

# **The Trade Marks (International Registration) Order 1996**

*Made* 11th March 1996

*Laid before Parliament* 11th March 1996

*Coming into force* 1st April 1996

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The Secretary of State, in exercise of the powers conferred on him by [section 54](#) of the Trade Marks Act 1994<sup>(a)</sup> thereby makes the following Order:—

## **PRELIMINARY**

### **Citation commencement and extent**

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<sup>(a)</sup> 1994 c.26

1.—(1) This Order may be cited as the Trade Marks (International Registration) Order 1996 and comes into force on 1st April 1996.

(2) This Order extends to England and Wales, Scotland, Northern Ireland and the Isle of Man.

## Interpretation

2. In this Order—

“the Act” means the Trade Marks Act 1994, and references to a section are, unless the context otherwise requires, to sections of that Act;

“basic application” and “basic registration” have the respective meanings given by [article 22](#);

“Common Regulations” means the regulations adopted under [article 10](#) of the Madrid Protocol with effect from 1 April 1996;

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

“International Bureau” means the International Bureau of the World Intellectual Property Organisation;

“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 United Kingdom” 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 United Kingdom under [Article 3ter \(1\) or \(2\)](#) of the Madrid Protocol;

“notifiable transaction” has the meaning given by [article 6](#);

“protected international trade mark (UK)” has the meaning given by [article 12](#), and references to “protection” and “protected” shall be construed accordingly;

“the Rules” means the Trade Marks Rules 1994<sup>(b)</sup>, and references to a rule shall, unless the context otherwise requires, be construed accordingly;

“supplementary register” has the meaning given by [article 24](#);

“transformation application” has the meaning given by [article 19](#);

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<sup>(b)</sup> S.I. 1994/2583

“United Kingdom” includes the Isle of Man.

## **INTERNATIONAL REGISTRATIONS DESIGNATING THE UNITED KINGDOM**

### **Entitlement to protection**

3.—(1) An international registration designating the United Kingdom shall be entitled to become protected subject to the provisions of [articles 9 to 12](#) where, if the particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration (including any imposed by the Rules).

(2) For that purpose, [sections 32 to 34](#), [rules 5 to 8](#) and [rules 10](#) and [11](#) shall be disregarded.

### **Effects of Protected International Trade Mark (UK)**

4.—(1) The proprietor of a protected international trade mark (UK) has, subject to the provisions of this Order, the same rights and remedies as are given by or under [sections 9 to 12 and 14 to 20](#) to the proprietor of a registered trade mark, subject to the limits on effect and to the provisions relating to exhaustion which are applicable to a registered trade mark by virtue of [section 11](#) and [section 12](#) respectively.

(2) For the purposes of [section 9](#) (rights conferred by registered trade mark)—

- (a) the rights of the proprietor shall have effect as of the date on which it is to be treated as registered pursuant to [article 12](#) or [article 21](#);
- (b) a protected international trade mark (UK) shall be treated as being in fact registered when it becomes protected pursuant to [article 12](#).

(3) References in [sections 10 and 11](#) to goods or services in respect of which a trade mark is registered are to goods or services in respect of which a protected international trade mark (UK) confers protection in the United Kingdom.

(4) Where the holder of an international registration designating the United Kingdom by notice in writing sent to the registrar—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark, or
- (b) agrees that the rights conferred in the United Kingdom by the international registration shall be subject to a specified territorial or other limitation,

the registrar shall enter the disclaimer or limitation in the supplementary register and shall publish the disclaimer or limitation.

(5) Where a protected international trade mark (UK) is subject to a disclaimer or limitation, the rights conferred in relation to it by the application of [section 9](#) are restricted accordingly.

(6) The remedy for groundless threats of infringement proceedings given by **section 21** applies in relation to a protected international trade mark (UK) as in relation to a registered trade mark; 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 protection of a protected international trade mark (UK); 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 a protected international trade mark (UK) or is the subject of an international application or international registration designating the United Kingdom.

