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STATUTORY INSTRUMENTS

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**2019 No. 269**

**EXITING THE EUROPEAN UNION  
TRADE MARKS**

**The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019**

*Made - - - - 13th February 2019*

*Coming into force in accordance with regulation 1*

The Secretary of State in exercise of the powers conferred by section 8(1) of, and paragraph 1 of Schedule 4 and paragraph 21(b) of Schedule 7 to, the European Union (Withdrawal) Act 2018 <sup>M1</sup> and by section 78 of the Trade Marks Act 1994 <sup>M2</sup> and with the consent of the Treasury makes the following Regulations.

In accordance with paragraph 12(1) of Schedule 7 to the European Union (Withdrawal) Act 2018, a draft of this instrument has been laid before Parliament and approved by resolution of each House of Parliament.

**Marginal Citations**

**M1** 2018 c. 16. See section 20(1) of that Act for a definition of “Minister of the Crown”.

**M2** 1994 c. 26.

**Citation, commencement and interpretation**

**1.—(1)** These Regulations may be cited as the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and come into force on exit day.

**(2)** In these Regulations—

“the 1994 Act” means the Trade Marks Act 1994;

“the Rules” means the Trade Mark Rules 2008 <sup>M3</sup>.

**Commencement Information**

**I1** Reg. 1 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

- M3** S.I. 2008/1797 amended by S.I. 2009/546, S.I. 2009/2089, S.I. 2012/1003, S.I. 2013/2235, S.I. 2018/825; there are other amending instruments but none are relevant.

### Certain trade marks registered as European Union trade marks to have effect under the 1994 Act

2. Schedule 1 contains amendments to the 1994 Act to make provision for certain trade marks registered as European Union trade marks to be treated as registered trade marks from [F1IP completion day] and about certain applications for such marks made before [F1IP completion day].

#### Textual Amendments

- F1** Words in reg. 2 substituted (31.12.2020 immediately before IP completion day) by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), 8

#### Commencement Information

- I2** Reg. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

### Fees payable in respect of a comparable trade mark (EU)

3. Schedule 2, which makes provision for the payment of fees in respect of a comparable trade mark (EU) (as that term is defined for the purposes of Schedule 2A to the 1994 Act as inserted by Schedule 1), has effect.

#### Commencement Information

- I3** Reg. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

### Other amendments to the 1994 Act

4. Schedule 3, which contains other amendments to the 1994 Act, has effect.

#### Commencement Information

- I4** Reg. 4 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

### Amendments to the Rules

5. Schedule 4, which contains amendments to the Rules, has effect.

#### Commencement Information

- I5** Reg. 5 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

### Consequential amendments etc

6. Schedule 5, which contains consequential amendments, repeals, revocations, transitional and saving provisions, has effect.

#### Commencement Information

**I6** Reg. 6 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1, Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

Department for Business, Energy and Industrial  
Strategy

*Chris Skidmore*  
Minister of State for Universities, Science,  
Research and Innovation

We consent to the making of these regulations

*Jeremy Quin*  
*Rebecca Harris*  
Two of the Lords Commissioners of Her  
Majesty's Treasury

## SCHEDULE 1

## Regulation 2

Amendments to the 1994 Act to make provision for certain trade marks registered as European Union trade marks to be treated as registered trade marks and about certain applications for such marks

1. The 1994 Act is amended as follows.

#### Commencement Information

- I7** Sch. 1 para. 1 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1(1)

2. After section 52 <sup>M4</sup> (and before the italic heading before section 53), insert—

**“52A Certain trade marks registered as European Union trade marks to be treated as registered trade marks**

**52A.** Schedule 2A makes provision for European Union trade marks (including certain expired and removed marks) to be treated as registered trade marks with effect from [<sup>F2</sup>IP completion day] and about certain applications for a European Union trade mark made before [<sup>F2</sup>IP completion day].”

#### Textual Amendments

- F2** Words in **Sch. 1 para. 2** substituted (31.12.2020 immediately before IP completion day) by **The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050)**, regs. 1(2), **9(a)**

#### Commencement Information

- I8** Sch. 1 para. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1(1)

#### Marginal Citations

- M4** Section 52 was amended by the **Legal Services Act 2007 (c. 29)**, **paragraph 110** of Schedule 21, **S.I. 2016/299**, **regulations 2** and 5, the **Intellectual Property (Unjustified Threats) Act 2017 (c. 14)**, **section 2(3)** and **S.I. 2018/825**, **regulation 27**.

3. After Schedule 2, insert—

“SCHEDULE 2A

Section 52A

EUROPEAN UNION TRADE MARKS

**PART 1**

Existing European Union trade marks

**A trade mark registered as an existing EUTM to be treated as registered under this Act**

1.—(1) A trade mark which is registered in the EUTM Register immediately before [F<sup>3</sup>IP completion day] (an “existing EUTM”) is to be treated on and after [F<sup>3</sup>IP completion day] as if an application had been made, and the trade mark had been registered, under this Act in respect of the same goods or services as the existing EUTM is registered in the EUTM Register.

(2) A registered trade mark which comes into being by virtue of sub-paragraph (1) is referred to in this Act as a comparable trade mark (EU).

(3) This Act applies to a comparable trade mark (EU) as it applies to other registered trade marks except as otherwise provided in this Schedule.

(4) A comparable trade mark (EU) is deemed for the purposes of this Act to be registered as of the filing date accorded pursuant to Article 32 to the application which resulted in the registration of the corresponding EUTM and that date is deemed for the purposes of this Act to be the date of registration.

(5) Section 40(3) and (4) does not apply to the registration of a comparable trade mark (EU) under this Part.

(6) Section 67(1) applies in relation to the provision of information and the inspection of documents relating to a comparable trade mark (EU) notwithstanding that there will have been no application under this Act for the registration of the trade mark (and so no publication of an application).

(7) Nothing in this Act authorises the imposition of a fee, or the making of provision by rules or regulations which authorises the imposition of a fee, in respect of any matter relating to a comparable trade mark (EU) (see instead provision made by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018).

(8) For the purposes of this Act—

- (a) the date of filing of an application for registration of a comparable trade mark (EU) is the filing date accorded pursuant to Article 32 to the application which resulted in the registration of the corresponding EUTM;
- (b) references to the date of application for registration of a comparable trade mark (EU) are to the date of filing of the application;
- (c) where an earlier trade mark is a comparable trade mark (EU), references to the completion of the registration procedure for the earlier trade mark are to the completion of the registration procedure in respect of the corresponding EUTM.

(9) In this Schedule—

- (a) “corresponding EUTM”, in relation to a comparable trade mark (EU), means the existing EUTM from which the comparable trade mark (EU) derives;

- (b) “the EUTM Register” means the register of European Union trade marks maintained by the European Union Intellectual Property Office.

### **Opt out**

2.—(1) Subject to sub-paragraph (2), the proprietor of an existing EUTM may, at any time on or after [<sup>F3</sup>IP completion day], serve notice on the registrar that the trade mark is not to be treated as if the trade mark had been registered under this Act (an “opt out notice”).

(2) An opt out notice may not be served where on or after [<sup>F3</sup>IP completion day]—

- (a) the comparable trade mark (EU) has been put to use in the United Kingdom by the proprietor or with the proprietor's consent (which use includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes);
- (b) the comparable trade mark (EU) (or any right in or under it) has been made the subject of an assignment, licence, security interest or any other agreement or document except for an assent by personal representatives in relation to the comparable trade mark (EU); or
- (c) proceedings based on the comparable trade mark (EU) have been initiated by the proprietor or with the proprietor's consent.

(3) An opt out notice must—

- (a) identify the existing EUTM; and
- (b) include the name and address of any person having an interest in the existing EUTM which had effect before [<sup>F3</sup>IP completion day] in the United Kingdom, and in respect of which an entry was recorded in the EUTM Register.

(4) An opt out notice is of no effect unless the proprietor in that notice certifies that any such person—

- (a) has been given not less than three months' notice of the proprietor's intention to serve an opt out notice; or
- (b) is not affected or if affected, consents to the opt out.

(5) Where a notice has been served in accordance with this paragraph—

- (a) the comparable trade mark (EU) which derives from the existing EUTM ceases with effect from [<sup>F3</sup>IP completion day] to be treated as if it had been registered under this Act; and
- (b) the registrar must, where particulars of the comparable trade mark (EU) have been entered in the register, remove the comparable trade mark (EU) from the register.

### **Entries to be made in the register in relation to a comparable trade mark (EU)**

3.—(1) The registrar must as soon as reasonably practicable after [<sup>F3</sup>IP completion day] enter a comparable trade mark (EU) in the register.

(2) The particulars of the goods or services in respect of which the comparable trade mark (EU) is treated as if it had been registered must be taken from the English language version of the entry for the corresponding EUTM in the EUTM Register.

(3) Where—

- (a) the application for registration of the corresponding EUTM was not filed in English; or

- (b) the second language indicated by the applicant pursuant to Article 146(3) was a language other than English,

a person having a sufficient interest who considers that the English language version is inaccurate may apply to the registrar for rectification of the register by the substitution of an English translation of the relevant authentic text (as determined in accordance with Article 147(3)) verified to the satisfaction of the registrar as corresponding to the authentic text.

#### **Comparable trade mark (EU) which derives from an EU Collective Mark or EU Certification Mark**

4.—(1) This paragraph applies where the European Union trade mark from which a comparable trade mark (EU) derives is an EU collective mark or an EU certification mark.

(2) The comparable trade mark (EU) is to be treated as either a collective mark or a certification mark, as the case may be.

(3) The proprietor of the comparable trade mark (EU) must, following notice from the registrar, file with the registrar regulations governing the use of the European Union trade mark, submitted pursuant to the European Union Trade Mark Regulation, which had effect immediately before [<sup>F3</sup>IP completion day].

(4) Where the regulations referred to in sub-paragraph (3) are in a language other than English they must be filed together with a translation into English verified to the satisfaction of the registrar as corresponding to the original text.

