidity) are identical in substance to Article 45.4(a).   |
| 45.4(b)   | Section 47(2) and Article 5(5) of the Relative Grounds Order           | No change: existing provisions (grounds for invalidation) is identical in substance to Article 45.4.   |
| 45.5  | Section 46(5) and Section 47(5)  | No change: existing provisions (revocation and invalidity may be directed to part of the specification) are identical in substance to Article 45.5.  |
| 45.6  | Section 47 as amended by Regulation 23(9)                              | Amendment to clarify that if invalidation is based on more than one earlier right, they must belong to same proprietor. New section 47(5A).  |
| Article 46: Non-use as a defence in proceedings seeking a declaration of invalidity |  |  |
| 46.1  | Section 47(2A)(c ) and Section 47(2B) (as amended by Regulation 23(5)) | No change specific to this article: existing provisions (use in invalidity proceedings – as amended) are identical in substance to Article 46.1.   |
| 46.2  | Section 47 as amended by Regulation 23(5)                              | Amendment to clarify that under certain circumstances in invalidity proceedings the proprietor of the earlier mark may be required to provide proof of use for a second period, namely in the 5 years immediately preceding the filing/ priority date of the later mark. |
| 46.3  | Section 47(2A)   | No change: existing provision (circumstances under which invalidation may not succeed) is identical in substance to Article 46.3. (Minor edit to remove the word 'but').   |
| 46.4  | Section 47(2E)   | No change: existing provision (use in invalidation proceedings may apply to part of the specification) is identical in substance to Article 46.4.  |
| 46.5  | Section 47(2D)   | No change: existing provision (reference to use in the European Union) is identical in substance to Article 46.5.  |



| Articles of the Directive                                    | National Provision  | Description of the change   |
|--|---|---|
| <b>Article 47: Consequences of revocation and invalidity</b> |   |   |
| 47.1   | Section 46(6)   | No change: existing provision (date revocation takes effect) is identical in substance to Article 47.1.   |
| 47.2   | Section 47(6)   | No change: existing provision (effect of invalidation) is identical in substance to Article 47.2.   |
| <b>Article 48: Duration of registration</b>                  |   |   |
| 48.1   | Section 42(1) and section 40(3)   | No change: existing provisions (registration period from date of filing) are identical in substance to Article 48.1   |
| 48.2   | Section 42(2)   | No change: existing provision (renewal period) is identical in substance to Article 48.2.   |
| <b>Article 49: Renewal</b>                                   |   |   |
| 49.1 first sentence  | Section 43(1) and Section 82  | No change: existing provision (who may renew a registration) is identical in substance to Article 49.1.   |
| 49.1 second sentence   |   | Optional: not being implemented. Payment may constitute a request for renewal. Do not propose to amend current system, which is used and understood.  |
| 49.2 first sentence  | Rule 34(1) as amended by Regulation 39(2) and Rule 35, as amended by Regulation 40. | Amendment to the period in which the IPO must notify the proprietor of the expiry of a registered mark (from between 6 and 1 months before expiry to 'at least' six months before expiry). Consequential amendment to permit renewal as soon as the proprietor has been notified.<br><br>See paragraph 67 for discussion. |
| 49.2 second sentence   | Rule 34 as amended by Regulation 39(3)  | Amendment to ensure that the IPO is not liable if it fails to notify the proprietor about expiry. New Rule 34(2A)   |
| 49.3   | Section 43(3) and Rules 35 and 36   | No change: existing provisions (payment period and late renewal) are identical in substance to Article 49.3.  |
| 49.4   | Section 43 as amended by Regulation 21  | Amendment to permit partial renewals. New Section 43(3A).   |
| 49.5   | Section 43(4)   | No change: existing provision (when renewal takes effect) is identical in substance to Article 43(4).   |

| Articles of the Directive                       | National Provision | Description of the change   |
|---|--------------------|---|
| <b>SECTION 4: COMMUNICATION WITH THE OFFICE</b> |                    |   |
| Article 50<br>Communication with the office     | Rule 11            | No change: existing provision (address for service) is identical in substance to Article 50.      |
| <b>CHAPTER 4 ADMINISTRATIVE COOPERATION</b>     |                    |   |
| Article 51 to 52                                |                    | These articles deal with administration and cooperation only.                                     |
| <b>CHAPTER 5 FINAL PROVISIONS</b>               |                    |   |
| Article 53 to 57                                |                    | These articles deal with data protection, transposition, repeal, entry into force and addressees. |

