

*Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, PART 1. (See end of Document for details)*

## SCHEDULES

### [<sup>F1</sup>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 1

##### EXISTING INTERNATIONAL TRADE MARKS PROTECTED IN THE EUROPEAN UNION

*An international trade mark protected in the European Union to be treated as registered under this Act*

- 1
- (1) A trade mark which, immediately before IP completion day, is an international trade mark which is protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation (an “existing IR(EU)”) is to be treated on and after IP completion day as if an application had been made, and the trade mark had been registered, under this Act in respect of the same goods or services in respect of which the international trade mark is protected in the European Union.
  - (2) Where the international registration to which an international trade mark is subject is sub-divided to reflect the making of more than one request for territorial extension to the European Union under Article 3ter there is to be deemed for the purposes of sub-paragraph (1) to be a separate trade mark in respect of the goods or services covered by each sub-division of the registration.
  - (3) Where the international registration to which an international trade mark is subject has been created by virtue of Rule 27(2) (recording of partial change in ownership) (a “separate international registration”), it is irrelevant for the purposes of the application of sub-paragraph (2) to that separate international registration that the requests for territorial extension were made before the separate international registration was created.
  - (4) A registered trade mark which comes into being by virtue of sub-paragraph (1) is referred to in this Act as a comparable trade mark (IR).
  - (5) This Act applies to a comparable trade mark (IR) as it applies to other registered trade marks except as otherwise provided in this Schedule.
  - (6) A comparable trade mark (IR) is deemed for the purposes of this Act to be registered as of—

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- (a) where the protection in the European Union of the existing IR(EU) from which the comparable trade mark (IR) derives resulted from a request for territorial extension under Article 3ter(1) (request mentioned in original application), the date of registration of the existing IR(EU) accorded pursuant to Article 3(4); or
  - (b) where the protection in the European Union of the existing IR(EU) from which the comparable trade mark (IR) derives resulted from a request for territorial extension under Article 3ter(2) (subsequent request), the date on which the request was recorded in the International Register,
- and that date is deemed for the purposes of this Act to be the date of registration.
- (7) Section 40(3) and (4) does not apply to the registration of a comparable trade mark (IR) under this Part.
  - (8) Section 67(1) applies in relation to the provision of information and the inspection of documents relating to a comparable trade mark (IR) notwithstanding that there will have been no application under this Act for the registration of the trade mark (and so no publication of an application).
  - (9) Nothing in this Act authorises the imposition of a fee, or the making of provision by rules or regulations which authorises the imposition of a fee, in respect of any matter relating to a comparable trade mark (IR) (see instead provision made by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018).
  - (10) For the purposes of this Act—
    - (a) the date of filing of an application for registration of a comparable trade mark (IR) is the same date as the deemed date of registration of the comparable trade mark (IR) under sub-paragraph (6);
    - (b) references to the date of application for registration of a comparable trade mark (IR) are to the date of filing of the application;
    - (c) where an earlier trade mark is a comparable trade mark (IR), references to the completion of the registration procedure for the earlier trade mark are to publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation in respect of the existing IR(EU) from which the comparable trade mark (IR) derives.
  - (11) In this Schedule—
    - (a) “the International Register” means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol;
    - (b) “international registration” means a registration made in the International Register in accordance with the Madrid Protocol;
    - (c) “international trade mark” means a trade mark which is the subject of an international registration.

### *Opt out*

- 2 (1) Subject to sub-paragraphs (2) and (6), the proprietor of an existing IR(EU) may, at any time on or after IP completion day, serve notice on the registrar that the trade mark is not to be treated as if the trade mark had been registered under this Act (an “opt out notice”).
- (2) An opt out notice may not be served where on or after IP completion day—

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- (a) the comparable trade mark (IR) has been put to use in the United Kingdom by the proprietor or with the proprietor's consent (which use includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes);
  - (b) the comparable trade mark (IR) (or any right in or under it) has been made the subject of an assignment, licence, security interest or any other agreement or document except for an assent by personal representatives in relation to the comparable trade mark (IR); or
  - (c) proceedings based on the comparable trade mark (IR) have been initiated by the proprietor or with the proprietor's consent.
- (3) An opt out notice must—
- (a) identify the number of the international registration to which the existing IR(EU) to which the notice relates is subject; and
  - (b) include the name and address of any person having an interest in the existing IR(EU) which had effect before IP completion day in the United Kingdom, and in respect of which an entry was recorded in the International Register.
- (4) An opt out notice is of no effect unless the proprietor in that notice certifies that any such person—
- (a) has been given not less than three months' notice of the proprietor's intention to serve an opt out notice; or
  - (b) is not affected or if affected, consents to the opt out.
- (5) Where a notice has been served in accordance with this paragraph—
- (a) the comparable trade mark (IR) which derives from the existing IR(EU) ceases with effect from IP completion day to be treated as if it had been registered under this Act; and
  - (b) the registrar must, where particulars of the comparable trade mark (IR) have been entered in the register, remove the comparable trade mark (IR) from the register.
- (6) Where an international trade mark which is protected in the European Union is treated as being more than one trade mark by virtue of paragraph 1(2)—
- (a) an opt out notice must relate to all of the existing IR(EU)s which (by virtue of paragraph 1(2)) derive from the international trade mark;
  - (b) the references in sub-paragraph (2) to the comparable trade mark (IR) are to be read as references to any of the comparable trade marks (IR) which derive from the existing IR(EU)s to which the opt out notice relates; and
  - (c) the references in sub-paragraph (5) to the comparable trade mark (IR) are to be read as references to all of the comparable trade marks (IR) which derive from the existing IR(EU)s to which the notice relates.