(5) Paragraph 9 of Schedule 1 and paragraph 10 of Schedule 2 apply in relation to the translation referred to in sub-paragraph (4) as they apply in relation to the regulations referred to in sub-paragraph (3).

(6) Where the regulations or any translation are not filed in accordance with the above provisions—

- (a) the registrar must remove the comparable trade mark (EU) from the register; and
- (b) the rights of the proprietor shall be deemed to have ceased as from the date of removal.

#### **Renewal of a comparable trade mark (EU) which expires within six months after [<sup>F3</sup>IP completion day]**

5.—(1) This paragraph applies to the renewal of the registration of a comparable trade mark (EU) which expires within the period beginning with [<sup>F3</sup>IP completion day] and ending with the end of the relevant period (and accordingly section 43(1) to (3A) does not apply).

(2) The registration of the comparable trade mark (EU) may be renewed at the request of the proprietor before the expiry of the registration.

(3) Where the registration of the comparable trade mark (EU) is not renewed in accordance with sub-paragraph (2)—

- (a) on, or as soon as reasonably practicable after, the expiry of the registration, the registrar must notify the proprietor that the registration has expired and of the manner in which the registration may be renewed; and
- (b) a request for renewal must be made within the period of six months beginning with the date of the notice.

(4) If a request for renewal is made in respect of only some of the goods or services for which the comparable trade mark (EU) is registered, the registration is to be renewed for those goods or services only.

(5) If the registration is not renewed in accordance with the above provisions, the registrar must remove the comparable trade mark (EU) from the register.

(6) Section 43(4) and (6) applies to the registration of a comparable trade mark (EU) which is renewed in accordance with the above provisions.

(7) In paragraph (1), the “relevant period” means the period of six months beginning with the day after that on which [F3IP completion day] falls.

### **Restoration of a comparable trade mark (EU)**

6. Where a comparable trade mark (EU) is removed from the register pursuant to paragraph 5, the rules relating to the restoration of the registration of a trade mark (referred to in section 43(5)) apply in relation to the restoration of the comparable trade mark (EU) to the register.

### **Raising of relative grounds in opposition proceedings in case of non-use**

7.—(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before [F3IP completion day]—

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [F3IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [F3IP completion day]—

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
- (b) the references in section 6A to the United Kingdom include the European Union.

### **Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)**

8.—(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the “five-year period”) has expired before [F3IP completion day]—

- (a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [F3IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [F3IP completion day]—

- (a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and
- (b) the references in sections 11A and 46 to the United Kingdom include the European Union.



### **Grounds for invalidity of registration of a trade mark based upon an earlier comparable trade mark (EU)**

**9.**—(1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the “five-year period”) has expired before [F<sup>3</sup>IP completion day]—

- (a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
- (b) the references in section 47 to the United Kingdom include the European Union.

(3) Where [F<sup>3</sup>IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [F<sup>3</sup>IP completion day]—

- (a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
- (b) the references in section 47 to the United Kingdom include the European Union.

### **Reputation of a comparable trade mark (EU)**

**10.**—(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before [F<sup>3</sup>IP completion day], references in sections 5(3) and 10(3) to—

- (a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and
- (b) the United Kingdom include the European Union.

### **Rights conferred by registered trade mark**

**11.** Section 9 applies in relation to a comparable trade mark (EU) but as if—

- (a) the words in brackets in subsection (3) referring to section 40(3) were replaced with a reference to paragraph 1(4) of this Schedule; and
- (b) the proviso in subsection (3) were omitted.

### **Effect of claim of priority**

**12.**—(1) This paragraph applies where—

- (a) the proprietor of an existing EUTM has claimed a right of priority in accordance with Article 35; and
- (b) immediately before [F<sup>3</sup>IP completion day] there is an entry in the EUTM Register containing particulars of that claim of priority (a “claim of priority”).

(2) The proprietor of the comparable trade mark (EU) which derives from the existing EUTM is to be treated on and after [F<sup>3</sup>IP completion day] as having the same claim of priority.

(3) Accordingly, the relevant date for the purposes of establishing, in relation to the comparable trade mark (EU), which rights take precedence is the date of filing of the application for a trade mark in a Convention country which formed the basis for the claim of priority.

### Effect of seniority claim

**13.—**(1) This paragraph applies where immediately before [<sup>F3</sup>IP completion day] an existing EUTM has a valid claim to seniority of a trade mark which trade mark (the “senior mark”) is a registered trade mark or a protected international trade mark (UK).

(2) The comparable trade mark (EU) which derives from the existing EUTM is to be treated on and after [<sup>F3</sup>IP completion day] as if it had a valid claim to seniority of the senior mark.

(3) Accordingly, where the proprietor of the comparable trade mark (EU) surrenders the senior mark or allows it to lapse (whether wholly or partially), subject to paragraph 14, the proprietor of the comparable trade mark (EU) is deemed to continue to have the same rights as the proprietor would have had if the senior mark had continued to be registered in respect of all the goods or services for which it was registered prior to the surrender or lapse.

(4) An existing EUTM has a valid claim to seniority of a trade mark where—

- (a) a claim has been filed in accordance with Article 39 or 40; and
- (b) the seniority claimed for the existing EUTM has not lapsed in the circumstances referred to in Article 39.

### Determination of invalidity and liability to revocation in relation to claims of seniority

**14.—**(1) Where pursuant to paragraph 13 a comparable trade mark (EU) is treated as if it had a valid claim to seniority of a registered trade mark which has been—

- (a) removed from the register under section 43; or
- (b) surrendered under section 45,

any person may apply to the registrar or to the court for the declaration set out in subparagraph (2).

(2) The declaration is that if the trade mark had not been so removed or surrendered, the registration of the trade mark would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47.

(3) Where the declaration is that had the trade mark not been so removed or surrendered the registration of it would have been liable to be—

- (a) revoked under section 46 with effect from a date prior to—
  - (i) the filing date accorded pursuant to Article 32 to the application which resulted in the registration of the existing EUTM from which the comparable trade mark (EU) derives where there has been no claim of priority; or
  - (ii) the priority date (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM from which the comparable trade mark (EU) derives where there has been a claim of priority; or
- (b) declared invalid under section 47,

the seniority claimed for the comparable trade mark (EU) is to be treated as if it never had effect.

(4) Where pursuant to paragraph 13 a comparable trade mark (EU) is treated as if it had a valid claim to seniority of a protected international trade mark (UK) which has been—

- (a) removed from the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol; or

(b) surrendered under the Madrid Protocol,  
any person may apply to the registrar or to the court for the declaration set out in sub-paragraph (5).

(5) The declaration is that, if the trade mark had not been so removed or surrendered, the protection of the mark in the United Kingdom would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47.

(6) Where the declaration is that had the trade mark not been so removed or surrendered the protection of the mark in the United Kingdom would have been liable to be—

- (a) revoked under section 46 with effect from a date prior to—
  - (i) the filing date accorded pursuant to Article 32 to the application which resulted in the registration of the existing EUTM from which the comparable trade mark (EU) derives where there has been no claim of priority; or
  - (ii) the priority date (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM from which the comparable trade mark (EU) derives where there has been a claim of priority; or
- (b) declared invalid under section 47,

the seniority claimed for the comparable trade mark (EU) is to be treated as if it never had effect.

(7) References in sub-paragraphs (5) and (6) to sections 46 and 47 are to those sections as they apply to a protected international trade mark (UK) under an order made pursuant to section 54.

(8) Where a trade mark has been surrendered or allowed to lapse in respect of some only of the goods or services for which it is registered, the declaration in sub-paragraphs (2) and (5) is that if the goods or services had not been removed from the registration, the registration of the trade mark would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47 and sub-paragraphs (3) and (6) shall be construed accordingly.

#### **Procedure for declaration that trade mark would have been liable to be revoked or declared invalid**

**15.—**(1) In the case of proceedings on an application under paragraph 14 before the registrar, the rules relating to applications for and proceedings relating to the revocation or invalidation of a trade mark apply, with necessary modifications.

(2) In the case of proceedings on an application under paragraph 14 before the court, section 74 applies to the proceedings as it applies to proceedings involving an application of the type referred to in section 74(1)(a) to (c).

#### **Assignment of an existing EUTM not registered on [F<sup>3</sup>IP completion day]**

**16.—**(1) This paragraph applies where before [F<sup>3</sup>IP completion day] an existing EUTM (or any right in it) is the subject of an assignment (a “relevant assignment”) which immediately before [F<sup>3</sup>IP completion day] is not recorded in the EUTM Register.

(2) Section 25 applies in relation to a relevant assignment as if it were a registrable transaction affecting a comparable trade mark (EU), subject to the modification set out below.

- (3) An application under section 25(1) may only be made by—
  - (a) a person claiming to be entitled to an interest in or under a comparable trade mark (EU) by virtue of a relevant assignment of the corresponding EUTM; or
  - (b) the proprietor of the comparable trade mark (EU).

### **Effect of a licence of an existing EUTM**

**17.—**(1) This paragraph applies where immediately before [F<sup>3</sup>IP completion day] an existing EUTM is the subject of a licence (a “relevant licence”) which—

- (a) authorises the doing of acts in the United Kingdom which would otherwise infringe the European Union trade mark; and
- (b) does not expire on [F<sup>3</sup>IP completion day].

(2) Subject to any agreement to the contrary between the licensee and the licensor, a relevant licence continues to authorise the doing of acts in the United Kingdom which would otherwise infringe the comparable trade mark (EU) which derives from the existing EUTM.

(3) Sub-paragraph (2) is subject to—

- (a) the terms on which the relevant licence was granted; and
- (b) such modifications to the terms referred to in paragraph (a) as are necessary for their application in the United Kingdom.

(4) Section 25 applies in relation to a relevant licence as if it were a registrable transaction affecting a comparable trade mark (EU), subject to the modifications set out below.

(5) An application under section 25(1) may only be made by—

- (a) a person claiming to be a licensee by virtue of the relevant licence; or
- (b) the proprietor of the comparable trade mark (EU).