| <b>OTHER AMENDMENTS/ISSUES</b>  |                                 |  |
|---|---------------------------------|--|
| National provision  | Suggested action                | Comment  |
| Section 13  | Retained                        | The ability to apply disclaimers or limitations to marks is considered to serve a useful business function.<br><br>See paragraph 69 for discussion.  |
| Sections 51 and 52  | Amended by Regulation 26 and 27 | Amendments to update the references to the EU Trade Mark Regulation.   |
| Rule 5(6)   | Amended by Regulation 34        | Amendment to give the registrar greater flexibility as to when the fast track examination service should be offered.<br><br>See paragraph 73 for discussion.   |
| Schedule 1, Part 2 of the Trade Marks (International Registration) Order 2008 | Amended by Regulation 50        | Amendment to correct the list of rules which do not apply to international marks, to exclude provisions relating to series marks. (Provisions relating to divisions and mergers are required to apply to international marks by February 2019, and are therefore not mentioned in the Schedule as being excluded). |
| Regulation 12(1)(a)(ii) of the Community Trade Mark Regulations 2006          | Repealed by Regulation 48       | Amendment to remove redundant references to patent county courts.  |
| Regulations 5, 10 11 and 12 of the Community Trade Mark Regulations           | Amended by Regulations 45 to 48 | Amendments to update the references to the EU Trade Mark Regulation.   |

# Annex B: Draft statutory instrument

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## STATUTORY INSTRUMENTS

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**2018 No. XXXX**

### TRADE MARKS

#### The Trade Marks Regulations 2018

*Made* - - - - - \*\*\*

*Laid before Parliament* \*\*\*

*Coming into force* - - - [14th January 2019]

The Secretary of State has been designated<sup>(a)</sup> for the purposes of section 2(2) of the European Communities Act 1972<sup>(b)</sup> in relation to intellectual property (including both registered and unregistered rights).

The Secretary of State makes these Regulations in exercise of the powers conferred by that section and by sections 52, 54 and 78 of the Trade Marks Act 1994<sup>(c)</sup>.

### PART 1

#### General

#### Citation, commencement and interpretation

1.—(1) These Regulations may be cited as the Trade Marks Regulations 2018 and come into force on [14th January 2019].

(2) In these Regulations—

“the 1994 Act” means the Trade Marks Act 1994;

“the CTM Regulations” means the Community Trade Mark Regulations 2006<sup>(d)</sup>;

“the International Registration Order” means the Trade Marks (International Registration) Order 2008<sup>(e)</sup>;

“the Rules” means the Trade Marks Rules 2008<sup>(f)</sup>.

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(a) S.I. 2006/608.

(b) 1972 c. 68; section 2(2) was amended by the Legislative and Regulatory Reform Act 2006 (c.51), section 27(1) and the European Union (Amendment) Act 2008 (c.7), section 3(3) and Part 1 of the Schedule.

(c) 1994 c. 26.

(d) S.I. 2006/1027.

(e) S.I. 2008/2206.

(f) S.I. 2008/1797.

## PART 2

### Amendments to the 1994 Act

#### Amendments to the 1994 Act

2. The 1994 Act is amended in accordance with regulations 3 to 32.

#### Trade Marks

3. In section 1, for subsection (1) substitute—

“(1) In this Act “trade mark” means any sign which is capable—

- (a) of being represented in the register in a manner which enables the registrar and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and
- (b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”.

#### Absolute grounds for refusal of registration

- 4.—(1) Section 3 is amended as follows.

(2) In subsection (2), after “the shape” in each place insert “, or another characteristic,”.

(3) In subsection (4)(a), after “EU law” insert “other than law relating to trade marks”.

(4) After subsection (4), insert—

“(4A) A trade mark is not to be registered if its registration is prohibited by or under—

- (a) any enactment or rule of law,
- (b) any provision of EU law, or
- (c) any international agreement to which the United Kingdom or the EU is a party,

providing for the protection of designations of origin or geographical indications.