### **International Trade mark (UK) as an object of property**

5. The provisions of **sections 22, 23, 24** (except **subsection (2)(b)**) and **26** (which relate to a registered trade mark as an object of property) apply, with the necessary modifications, in relation to an international trade mark (UK) as in relation to a registered trade mark.

### **Notification of transactions**

6.—(1) The following are notifiable transactions for the purposes of this article—

- (a) the grant of a licence under a protected international trade mark (UK);
- (b) the granting of any security interest (whether fixed or floating) over an international trade mark (UK) or any right in or under it.

(2) On application being made to the registrar by—

- (a) a person claiming to be entitled to an interest in or under an international trade mark (UK) by virtue of a notifiable transaction, or
- (b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the supplementary register.

(3) The following are relevant transactions for the purposes of this article—

- (a) a notifiable transaction;
- (b) an assignment of an international trade mark (UK) or any right in it;
- (c) the making by personal representatives of an assent in relation to an international trade mark (UK) or any right in or under it;
- (d) an order of a court other competent authority transferring an international trade mark (UK) or any right in or under it.

(4) Until (in the case of a notifiable transaction) an application has been made for registration of the prescribed particulars or (in the case of any other relevant transaction) the transaction has been recorded in the International Register—

- (a) the transaction is ineffective as against a person acquiring an interest in or under the international trade mark (UK) in ignorance of it, and
- (b) a person claiming to be a licensee by virtue of the transaction does not have the protection of [section 30](#) or [31](#) (rights and remedies of licensee in relation to infringement).

(5) Where a person becomes the proprietor or a licensee of an international trade mark (UK) by virtue of a relevant transaction, then unless—

- (a) an application for registration of the transaction (in the case of a notifiable transaction) is made, or (in the case of any other relevant transaction) a request for recordal in the International Register is made, before the end of a period of six months beginning with its date, or
- (b) the court is satisfied that it was not practicable for such an application or request for recordal to be made before the end of that period and that an application or request for recordal (as the case may be) was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the international trade mark (UK) occurring after the date of the transaction and before (in the case of a notifiable transaction) the prescribed particulars of the transaction are registered or (in the case of any other relevant transaction) the transaction is recorded in the International Register.

(6) “Prescribed particulars” means the particulars prescribed by [rule 34](#).

## Licensing

7.—(1) The provisions of [sections 28 to 31](#) apply, with the necessary modifications, in relation to licences to use a protected international trade mark (UK).

(2) The reference in [section 28\(1\)](#) to goods or services for which a trade mark is registered shall be treated as a reference to goods or services in respect of which the trade mark is protected in the United Kingdom.

## Priority

8.—(1) The provisions of [section 35](#) (claim to priority of Convention application) apply, subject as mentioned below, so as to confer a right to priority in relation to protection of an international registration designating the United Kingdom as they apply in relation to registering a trade mark under the Act.

(2) [Subsection \(5\)](#) of that section does not apply and the manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.

## Examination

9.—(1) Upon receiving from the International Bureau notification of an international registration designating the United Kingdom, the registrar shall examine whether it satisfies the requirements of [article 3](#).

(2) For that purpose, he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) If it appears to the registrar that the requirements referred to in [paragraph \(1\)](#) above are not met, or are met only in relation to some of the goods or services in respect of which protection in the United Kingdom has been requested, he shall give notice of refusal to the International Bureau.

(4) Notice of refusal shall specify a period within which the holder may make representations.

(5) A holder making representations shall file an address for service in the United Kingdom on Form TM33.

### **Publication, opposition proceedings and observations**

10.—(1) Where following examination pursuant to [article 9](#) it appears to the registrar that the requirements of [article 3](#) are met in relation to all or some of the goods or services comprised in the international registration, the registrar shall publish a notice specifying particulars of the international registration and specifying the goods or services for which protection will be conferred.

(2) Any person may, within three months of the date of publication pursuant to [paragraph \(1\)](#) above, give notice to the registrar of opposition to the conferring of protection.

The notice shall be given in writing in the manner prescribed by [rule 13](#), shall include a statement of the grounds of opposition and shall where opposition is based on an earlier trade mark indicate the goods or services on which the opposition is based.