(6) Where immediately before [F<sup>3</sup>IP completion day] there is an entry in the EUTM Register relating to a relevant licence—

- (a) section 25(3) and (4) does not apply until after the expiry of the relevant period; and
- (b) section 25(4)(a) applies after the expiry of the relevant period but as if the reference to six months beginning with the date of the transaction were a reference to eighteen months beginning with [F<sup>3</sup>IP completion day].

(7) In paragraph (6)(a), the “relevant period” means the period of twelve months beginning with the day after that on which [F<sup>3</sup>IP completion day] falls.

### **Effect of a security interest in an existing EUTM**

**18.—**(1) This paragraph applies where immediately before [F<sup>3</sup>IP completion day] an existing EUTM (or any right in or under it) is the subject of a security interest (a “relevant security interest”) which does not terminate on [F<sup>3</sup>IP completion day].

(2) References to the existing EUTM in any document which grants or refers to the relevant security interest are to be read as including references to the comparable trade mark (EU) which derives from the existing EUTM.

(3) Section 25 applies in relation to a relevant security interest as if it were a registrable transaction affecting a comparable trade mark (EU), subject to the modifications set out below.

(4) An application under section 25(1) may only be made by—

- (a) a person claiming to be entitled to an interest in or under a comparable trade mark (EU) by virtue of the relevant security interest; or
  - (b) the proprietor of the comparable trade mark (EU).
- (5) Where immediately before [F<sup>3</sup>IP completion day] there is an entry in the EUTM Register relating to a relevant security interest—
- (a) section 25(3) and (4) do not apply until after the expiry of the relevant period; and
  - (b) section 25(4)(a) applies after the expiry of the relevant period but as if the reference to six months beginning with the date of the transaction were a reference to eighteen months beginning with [F<sup>3</sup>IP completion day].
- (6) In paragraph (5)(a), the “relevant period” means the period of twelve months beginning with the day after that on which [F<sup>3</sup>IP completion day] falls.

#### **Continuity of rights in relation to a comparable trade mark (EU)**

**19.**—(1) References to an existing EUTM or the registration of an existing EUTM in any document made before [F<sup>3</sup>IP completion day] shall, unless there is evidence that the document was not intended to have effect in the United Kingdom, be read on and after [F<sup>3</sup>IP completion day] as including references to the comparable trade mark (EU) or the registration of the comparable trade mark (EU) which derives from the existing EUTM.

(2) Subject to any agreement to the contrary, a consent granted before [F<sup>3</sup>IP completion day] by the proprietor of an existing EUTM to the doing on or after [F<sup>3</sup>IP completion day] of an act in the United Kingdom which would otherwise infringe the comparable trade mark (EU) which derives from the existing EUTM is to be treated for the purposes of section 9 as a consent to the doing of that act.

#### **Existing EUTM: pending proceedings**

**20.**—(1) This paragraph applies where on [F<sup>3</sup>IP completion day] an existing EUTM is the subject of proceedings which are pending (“pending proceedings”) before a court in the United Kingdom designated for the purposes of Article 123 (“EU trade mark court”).

(2) Subject to sub-paragraphs (3) and (4), the provisions contained or referred to in Chapter 10 of the European Union Trade Mark Regulation (with the exception of Articles 128(2), (4), (6) and (7) and 132) continue to apply to the pending proceedings as if the United Kingdom were still a Member State with effect from [F<sup>3</sup>IP completion day].

(3) Where the pending proceedings involve a claim for infringement of an existing EUTM, without prejudice to any other relief by way of damages, accounts or otherwise available to the proprietor of the existing EUTM, the EU trade mark court may grant an injunction to prohibit unauthorised use of the comparable trade mark (EU) which derives from the existing EUTM.

(4) Where the pending proceedings involve a counterclaim for the revocation of, or a declaration of invalidity in relation to, an existing EUTM, the EU trade mark court may revoke the registration of the comparable trade mark (EU) which derives from the existing EUTM or declare the registration of the comparable trade mark (EU) which derives from the existing EUTM to be invalid.

(5) Where the grounds for revocation or invalidity exist in respect of only some of the goods or services for which the existing EUTM is registered, the revocation or declaration of invalidity in respect of the registration of the comparable trade mark (EU) which derives from the existing EUTM relates to those goods or services only.

(6) Where (by virtue of sub-paragraph (4)) the registration of a comparable trade mark (EU) is revoked to any extent, the rights of the proprietor are deemed to have ceased to that extent as from—

- (a) the date of the counterclaim for revocation, or
- (b) if the court is satisfied that the grounds for revocation existed at an earlier date, that date.

(7) Where (by virtue of sub-paragraph (4)) the registration of a comparable trade mark (EU) is declared invalid to any extent, the registration is to that extent to be deemed never to have been made, provided that this does not affect transactions past and closed.

(8) For the purposes of this paragraph proceedings are treated as pending on [F<sup>3</sup>IP completion day] if they were instituted but not finally determined before [F<sup>3</sup>IP completion day].

#### **Existing EUTM: effect of injunction**

**21.—**(1) This paragraph applies where immediately before [F<sup>3</sup>IP completion day] an injunction is in force prohibiting the performance of acts in the United Kingdom which infringe or would infringe an existing EUTM (a “relevant injunction”).

(2) Subject to any order of the court to the contrary, a relevant injunction will have effect and be enforceable to prohibit the performance of acts which infringe or would infringe a comparable trade mark (EU) to the same extent as in relation to the European Union trade mark from which the comparable trade mark (EU) derives as if it were an injunction granted by the court.

#### **[F<sup>4</sup>Existing EUTM: effect of invalidity or revocation**

**21A.—**(1) This paragraph applies where, on IP completion day, an existing EUTM is the subject of proceedings under Article 58 (Grounds for revocation), 59 (Absolute grounds for invalidity) or 60 (Relative grounds for invalidity) which have been instituted but not finally determined before IP completion day (“cancellation proceedings”).

(2) Subject to sub-paragraph (4), where—

- (a) the existing EUTM is revoked or declared invalid (whether wholly or partially) pursuant to a decision in the cancellation proceedings which is finally determined, and
- (b) the registrar has—
  - (i) received notice of the situation referred to in paragraph (a) (“a cancellation notice”), or
  - (ii) otherwise become aware of the situation referred to in paragraph (a),

the registration of the comparable trade mark (EU) which derives from the existing EUTM must be revoked or declared invalid to the same extent as the existing EUTM.

(3) Where (by virtue of sub-paragraph (2)) the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent, the registrar must—

- (a) remove the comparable trade mark (EU) from the register (where the revocation or declaration of invalidity relates to all the goods or services for which the existing EUTM was registered); or
- (b) amend the entry in the register listing the goods or services for which the comparable trade mark (EU) is registered (where the revocation or declaration

of invalidity relates to only some of the goods or services for which the existing EUTM was registered).

(4) The registration of a comparable trade mark (EU) must not be revoked or declared invalid under sub-paragraph (2) where the grounds on which the existing EUTM was revoked or declared invalid (whether wholly or partially) would not apply or would not have been satisfied in relation to the comparable trade mark (EU)—

- (a) if the comparable trade mark (EU) had existed as at the date the cancellation proceedings were instituted, and
- (b) an application for the revocation or a declaration of invalidity of the comparable trade mark (EU) based on those grounds had been made on that date under section 46 or 47 (as the case may be).

(5) Where a comparable trade mark (EU) is revoked or declared invalid to any extent pursuant to this paragraph—

- (a) the rights of the proprietor are deemed to have ceased to that extent as from the date on which the rights of the proprietor of the existing EUTM are deemed to have ceased under the EUTM Regulation;
- (b) subject to any claim for compensation for damage caused by negligence or lack of good faith on the part of the proprietor or a claim for restitution based upon the unjust enrichment of the proprietor, the revocation or invalidity of the comparable trade mark (EU) does not affect—
  - (i) a decision arising from infringement proceedings which has been finally determined and which has been enforced prior to the date on which the entry in the register of the comparable trade mark (EU) has been removed or amended pursuant to sub-paragraph (3) (“the decision date”);
  - (ii) any contract entered into prior to the decision date to the extent that it has been performed prior to the decision date, subject to the right of a party to the contract to claim the repayment of any consideration paid under the contract where, having regard to the circumstances, it is fair and equitable for such repayment to be made.

(6) A cancellation notice may be submitted to the registrar by any person.

(7) For the purposes of this paragraph—

- (a) proceedings are instituted if an application or counterclaim for revocation or for a declaration of invalidity—
  - (i) has been filed (and not subsequently withdrawn) with the European Union Intellectual Property Office or a court designated for the purposes of Article 123, and
  - (ii) meets the requirements for being accorded a filing date under the European Union Trade Mark Regulation and Commission Delegated Regulation (EU) 2018/625 of 5th March 2018;
- (b) a decision is finally determined when—
  - (i) it has been determined, and
  - (ii) there is no further possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time).]

## PART 2

### Treatment of European Union trade marks which expire during the period of six months ending on [F<sup>3</sup>IP completion day]

#### Registration of certain expired European Union trade marks

**22.—**(1) This Part applies to a trade mark which was registered in the EUTM Register immediately before the transitional period but which, as a result of the expiry of the registration of the European Union trade mark during the transitional period, does not fall within paragraph 1(1) (an “expired EUTM”).

(2) An expired EUTM is to be treated as if it were an existing EUTM.

(3) The provisions of Part 1 of this Schedule apply to an expired EUTM as they apply to an existing EUTM subject to the provisions of this Part of the Schedule.

(4) Notwithstanding the entry in the register (under paragraph 3, as applied by sub-paragraph (3)) of a comparable trade mark (EU) which derives from an expired EUTM, the registration of the comparable trade mark (EU) is expired until it is renewed in accordance with paragraph 23 (or the comparable trade mark (EU) is removed from the register in accordance with paragraph 23(4)).

(5) In this paragraph, “transitional period” means the period of six months ending with [F<sup>3</sup>IP completion day].

