STATUTORY INSTRUMENTS

2006 No. 1027

TRADE MARKS

The Community Trade Mark Regulations 2006

Made - - - -	*5th April 2006*
Laid before Parliament	*6th April 2006*
Coming into force - -	*29th April 2006*

The Secretary of State makes the following Regulations in exercise of the powers conferred by section 52 of the Trade Marks Act 1994(**a**):

Citation, commencement, extent and revocations

1.—(1) These Regulations may be cited as the Community Trade Mark Regulations 2006 and shall come into force on 29th April 2006.

(2) These Regulations extend to England and Wales, Scotland and Northern Ireland.

(3) The instruments set out in the Schedule (revocations) shall be revoked to the extent specified.

Interpretation

2.—(1) In these Regulations—

"Community trade mark court" means a court designated by regulation 12;

"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 3*ter* (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 3*ter* (1) or (2) of the Madrid Protocol.

(2) In regulations 3 to 9, a reference to a Community trade mark includes a reference to an international trade mark (EC), and in that case—

(**a**) 1994 c. 26; section 47 was amended by SI 2004/946, section 53 was amended by SI 2004/2332, section 89 was amended by SI 2004/1473 and sections 90 and 91 were amended by the Commissioners for Revenue and Customs Act 2005 (c.11). There are other amendments but none is relevant.

(a) a reference to a revocation or declaration of invalidity of the mark is a reference to a revocation or declaration of invalidity of the protection of the mark;

(b) a reference to the goods or services for which the mark is registered is a reference to the goods or services in respect of which the mark is protected.

(3) In these Regulations "the Act" means the Trade Marks Act 1994, and any reference to a section is, unless the context otherwise requires, a reference to a section of that Act.

Determination of invalidity and liability to revocation in relation to claims of seniority

3.—(1) Where the proprietor of a Community trade mark claims the seniority of a registered trade mark which—

(a) has been removed from the register under section 43, or

(b) has been surrendered under section 45,

any person may apply to the registrar or to the court for the declaration set out in paragraph (3).

(2) Where such a proprietor claims the seniority of an international trade mark (UK) which has been removed from the International Register or surrendered, any person may apply to the registrar or to the court for the declaration set out in paragraph (3).

(3) The declaration is that if the trade mark had not been so removed or surrendered, it would have been liable to be revoked under section 46 or declared invalid under section 47(**a**).

(4) An address for service in the United Kingdom shall be filed by—

(a) the person making an application under paragraph (1) or (2); and

(b) the proprietor of the Community trade mark,

unless in a particular case the registrar otherwise directs.

(5) Where the trade mark has been surrendered in respect of some only of the goods or services for which it is registered (or protected), paragraph (1) or (2) shall apply in relation to those goods or services only.

Procedure for declaration that trade mark would have been liable to be revoked or declared invalid

4.—(1) In proceedings on an application under regulation 3(1) or (2) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration.

(2) In the case of such proceedings before the registrar, the provisions of rules 31 to 37, 54 to 62, 67 to 69 and 72 of the Trade Marks Rules 2000(**b**), with necessary modifications, shall apply.

(3) In the case of such proceedings before the court, the registrar is entitled to appear and be heard, and shall appear if so directed by the court.

(4) Unless otherwise directed by the court, the registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of—

(a) any proceedings before him in relation to the matter in issue,

(b) the grounds of any decision given by him affecting it,

(c) the practice of the Patent Office in like cases, or

(d) such matters relevant to the issues and within his knowledge as registrar as he thinks fit;

and the statement shall be deemed to form part of the evidence in the proceedings.

(5) Anything which the registrar is or may be authorised or required to do under this regulation may be done on his behalf by a duly authorised officer.

(**a**) Those provisions are applied (subject to adaptations) to an international trade mark (UK) by article 13 of SI 1996/714, amended by SI 2000/138, 2002/692 and 2004/948.

(**b**) SI 2000/136, amended by SI 2001/3832 and 2004/947.

Remedies in infringement proceedings

5.—(1) This regulation is without prejudice to the duties of the Community trade mark court under Article 98(1) of the Community Trade Mark Regulation.

(2) In an action for infringement of a Community trade mark all such relief by way of damages, injunctions, accounts or otherwise is available to the proprietor of the Community trade mark as is available in respect of the infringement of any other property right.

(3) The provisions of sections 15 to 19 apply in relation to a Community trade mark as they apply to a registered trade mark; and any reference to the court shall be construed as meaning the Community trade mark court.

Groundless threats of infringement proceedings

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

(2) However, in the application of those provisions in relation to an international trade mark (EC)—

(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);

(b) the reference in section 21(4) to notification that a trade mark is registered, shall be treated as a reference to notification that a trade mark is an international trade mark (EC); and

(c) the reference in section 21(4) to notification that an application for registration has been made, shall be treated as a reference to notification that a trade mark is the subject of an international application or international registration designating the European Community.

Importation of infringing goods, material or articles

7.—(1) The provisions of—

(a) section 89 (infringing goods, material or articles may be treated as prohibited goods);

(b) section 90 and section 91 (power of Commissioners of Customs and Excise to disclose information),

apply in relation to a Community trade mark as they apply in relation to a registered trade mark.