(4B) A trade mark is not to be registered if its registration is prohibited by or under—

- (a) any provision of EU law, or
- (b) any international agreement to which the EU is a party,

providing for the protection of traditional terms for wine or traditional specialities guaranteed.

(4C) A trade mark is not to be registered if it—

- (a) consists of, or reproduces in its essential elements, an earlier plant variety denomination registered as mentioned in subsection (4D), and
- (b) is in respect of plant varieties of the same or closely related species.

(4D) Subsection (4C)(a) refers to registration in accordance with any—

- (a) enactment or rule of law,
- (b) provision of EU law, or
- (c) international agreement to which the United Kingdom or the EU is a party,

providing for the protection of plant variety rights.”

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(a) Section 3(4) was amended by S.I. 2011/1043, article 6(2)(a).

### Relative grounds for refusal of registration

5.—(1) Section 5(a) is amended as follows.

(2) After subsection (3), insert—

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”.

(3) In subsection (4)(a), for “trade, or” substitute “trade, where the condition in subsection (4A) is met,”.

(4) In subsection (4), after paragraph (a) insert—

“(aa) by virtue of any provision of EU law, or any enactment or rule of law, providing for protection of designations of origin or geographical indications, where the condition in subsection (4B) is met, or”.

(5) After subsection (4), insert—

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

(4B) The condition mentioned in subsection 4(aa) is that—

- (a) an application for a designation of origin or a geographical indication has been submitted prior to the date of application for registration of the trade mark or the date of the priority claimed for that application, and
- (b) the designation of origin or (as the case may be) geographical indication is subsequently registered.

(4C) For the purposes of this section goods and services—

- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;
- (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”.

(6) In subsection (4)(b), after “paragraph (a)” insert “or (aa)”.

(7) After subsection (5) insert—

“(6) Where an agent or representative (“R”) of the proprietor of a trade mark applies, without the proprietor’s consent, for the registration of the trade mark in R’s own name, the application is to be refused unless R justifies that action.

(7) In subsection (4C), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979(b).”.

### Grounds for refusal relating to only some of the goods or services

6. After section 5 insert—

#### “5A Grounds for refusal relating to only some of the goods or services

Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”.

(a) Section 5 was amended by S.I. 2004/946, regulations 3 and 7(1), S.I. 2004/2332, regulations 2 and 3, S.I. 2011/1043, article 4(1) and S.I. 2016/299, the Schedule, paragraph 1.

(b) United Nations Treaty Series, Vol. 1154, No I 18200, p. 89.

**Meaning of “earlier trade mark”**

7.—(1) Section 6(a) is amended as follows.

(2) In subsection (1)(b) after “international trade mark (UK)” insert “even where the earlier trade mark has been surrendered or its registration has expired”.

(3) Omit subsection (3).

**Raising of relative grounds in opposition proceedings in case of non-use**

8.—(1) Section 6A(b) is amended as follows.

(2) In subsection (1)(c), for the words from “period” to the end substitute “relevant period”.

(3) After subsection (1) insert—

“(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.”.

(4) In subsection (3)(a) for “period of five years ending with the date of publication of the application” substitute “relevant period”.

(5) In subsection (4)(a)—

(a) after “a form” insert “(the “variant form”);”;

(b) after “registered” insert “(regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)”.

(6) After subsection (5) insert—

“(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) 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.”.

**Rights conferred by registered trade mark**

9.—(1) Section 9 is amended as follows.

(2) In subsection (1) before “section 10” insert “subsections (1) to (3) of”.

(3) After subsection (1) insert—

“(1A) See subsections (3B) to (3D) of section 10 for provision about certain other acts amounting to infringement of a registered trade mark.

(1B) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of filing of the application for registration or (where applicable) the date of the priority claimed in respect of that application.”.

(4) In subsection (2)—

(a) omit “such”, and

(b) at the end insert “such as is mentioned in subsection (1) or (1A)”.

**Infringement of registered trade mark**

10.—(1) Section 10(c) is amended as follows.

(2) After subsection (3) insert—

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(a) Section 6 was amended by S.I. 2004/2332, regulation 2 and regulation 4 and S.I. 1999/1899, regulation 13(1).