#### Renewal of an expired EUTM

**23.—**(1) Where the registration of an expired EUTM is renewed in accordance with Article 53 of the Continuing EUTM Regulation the registrar must, as soon as reasonably practicable after the date of such renewal, renew the registration of the comparable trade mark (EU) which derives from the expired EUTM.

(2) A comparable trade mark (EU) which is renewed under sub-paragraph (1) shall be renewed for a period of ten years from the expiry of the registration of the expired EUTM.

(3) If the registration of an expired EUTM is renewed in respect of only some of the goods or services in respect of which the expired EUTM was registered before its registration expired, the registration of the comparable trade mark (EU) under sub-paragraph (1) is to be renewed for those goods or services only.

(4) If the registration of an expired EUTM is not renewed within the time period permitted by Article 53 of the Continuing EUTM Regulation—

(a) the registrar must remove from the register the comparable trade mark (EU) which derives from the expired EUTM; and

(b) the comparable trade mark (EU) ceases with effect from [F<sup>3</sup>IP completion day] to be treated as if it had been registered under this Act.

(5) In this Schedule, the “Continuing EUTM Regulation” means Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark <sup>M5</sup> as it has effect in EU law.



## PART 3

### Applications for European Union trade marks which are pending on [F3IP completion day]

#### Application of Part

**24.—**(1) This Part applies to an application for registration of a trade mark under the EUTM Regulation in respect of which the conditions in sub-paragraph (2) are satisfied (an “existing EUTM application”).

(2) The conditions referred to in sub-paragraph (1) are—

- (a) the application has been accorded a filing date pursuant to Article 32; and
- (b) as at the time immediately before [F3IP completion day], the application has been neither granted nor refused by the European Union Intellectual Property Office.

#### Application for registration under this Act based upon an existing EUTM application

**25.—**(1) This paragraph applies where a person who has filed an existing EUTM application or a successor in title of that person applies for registration of the same trade mark under this Act for some or all of the same goods or services.

(2) Where an application for registration referred to in sub-paragraph (1) is made within a period beginning with [F3IP completion day] and ending with the end of the relevant period—

- (a) the relevant date for the purposes of establishing which rights take precedence is the earliest of—
  - (i) the filing date accorded pursuant to Article 32 to the existing EUTM application;
  - (ii) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM application; and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom which commenced in the period between the date referred to in paragraph (a) and the date of the application under this Act.

(3) In paragraph (2), the “relevant period” means the period of nine months beginning with the day after that on which [F3IP completion day] falls.

#### Right to claim seniority where seniority has been claimed by an existing EUTM application

**26.—**(1) Where an existing EUTM application claims seniority of a trade mark which trade mark (“the senior mark”) is a registered trade mark or a protected international trade mark (UK), the applicant may claim seniority of the senior mark in an application for registration of a trade mark (“a relevant mark”) pursuant to this Part.

(2) The effect of a seniority claim made pursuant to sub-paragraph (1) is that where following the registration of the relevant mark the proprietor of that mark surrenders the senior mark or allows it to lapse (wholly or partially), subject to paragraph 27, the proprietor of the relevant mark is deemed to continue to have the same rights as the proprietor would have had if the senior mark had continued to be registered in respect of all the goods or services for which it was registered prior to the surrender or lapse.

(3) Provision may be made by rules as to the manner of claiming seniority pursuant to this paragraph.

**Determination of invalidity and liability to revocation in relation to claim of seniority under paragraph 26**

**27.—**(1) Where a relevant mark has claimed seniority of a registered trade mark which has been—

- (a) removed from the register under section 43; or
- (b) surrendered under section 45,

any person may apply to the registrar or to the court for the declaration set out in subparagraph (2).

(2) The declaration is that, if the trade mark had not been so removed or surrendered, the registration of the trade mark would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47.

(3) Where the declaration is that had the trade mark not been so removed or surrendered, the registration of it would have been liable to be—

- (a) revoked under section 46 with effect from a date prior to—
  - (i) the filing date accorded pursuant to Article 32 to the existing EUTM application on which the application for registration of a relevant mark is based where there has been no claim of priority; or
  - (ii) the priority date (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM application on which the registration of a relevant mark is based where there has been a claim of priority; or
- (b) declared invalid under section 47,

the seniority claimed for the relevant mark is to be treated as if it never had effect.

(4) Where a relevant mark has claimed seniority of a protected international trade mark (UK) which has been—

- (a) removed from the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol; or
- (b) surrendered under the Madrid Protocol,

any person may apply to the registrar or to the court for the declaration set out in subparagraph (5).

(5) The declaration is that, if the trade mark had not been so removed or surrendered, the protection of the trade mark in the United Kingdom would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47.

(6) Where the declaration is that had the trade mark not been so removed or surrendered, the registration of it would have been liable to be—

- (a) revoked under section 46 with effect from a date prior to—
  - (i) the filing date accorded pursuant to Article 32 to the existing EUTM application on which the application for registration of a relevant mark is based where there has been no claim of priority; or
  - (ii) the priority date (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM application on which

the registration of a relevant mark is based where there has been a claim of priority; or

(b) declared invalid under section 47,

the seniority claimed for the relevant mark is to be treated as if it never had effect.

(7) References in sub-paragraphs (5) and (6) to sections 46 and 47 are to those sections as they apply to a protected international trade mark (UK) under an order made pursuant to section 54.

(8) Where a trade mark has been surrendered or allowed to lapse in respect of only some of the goods or services for which it is registered, the declaration in sub-paragraphs (2) and (5) is that if the goods or services had not been removed from the registration, the registration of the trade mark would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47 and sub-paragraphs (3) and (6) shall be construed accordingly.

(9) The provisions of paragraph 15 apply in relation to an application under this paragraph as they apply to an application under paragraph 14.

## PART 4

### Restoration of European Union trade mark registrations and applications

#### Restoration of a European Union trade mark to the EUTM Register

**28.—**(1) This paragraph applies where—

- (a) before [F3IP completion day] a trade mark is removed from the EUTM Register pursuant to the European Union Trade Mark Regulation; and
- (b) on or after [F3IP completion day] the trade mark is restored to the EUTM Register pursuant to the Continuing EUTM Regulation.

(2) Where the proprietor of a European Union trade mark referred to in sub-paragraph (1) (b) files a request with the registrar within the period of six months beginning with the date of such restoration—

- (a) the trade mark will be treated as if it was an existing EUTM on [F3IP completion day]; and
- (b) the provisions of Part 1 apply to the comparable trade mark (EU) which derives from the existing EUTM.

#### Restoration of an application for a European Union trade mark

**29.—**(1) This paragraph applies where—

- (a) before [F3IP completion day] an application for a European Union trade mark is refused pursuant to the European Union Trade Mark Regulation; and
- (b) on or after [F3IP completion day] the application (a “relevant application”) is restored pursuant to the Continuing EUTM Regulation.

(2) Where a person who has filed a relevant application or a successor in title of that person applies for registration of the same trade mark under this Act for some or all of the same goods or services, the provisions of paragraphs 25, 26 and 27 apply to the relevant application as if it were an existing EUTM application but as if the “relevant period” in

paragraph 25(2) meant the period of nine months beginning with the date on which the relevant application is restored as referred to in sub-paragraph (1)(b).

## PART 5

### Interpretation

#### Interpretation

##### 30.—(1) In this Schedule—

- “comparable trade mark (EU)” has the meaning given by paragraph 1(2);
- “the Continuing EUTM Regulation” has the meaning given by paragraph 23(5);
- “corresponding EUTM” has the meaning given by paragraph 1(9)(a);
- “the EUTM Register” has the meaning given by paragraph 1(9)(b);
- “existing EUTM” has the meaning given by paragraph 1(1);
- “existing EUTM application” has the meaning given by paragraph 24(1);
- “expired EUTM” has the meaning given by paragraph 22(1);
- “the previous EUTM Regulations” means Council Regulation (EC) No 207/2009 of 26th February 2009 on the European Union trade mark <sup>M6</sup> and Council Regulation (EC) No 40/94 of 20<sup>th</sup> December 1993 on the Community trade mark <sup>M7</sup>;
- “protected international trade mark (UK)” has the same meaning as in the Trade Marks (International Registration) Order 2008 <sup>M8</sup>.

##### (2) References in this Schedule to—

- (a) an “Article” are to an Article of the European Union Trade Mark Regulation and include references to any equivalent Article contained in the previous EUTM Regulations;
- (b) the European Union Trade Mark Regulation include references to the previous EUTM Regulations;
- (c) a European Union trade mark include references to an EU collective mark and an EU certification mark as defined in Articles 74 and 83.”.

#### Textual Amendments

- F3** Words in Sch. 1 para. 3 substituted (31.12.2020 immediately before IP completion day) by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), 9(b)(i)
- F4** Words in Sch. 1 para. 3 inserted (31.12.2020 immediately before IP completion day) by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), 9(b)(ii)

#### Commencement Information

- I9** Sch. 1 para. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

- M5** OJ No. L 154/1, 16.6.2017, p.1.
- M6** OJ No. L 78, 24.3.2009, p.1.
- M7** OJ No. L 11, 14.1.1994, p.1.

**M8** [S.I. 2008/2206](#).

## SCHEDULE 2

Regulation 3

### Fees payable in respect of a comparable trade mark (EU)

1. The renewal of the registration of a comparable trade mark (EU) under section 43 of the 1994 Act is subject to the payment of a renewal fee and, in the circumstances referred to in section 43(3) of the 1994 Act, payment of an additional renewal fee.

#### Commencement Information

**I10** Sch. 2 para. 1 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

2. The renewal of the registration of a comparable trade mark (EU) under paragraph 5 of Schedule 2A to the 1994 Act is subject to the payment of a renewal fee as if the renewal had been requested under section 43(1) of the 1994 Act before the expiry of the registration.

#### Commencement Information

**I11** Sch. 2 para. 2 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

3. If a renewal fee is paid in respect of only some of the goods or services for which a comparable trade mark (EU) is registered, the registration is to be renewed for those goods or services only.

