

**EXPLANATORY MEMORANDUM TO**  
**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008**

**2008 No. 2206**

1. This explanatory memorandum has been prepared by the Department for Innovation Universities and Skills and is laid before Parliament by Command of Her Majesty.

**2. Description**

2.1 This instrument modernises and replaces The Trade Marks (International Registration) Order 1996 (SI 1996 No 714 as amended) (“the Order”). The Order is made under powers conferred by section 54 of the Trade Mark Act 1994 (“TMA”) and gives effect in the UK to the provisions of the Madrid Protocol, which is the system by which trade marks can be registered internationally and subsequently protected in the holder’s choice of designated states or territories.

**3. Matters of special interest to the Joint Committee on Statutory Instruments**

3.1 None

**4. Legislative Background**

4.1 The existing Order has been amended five times since it came into force, normally in the wake of changes to domestic trade mark rules. Recent changes to the latter have been consulted upon and resulted in a new statutory instrument (SI 2008 No 1797, The Trade Marks Rules 2008, the “Rules”) which comes into force on 1<sup>st</sup> October 2008. A number of changes, in particular in relation to oppositions and other *inter-partes* actions, also apply to international marks designating the UK, through the mechanism of the Order.

4.2 In order to preserve the principle of parity of treatment with domestic trade mark applications, the Order must be replaced. That said, not all procedures and practices that apply to domestic trade marks are the same for international marks. This is largely because the international system divides up responsibility for registration and formal examination between the international authority (the World Intellectual Property Organisation, WIPO) and designated national authorities, the latter carrying out examination of applications for trade marks substantively under their own laws. The legal function of the Order is to make the link between self standing international provisions contained in the Madrid Protocol and Common Regulations made under the Protocol, and domestic trade mark law. In the UK the latter consists of the Trade Marks Act 1994 (as Amended) and the Rules, as cited above.

4.3 In performing this linking function, the Order has now been recast to make it a complete code of the treatment of international marks where its predecessor was

not. This is achieved by applying or disapplying specific sections of the Act and the Rules and mirroring as much as is possible the domestic regime – particularly in respect of procedural matters.

- 4.4 The recasting of the Order however is entirely technical and involves no policy changes. The Act, the Rules and the Order are now firmly meshed together to form a whole, in relation to which future change will be consulted upon and implemented simultaneously.
- 4.5 In relation to changes affecting the tribunal function of the UK-IPO, in accordance with section 8 of the Tribunals and Inquiries Act 1992 we have, by communication dated 2<sup>nd</sup> July 2008, consulted with the Administrative Justice and Tribunals Council (“AJTC”).

## **5. Territorial Extent and Application**

- 5.1 This instrument applies to all of the United Kingdom and to the Isle of Man.

## **6. European Convention on Human Rights**

- 6.1 As the instrument is subject to negative resolution procedure and does not amend primary legislation, no statement is required

## **7 Policy background**

- 7.1 As explained above, the new Order contains no policy changes.

### **Consultation**

- 7.2 Given the technical nature of this instrument, the absence of policy changes and the fact that comment was only required on the legal functioning of the Order, a one month informal consultation period was agreed with Ministers. This took place in June 2008. Copies of the draft were sent directly to individuals on our stakeholder group, the Registry Practices Working Group. Those individuals represent professional groups such as CIPA (Chartered Institute of Patent Agents), ITMA (Institute of Trade Mark Attorneys), TMPDF (Trade Marks and Patents Design Federation), as well as other individuals such as barristers and solicitors who had expressed a specific interest. Further, the instrument was posted on our website and drawn attention to specialist – and widely consulted – intellectual property Web Log sites. This approach to the consultation is believed to have covered all the relevant interest groups, given that the users of the international system of trade mark registration tend only to be larger multinational concerns whose brand strategy spans different countries and regions.

7.3. Two responses were received. Both are from users of the Madrid system and who have practical knowledge as a result. Both responses were, in general terms, very supportive of the overall recasting of the Order.

## **8. Impact**

8.1 As the Order is a measure whose detailed effect is drawn from the Rules, no assessment is required, given that the impact of the Order extends from the latter for which an impact assessment has already been prepared.

## **9. Contact**

Edward Smith at the UK Intellectual Property Office (an executive agency of the Department for Innovation Universities and Skills) Tel: GTN 1214 1196 or e-mail: [edward.smith@ipo.gov.uk](mailto:edward.smith@ipo.gov.uk) can answer any queries regarding the instrument.