

*Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Paragraph 21. (See end of Document for details)*

## SCHEDULES

### [<sup>F1</sup>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

##### *Existing IR(EU): pending proceedings*

- 21 (1) This paragraph applies where on IP completion day an existing IR(EU) is the subject of proceedings which are pending (“pending proceedings”) before a court in the United Kingdom designated for the purposes of Article 123 of the European Union Trade Mark Regulation (“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 IP completion day.
- (3) Where the pending proceedings involve a claim for infringement of an existing IR(EU), without prejudice to any other relief by way of damages, accounts or otherwise available to the proprietor of the existing IR(EU), the EU trade mark court may grant an injunction to prohibit unauthorised use of the comparable trade mark (IR) which derives from the existing IR(EU).
- (4) Where the pending proceedings involve a counterclaim for the revocation of, or a declaration of invalidity in relation to, an existing IR(EU), the EU trade mark court may revoke the registration of the comparable trade mark (IR) which derives from the existing IR(EU) or declare the registration of the comparable trade mark (IR) which derives from the existing IR(EU) 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 IR(EU) is registered, the revocation or declaration of invalidity in respect of the registration of the comparable trade mark (IR) which derives from the existing IR(EU) relates to those goods or services only.

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- (6) Where (by virtue of sub-paragraph (4)) the registration of a comparable trade mark (IR) 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 (IR) 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 IP completion day if they were instituted but not finally determined before IP completion day.]

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