

SCHEDULE 3

Regulation (EU) No 1308/2013 of the European Parliament and of the Council: new provisions

PART 2

New Articles 102a and 102b

“Article 102a

Transitional provisions: relationship with trade marks

1. Unless paragraph 4 applies, an application to register a trade mark that was pending immediately before IP completion day or filed during the relevant period must be refused where, if the trade mark is registered, the use of the trade mark will contravene Article 103(2) in relation to a category A designation of origin or geographical indication.

2. Unless paragraph 4 applies, an application to register a trade mark that was pending immediately before IP completion day or filed during the relevant period must be refused where:

- (a) if the trade mark is registered, the use of the trade mark will contravene Article 103(2) in relation to a category B designation of origin or geographical indication, and
- (b) after the application for the trade mark is accepted but before the trade mark is registered:

(i) in the case of a type 3B designation of origin or geographical indication:

(aa) the international agreement referred to in paragraph (c) of column 2 of row 3 of the Types Table enters into force, and

(bb) the entry into force of the international agreement is brought to the attention of the registrar before the trade mark is registered;

(ii) in the case of any other category B designation of origin or geographical indication:

(aa) the Secretary of State publishes an Article 99 approval notice relating to the designation of origin or geographical indication, and

(bb) the Article 99 approval notice is brought to the attention of the registrar before the trade mark is registered.

3. Where an application for a declaration of invalidity is made under the TMA (as applied by Article 102b(1) and modified by Article 102b(2)) in relation to the registration of a trade mark, the registration of the trade mark must be declared to be invalid, unless paragraph 4 applies, if:

- (a) the application to register the trade mark was pending immediately before IP completion day or filed during the relevant period,
- (b) the use of the trade mark contravenes, or will, if used, contravene, Article 103(2) in relation to a category B designation of origin or geographical indication, and
- (c) in the case of a type 2B, 4B, 5B or 6B designation of origin or geographical indication, the Secretary of State publishes an Article 99 approval notice relating to the designation of origin or geographical indication on or after the time at which the trade mark application is accepted.

4. This paragraph applies where a column 5 date applies in relation to a category A or B designation of origin or geographical indication and, taking account of any priority claimed in respect of an application to register a trade mark referred to in paragraph 1, 2 or 3(a) (as relevant) and on the basis of the information available to the registrar, it appears to the registrar that the date of filing of the trade mark application is earlier than the column 5 date that applies to the relevant designation of origin or geographical indication.

5. As regards paragraphs 1 and 2, a column 5 date does not apply in relation to a type 3A, 4A or 5A designation of origin or geographical indication where the EUIA referred to in paragraph (b) in column 2 of the row of the Types Table relating to the designation of origin or geographical indication provides that an application for a trade mark must be refused, regardless of when that application is filed, if the trade mark, if registered, will contravene a provision in the EUIA providing for the protection of the use of the designation of origin or geographical indication.

6. As regards paragraph 3, a column 5 date does not apply in relation to a type 3B, 4B or 5B designation of origin or geographical indication where the EUIA referred to in paragraph (b) in column 2 of the row of the Types Table relating to the designation of origin or geographical indication provides that the registration of a trade mark must be invalidated if, regardless of when the application that resulted in the registration of the trade mark is filed, the use of the trade mark contravenes a provision in the EUIA providing for the protection of the use of the designation of origin or geographical indication.

7. Where a designation of origin or geographical indication falls within the definition of more than one type of designation of origin or geographical indication in Article 93a, the column 5 date to be taken into account for the purpose of paragraph 4 is the earliest of the column 5 dates for the relevant types of designation of origin or geographical indication.

8. In a case of a category A or B designation of origin or geographical indication that is not on Great Britain's PDOs and PGIs Register at the time an assessment is carried out under paragraph 1, 2 or 3, the designation of origin or geographical indication is to be treated, for the purpose of the assessment, as being a protected designation of origin or protected geographical indication, as relevant, in determining whether the use of the trade mark will contravene Article 103(2) in relation to that designation of origin or geographical indication.

