
STATUTORY INSTRUMENTS

2004 No. 2332

**The Trade Marks (International Registrations Designating
the European Community, etc.) Regulations 2004**

PART 2

**INTERNATIONAL REGISTRATIONS
DESIGNATING THE EUROPEAN COMMUNITY**

Amendment of the 1994 Act

2. The 1994 Act is amended as follows.
3. In section 5(3) (earlier trade marks with a reputation), after “Community trade mark” insert “or international trade mark (EC)”.
4. In section 6(1) (meaning of “earlier trade mark”)—
 - (a) in paragraph (a), for “or Community trade mark” substitute “, Community trade mark or international trade mark (EC)”; and
 - (b) for paragraph (b) substitute—
 - “(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),
 - (ba) a registered trade mark or international trade mark (UK) which—
 - (i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and
 - (ii) accordingly has the same claim to seniority, or”.
5. In section 53 (the Madrid Protocol), after the definition of “the International Bureau” insert—

““international trade mark (EC)” means a trade mark which is entitled to protection in the European Community under that Protocol;”.
6. In section 104 (index of defined expressions), after the entry for “the International Bureau”, insert—

“international trade mark (EC)section 53”.

Amendment of the 1996 Regulations

7. The 1996 Regulations are amended as follows.
8. In regulation 2 (interpretation), after the definition of “the Community Trade Mark Regulation” insert—

“the International Bureau”, “international trade mark (EC)”, “international trade mark (UK)” and “the Madrid Protocol” have the meanings given in section 53;

“international application” means an application to the International Bureau for registration of a trade mark in the International Register;

“international application designating the European Community” means an international application in which a request has been made for extension of protection to the European Community under Article 3ter(1) of the Madrid Protocol;

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

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

“international registration designating the European Community” means an international registration in relation to which a request has been made (either in the relevant international application or subsequently) for extension of protection to the European Community under Article 3ter(1) or (2) of the Madrid Protocol.”.

9.—(1) In regulation 3(1) (determination *a posteriori* of invalidity and liability to revocation), after “Community trade mark” insert “or of an international trade mark (EC)”.

(2) After that paragraph insert—

“(1A) Where such a proprietor claims the seniority of an international trade mark (UK) which has been removed from the International Register or surrendered, application may be made to the registrar or to the court by any person for a declaration that, if the international trade mark (UK) had not been so removed or surrendered, its protection would have been liable to be revoked under section 46 or declared invalid under section 47 (as applied by article 13 of the Trade Marks (International Registration) Order 1996(1)).”.

(3) In regulation 3(2), for “a registered” substitute “the”, and after “paragraph (1)” insert “or (1A)”.

(4) In regulation 3(3) and in regulation 3(4), after “paragraph (1)” insert “or (1A)”.

10. For regulation 4 substitute—

“Groundless threats of infringement proceedings

4.—(1) The provisions of section 21 apply in relation to a Community trade mark as in relation to a registered trade mark.

(2) Those provisions apply in relation to an international trade mark (EC), and for this purpose—

- (a) the reference in section 21(3) to the registration of the trade mark shall be treated as a reference to the protection of the international trade mark (EC); and
- (b) the reference in section 21(4) to notification that a trade mark is registered, or that an application for registration has been made, shall be treated as a reference to notification that a trade mark is an international trade mark (EC), or is the subject of an international application or international registration designating the European Community.”.

11. In regulation 6 (importation of infringing goods, material or articles), after both occurrences of “Community trade mark” insert “or an international trade mark (EC)”.

12. In regulation 7 (offences and forfeiture)—

(1) S.I. 1996/714; article 13 was amended by S.I. 2000/138 and 2004/948.

- (a) after “in relation to goods),” insert “section 92A (search warrants)(2),”;
- (b) after each of the first two occurrences of “Community trade mark” insert “or an international trade mark (EC)”;
- (c) after “a Community trade mark is registered” insert “or in respect of which an international trade mark (EC) confers protection in the European Community”.

13. After regulation 8 (falsely representing trade mark as a Community trade mark) insert—

“Falsely representing trade mark as an international trade mark (EC)

8A.—(1) It is an offence for a person—

- (a) falsely to represent that a mark is an international trade mark (EC), or
- (b) to make a false representation as to the goods or services in respect of which an international trade mark (EC) confers protection in the European Community,

knowing or having reason to believe that the representation is false.

(2) A person guilty of an offence under this regulation is liable on summary conviction to a fine not exceeding level 3 on the standard scale.”.

14. For regulation 10 substitute—

“Conversion

10.—(1) This regulation applies where, pursuant to Article 108 of the Community Trade Mark Regulation(3)—

- (a) the applicant for or the proprietor of a Community trade mark requests the conversion of his Community trade mark application or Community trade mark into an application for registration of a trade mark under the Act; or
- (b) the holder of an international registration designating the European Community requests (in accordance with Article 154(1)(a) of that Regulation) the conversion of that designation into an application for registration of a trade mark under the Act.

(2) Where the request has been transmitted to the registrar under Article 109(3) of the Community Trade Mark Regulation, it shall be treated as an application for registration of a trade mark under the Act.

(3) A decision of the registrar in relation to the request shall be treated as a decision of the registrar under the Act.”.

(2) Section 92A was inserted by section 6 of the Copyright, etc. and Trade Marks (Offences and Enforcement) Act 2002 (c. 25).
(3) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ No L 11, 14.1.1994, p. 1), to which amendments relevant to these Regulations have been made by Council Regulation (EC) No 1992/2003 of 27 October 2003 (OJ No L 296, 14.11.2003, p. 1) and Council Regulation (EC) No 422/2004 of 19 February 2004 (OJ No L 70, 9.3.2004, p. 1).