(b) Section 6A was inserted by S.I. 2004/946, regulations 3 and 4 and amended by S.I. 2008/1067 regulations 3 and 4 and S.I. 2011/1043, article 4(1).

(c) Section 10 was amended by S.I. 2004/946, regulations 3 and 7(2).

“(3A) Subsection (3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered.

(3B) A person infringes a registered trade mark if—

- (a) the risk mentioned in subsection (3C) exists, and
- (b) the person carries out in the United Kingdom, in the course of trade, an act specified in subsection (3D).

(3C) The risk mentioned in subsection (3B)(a) is that—

- (a) the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed, could be used in relation to goods or services, and
- (b) that use would constitute an infringement of the rights of the proprietor of the trade mark.

(3D) The acts mentioned in subsection (3B)(b) are—

- (a) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed; or
- (b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.”.

(3) In subsection (4)(c), after “under the sign,” omit “or”.

(4) After subsection (4)(c), insert—

“(ca) uses the sign as a trade or company name or part of a trade or company name;”.

(5) In subsection (4)(d)—

- (a) for “or” substitute “and”;
- (b) after “advertising” insert “; or”.

(6) After subsection (4)(d), insert—

“(e) uses the sign in comparative advertising in a manner that is contrary to the Business Protection from Misleading Marketing Regulations 2008(a).”.

(7) Omit subsections (5) and (6).

### **Right to prevent goods entering the UK without being released for free circulation and prohibition on the use of a trade mark registered in the name of an agent or representative**

11. After section 10, insert—

#### **“10A Right to prevent goods entering the UK without being released for free circulation**

(1) The proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into the United Kingdom in the course of trade without being released for free circulation if they are goods for which the trade mark is registered which—

- (a) come from outside the EU; and
- (b) bear without authorisation a sign which is identical with the trade mark or cannot be distinguished in its essential aspects from the trade mark.

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(a) S.I. 2008/1276 (as amended by the Business Protection from Misleading Marketing (Amendment) Regulations S.I. 2013/2701) which implemented Directive 2006/114/EC of the European Parliament and of the Council concerning misleading and comparative advertising (OJ No L376, 27.12.2017, p.21).

(2) In subsection (1) the reference to goods for which the trade mark is registered includes a reference to the packaging of goods for which the trade mark is registered.

(3) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of application for registration of the trade mark, or (where applicable) the date of the priority claimed in respect of that application.

(4) The entitlement of the proprietor under subsection (1) is to lapse if, during the proceedings to determine whether the trade mark has been infringed, initiated in accordance with the European Customs Enforcement Regulation, evidence is provided by the declarant or the holder of the goods that the proprietor of the trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

(5) References in this Act to the “European Customs Enforcement Regulation” are references to Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights(a).

### **10B Prohibition on the use of a trade mark registered in the name of an agent or representative**

(1) Subsection (2) applies where a trade mark is registered in the name of an agent or representative of a person (“P”) who is the proprietor of the trade mark, without P’s consent.

(2) Unless the agent or representative justifies the action mentioned in subsection (1), P may do either or both of the following—

- (a) prevent the use of the trade mark by the agent or representative (notwithstanding the rights conferred by this Act in relation to a registered trade mark);
- (b) apply for the rectification of the register so as to substitute P’s name as the proprietor of the registered trade mark.”.

### **Limits on effect of registered trade mark**

**12.—**(1) Section 11 is amended as follows.

(2) In subsection (1) omit “another registered trade mark in relation to goods and services for which the latter is registered (but see section 47(6) (effect of declaration of invalidity of registration))” and substitute “a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1)”.

(3) After subsection (1) insert—

“(1A) A registered trade mark is not infringed by the use of a later registered European Union trade mark where that later European Union trade mark would not be declared invalid as a result of Article 60(1), (3), (4), 61(1), (2) or 64(2) of the European Union Trade Mark Regulation.

(1B) Where subsection (1) or (1A) applies, the later registered trade mark is not infringed by the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later registered trade mark.”.

(4) In subsection (2)(a) for “a person” substitute “an individual”.

(5) In subsection (2)(b) for “indications concerning” substitute “signs or indications which are not distinctive or which concern”.

