



Workshop: Plain packaging in the industry

EU Overview of the status of national legislation

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Abstract

1. Background: **International Treaties**

- Paris Convention (Art 7)
- TRIPS
- Tobacco Product Directive

2. First country to implement plain packaging law for tobacco products – Australia (2012)

3. EU Position: Tobacco Products Directive (2014/40/EU)

Entered into force on 19 May 2014

Became applicable in EU countries on 20 May 2016

4. UK, the second country in the world to pass legislation standardised packaging as The Standardised Packaging of Tobacco Products Regulations 2015. These Regulations came into force on 20th May 2016.

Miscellaneous provision that mentions registered trade marks and design , Rule 13 and 14.

5. Legal Challenge in the UK

BRITISH AMERICAN TOBACCO UK LIMITED BRITISH AMERICAN TOBACCO (BRANDS) INC. BRITISH AMERICAN TOBACCO (INVESTMENTS) LIMITED PHILIP MORRIS LIMITED PHILIP MORRIS BRANDS SARL PHILIP MORRIS PRODUCTS S.A. JT INTERNATIONAL SA GALLAHER LIMITED IMPERIAL TOBACCO LIMITED TANN UK LIMITED TANNPAPIER GMBH BENKERT UK LIMITED DEUTSCHE BENKERT GMBH & CO KG

V

SECRETARY OF STATE FOR HEALTH

- Conclusions in paragraph 46. “ For the reasons set out in this judgment all of the applications for judicial review fail. The Regulations were lawful when they were promulgated by Parliament and they are lawful now in the light of the most up to date evidence.”

6. Other countries that has implemented the TPD: France, Ireland, Hungary, Romania (not yet in force), Slovenia (not yet in force).

7. Countries not yet implemented TPD

Germany, Italy, Portugal, Greece

8. Standardized packaging in the industry – beyond tobacco.

ANNEX

UK's Tobacco Products Regulations 2015, Rule 13 and 14

PART 5

Miscellaneous provisions

Trade marks and registered designs

Regulations not to affect registration of trade marks etc

13.—(1) For the avoidance of doubt, nothing in, or done in accordance with, these Regulations—

(a) forms an obstacle to the registration of a trade mark under the Trade Marks Act 1994(1), or

(b) gives rise to a ground for the declaration of invalidity of a registered trade mark under section 47(1) of that Act (grounds for invalidity of registration).

(2) Without limiting paragraph (1), nothing in, or done in accordance with, these Regulations—

(a) causes any trade mark to be contrary to public policy or to accepted principles of morality for the purposes of section 3(3)(a) of that Act (absolute grounds for refusal of registration),

(b) amounts to an enactment or rule of law which prohibits the use of a trade mark for the purposes of section 3(4) of that Act(2),

(c) amounts to a rule of law by which the use in the United Kingdom of any trade mark is liable to be prevented for the purposes of section 5(4) of that Act (relative grounds for refusal of registration),

(d) causes an application for the registration of a trade mark under that Act to be one which is made in bad faith, or

(e) prevents an applicant for the registration of a trade mark under that Act from having such a *bona fide* intention as is mentioned in section 32(3) of that Act (application for registration of trade mark).

(3) Paragraph (4) applies for the purposes of section 6(3) of the Trade Marks Act 1994 (meaning of “earlier trade mark”) if the trade mark there mentioned is a registered trade mark and its use is affected by these Regulations.

(4) A *bona fide* use of the trade mark is to be regarded as having taken place during the two years there mentioned if there would have been such use of the trade mark during that period were these Regulations not in force.

(5) Paragraph (6) applies for the purposes of—

(a) section 6A(3) of the Trade Marks Act 1994 (raising of relative grounds in opposition proceedings in case of non-use)(3), or

(b) section 47(2B) of that Act (grounds for invalidity of registration)(4),

if the earlier trade mark there mentioned is a registered trade mark and its use is affected by these Regulations.

(6) If any provision of these Regulations causes any non-use of the trade mark within the period of five years there mentioned, such provision is to be regarded as a proper reason for that non-use, provided that the trade mark would have been put to such genuine use as is there mentioned were these Regulations not in force.

(7) Paragraph (8) applies for the purposes of section 46(1)(a) or (b) of the Trade Marks Act 1994 (revocation of registration) if the use of the registered trade mark there mentioned is affected by these Regulations.

(8) If any provision of these Regulations causes any non-use of the registered trade mark within the period of five years there mentioned, such provision is to be regarded as a proper reason for that non-use, provided that the registered trade mark would have been put to such genuine use as is there mentioned were these Regulations not in force.

(9) To the extent that any provision of the Trade Marks Act 1994 mentioned in this regulation (a “relevant provision”) applies to international trade marks (UK) (whether by virtue of that Act, the Trade Marks (International Registration) Order 2008(5) or otherwise, and whether with or without modifications), then provision made by this regulation in relation to that relevant provision shall also apply (with any necessary modifications) to international trade marks (UK).

Regulations not to affect registration of designs etc

14.—(1) For the avoidance of doubt, nothing in, or done in accordance with, these Regulations has the effect that a design may or must be refused registration or declared invalid under the Registered Designs Act 1949(6).

(2) Without limiting paragraph (1), nothing in, or done in accordance with, these Regulations causes any design to be contrary to public policy or to accepted principles of morality for the purposes of section 1D of that Act (designs contrary to public policy or morality)(7).

(3) Paragraph (4) applies for the purposes of section 11ZA(1A)(a) of that Act (grounds for invalidity of registration)(8) if the design to which the later design there mentioned is compared is one whose use is affected by these Regulations.

(4) The design is to be regarded as having been made available to the public on or after the relevant date there mentioned if it would have been so made available on or after that date were these Regulations not in force.

(5) For the avoidance of doubt, nothing in, or done in accordance with, these Regulations amounts to, or permits, any Crown use of a registered design.

(6) In this regulation—

“Crown use” has the same meaning as in paragraph 2A of Schedule 1 to the Registered Designs Act 1949 (compensation for loss of profit)(9);

“design” and “registered design” have the same meaning as in that Act.