

SCHEDULE 5

Regulation 6

Consequential amendments, repeals, revocations, transitional and saving provisions

Consequential amendments

1. In section 24D(5)(b) of the Registered Designs Act 1949 ^{M1} omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

Commencement Information

I1 Sch. 5 para. 1 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

Marginal Citations

M1 1949 c. 88 as amended by S.I. 2006/1028, schedule 1, paragraph 3.

2. In sections 114(6)(c), 204(6)(c) and 231(6)(c) of the Copyright, Designs and Patents Act 1988 ^{M2} omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

Commencement Information

I2 Sch. 5 para. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

Marginal Citations

M2 1988 c. 48.

3. In regulation 5(7)(b) of the Olympics Association Right (Infringement Proceedings) Regulations 1995 ^{M3} omit “(including that section as applied by regulation 4 of the Community Trade Marks Regulations 2006)”.

Commencement Information

I3 Sch. 5 para. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

Marginal Citations

M3 S.I. 1995/3325 as amended by S.I. 2010/2477, regulation 6.

4. In regulation 1C(5)(d) of the Community Design Regulations 2005 ^{M4} omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

Commencement Information

I4 Sch. 5 para. 4 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1(1)

Changes to legislation: There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 5. (See end of Document for details)

Marginal Citations

M4 S.I. 2005/2339 as amended by S.I. 2006/1028, **schedule 3**, paragraph 9.

5. In regulation 4(8)(b) of the Olympics, Paralympics and London Olympics Association Rights (Infringement Proceedings) Regulations 2010 ^{M5} omit “(including that section as applied by regulation 4 of the Community Trade Marks Regulations 2006)”.

Commencement Information

I5 Sch. 5 para. 5 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1(1)

Marginal Citations

M5 S.I. 2010/2477.

Repeals and revocations

6. The enactments listed in column 1 of the Table are repealed or revoked to the extent specified in column 2.

<i>Enactment</i>	<i>Extent of repeal or revocation</i>
The Legal Services Act 2007 M6	[^{F1} Schedule 21], paragraph 110
The Intellectual Property (Unjustified Threats) Act 2017 M7	Section 3
Community Trade Mark (Amendment) Regulations 2008 M8	In its entirety
The European Union Trade Mark Regulations 2016 M9	Regulations 6 to 12
The Trade Marks Regulations 2018 M10	Regulations 7(2), 8(6), 23(7) and 27
Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14th June 2017 on the European Union trade mark M11	In its entirety
Commission Implementing Regulation (EU) 2018/626 of 5th March 2018 M12	In its entirety
Commission Delegated Regulation (EU) 2018/625 of 5th March 2018 M13	In its entirety

Textual Amendments

- F1** Words in [Sch. 5 para. 6](#) Table 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), [12](#)

Commencement Information

- I6** Sch. 5 para. 6 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

Marginal Citations

- M6** [2007 c. 29](#).
M7 [2017 c. 14](#).
M8 [S.I. 2008/1959](#).
M9 [S.I. 2016/299](#).
M10 [S.I. 2018/825](#).
M11 O.J. No. L 154/1, 16.6.2017, p.1.
M12 O.J. No. L 104/1, 24.4.2018, p.37.
M13 O.J. No. L 104/1, 24.4.2018, p.1.

Transitional and Saving Provisions

7.—(1) [^{F2}Subject to paragraph 8,] any application or proceeding under the 1994 Act which was made or commenced before the coming into force of these Regulations shall be dealt with under the 1994 Act as it had effect before regulation 4 came into force.

[^{F3}(1A) Sub-paragraph 1 does not apply to an application to register a trade mark that was pending immediately before the coming into force of these Regulations referred to in—

- (a) Article 14a of Regulation (EU) No 1151/2012 of the European Parliament and of the Council on quality schemes for agricultural products and foodstuffs, or that Article as applied by Article 14d of that Regulation;
- (b) Article 102a of Regulation (EU) No 1308/2013 of the European Parliament and of the Council establishing a common organisation of the markets in agricultural products, or that Article as applied by Article 102d of that Regulation;
- (c) Article 19a of Regulation (EU) No 251/2014 of the European Parliament and of the Council on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products, or that Article as applied by Article 19d of that Regulation;
- (d) Article 32a of Commission Delegated Regulation (EU) 2019/33 supplementing Regulation (EU) No 1308/2013 of the European Parliament and of the Council as regards applications for protection of designations of origin, geographical indications and traditional terms in the wine sector, the objection procedure, restrictions of use, amendments to product specifications, cancellation of protection, and labelling and presentation, or that Article as applied by Article 32d of that Regulation;]
- [^{F4}(e) Article 36a of Regulation (EU) 2019/787 of the European Parliament and of the Council on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages, or that Article as applied by Article 36d of that Regulation.]

Changes to legislation: There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 5. (See end of Document for details)

(2) The repeal of section 52 of the 1994 Act (Power to make provision in connection with European Union Trade Mark Regulation) does not affect any proceedings which are pending on the coming into force of these Regulations before the EU trade mark courts designated by regulation 12 of the Community Trade Mark Regulations 2006^{M14} insofar as such proceedings relate to the application and enforcement of a European Union trade mark in the United Kingdom.

Textual Amendments

- F2** Words in Sch. 5 para. 7(1) inserted (26.11.2021) by [The Trade Marks and International Trade Marks \(Amendment\) \(EU Exit\) Regulations 2021 \(S.I. 2021/1235\)](#), regs. 1, **3**
- F3** Sch. 5 para. 7(1A) inserted (31.12.2020 immediately before IP completion day) by [The Agricultural Products, Food and Drink \(Amendment etc.\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1637\)](#), regs. 1(6), **3** (as amended by [S.I. 2020/1661](#), regs. 1(2)(b), **16(2)(a)-(d)**)
- F4** Sch. 5 para. 7(1A)(e) inserted (31.12.2020 immediately before IP completion day) by [The Agricultural Products, Food and Drink \(Amendment\) \(EU Exit\) Regulations 2020 \(S.I. 2020/1661\)](#), regs. 1(2)(b), **12**

Commencement Information

- I7** Sch. 5 para. 7 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1](#), [Sch. 5 para. 1\(1\)](#)), see reg. 1(1)

Marginal Citations

- M14** [S.I. 2006/1027](#) as amended by, [S.I. 2008/1959](#), [2011/1043](#), [2016/299](#) and by the [Intellectual Property \(Unjustified Threats\) Act 2017 \(c.14\)](#), [section 3](#).

[^{F5}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—

Changes to legislation: There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 5. (See end of Document for details)

- (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.]

Textual Amendments

- F5** Sch. 5 para. 8 inserted (26.11.2021) by [The Trade Marks and International Trade Marks \(Amendment\) \(EU Exit\) Regulations 2021 \(S.I. 2021/1235\)](#), regs. 1, 4

Changes to legislation:

There are currently no known outstanding effects for the The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 5.