(6) In subsection (2)(c) for “where it” substitute “for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use”.

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(a) OJ No L181/15, 29.6.2013, p.1.



### **Non-use as defence in infringement proceedings**

**13.** After section 11, insert—

#### **“11A Non-use as defence in infringement proceedings**

(1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1)(a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.

(2) Subsection (3) applies in relation to an action for infringement of a registered trade mark where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought.

(3) If the defendant so requests, the proprietor of the trade mark must furnish proof—

- (a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in the United Kingdom by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action, or
- (b) that there are proper reasons for non-use.

(4) Nothing in subsections (2) and (3) overrides any provision of section 46, as applied by subsection (1) (including the words after the semi-colon in section 46(3)).”

### **Assignment, &c of registered trade mark**

**14.** In section 24 after subsection (1) insert—

“(1A) A contractual obligation to transfer a business is to be taken to include an obligation to transfer any registered trade mark, except where there is agreement to the contrary or it is clear in all the circumstances that this presumption should not apply.”

### **Application for registration of trade mark as an object of property**

**15.** In section 27(1) after “sections 22 to 26 (which relate to a registered trade mark as an object of property)” insert “and sections 28 to 31 (which relate to licensing)”.

### **Licensing of registered trade mark**

**16.** In section 28 after subsection (4) insert—

“(5) The proprietor of a registered trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in the licence with regard to—

- (a) its duration,
- (b) the form covered by the registration in which the trade mark may be used,
- (c) the scope of the goods or services for which the licence is granted,
- (d) the territory in which the trade mark may be affixed, or
- (e) the quality of the goods manufactured or of the services provided by the licensee.”

### **General provisions as to rights of licensees in case of infringement**

**17.—**(1) Section 30 is amended as follows.

(2) After subsection (1) insert—

“(1A) Except so far as the licence provides otherwise a licensee may only bring proceedings for infringement of the registered trade mark with the consent of the proprietor (but see subsections (2) and (3)).”

(3) In subsection (2), for “A licensee is entitled, unless his licence or any licence through which his interest is derived, provides otherwise, to” substitute “An exclusive licensee may”.

(4) In subsection (3) after “If the proprietor” insert “mentioned in subsection (2)” and before “licensee” insert “exclusive”.

(5) Omit subsection (4).

(6) Omit subsection (5).

(7) After subsection (6), insert—

“(6A) Where the proprietor of a registered trade mark brings infringement proceedings, a licensee who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.”.

### **Application for registration**

**18.** In section 32(2)(d) after “mark” insert “, which is capable of being represented in the register in a manner which enables the registrar and the public to determine the clear and precise subject matter of the protection afforded to the proprietor”.

### **Publication, opposition proceedings and observations**

**19.**—(1) Section 38 is amended as follows.

(2) After subsection (2) insert—

“(2A) Where a notice of opposition is filed on the basis of one or more earlier trade marks or other earlier rights—

- (a) the rights (if plural) must all belong to the same proprietor;
- (b) the notice may be filed on the basis of part, or the totality, of the goods or services in respect of which the earlier right is protected or applied for.

(2B) A notice of opposition may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.”.

### **Registration: supplementary provisions**

**20.**—(1) Section 41 is amended as follows.

(2) After section 41(1)(a) insert—

“(aa) the division of a registration of a trade mark into several registrations;”.

(3) In subsection (3)(b), after each reference to “application” insert “or registration” and after “applications” insert “or registrations”.

### **Renewal of registration**

**21.** In section 43 after subsection (3) insert—

“(3A) If a request for renewal is made or the renewal fee is paid in respect of only some of the goods or services for which the trade mark is registered, the registration is to be renewed for those goods or services only.”.

### **Revocation of registration**

**22.** In section 46(2)—

- (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)”.

### Grounds for invalidity of registration

23.—(1) Section 47(a) 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) omit paragraph (a) and 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 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.”.

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(a) Section 47 was amended by S.I. 2004/946, regulations 3 and 6, S.I. 2008/1067, regulation 3 and S.I. 2011/1043 article 4(1).

### Collective marks

**24.** In section 49, for subsection (1) substitute—

“(1) A collective mark is a mark which is described as such when it is applied for and is capable of distinguishing the goods and services of members of the association which is the proprietor of the mark from those of other undertakings.