9. A trade mark that could be used in the United Kingdom under Article 102(2) of EU Regulation 1308/2013 immediately before IP completion day may continue to be used in Great Britain on and after IP completion day:

- (a) notwithstanding that the use of the trade mark would contravene Article 103(2) of Regulation (EU) No 1308/2013 in Great Britain in relation to a designation of origin or geographical indication registered by the Secretary of State under this Regulation;
- (b) provided that no grounds for the invalidation or revocation of the trade mark exist in, or under, the TMA.

10. Nothing in this Regulation prevents a trade mark that could be renewed in the United Kingdom pursuant to Article 102(2) of EU Regulation 1308/2013 immediately before IP completion day from being renewed after IP completion day:

- (a) notwithstanding that the use of the renewed trade mark would contravene Article 103(2) in Great Britain in relation to a designation of origin or geographical indication registered by the Secretary of State under this Regulation;
- (b) provided that no grounds for the invalidation or revocation of the trade mark exist in, or under, the TMA.

11. Where paragraph 9 or 10 applies to the use or renewal of a trade mark, this does not affect the use of:

- (a) a designation of origin or geographical indication entered on Great Britain's PDOs and PGIs Register following a decision by the Secretary of State to approve an application made under Article 95(1A) or Article 3 of Commission Implementing Regulation (EU) 2019/34 laying down rules for the application of 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, amendments to product specifications, the register of protected names, cancellation of protection and use of symbols, and of Regulation (EU) No 1306/2013 of the European Parliament and of the Council as regards an appropriate system of checks;
- (b) a designation of origin or geographical indication entered on Great Britain's PDOs and PGIs Register by the Secretary of State following a decision of the Secretary of State to approve an application to which Article 97a applies;
- (c) a designation of origin or geographical indication entered on Great Britain's PDOs and PGIs Register by the Secretary of State pursuant to the second sentence of Article 104;
- (d) an established protected designation of origin or an established protected geographical indication entered on Great Britain's PDOs and PGIs Register by the Secretary of State pursuant to Article 107(1).

12. In this Article:

- (a) 'an application to register a trade mark' means an application to register a trade mark filed under the TMA;
- (b) 'a category A designation of origin or geographical indication' means a type 1, 2A, 3A, 4A, 5A or 6A designation of origin or geographical indication;
- (c) 'a category B designation of origin or geographical indication' means a type 2B, 3B, 4B, 5B or 6B designation of origin or geographical indication;
- (d) 'column 5 date', in relation to a designation of origin or geographical indication that is a category A or B designation of origin or geographical indication, means the date specified, or provided for, in column 5 of the Types Table in the row relating to the relevant type of designation of origin or geographical indication;
- (e) 'date of filing':
 - (i) in the case of an EUTM-based trade mark application, means the filing date referred to in paragraph 25(2)(a)(i) of Schedule 2A to the TMA for the existing EUTM application;
 - (ii) in the case of an ITM-based trade mark application, means:
 - (aa) in the case of an application for the registration of a trade mark to which paragraph 28 of Schedule 2B to the TMA applies, the date referred to in paragraph 28(2)(a) of that Schedule for the existing ITM application or existing request for EU extension (as the case may be);
 - (bb) in the case of an application for the registration of a trade mark to which paragraph 29 of Schedule 2B to the TMA applies, the date referred to in paragraph 29(2)(a) of that Schedule for the existing ITM application or existing request for EU extension (as the case may be);
 - (iii) in any other case, has the meaning given by section 33 of the TMA;
- (f) 'established protected designation of origin' has the meaning given by Article 107(2)(a);

