

# **Informal Consultation Paper on The Modernisation of the Trade Marks (International Registration) Order**

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## **Introduction**

1. Currently, the legal framework for the examination of international trade marks designating the UK (international marks (UK)) is a mix of the self standing international provisions in the Madrid Protocol ('the Protocol') and secondary legislation in the Trade Marks (International Registration) Order 1996 (SI 1996 No 714) ('the Order 1996'), made under powers conferred by section 54 of the Trade Mark Act 1994 (as amended, 'the Act'). The Order 1996 has been amended five times, normally in the wake of changes to domestic rules, since 1996.

## **Summary**

2. The UK-IPO now propose to consolidate this instrument, and incorporate changes made to domestic rules (The Trade Mark Rules 2008 ('the Rules') currently subject to consultation) as they apply to international marks (UK).
3. Moreover, the opportunity has been taken to re-cast the Order 1996 in a way which will:
  - (a) reduce the need to amend the Order to reflect subsequent changes to domestic legislation and simplify those changes when they occur;
  - (b) improve and clarify our implementation of the Protocol; and
  - (c) rectify various problems in the Order 1996.
4. The revision proposed is intended to achieve this by applying essentially the same legal regime to international marks that are applied to domestic filings. In substance, that set out in the Act and the Rules.
5. The changes and re-casting have no policy implications as far as regards our treatment of international marks (UK) or our function as an Office of Origin. The issue therefore is solely whether the draft text attached meets the three objectives set out in the above paragraph. We would be grateful for your views in response to the specific questions below.

## **Simplifying future changes**

6. In the past, separate exercises were conducted to implement changes to the Rules and (consequential) changes to the Order 1996. This, in part, explains the large number of amendments since its initial implementation, some of which have been extensive and complicated.
7. The draft Order is intended to be re-cast in such a way that changes of this type – certainly where they are extensive – will be reduced. The approach taken has been to apply the totality of the provisions of the Act and the Rules to international marks (UK), but disapply or modify the same where they conflict with the requirements of the Protocol or the Common Regulations (the ‘Regulations’). Schedules 1 and 2 of the draft Order set out the disappliances and modifications (Annex A).
8. It is hoped that the changes will reduce the burden on users in relation to consultations on legal developments. The objective is that any future changes involving both the Rules and Order will not be conducted as separate exercises but at the same time and with clear reference to both instruments.
9. It has of course, been necessary to retain ‘standalone’ provisions to deal with specific requirements relating to International marks. Many of these reflect or reproduce those as set in the Order 1996.

### *Question:*

- *Will the attached draft, and policy of merging future consultation, simplify matters from a user perspective in relation to the any amendments to the Order that might be required?*

## **Improve efficiency and clarity**

10. As pointed out above, the Order 1996 has been amended five times since its initial implementation. It now includes some provisions of the Protocol and the Common Regulations, some of the Act and the Rules, disapplies others and imports wholesale more recent changes to the Rules. Apart from the complication this has engendered, and the unnecessary repetition, there is a lack of clarity in terms of precisely how the domestic provisions apply (or do not) to international marks (UK). For example, there is a reliance on ‘deeming provisions’ which apply the Act and the Rules ‘except as otherwise provided’ and ‘with necessary modifications’ (see e.g. Art. 32 of the Order 1996) which imbue an element of uncertainty of interpretation.
11. The new approach determines to avoid these pitfalls by making the Order a complete statement as far as the treatment of international marks (UK) is concerned. Rather than repetition, silence, or generalised provisions, the draft Order, as stated above, expressly

disapplies those provisions which have no effect and applies or modifies those that do. Although the Order can never properly be 'self contained', it nevertheless gives clear references to the Act, Rules, Protocol and Common Regulations, so as to create a complete picture or 'code'.

12. We believe there is a certain logic in replicating (as far as is possible) in the International regime the registration procedures that apply to domestic trade marks. This is essentially what happens already and it will mean that users (in the vast majority) of instances will only need to consult the Act and Rules in determining procedure before the Office.
13. Our objective is to be as clear as possible, not least by clarifying provisions in the existing Order that are ambiguous – for example, the date of conferring protection for the purposes of revocation has been addressed in the draft with a specific provision. In addition there have been two decisions of the registrar (BL O/302/06 and BL O/318/03), which dealt, respectively, with whether or not section 72 applied to international marks (UK) and whether (based on the wording of Art 10 of the existing Order) the registrar was bound to publish once he had examined the mark. Ambivalence raised by both cases has been dealt with in the draft.
14. Finally, we hope the clarity of the Order has been enhanced by its presentation as discrete Schedules that deal with distinct aspects of the international regime. For example, Schedule 1 lists those parts of the Act and Rules that are applied and disapplied, setting clear boundaries between the same. Schedule 2 records the 'mechanics' of appliance and disapplication (i.e. necessary modifications), while other of the Schedules address International applications in the UK, concurrent registrations and transformation applications. The aim of the Office is that users will be able to access those parts of the Order that address matter of particular concern in much more direct manner than at present.

*Questions:*

- *Do you think the attached draft represents the interface between the UK and International regimes in a workable fashion?*
- *Are there any gaps or errors?*
- *Are there any matters in the draft which are inconsistent with the Protocol and Common Regulations ?*

**Existing inconsistencies**

15. There are a number of errors and problems associated with the Order 1996. For example, Art. 3(2) disregards the requirement in section 32 of the Act for a declaration of intention to use, and Arts. 12(1B) and (1C) suggest that an international mark (UK) is capable of division. The existing draft is silent on the issue of Certification and Collective

marks, which are dealt with only in guidance and provides for a rather limited definition of the role of the supplementary register. We have taken the opportunity to clarify matters in the draft.

