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STATUTORY INSTRUMENTS

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**2008 No. 2206**

**The Trade Marks (International Registration) Order 2008**

**Citation and commencement**

1. This Order may be cited as the Trade Marks (International Registration) Order 2008 and shall come into force on 1st October 2008.

**Interpretation**

2. In this Order—

“the Act” means the Trade Marks Act 1994 and “section” means a section of that Act;

“Common Regulations” means the regulations adopted under article 10 of the Madrid Protocol with effect from 1 April 1996 and as amended with effect from 1 April 2002;

“concurrent registered trade mark” means a trade mark as defined in Schedule 4, paragraph 2;

“date of the international registration” means the date of the international registration under Article 3(4) of the Madrid Protocol;

“international application” means an application by way of the Patent Office as office of origin to the International Bureau for registration of a trade mark in the International Register;

“International Register” means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol;

“international registration” means a registration of a trade mark in the International Register;

“protected international trade mark (UK)” means an international registration which is the subject of a request for extension and which is protected in accordance with section 38 as modified by Schedule 2, paragraph 6 and references to “protection” and “protected” shall be construed accordingly;

“request for extension” means a request for an extension of protection to the United Kingdom under Article 3<sup>ter</sup> (1) or (2) of the Madrid Protocol which has been notified by the International Bureau;

“the Relative Grounds Order” means the Trade Marks (Relative Grounds) Order 2007(1);

“supplementary register” means the register of international trade marks (UK) required to be maintained under section 63 as modified by Schedule 2, paragraph 8 ;

“the Trade Marks Rules” means the Trade Marks Rules 2008(2) and “trade marks rule” shall be construed accordingly.

**International trade marks (UK)**

3.—(1) An international registration which is the subject of a request for extension shall be entitled to protection subject to the provisions of the Act, the Relative Grounds Order and the Trade Marks Rules as applied by this Order if the particulars of the request for extension were contained

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(1) [S.I. 2007/1976](#).

(2) [S.I. 2008/1797](#).

in an application for registration of a trade mark under the Act and such application would satisfy the requirements of the Act (including any imposed by the Trade Mark Rules).

(2) Subject to paragraph (3) a protected international trade mark (UK) shall be treated as if it were a trade mark registered under the Act and the holder shall have the same rights and remedies but shall be subject to the same conditions as the proprietor of a registered trade mark.

(3) The provisions of the Act (except those listed in Schedule 1, Part 1), the Relative Grounds Order and the Trade Marks Rules (except those listed in Schedule 1, Part 2) shall apply to international trade marks (UK) and requests for extension with the following modifications;

- (a) references to a registered trade mark shall include references to a protected international trade mark (UK);
- (b) references to a proprietor of a registered trade mark shall include references to the holder of a protected international trade mark (UK);
- (c) references to an application for registration of a trade mark shall include references to a request for extension;
- (d) references to an applicant for registration shall include references to the holder of an international registration in respect of which a request for extension has been made;
- (e) references to registration of a trade mark shall include the conferring of protection on an international registration which is the subject of a request for extension;
- (f) references to the goods or services for which a trade mark is registered shall include references to the goods or services in respect of which a protected international trade mark (UK) confers protection;
- (g) references to the publication of the application include references to the publication of the notice of details of the international registration in the Journal;
- (h) references to the register are to the supplementary register;
- (i) the modifications set out in Schedule 2; and
- (j) such further modifications as the context requires for the purpose of giving effect to those provisions as applied by this Order.

#### **International applications originating in the United Kingdom**

4. The provisions set out in Schedule 3 shall apply in relation to the making of applications for international registration by way of the Patent Office as office of origin.

#### **Concurrent registrations and transformation applications**

5. The provisions set out in Schedule 4 shall apply in relation to—
- (a) the effects of international registration where a trade mark is also registered under the Act; and
  - (b) the transformation of an application for an international registration, or an international registration, into an application for registration of a trade mark under the Act.

#### **Miscellaneous and General Provisions**

6. The provisions set out in Schedule 5 shall apply.

#### **Fees**

7. The fees to be paid in respect of any matters arising under this Order shall be those specified in Schedule 6.

### **Revocations and transitional provisions**

8.—(1) The instruments set out in Schedule 7 are revoked (“the previous Orders”).

(2) Where immediately before this Order comes into force any time period prescribed by the previous Orders has effect in relation to any act or proceeding and has not expired, the time or period prescribed by the previous Orders and not by this Order shall apply to that act or proceeding.

(3) Except as provided by paragraph (4), where a new step is to be taken on or after 1st October 2008 in relation to any proceedings commenced under the previous Orders this Order shall apply to such proceedings from that date.

(4) Subject to paragraph (5), where prior to the entry into force of this Order:

- (a) A Form TM8 and counter-statement have been filed in
  - (i) opposition proceedings; or
  - (ii) proceedings for the revocation of a trade mark on the grounds set out in section 46(1)(c) or (d); or
  - (iii) invalidation proceedings; or
- (b) an application for revocation of a trade mark on the grounds set out in section 46(1)(a) or (b) has been filed,

the previous Orders shall apply with regard to the filing of any evidence in relation to those proceedings.

(5) Where proceedings as described in paragraph (4) are consolidated with proceedings commenced on or after 1st October 2008 this Order shall apply with regard to the filing of any evidence in relation to those consolidated proceedings.

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13th August 2008