- (g) ‘established protected geographical indication’ has the meaning given by Article 107(2)(b);
- (h) ‘EUTM-based trade mark application’ means an application to register a trade mark to which paragraph 25(1) of Schedule 2A to the TMA applies that is made within the period specified in paragraph 25(2) of that Schedule;
- (i) ‘existing EUTM application’ has the same meaning as in paragraph 24 of Schedule 2A to the TMA;
- (j) ‘existing ITM application’ has the same meaning as in paragraph 27(1)(a) of Schedule 2B to the TMA;
- (k) ‘existing request for EU extension’ has the same meaning as in paragraph 27(1)(b) of Schedule 2B to the TMA;
- (l) ‘ITM-based trade mark application’ means an application to register a trade mark to which paragraph 28(1) or 29(1) of Schedule 2B to the TMA applies that is made within the period specified in paragraph 28(1)(c) or 29(1)(c) (as the case may be) of that Schedule;
- (m) ‘the registrar’ has the meaning given by section 62 of the TMA.

13. Any reference in this Article to:

- (a) ‘priority claimed in respect of an application’:
 - (i) in the case of an EUTM-based trade mark application, means any priority claimed in respect of the existing EUTM application referred to in paragraph 25(2)(a)(ii) of Schedule 2A to the TMA;
 - (ii) in the case of an ITM-based trade mark application, means any priority claimed in respect of the existing ITM application or the existing request for EU extension referred to in paragraph 28(2)(b) or 29(2)(b) (as the case may be) of Schedule 2B to the TMA;
 - (iii) in any other case, means any priority claimed in respect of the application pursuant to section 35 of the TMA;
- (b) an application to register a trade mark that was ‘pending immediately before IP completion day’ is a reference to an application that was neither refused, nor resulted in the registration of the trade mark that is the subject of the application, before IP completion day;
- (c) a trade mark includes a reference to:
 - (i) a collective mark as defined in section 49(1) of the TMA;
 - (ii) a certification mark as defined in section 50(1) of the TMA.

Article 102b

Application and modification of trade mark provisions

1. For the purpose of Article 102a, the following provisions of the TMA apply, with the modifications, in the case of sections 47(3) and (5), 74(1), 76(1) and 77(1), specified in paragraph 2:

- (a) subsections (3) to (5) and (6) of section 47 (invalidation of trade marks) in relation to an application to invalidate a trade mark referred to in Article 102a(3);
- (b) section 72 (registration to be prima face evidence of validity);
- (c) section 73 (certificate of validity of contested application);

- (d) section 74 (registrar's appearance in proceedings involving the register of trade marks);
- (e) section 75 (definition of 'the court');
- (f) section 76 (appeals) except for subsection (5);
- (g) section 77(1) (persons appointed to hear and determine appeals).

2. The modifications are:

- (a) section 47 applies as if:
 - (i) in subsection (3), in the words before paragraph (a), after 'invalidity' there were inserted 'made under this section, as applied by Article 102b(1) of Regulation (EU) No 1308/2013 of the European Parliament and of the Council establishing a common organisation of the markets in agricultural products,';
 - (ii) in subsection (5), for 'grounds of invalidity exist' there were substituted 'ground for invalidity specified in Article 102a(3) of Regulation (EU) No 1308/2013 of the European Parliament and of the Council exists';
- (b) section 74(1) applies as if, for the words from 'for' to 'the registrar' there were substituted 'for a declaration of the invalidity of the registration of a trade mark, the registrar';
- (c) section 76(1) applies as if:
 - (i) in the first paragraph, for the words from 'under' to the end there were substituted 'made under Article 102a(3) of Regulation (EU) No 1308/2013 of the European Parliament and of the Council';
 - (ii) the second paragraph were omitted;
- (d) section 77(1) applies as if, at the end there were inserted 'as applied by Article 102b(1) of Regulation (EU) No 1308/2013 of the European Parliament and of the Council'.

3. In the case of the following proceedings, the rules made under section 68 or 69 of the TMA apply to those proceedings as they apply to proceedings involving an application of the type referred to in section 74(1)(b) of the TMA:

- (a) an application to invalidate a trade mark referred to in Article 102a(3);
- (b) an appeal to an appointed person from a decision of the registrar in relation to an application referred to in paragraph (a)."