

SCHEDULE 4

Regulation 6

Amendments to the 1994 Act to make provision for certain international trade marks protected in the European Union to be treated as registered trade marks and about certain applications for such marks and transformation applications

1. The 1994 Act is amended as follows.

Commencement Information

- I1** Sch. 4 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

2. After section 54 ^{M1} (and before the italic heading before section 55), insert—

“54A Certain international trade marks protected in the European Union to be treated as registered trade marks

54A. Schedule 2B makes provision for international trade marks protected in the European Union (including certain expired marks) to be treated as registered trade marks with effect from [F1IP completion day] and about certain applications for the protection of an international trade mark in the European Union and transformation applications made before [F1IP completion day].”

- F1** Words in Sch. 4 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), 22(a)

Commencement Information

- I2** Sch. 4 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

Marginal Citations

- M1** Section 54 was amended by the Intellectual Property (Unjustified Threats) Act 2017 (c. 14), section 2(4).

3. Before Schedule 3, insert—

“SCHEDULE 2B

Section 54A

INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION

PART 1

Existing international trade marks protected in the European Union

An international trade mark protected in the European Union to be treated as registered under this Act

1.—(1) A trade mark which, immediately before [F2IP completion day], is an international trade mark which is protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation (an “existing IR(EU)”) is to be treated on and after [F2IP completion day] as if an application had been made, and the

Changes to legislation: There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 4. (See end of Document for details)

trade mark had been registered, under this Act in respect of the same goods or services in respect of which the international trade mark is protected in the European Union.

(2) Where the international registration to which an international trade mark is subject is sub-divided to reflect the making of more than one request for territorial extension to the European Union under Article 3ter there is to be deemed for the purposes of sub-paragraph (1) to be a separate trade mark in respect of the goods or services covered by each sub-division of the registration.

(3) Where the international registration to which an international trade mark is subject has been created by virtue of Rule 27(2) (recording of partial change in ownership) (a “separate international registration”), it is irrelevant for the purposes of the application of sub-paragraph (2) to that separate international registration that the requests for territorial extension were made before the separate international registration was created.

(4) 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 (IR).

(5) This Act applies to a comparable trade mark (IR) as it applies to other registered trade marks except as otherwise provided in this Schedule.

(6) A comparable trade mark (IR) is deemed for the purposes of this Act to be registered as of—

- (a) where the protection in the European Union of the existing IR(EU) from which the comparable trade mark (IR) derives resulted from a request for territorial extension under Article 3ter(1) (request mentioned in original application), the date of registration of the existing IR(EU) accorded pursuant to Article 3(4); or
- (b) where the protection in the European Union of the existing IR(EU) from which the comparable trade mark (IR) derives resulted from a request for territorial extension under Article 3ter(2) (subsequent request), the date on which the request was recorded in the International Register,

and that date is deemed for the purposes of this Act to be the date of registration.

(7) Section 40(3) and (4) does not apply to the registration of a comparable trade mark (IR) under this Part.

(8) Section 67(1) applies in relation to the provision of information and the inspection of documents relating to a comparable trade mark (IR) 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).

(9) 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 (IR) (see instead provision made by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018).

(10) For the purposes of this Act—

- (a) the date of filing of an application for registration of a comparable trade mark (IR) is the same date as the deemed date of registration of the comparable trade mark (IR) under sub-paragraph (6);
- (b) references to the date of application for registration of a comparable trade mark (IR) are to the date of filing of the application;
- (c) where an earlier trade mark is a comparable trade mark (IR), references to the completion of the registration procedure for the earlier trade mark are to publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation

in respect of the existing IR(EU) from which the comparable trade mark (IR) derives.

(11) In this Schedule—

- (a) “the International Register” means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol;
- (b) “international registration” means a registration made in the International Register in accordance with the Madrid Protocol;
- (c) “international trade mark” means a trade mark which is the subject of an international registration.

Opt out

2.—(1) Subject to sub-paragraphs (2) and (6), the proprietor of an existing IR(EU) may, at any time on or after [F²IP 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 [F²IP completion day]—

- (a) the comparable trade mark (IR) 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 (IR) (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 (IR); or
- (c) proceedings based on the comparable trade mark (IR) have been initiated by the proprietor or with the proprietor's consent.

(3) An opt out notice must—

- (a) identify the number of the international registration to which the existing IR(EU) to which the notice relates is subject; and
- (b) include the name and address of any person having an interest in the existing IR(EU) which had effect before [F²IP completion day] in the United Kingdom, and in respect of which an entry was recorded in the International 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 (IR) which derives from the existing IR(EU) ceases with effect from [F²IP 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 (IR) have been entered in the register, remove the comparable trade mark (IR) from the register.

