

2021 No.

EXITING THE EUROPEAN UNION

TRADE MARKS

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

<i>Sift requirements satisfied</i>	***
<i>Made</i> - - - -	***
<i>Laid before Parliament</i>	***
<i>Coming into force</i>	***

The Secretary of State, in exercise of the powers conferred by section 8(1) of, and paragraph 21(b) of Schedule 7 to, the European Union (Withdrawal) Act 2018(a), makes the following Regulations.

The requirements of paragraph 3(2) of Schedule 7 to the European Union (Withdrawal) Act 2018 (relating to the appropriate procedure for these Regulations) have been satisfied.

Citation and commencement

1. These Regulations may be cited as the Trade Marks and International Trade Marks (Amendment) (EU Exit) Regulations 2021 and come into force on the 22nd day after the day on which they are laid.

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

2. The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019(b) are amended as follows.
3. In Schedule 5, paragraph 7(1), before “Any application” insert “Subject to paragraph 8,”.
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.

(a) 2018 c. 16; Section 8 was amended by the European Union (Withdrawal Agreement) Act 2020 (c. 1), section 27. Paragraph 21(b) of Schedule 7 was amended by the European Union (Withdrawal Agreement) Act 2020, Schedule 5, paragraph 53(2)(b).
(b) S.I. 2019/269, amended by S.I. 2020/1050, 2020/1637, 2020/1661.

(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.”.

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

5. The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019(a) are amended as follows.

6. In regulation 10(2), before “Any application” insert “Subject to regulation 10A,”.

7. After regulation 10 insert—

“Qualification to Transitional Provision

10A—(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 10(1) came into force subject to the provisions set out in this regulation.

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

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

(4) The conditions mentioned in 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

(a) S.I. 2019/638, amended by S.I. 2020/1050.

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 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 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 paragraph (4)(c) has resulted in the registration of the trade mark in part only, or
- (c) the trade mark referred to in 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 10(1) came into force taking account of the provisions in 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 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 paragraph (6)(b) is registered, or
- (c) the trade mark referred to in 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 10(1) 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 regulation—

- (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 regulation;
- (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.”.

Name

Parliamentary Under Secretary of State

Department for Business, Energy and Industrial Strategy

Date

EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations are made in exercise of the powers conferred by section 8(1) of the European Union (Withdrawal) Act 2018 (c.16) (“the EUWA”) in order to address failures of retained EU law

to operate effectively and other deficiencies (in particular under paragraph (e) of section 8(2) of the EUWA) and paragraph 21(b) of Schedule 7 to the EUWA. These Regulations amend the transitional provisions contained in paragraph 7 of Schedule 5 to the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and regulation 10(2) of the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (“the existing regulations”)

The Regulations qualify the application of the transitional provisions in the existing regulations to provide that, in the case of opposition or invalidation proceedings, such proceedings shall be dealt with under the Trade Marks Act 1994 (“the 1994 Act”) as it had effect prior to the coming into force of the amendments made to that Act by the existing regulations, but subject to certain qualifications.

Where the opposition or invalidation proceedings are based on the ground that there exists an earlier trade mark which is an existing EUTM or existing IR(EU) (as those terms are defined in Schedules 2A and 2B to the 1994 Act) and the relevant comparable trade mark has been the subject of a declaration of invalidity under section 47 of the 1994 Act or a revocation decision based on certain grounds under section 46 of the 1994 Act, the registrar may decide that the extent to which reliance may be placed on the earlier trade mark will depend upon the extent to which the relevant comparable mark is not declared invalid or the registration is not revoked (see new paragraphs 8(6)(a) and (7)(a) and new regulations 10A(6)(a) and (7)(a) inserted in the existing regulations by these regulations).

Similar provisions apply where the earlier trade mark is an existing EUTM application, an existing ITM application or existing request for EU extension (as those terms are defined in Schedules 2A and 2B to the 1994 Act) (“a relevant earlier application”) and an application for registration of the same trade mark under the 1994 Act has resulted in the registration of the same trade mark, which trade mark has been the subject of a declaration of invalidity or revocation decision as referred to above (see new paragraphs 8(6)(c) and (7)(c) and new regulations 10A(6)(c) and (7)(c) inserted in the existing regulations by these regulations).

Where the opposition or invalidation proceedings are based on the ground that there exists an earlier trade mark which is a relevant earlier application and an application for registration of the same trade mark under the 1994 Act has resulted in the registration of the trade mark in part only, the registrar may decide that reliance may be placed on the earlier trade mark only to the same extent that the domestic trade mark is registered (see new paragraphs 8(6)(b) and (7)(b) and new regulations 10A(6)(b) and (7)(b) inserted in the existing regulations by these regulations).

The registrar may defer the hearing of the relevant proceedings pending the determination of invalidation or revocation proceedings or the outcome of the application for a domestic trade mark based upon a relevant earlier application (see new paragraph 8(5) and new regulation 10A(5) inserted in the existing regulations by these regulations).

In addition, where relevant proceedings are based on an earlier trade mark which is—

- (a) an existing EUTM or existing IR(EU) which is the subject of an opt out notice (in accordance with paragraph 2 of Schedule 2A and 2B to the 1994 Act),
- (b) a relevant earlier application and no application has been made for registration of a domestic trade mark based upon it under Schedules 2A or 2B to the 1994 Act and the relevant time period for making such application has expired, or
- (c) a relevant earlier application where an application has been made for registration of a domestic trade mark based upon it under Schedules 2A or 2B to the 1994 Act but the application has not resulted in the registration of the trade mark whether in whole or in part,

the registrar may determine that such earlier trade marks may not be relied upon in the invalidation or opposition proceedings (see new paragraph 8(8) and new regulation 10A(8) inserted in the existing regulations by these regulations).

A full impact assessment has not been produced for this instrument as no significant impact on the private, voluntary or public sector is foreseen.

A copy of this instrument and the explanatory memorandum are available from the Intellectual Property Office, Concept House, Cardiff Road, Newport NP20 8QQ. The explanatory memorandum is also available alongside this instrument on the Legislation UK website www.legislation.gov.uk (copies have also been placed in the libraries of both Houses of Parliament).

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