*Question:*

- *Are there any other issues in the Order 1996 that should be addressed in the new Order?*

### **Status of the draft**

16. We would like this draft to come into effect at the same time as the consolidated Trade Mark Rules. This timeframe has meant that the time available to us and our legal advisers to undertake all the necessary checking and cross referencing to the Act, Rules and Madrid legislation has been short. Whilst we are confident that the draft represents a suitable framework, and in its detail will be substantially correct, there are aspects which have received rather less attention (e.g. the detail of the application, disapplication or modification of specific provisions in the Rules), and we especially welcome comments from those familiar with the Madrid system who may be able to spot anything which is inconsistent with their practical experience.

### **Responding To The Consultation**

17. This document is divided into various Annexes which contain the current draft of the Order, an annotated version of the same which provides comments on the policy and reasoning behind various provisions that are less than self-explanatory and, finally, a table provided comment and cross references between the Order, the Act and the Rules. It is hoped that these documents will assist in your understanding of the Order and in any responses you wish to make.
18. Please note that this is an informal consultation that, in agreement with Ministers, is directed to a limited number of consultees. This is largely because the changes are technical in nature and do not affect the International regime in the UK. Nevertheless, responses are welcomed from any individual, organisation, company or firm. Copies of this document are available from the contact address given below.
19. Please email any views you have to [edward.smith@ipo.gov.uk](mailto:edward.smith@ipo.gov.uk). Alternatively please send us your views in writing to the following postal address marked "International Order":

Edward Smith  
Room 2Y16  
Concept House  
Cardiff Road  
Newport  
NP10 8QQ

20. Please let us have your responses by June 30<sup>th</sup> 2008.

21. The following is a list of organisations and individuals to whom a copy of this consultation document has been sent. It is also available on the Intellectual Property Office website and can be viewed and commented upon by anyone accessing it:

Jan Vleck CIPA  
Angela Fox ITMA  
Jeremy Pennant ITMA  
Richard Gallafent FICPI  
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# Annex A: Trade Marks (International Registration) Order 2008 and annotations.

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STATUTORY INSTRUMENTS - DRAFT 21/05/08

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**2008 No.**

## **TRADE MARKS**

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

*Made* - - - - - \*\*\*  
*Laid before Parliament* \*\*\*  
*Coming into force* - - - - - *1st October 2008*

#### ARRANGEMENT OF ARTICLES

1. Citation and commencement
2. Interpretation
3. International trade marks (UK)
4. International applications originating in the United Kingdom
5. Concurrent registrations and transformation applications
6. Miscellaneous and General Provisions
7. Transitional provisions
8. Revocations

- 
- SCHEDULE 1 — Provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2008 which do not apply to International Trade Marks (UK) or requests for extension
- SCHEDULE 2 — Modifications to provisions of the Trade Marks Act 1994 applied to International Trade Marks (UK)
- SCHEDULE 3 — International applications originating in the United Kingdom
- SCHEDULE 4 — Concurrent registrations and transformation applications
- SCHEDULE 5 — Miscellaneous and General Provisions
- SCHEDULE 6 — Revocations

The Secretary of State, in exercise of the powers conferred by section 54 of the Trade Marks Act 1994<sup>(1)</sup>, makes the following Order:

### **Citation and commencement**

1. This Order may be cited as the Trade Marks (International Registration) Order 2008 and comes into force on [            ].

### **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<sup>(2)</sup>

“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<sup>(3)</sup> and “trade marks rule” shall be construed accordingly.

### **International trade marks (UK)**

#### *General comment on Art 3*

*Art. 3 is the central proposition of the Order. The intention is to interpret the whole of the Act through the ‘lens’ of the Order, as far as IMs (International marks) and other Madrid related functions are concerned. This is a broader approach than the existing Order which concentrates on the registrar’s particular functions under the Madrid system and,*

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(1) 1994 c. 26.

(2) S.I. 2007/1976.

(3) S.I. 2008 [    ].

*sometimes in a general way, the nature of the resulting rights and remedies.*

*As the Order represents a complete statement of the application of the Protocol and the Regulations in the UK, there is a need to marry up the terminology of the same with that used in the Act and the Rules. Art. 3(3) is intended to redefine specific terms in the Act in relation to the terminology and processes used in the Madrid texts. For example, a request for extension sent to the UK is already 'registered' (which includes formalities examination and publication by the International Board) under the international regime even before it comes to be examined under our own Act. The Order adapts the Act to reflect those differences.*

*Moreover, there is an potential overlap of duties and functions as between IB and the registrar such that it is necessary to clarify exactly where and in what way responsibility is exercised.*

*Consistent with the intention to provide a complete statement of the operation of the Protocol, Art. 3(3) refers to Schedule 1 which is a list of sections of the Act and Rules which are expressly disapplied for the purposes of the International regime.*

*Art. 3(3) also refers to Schedule 2 which comprises the necessary modifications of the Act and Rules; i.e. key areas at the interface between the latter, and the Protocol and the Regulations which require their own specific provision.*

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 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);

*The Madrid system works on a default basis; i.e. Marks are already 'registered' before they come to be examined, and if not objected to become 'protected' (the term used in the Madrid texts) in the relevant territory.*

- (b) references to a proprietor of a registered trade mark shall include references to the holder of a protected international trade mark (UK);

*'Holder' is the term used in the Madrid texts for a person whose international application has been registered at WIPO.*

- (c) references to an application for registration of a trade mark shall include references to a request for extension;

*'Request for extension' is the term used in the Madrid texts.*

- (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;

*Under Madrid, an 'applicant' is already a 'holder' as his mark is already registered at WIPO.*

- (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;