(3) The registrar shall, upon notice of opposition being given, and in any event within four months of publication pursuant to [paragraph \(1\)](#) above, give notice of refusal to the International Bureau stating the matters relating to the opposition referred to in [paragraph \(2\)](#) above.

(4) Within three months of the date on which notice of refusal based on opposition is given to the International Bureau, the holder may file a counter-statement, in conjunction with notice of the same on Form TM8 and an address for service in the United Kingdom.

(5) Subject to the provisions of this article, [rules 13](#) and [14](#) shall apply in relation to opposition proceedings, with the substitution of the holder for the applicant.

(6) Where a notice has been published pursuant to [paragraph \(1\)](#) above, any person may, at any time before the trade mark has become protected in accordance with [article 12](#), make observations in writing to the registrar as to whether the trade mark should be protected.

A person who makes observations does not thereby become a party to proceedings in relation to the request for protection.

## Notices of refusal

**11.**—(1) Except where refusal is based on an opposition, notice of refusal shall not be given after the expiry of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom.

(2) The registrar shall inform the International Bureau that oppositions may be filed after the expiry of the period of 18 months referred to in [paragraph \(1\)](#) above unless, at least four months before the expiry of the said period, he has published the notice referred to in [article 10\(1\)](#).

(3) Notices of refusal shall set out the matters required by [Article 5](#) of the Madrid Protocol and [Rule 17](#) of the Common Regulations.

(4) Where—

- (a) notice of refusal has been given pursuant to [article 9\(3\)](#), and
  - (i) the holder makes representations within the period specified under [article 9\(4\)](#), or
  - (ii) the holder makes no representations within that period, or informs the registrar that he does not intend to make any representations; or
- (b) notice of refusal based on an opposition has been given pursuant to [article 10\(3\)](#) and
  - (i) the holder files a counter-statement within the period specified in [article 10\(4\)](#), or
  - (ii) the holder files no counter-statement within that period or informs the registrar that he does not intend to file a counter-statement,

the registrar shall inform the International Bureau of that fact.

(5) Where—

- (a) after notice of refusal has been given pursuant to [article 9\(3\)](#), the holder makes representations within the period specified under [article 9\(4\)](#); or
- (b) after notice of refusal based on an opposition, the holder files a counter-statement within the period specified in [article 10\(4\)](#),

the registrar shall, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(6) For the purposes of [paragraph \(5\)](#) above, a final decision shall be regarded as being made where—

- (a) the registrar, or the appointed person or the court on appeal or further appeal from the registrar, decides whether the refusal shall be upheld, in whole or in relation to some only of the goods or services in relation to which protection



in the United Kingdom is requested, and any right of appeal against that decision expires or is exhausted;

- (b) the representations or counter-statement are withdrawn; or
- (c) the proceedings relating to the refusal are discontinued or abandoned.

## Protection

12.—(1) Where—

- (a) following examination and publication pursuant to [articles 9](#) and [10](#)—
  - (i) the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom has not expired, but the period for giving notice of refusal based on an opposition in accordance with [article 10\(3\)](#) expires without notice of refusal (whether based on opposition or otherwise) having been given,
  - (ii) the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom has expired, and the period for giving notice of opposition in accordance with [article 10\(2\)](#) expires without notice of opposition having been given,
  - (iii) notice of refusal has been given in respect of some only of the goods or services in respect of which protection in the United Kingdom has been requested and the registrar informs the International Bureau in accordance with [article 11\(4\)](#) that the holder has made no representations within the period specified in [article 9\(4\)](#) or has filed no counter-statement within the period specified in [article 10\(4\)](#) (as the case may be) or that the holder has informed the registrar that he does not intend to make such representations or file such a counter-statement, or
  - (iv) notice of refusal has been given in respect of all or some of the goods or services in respect of which protection in the United Kingdom has been requested and the registrar notifies the International Bureau in accordance with [article 11\(5\)](#) that a final decision has been made that the refusal is withdrawn, or is withdrawn in respect of some of the goods or services in respect of which protection in the United Kingdom has been requested; or
- (b) the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom expires without any notice of refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period,

the trade mark which is the subject of the request for protection shall thereupon be protected as a protected international trade mark (UK); and in a case where a refusal subsists in respect of some of the goods or services in respect of which protection in the United Kingdom has been requested, protection shall apply only as regards the remaining goods or services.