(1A) An association of manufacturers, producers, suppliers of services or traders which has the capacity in its own name to enter into contracts and to sue or be sued may be registered as the proprietor of a collective mark.”.

### Certification marks

**25.** In section 50(1) for “indicating” substitute “which is described as such when the mark is applied for and indicates”.

### Meaning of “European Union trade mark”

**26.** In section 51(a) omit “Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union Trade Mark” and substitute “Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark(b).”.

### Power to make provision in connection with European Union Trade Mark Regulation

**27.—**(1) Section 52(c) is amended as follows.

(2) In subsection (3)(b) omit “Article 93” and substitute “Article 120”.

(3) In subsection (3A) omit “Council Regulation (EC) No 40/94 of 20th December 1993 on the Community trade mark” and substitute “Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union Trade Mark(d).”.

### Acts of agent or representative: Article 6septies

**28.** Omit section 60.

### Infringing goods, material or articles may be treated as prohibited goods

**29.** In section 89(3) for “Article 5(1) of Council Regulation (EC) No 1383/2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights” substitute “Article 3 of the European Customs Enforcement Regulation”.

### Reproduction of trade marks in dictionaries, encyclopaedias etc.

**30.** After section 99, insert—

#### “99A Reproduction of trade marks in dictionaries, encyclopaedias etc.

(1) Subsection (2) applies if the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered.

(a) Section 51 was amended by S.I. 2016/299, regulation 4.

(b) OJ No L154/1, 16.6.2017, p.1.

(c) Section 52 was amended by S.I. 2016/299, regulation 5.

(d) OJ No L78, 24.3.2009, p.1; as amended by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015, OJ No. L341, 24.12.2015, p.21.

(2) The publisher of the work must, at the request of the proprietor of the trade mark, ensure that the reproduction of the trade mark is accompanied by an indication that it is a registered trade mark.

(3) The action required by subsection (2) must be taken—

- (a) without delay, and
- (b) in the case of works in printed form, at the latest in the next edition of the publication.

(4) If the publisher fails to take any action required by subsection (2) the court may, on an application by the proprietor—

- (a) order the publisher to take the action concerned;
- (b) if the work is in printed form, order the publisher to secure the destruction of copies of the work in the publisher's possession, custody or control.”.

### **Index of defined expressions**

**31.** In section 104 after the entry in the table for “earlier trade mark” insert—

|  |              |
|--|--------------|
| “European Customs Enforcement Regulation | section 10A” |
|--|--------------|

### **Schedule 1 - Collective marks**

**32.**—(1) Schedule 1 is amended as follows.

(2) In paragraph 5—

- (a) in subparagraph (2) omit “, where they exist,”;
- (b) the second sentence of subparagraph (2) is renumbered as subparagraph (4), and
- (c) before subparagraph (4) insert—

“(3) Where the regulations govern use of a mark referred to in paragraph 3(1), they must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.”.

(3) In paragraph 6(1)(a) after “paragraph 5(2)” insert “and (3)”.

(4) In paragraph 12—

- (a) for subparagraph (2), substitute—

“(2) Subject to any agreement to the contrary between the authorised user and the proprietor, an authorised user may only bring proceedings for infringement of a registered collective mark with the consent of the proprietor.”;

- (b) omit subparagraph (3);
- (c) omit subparagraph (4);
- (d) omit subparagraph (5);
- (e) after subparagraph (6), insert—

“(7) Where the proprietor of a registered collective mark brings infringement proceedings, an authorised user who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.”.

(5) In paragraph 13—

- (a) in subparagraph (a), for “proprietor” substitute “persons authorised to use it”;
- (b) in subparagraph (b), for “has failed to observe, or to secure the observance of,” substitute “has not taken reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in” and after “mark” insert “(as amended from time to time)”;

- (c) in subparagraph (c)(i), after “paragraph 5(2)” insert “and (3)”.
- (6) In paragraph 14—
  - (a) for “may” substitute “shall”;
  - (b) after “the provisions of” insert “section 49(1A) (definition of who may be registered as the proprietor of a certification mark) or”;
  - (c) after “6(1)” insert “unless the breach was only of paragraph 6(1) and the proprietor of the mark, by amending the regulations governing use, complies with the requirements of paragraph 6(1)”.