*This is especially important in relation to applications for revocation under section 46(1).*

- (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;

*This simply reinforces the point that International Marks (UK) (IMs) are protected in the UK, rather than registered.*

- (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;

*The UK publishes details of IMs which have been accepted and which are then open to opposition. This is in contrast to some countries which simply rely on 'publication' by the International Bureau (IB) in their international register and Gazette.*

- (h) references to the register are to the supplementary register;

*The UK does not directly 'control' the international register in the sense of making entries and amendments, but since our obligations under Madrid system started we have our own 'supplementary register' which is, in most respects, a mirror of the international register. Where it is not an exact mirror, this is largely because national provisions permit certain events and actions to be recorded which the Madrid system apparently does not (security interest may be an example). It is to be noted that we have not limited the legal definition of the supplementary register to that set out in Art. 24 of the Order 1996.*

- (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.

#### **Transitional provisions**

7. [                    ]

#### **Revocations**

8. The instruments set out in Schedule 6 are revoked.

## SCHEDULE 1

Article 3(3)

### Provisions of the Act and Trade Marks Rules which do not apply to International Trade Marks (UK) or requests for extension

#### PART 1

section 24(2)(b) (assignment or other transmission in relation to use of the trade mark in a particular manner or locality)

section 32(1), (2) and (4) (application for registration)

section 33(1) (date of filing)

section 34 (classification of trade marks)

section 36 (overseas claims to priority)

section 39(2) (withdrawal, restriction or amendment of application)

section 40 (registration)

section 41 (registration: supplementary provisions)

section 42 (duration of registration)

section 43 (renewal of registration)

section 44 (alteration of registered trade mark)

section 45 (surrender of registered trade mark)

section 64(4) (change of name and address by proprietor or licensee)

section 65 (adaptation of entries to new classification)

section 79 (fees)

section 94 (falsification of register)

section 105 (transitional provisions)

*The table at Annex B provides the reasoning  
behind the disapplication of these provisions*

#### PART 2

trade marks rule 6 (claim to priority; sections 35 & 36)

trade marks rule 12(4)(a) (failure to provide an address for service)

trade marks rule 13 (deficiencies in application; section 32)

trade marks rule 31 (registration subject to disclaimer or limitation; section 13)

trade marks rule 46 (form of register; section 63(1))

trade marks rule 56 (request for information; s.67(1) (Form TM31C))

## SCHEDULE 2

Article 3(3)(i)

### Modifications to provisions of the Act applied to International Trade Marks (UK)

1.—(1) Section 25 (registration of transactions affecting registered trade mark) is modified as follows.

*The policy here is to reproduce the effect of Art. 6 of the Order 1996. Essentially, the draft above does not set out what is or is not a recordable transaction for the purpose of the Protocol – that is the purview of the latter – rather it seeks to mirror the legal consequences of not doing so for certain defined transactions as set out in s. 25 of the Act.*

*In this sense, the objective of this version of s. 25 is different from that in the Act. It is not to require transactions be registered, but simply to set of the legal benefits of doing so.*

(2) Omit paragraph (a) of subsection (1) and substitute-

“(a) a person claiming to be entitled to any security interest (whether fixed or floating) over a protected international trade mark (UK) or any right in or under it, or”.

*The requirement to record a security of interest applies to the supplementary register only (art 6(1)&(2) of the Order 1996); such transactions are not mentioned in the Protocol and Regulations;*

(3) Omit paragraphs (a), (b) and (c) of subsection (2) and substitute—

“(a) a change to the ownership of a registration recorded by the International Bureau in the International Register pursuant to article 9 of the Madrid Protocol;

(b) the grant of a licence recorded by the International Bureau in the International Register pursuant to rule 20 *bis* of the Common Regulations;”.

(4) After subsection (2)(e) insert—

“(f) any matter other than as is referred to in paragraphs (a) and (b) above that is recorded in the International Register pursuant to article 9 *bis* of the Madrid Protocol.”.

(5) In subsection (3) omit “Until an application has been made for registration of the prescribed particulars of a registrable transaction” and substitute “Until an application for registration of a matter in the supplementary register pursuant to subsection (1) has been made or an application for registration of a registrable transaction in the International Register (in accordance with Article 9 *bis* of the Madrid Protocol and rule 20 *bis* of the Common Regulations) has been made”.

*The legal effect of Art. 6(4) of the Order 1996 is reproduced here (i.e. those in s. 25(3)) and apply to all registered transactions (Art 9 and 9bis, Protocol), as well as to a security of interest.*

(6) In subsection (4)(a) omit “the prescribed particulars of the transaction” and substitute “a transaction in the International Register (in accordance with Article 9 *bis* of the Madrid Protocol) and rule 20 *bis* of the Common Regulations”.

*The legal effect of Art 6(5) should only apply to change of ownership (art. 8, Protocol) and licenses only (rule, 20bis (C. regs).*

2. In section 33 (date of filing), for subsection (1), substitute—

“33.—(1) The date of filing of a request for extension shall be the date of the international registration except—

- (a) where at the time protection is conferred on an international trade mark (UK) there is a concurrent registered trade mark, the date of filing shall be the date of filing of the registered trade mark; and
- (b) where a request for extension is made in accordance with Article 3ter(2) of the Madrid Protocol, the date of filing shall be the date that the request for extension was recorded in the International Register.”.

*Specific provision is required to clarify the ‘date of filing’ of an IM (UK). This Article applies the Protocol Arts. 3(4), 3(ter)(2), and 4(bis)(1) to the notion of ‘date of filing’ in the Act explaining how, in each of the three situations, date of filing would be interpreted.*

3. In section 35 (claim to priority of convention application), for subsection (5), substitute—

“(5) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.”.

