

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, PART 3. (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 3

APPLICATIONS FOR THE EXTENSION OF PROTECTION OF INTERNATIONAL REGISTRATIONS TO THE EUROPEAN UNION WHICH ARE PENDING ON IP COMPLETION DAY

Interpretation

- 27 (1) In this Part—
- (a) references to an “existing ITM application” are to an international application which contains a request for extension of the protection resulting from an international registration to the European Union under Article 3ter(1) in respect of which the conditions in sub-paragraph (2) are satisfied;
 - (b) references to an “existing request for EU extension” are to a request for extension to the European Union of the protection resulting from an international registration made subsequent to the international registration pursuant to Article 3ter(2) in respect of which the conditions in sub-paragraph (3) are satisfied;
 - (c) references to an “international application” are to an application to the International Bureau under Article 2(2) for the registration of a trade mark in the International Register.
- (2) The conditions referred to in sub-paragraph (1)(a) are—
- (a) the international application was filed before IP completion day with the Office of origin in accordance with Article 2(2); and
 - (b) as at the time immediately before IP completion day, the request for extension of protection to the European Union mentioned in the international application has been neither granted nor refused by the European Union Intellectual Property Office.
- (3) The conditions referred to in sub-paragraph (1)(b) are—
- (a) the request for extension of protection to the European Union was filed before IP completion day with the Office of origin or the International Bureau (as the case may be) in accordance with Rule 24(2); and

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- (b) as at the time immediately before IP completion day, the request for extension of protection to the European Union has been neither granted nor refused by the European Union Intellectual Property Office under the European Union Trade Mark Regulation.
- (4) In sub-paragraphs (2)(b) and (3)(b) —
- (a) the reference to the request for extension of protection to the European Union being “granted” means the European Union Intellectual Property Office having sent to the International Bureau a statement to the effect that protection is granted to the mark in the European Union in accordance with Rule 18*ter*; and
 - (b) the reference to the request for extension of protection to the European Union being “refused” means the European Union Intellectual Property Office having sent to the International Bureau a notification of refusal in accordance with Article 5(1) or (2) which refusal has not been subsequently withdrawn.

Application for registration under this Act based upon an existing ITM application or an existing request for EU extension recorded in the International Register prior to IP completion day

- 28 (1) This paragraph applies where—
- (a) either—
 - (i) an existing ITM application has been filed with the International Bureau in respect of a trade mark and the date accorded to the international registration of the trade mark pursuant to Article 3(4) is a date prior to IP completion day; or
 - (ii) an existing request for EU extension in respect of a trade mark has been filed with the International Bureau and the date on which it was recorded in the International Register pursuant to Article 3*ter*(2) is a date prior to IP completion day;
 - (b) the person who filed the existing ITM application or (as the case may be) the existing request for EU extension, 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, and
 - (c) the application under this Act is made within a period beginning with IP completion day and ending with the end of the period referred to in sub-paragraph (4).
- (2) Where this paragraph applies, the relevant date for the purposes of establishing which rights take precedence is the earliest of—
- (a) the date accorded to the international trade mark the subject of the existing ITM application pursuant to Article 3(4) or, in the case of an existing request for EU extension, the date on which the request was recorded in the International Register pursuant to Article 3*ter*(2);
 - (b) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention in respect of the existing ITM application or the existing request for EU extension (as the case may be).
- (3) The registrability of the trade mark the subject of an application under this Act of the type mentioned in sub-paragraph (1)(b) and made within the period mentioned in sub-paragraph (1)(c) shall not be affected by any use of the mark in the United

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Kingdom which commenced in the period between the date referred to in sub-paragraph (2) and the date of the application under this Act.

- (4) In sub-paragraph (1)(c), the period referred to is the period of nine months beginning with the day after that on which IP completion day falls.
- (5) A right of priority claimed pursuant to Article 4 of the Paris Convention in respect of an existing request for EU extension is to be disregarded for the purposes of sub-paragraph (2)(b) unless the existing request for EU extension was recorded in the International Register within a period of six months beginning with the day after the priority date recorded in the International Register in respect of the international application for protection of the trade mark which is the same as the one in respect of which the existing request for EU extension was filed.