(6) Where an international trade mark which is protected in the European Union is treated as being more than one trade mark by virtue of paragraph 1(2)—

Changes to legislation: There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 4. (See end of Document for details)

- (a) an opt out notice must relate to all of the existing IR(EU)s which (by virtue of paragraph 1(2)) derive from the international trade mark;
- (b) the references in sub-paragraph (2) to the comparable trade mark (IR) are to be read as references to any of the comparable trade marks (IR) which derive from the existing IR(EU)s to which the opt out notice relates; and
- (c) the references in sub-paragraph (5) to the comparable trade mark (IR) are to be read as references to all of the comparable trade marks (IR) which derive from the existing IR(EU)s to which the notice relates.

Entries to be made in the register in relation to a comparable trade mark (IR)

3.—(1) The registrar must as soon as reasonably practicable after [F²IP completion day] enter a comparable trade mark (IR) in the register.

(2) The particulars of the goods or services in respect of which the comparable trade mark (IR) is treated as if it had been registered must be taken from the English language version of the entry in the International Register for the corresponding (IR).

(3) Where on or after [F²IP completion day] the entry in the International Register containing the particulars referred to in sub-paragraph (2) is modified to correct an error pursuant to Rule 28, a person having a sufficient interest may apply to the registrar for rectification of the register by the substitution of the English language version of the entry for the corresponding (IR) in the International Register as modified.

(4) In this Schedule, the “corresponding (IR)”, in relation to a comparable trade mark (IR), means the existing IR(EU) from which the comparable trade mark (IR) derives.

Comparable trade mark (IR) which derives from a mark treated as an EU Collective Mark or EU Certification Mark

4.—(1) This paragraph applies where the existing IR(EU) from which a comparable trade mark (IR) derives is dealt with for the purposes of the European Union Trade Mark Regulation as an EU collective mark or an EU certification mark.

(2) The comparable trade mark (IR) 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 (IR) must, following notice from the registrar, file with the registrar regulations governing the use of the international trade mark, submitted pursuant to the European Union Trade Mark Regulation, which had effect immediately before [F²IP 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 (IR) 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 (IR) which expires within six months after [F²IP completion day]

5.—(1) This paragraph applies to the renewal of the registration of a comparable trade mark (IR) which expires within the period beginning with [F²IP 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 (IR) may be renewed at the request of the proprietor before the expiry of the registration.

(3) Where the registration of the comparable trade mark (IR) 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 (IR) 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 (IR) from the register.

(6) Section 43(4) and (6) applies to the registration of a comparable trade mark (IR) which is renewed in accordance with the above provisions.

(7) In sub-paragraph (1), the “relevant period” means the period of six months beginning with the day after that on which [F²IP completion day] falls.

Restoration of a comparable trade mark (IR)

6. Where a comparable trade mark (IR) 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 (IR) 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 (IR), 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 [F²IP 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 (IR); and
- (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [F²IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [F²IP 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 (IR); 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 (IR)

8.—(1) Sections 11A and 46 apply in relation to a comparable trade mark (IR), 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 [F²IP 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 (IR); and
- (b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [F²IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [F²IP 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 (IR); 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 (IR)

9.—(1) Section 47 applies where an earlier trade mark is a comparable trade mark (IR), 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 [F²IP 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 (IR); and
- (b) the references in section 47 to the United Kingdom include the European Union.

(3) Where [F²IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [F²IP 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 (IR); and
- (b) the references in section 47 to the United Kingdom include the European Union.

Reputation of a comparable trade mark (IR)

10.—(1) Sections 5 and 10 apply in relation to a comparable trade mark (IR), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (IR) falls to be considered in respect of any time before [F²IP 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 (IR); 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 (IR) but as if—

- (a) the words in brackets in subsection (3) referring to section 40(3) were replaced with a reference to paragraph 1(6) of this Schedule; and
- (b) the proviso in subsection (3) were omitted.

Effect of disclaimer

12. Where, immediately before [^{F2}IP completion day], the protection in the European Union of an existing IR(EU) is subject to a disclaimer recorded in the International Register, the registration of the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated on and after [^{F2}IP completion day] as subject to the same disclaimer (and section 13 applies accordingly but as if the reference to “publication” in subsection (2) was omitted).

Effect of claim of priority

13.—(1) This paragraph applies where—

- (a) a right of priority was claimed in respect of an international application for protection of a trade mark in accordance with Rule 9(4)(iv);
- (b) immediately before [^{F2}IP completion day] there is an entry in the International Register in respect of that trade mark containing particulars of that claim of priority (a “claim of priority”);
- (c) the trade mark is an existing IR(EU).