*The manner of claiming priority in respect of an IM (UK) is determined under the Protocol; see Art. 4(2) of the Protocol.*

4. In section 37 (examination of application) omit subsections (3) to (5) and substitute—

“(3) If it appears to the registrar that the requirements for registration are not met, the registrar shall give notice of provisional refusal to the International Bureau.

*This corresponds to Art. 9(3) in the Order 1996.*

(4) Where the International Bureau notifies the registrar or the registrar considers that a particular term used to indicate any of the goods or services included in the international registration is—

- (a) too vague for the purposes of classification; or
- (b) incomprehensible or linguistically incorrect,

the registrar may give notice of provisional refusal to the International Bureau in respect of that term.

(5) Where a decision of the registrar has been notified to the International Bureau pursuant to subsection (3) or (4), the registrar shall give the holder of the international registration an opportunity, within such period as the registrar may specify, to make representations or amend the request for extension by limiting the goods and services.

*Under the Madrid system, in the event of an objection, provisional notices of refusal are sent to the holder via the International Bureau (IB). The holder normally then appoints an attorney with a qualifying address for service, to whom all*

*subsequent correspondence is sent. The paragraph also gives the registrar power to issue provisional notice of refusal in respect of terms used in the specification which either the IB or, the registrar consider do not clearly indicate the nature of the goods/services. The power is analogous to the power in relation to a domestic case and would be exercised only where it would have been exercised against a domestic case.*

5. In section 38(2) (publication, opposition proceedings and observations) after “opposition to the registration” insert “in which event the registrar shall give notice of provisional refusal to the International Bureau”.

*This requires us to publish details (separately to the International Bureau) of an International mark for opposition purposes in our own Journal, and also to send provisional notice of refusal to the International Board in the event of an opposition.*

*As this Order applies the opposition procedures of the Act and Rules, there is no need for ‘bespoke’ provisions as in the Order 1996 as set out in Art. 10A, 10B and 10C of the Order 1996.*

6. After section 38, insert -

**“38A. Notices of provisional refusal**

(1) A notice of provisional refusal must set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.

(2) Except as provided in subsection (3), a notice of provisional refusal may not be given after the expiry of the relevant period.

(3) Where before the expiry of the relevant period the registrar has given notice to the International Bureau—

- (a) that the period prescribed for the purposes of section 38(2) expires after the end of the relevant period; or
- (b) that the period prescribed for the purposes of section 38(2) expires less than one month before the end of the relevant period;

a notice of provisional refusal may be given after the expiry of the relevant period provided that it is given before the end of the period of one month beginning immediately after the period prescribed for the purposes of section 38(2).

(4) Where the registrar sends the International Bureau a notice of provisional refusal, the registrar must notify the International Bureau as to the final decision (meaning a decision from which no appeal may be brought) on whether the refusal should be upheld.

(5) The relevant period is the period of 18 months beginning with the date the International Bureau sent the registrar the request for extension.

*This applies Art 5 of the Protocol (and related Common Regulations) in relation to the time limits allowed in which to send provisional notices of refusal and, in the case of opposition*

*periods close to or expiring after the relevant period, notices explaining that such notices may issue.*

*The provision reproduces the effects of Art. 11 of the Order 1996, though it frames the timelines in a different way: essentially the new provisions retain the reference to the 18 month limit and sets out the circumstances where provisional refusal may occur after that period.*

### **38B. Protection**

(1) Where no notice of provisional refusal is given to the International Bureau following publication under section 38(1), the international registration which is the subject of the request for extension shall be protected as a protected international trade mark (UK) with effect from the first day immediately following the end of the period prescribed for the purposes of section 38(2).

(2) Where notice of provisional refusal is given following publication under section 38(1), the international registration which is the subject of the request for extension shall be protected as a protected international trade mark (UK) with effect from the date on which the registrar notifies the International Bureau that the final decision is that the provisional refusal should not be upheld in accordance with section 38A(4).

(3) The reference to the completion of the registration procedure in section 46(1) shall be construed as a reference to the conferring of protection on an international registration in accordance with this section.

(4) When an international registration becomes protected as a protected international trade mark (UK), the registrar shall-

- (a) notify the International Bureau that the international registration is protected in the United Kingdom; and
- (b) publish a notice specifying the number of the international registration in respect of that trade mark, the date on which protection is conferred and the date and place of publication of the request for extension under section 38(1) in relation to that trade mark.”.

*Under para 38B it is necessary to explain when exactly the ‘completion of the Registration procedure’, for the purposes of section 46(1) occurs. In the existing Order 1996 this has not been expressly stated.*

*It is noted, again, that Art. 12(1B) and 12(1C) of the Order 1996 are ultra vires, as they effectively divide international applications. As a consequence, their effect is not reproduced in the draft Order.*

7. In section 39 (Withdrawal, restriction or amendment of application) for subsection (1) substitute—

“(1) The goods and services covered by a request for extension may be restricted at any time by the applicant provided that if the request for extension has been published, the restriction must also be published in the Journal and recorded in the supplementary register.”.

*The holder of an International mark may withdraw the request for extension via the International Bureau, or restrict the goods and services (see Art 9bis(iii) and (iv) of the Protocol)*

8.—(1) Section 63 (the register) shall be modified as follows.

(2) For subsection (1) substitute—

“(1) The registrar shall maintain a register for the purpose of entering particulars relating to international trade marks (UK).”.

(3) In subsection (3) for the words “shall be kept in such manner as may be prescribed” substitute “need not be kept in documentary form”.

(4) After subsection (3) insert—

“(4) Following notification from the International Bureau under rule 28(2) of the Common Regulations the registrar may correct an error or omission in the information entered in the register required to be maintained under subsection (1).”.

