

*This Statutory Instrument has been made in consequence of defects in [SI 2004/946](#) and [SI 2004/2332](#) and is being issued free of charge to all known recipients of those Statutory Instruments.*

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## STATUTORY INSTRUMENTS

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# 2008 No. 1067

## TRADE MARKS

### The Trade Marks (Earlier Trade Marks) Regulations 2008

<i>Made</i>	- - - -	<i>9th April 2008</i>
<i>Laid before Parliament</i>		<i>14th April 2008</i>
<i>Coming into force</i>	- -	<i>10th May 2008</i>

The Secretary of State, being a Minister designated<sup>(1)</sup> for the purposes of section 2(2) of the European Communities Act 1972<sup>(2)</sup> in relation to intellectual property (including both registered and unregistered rights), in exercise of the powers conferred on the Secretary of State by that section, makes the following Regulations.

#### **Citation, commencement and extent**

1. These Regulations may be cited as the Trade Marks (Earlier Trade Marks) Regulations 2008 and shall come into force on 10th May 2008.
2. These Regulations extend to England and Wales, Scotland and Northern Ireland.

#### **Amendments to the Trade Marks Act 1994**

3. The Trade Marks Act 1994<sup>(3)</sup> is amended as follows.
- 4.—(1) Section 6A (raising of relative grounds in opposition proceedings in case of non-use)<sup>(4)</sup> is amended as follows.
  - (2) In subsection (1)(b) after “earlier trade mark” insert “of a kind falling within section 6(1)(a), (b) or (ba)”.
  - (3) In subsection (5) after “Community trade mark” insert “or international trade mark (EC)”.
- 5.—(1) Section 47 (grounds for invalidity of registration) is amended as follows.

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(1) [S.I. 2006/608](#).

(2) [1972 c. 68](#).

(3) [1994 c. 26](#), relevant amendments to which are noted below.

(4) Section 6A was inserted by regulation 4 of [S.I. 2004/946](#).

- (2) In subsection (2D)(5) after “Community trade mark” insert “or international trade mark (EC)”.
- (3) After subsection (2E)(6) insert—
- “(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).”.

### **Transitional Provisions**

- 6.**—(1) Regulation 4(2) does not apply to an application for registration of a trade mark which—
- (a) was made on or after 5th May 2004 but before the coming into force of these Regulations, and
- (b) was not finally determined before the coming into force of these Regulations.
- (2) Paragraph (1) is without prejudice to the application of Regulation 4(2) to an application for registration of a trade mark which was made before 5th May 2004 but which was not finally determined before the coming into force of these Regulations.
- 7.** Regulation 5(3) does not apply to an application for a declaration of invalidity which was made, but not finally determined, before the coming into force of these Regulations.
- 8.**—(1) Regulation 5(3) does not apply to an application made on or after the coming into force of these Regulations for a declaration of invalidity in respect of a trade mark the application for the registration of which was made on or after 5th May 2004 but before the coming into force of these Regulations.
- (2) Paragraph (1) is without prejudice to the application of Regulation 5(3) to any other application made on or after the coming into force of these Regulations for a declaration of invalidity (including an application in respect of a trade mark the application for the registration of which was made before 5th May 2004).

*Baroness Delyth Morgan*  
Parliamentary Under Secretary of State for  
Intellectual Property and Quality  
Department for Innovation, Universities and  
Skills

9th April 2008

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(5) Section 47(2D) was inserted by regulation 6 of S.I. 2004/946.

(6) Section 47(2E) was inserted by regulation 6 of S.I. 2004/946.

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## EXPLANATORY NOTE

*(This note is not part of the Regulations)*

These Regulations amend the Trade Marks Act 1994 (“the Act”).

Regulations 4(3) and 5(2) make consequential amendments which were omitted when the Trade Marks (International Registrations Designating the European Community) Regulations 2004 ([S.I. 2004/2332](#)) (“the 2004 Regulations”) were made. The 2004 Regulations made certain amendments to the Act to give effect to the European Community’s accession to the Protocol to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27th June 1989. Both Community trade marks and international trade marks (EC) have the same effect and territorial range and therefore the amendments to sections 6A and 47 of the Act to include reference to both Community trade marks and international trade marks (EC) are necessary to remedy the omission.

Regulations 4(2) and 5(3) further amend sections 6A and 47 of the Act to disapply the requirement to satisfy the “use conditions” where the earlier trade mark relied on by the person opposing the registration of a trade mark or applying for a declaration of invalidity is a well-known trade mark which is entitled to protection under the Paris Convention for the Protection of Industrial Property of March 20th 1883 as amended or the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994 and the Agreement on Trade – Related Aspects of Intellectual Property Rights, which is an integral part of the WTO Agreement. These amendments are required to ensure compliance with Article 4(2)(d) of Directive [89/104/EEC](#), the First Council Directive to approximate the laws of the Member States relating to trade marks (O.J. L40, 11.2.89, p.1), which requires Member States to protect well known trade marks against later conflicting national marks whether or not the well known mark is registered or in use in the Member State of the registering authority.

Regulations 6, 7 and 8 are transitional provisions relating to regulations 4(2) and 5(3).

A full impact assessment has not been prepared for this instrument as no impact on the private or voluntary sectors is foreseen.

An Explanatory Memorandum is available alongside the instrument on the OPSI Website.