#### Commencement Information

**I12** Sch. 2 para. 3 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

4. A request for information or inspection of documents relating to a comparable trade mark (EU) made under section 67 of the 1994 Act is subject to payment of the appropriate fee (if any).

#### Commencement Information

**I13** Sch. 2 para. 4 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

5. The Trade Marks (Fees) Rules 2008<sup>M9</sup> apply to comparable trade marks (EU) as they apply to other registered trade marks.

#### Commencement Information

**I14** Sch. 2 para. 5 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

#### Marginal Citations

**M9** S.I. 2008/1958 as amended by S.I. 2009/2089, **rules 15 to 19**, S.I. 2010/33, rules 13 to 14, S.I. 2012/1003, **rule 3(2)**, S.I. 2013/2236, rules 2(1) to (c).

**6.** The Commissioners for Her Majesty's Revenue and Customs may by regulations made by statutory instrument require the proprietor or a licensee of a comparable trade mark (EU) who is giving notice under section 89 of the 1994 Act to pay such fees in respect of the notice as may be specified by the regulations.

#### Commencement Information

**I15** Sch. 2 para. 6 in force at 31.12.2020 on IP completion day (in accordance with **2020 c. 1, Sch. 5 para. 1(1)**), see reg. 1(1)

**7.** Regulations under paragraph 6 may make different provision as respects different classes of case to which they apply and may include such incidental and supplementary provisions as the Commissioners consider expedient.

#### Commencement Information

**I16** Sch. 2 para. 7 in force at 31.12.2020 on IP completion day (in accordance with **2020 c. 1, Sch. 5 para. 1(1)**), see reg. 1(1)

**8.** A statutory instrument containing regulations under paragraph 6 is subject to annulment in pursuance of a resolution of either House of Parliament.

#### Commencement Information

**I17** Sch. 2 para. 8 in force at 31.12.2020 on IP completion day (in accordance with **2020 c. 1, Sch. 5 para. 1(1)**), see reg. 1(1)

**9.** The Trade Marks (Customs) Regulations 1994, to the extent that they make provision which could be made under paragraph 6, are to be treated as if they had been made under paragraph 5 as well as under section 90 of the 1994 Act.

#### Commencement Information

**I18** Sch. 2 para. 9 in force at 31.12.2020 on IP completion day (in accordance with **2020 c. 1, Sch. 5 para. 1(1)**), see reg. 1(1)

## SCHEDULE 3

Regulation 4

### Other amendments to the 1994 Act

#### Further amendments to the 1994 Act

**1.** The 1994 Act is further amended as follows.

#### Commencement Information

- I19** Sch. 3 para. 1 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

#### Absolute grounds for refusal of registration

- 2.—(1) Section 3<sup>M10</sup> is amended as follows.
- (2) In subsection (4), omit “or by any provision of EU law”.
- (3) In subsection (4A)—
- (a) at the end of paragraph (a) insert “ or ”;
  - (b) omit paragraph (b) (together with the final “or”);
  - (c) in paragraph (c), omit “or the EU”.
- [<sup>F5</sup>(4) In subsection (4B)—
- (a) in paragraph (a) for “provision of EU law” substitute “enactment or rule of law”;
  - (b) in paragraph (b) for “EU” substitute “United Kingdom”.]

(5) In subsection (4D)—

    - (a) at the end of paragraph (a) insert “ or ”;
    - (b) omit paragraph (b) (together with the final “or”);
    - (c) in paragraph (c), omit “or the EU”.

#### Textual Amendments

- F5** Sch. 3 para. 2(4) substituted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), [10\(a\)](#)

#### Commencement Information

- I20** Sch. 3 para. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

#### Marginal Citations

- M10** Section 3 was amended by [S.I. 2011/1043](#), [article 6\(2\)\(a\)](#) and [S.I. 2018/825](#), [regulation 4](#).

#### Relative grounds for refusal of registration

- 3.—(1) Section 5<sup>M11</sup> is amended as follows.
- (2) In subsection (3) omit “(or, in the case of a European Union trade mark or international trade mark (EC), in the European Union)”.
- (3) In subsection (4)(aa), omit “any provision of EU law, or”.

#### Commencement Information

- I21** Sch. 3 para. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

### Marginal Citations

**M11** Section 5 amended by S.I. 2004/946, **regulations 3** and 7(1), S.I. 2004/2332, **regulations 2** and 3, S.I. 2011/1043, **article 4(1)**, S.I. 2016/299, the Schedule, paragraph 1 and S.I. 2018/825, **regulation 5**.

### Meaning of “earlier trade mark”

- 4.—**(1) Section 6 <sup>M12</sup> is amended as follows.
- (2) In subsection (1)(a)—
- (a) after “registered trade mark” omit “,” and insert “ or ”;
- (b) omit “European Union trade mark or international trade mark (EC)”.
- (3) After subsection (1)(a) insert—
- “(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.”
- (4) Omit subsection (1)(b).
- (5) In subsection (1)(ba)(i)—
- (a) before “has been converted” insert “prior to [F6IP completion day]”; and
- (b) for “within paragraph (b) from an earlier trade mark” substitute “ of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired ”.
- (6) After subsection (1) insert—
- “(1A) In subsection (1), “protected international trade mark (UK)” has the same meaning as in the Trade Marks (International Registration) Order 2008.”
- (7) In subsection (2) omit “or (b)”.
- (8) After subsection (2) insert—
- “(2A) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made pursuant to paragraph 25 of Schedule 2A and which if registered would be an earlier trade mark by virtue of subsection (1)(aa), subject to its being so registered.”

### Textual Amendments

**F6** Words in Sch. 3 para. 4(5)(a) substituted (31.12.2020 immediately before IP completion day) by **The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020** (S.I. 2020/1050), regs. 1(2), **10(b)**

### Commencement Information

**I22** Sch. 3 para. 4 in force at 31.12.2020 on IP completion day (in accordance with **2020 c. 1**, **Sch. 5 para. 1(1)**), see reg. 1(1)

### Marginal Citations

**M12** Section 6 was amended by S.I. 1999/1899, **regulation 13(1)**, S.I. 2004/2332, regulations 2 and 4, S.I. 2016/299, the Schedule, paragraph 1 and S.I. 2018/825, **regulations 7**.



## Raising of relative grounds in opposition proceedings in case of non-use

- 5.—(1) Section 6A <sup>M13</sup> is amended as follows.
- (2) In subsection (1)(b) for “(b)” substitute “ (aa) ”.
- (3) Omit subsections (5) and (5A).

### Commencement Information

**I23** Sch. 3 para. 5 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

### Marginal Citations

**M13** Section 6A was inserted by S.I. 2004/946, regulations 3 and 4 and amended by S.I. 2008/1067 regulations 3 and 4, S.I. 2011/1043, article 4(1), S.I. 2016/299, the Schedule, paragraph 1 and S.I. 2018/825, regulation 8.

## Right to prevent goods entering the UK without being released for free circulation

- 6.—(1) Section 10A is amended as follows.
- (2) In subsection (1)(a) for “EU” substitute “ United Kingdom ”.
- (3) In subsection (5), after “intellectual property rights” insert “ as amended from time to time ”.

### Commencement Information

**I24** Sch. 3 para. 6 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

## Limits on effect of registered trade mark

- 7.—(1) Section 11 <sup>M14</sup> is amended as follows.
- (2) Omit subsection (1A).
- (3) In subsection (1B), omit “or (1A)”.

### Commencement Information

**I25** Sch. 3 para. 7 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

### Marginal Citations

**M14** Section 11 was amended by S.I. 2018/825, regulation 12.

## Order as to disposal of infringing goods, material or articles

8. In section 19(6)(a) <sup>M15</sup> omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

**Changes to legislation:** There are currently no known outstanding effects for the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. (See end of Document for details)

#### Commencement Information

**I26** Sch. 3 para. 8 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

**M15** Section 19 was amended by S.I. 2006/1028, Schedule 2, paragraph 6.

### Grounds for invalidity of registration

9. In section 47<sup>M16</sup> omit subsections (2D) and (2DA).

#### Commencement Information

**I27** Sch. 3 para. 9 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

**M16** Section 47 was amended by S.I. 2004/946, regulations 3 and 6, S.I. 2008/1067, regulations 3 and 5, S.I. 2011/1043 article 4(1), S.I. 2016/299, the Schedule, paragraph 1 and S.I. 2018/825, regulation 23.

### Meaning of “European Union trade mark”

10. In section 51<sup>M17</sup>, in the definition of “the European Union Trade Mark Regulation” at the end insert “ (as it had effect immediately before [F7IP completion day]) ”.

#### Textual Amendments

**F7** Words in Sch. 3 para. 10 substituted (31.12.2020 immediately before IP completion day) by The Intellectual Property (Amendment etc.) (EU Exit) Regulations 2020 (S.I. 2020/1050), regs. 1(2), 10(c)

#### Commencement Information

**I28** Sch. 3 para. 10 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

**M17** Section 51 was amended by S.I. 2016/299, regulations 2 and 4 and S.I. 2018/825, regulation 26.

### Power to make provision in connection with European Union Trade Mark Regulation

11. Omit section 52.

#### Commencement Information

**I29** Sch. 3 para. 11 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

## Privilege for communications with registered trade mark agents

12.—(1) Section 87(3) is amended as follows.

(2) At the end of paragraph (c) insert “ or ”.

(3) After paragraph (c) insert—

“(d) a person whose name appears on the list of professional representatives for trade mark matters maintained by the European Union Intellectual Property Office referred to in Article 120 of the European Union Trade Mark Regulation.”

(4) After subsection (3) insert—

“(4) Where a trade mark attorney is a person falling within subsection (3)(d), subsection (2) applies as if the reference to a matter mentioned in subsection (1) were a reference to a matter relating to the protection of a trade mark.”