*This provides for the ‘supplementary register’ of IMs, for which the registrar is responsible*

9. In section 67(2)(a) (Information about applications and registered trade marks) before “in such cases” insert “any information recorded in the International Register or”.

*The registrar is prevented from communicating information prior to publication to third parties in a domestic case, and it is necessary to qualify that for IMs.*

## International applications originating in the United Kingdom

### Application for international registration at the Patent Office

**10.**—(1) An applicant for the registration of a trade mark, or the proprietor of a registered trade mark, may, subject to the provisions of this paragraph, apply by way of the Patent Office as office of origin for the international registration of the trade mark.

(2) For the purposes of this paragraph an applicant shall be—

- (a) a British citizen, a British overseas territories citizen, a British overseas citizen, a British subject or a British protected person;
- (b) an individual domiciled in the United Kingdom;
- (c) a body incorporated under the law of a part of the United Kingdom; or
- (d) a person who has a real and effective industrial or commercial establishment in the United Kingdom.

(3) Where the registrar has reasonable doubts about whether an applicant is eligible, the registrar—

- (a) must inform the applicant of the reason for those doubts; and
- (b) may require that applicant to file evidence in support of his eligibility.

(4) Where—

- (a) the registrar has no doubts or is satisfied as to the applicant's eligibility; and
- (b) the particulars appearing in the application for an international registration correspond with the particulars at that time in the basic application or, as the case may be, the basic registration,

the registrar must submit the application to the International Bureau.

(5) In this Schedule—

- (a) "basic application" means an application for registration of a trade mark in the United Kingdom in respect of which application is made for international registration;
- (b) "basic registration" means a trade mark registered in the United Kingdom in respect of which application is made for international registration.

### Termination of basic application or basic registration

**11.**—(1) This paragraph applies where the registrar submits an application to the International Bureau in accordance with paragraph 1 and the basic application or basic registration is terminated.

(2) Where, before the end of the relevant period, a basic application or basic registration is terminated, the registrar shall request that the International Bureau cancel the International Registration.

(3) A basic application is terminated where it is—

- (a) not accepted;
- (b) refused; or
- (c) withdrawn (including deemed as such).

(4) A basic registration is terminated where the rights in the registered trade mark cease to have effect.

(5) Where a basic application or basic registration is terminated in respect of some only of the goods or services for which the trade mark is registered (or is sought to be registered), the request must relate only to those goods and services.

(6) The relevant period is the period of 5 years beginning with the date of the international registration.

(7) But if during that period the registrar becomes aware of proceedings which may result in the termination of the basic application or basic registration, the registrar must notify the International Bureau accordingly, stating that no final decision has been made.

(8) On completion of the proceedings referred to in paragraph (7) the registrar must promptly notify the International Bureau of their outcome.

### **Division or merger of basic application or basic registration**

**12.—**(1) This paragraph applies where the registrar submits an application to the International Bureau in accordance with paragraph (1) and—

- (a) the basic application [or basic registration? Rule 19 of the TM Rules only refers to division of applications not registrations, but Rule 23 of the Common Regs contemplates that registrations can be divided, is this possible under domestic law?] is divided into two or more applications; or
- (b) two or more basic applications or basic registrations are merged into a single application or registration.

(2) Where, before the end of the relevant period, a basic application is divided or two or more basic applications or basic registrations are merged, the registrar shall notify the International Bureau and shall indicate —

- (a) the number of the international registration or, where the mark has not been registered, the number of the basic application;
- (b) the name of the applicant or the holder of the relevant trade mark; and
- (c) the number of each application resulting from the division or the number of the application or registration resulting from the merger.

(3) The relevant period is the period of 5 years beginning with the date of the international registration.

*These provisions give effect to obligations as an Office of Origin in accordance with e.g. Arts 2, 3 and 6 of the Protocol and related rules in the Regulations. They also confer a power of enquiry in respect of entitlement requirements under the Protocol. This is not a new power as it exists under the current Order. The current Order omits to mention division and merger.*

## Concurrent registrations and transformation applications

### Transformation applications

1.—(1) A transformation application is an application to register a trade mark under the Act where—

- (a) the mark was the subject of an international registration and the international registration was the subject of a request for extension; and
- (b) the international registration was cancelled at the request of the Office of origin under Article 6(4) of the Madrid Protocol.

(2) But an application shall only be treated as a transformation application where the goods and services cited in it are identical to some or all of the goods and services included in the international registration.

(3) Any application made under the Act which is a transformation application shall state that it is made by way of transformation.

(4) Such an application may only be made before the end of the period of three months beginning with the date on which the international registration was cancelled.

(5) A transformation application may only be made by the person who was the holder of the international registration immediately before it was cancelled.

(6) Where on or before the date the transformation application was made, the trade mark is protected as an international trade mark (UK), the mark shall be registered under the Act; and it shall have the date of filing of the cancelled international trade mark (UK).

(7) Where on that date the trade mark is not so protected, the transformation application shall be treated as an application to register under the Act and it shall have the date of filing of the request for extension relating to that mark.

(8) Where in relation to the international registration a right of priority was claimed on the basis of a Convention application, the transformation application shall have the same right of priority.

### Concurrent registrations

2.—(1) This paragraph applies where at the time protection is conferred on an international trade mark (UK) there is a concurrent registered trade mark.

(2) A registration is concurrent where—

- (a) the proprietor of the registered trade mark is the holder of the protected international trade mark (UK);
- (b) the registered trade mark is the same as the protected international trade mark (UK);
- (c) the goods and services in relation to which protection is conferred by the international trade mark (UK) include all those for which the registered trade mark is registered.