(2) Subject to sub-paragraph (4), the proprietor of the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated on and after [^{F2}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 (IR), 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.

(4) Where the protection in the European Union of the existing IR(EU) resulted from a request for territorial extension under Article 3^{ter}(2), the proprietor of the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated on and after [^{F2}IP completion day] as having the same claim of priority only where the request for territorial 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 referred to in sub-paragraph (1)(a).

Effect of seniority claim

14.—(1) This paragraph applies where immediately before [^{F2}IP completion day] an existing IR(EU) 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 (IR) which derives from the existing IR(EU) is to be treated on and after [^{F2}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 (IR) surrenders the senior mark or allows it to lapse (whether wholly or partially), subject to paragraph 15, the proprietor of the comparable trade mark (IR) is deemed to continue to have the same rights

Changes to legislation: There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 4. (See end of Document for details)

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 IR(EU) has a valid claim to seniority of a trade mark where—
- (a) a claim has been filed in accordance with Article 191 or 192 of the European Union Trade Mark Regulation in respect of the international registration to which the existing IR(EU) is subject; and
 - (b) the seniority so claimed has not lapsed in the circumstances referred to in Article 39 of that Regulation (as it applies to international registrations under Article 182 of that Regulation).

Determination of invalidity and liability to revocation in relation to claims of seniority

15.—(1) Where pursuant to paragraph 14 a comparable trade mark (IR) is treated as if it had a valid claim to 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 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—

- (a) revoked under section 46 with effect from a date prior to—
 - (i) where there has been no claim of priority pursuant to Article 35 of the European Union Trade Mark Regulation (as it applies to international registrations under Article 182 of that Regulation) in respect of the existing IR(EU) from which the comparable trade mark (IR) derives, the deemed date of registration of the comparable trade mark (IR); or
 - (ii) where there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the existing IR(EU) from which the comparable trade mark (IR) derives; or
- (b) declared invalid under section 47,

the seniority claimed for the comparable trade mark (IR) is to be treated as if it never had effect.

(4) Where pursuant to paragraph 14 a comparable trade mark (IR) is treated as if it had a valid claim to 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 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—

- (a) revoked under section 46 with effect from a date prior to—
 - (i) where there has been no claim of priority pursuant to Article 35 of the European Union Trade Mark Regulation (as it applies to international registrations under Article 182 of that Regulation) in respect of the existing IR(EU) from which the comparable trade mark (IR) derives, the deemed date of registration of the comparable trade mark (IR); or
 - (ii) where there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the existing IR(EU) from which the comparable trade mark (IR) derives; or
- (b) declared invalid under section 47,

the seniority claimed for the comparable trade mark (IR) is to be treated as if it never had effect.

(7) Where the protection in the European Union of an existing IR(EU) resulted from a request for territorial extension under Article 3ter(2), a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the existing IR(EU) is to be disregarded for the purposes of sub-paragraphs (3)(a)(ii) and (6)(a)(ii) unless the request for territorial 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 request for territorial 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 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

16.—(1) In the case of proceedings on an application under paragraph 15 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 15 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 IR(EU) not registered on [F²IP completion day]

17.—(1) This paragraph applies where before [F²IP completion day] an existing IR(EU) (or any right in it) is the subject of an assignment (a “relevant assignment”) which immediately before [F²IP completion day] is not recorded in the International Register.

Changes to legislation: There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 4. (See end of Document for details)

(2) Section 25 applies in relation to a relevant assignment as if it were a registrable transaction affecting a comparable trade mark (IR), 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 (IR) by virtue of a relevant assignment of the corresponding (IR); or
- (b) the proprietor of the comparable trade mark (IR).

Effect of a licence of an existing IR(EU)

18.—(1) This paragraph applies where immediately before [F²IP completion day] an existing IR(EU) 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 international trade mark; and
- (b) does not expire on [F²IP 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—

- (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 (IR), 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 (IR).

(6) Where immediately before [F²IP completion day] there is an entry in the International 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 [F²IP 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 [F²IP completion day] falls.

Effect of a security interest in an existing IR(EU)

19.—(1) This paragraph applies where immediately before [F²IP completion day] an existing IR(EU) (or any right in or under it) is the subject of a security interest (a “relevant security interest”) which—

- (a) restricts the proprietor's right to dispose in the European Union of the existing IR(EU); and
- (b) does not terminate on [F²IP completion day].

(2) References to the existing IR(EU), or the international registration to which the existing IR(EU) is subject, in any document which grants or refers to the relevant security

interest are to be read as including references to the comparable trade mark (IR) which derives from the existing IR(EU).

