

On 14 January 2019, the [Trade Marks Regulations 2018](#) (the Regulations) came into force in the UK, amending provisions in the Trade Mark Act 1994 (TMA) and the Trade Mark Rules 2008, bringing UK trade mark law in line with that of the EU. The changes introduced can be divided into three main areas: trade mark applications, trade mark disputes and trade mark management.

Trade Mark Applications

Definition of a Trade Mark

Traditionally, trade marks had to be capable of graphical representation, but the Regulations amend this, so that any mark which can be represented “in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded” is now capable of registration. This means that elements such as sound, movement, colours and possibly even smells may potentially be registered as trade marks within the UK. Applications can be supported by a variety of formats, such as MP3s or JPEGs.

Whilst this brings the UK into line with the EU Community trade mark system, applicants should bear in mind that any international applications within the Madrid system currently still require graphical representation – and will require a “traditional”, graphically represented UK application to support it.

Extension of the Grounds of Mandatory Objections

The Regulations’ extension to the definition of a trade mark has been mirrored by an extension to the grounds of objection.

Previously, applicants would not be permitted to register a mark which consisted solely of shapes which purely have a technical function, added value to the goods, or where they were the result of the nature of the goods. This has been extended to prevent registration of any mark which consists of any characteristic which is inherent to the goods – and so may cover elements such as smells or sounds.

Collective Trade Marks

The Regulations introduce several changes to the law around collective trade marks – those marks which have traditionally been held by trade associations and used by members to designate membership.

The definition of who may apply for a collective mark has been expanded and there are additional requirements for provisions to be included in the regulations that holders must produce to govern collective marks (and who will be allowed to use them). Rules around action for infringement of a collective mark have also been amended (for example, permission or agreement from the mark’s proprietor will be required before an authorised user can take action).

Notification of Earlier Rights

When a UK trade mark application is made, the UK Intellectual Property Office (UKIPO) searches for marks which are already registered and which may conflict with the new application. Following implementation of the Regulations, the UKIPO will no longer notify an applicant of any trade mark which was registered, but has since expired.

Because an expired mark may be restored to the register up to 12 months after its renewal date (and, subsequently, block the more recent application), it is important that all applicants carry out full clearance searches, including a review of any recently expired marks, although the Regulations provide a defence for any use of a later trade mark in good faith, in certain circumstances, where an expired mark is subsequently restored to the register.

Definition of the “Five-Year Period” in Opposition Proceedings

During a trade mark application, the holder of a similar, pre-existing mark may raise an objection. Such objection requires genuine use of the mark in a defined five-year period. The Regulations have amended the definition of the five-year period so that it is now from the date of the application of the mark (or its priority date), rather than the date of the publication of the mark, in line with the EU proof of use requirements.

Trade Mark Disputes

Counterfeit Disputes

The Regulations have introduced changes which may offer additional possibilities for taking action against counterfeiting.

For example, enforcement action is now permitted against those indirectly aiding in the production of counterfeit goods by preparing infringing packaging, labels or other materials, even if the producer was unaware of the potential infringement.

In addition, where a trade mark holder becomes aware that counterfeit goods are passing through the UK to a country outside the EU, it can ask the UK customs authority to seize such goods. Historically, to take advantage of this right, a trade mark owner had to demonstrate that goods would have been put on the UK market, resulting in few seizures being carried out. The Regulations shift the burden of proof and now require the exporter to provide evidence that the trade mark holder is not entitled to prohibit the putting of such goods on the market of their destination, which may lead to an increased use of the right to seizure.

Infringement Procedures

The Regulations allow courts, for the first time, to determine issues relating to the validity of a trade mark during infringement proceedings, marking a change from the previous requirement (based on the premise that a registered mark could not infringe another registered mark) that infringement proceedings could not occur until registration of a mark had been cancelled. From a practical perspective, this means that there will be no need for separate invalidity and infringement actions.

Defences Against Infringement

“Own Name” Defence

The Regulations narrow the scope of the “own name” defence so that the corporate use of trade or company name will no longer be a defence to infringement (it will only be available where used by an individual in their personal capacity).

The [guidance from the UK government on the implementation of the Regulations](#) recognises that this may cause difficulties as, following 14 January 2019, companies which previously used their names legitimately, may now be liable for infringement and advises that specialist legal advice is sought.

Non-use Defence

Anyone alleging registered trade mark infringement must show that their registration is valid and that they have made genuine use of the mark during the previous five years. As part of a defence to trade mark infringement, the Regulations now permit a request for the original owner of the mark to provide proof of such genuine use.

Invalidation Proceedings – Proof of Use Requirements

In proceedings to invalidate a registered trade mark on the basis of a pre-existing mark, the Regulations make it necessary to demonstrate use of the original mark for a five-year period preceding the invalidation application.

If the later mark has been on the register for longer than five years, the original mark's owner may now also be required to demonstrate genuine use of the mark for a period of five years prior to the application of the later mark, so as to ensure that the original owner does not unfairly preserve rights by making only minimal use of the mark.

Trade Mark Management

Licensing

In addition to extending the licensing provisions in the TMA to cover applications for trade marks, as well as registered marks, the Regulations now permit an owner of a licensed mark to take action against a licensee who breaches certain licence terms (such as those relating to term or the geographic area in which the mark can be used) under trade mark law rather than under contract law – potentially offering a trade mark owner a simpler route of action.

The manner in which a licensee can take legal action against a potential infringer is also changed under the Regulations, and non-exclusive licensees are now prohibited from taking legal action without the owner's permission. Exclusive licensees may take legal action if the trade mark owner either refuses permission or fails to grant it within two months of request.

In addition, the Regulations introduce a right for a licensee to intervene in infringement proceedings brought by the owner of a mark in order to seek compensation for any loss the licensee has suffered (before the implementation of the Regulations, although the court could take any licensees' losses into account, such damages would be awarded to the owner, on behalf of such licensee).

Dividing Registrations

From the date of implementation, trade mark registrations, as well as applications, may be divided. This may be beneficial where a registration is the subject of a dispute, although owners must bear in mind that any licenses, security interests or disclaimers recorded against the registered mark will also apply to each of the divided registrations, unless their removal is requested and permitted.

Renewal and Restoration

Once registered for 10 years, a renewal fee is payable for the mark to remain on the register. The UKIPO will continue to provide renewal reminders; however, these will be sent six months prior to expiry (rather than the previous four months).

If the trade mark is not renewed, it will be removed from the register, although a trade mark may be restored to the register if the IPO decides that the failure to renew was “unintentional”. This is a change under the Regulations and is seen to be easier to establish than the previous position (where the IPO had to decide if it would be “just” to renew the mark).

Conclusion

The Regulations introduce a number of changes which may have considerable impact on the marks you protect by registration, as well as the management of both those registrations, and their exploitation and protection from infringement. For further advice and assistance with your trade mark portfolio, and any other intellectual property law issues, please contact the listed lawyer for more information.

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