
STATUTORY INSTRUMENTS

2021 No. 1235

**The Trade Marks and International Trade Marks
(Amendment) (EU Exit) Regulations 2021**

Amendments to the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019

4. In Schedule 5, after paragraph 7 insert—

“Qualification to Transitional Provision

8.—(1) Opposition or invalidation proceedings other than excluded proceedings (“relevant proceedings”) shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force subject to the provisions set out in this paragraph.

(2) The provisions in sub-paragraphs (5) and (6) apply to relevant proceedings where the conditions in sub-paragraph (4) are met.

(3) The provisions in sub-paragraph (8) apply to relevant proceedings in the circumstances mentioned in that sub-paragraph.

(4) The conditions mentioned in sub-paragraph (2) are that—

- (a) the relevant proceedings are based, whether wholly or partially, on the ground that there exists an earlier trade mark (“a relevant earlier mark”) which is—
 - (i) an existing EUTM,
 - (ii) an existing EUTM application,
 - (iii) an existing IR(EU), or
 - (iv) an existing ITM application or existing request for EU extension;
- (b) in the case of proceedings referred to in sub-paragraphs (a)(i) and (iii), the comparable trade mark (EU) or comparable trade mark (IR) which derives from the existing EUTM or the existing IR(EU) (as the case may be) is the subject of—
 - (i) a declaration of invalidity under section 47 of the 1994 Act,
 - (ii) a revocation decision under section 46 of the 1994 Act based on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or
 - (iii) an application for a declaration of invalidity or revocation as referred to in sub-paragraphs (i) and (ii);
- (c) in the case of proceedings referred to in sub-paragraphs (a)(ii) and (iv), an application for registration of a trade mark based upon the existing EUTM application pursuant to paragraph 25 of Schedule 2A to the 1994 Act or an application for registration of a trade mark based upon the existing ITM application or the existing request for EU extension pursuant to paragraph 28 or 29 of schedule 2B to the 1994 Act (as the case may be)—

- (i) has been made and the application has neither resulted in the registration of the trade mark nor the registration being refused (“a pending TM application”),
 - (ii) has resulted in the registration of the trade mark in part only,
 - (iii) has resulted in the registration of the trade mark, which registration is the subject of a revocation decision or an application for the same under section 46 of the 1994 Act based on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or
 - (iv) has resulted in the registration of the trade mark which registration is the subject of a declaration of invalidity or an application for the same under section 47 of the 1994 Act.
- (5) In the case of an application for a declaration of invalidity or revocation as referred to in sub-paragraphs (4)(b)(iii) and (4)(c)(iii) and (iv) (“pending proceedings”) or a pending TM application, the registrar may decide that the relevant proceedings be determined only after—
- (a) a final decision has been made in the pending proceedings;
 - (b) the trade mark the subject of the pending TM application has been registered whether in whole or in part or the trade mark has not proceeded to registration for any reason, including as a result of the application not being accepted or it being successfully opposed, withdrawn or abandoned.
- (6) Where—
- (a) the comparable trade mark (EU) or comparable trade mark (IR) referred to in sub-paragraph (4)(b) is the subject of a final decision which declares the registration invalid to any extent or revokes the registration to any extent on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application,
 - (b) the application for registration of a trade mark referred to in sub-paragraph (4)(c) has resulted in registration of the trade mark in part only, or
 - (c) the trade mark referred to in sub-paragraph (4)(c)(iii) or (iv) is the subject of a final decision which revokes the registration to any extent on grounds other than those contained in section 46(1)(a) or (b) of the 1994 Act with effect from a date prior to the date of filing of the application for registration of the trade mark the subject of the relevant proceedings or (where applicable) the date of the priority claimed in respect of that application, or which declares the registration invalid to any extent,
- the registrar may decide that the relevant proceedings shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force taking account of the provisions in sub-paragraph (7).
- (7) A relevant earlier mark on which the relevant proceedings were based may be relied on if or to the same extent that—
- (a) the registration of the comparable trade mark (EU) or comparable trade mark (IR) referred to in sub-paragraph (6)(a) is not declared invalid or the registration is not revoked,

- (b) the application for registration of a trade mark referred to in sub-paragraph (6) (b) is registered, or
 - (c) the trade mark referred to in sub-paragraph (6)(c) is not revoked or declared invalid.
- (8) Where the relevant proceedings are based whether wholly or partially on the ground that there exists a relevant earlier mark which is—
- (a) an existing EUTM or an existing IR(EU) which is the subject of an opt out notice,
 - (b) an existing EUTM application, an existing ITM application or an existing request for EU extension in respect of which—
 - (i) no application has been made for registration of the same trade mark pursuant to paragraph 25 of Schedule 2A to the 1994 Act or paragraph 28 or 29 of Schedule 2B to the 1994 Act (as the case may be) and the period within which such application must be made, as provided in those paragraphs, has expired, or
 - (ii) an application for registration of the same trade mark has been made pursuant to the provisions referred to in sub-paragraph (i) and the trade mark has not proceeded to registration whether in whole or in part for any reason, including as a result of the application not being accepted, or it being successfully opposed, withdrawn or abandoned,

the relevant proceedings shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force except the registrar may decide that the existing EUTM, existing IR(EU), existing EUTM application, existing ITM application or existing request for EU extension (as the case may be) may not be relied upon as an earlier trade mark for the purposes of the relevant proceedings.

- (9) In this paragraph—
- (a) “excluded proceedings” means opposition or invalidation proceedings which have been the subject of a decision on the substantive issues raised in the proceedings prior to the coming into force of this paragraph;
 - (b) “final decision” means a decision which has been determined and there is no possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time);
 - (c) the terms “existing EUTM”, “comparable trade mark (EU)” and “existing EUTM application” have the meanings given respectively by paragraphs 1(1), 1(2) and 24(1) of Schedule 2A to the 1994 Act;
 - (d) the term “opt out notice”, in relation to an existing EUTM, has the meaning given by paragraph 2(1) of Schedule 2A to the 1994 Act and in relation to an existing IR(EU) has the meaning given by paragraph 2(1) of Schedule 2B to the 1994 Act;
 - (e) the terms “existing IR(EU)” and “comparable trade mark (IR)” have the meanings given respectively by paragraphs 1(1) and 1(4) of Schedule 2B to the 1994 Act;
 - (f) the terms “existing ITM application” and “existing request for EU extension” have the meanings given by paragraph 33(7) of Schedule 2B to the 1994 Act.”