(3) Section 25 applies in relation to a relevant security interest as if it were a registrable transaction affecting a comparable trade mark (IR), 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 (IR) by virtue of the relevant security interest; or
- (b) the proprietor of the comparable trade mark (IR).

(5) Where immediately before [F²IP completion day] there is an entry in the International 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 [F²IP completion day].

(6) In sub-paragraph (5)(a), the “relevant period” means the period of twelve months beginning with the day after that on which [F²IP completion day] falls.

Continuity of rights in relation to a comparable trade mark (IR)

20.—(1) References to an existing IR(EU), or the international registration to which an existing IR(EU) is subject, in any document made before [F²IP 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 [F²IP completion day] as including references to the comparable trade mark (IR) or the registration of the comparable trade mark (IR) which derives from the existing IR(EU).

(2) Subject to any agreement to the contrary, a consent granted before [F²IP completion day] by the proprietor of an existing IR(EU) to the doing on or after [F²IP completion day] of an act in the United Kingdom which would otherwise infringe the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated for the purposes of section 9 as a consent to the doing of that act.

Existing IR(EU): pending proceedings

21.—(1) This paragraph applies where on [F²IP 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 [F²IP 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).

Changes to legislation: There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 4. (See end of Document for details)

(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.

(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 [F²IP completion day] if they were instituted but not finally determined before [F²IP completion day].

Existing IR(EU): effect of injunction

22.—(1) This paragraph applies where immediately before [F²IP completion day] an injunction is in force prohibiting the performance of acts in the United Kingdom which infringe or would infringe an existing IR(EU) (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 (IR) to the same extent as in relation to the existing IR(EU) from which the comparable trade mark (IR) derives as if it were an injunction granted by the court.

PART 2

Treatment of international trade marks protected in the European Union which expire during the period of six months ending on [F²IP 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 [F²IP completion day].

Renewal of an expired IR(EU)

24.—(1) Where within the period beginning with [F²IP 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 [F²IP 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 [F²IP 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 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).

PART 3

Applications for the extension of protection of international registrations to the European Union which are pending on [F²IP 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 3^{ter}(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 3^{ter}(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 [F²IP completion day] with the Office of origin in accordance with Article 2(2); and
 - (b) as at the time immediately before [F²IP 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 [F²IP completion day] with the Office of origin or the International Bureau (as the case may be) in accordance with Rule 24(2); and
 - (b) as at the time immediately before [F²IP 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 [F²IP 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 [F²IP 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 [F²IP 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 [F²IP 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 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 [F²IP 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 [F²IP 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 [F²IP 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 [F²IP 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.

(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.

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(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 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 3^{ter}(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 3^{ter}(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 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.

PART 4

Transformation applications which are pending on [F²IP completion day]

Transformation applications

32.—(1) In this Part, references to a “transformation application” are to an application for transformation of an international registration which has been cancelled (a “cancelled international registration”) into an application for registration of a European Union trade mark filed under Article 204 of the European Union Trade Mark Regulation in respect of which the conditions in sub-paragraph (2) are satisfied.

(2) The conditions referred to in sub-paragraph (1) are—

- (a) the transformation application was filed before [F²IP completion day] with the European Union Intellectual Property Office;
- (b) as at the time immediately before [F²IP completion day] the transformation application has neither been granted nor refused by the European Union Intellectual Property Office under the European Union Trade Mark Regulation; and
- (c) the international registration was not cancelled at the request of the Patent Office as Office of origin for the international registration of the trade mark.

(3) In sub-paragraph (2)(b)—

- (a) the reference to the transformation application being “granted” means a European Union trade mark being registered under the European Union Trade Mark Regulation pursuant to the transformation application; and
- (b) the reference to the transformation application being “refused” means the transformation application being subject to the provisions in Article 204(5) of the European Union Trade Mark Regulation.

Application for registration based upon a cancelled international registration

33.—(1) This paragraph applies where—

- (a) a person who has filed a transformation application in respect of a cancelled international registration, or a successor in title of that person, applies for registration under this Act of a trade mark which is the same as the trade mark which was the subject of the cancelled international registration and in respect of some or all of the same goods or services included in the international registration;
- (b) the application for registration under this Act is made within the period beginning with [F²IP completion day] and ending with the end of the relevant period; and
- (c) on or before the date of the transformation application on which the application for registration under this Act is based the trade mark that was the subject of the cancelled international registration—
 - (i) was protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation; or
 - (ii) was the subject of an existing ITM application or an existing request for EU extension which, as at that date, had neither been granted nor refused by the European Union Intellectual Property Office (the references to “granted” and “refused” having the same meaning as given by paragraph 27(4)).