### Commencement Information

**I30** Sch. 3 para. 12 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

## Minor definitions

13. In section 103 <sup>M18</sup>, omit subsection (3).

### Commencement Information

**I31** Sch. 3 para. 13 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

### Marginal Citations

**M18** Section 103 was amended by S.I. 2011/1043, article 6(1)(d).

## Index of defined expressions

14.—(1) Section 104 is amended as follows.

(2) After the entry in the table for “commencement (of this Act)” insert—

“comparable trade mark (EU)	Schedule 2A, paragraph 1(2)”
(3) After the entry in the table for “date of application” insert—	
“date of application (comparable trade mark (EU))	Schedule 2A, paragraph 1(8)(b)”
(4) After the entry in the table for “date of filing” insert—	
“date of filing (comparable trade mark (EU))	Schedule 2A, paragraph 1(8)(a)”
(5) After the entry in the table for “date of registration” insert—	
“date of registration (comparable trade mark (EU))	Schedule 2A, paragraph 1(4)”

#### Commencement Information

**I32** Sch. 3 para. 14 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

## SCHEDULE 4

Regulation 5

### Amendments to the Rules

#### Amendments to the Rules

1. The Rules are amended in accordance with paragraphs 2 to 11.

#### Commencement Information

**I33** Sch. 4 para. 1 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

2.—(1) Rule 2 is amended as follows.

(2) In the definition of “fast track opposition”, sub-paragraph (b), for “or in the EU, or is protected in one or another of those territories as an international trade mark (UK) or (EU)” substitute “ or is protected in the UK as an international trade mark (UK) ”.

(3) In paragraph (2) after “in the Act” insert “ , a reference to a schedule is a reference to that schedule to the Act ”.

#### Commencement Information

**I34** Sch. 4 para. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

3. After rule 2 insert—

#### “Comparable trade mark (EU)

2A These Rules apply to a comparable trade mark (EU) as they apply to other registered trade marks.”

#### Commencement Information

**I35** Sch. 4 para. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

4.—(1) Rule 4 is amended as follows.

(2) In sub-paragraph (1) omit “by rules under section 79 (fees)”.

(3) In sub-paragraph (2) omit “by those rules”.

(4) After sub-paragraph (2) insert—

“(3) In this rule, “prescribed” means—

- (a) in relation to a registered trade mark other than a comparable trade mark (EU), prescribed by rules under section 79 (fees);
- (b) in relation to a comparable trade mark (EU), prescribed by virtue of regulations under Schedule 4 to the European Union (Withdrawal) Act 2018.”

#### Commencement Information

**I36** Sch. 4 para. 4 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

5. After rule 5 insert—

#### “Application for registration based upon an existing EUTM application; Schedule 2A paragraph 25

**5A.—**(1) Where an application for registration is made in accordance with paragraph 25 of Schedule 2A, the application for registration under rule 5 must specify—

- (a) the number accorded to the existing EUTM application;
- (b) the filing date accorded to the existing EUTM application; and
- (c) the date of priority (if any) accorded pursuant to a right of priority claimed in respect of the existing EUTM application.

(2) Where—

- (a) a right of priority has been claimed (“a priority claim”) in respect of the existing EUTM application; or
- (b) the seniority of a registered trade mark or a protected international trade mark (UK) has been claimed (“a seniority claim”) under paragraph 26 of Schedule 2A,

the application for registration under rule 5 must, in addition, specify the information provided in paragraph (3).

(3) The information is—

- (a) in relation to a priority claim, the information specified in rule 6(1)(a) to (c); and
- (b) in relation to a seniority claim, the number of the registered trade mark or protected international trade mark (UK) from which the trade mark the subject of the application claims seniority and the seniority date.

(4) The registrar may, in any particular case, by notice require the applicant to file, within such period of not less than one month as the notice may specify, such documentary evidence as the registrar may require certifying, or verifying to the satisfaction of the registrar—

- (a) the filing date accorded to the existing EUTM application, the representation of the mark and the goods or services covered by the existing EUTM application; and
- (b) in relation to a priority claim, the date of filing of the overseas application, the country or registering or competent authority, the representation of the mark and the goods or services covered by the overseas application.”

#### Commencement Information

**I37** Sch. 4 para. 5 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

[<sup>F8</sup>6.—(1) Rule 11 is amended as follows.

(2) At the end of paragraph (1)(d), omit “.” and substitute “;”.

(3) After paragraph (1)(d) insert—

“(e) a proprietor of a comparable trade mark (EU) who sends a derogation notice to the registrar under rule 43A.”.

(4) In paragraph (4), for “another EEA state” substitute “an EEA state”.]

#### Textual Amendments

**F8** Sch. 4 para. 6 substituted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(a)**

#### Commencement Information

**I38** Sch. 4 para. 6 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), **Sch. 5 para. 1(1)**), see reg. 1(1)

[<sup>F9</sup>6A.—(1) Rule 12 is amended as follows.

(2) At the end of paragraph (4)(d), omit “.” and substitute “;”.

(3) After paragraph (4)(d), insert—

“(e) in the case of the proprietor who sends a derogation notice to the registrar, the registrar must proceed as if the proprietor had not sent a derogation notice.”.]

#### Textual Amendments

**F9** Sch. 4 para. 6A inserted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(b)**

#### Commencement Information

**I39** Sch. 4 para. 6A in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), **Sch. 5 para. 1(1)**), see reg. 1(1)

7. In rule 14(3) for “section 6(1)(a) or (b)” substitute “ section 6(1)(a) or (aa) ”.

#### Commencement Information

**I40** Sch. 4 para. 7 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), **Sch. 5 para. 1(1)**), see reg. 1(1)

8. In rule 17A(6)(d), omit “or (EU)”.

#### Commencement Information

**I41** Sch. 4 para. 8 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), **Sch. 5 para. 1(1)**), see reg. 1(1)

9. After rule 29 insert—

**“Filing of regulations for EU collective and certification marks; Schedule 2A, paragraph 4**

**29A** Regulations governing the use of a comparable trade mark (EU) which is a collective mark or a certification mark and any translation required to be filed under paragraph 4 of Schedule 2A must be filed within a period of three months following the date of notice from the registrar.”

**Commencement Information**

**I42** Sch. 4 para. 9 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

**10.** After rule 37 insert—

**“Restoration of a European Union trade mark; Schedule 2A, paragraph 28**

**37A** A request for the registration of a comparable trade mark (EU) following the restoration of a European Union trade mark under paragraph 28 of Schedule 2A must include—

- (a) a representation of the European Union trade mark;
- (b) the registration number of that mark;
- (c) the name and address of the proprietor;
- (d) the goods or services in respect of which that mark is registered;
- (e) the priority date (if any) accorded pursuant to a claim of priority filed in respect of that mark pursuant to the European Union Trade Mark Regulation and the information specified in rule 6(1)(a) to (c) in respect of that priority claim;
- (f) the number of the registered trade mark or international trade mark (UK) from which that mark claimed seniority (if any) and the seniority date.”

**Commencement Information**

**I43** Sch. 4 para. 10 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

[<sup>F10</sup>**10A.**—(1) Rule 43 is amended as follows.

(2) At the end of paragraph (1)(b), omit “, or” and substitute “;”.

(3) At the end of paragraph (1)(c), omit “,” and substitute “; or”.

(4) After paragraph (1)(c), insert—

“(d) the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent under rule 43A(6).”

(5) In paragraph (2), after “application and shall” insert “, in the cases referred to in paragraph (1)(a) to (c).”

(6) In paragraph (3)—

(a) after “TM8” insert “or the derogation notice”;

(b) after “TM26(O)” omit “or” and substitute “;”;

- (c) after “TM 26(I)” insert “or notification from the registrar under rule 43(4)(b) that the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM”.

#### Textual Amendments

- F10** Sch. 4 paras. 10A, 10B inserted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**

#### Commencement Information

- I44** Sch. 4 para. 10A in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

**10B.** After rule 43 insert—

#### **“Invalidation or revocation of Existing EUTM: Cancellation notice and procedure on application for derogation; Schedule 2A paragraph 21A**

**43A.—**(1) A cancellation notice under paragraph 21A of Schedule 2A must—

- (a) identify the existing EUTM by the number under which the existing EUTM was registered in the EUTM Register immediately before IP completion day, together with a representation of the mark,
- (b) include the following details with regard to the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially)—
  - (i) the date of the decision (including any decision determined on appeal),
  - (ii) whether the revocation or declaration of invalidity related to all or part of the goods or services for which the existing EUTM was registered,
  - (iii) where the existing EUTM was revoked (whether wholly or partially) the date on which the revocation took effect,
- (c) be accompanied by a copy of the decision (including any decision determined on appeal) pursuant to which the existing EUTM was revoked or declared to be invalid, and
- (d) include a statement confirming that the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially) has been finally determined.

(2) Where a cancellation notice is submitted to the registrar by the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the cancellation notice must be accompanied by—

- (a) a notice (a “derogation notice”) in writing to the registrar that, based upon the provisions in paragraph 21A(4) of Schedule 2A, the comparable trade mark (EU) should not be revoked or declared invalid (whether wholly or partially), and
- (b) a statement of the reasons why paragraph 21A(4) of Schedule 2A applies (a “statement”) together with relevant supporting evidence (“supporting evidence”).

(3) Where the proprietor of a comparable trade mark (EU) submits a cancellation notice to the registrar but fails to send a derogation notice, a statement or supporting evidence, the registration of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice must be revoked or declared invalid to the same extent as the existing EUTM, unless the registrar directs otherwise.



(4) Where the registrar receives a cancellation notice submitted by a person other than the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the registrar must as soon as reasonably practicable after receipt of the cancellation notice—

- (a) send a copy of the cancellation notice to the proprietor of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice, and
- (b) notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM that based upon the revocation or declaration of invalidity of the existing EUTM, the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM.

(5) Where the registrar has become aware of the situation referred to in paragraph 21A(2)(a) of Schedule 2A otherwise than by a cancellation notice, the registrar must as soon as reasonably practicable after becoming aware of that situation, notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM in the terms provided in paragraph (4)(b).

