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STATUTORY INSTRUMENTS

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**1996 No. 1908**

**TRADE MARKS**

**The Community Trade Mark Regulations 1996**

<i>Made</i>	- - - -	<i>23rd July 1996</i>
<i>Laid before Parliament</i>		<i>23rd July 1996</i>
<i>Coming into force</i>	- -	<i>14th August 1996</i>

The Secretary of State, in exercise of powers conferred by section 52 of the Trade Marks Act 1994<sup>(1)</sup> hereby makes the following Regulations:—

1.—(1) These Regulations may be cited as the Community Trade Mark Regulations 1996 and come into force on 14th August 1996.

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

**Interpretation**

2. In these Regulations—

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

“the Community Trade Mark Regulation” means Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community trade mark<sup>(2)</sup>;

“the Rules” means the Trade Marks Rules 1994<sup>(3)</sup> and references to a rule shall, unless the context otherwise requires, be construed accordingly.

**Determination *a posteriori* of invalidity and liability to revocation**

3.—(1) Where the proprietor of a Community trade mark claims the seniority of a registered trade mark which has been removed from the register under section 43 or has been surrendered under section 45, application may be made to the registrar or to the court by any person for a declaration that, if the registered 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.

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(1) 1994 c. 26.

(2) O.J. No. L 11, 14.1.94.

(3) S.I. 1994/2583.

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

(3) The provisions of section 46 or 47 (as the case may be), sections 72, 74 and 76, with necessary modifications, apply in relation to an application under paragraph (1) above.

(4) The provisions of rule 31, with necessary modifications, apply in relation to the procedure on applications made under paragraph (1) above.

#### **Groundless threats of infringement proceedings**

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

#### **Privilege for communications with professional representatives**

5. The provisions of section 87 (privilege for communications between a person and his registered trade mark agent) apply in relation to persons on the list of professional representatives maintained in pursuance of Article 89 of the Community Trade Mark Regulation (“professional representatives”) and for this purpose the definition of “trade mark agent” in subsection (3) of that section includes professional representatives.

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

6. 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 Community trade mark, infringing goods, material or articles, and for the purposes of those provisions —

- (a) references to a registered trade mark shall include a Community trade mark;
- (b) the Trade Marks (Customs) Regulations 1994<sup>(4)</sup> shall apply in relation to notices given under the provisions of section 89.

#### **Offences and forfeiture**

7. 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 Community trade mark and for the purposes of those provisions—

- (a) references to a registered trade mark shall include a Community trade mark;
- (b) references to goods in respect of which a trade mark is registered shall include goods in respect of which a Community trade mark is registered.

#### **Falsely representing trade mark as a Community trade mark**

8.—(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.

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(4) S.I. 1994/2625.

(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.

#### **Designation of Community Trade Mark courts**

9. 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 and Northern Ireland, the High Court, and
- (b) in Scotland, the Court of Session.

#### **Conversion**

10.—(1) The provisions of this Regulation apply where 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 (“conversion application”) pursuant to Article 108 of the Community Trade Mark Regulation.

(2) Where the registrar decides that a request for a conversion application is admissible pursuant to Article 108, 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 a conversion application shall be treated as a decision of the registrar under the Act.

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

11. Except as otherwise provided, or where their application would be inconsistent with the provisions of these Regulations, the Rules shall apply, with the necessary modifications, to these Regulations.

23rd July 1996

*Ian Taylor,*  
Parliamentary Under Secretary of State for  
Science and Technology,  
Department of Trade and Industry

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## EXPLANATORY NOTE

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

These Regulations make provision for the operation of the Community Trade Mark Regulation (Council Regulation (EC) No. 40/94 of 20th December 1993 (O.J. No. L 11, 14.1.94, p.1)). In particular, these Regulations provide for the following:

- (a) the procedures for determining a posteriori the invalidity, or liability to revocation, of the registration of a trade mark from which a Community trade mark claims seniority;
- (b) the conversion of a Community trade mark, or an application for a Community trade mark, into an application for registration under the Trade Marks Act 1994;
- (c) the designation of courts in the United Kingdom having jurisdiction over proceedings arising out of the Community Trade Mark Regulation;
- (d) the application in relation to a Community trade mark of the provisions of the Trade Marks Act 1994 which deal with groundless threat of infringement proceedings, importation of infringing goods, material or articles and offences;
- (e) privilege for communications with persons on the list of professional representatives maintained in pursuance of Article 89 of the Community Trade Mark Regulation;
- (f) the application of the Trade Marks Rules 1994 (S.I.1994/2583).