(2) For the purposes of application by this Order of provisions of the Act, subject to [article 21](#), a trade mark so protected shall be treated as being registered under the Act as of the following date:—

- (a) where the request for extension of protection to the United Kingdom is mentioned in the international application, or is made subsequently, but on or before the date of the international registration, the date of that international registration;
- (b) where the request for such extension is made subsequently to the international registration, the date on which the request is recorded in the International Register.

(3) When a trade mark becomes protected pursuant to this article, the registrar shall publish particulars of the international registration specifying the date on which, and the goods or services in respect of which, protection is conferred.

## **Revocation and Invalidity**

**13.**— (1) The provisions of [section 46](#) (revocation of registration) and [section 47](#) (grounds for invalidity of registration) shall apply, subject to the adaptations set out below, so as to permit the protection of a protected international trade mark (UK) to be revoked, or declared invalid.

(2) The reference in [section 46\(1\)](#) to the date of completion of the registration procedure shall be construed as a reference to the date of the protected international trade mark (UK) becoming protected; the reference in [section 46\(2\)](#) to the form in which a trade mark was registered shall be construed as reference to the form in which it is protected; and the references in [section 46\(5\)](#) and [section 47\(5\)](#) to goods or services for which the trade mark is registered shall be construed as references to those in respect of which it is protected.

(3) The references in [section 46](#) to the registration of a trade mark being revoked and the references in [section 47](#) to the registration of a trade mark being declared invalid shall be construed as references to the protection of a protected international trade mark (UK) being revoked or declared invalid, as the case may be.

(4) The provisions of [rule 31](#), with necessary modifications, apply in relation to the procedure on application for revocation and declaration of invalidity of protection of a protected international trade mark (UK).

(5) 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 the date on which the revocation is recorded in the International Register;
- (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):

Provided that this shall not affect transactions past and closed as at the date when the invalidity is recorded in the International Register.

## **Effect of acquiescence**

**14. Section 48** (effect of acquiescence) applies where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a protected international trade mark (UK); and for that purpose—

- (a) the reference to a registered trade mark shall be construed as including a protected international trade mark (UK);
- (b) the references to registration shall include references to protection of a protected international trade mark (UK).

## **Proceedings relating to invalidity and revocation of protection**

**15.—(1)** The provisions of **section 73** (certificate of validity of contested registration) apply, with the necessary modifications, in relation to proceedings before the court in which the validity of the protection of a protected international trade mark (UK) is contested.

(2) The provisions of **section 74** (registrar's appearance in proceedings involving the registrar) apply, with the necessary modifications, in relation to proceedings before the court involving an application for—

- (a) the revocation of the protection of a protected international trade mark (UK);
- (b) a declaration of the invalidity of the protection of a protected international trade mark (UK);
- (c) the rectification of the supplementary register.

## **Importation of infringing goods, materials or articles**

**16.** The provisions of **section 89** (infringing goods, material or articles may be treated as prohibited goods) **section 90** and **section 91** of the Act (power of Commissioners of Customs and Excise to disclose information) apply in relation to goods which are, in relation to a protected international trade mark (UK), infringing goods, materials or articles, and for the purposes of those provisions—

- (a) references to a registered trade mark shall be to a protected international trade mark (UK);
- (b) the Trade Marks (Customs) Regulations 1994<sup>(a)</sup> shall apply in relation to notices given under the provisions of **section 89**.

## **Offences and forfeiture**

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<sup>(a)</sup> S.I. 1994/2625

17.—(1) The provisions of [section 92](#) (unauthorised use of trade mark, etc, in relation to goods), [section 93](#) (enforcement function of local weights and measures authority), [section 97](#) (forfeiture: England and Wales) and [section 98](#) (forfeiture: Scotland) apply in relation to a protected international trade mark (UK).