(6) The proprietor of a comparable trade mark (EU) referred to in paragraph (4) and (5) must, within such period of not less than one month as may be specified in the notice referred to in paragraph (4)(b) and (5), send to the registrar a derogation notice accompanied by a statement and supporting evidence as referred to in paragraph (2), failing which the registration of the comparable trade mark (EU) must be revoked or declared invalid to the same extent as the corresponding EUTM, unless the registrar directs otherwise.

(7) The registrar must, in reaching a decision as to whether paragraph 21A(4) of Schedule 2A applies to a comparable trade mark (EU), have regard to the statement and supporting evidence filed by the proprietor of the comparable trade mark (EU) and must send written notice of the decision to the proprietor, stating the reasons for that decision.

(8) For the purposes of any appeal against a decision referred to in sub-paragraph (7), the date on which the notice is sent must be taken to be the date of the decision.”.]

#### Textual Amendments

**F10** Sch. 4 paras. 10A, 10B inserted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(c)**

#### Commencement Information

**I45** Sch. 4 para. 10B in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

**11.—(1)** Rule 47 is amended as follows.

(2) At the end of paragraph (a) insert “ or, in the case of a comparable trade mark (EU), as determined in accordance with paragraph 1 of Schedule 2A ”.

(3) At the end of paragraph (b) insert “ (which in the case of a comparable trade mark (EU) is the date of registration of the corresponding EUTM in the EUTM Register) ”.

(4) After paragraph (c) insert—

“(ca) in the case of a comparable trade mark (EU)—

- (i) the priority date (if any) accorded pursuant to a claim of priority filed in respect of the corresponding EUTM pursuant to the European Union Trade Mark Regulation; and

**Changes to legislation:** There are currently no known outstanding effects for the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. (See end of Document for details)

- (ii) the number of the registered trade mark or international trade mark (UK) from which the corresponding EUTM claimed seniority (if any) and the seniority date;
- (cb) where the mark is registered pursuant to an application referred to in paragraph 26 of Schedule 2A—
  - (i) the priority date (if any) accorded pursuant to a claim to a right to priority made under paragraph 25(2)(a)(ii) of Schedule 2A; and
  - (ii) the number of the registered trade mark or international trade mark (UK) from which the application claims seniority (if any) and the seniority date;”.
- (5) Omit paragraph (l).
- (6) After paragraph (m) <sup>M19</sup> insert—
  - “(n) in the case of a comparable trade mark (EU) an indication that it is derived from an existing EUTM, including the number of the corresponding EUTM [<sup>F11</sup>], and where the corresponding EUTM is subject to cancellation proceedings, that cancellation is pending].”.

#### Textual Amendments

**F11** Words in [Sch. 4 para. 11\(6\)](#) inserted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **11(d)**

#### Commencement Information

**I46** [Sch. 4 para. 11](#) in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

#### Marginal Citations

**M19** Paragraph (m) was inserted by [S.I. 2018/825](#), [regulation 43](#).

## SCHEDULE 5

Regulation 6

Consequential amendments, repeals, revocations, transitional and saving provisions

### Consequential amendments

**1.** In section 24D(5)(b) of the Registered Designs Act 1949 <sup>M20</sup> omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

#### Commencement Information

**I47** [Sch. 5 para. 1](#) in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

#### Marginal Citations

**M20** [1949 c. 88](#) as amended by [S.I. 2006/1028](#), [schedule 1](#), paragraph 3.

**2.** In sections 114(6)(c), 204(6)(c) and 231(6)(c) of the Copyright, Designs and Patents Act 1988 <sup>M21</sup> omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

#### Commencement Information

**I48** Sch. 5 para. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

**M21** 1988 c. 48.

3. In regulation 5(7)(b) of the Olympics Association Right (Infringement Proceedings) Regulations 1995 <sup>M22</sup> omit “(including that section as applied by regulation 4 of the Community Trade Marks Regulations 2006)”.

#### Commencement Information

**I49** Sch. 5 para. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

**M22** S.I. 1995/3325 as amended by S.I. 2010/2477, regulation 6.

4. In regulation 1C(5)(d) of the Community Design Regulations 2005 <sup>M23</sup> omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

#### Commencement Information

**I50** Sch. 5 para. 4 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

**M23** S.I. 2005/2339 as amended by S.I. 2006/1028, schedule 3, paragraph 9.

5. In regulation 4(8)(b) of the Olympics, Paralympics and London Olympics Association Rights (Infringement Proceedings) Regulations 2010 <sup>M24</sup> omit “(including that section as applied by regulation 4 of the Community Trade Marks Regulations 2006)”.

#### Commencement Information

**I51** Sch. 5 para. 5 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

#### Marginal Citations

**M24** S.I. 2010/2477.

### Repeals and revocations

6. The enactments listed in column 1 of the Table are repealed or revoked to the extent specified in column 2.

#### Enactment

The Legal Services Act 2007

#### Extent of repeal or revocation

[<sup>F12</sup>Schedule 21], paragraph 110

**Changes to legislation:** There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. (See end of Document for details)

M25

The Intellectual Property (Unjustified Threats) Section 3  
Act 2017  
M26

Community Trade Mark (Amendment) In its entirety  
Regulations 2008  
M27

The European Union Trade Mark Regulations Regulations 6 to 12  
2016  
M28

The Trade Marks Regulations 2018 Regulations 7(2), 8(6), 23(7) and 27  
M29

Regulation (EU) 2017/1001 of the European In its entirety  
Parliament and of the Council of 14th June 2017  
on the European Union trade mark  
M30

Commission Implementing Regulation (EU) In its entirety  
2018/626 of 5th March 2018  
M31

Commission Delegated Regulation (EU) In its entirety  
2018/625 of 5th March 2018  
M32

#### Textual Amendments

**F12** Words in [Sch. 5 para. 6](#) Table substituted (31.12.2020 immediately before IP completion day) by [The Intellectual Property \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1050\)](#), regs. 1(2), **12**

#### Commencement Information

**I52** Sch. 5 para. 6 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

#### Marginal Citations

**M25** [2007 c. 29](#).

**M26** [2017 c. 14](#).

**M27** [S.I. 2008/1959](#).

**M28** [S.I. 2016/299](#).

**M29** [S.I. 2018/825](#).

**M30** O.J. No. L 154/1, 16.6.2017, p.1.

**M31** O.J. No. L 104/1, 24.4.2018, p.37.

**M32** O.J. No. L 104/1, 24.4.2018, p.1.

#### Transitional and Saving Provisions

7.—(1) [<sup>F13</sup>Subject to paragraph 8,] any application or proceeding under the 1994 Act which was made or commenced before the coming into force of these Regulations shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force.

[<sup>F14</sup>(1A) Sub-paragraph 1 does not apply to an application to register a trade mark that was pending immediately before the coming into force of these Regulations referred to in—

- (a) Article 14a of Regulation (EU) No 1151/2012 of the European Parliament and of the Council on quality schemes for agricultural products and foodstuffs, or that Article as applied by Article 14d of that Regulation;
- (b) Article 102a of Regulation (EU) No 1308/2013 of the European Parliament and of the Council establishing a common organisation of the markets in agricultural products, or that Article as applied by Article 102d of that Regulation;
- (c) Article 19a of Regulation (EU) No 251/2014 of the European Parliament and of the Council on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products, or that Article as applied by Article 19d of that Regulation;
- (d) Article 32a of Commission Delegated Regulation (EU) 2019/33 supplementing Regulation (EU) No 1308/2013 of the European Parliament and of the Council as regards applications for protection of designations of origin, geographical indications and traditional terms in the wine sector, the objection procedure, restrictions of use, amendments to product specifications, cancellation of protection, and labelling and presentation, or that Article as applied by Article 32d of that Regulation;]

[<sup>F15</sup>(e) Article 36a of Regulation (EU) 2019/787 of the European Parliament and of the Council on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages, or that Article as applied by Article 36d of that Regulation.]

(2) The repeal of section 52 of the 1994 Act (Power to make provision in connection with European Union Trade Mark Regulation) does not affect any proceedings which are pending on the coming into force of these Regulations before the EU trade mark courts designated by regulation 12 of the Community Trade Mark Regulations 2006 <sup>M33</sup> insofar as such proceedings relate to the application and enforcement of a European Union trade mark in the United Kingdom.

#### Textual Amendments

- F13** Words in [Sch. 5 para. 7\(1\)](#) inserted (26.11.2021) by [The Trade Marks and International Trade Marks \(Amendment\) \(EU Exit\) Regulations 2021 \(S.I. 2021/1235\)](#), regs. 1, [3](#)
- F14** [Sch. 5 para. 7\(1A\)](#) inserted (31.12.2020 immediately before IP completion day) by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(6), [3](#) (as amended by [S.I. 2020/1661](#), regs. 1(2)(b), [16\(2\)\(a\)-\(d\)](#))
- F15** [Sch. 5 para. 7\(1A\)\(e\)](#) inserted (31.12.2020 immediately before IP completion day) by [The Agricultural Products, Food and Drink \(Amendment\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1661\)](#), regs. 1(2)(b), [12](#)

#### Commencement Information

- I53** [Sch. 5 para. 7](#) in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

#### Marginal Citations

- M33** [S.I. 2006/1027](#) as amended by, [S.I. 2008/1959](#), [2011/1043](#), [2016/299](#) and by the [Intellectual Property \(Unjustified Threats\) Act 2017 \(c.14\)](#), [section 3](#).

## [<sup>F16</sup>Qualification to Transitional Provision

8.—(1) Opposition or invalidation proceedings other than excluded proceedings (“relevant proceedings”) shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force subject to the provisions set out in this paragraph.

(2) The provisions in sub-paragraphs (5) and (6) apply to relevant proceedings where the conditions in sub-paragraph (4) are met.

(3) The provisions in sub-paragraph (8) apply to relevant proceedings in the circumstances mentioned in that sub-paragraph.

