

## 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

- I1** 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>M1</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>F1</sup>IP completion day] and about certain applications for a European Union trade mark made before [<sup>F1</sup>IP completion day].”

- F1** 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

- I2** 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

- M1** 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 [<sup>F2</sup>IP completion day] (an “existing EUTM”) is to be treated on and after [<sup>F2</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 [F<sup>2</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 [F<sup>2</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>F2</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>F2</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>F2</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>F2</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>F2</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>F2</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 [<sup>F2</sup>IP 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 [F<sup>2</sup>IP 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 [F<sup>2</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>2</sup>IP 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 [F<sup>2</sup>IP 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 [F<sup>2</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>2</sup>IP 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>2</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>2</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>2</sup>IP completion day]—

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- (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>2</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>2</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>2</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 [F<sup>2</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 [F<sup>2</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 claim has been filed in accordance with Article 39 or 40; and
  - 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—

- removed from the register under section 43; or
- 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—

- revoked under section 46 with effect from a date prior to—
  - 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
  - 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

- 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—

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

- revoked under section 46 with effect from a date prior to—

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- (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 [<sup>F2</sup>IP completion day]**

**16.—(1)** This paragraph applies where before [<sup>F2</sup>IP completion day] an existing EUTM (or any right in it) is the subject of an assignment (a “relevant assignment”) which immediately before [<sup>F2</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 [<sup>F2</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>2</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>2</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>2</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>2</sup>IP completion day] falls.

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

**18.—(1)** This paragraph applies where immediately before [F<sup>2</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>2</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>2</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>2</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>2</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>2</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>2</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>2</sup>IP completion day] by the proprietor of an existing EUTM to the doing on or after [F<sup>2</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>2</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>2</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 [<sup>F2</sup>IP completion day] if they were instituted but not finally determined before [<sup>F2</sup>IP completion day].

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

**21.—(1)** This paragraph applies where immediately before [<sup>F2</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.

### **[<sup>F3</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)—

**Changes to legislation:** There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 1. (See end of Document for details)

- (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>2</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 subparagraph (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>2</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>2</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>M<sup>2</sup></sup> as it has effect in EU law.

## **PART 3**

### Applications for European Union trade marks which are pending on [F<sup>2</sup>IP 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

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- (b) as at the time immediately before [<sup>r2</sup>IP 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 [<sup>r2</sup>IP 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 [<sup>r2</sup>IP 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 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) 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

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effect from a date specified in the declaration or declared invalid under section 47 and subparagraphs (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 [<sup>F2</sup>IP completion day] a trade mark is removed from the EUTM Register pursuant to the European Union Trade Mark Regulation; and
- (b) on or after [<sup>F2</sup>IP 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 [<sup>F2</sup>IP 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 [<sup>F2</sup>IP 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 [<sup>F2</sup>IP 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>M3</sup> and Council Regulation ([EC No 40/94](#) of 20<sup>th</sup> December 1993 on the Community trade mark <sup>M4</sup>;  
“protected international trade mark (UK)” has the same meaning as in the Trade Marks (International Registration) Order 2008 <sup>M5</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.”.

**F2** 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)**

**F3** 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

**I3** 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

- M2** OJ No. L 154/1, 16.6.2017, p.1.  
**M3** OJ No. L 78, 24.3.2009, p.1.  
**M4** OJ No. L 11, 14.1.1994, p.1.  
**M5** [S.I. 2008/2206](#).

**Changes to legislation:**

There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 1.