

2002 No. 692

TRADE MARKS

The Trade Marks (International Registration)  
(Amendment) Order 2002

Made - - - - -	14th March 2002
Laid before Parliament	14th March 2002
Coming into force - -	4th April 2002

The Secretary of State, in exercise of the powers conferred by section 54 of the Trade Marks Act 1994(a), hereby makes the following Order:

Citation, commencement and extent

1.—(1) This Order may be cited as the Trade Marks (International Registration) (Amendment) Order 2002 and shall come into force on 4th April 2002.

(2) This Order extends to England and Wales, Scotland, Northern Ireland and the Isle of Man.

Amendment of the Trade Marks (International Registration) Order 1996

2. The Trade Marks (International Registration) Order 1996(b) (“the Principal Order”) shall be amended as set out in articles 3 to 11.

3. In article 2 at the end of the definition of “Common Regulations” there shall be inserted “as amended with effect from 1st April 2002”.

4. In article 4—

(a) in paragraph (4)(a), after the words “trade mark” there shall be inserted “in the United Kingdom”;

(b) for paragraph (5) there shall be substituted—

“Where an international registration contains a disclaimer of any right to the exclusive use of any specified element of the trade mark or where a protected international trade mark (UK) is subject to a disclaimer or limitation by virtue of a notice sent to the registrar under paragraph (4) above, the rights conferred in relation to it by the application of section 9 are restricted accordingly.”.

5. In article 6—

(a) for paragraph (1) there shall be substituted—

“(1) The granting of any security interest (whether fixed or floating) over an international trade mark (UK) or any right in or under it is a notifiable transaction for the purposes of this article.”;

(b) after paragraph (3)(b) there shall be inserted—

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(a) 1994 c. 26.

(b) S.I. 1996/714 amended by S.I. 2000/138.

“(bb) the grant of a licence under an international trade mark (UK);”;

(c) for paragraph (5) there shall be substituted—

“(5) Where a person becomes the proprietor or licensee of an international trade mark (UK) by virtue of a relevant transaction, then unless—

(a) a request for recordal in the International Register is made before the end of a period of six months beginning with its date, or

(b) the court is satisfied that it was not practicable for such a request for recordal to be made before the end of that period and that a request for recordal was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the international trade mark (UK) occurring after the date of the transaction and before the transaction is recorded in the International Register.”.

6. In article 9—

(a) in paragraph (3), for the words “notice of refusal” there shall be substituted “notice of provisional refusal”; and

(b) in paragraph (4), for the words “Notice of refusal” there shall be substituted “Notice of provisional refusal”.

7. In article 10—

(a) in paragraph (3), for the words “notice of refusal” there shall be substituted “notice of provisional refusal”; and

(b) in paragraph (4), for the words “notice of refusal” there shall be substituted “notice of provisional refusal”.

8. For article 11 there shall be substituted—

“Notices of provisional refusal

11.—(1) Except where provisional refusal is based on an opposition, notice of provisional refusal shall not be given after the expiry of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom.

(2) The registrar shall inform the International Bureau that oppositions may be filed after the expiry of the period of 18 months referred to in paragraph (1) above unless, at least four months before the expiry of the said period, he has published the notice referred to in article 10(1).

(3) Notices of provisional refusal shall set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.

(4) Where the registrar has given notice of provisional refusal to the International Bureau pursuant to article 9(3) or 10(3), the registrar shall, upon deciding whether the provisional refusal shall be upheld, in whole or in relation to some only of the goods or services in relation to which protection in the United Kingdom is requested, notify the International Bureau of that decision.

(5) Where, after a decision of the registrar has been notified to the International Bureau pursuant to paragraph (4) the decision is referred to an appointed person or the court on appeal or further appeal from the registrar, the registrar shall notify the International Bureau of the decision of that person or court.”.

9.—(1) Article 12 shall be amended as follows.

(2) For paragraph (1) there shall be substituted—

“(1) Where the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom expires without any notice of provisional refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period, the trade mark which is the subject of the request for protection shall thereupon be protected as a protected international trade mark (UK).

(1A) Subject to paragraph (1), where particulars of an international registration have been published pursuant to article 10(1) in respect of all or some of the goods or services comprised in the international registration and the period for giving notice of opposition in accordance with article 10(2) expires without notice of opposition having been given in

respect of any of the goods or services specified in the notice published pursuant to article 10(1) and without notice of refusal not based on an opposition having been given and not withdrawn, the trade mark which is the subject of the international registration in question shall thereupon be protected as a protected international trade mark (UK) in respect of those goods or services.

(1B) Subject to paragraph (1), where particulars of an international registration have been published pursuant to article 10(1) in respect of all or some of the goods or services comprised in the international registration and on expiry of the period for giving notice of opposition in accordance with article 10(2) notice of opposition has been given in respect of some only of the goods or services specified in the notice published pursuant to article 10(1) and no notice of refusal not based on an opposition has been given and not withdrawn in respect of the remaining goods or services specified in that notice, the trade mark which is the subject of the international registration in question shall thereupon be protected as a protected international trade mark (UK) in respect of those remaining goods or services.

(1C) Subject to paragraph (1), where particulars of an international registration have been published pursuant to article 10(1) in respect of all or some of the goods or services comprised in the international registration and within the period for giving notice of opposition in accordance with article 10(2) notice of opposition has been given in respect of all or some of the goods or services specified in the notice published pursuant to article 10(1) but subsequently a final decision is made that the notice of provisional refusal given as a result of that opposition is withdrawn, or is withdrawn in respect of some of the goods or services in respect of which protection in the United Kingdom has been requested, the trade mark which is the subject of the international registration in question shall thereupon be protected as a protected international trade mark (UK) in respect of the goods or services specified in the notice published pursuant to article 10(1) other than those in respect of which a notice of refusal (whether based on an opposition or otherwise) continues to subsist.