(4) The conditions mentioned in sub-paragraph (2) are that—

(a) the relevant proceedings are based, whether wholly or partially, on the ground that there exists an earlier trade mark (“a relevant earlier mark”) which is—

- (i) an existing EUTM,
- (ii) an existing EUTM application,
- (iii) an existing IR(EU), or
- (iv) an existing ITM application or existing request for EU extension;

(b) in the case of proceedings referred to in sub-paragraphs (a)(i) and (iii), the comparable trade mark (EU) or comparable trade mark (IR) which derives from the existing EUTM or the existing IR(EU) (as the case may be) is the subject of—

- (i) a declaration of invalidity under section 47 of the 1994 Act,
- (ii) a revocation decision under section 46 of the 1994 Act based on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or
- (iii) an application for a declaration of invalidity or revocation as referred to in sub-paragraphs (i) and (ii);

(c) in the case of proceedings referred to in sub-paragraphs (a)(ii) and (iv), an application for registration of a trade mark based upon the existing EUTM application pursuant to paragraph 25 of Schedule 2A to the 1994 Act or an application for registration of a trade mark based upon the existing ITM application or the existing request for EU extension pursuant to paragraph 28 or 29 of schedule 2B to the 1994 Act (as the case may be)—

- (i) has been made and the application has neither resulted in the registration of the trade mark nor the registration being refused (“a pending TM application”),
- (ii) has resulted in the registration of the trade mark in part only,
- (iii) has resulted in the registration of the trade mark, which registration is the subject of a revocation decision or an application for the same under section 46 of the 1994 Act based on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or
- (iv) has resulted in the registration of the trade mark which registration is the subject of a declaration of invalidity or an application for the same under section 47 of the 1994 Act.

(5) In the case of an application for a declaration of invalidity or revocation as referred to in sub-paragraphs (4)(b)(iii) and (4)(c)(iii) and (iv) (“pending proceedings”) or a pending TM application, the registrar may decide that the relevant proceedings be determined only after—

- (a) a final decision has been made in the pending proceedings;
  - (b) the trade mark the subject of the pending TM application has been registered whether in whole or in part or the trade mark has not proceeded to registration for any reason, including as a result of the application not being accepted or it being successfully opposed, withdrawn or abandoned.
- (6) Where—
- (a) the comparable trade mark (EU) or comparable trade mark (IR) referred to in sub-paragraph (4)(b) is the subject of a final decision which declares the registration invalid to any extent or revokes the registration to any extent on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application,
  - (b) the application for registration of a trade mark referred to in sub-paragraph (4)(c) has resulted in registration of the trade mark in part only, or
  - (c) the trade mark referred to in sub-paragraph (4)(c)(iii) or (iv) is the subject of a final decision which revokes the registration to any extent on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or which declares the registration invalid to any extent,

the registrar may decide that the relevant proceedings shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force taking account of the provisions in sub-paragraph (7).

(7) A relevant earlier mark on which the relevant proceedings were based may be relied on if or to the same extent that—

- (a) the registration of the comparable trade mark (EU) or comparable trade mark (IR) referred to in sub-paragraph (6)(a) is not declared invalid or the registration is not revoked,
- (b) the application for registration of a trade mark referred to in sub-paragraph (6)(b) is registered, or
- (c) the trade mark referred to in sub-paragraph (6)(c) is not revoked or declared invalid.

(8) Where the relevant proceedings are based whether wholly or partially on the ground that there exists a relevant earlier mark which is—

- (a) an existing EUTM or an existing IR(EU) which is the subject of an opt out notice,
- (b) an existing EUTM application, an existing ITM application or an existing request for EU extension in respect of which—
  - (i) no application has been made for registration of the same trade mark pursuant to paragraph 25 of Schedule 2A to the 1994 Act or paragraph 28 or 29 of Schedule 2B to the 1994 Act (as the case may be) and the period within which such application must be made, as provided in those paragraphs, has expired, or
  - (ii) an application for registration of the same trade mark has been made pursuant to the provisions referred to in sub-paragraph (i) and the trade mark has not proceeded to registration whether in whole or in part for any reason, including as a result of the application not being accepted, or it being successfully opposed, withdrawn or abandoned,

the relevant proceedings shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force except the registrar may decide that the existing EUTM, existing IR(EU), existing EUTM application, existing ITM application or existing request for EU extension (as the case may be) may not be relied upon as an earlier trade mark for the purposes of the relevant proceedings.

(9) In this paragraph—

- (a) “excluded proceedings” means opposition or invalidation proceedings which have been the subject of a decision on the substantive issues raised in the proceedings prior to the coming into force of this paragraph;
- (b) “final decision” means a decision which has been determined and there is no possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time);
- (c) the terms “existing EUTM”, “comparable trade mark (EU)” and “existing EUTM application” have the meanings given respectively by paragraphs 1(1), 1(2) and 24(1) of Schedule 2A to the 1994 Act;
- (d) the term “opt out notice”, in relation to an existing EUTM, has the meaning given by paragraph 2(1) of Schedule 2A to the 1994 Act and in relation to an existing IR(EU) has the meaning given by paragraph 2(1) of Schedule 2B to the 1994 Act;
- (e) the terms “existing IR(EU)” and “comparable trade mark (IR)” have the meanings given respectively by paragraphs 1(1) and 1(4) of Schedule 2B to the 1994 Act;
- (f) the terms “existing ITM application” and “existing request for EU extension” have the meanings given by paragraph 33(7) of Schedule 2B to the 1994 Act.]

#### Textual Amendments

**F16** Sch. 5 para. 8 inserted (26.11.2021) by [The Trade Marks and International Trade Marks \(Amendment\) \(EU Exit\) Regulations 2021 \(S.I. 2021/1235\)](#), regs. 1, 4

## EXPLANATORY NOTE

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

These Regulations are made in exercise of the powers conferred by section 8(1) of the European Union (Withdrawal) Act 2018 (c.16) (“the EUWA”) in order to address failures of retained EU law to operate effectively and other deficiencies (in particular under paragraphs (c), (d) and (g) of section 8(2) of the EUWA) and paragraph 1 of Schedule 4 of the EUWA (in relation to the charging of fees or other charges by the registrar under the Trade Marks Act 1994 (c.26) (“the 1994 Act”) in connection with the exercise of functions conferred on the registrar by virtue of provision made under section 8(1)).

Schedule 1 to these Regulations inserts new Schedule 2A into the 1994 Act.

Part 1 of Schedule 2A provides that a trade mark which is registered immediately before exit day as a European Union trade mark under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ No. L 154, 16.6.2017, p.1) (“the EUTM Regulation”) is to be treated on and after exit day as if it had been applied for and registered as a trade mark under the 1994 Act (unless the proprietor opts not to receive such a mark) and the provisions of the 1994 Act are expressed to apply to such marks as they apply to other marks registered under the 1994 Act, except as provided to the contrary.

Part 1 contains provisions which adapt the application of various provisions (for example the raising of relative grounds in opposition proceedings in case of non-use under section 6A of the 1994 Act) which rely upon the applicant or defendant being able to demonstrate that the



trade mark has been put to genuine use in the UK, by providing that in considering whether such conditions have been met, there will be included genuine use of the trade mark in the European Union prior to exit day. It also contains provisions setting out the effect on a trade mark derived from a European Union trade mark of transactions (such as the grant of a licence or a security interest) entered into prior to exit day in relation to that European Union trade mark and also the conduct of proceedings which are pending on exit day before the courts in the United Kingdom which have been designated as EU trade marks courts for the purposes of the EUTM Regulation. Part 2 of Schedule 2A makes provision for European Union trade marks which have expired during the period of 6 months ending on exit day (and which accordingly are not covered by the provisions in Part 1). Subject to their renewal in accordance with the EUTM Regulation, such marks will be treated on and after exit day as if they had been applied for and registered under the 1994 Act and the provisions of Part 1 apply to such marks.

Part 3 provides that where an application for a European Union trade mark is pending on exit day, the applicant may file an application for registration of the same mark under the 1994 Act and such application may claim the filing date, the priority date (if any) and seniority of another national mark (if any) of the application for the European Union trade mark on which it is based. Such an application must be made within 9 months of exit day.

Part 4 provides that where a European Union trade mark is removed from the register prior to exit day and is restored to the register after exit day pursuant to the EUTM Regulation, the proprietor may within a period of 6 months following the restoration request that the trade mark be treated as if it were subject to Part 1. Similar provision applies in relation to an application for a European Union trade mark which is refused and subsequently restored.

Schedule 2 to the Regulations (made pursuant to paragraph 1 of Schedule 4 to the EUWA) makes provision for the payment of fees in relation to trade marks which derive from European Union trade marks pursuant to the provisions in Schedule 1 and provides that the Trade Marks (Fees) Rules 2008 (S.I. 2008/1958) apply to such marks as they apply to other registered trade marks under the 1994 Act.

Schedule 3 contains other amendments to the 1994 Act by removing EU references which are no longer appropriate.

Schedule 4 contains amendments to the Trade Marks Rules 2008 (S.I. 2008/ 1797) which are made under section 78 of the 1994 Act and reflect changes to procedural matters arising out of the amendments to the 1994 Act made under these Regulations.

Schedule 5 contains various consequential amendments, repeals, revocations, transitional and saving provisions arising out of the provisions contained in Schedules 1 to 4 of the Regulations. In particular it revokes the EUTM Regulation and the related Commission Implementing Regulation (EU) 2018/626 of 5<sup>th</sup> March 2018 and Commission Delegated Regulation (EU) 2018/625 of 5<sup>th</sup> March 2018.

A full impact assessment has not been produced for this instrument as no significant impact on the private, voluntary sector or public sector is foreseen. A copy of this instrument and the Explanatory Memorandum is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, NP20 8QQ. The explanatory memorandum is also available alongside the instrument on the Legislation UK website [www.legislation.gov.uk](http://www.legislation.gov.uk) (copies have also been placed in the libraries of both Houses of Parliament).

**Changes to legislation:**

There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019.