(2) Where this paragraph applies by virtue of sub-paragraph (1)(c)(i), the relevant date for the purposes of establishing which rights take precedence is the earliest of—

(a) where—

(i) the protection in the European Union of the trade mark that was the subject of the cancelled international registration resulted from a request for territorial extension under Article 3*ter*(1), the date of registration accorded to the international registration pursuant to Article 3(4); or

(ii) the protection in the European Union of the trade mark that was the subject of the cancelled international registration resulted from a request for territorial extension under Article 3*ter*(2), the date on which the request was recorded in the International Register; and

(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 request referred to in paragraph (a)(i) or (ii).

(3) Where this paragraph applies by virtue of sub-paragraph (1)(c)(ii), the relevant date for the purposes of establishing which rights take precedence is the earliest of—

(a) the date accorded to the trade mark that was 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); and

(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 request referred to in paragraph (a).

(4) A right of priority claimed pursuant to Article 4 of the Paris Convention in respect of a request for territorial extension to the European Union made under Article 3*ter*(2) is to be disregarded for the purposes of sub-paragraphs (2)(b) and (3)(b) unless the request for 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 request for extension was filed.

(5) The registrability of the trade mark the subject of an application under this Act of the type mentioned in sub-paragraph (1)(a) and made within the period mentioned in sub-paragraph (1)(b) 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) or (3) (as the case may be) and the date of the application for registration of the trade mark under this Act.

(6) Paragraphs 30 and 31 apply in relation to an application for a trade mark under this Act of the type mentioned in sub-paragraph (1)(a) and made within the period mentioned in sub-paragraph (1)(b), as they apply in relation to an application for registration of a trade mark pursuant to Part 3, but as if—

(a) the references to an existing ITM application or an existing request for EU extension and an existing ITM application and an existing request for EU extension had the same meaning as they have in this paragraph; and

(b) the references to an existing ITM application included references to a “protected EU designation”.

(7) In this paragraph—

(a) an “existing ITM application” means 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) which has been filed with the Office of origin in accordance with Article 2(2);

- (b) an “existing request for EU extension” means 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) which has been filed with the Office of origin or the International Bureau (as the case may be) in accordance with Rule 24(2);
- (c) the “relevant period” means the period of nine months beginning with the day after that on which [F2IP completion day] falls;
- (d) a “protected EU designation” means an international registration which prior to its cancellation was protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation.

PART 5

Interpretation

Interpretation

34.—(1) In this Schedule—

“comparable trade mark (IR)” has the meaning given by paragraph 1(4);

“the Common Regulations” means the Common Regulations under the Madrid Agreement concerning the international registration of marks and the Madrid Protocol in force on 1st November 2017 ^{M2};

“corresponding (IR)” has the meaning given by paragraph 3(4);

“existing IR(EU)” has the meaning given by paragraph 1(1);

“expired IR(EU)” has the meaning given by paragraph 23(1);

“international application” has the meaning given by paragraph 27(1)(c);

“the International Register” has the meaning given by paragraph 1(11)(a);

“international registration” has the meaning given by paragraph 1(11)(b);

“international trade mark” has the meaning given by paragraph 1(11)(c);

“Office of origin” has the meaning given by Article 2(2);

“the previous EUTM Regulations” means Council Regulation (EC) No 207/2009 of 26th February 2009 on the European Union trade mark ^{M3} and Council Regulation (EC) No 40/94 of 20th December 1993 on the Community trade mark ^{M4};

“protected international trade mark (UK)” has the same meaning as in the Trade Marks (International Registration) Order 2008 ^{M5};

(2) References in this Schedule to—

(a) an “Article” are to an Article of the Madrid Protocol;

(b) an Article of the European Union Trade mark Regulation include references to any equivalent Article contained in the previous EUTM Regulations;

(c) the European Union Trade Mark Regulation include references to the previous EUTM Regulations;

Changes to legislation: There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 4. (See end of Document for details)

- (d) an international trade mark include references to an international trade mark which is dealt with for the purposes of the European Union Trade Mark Regulation as an EU collective mark or an EU certification mark;
- (e) a “Rule” are to a Rule of the Common Regulations.

(3) In this Schedule, references to a request for territorial extension, in relation to an existing IR(EU) which is the subject of a separate international registration within the meaning of paragraph 1(3), are to the request made before the separate international registration was created.”.

F2 Words in [Sch. 4 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), **22(b)**

Commencement Information

I3 [Sch. 4 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

Marginal Citations

- M2** Available from the World Intellectual Property Organization at www.wipo.int.
- 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 Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 4.