(1D) For the purposes of paragraph (1C) a final decision shall be regarded as being made where the registrar, or the appointed person or the court on appeal or further appeal from the registrar, decides whether the refusal shall be upheld, in whole or in relation to some only of the goods or services in relation to which protection in the United Kingdom is requested, and any right of appeal against that decision expires or is exhausted.”.

(3) For paragraph (3) there shall be substituted—

“(3) When a trade mark becomes protected pursuant to this article, the registrar shall publish a notice specifying the number of the international registration in respect of that trade mark, the date on which protection is conferred and the date and place of publication of the notice published under article 10(1) in relation to that trade mark.”.

10. After article 12 there shall be inserted—

“Correction of international registration

12A.—(1) This article applies where the International Bureau notifies the registrar pursuant to Rule 28 of the Common Regulations that it has corrected an international registration designating the United Kingdom and the correction—

- (a) substantially affects the identity of the trade mark; or
- (b) reduces or extends the goods or services comprised in the international registration.

(2) The registrar may treat a notification of correction to which this article applies as a new notification of an international registration designating the United Kingdom and where a notification of correction is so treated—

- (a) if the correction substantially affects the identity of the trade mark, paragraph (3) below shall apply; or
- (b) if the correction reduces or extends the goods or services comprised in the international registration, paragraph (4) below shall apply.

(3) Where this paragraph applies in accordance with paragraph (2), articles 9 to 12 shall apply to the notification of correction as if it were a new notification of an international registration designating the United Kingdom and—

- (a) if the trade mark which is the subject of the international registration has not

become a protected international trade mark (UK) before receipt of the notification of correction in relation to it, the original notification of that international registration to the registrar shall be treated as having been withdrawn;

- (b) if the trade mark which is the subject of the international registration has become a protected international trade mark (UK) before receipt of the notification of correction in relation to it, the protection conferred by article 12 in respect of that trade mark shall cease on receipt of the notification of correction but this shall not affect transactions past and closed as at that date.
- (4) Where this paragraph applies in accordance with paragraph (2)—
- (a) articles 9 to 12 shall apply to the notification of correction as if it were a new notification of an international registration designating the United Kingdom so far as it relates to goods or services not previously comprised in the international registration; and
  - (b) if the trade mark which is the subject of the international registration has become a protected international trade mark (UK) before receipt of the notification of correction in relation to it, the protection conferred by article 12 in respect of that trade mark so far as it relates to goods or services which are no longer comprised in the international registration shall cease on receipt of the notification of correction but this shall not affect transactions past and closed as at that date.”.

11. In paragraph (1)(a) of article 24, at the end there shall be inserted “made under article 4(4)”.

#### Transitional Provisions

12.—(1) Where an application has been made to the registrar under article 6(2) of the Principal Order before the commencement of this Order in relation to the grant of a licence under a protected international trade mark (UK), article 6 of the Principal Order as it has effect immediately before the commencement of this Order shall continue to apply and accordingly, if prescribed particulars of the transaction have not been entered in the supplementary register, they shall be entered in that register and the transaction shall continue to be treated as a notifiable transaction for the purposes of paragraphs (4) and (5) of article 6 (as they have effect immediately before the commencement of this Order).

13. Where before the commencement of this Order the registrar has given notice of refusal to the International Bureau pursuant to article 9(3) or 10(3) of the Principal Order but has not notified the International Bureau of a final decision in relation to that refusal, article 11(4) of the Principal Order as amended by this Order shall apply as if the notice of refusal so given to the International Bureau was a notice of provisional refusal pursuant to article 9(3) or 10(3) of the Principal Order as amended by this Order.

Melanie Johnson,  
Parliamentary Under Secretary of State for  
Competition, Consumers and Markets,  
Department of Trade and Industry

14th March 2002

## EXPLANATORY NOTE

(This note is not part of the Order)

This Order amends the Trade Marks (International Registration) Order 1996 (S.I. 1996/714) (“the Principal Order”) as amended by the Trade Marks (International Registration) (Amendment) Order 2000 (S.I.2000/138) as a consequence of the amendment of the Common Regulations adopted under article 10 of the Madrid Protocol having effect from 1st April 2002.

The amendments of substance made by this Order are as follows:

- (a) article 4 amends article 4 of the Principal Order as a consequence of new provisions enabling applicants for international registration of trade marks under the Madrid Protocol to disclaim rights to exclusive use of specified elements of a mark;
- (b) article 5 amends article 6 of the Principal Order as regards the grant of a licence under an international trade mark designating the UK to reflect new provisions for the recording of such licences in the international register of trade marks maintained by the International Bureau of the World Intellectual Property Organisation for the purposes of the Madrid Protocol;
- (c) article 8 substitutes a new article 11 of the Principal Order as a consequence of new requirements for notification by Contracting Parties to the Madrid Protocol of provisional refusals to protect an international trade mark designating the UK (and consequential amendments are made to articles 9, 10 and 12 of the Principal Order);
- (d) article 10 inserts a new article 12A into the Principal Order as a consequence of new provisions regarding the correction of the international register of trade marks.

Articles 12 and 13 make transitional provisions.

The Madrid Protocol is published as Cm 3505 Treaty Series No 3(1997). Copies of the Common Regulations are available from: WIPO P.O. Box 18 CH—1211 Geneva 20 Switzerland.

A regulatory impact assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Intellectual Property Policy Directorate of the Patent Office, Room 3B38, Concept House, Cardiff Road, Newport NP10 8QQ.





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