Application for registration under this Act based upon an existing ITM application or an existing request for EU extension recorded in the International Register on or after IP completion day

- 29 (1) This paragraph applies where—
- (a) either—
 - (i) an existing ITM application has been filed with the International Bureau in respect of a trade mark and the date accorded to the international registration of the trade mark pursuant to Article 3(4) is a date on or after IP completion day; or
 - (ii) an existing request for EU extension in respect of a trade mark has been filed with the International Bureau and the date on which it was recorded in the International Register pursuant to Article 3ter(2) is a date on or after IP completion day;
 - (b) the person who filed the existing ITM application or (as the case may be) the existing request for EU extension, 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; and
 - (c) the application under this Act is made within the period of nine months beginning with the date referred to in sub-paragraph (a)(i) or (ii) (as the case may be).
- (2) Where this paragraph applies, the relevant date for the purposes of establishing which rights take precedence is the earliest of—
- (a) the date accorded to the international trade mark the subject of the existing ITM application pursuant to Article 3(4) or, in the case of an existing request for EU extension, the date on which the request was recorded in the International Register pursuant to Article 3ter(2);
 - (b) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention in respect of the existing ITM application or the existing request for EU extension (as the case may be).
- (3) The registrability of the trade mark the subject of an application under this Act of the type mentioned in sub-paragraph (1)(b) and made within the period mentioned in sub-paragraph (1)(c) 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 sub-paragraph (2) and the date of the application under this Act.

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- (4) A right of priority claimed pursuant to Article 4 of the Paris Convention in respect of an existing request for EU extension is to be disregarded for the purposes of sub-paragraph (2)(b) unless the existing request for EU extension was recorded in the International Register within a period of six months beginning with the day after the priority date recorded in the International Register in respect of the international application for protection of the trade mark which is the same as the one in respect of which the existing request for EU extension was filed.

Right to claim seniority where seniority has been claimed by an existing ITM application or an existing request for EU extension

- 30 (1) Where an existing ITM application or an existing request for EU extension 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 31, 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.
- (4) In sub-paragraph (1), an application for registration of a trade mark “pursuant to this Part” means an application that is of the type mentioned in paragraph 28(1)(b) or 29(1)(b) and that is made within the period mentioned in paragraph 28(1)(c) or 29(1)(c) (as the case may be).

Determination of invalidity and liability to revocation in relation to claim of seniority under paragraph 30

- 31 (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 sub-paragraph (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) where the application for registration of the relevant mark was based on an existing ITM application and there has been no claim

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- of priority, the date of registration accorded pursuant to Article 3(4) to the international trade mark the subject of the existing ITM application;
- (ii) where the application for registration of the relevant mark was based on an existing request for EU extension and there has been no claim of priority, the date on which the request was recorded in the International Register pursuant to Article 3ter(2);
 - (iii) where the application for registration of the relevant mark was based on an existing ITM application or an existing request for EU extension and there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention; 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 International Register; 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 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) where the application for registration of the relevant mark was based on an existing ITM application and there has been no claim of priority, the date of registration accorded pursuant to Article 3(4) to the international trade mark the subject of the existing ITM application;
 - (ii) where the application for registration of the relevant mark was based on an existing request for EU extension and there has been no claim of priority, the date on which the request was recorded in the International Register pursuant to Article 3ter(2);
 - (iii) where the application for registration of the relevant mark was based on an existing ITM application or an existing request for EU extension and there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention; 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) Where the application for registration of the relevant mark was based on an existing request for EU extension a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the request for EU extension is to be disregarded for the purposes of sub-paragraphs (3)(a)(iii) and (6)(a)(iii) unless the request for territorial extension was recorded in the International Register within

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a period of six months beginning with the day after the priority date recorded in the International Register in respect of the international application for protection of the trade mark which is the same as the one in respect of which the request for EU extension was filed.

- (8) 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.
- (9) 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.
- (10) The provisions of paragraph 16 apply in relation to an application under this paragraph as they apply to an application under paragraph 15.]

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