## PART 3

### Amendments to the Rules

#### Amendments to the Rules

**33.** The Rules are amended in accordance with regulations 34 to 42.

#### Application for registration: section 32 (Form TM3)

**34.** For rule 5(6) substitute—

“(6) The Registrar may at any time—

- (a) suspend the right of applicants to file a request for expedited examination under paragraph (2) (“the expedited examination service”) for such period as the registrar deems fit; and
- (b) resume the expedited examination service.

(7) Where the registrar suspends or resumes the expedited examination service pursuant to paragraph (6), the registrar must publish a notice on the Office website—

- (a) of the date from which the expedited examination service is suspended;
- (b) of the date upon which the expedited examination service will resume.”.

#### Application may relate to more than one class and shall specify the class (Form TM3A)

**35.**—(1) Rule 8 is amended as follows.

(2) In paragraph (2)(b) omit “in such a way as to indicate clearly the nature of those goods or services” and insert “with sufficient clarity and precision to enable the registrar and economic operators, on that sole basis, to determine the extent of the protection sought”.

(3) After paragraph (2) insert—

“(2A) For the purposes of paragraph (2)(b) an application may specify the general indications included in the class headings of the Nice Classification or other general terms provided that they satisfy the requirement that the goods or services be described with sufficient clarity and precision referred to in paragraph (2)(b).

(2B) Where the specification contained in the application describes the goods or services using general terms, including the general indications included in the class headings of the Nice Classification, the application shall be treated as including only the goods or services clearly covered by the literal meaning of the term or indication.”.

(4) After paragraph (4) insert—

“(5) In this rule “economic operators” means any person or group of persons which, in the course of trade, manufactures, supplies, imports or exports goods or services.”.

### **Determination of classification**

**36.** In rule 9(3)—

- (a) after “under paragraph (2),” insert “the registrar must reject”; and
- (b) omit “, shall be treated as abandoned”.

### **Opposition proceedings: filing of notice of opposition**

**37.** In rules 17(5)(d) and 17A(6)(e) for “date of publication” substitute “date of application for registration or, if any, the date of priority”.

### **Division of registration**

**38.** After rule 26 insert—

#### **“26A Division of registration; section 41 (Form [ ])**

(1) The proprietor of a trade mark may request the registrar on Form [ ] to divide the specification of the registration (the original registration) into two or more separate trade marks (divisional registrations), indicating for each divisional registration the specification of goods or services.

(2) Each divisional registration must be treated as a separate registration with the same date of registration as the original registration.

(3) No application under paragraph (1) may be granted in respect of the registration of a trade mark which is the subject of proceedings for its revocation or invalidation, or in respect of which a counterclaim for its revocation or invalidation is brought, where the application would introduce a division amongst the goods or services in respect of which the proceedings or counterclaim are directed.

(4) Where the original registration is subject to a disclaimer or limitation, the divisional registrations must also be restricted accordingly.

(5) Where the original registration has had registered in relation to it particulars relating to the grant of a licence or a security interest or any right in or under it, or of any memorandum or statement of the effect of a memorandum, the registrar must enter in the register the same particulars in relation to each of the divisional registrations into which the original registration has been divided.”

### **Reminder of renewal of registration; section 43**

**39.**—(1) Rule 34 is amended as follows.

(2) In paragraph (1)—

- (a) omit “at any time not earlier than six months nor later than one month” and substitute “at least six months”;
- (b) omit “(except where renewal has already been affected under rule 35)”.

(3) After paragraph (2) insert—

“(2A) The registrar is not subject to any liability by reason of any failure to notify the proprietor in accordance with paragraph (1) and no proceedings lie against any officer of the registrar in respect of any such failure.”.

### **Renewal of registration; section 43 (Form TM11)**

**40.** In rule 35, after “expiration of the registration” insert “or following receipt of a notice from the registrar pursuant to rule 34(1)”.



**Restoration of registration; section 43 (Form TM13)**

**41.**—(1) Rule 37 is amended as follows.

(2) In paragraph (1) omit “if, having regard to the circumstances of the failure to renew, the registrar is satisfied that it is just to do so” and substitute “if the registrar is satisfied that the failure to renew was unintentional”.