(3) The protected international trade mark (UK) shall be treated as being registered under the Act as of the date of registration of the registered trade mark..

(4) The priorities claimed in respect of the registered trade mark may also be claimed in respect of the international trade mark (UK).

(5) The provisions of this paragraph shall continue to apply after the registered trade mark lapses or is surrendered, but shall cease to apply if it is revoked or declared invalid.

(6) On the application of the holder of the protected international trade mark (UK) the registrar shall note the international registration in the register against the registered trade mark.

(7) For the purposes of paragraph (6), the holder of the international trade mark (UK) shall make an application to the registrar using Form TM28.

*Transformation applications are covered by Art. 9quinquies of the Protocol and concurrent applications (termed 'replacement' in the Protocol) are covered by Art 4bis (and any related rules in the Common Regulations).*

## Miscellaneous and General Provisions

**Correction of international registration**

13.—(1) Where the International Bureau notifies the registrar that it has corrected an international registration and the correction either—

- (a) substantially affects the identity of the trade mark; or
- (b) alters the goods or services covered by the international registration,

the registrar may treat the notification as a new request for extension.

(2) Where paragraph (1)(a) applies, any earlier request for protection shall be deemed to have been withdrawn and any resulting protection granted to the international trade mark (UK) shall be treated as having been declared invalid.

(3) Where paragraph (1)(b) applies and—

- (a) the correction extends the goods and services covered by the request for extension, the new request for extension shall apply only to the additional goods and services; or
- (b) the correction restricts the goods and services covered by the international registration, to the extent it relates to goods and service outside the restriction, an earlier request for protection shall be treated as having been withdrawn, and any resulting protection granted to the international trade mark (UK) shall be treated as having been declared invalid.

*Rule 28 of the Common Regulations refers.*

**Assignment**

14.—(1) A protected international trade mark (UK) may only be assigned to an eligible person.

(2) An eligible person is—

- (a) a national of any country which is a party to the Madrid Protocol;
- (b) an individual domiciled in such a country;
- (c) a body incorporated under the law of such a country; and
- (d) a person who has a real and effective industrial or commercial establishment in such a country.

*See Arts 2 and 9 of the Protocol.*

**Judicial notice**

15.—(1) Judicial notice shall be taken of the following—

- (a) the Madrid Protocol and the Common Regulations;
- (b) copies issued by the International Bureau of entries in the International Register;
- (c) copies of the periodical gazette published by the International Bureau in accordance with rule 32 of the Common Regulations.

(2) Any document mentioned in paragraph (1)(b) or (c) shall be admissible as evidence of any instrument or other act of the International Bureau so communicated.

(3) Where in relation to the international registration a right of priority was claimed on the basis of a Convention application, the transformation application shall have the same right of priority.

*This provision is reflected in the current order and derives from e.g. Art 5bis and 5ter of the Protocol, which exempt such documents from 'legalisation'.*

### **Revocation**

**16.** Where the protection of a protected international trade mark (UK) is revoked or declared invalid to any extent, the registrar shall notify the International Bureau, and—

- (a) in the case of a revocation, the rights of the proprietor shall be deemed to have ceased to exist to that extent as from—
  - (i) the date of the application for revocation, or
  - (ii) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date;
- (b) in the case of a declaration of invalidity, the trade mark shall to that extent be deemed never to have been a protected international trade mark (UK).

*This confirms the position if an IM is revoked or declared invalid. It brings the date of the ceasing of effect of the rights of the proprietor into line with the position on a domestic case. The current Order is out of step in this regard and the deeming date is when the appropriate entry is made on the international register.*

### **Requests for Information**

**17.** A request for information relating to a protected international trade mark (UK) must be made on Form TM31M.

### **Communication of information to the International Bureau**

**18.** Notwithstanding any other enactment or rule of law, the registrar may communicate to the International Bureau any information which the United Kingdom is required to communicate by virtue of this Order or pursuant to the Madrid Protocol or Common Regulations.

### **Transmission of fees to the International Bureau**

**19.** The registrar may accept for transmission to the International Bureau fees payable to the International Bureau in respect of an application for international registration originating in the United Kingdom or a renewal of such an international registration, subject to such terms and conditions as the registrar may specify, either generally by published notice, or in any particular case by written notice to the applicant desiring to make payment by such means.

## SCHEDULE 6

Article 8

### Revocations

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*Title and number*

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The Trade Marks (International Registration) Order 1996 (SI 1996/714)

Trade Marks (International Registration) (Amendment) Order 2000 (SI 2000/138)

Trade Marks (International Registration) (Amendment) Order 2002 (SI 2002/692)

Trade Marks (International Registration) (Amendment) Order 2004 (SI 2004/948)

Trade Marks (International Registration) (Amendment) Order 2006 (SI 2006/763)

Trade Marks (International Registration) (Amendment No 2) Order 2006 (SI 2006/1080)

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## Annex B: The provisions of the Trade Marks Act 1994 (As amended), the Trade Marks Rules 2008 and the Trade Marks (International Registration) Order 2008

Section of Act	Effect	Relevant Rules	Comment
s. 1 to 6	Not disapplied.		These contain the basic requirements of UK Law in relation to the examination of International marks. They have effect in the Order via Art. 3.
s. 7 and 8	Not disapplied.		s. 7 is now defunct – see 7(5). The power in s. 8 has been effected in The Trade Marks (Relative Grounds) Order 2007, which also applies to International marks.
s. 9 to 12	Not disapplied.		The law on infringement is the purview of member states. The rights and remedies under the Act are applied by the Order (Art. 3(2)).

