

## ***The Trade Marks (Proof of Use, etc.) Regulations 2004***

2004 No. 946

### **TRADE MARKS**

The Trade Marks (Proof of Use, etc.) Regulations 2004

Made 28th March 2004

Laid before Parliament 31st March 2004

Coming into force 5th May 2004

The Secretary of State, being a Minister designated for the purposes of section 2(2) of the European Communities Act 1972 in relation to measures relating to patents and to trade marks, in exercise of the powers conferred on her by that section, hereby makes the following Regulations:

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

1. These Regulations may be cited as the Trade Marks (Proof of Use, etc.) Regulations 2004 and shall come into force on 5th May 2004.
2. These Regulations extend to England and Wales, Scotland and Northern Ireland.

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

3. The Trade Marks Act 1994 shall be amended as follows.
4. After section 6 there shall be inserted -  
" 6A Raising of relative grounds in opposition proceedings in case of non-use
  1. This section applies where -
    - a. an application for registration of a trade mark has been published,
    - b. there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
    - c. the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
  2. In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

3. The use conditions are met if -
    - a. within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
    - b. the earlier trade mark has not been so used, but there are proper reasons for non-use.
  4. For these purposes -
    - a. use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
    - b. use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
  5. In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
  6. Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
  7. Nothing in this section affects -
    - a. the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
    - b. the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."
5. In section 40 (registration), in subsection (1), for the words after "his notice" there shall be substituted "since the application was accepted that the registration requirements (other than those mentioned in section 5(1), (2) or (3)) were not met at that time."
6. In section 47 (grounds for invalidity of registration), after subsection (2) there shall be inserted -
- " (2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -
- a. the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
  - b. the registration procedure for the earlier trade mark was not completed before that

date, or

- c. the use conditions are met.

(2B) The use conditions are met if -

- a. within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- b. it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

- a. use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- b. use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

7. -

- 1. In section 5, subsection (3)(b) and the word "and" immediately preceding it shall be omitted.
- 2. In section 10(3) -
  - a. after the words "course of trade" there shall be inserted ", in relation to goods or services,";
  - b. paragraph (b) and the word "and" immediately preceding it shall be omitted.

### **Transitional provisions**

8. Regulations 4 and 5 shall not apply in respect of any application for the registration of a trade mark which has been published before they came into force.

9. Any application under section 47(3) of the Trade Marks Act 1994 (application for a declaration of invalidity) which was made before the coming into force of these Regulations shall be dealt with under section 47 as it had effect before regulation 6 came into force.

Sainsbury of Turville,

Parliamentary Under-Secretary of State for Science and Innovation, Department of Trade  
and Industry

28th March 2004

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## **EXPLANATORY NOTE**

(This note is not part of the Regulations)

Regulations 4 to 6 implement Article 11(1) and (2) of Directive 89/104/EEC, the First Council Directive to approximate the laws of the Member States relating to trade marks (O.J. L40, 11.2.89, p.1) ("the Directive").

Regulation 4, which implements Article 11(2) of the Directive in part, inserts a new section 6A into the Trade Marks Act 1994 ("the Act"). This section will require an opponent who bases his opposition to the registration of a trade mark on certain earlier trade marks to show use of those marks.

Regulation 5 makes a consequential amendment to section 40 (registration) of the Act.

Regulation 6, which implements Article 11(1) of the Directive, inserts five new subsections into section 47 of the Act (invalidity). These subsections require an applicant who bases his application for a declaration of invalidity on certain earlier trade marks to show use of those marks.

Regulation 7 repeals section 5(3)(b) and amends section 10(3) of the Act. These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or services which are not similar where the earlier trade mark has a reputation and the use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered.

Regulations 8 and 9 are transitional provisions relating to opposition proceedings and applications for a declaration of invalidity.

A Regulatory Impact Assessment is available, copies of which have been placed in the libraries of both Houses of Parliament. Copies of the assessment are also available from the Trade Marks Directorate, The Patent Office, Concept Office, Cardiff Road, Newport, NP10 8QQ.