
EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations amend the Trade Marks Act 1994 (“the 1994 Act”) and the Community Trade Mark Regulations 1996 (S.I. [1996/1908](#), amended by S.I. [2004/949](#)) (“the 1996 Regulations”). Part I of the 1994 Act implements First Council Directive [89/104/EEC](#) to approximate the laws of the Member States relating to trade marks (OJ No L 40, 11.2.1989, p.1) (“the First Directive”). The 1996 Regulations make provision for the operation of Council Regulation (EC) No 40/94 on the Community trade mark (OJ No 11, 14.1.1994, p.1) (“Regulation 40/94”).

Part 1 provides for citation, commencement and interpretation.

Part 2 makes amendments to the 1994 Act and the 1996 Regulations which are necessary as a result of the accession of the European Community to the Protocol to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on 27th June 1989 (“the Madrid Protocol”). For the purposes of the United Kingdom’s own ratification of the Madrid Protocol, the Protocol is given effect in the United Kingdom by the Trade Marks (International Registration) Order 1996 (S.I. [1996/714](#), amended by S.I. [2000/138](#), [2002/692](#) and [2004/948](#)). The Madrid Protocol is published as Cm 1601 Miscellaneous Series No 14 (1991).

Article 14 of the Madrid Protocol permits an intergovernmental organisation such as the European Community to sign or accede to the Protocol, provided that the organisation has a regional office for the purposes of registering marks with effect in the territory of the organisation. A Community trade mark registered at the Office for Harmonization in the Internal Market (trade marks and designs), under Regulation 40/94, does indeed have effect in the territory of the Community. The amendments to Regulation 40/94 which were necessary to give effect to the Community’s accession were made by Council Regulation (EC) No [1992/2003](#) (OJ No L 296, 14.11.2003, p.1), which enters into force on the date on which the Madrid Protocol enters into force with respect to the European Community (1st October 2004).

As a result of the Community’s accession to the Madrid Protocol, it will be possible for applicants for a Community trade mark, and proprietors of such trade marks, to apply for international protection of their marks by making an application under that Protocol; and, conversely, for holders of an international registration under the Madrid Protocol to apply for protection of their marks under the Community trade mark system. An international registration designating the Community has, from the date of its registration or of the subsequent designation of the Community, the same effect as an application for a Community trade mark; and if no refusal is notified in accordance with Article 5 of the Protocol, or any such refusal is withdrawn, the registration has the same effect as the registration of a mark as a Community trade mark.

These Regulations introduce into the 1994 Act, and into the 1996 Regulations, a definition of “international trade mark (EC)”: this is defined to be a trade mark which is entitled to protection in the European Community under the Madrid Protocol. Thus a new category of international trade mark having effect in the United Kingdom is given recognition alongside the category “international trade mark (UK)” as defined by section 53 of the 1994 Act.

Regulations 3 and 4 amend the 1994 Act to update the United Kingdom’s implementation of Article 4 of the First Directive, by taking into account the existence of that new category of trade mark in defining the meaning of “earlier trade mark”.

Thus, by the amendment made to section 6(1)(a) by *regulation 4*, an international trade mark (EC) which has an earlier application date than another mark is defined to be an “earlier trade mark” for the

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purposes of the Act (and hence in particular for the purposes of a refusal of registration of the other mark under section 5 or a declaration of invalidity under section 47(2)). This regulation also amends section 6(1) to make it clear that an international trade mark (EC) may enjoy the seniority of an earlier trade mark registered under the 1994 Act (or of an international trade mark (UK)) pursuant to the new Article 148 of Regulation 40/94, and that such seniority will be preserved on any subsequent conversion (under Article 154(1) of that Regulation) of the international trade mark (EC) into an international trade mark (UK) or a trade mark registered under the Act, as well as on the conversion of a Community trade mark. The seniority of a trade mark is an attribute which enables the rights attaching to an earlier identical trade mark to be preserved even where the latter is surrendered or allowed to lapse.

The amendment made to section 5(3) by *regulation 3* is a consequential amendment which ensures that the “reputation” of an earlier trade mark which is to be taken into account for the purposes of that subsection is, in the case of an international trade mark (EC), its reputation in the European Community.

Regulations 5 and 6 make provision for the definition in the 1994 Act of the expression “international trade mark (EC)”.

Regulations 8 to 14 make amendments to the 1996 Regulations which are necessary, in particular, to ensure that relevant provisions of those Regulations apply to an international trade mark (EC) as they apply to a Community trade mark.

Thus *regulation 9* amends regulation 3 of the 1996 Regulations to permit an application to be made to contest the seniority of an international trade mark (EC). It also amends that regulation to take into account the possibility of claiming seniority from an international trade mark (UK).

Regulation 10 extends the provisions of the 1994 Act relating to groundless threats, to threats to bring infringement proceedings in relation to an international trade mark (EC).

Regulations 11 and 12 similarly extend provisions relating to the control of the importation of infringing goods, and to offences and enforcement powers concerning counterfeit goods. Regulation 7 of the 1996 Regulations is also amended in order to take into account section 92A of the 1994 Act, which was inserted by the Copyright, etc. and Trade Marks (Offences and Enforcement) Act 2002.

Regulation 13 creates an offence of falsely representing a trade mark as an international trade mark (EC).

Regulation 14 substitutes a new version of regulation 10 in the 1996 Regulations, in order to provide for the conversion of an international registration designating the Community into an application for a trade mark under the 1994 Act, under the new Article 154(1)(a) of Regulation 40/94. The new version also takes into account the amendments to Article 109(3) and 110(1) of Regulation 40/94 made by Article 1 of Council Regulation (EC) No 422/2004 (OJ No L 70, 9.3.2004, p.1). Those amendments give to the Office for Harmonization in the Internal Market the competence to decide on the admissibility of a conversion application, both in the case of the conversion of a Community trade mark (or a Community trade mark application) and in that of the conversion of an international registration designating the Community. (Under the new Article 154(1)(b) of Regulation 40/94, it is also possible to request the conversion of an international registration designating the Community into an international registration designating the United Kingdom.)

Part 3 amends the 1996 Regulations by substituting a new version of regulation 9 designating the Patents County Court and seven other county courts as additional courts having jurisdiction in England and Wales over proceedings arising out of Regulation 40/94.

A partial regulatory impact assessment has been prepared for Part 2 and has been placed in the libraries of both Houses of Parliament.

A regulatory impact assessment has not been prepared for Part 3, but the change should assist small and medium size enterprises by providing improved access to justice.

Changes to legislation: *There are currently no known outstanding effects for the The Trade Marks (International Registrations Designating the European Community, etc.) Regulations 2004. (See end of Document for details)*

A Transposition Note, setting out how these Regulations implement the First Directive and Regulation 40/94, has been placed in the libraries of both Houses of Parliament.

The Transposition Note and the partial regulatory impact assessment are also available from: Mark Bryant, Room 3B46, Trade Marks Directorate, The Patent Office, Concept House, Cardiff Road, Newport, NP10 8QQ.

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