Section of Act	Effect	Relevant Rules	Comment
s. 13	Not disapplied.	Note that r. 31, which refers to the publication of disclaimers or limitations, is disapplied in Sch. 2, Part 2.	Though the limitations affect the rights in the mark (colour, descriptive word) are the purview of WIPO, the permission in the s. 13 does not impinge on this. s. 13(2) refers to the supplementary register (See Sch. 3(1)(6)), where limitations and disclaimers are recorded.
s. 14	Not disapplied.		'Proprietor' is defined in the Order, Art. 3(3)(b).
s. 15 to 22	Not disapplied.		The definitions of 'registered' and 'request for extension' in Art. 3(3)(a) and (c) apply.
s. 23	Not disapplied.		The provision deals with the legal effects of co-ownership in the UK. For example, paragraph 4 would only deal with co-ownership licenses that have effect in the UK.
s. 24(2)(b)	Disapplied.		An international mark (UK) is designated to one unitary area (the UK) : it can't be sold off in 'bits', as with a domestic mark. The rest of this provision is concerned with the law in relation to assignments in the UK, which will apply.

Section of Act	Effect	Relevant Rules	Comment
s. 25	Modified (Sch. 2(1)).	Note that r. 48(c) and 49(1)(d) apply (security of interest), given the amendment to s. 25(1). This triggers the use of form TM24 (which is the current practice). The rest of the provisions in r. 48 and 49 do not apply, under the modification to s. 25(1).	<p>The aim of this modification is to reproduce the effect of Art. 6 of the Order 1996. Essentially, we do not set out what is or is not a recordable transaction for the purpose of the Protocol – that is the purview of the latter – rather we mirror the legal consequences of not so recording for certain defined transactions.</p> <p>The requirement to record a security of interest applies to the supplementary register only; this is the only registerable transaction we will make by direct request to UK-IPO via a TM24, independent of the international register.</p> <p>The modifications in Sch. 2, 1(5) and (6) to s. 25(3) and (4) are intended to mirror the legal effects of Art. 6(4) and (5) of the Order 1996.</p>
s. 26	Not disapplied.		s. 26(1) is a disappliance which applies to the supplementary register only. s. 26(2) implements a particular requirement of English and Scottish law.

Section of Act	Effect	Relevant Rules	Comment
s. 27	Not disapplied.	Note that r. 48(c) and 49(1)(d) apply in relation to s. 27(3), given the amendment to s. 25(1) as set out above. This triggers the use of form TM24 (which is the current practice).  r. 49(3) also applies, but to the supplementary register.	s. 27(1) applies s. 22 to 26 to applications as well as registrations of trade marks: both can (and should) be able to be bought and sold as property.  s. 27(2) the share of a co-owned mark applies to an application as much as a registration.  s. 27(3), which covers the registration of such transactions, applies to registration of a security of interest only, given the amendment to s. 25(1).
s. 28 to 31	Not disapplied.		Given the extent of the Act (s. 108) clearly these provisions can only define the nature of, and rights associated with, licenses as they originate/apply under UK law.
s. 32(1), (2) and (4)	Disapplied	As a consequence, r. 5 is disapplied. This also takes out the expedited examination procedure (fast track). s. 32(3) is applied as this is a requirement of UK law, as a consequence, r. 13 is disapplied.	WIPO is responsible for the formalities of application, but we need to keep the requirement of an intention to use as this is part of UK trade mark law. However, the procedural aspects of this in r. 13(3) are the purview of WIPO.

Section of Act	Effect	Relevant Rules	Comment
s. 33(1)	Modified (Sch. 2(2)).		Reflects the meaning of 'date of filing' as the date of international registration, as amended by Sch. 2(3)(a) and (b).
s. 34	Disapplied	Also disapplies rule 7 of the Rules.	See Art. 3(2) of the Protocol.
s. 35(5)	Disapplied	r. 6 is disapplied.	This reflects Art. 8 of the current Order and has identical effect.
s. 36	Disapplied	The Trade Marks (Claims to Priority from Relevant Countries) Order 1994 is also disapplied.	A power in relation to priority from relevant, non-Convention countries. Such priority should not apply to International applications, which only draw priority from Art. 4(2) of the Protocol.
s. 37(3), (4) and (5)	Modified (Sch. 2(4))	Note that r. 5 is already disapplied.	s. 37(1) applies, while s. 37(2) has been removed by the Trade Marks (Relative Grounds) Order 2007.  The rest of this section is disapplied and substituted by the procedures relating to international marks (Sch. 1(4)).

Section of Act	Effect	Relevant Rules	Comment
s. 38(1)	Not disapplied.	r. 16 applies, i.e. publication in the Journal.	s. 38(1) to the Supplementary Register. The reference to the 'prescribed manner' is a reference to the Rules; thus r.16 is applicable.
s. 38(2)	Modified (Sch. 2(5)).	r. 17 applies.	The UK opposition procedure is followed in relation to International marks (s. 38(2) and r. 17)
s. 38(3)	Not disapplied.	r. 22 is thus applied.	Observations may be made on International Registrations (s. 38(3) and r. 22) and the same procedures followed.
s. 39(2)	Disapplied.	r. 24 is rendered inapplicable; r. 25(1) is only applicable to the extent provide for by s. 39(1) and (3).	r. 25(2)ff is required. Publication is in the supplementary register; objection to the changes is allowed under this rule.
s. 40	Disapplied	r. 23 is consequently disapplied.	For example, the Registrar has no right to 'register' (i.e. 'protect') international marks and cannot issue registration certificates for the same.

