

SCHEDULES

[^{F1}SCHEDULE 2B

INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION

Textual Amendments

- F1** Sch. 2B inserted (31.12.2020) by [The Designs and International Trade Marks \(Amendment etc.\) \(EU Exit\) Regulations 2019](#) (S.I. 2019/638), reg. 1, [Sch. 4 para. 3](#) (with Sch. 5 Pt. 2) (as amended by S.I. 2020/1050, regs. 1(2), [22\(b\)](#)); 2020 c. 1, [Sch. 5 para. 1\(1\)](#)

PART 2

TREATMENT OF INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION WHICH EXPIRE DURING THE PERIOD OF SIX MONTHS ENDING ON IP COMPLETION DAY

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)—

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Paragraph 26. (See end of Document for details)

- (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).]

Changes to legislation:

There are currently no known outstanding effects for the Trade Marks Act 1994, Paragraph 26.