(3) After paragraph (1) insert—

“(1A) Where a mark is restored to the register, the proprietor of the mark may not bring an action for infringement against a third party who, in good faith, has put goods on the market or supplied services under a sign which is identical with or similar to the mark in respect of the period beginning with the date of expiration of the registration and ending on the date its restoration is published in accordance with paragraph (2).”.

**Entry in register of particulars of registered trade marks; section 63(2) (Form TM24)**

**42.** In Rule 47, after paragraph (1) insert—

“(m)where the mark is a collective mark and amended regulations have been accepted by the registrar, that fact, including the date of that entry.”.

**PART 4****Amendments to the CTM Regulations and the International Registration Order****Amendments to the CTM Regulations**

**43.** The CTM Regulations are amended in accordance with regulations 44 to 48.

**Determination of invalidity and liability to revocation in relation to claims of seniority**

**44.** In regulation 3(3) after “liable” insert “as at the date of such removal or surrender”.

**Remedies in infringement proceedings**

**45.** In regulation 5(1), for “Article 102(1)” substitute “Article 130(1)”.

**Conversion**

**46.**—(1) Regulation 10 is amended as follows.

(2) In paragraph (1), for “Article 112” substitute “Article 139”.

(3) In paragraph (1)(b), for “Article 159(1)(a)” substitute “Article 202(1)(a)”.

(4) In paragraph (2), for “Article 113(3)” substitute “Article 140(5)”.

**Privilege for communications with those on the list of professional trade marks representatives**

**47.** In regulation 11(3), for “Article 93” substitute “Article 120”.

**Designation of Community trade mark courts**

**48.**—(1) Regulation 12 is amended as follows.

(2) In paragraph (1), for “Article 95” substitute “Article 123(1)”.

(3) At the end of paragraph (1)(a)(i) insert “and”.

(4) Omit paragraph (1)(a)(ii).



**Amendments to the International Registration Order**

49. The International Registration Order is amended in accordance with regulations 50 to 51.

**Provisions of the Act and Trade Mark Rules which do not apply to International Trade Marks (UK) or requests for extension**

50. In Part 2 of Schedule 1, after the entry in the table relating to “trade marks rule 13 (deficiencies in application; section 32)” insert—

“trade marks rule 28 (registration of a series of trade marks; section 41 (Form TM12)).”.

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

51. In paragraph 6 of Schedule 2 inserting section 38(B)(3) of the 1994 Act, omit “section 46(1)” and substitute “sections 6A, 11A, 46(1) and 47(2A)”.

**PART 5****Transitional Provisions****Transitional Provisions**

52.—(1) Anything done or having effect as if done under, for the purposes of, or in reliance on the old Regulation or a provision of the old Regulation has effect, so far as necessary for continuing its effect after the coming into force of these Regulations, as if done under, for the purposes of, or in reliance on the current Regulation or the corresponding provision of that Regulation.

(2) In this regulation—

- (a) “the old Regulation” means Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union Trade Mark;
- (b) “the current Regulation” means Regulation (EU) No 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark.

**Saving provision**

53. Subject to the amendments made by regulations 44 to 48, any regulations made under section 52 of the 1994 Act which have effect immediately before the coming into force of these Regulations have effect after then as if made under that section as amended by these Regulations.

*Name*

Minister of State for [ ]

Date

Department for Business, Energy and Industrial Strategy

**EXPLANATORY NOTE**

*(This note is not part of the Regulations)*

These Regulations make provision for the implementation of Directive 2015/2436<sup>(a)</sup> of the European Parliament and of the Council of 23 December 2015 to approximate the laws of Member States relating to trade marks.

Part 2 of these Regulations amends the 1994 Act.

[Description of effect of regulations]

A full impact assessment of the effect that this instrument will have on the costs of business, the voluntary sector and the public sector is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, NP10 8QQ and is annexed to the Explanatory Memorandum (together with a transposition note) which is available alongside the instrument on [www.legislation.gov.uk](http://www.legislation.gov.uk).

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<sup>(a)</sup> OJ No L336, 23.12.2015, p 1.



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