

SCHEDULES

[^{F1}SCHEDULE 2B

INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION

Textual Amendments

- F1** Sch. 2B inserted (31.12.2020) by [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019 \(S.I. 2019/638\)](#), reg. 1, [Sch. 4 para. 3](#) (with Sch. 5 Pt. 2) (as amended by [S.I. 2020/1050](#), regs. 1(2), [22\(b\)](#)); 2020 c. 1, [Sch. 5 para. 1\(1\)](#)

PART 1

EXISTING INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION

Effect of a licence of an existing IR(EU)

- 18 (1) This paragraph applies where immediately before IP completion day an existing IR(EU) is the subject of a licence (a “relevant licence”) which—
- authorises the doing of acts in the United Kingdom which would otherwise infringe the international trade mark; and
 - does not expire on 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 (IR) which derives from the existing IR(EU).
- (3) Sub-paragraph (2) is subject to—
- the terms on which the relevant licence was granted; and
 - 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 (IR), subject to the modifications set out below.
- (5) An application under section 25(1) may only be made by—
- a person claiming to be a licensee by virtue of the relevant licence; or
 - the proprietor of the comparable trade mark (IR).
- (6) Where immediately before IP completion day there is an entry in the International Register relating to a relevant licence—
- section 25(3) and (4) does not apply until after the expiry of the relevant period; and

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Paragraph 18. (See end of Document for details)

- (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 IP completion day.
- (7) In sub-paragraph (6)(a), the “relevant period” means the period of twelve months beginning with the day after that on which IP completion day falls.]

Changes to legislation:

There are currently no known outstanding effects for the Trade Marks Act 1994, Paragraph 18.