(2) For the purposes of the provisions referred to in [paragraph \(1\)](#) above—

- (a) references to a registered trade mark shall be treated as references to a protected international trade mark (UK);
- (b) references to goods in respect of which a trade mark is registered shall be treated as references to goods in respect of which a protected international trade mark (UK) confers protection in the United Kingdom.

(3) No offence under [section 92](#) in relation to a protected international trade mark is committed by anything done before the date of publication pursuant to [article 120\(3\)](#).

## **Falsely representing trade mark as a protected international trade mark (UK)**

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

- (a) falsely to represent that a mark is a protected international trade mark (UK), or
- (b) to make a false representation as to the goods or services for which a protected international trade mark (UK) confers protection in the United Kingdom

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

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

## **TRANSFORMATION OF AN INTERNATIONAL REGISTRATION INTO A NATIONAL APPLICATION**

### **Transformation applications**

19.—(1) The provisions of this article apply where—

- (a) an international registration designating the United Kingdom is cancelled at the request of the Office of origin under [Article 6\(4\)](#) of the Madrid Protocol in respect of all or some of the goods or services listed in the registration;
- (b) an application (a “transformation application”) is made to the registrar, within three months of the date on which the international registration was cancelled, for registration in the United Kingdom of a trade mark identical to that comprised in the international registration in respect of some or all of the goods or services in respect of which the international registration was cancelled; and

(c) the application is made by the person who was the holder of the international registration immediately before its cancellation.

(2) A transformation application shall be made on Form TM3 and shall state that it is made by way of transformation.

(3) A trade mark registered pursuant to a transformation application shall be treated as if it were registered as of the date of the international registration according to [Article 3\(4\)](#) of the Madrid Protocol or, where the request for extension to the United Kingdom was made subsequently to the international registration, on the date of recordal of that request according to [Article 3ter](#) of the Madrid Protocol, and that date shall be deemed for the purposes of the Act to be the date of registration.

## **Procedure on transformation application**

**20.**—(1) Where the international trade mark (UK) has become protected pursuant to [article 12](#) on or before the actual date on which the transformation application is made (“the transformation date”) the trade mark shall be registered under the Act.

(2) Where the international registration designating the United Kingdom has not become protected under [article 12](#) at the transformation date and a notice has been published pursuant to [article 10\(1\)](#) in respect of the trade mark, the registrar shall treat the publication of such notice as being the publication of the transformation application under [section 38\(1\)](#) and shall publish a notice that it is being so treated. Any opposition shall be treated as opposition under [section 38\(2\)](#).

(3) Where a notice has not yet been published pursuant to [article 10\(1\)](#) at the transformation date and the registrar has issued a notice of refusal pursuant to [article 9\(3\)](#), the registrar shall for the purposes of the transformation application treat the notice of refusal as if it had been issued under [section 37\(3\)](#).

The registrar shall in that event inform the applicant of the nature of the response required of him in respect of his transformation application and shall further specify the period within which the applicant must respond to the registrar.

## **CONCURRENT REGISTRATIONS**

### **Effects of international registration where trade mark is also registered under the Act**

**21.**—(1) The provisions of this article apply, without prejudice to the rights and remedies conferred in respect of a trade mark registered under the Act, where—

- (a) the registered trade mark is also a protected international trade mark (UK);
- (b) the proprietor of the registered trade mark is the holder of the international trade mark (UK);
- (c) all the goods or services in respect of which the registered trade mark is registered are protected under the protected international trade mark (UK);

(d) the date of registration of the registered trade mark is earlier than the date specified in [article 12\(2\)](#) in relation to the international trade mark (UK).

(2) For the purposes of application by this Order of the provisions of the Act, the protected international trade mark (UK) shall be treated, notwithstanding the provisions of [article 12\(2\)](#), as being registered under the Act as of the date of registration of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered.

(3) For the purpose of determining whether the international trade mark (UK) is an earlier trade mark, it shall be treated as having the date of application of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered, taking account (where appropriate) of the priorities claimed in respect of the registered trade mark.

