

Draft Regulations laid before Parliament under paragraph 6(1) of Schedule 5 to the European Union (Future Relationship) Act 2020, for approval by resolution of each House of Parliament.

DRAFT STATUTORY INSTRUMENTS

2022 No.

TRADE MARKS

The Trade Marks (Amendment) Regulations 2022

Made - - - - *******

Coming into force in accordance with regulation 1

The Secretary of State in exercise of powers conferred by section 31(1)(a) of the European Union (Future Relationship) Act 2020(1) makes the following Regulations.

A draft of these Regulations has been approved by resolution of each House of Parliament pursuant to paragraph 6(1) of Schedule 5 to the European Union (Future Relationship) Act 2020.

Citation and commencement

1. These Regulations may be cited as the Trade Marks (Amendment) Regulations 2022 and come into force on the twenty-first day after the day on which they are made.

Amendments to the Trade Marks Act 1994

2. The Trade Marks Act 1994(2) is amended in accordance with regulations 3 to 5.
3. In section 56(1)(3)—
 - (a) in paragraph (a), after “national of” insert “the United Kingdom or”, and
 - (b) in paragraph (b), after “establishment in,” insert “the United Kingdom or”.
4. In section 56(2), for the words from “his mark” to “confusion” substitute—

“the well known trade mark—

 - (a) in relation to identical or similar goods or services, where the use is likely to cause confusion, or
 - (b) where the well known trade mark has a reputation in the United Kingdom and the use of the other trade mark—
 - (i) is without due cause, and

(1) [2020 c. 29](#). See section 37 of that Act for a definition of “relevant national authority”.
(2) [1994 c. 26](#).
(3) Section 56 was amended by [S.I. 1999/1899](#).

(ii) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the well known trade mark”.

5. After section 56(2) insert—

“(2A) Subsection (2)(b) applies irrespective of whether the goods or services in relation to which the other trade mark is used are identical with, similar to or not similar to those for which the well known trade mark is entitled to protection.”.

Date

Name
Title
Department for Business, Energy and Industrial
Strategy

EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations are made in exercise of the power conferred by section 31(1) of the European Union (Future Relationship) Act 2020 (c. 29).

Regulation 3 amends section 56(1) of the Trade Marks Act 1994 (c. 26) (“the Act”) so as to provide that references in the Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement include a mark which is well-known in the United Kingdom as being the mark of a national of the United Kingdom or a person who is domiciled in or has a real and effective industrial commercial establishment in the United Kingdom.

Regulations 4 and 5 amend section 56(2) of the Act and insert new subsection (2A). These extend the right of a proprietor of a well known trade mark (as referred to in section 56(1)) to restrain the use in the United Kingdom of a trade mark which is identical or similar to the well known trade mark irrespective of whether the goods or services are identical with, similar to or not similar to those for which the well known trade mark is protected, provided that the well known trade mark has a reputation in the United Kingdom and the use of the other trade mark, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the well known trade mark.

A full impact assessment has not been produced for this instrument as no, or no significant, impact on the private, voluntary or public sectors is foreseen. A copy of this instrument together with the Explanatory Memorandum is available on the Legislation UK website www.legislation.gov.uk. A copy of this instrument, together with the Explanatory Memorandum, is also available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, NP20 8QQ.