(2) The Trade Marks (Customs) Regulations 1994(**a**) shall apply in relation to notices given under section 89 as applied by paragraph (1).

Offences and forfeiture

8.—(1) The provisions of—

(a) section 92 (unauthorised use of trade mark, etc, in relation to goods);

(b) section 92A (search warrants);

(c) section 93 (enforcement function of local weights and measures authority);

(d) section 97 (forfeiture: England and Wales or Northern Ireland); and

(e) section 98 (forfeiture: Scotland),

apply in relation to a Community trade mark as they apply in relation to a registered trade mark.

(2) For the purposes of those provisions, references to goods in respect of which a trade mark is registered shall include goods in respect of which an international trade mark (EC) confers protection in the European Community.

(**a**) SI 1994/2625.

Falsely representing trade mark as a Community trade mark

9.—(1) It is an offence for a person—

(a) falsely to represent that a mark is a Community trade mark, or

(b) to make a false representation as to the goods or services for which a Community trade mark is registered,

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.

Conversion

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

(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.

Privilege for communications with those on the list of professional trade marks representatives

11.—(1) This regulation applies to communications as to any matter relating to the protection of any trade mark or as to any matter involving passing off.

(2) Any such communication—

(a) between a person and his professional trade marks representative, or

(b) for the purposes of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his professional trade marks representative,

is privileged from, or in Scotland protected against, disclosure in legal proceedings in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his solicitor.

(3) In paragraph (2) a person's "professional trade marks representative" means a person who is retained by him and is on the special list of professional representatives for trade marks matters referred to in Article 89 of the Community Trade Mark Regulation.

Designation of Community trade mark courts

12.—(1) For the purposes of Article 91 of the Community Trade Mark Regulation, the following courts are designated as Community trade mark courts—

(a) in England and Wales—

(i) the High Court;

(ii) any county court designated as a patents county court under section 287(1) of the Copyright, Designs and Patents Act 1988(**a**); and

(iii) the county courts listed in paragraph (2);

(b) in Scotland, the Court of Session; and

(c) in Northern Ireland, the High Court.

(2) The county courts referred to in paragraph (1)(a)(iii) are the county courts at—

(a) Birmingham;

(b) Bristol;

(c) Cardiff;

(d) Leeds;

(e) Liverpool;

(f) Manchester; and

(g) Newcastle upon Tyne.

(3) For the purpose of hearing appeals from judgments of the courts designated by paragraph (1), the following courts are also designated as Community trade mark courts—

(a) in England and Wales, the Court of Appeal;

(b) in Scotland, the Court of Session; and

(c) in Northern Ireland, the Court of Appeal.

Barry Gardiner
Minister for Competitiveness
Department of Trade and Industry

5th April 2006

(**a**) 1988 c. 48.

SCHEDULE

Regulation 1(3)

Revocations

Title and number	*Extent of revocation*
Community Trade Mark Regulations 1996 (SI 1996/1908)	The whole Regulations.
Community Trade Mark (Amendment Regulations) 2004 (SI 2004/949)	The whole Regulations.
Trade Marks (International Registrations Designating the European Community, etc) Regulations 2004 (SI 2004/2332)	Regulations 7 to 14.
Community Trade Mark (Designation of Community Trade Mark Courts) Regulations 2005 (SI 2005/440)	The whole Regulations.

EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations make provision for the operation of the Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community trade mark (O.J. No. L 11, 14.1.94, p.1) ("the Community Trade Mark Regulation"). A Community trade mark registered at the Office for Harmonization in the Internal Market (trade marks and designs) under the Community Trade Mark Regulation has effect throughout the Community. As a result of the Community's accession to the Madrid Agreement Concerning the International Registration of Marks (adopted at Madrid on 27th June 1989), holders of an international registration under that Protocol may apply for protection of their marks under the Community trade mark system; and conversely applicants for, or proprietors of, a Community trade mark may apply for international protection of their marks under the Protocol. The provision made by these Regulations in respect of the Community trade mark also extends to marks protected under that Protocol in the territory of the Community.

Regulations 3 and 4 provides for the procedure for determining the invalidity, or liability to revocation, of the registration of a trade mark from which a Community trade mark claims seniority.

Regulation 5 sets out the sanctions available under national law for infringement of a Community trade mark. It also applies to such marks the provisions of the Trade Marks Act 1994 (c. 26) ("the 1994 Act") which deal with infringement proceedings.

Regulation 6 applies to Community trade marks the provisions of the 1994 Act dealing with groundless threats of infringement.

Regulation 7 and 8 applies the provisions to Community trade marks of the 1994 Act dealing with the importation of infringing goods, materials and articles, and offences and forfeiture.

Regulation 9 makes it a criminal offence to falsely represent that a mark is a Community trade mark or to make false representations as to the goods and services for which a Community trade mark is registered.

Regulation 10 provides for the conversion of a Community trade mark, or an application for a Community trade mark, into an application for registration under the 1994 Act.

Regulation 11 provides the privilege for communications with persons on the list of professional representatives maintained in pursuance of Article 89 of the Community Trade Mark Regulation.

Regulation 12 designates the courts in the United Kingdom having jurisdiction over proceedings arising out of the Community Trade Mark Regulation.

These Regulations replace the Community Trade Mark Regulations 1996 (SI 1996/1908).

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