(4) Where the conditions specified in [paragraph \(1\)](#) above are satisfied in relation to a trade mark, the provisions of [paragraphs \(2\)](#) and [\(3\)](#) above shall continue to apply in respect of the relevant international trade mark (UK) notwithstanding that the relevant registered trade mark lapses or is surrendered, but shall cease to apply if it revoked or declared invalid.

(5) 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.

(6) For the purposes of [paragraph \(5\)](#) above, the holder of the protected international trade mark (UK) shall make an application to the registrar using Form TM28.

## **INTERNATIONAL APPLICATIONS ORIGINATING IN THE UNITED KINGDOM**

### **Application for international registration**

**22.**—(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 article, apply through the registrar for the international registration of the trade mark.

(2) An application for international registration may be made only where the applicant for such registration is—

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

(3) The particulars appearing in the application shall correspond with the particulars appearing at that time in the basic application or basic registration as the case may be.

(4) The applicant for international registration shall provide at the request of the registrar such evidence as may be necessary to satisfy him that the applicant is eligible to make the application in accordance with [paragraph \(2\)](#) above.

(5) If an international application complies with the requirements set out in this article, the registrar shall submit the international application to the International Bureau.

(6) In this Order—

- (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.

## **Notification to International Bureau**

**23.**—(1) Where the registrar has submitted an application for international registration, he shall notify the International Bureau of the occurrence of any of the events specified in [paragraph \(2\)](#) below and shall request the International Bureau to cancel the international registration as regards those goods or services covered by the international application in respect of which the basic application or basic registration has ceased to subsist by reason of that event.

(2) The following events are specified for the purposes of [paragraph \(1\)](#) above:

- (a) before the expiry of five years from the date of the international registration, the registrar refuses to accept the basic application as regards some or all of the goods or services covered by the international registration or, after accepting the application, refuses to register the trade mark as regards some or all of those goods or services, having regard to matters coming to his notice since he accepted the application, and in either case that decision becomes a final decision, whether before or after the expiry of that period of five years;
- (b) opposition proceedings begun before the expiry of five years from the date of the international registration result in a final decision not to register the trade mark as regards some or all of the goods or services covered by the international registration;
- (c) the basic application is withdrawn, or is restricted as regards goods or services covered by the international registration, as a result of a request by the applicant made before the expiry of five years from the date of the international registration, or made subsequently when the basic application was at the time of the request subject to an appeal against refusal of registration or to opposition proceedings begun in either case before the expiry of that five year period;

- (d) the registration resulting from the basic application or the basic registration expires without renewal and is removed from the register before the expiry of five years from the date of the international registration and no request for its restoration is made within the time specified in **rule 30** or such a request is made and a final decision is made to refuse the request;
- (e) a final decision is made to revoke or declare invalid the registration resulting from the basic application or the basic registration, as a result of proceedings begun before the expiry of five years from the date of the international registration;
- (f) the registration resulting from the basic application, or the basic registration, is surrendered as a result of a request by the proprietor made before the expiry of five years from the date of the international registration, or made subsequently where at the time of the request—
  - (i) the basic application was subject to an appeal against refusal of registration or to opposition proceedings; or
  - (ii) the registration resulting from the basic application, or the basic registration, was subject to proceedings for revocation or invalidation;

and such appeal or proceedings were begun before the expiry of five years from the date of the international registration.

(3) For the purposes of this article:—

- (a) a final decision shall be regarded as made where—
  - (i) any right of appeal against the decision expires or is exhausted, or
  - (ii) proceedings relating to an application or registration are discontinued or abandoned;
- (b) reference to an application being withdrawn includes its being deemed to be withdrawn, or abandoned, or deemed never to have been made.

## **MISCELLANEOUS AND GENERAL PROVISIONS**

### **Supplementary Register**

**24.**—(1) The registrar shall maintain a register (“the supplementary register”) for the purpose of recording, in relation to international trade marks (UK)—

- (a) disclaimers and limitations;
- (b) notifiable transactions.

(2) The supplementary register need not be kept in documentary form.