Section of Act	Effect	Relevant Rules	Comment
s. 41	Disapplied	r. 26, 27 and 28 disapplied.	We do not divide or merge – only WIPO can do this. Further there are no series applications for international marks in the UK.
s. 42	Disapplied		The time period for registration is the purview of WIPO.
s. 43 and s 44	Disapplied	r. 34, 35, 36 and 37 are also, consequently, disapplied.	Renewal and alteration is the purview of the Protocol.
s. 45	Disapplied	r. 33 is thus disapplied.	Surrender is the purview of WIPO (called 'renunciation'). Use of forms thus rendered inapplicable (TM22 & TM23).
s. 46, 47 and 48	Not disapplied.	The rules that apply to the procedures in relation to revocation, invalidity and acquiescence also apply: r. 38 to 45.	Such remedies must be available to International trade mark holders (UK), as provided for by Art. 3 of the draft Order.
s. 49 and 50	Not disapplied.	This will trigger r. 29 and 30, but they are UK jurisdictional provisions.	Schedules 1 and 2 of the Act apply. The detail in relation to certification, collective etc. marks is set out in the International Work Manual section 3.2.4.

Section of Act	Effect	Relevant Rules	Comment
s. 51, 52 and 53	Not disapplied.		Neutral. These provisions retain certain definitions and, in the main, apply to the community trade mark and have no effect on International marks.
s. 54	Not disapplied.		Provides the power to make the Order.
s.55	Not disapplied.		Neutral. Powers in relation to the Paris Convention.
s. 56, 57, 58, 59 and 60.	Not disapplied.		<p>Neutral. These provides protection to marks that are well known in Convention Countries, and to national emblems.</p> <p>As a signatory to the Convention, a different regime to that in the Protocol, the UK law applies to all marks defined in s. 56(1) and protected emblems in 57(1) and 58(1). These may, or may not, be International marks as well.</p> <p>S. 60 deals with applications from unauthorised agents.</p>

Section of Act	Effect	Relevant Rules	Comment
s. 61	Not disapplied.		A disappliance in relation to stamp duty.
s. 62	Not disapplied.		Definition of Registrar.
s. 63	Not disapplied.	r. 47 applies. r. 48 and 49 are disapplied as above (see s. 25).	Refers to the supplementary register.
s. 64(4)	Disapplied.	r. 44 applies in relation to the procedures re. rectification; and r. 53 in relation to the removal of matter from the register.  r. 52 is disapplied following the disappliance of s. 64(4).	It seems, in so far as this power refers to the supplementary register, it must be retained by the UK-IPO, so as to rectify errors or omissions in the same.  However, to allow the power to change names and addresses (s. 64(4)) could lead to the supplementary register being out of step with the international register, and thus this is disapplied.
s. 65	Disapplied	Disapplies r. 54 and 55.	This seems to be the purview of the Protocol and the International Register.
s. 66	Not disapplied.	Consequently, r. 3 has effect also.	Requirement to publish forms used before the Registrar: extends to those forms mentioned in the Order and in the Rules that apply to International marks.

Section of Act	Effect	Relevant Rules	Comment
s. 67	Not disapplied.	r. 56 is disapplied. r 57 and 58 both apply.	This applies as set out; the same regime covers international marks as domestic marks. However, r. 56 is disapplied as we use the TM31M not the TM31C as a request for information (see Art 5 of the draft Order).
s. 68 and 69	Not disapplied.	This appliance triggers r. 62 to 69.	Relates to proceedings before the Registrar (costs and rules of evidence). Must apply.
s. 70	Not disapplied.		Exclusion of liability in respect of official Acts.
s. 71	Not disapplied.		Registrar's annual report – which includes the Madrid Protocol.
s. 72 to 77	Not disapplied.	r. 70 to 73 all applied.	Legal proceedings and appeals – all fall within the jurisdiction of the member state.
s. 79	Disapplied	Disapplies r. 4	There is a power for fees under s. 54 of the Act. We do not need this provision and disapplying it has the advantage of switching off any fee requirements in the Rules.

Section of Act	Effect	Relevant Rules	Comment
s. 80	Not disapplied	r. 80 applies.	Directions on hours of business.
s. 81	Not disapplied.	r. 81 is applied.	Publication in the Journal. This is necessary.
s. 82 to 88	Not disapplied.	r. 60 and 61	The jurisdiction of agents is the purview of the UK.
s. 89, 90	Not disapplied.		Importation into the UK of infringing goods.
s. 93	Not disapplied.		In general, offences are under the jurisdiction of the UK; s 93 provides for the powers of the Trading Standards Officers.
s. 94	Disapplied.		This is not a feature of the Order 1996 and not to disapply it would create a new offence.
s. 95	Not disapplied.		See Art 18 in the Order 1996. This section is equivalent to that provision.

Section of Act	Effect	Relevant Rules	Comment
s. 96	Not disapplied.		Necessary provisions that apply to Scotland.
s. 97 to 98	Not disapplied.		Forfeiture of goods: under UK jurisdiction.
s. 99	Not disapplied.		Offences in relation to the Royal Arms.
s. 100	Not disapplied.		Burden of proof of use provisions.
s. 101	Not disapplied.		Offences committed by partnerships.
s. 102 to 104	Not disapplied.		I have checked these and find nothing that affects the draft Order.
s. 105	Disapplied.		The 1938 Act will not apply to international marks. This has the effect of disapplying Schedule 3, which is concerned with transitional provisions and the 1938 Act.

Section of Act	Effect	Relevant Rules	Comment
s. 106	Not disapplied.		Schedule 4 – a whole series of consequential amendments to other instruments.
s. 107	Not disapplied.		Territorial waters.
s. 108	Not disapplied.		Extent of the Act.
s. 109	Not disapplied.		Commencement – though the reference to the 1938 Act is redundant.
s. 110	Not disapplied.		Name of the Act.