



Trade Marks Act 1994

1994 CHAPTER 26

PART II

[^{F1}EUROPEAN UNION] TRADE MARKS AND INTERNATIONAL MATTERS

The Madrid Protocol: international registration

53 The Madrid Protocol.

In this Act—

“the Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989;

“the International Bureau” has the meaning given by Article 2(1) of that Protocol; and

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...

“international trade mark (UK)” means a trade mark which is entitled to protection in the United Kingdom under that Protocol.

Textual Amendments

- F1** Words in s. 53 omitted (31.12.2020) by virtue of [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019](#) (S.I. 2019/638), reg. 1, **Sch. 8 para. 18** (with reg. 10(2), 10A) (as amended (26.11.2021) by [S.I. 2021/1235](#), regs. 6, 7); 2020 c. 1, **Sch. 5 para. 1(1)**

54 Power to make provision giving effect to Madrid Protocol.

- (1) The Secretary of State may by order make such provision as he thinks fit for giving effect in the United Kingdom to the provisions of the Madrid Protocol.
- (2) Provision may, in particular, be made with respect to—

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994,
Cross Heading: The Madrid Protocol: international registration. (See end of Document for details)

- (a) the making of applications for international registrations by way of the Patent Office as office of origin;
 - (b) the procedures to be followed where the basic United Kingdom application or registration fails or ceases to be in force;
 - (c) the procedures to be followed where the Patent Office receives from the International Bureau a request for extension of protection to the United Kingdom;
 - (d) the effects of a successful request for extension of protection to the United Kingdom;
 - (e) the transformation of an application for an international registration, or an international registration, into a national application for registration;
 - (f) the communication of information to the International Bureau;
 - (g) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.
- (3) Without prejudice to the generality of subsection (1), provision may be made by regulations under this section applying in relation to an international trade mark (UK) the provisions of—
- [^{F2}(a) sections 21 to 21F (unjustified threats);]
 - (b) sections 89 to 91 (importation of infringing goods, material or articles); and
 - (c) sections 92, 93, 95 and 96 (offences).
- (4) An order under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

Textual Amendments

- F2** S. 54(3)(a) substituted (1.10.2017) by [Intellectual Property \(Unjustified Threats\) Act 2017 \(c. 14\)](#), **ss. 2(4), 8**; [S.I. 2017/771](#), **reg. 2(1)(b)** (with **reg. 3**)

[^{F3}54A Certain international trade marks protected in the European Union to be treated as registered trade marks

Schedule 2B makes provision for international trade marks protected in the European Union (including certain expired marks) to be treated as registered trade marks with effect from IP completion day and about certain applications for the protection of an international trade mark in the European Union and transformation applications made before IP completion day.]

Textual Amendments

- F3** S. 54A inserted (31.12.2020) by [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/638\)](#), **reg. 1, Sch. 4 para. 2** (as amended by [S.I. 2020/1050](#), **regs. 1(2), 22(a)**); 2020 c. 1, **Sch. 5 para. 1(1)** Edit

Changes to legislation:

There are currently no known outstanding effects for the Trade Marks Act 1994, Cross Heading:
The Madrid Protocol: international registration.