(3) **Rules 34 to 39** apply, with the necessary modifications, in relation to the supplementary register.

### **Disclosure of Information**



**25.**—(1) Before publication of notice under [article 10\(1\)](#) in relation to an international registration designating the United Kingdom, the registrar shall not publish or communicate to any person documents or information relating to the international registration other than as provided in [paragraph \(2\)](#) below.

(2) In relation to an international registration designating the United Kingdom, the registrar shall on request make available for inspection by the public all information in his possession which is recorded in the International Register concerning that registration, the particulars contained in any application for registration of a notifiable transaction and any entry in the supplementary register resulting from such an application.

(3) Subject to [paragraph \(5\)](#) below, after publication of notice under [article 10\(1\)](#) in relation to an international registration designating the United Kingdom, the registrar shall on request provide a person with such information and permit him to inspect such documents, relating to the international registration as may be specified in the request.

(4) A request for information relating to an international registration designating the United Kingdom shall be made on Form TM31M.

(5) **Paragraphs (2) to (5) of rule 44**, and **rule 45**, apply in relation to the right of inspection conferred by [paragraph \(3\)](#) above.

(6) Where a person has been notified that an international registration designates the United Kingdom and that the proprietor will, if the registration becomes a protected international trade mark (UK), bring proceedings against him in respect of acts done after publication of notice under [article 10\(1\)](#), the registrar shall on request permit inspection under [paragraph \(3\)](#) above notwithstanding that such notice has not been published and that paragraph shall apply accordingly.

## **Exclusion of Liability**

**26.**—(1) The registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Order, or in any report or other proceedings consequent on such examination.

(2) No proceedings lie against an officer of the registrar in respect of any matter for which, by virtue of this article, the registrar is not liable.

## **Evidence of certain matters relating to an international registration**

**27.**—(1) In all legal proceedings relating to an international trade mark (UK), the registration of a person as holder of an international trade mark (UK) shall be prima facie evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it.

(2) 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.

(3) Any document mentioned in [paragraph \(2\)\(b\)](#) or [\(c\)](#) above shall be admissible as evidence of any instrument or other act thereby communicated of the International Bureau.

(4) Evidence of any instrument issued by the International Bureau or any entry in or extract from such a document may be given in any legal proceedings by production of a copy; and any document purporting to be such a copy shall be received in evidence.

(5) In any legal proceedings in Scotland, evidence of any matter given in any manner authorised by this article shall be sufficient evidence of it.

(6) In this article, ‘legal proceedings’ includes proceedings before the registrar.

## **Agents**

**28.** Any act required or authorised by this Order to be done by or to a person in connection with a request for protection of an international registration as a protected international trade mark (UK) or any procedure relating to a protected international trade mark (UK) may be done by or to an agent authorised by that person orally or in writing.

## **Burden of proving use of international trade mark (UK)**

**29.** If in any civil proceedings pursuant to this Order a question arises as to the use to which an international trade mark (UK) has been put, it is for the holder to show what use has been made of it.

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

**30.** Notwithstanding [section 67\(2\)](#) or 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 the Common Regulations.

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

**31.** 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 he 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.

## **Application of Trade Marks Rules 1994**

**32.—(1)** Except as otherwise provided, or where their application would be inconsistent with the provisions of this Order, the Rules shall apply, with the necessary modifications, in relation to an international registration designating the United Kingdom,

(including a protected international trade mark (UK)) as in relation to a registered trade mark or application.

(2) In their application to an international registration designating the United Kingdom, the Rules shall be treated in all respects as rules made under the Act and, in particular, rules relating to costs and security for costs and to evidence before the registrar shall be enforceable in relation to proceedings under this Order in the same manner as in relation to proceedings relating to a registered trade mark or application.

*Ian Taylor,*

Parliamentary Under-Secretary  
of State for Science and Technology,

11th March 1996 Department of Trade and Industry

### **EXPLANATORY NOTE**

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

This Order gives effect in the United Kingdom to the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27th June 1989 (“the Madrid Protocol”) which the United Kingdom ratified on 6th April 1995. The arrangements made under the Madrid Protocol become effective on the 1st April 1996 and the Order comes into force on that date.

