

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, PART 2. (See end of Document for details)

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 2

TREATMENT OF INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION WHICH EXPIRE DURING THE PERIOD OF SIX MONTHS ENDING ON IP COMPLETION DAY

Registration of certain expired international trade marks

- 23 (1) This Part applies to an international trade mark which, immediately before the transitional period, was protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation but which, as a result of the expiry of the registration of the international trade mark during the transitional period, does not fall within paragraph 1(1) (an “expired IR(EU)”).
- (2) Where the international registration to which an international trade mark is subject has been sub-divided as referred to in paragraph 1(2), there is to be deemed for the purposes of sub-paragraph (1) to be a separate expired trade mark in respect of the goods or services covered by each sub-division of the registration.
- (3) An expired IR(EU) is to be treated as if it were an existing IR(EU).
- (4) The provisions of Part 1 of this Schedule apply to an expired IR(EU) as they apply to an existing IR(EU) subject to the provisions of this Part of the Schedule.
- (5) Notwithstanding the entry in the register (under paragraph 3, as applied by sub-paragraph (4)) of a comparable trade mark (IR) which derives from an expired IR(EU), the registration of the comparable trade mark (IR) is expired until the proprietor gives notice to the registrar in accordance with paragraph 24(1)(b) (or the comparable trade mark (IR) is removed from the register in accordance with paragraph 24(2)).
- (6) In this paragraph, “transitional period” means the period of six months ending with IP completion day.

*Changes to legislation: There are currently no known outstanding effects
for the Trade Marks Act 1994, PART 2. (See end of Document for details)*

Renewal of an expired IR(EU)

- 24 (1) Where within the period beginning with IP completion day and ending with the end of the relevant period—
- (a) the international registration to which an expired IR(EU) is subject is renewed in accordance with Article 7; and
 - (b) the proprietor of the expired IR(EU) notifies the registrar of such renewal (a “renewal notice”),
- paragraphs 25 and 26 apply to the renewal of the registration of the comparable trade mark (IR) which derives from the expired IR(EU).
- (2) If within the period referred to in sub-paragraph (1) the proprietor fails to notify the registrar in accordance with sub-paragraph (1)(b)—
- (a) the registrar must remove from the register the comparable trade mark (IR) which derives from the expired IR(EU); and
 - (b) the comparable trade mark (IR) ceases with effect from IP completion day to be treated as if it had been registered under this Act.
- (3) In sub-paragraph (1), the “relevant period” means the period of nine months beginning with the day after that on which IP completion day falls.

Renewal of an expired IR(EU): territorial extension under Article 3ter(1)

- 25 (1) Where the protection in the European Union of an expired IR(EU) resulted from a request for territorial extension under Article 3ter(1), the registrar must, as soon as reasonably practicable following receipt of the renewal notice, renew the registration of the comparable trade mark (IR) which derives from the expired IR(EU).
- (2) A comparable trade mark (IR) which is renewed under sub-paragraph (1) shall be renewed for a period of ten years from the expiry of the international registration to which the expired IR(EU) is subject.
- (3) Section 43(6) applies to the registration of a comparable trade mark (IR) which is renewed in accordance with this paragraph.

Renewal of an expired IR(EU): territorial extension under Article 3ter(2)

- 26 (1) This paragraph applies where the protection in the European Union of an expired IR(EU) resulted from a request for territorial extension under Article 3ter(2).
- (2) The relevant date for the purposes of determining the date of renewal of the registration of the comparable trade mark (IR) which derives from the expired IR(EU) (the “relevant renewal date”) shall be—
- (a) the date of expiry of the period of ten years from the date on which the request for territorial extension was recorded in the International Register; or
 - (b) where the international registration to which the expired IR(EU) is subject has been renewed since the date referred to in paragraph (a), the anniversary of that date, computed by reference to periods of ten years, following the last renewal of the registration prior to the date of the renewal notice (the “notice date”).
- (3) Where the relevant renewal date of a comparable trade mark (IR) falls prior to the notice date, the registrar must, as soon as reasonably practicable following receipt

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, PART 2. (See end of Document for details)

of a renewal notice, renew the registration of the comparable trade mark (IR) which derives from the expired IR(EU).

- (4) Where the relevant renewal date of a comparable trade mark (IR) falls before the expiry of the period of six months beginning with the notice date, sub-paragraphs (5) and (6) apply (and accordingly section 43(1) to (3A) does not apply).
- (5) The registration of the comparable trade mark (IR) may be renewed at the request of the proprietor before the relevant renewal date.
- (6) Where the registration of the comparable trade mark (IR) is not renewed in accordance with sub-paragraph (5)—
 - (a) on, or as soon as reasonably practicable after, the relevant renewal date, the registrar must notify the proprietor that the registration of the comparable trade mark (IR) has expired and of the manner in which registration may be renewed; and
 - (b) a request for renewal must be made within a period of six months beginning with the date of the notice.
- (7) If a request for renewal is made in respect of only some of the goods or services for which the comparable trade mark (IR) is registered, the registration is to be renewed for those goods or services only.
- (8) A comparable trade mark (IR) which is renewed under sub-paragraph (3) or pursuant to a request for renewal in accordance with sub-paragraph (5) or (6) shall be renewed for a period of ten years from the relevant renewal date (and accordingly, section 43(4) does not apply).
- (9) Where sub-paragraphs (5) and (6) apply to the renewal of the registration of a comparable trade mark (IR) and the registration is not renewed in accordance with those provisions, the registrar must remove the comparable trade mark (IR) from the register.
- (10) Section 43(6) applies to the registration of a comparable trade mark (IR) which is renewed in accordance with this paragraph.
- (11) Where a comparable trade mark (IR) is removed from the register pursuant to sub-paragraph (9), 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 (IR) to the register.
- (12) Where the relevant renewal date of a comparable trade mark (IR) falls on or after the expiry of the period of six months beginning with the notice date, section 43 applies to the renewal of the registration of the comparable trade mark (IR) and references to the expiry of the registration are to be treated as references to the relevant renewal date of the comparable trade mark (IR).]

Changes to legislation:

There are currently no known outstanding effects for the Trade Marks Act 1994, PART 2.