The Madrid Protocol provides that the proprietor of, or the applicant for, a national registration of a trade mark may apply through the national trade marks office for a registration of that trade mark in the International Register of the International Bureau of the World Intellectual Property Organisation (“WIPO”). Protection for an international registration may be requested in any other contracting state to the Madrid Protocol by the holder of the international registration. Where protection is requested in respect of an international registration originating in another contracting state, the state in respect of which protection is requested is entitled to refuse protection where the international registration cannot be granted on the grounds which would apply under the International Convention for the Protection of Industrial Property (Cmnd. 4431). Provided that no refusal has been notified to the International Bureau, contracting states are required to accord the same protection to the international registration of the trade mark as if the trade mark had been registered with the trade mark office of that contracting state.

The procedure for registration of a trade mark at the International Bureau is governed by the Common Regulations adopted under the Madrid Protocol and which come into force on 1st April 1996. Trade marks registered in the International Register are to be published in a periodical gazette issued by the International Bureau.

The Order makes provision where protection is sought in the United Kingdom for an international registration originating in another contracting state. It also makes provision for applications for international registration which originate in the United Kingdom.

An international registration originating in another contracting state in respect of which protection is sought in the United Kingdom is entitled to become protected where it satisfies the requirements of an application for registration under the Trade Marks Act 1994 including any imposed by the Trade Marks Rules 1994 ([article 3](#)). The provisions of the Trade Marks Act 1994 apply with modifications where protection is conferred in respect of an international registration in the United Kingdom as a protected international trade mark (UK).

In particular, provision has been made for—

- (a) the rights conferred by and limitations of a protected international trade mark (UK); international trade mark (UK) as an object of property; notification of transactions and licensing of a protected international trade mark (UK) ([articles 3–8](#));
- (b) the procedure where the Patent Office is notified of a request for protection, including examination, publication, opposition proceedings, notices of refusal and conferring of protection ([articles 9–12](#));
- (c) revocation of protection, invalidity and proceedings related thereto; effect of acquiescence ([articles 13–14](#));
- (d) prevention of importation of infringing goods, offences and forfeiture, falsely representing a trade mark as a protected international trade mark (UK) ([articles 16–18](#));
- (e) transformation of an international registration into a national application for registration where the international registration is cancelled and related procedure ([articles 19–20](#));
- (f) effects of international registration where a trade mark is also registered under the Trade Marks Act 1994 ([article 2](#));

The Order also provides that applicants for a registered trade mark or a proprietor of a registered trade mark may apply through the Patent Office for an international registration. Where an application for international registration complies with the requirements specified in [article 22](#) of the Order, the registrar is required to submit the application to the International Bureau. The Order also provides that following the occurrence of certain events which result in an application for a trade mark or a registered trade mark to cease to subsist, the registrar shall notify the International Bureau of that event and request the International Bureau to cancel the international registration in respect of that trade mark or application ([article 2](#)).

The Order makes provision for a supplementary register to be established for the purposes of recording certain transactions in relation to international trade marks (UK) for which no provision is made in the International Register ([article 24](#)).

The Order also contains miscellaneous and general provisions in relation to various matters including the disclosure of information, communication of information to the International Bureau, exclusion of liability of the Patent Office, evidential matters, transmission of fees payable to the International Bureau and the application of the Trade Marks Rules 1994 (S.I. 1994/2583) ([articles 25–32](#)).

Provision has been made in a separate instrument for the payment of fees in respect of any matters arising under this Order.

The Madrid Protocol is published as Cm 1601 Miscellaneous Series No. 14 (1991). Copies of the Common Regulations are available from: WIPO P.O. Box 18 CH-1211 Geneva 20 Switzerland.

The addresses for the filing of documents at the Patent Office are prescribed in the Patent Office (Address) Rules 1991 (S.I. 1991/675), namely—

- (i) Cardiff Road, Newport, Gwent NP9 1RH; and
- (ii) 25 Southampton Buildings, London WC2A 1AY.