*Entries to be made in the register in relation to a comparable trade mark (IR)*

- 3
- (1) The registrar must as soon as reasonably practicable after IP completion day enter a comparable trade mark (IR) in the register.
  - (2) The particulars of the goods or services in respect of which the comparable trade mark (IR) is treated as if it had been registered must be taken from the English language version of the entry in the International Register for the corresponding (IR).

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- (3) Where on or after IP completion day the entry in the International Register containing the particulars referred to in sub-paragraph (2) is modified to correct an error pursuant to Rule 28, a person having a sufficient interest may apply to the registrar for rectification of the register by the substitution of the English language version of the entry for the corresponding (IR) in the International Register as modified.
- (4) In this Schedule, the “corresponding (IR)”, in relation to a comparable trade mark (IR), means the existing IR(EU) from which the comparable trade mark (IR) derives.

*Comparable trade mark (IR) which derives from a mark treated as an EU Collective Mark or EU Certification Mark*

- 4 (1) This paragraph applies where the existing IR(EU) from which a comparable trade mark (IR) derives is dealt with for the purposes of the European Union Trade Mark Regulation as an EU collective mark or an EU certification mark.
- (2) The comparable trade mark (IR) is to be treated as either a collective mark or a certification mark, as the case may be.
- (3) The proprietor of the comparable trade mark (IR) must, following notice from the registrar, file with the registrar regulations governing the use of the international trade mark, submitted pursuant to the European Union Trade Mark Regulation, which had effect immediately before IP completion day.
- (4) Where the regulations referred to in sub-paragraph (3) are in a language other than English they must be filed together with a translation into English verified to the satisfaction of the registrar as corresponding to the original text.
- (5) Paragraph 9 of Schedule 1 and paragraph 10 of Schedule 2 apply in relation to the translation referred to in sub-paragraph (4) as they apply in relation to the regulations referred to in sub-paragraph (3).
- (6) Where the regulations or any translation are not filed in accordance with the above provisions—
  - (a) the registrar must remove the comparable trade mark (IR) from the register; and
  - (b) the rights of the proprietor shall be deemed to have ceased as from the date of removal.

*Renewal of a comparable trade mark (IR) which expires within six months after IP completion day*

- 5 (1) This paragraph applies to the renewal of the registration of a comparable trade mark (IR) which expires within the period beginning with IP completion day and ending with the end of the relevant period (and accordingly section 43(1) to (3A) does not apply).
- (2) The registration of the comparable trade mark (IR) may be renewed at the request of the proprietor before the expiry of the registration.
- (3) Where the registration of the comparable trade mark (IR) is not renewed in accordance with sub-paragraph (2)—

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- (a) on, or as soon as reasonably practicable after, the expiry of the registration, the registrar must notify the proprietor that the registration has expired and of the manner in which the registration may be renewed; and
  - (b) a request for renewal must be made within the period of six months beginning with the date of the notice.
- (4) 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.
- (5) If the registration is not renewed in accordance with the above provisions, the registrar must remove the comparable trade mark (IR) from the register.
- (6) Section 43(4) and (6) applies to the registration of a comparable trade mark (IR) which is renewed in accordance with the above provisions.
- (7) In sub-paragraph (1), the “relevant period” means the period of six months beginning with the day after that on which IP completion day falls.

#### *Restoration of a comparable trade mark (IR)*

- 6 Where a comparable trade mark (IR) is removed from the register pursuant to paragraph 5, 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.

#### *Raising of relative grounds in opposition proceedings in case of non-use*

- 7 (1) Section 6A applies where an earlier trade mark is a comparable trade mark (IR), subject to the modifications set out below.
- (2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—
- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding (IR); and
  - (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
- (3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—
- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding (IR); and
  - (b) the references in section 6A to the United Kingdom include the European Union.

#### *Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (IR)*

- 8 (1) Sections 11A and 46 apply in relation to a comparable trade mark (IR), subject to the modifications set out below.
- (2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the “five-year period”) has expired before IP completion day—

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- (a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding (IR); and
  - (b) the references in sections 11A and 46 to the United Kingdom include the European Union.
- (3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—
- (a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding (IR); and
  - (b) the references in sections 11A and 46 to the United Kingdom include the European Union.

*Grounds for invalidity of registration of a trade mark based upon an earlier comparable trade mark (IR)*

- 9 (1) Section 47 applies where an earlier trade mark is a comparable trade mark (IR), subject to the modifications set out below.
- (2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the “five-year period”) has expired before IP completion day—
- (a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding (IR); and
  - (b) the references in section 47 to the United Kingdom include the European Union.
- (3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—
- (a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding (IR); and
  - (b) the references in section 47 to the United Kingdom include the European Union.

*Reputation of a comparable trade mark (IR)*

- 10 (1) Sections 5 and 10 apply in relation to a comparable trade mark (IR), subject to the modifications set out below.
- (2) Where the reputation of a comparable trade mark (IR) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—
- (a) the reputation of the mark are to be treated as references to the reputation of the corresponding (IR); and
  - (b) the United Kingdom include the European Union.

*Rights conferred by registered trade mark*

- 11 Section 9 applies in relation to a comparable trade mark (IR) but as if—
- (a) the words in brackets in subsection (3) referring to section 40(3) were replaced with a reference to paragraph 1(6) of this Schedule; and
  - (b) the proviso in subsection (3) were omitted.

### *Effect of disclaimer*

- 12 Where, immediately before IP completion day, the protection in the European Union of an existing IR(EU) is subject to a disclaimer recorded in the International Register, the registration of the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated on and after IP completion day as subject to the same disclaimer (and section 13 applies accordingly but as if the reference to “publication” in subsection (2) was omitted).

### *Effect of claim of priority*

- 13 (1) This paragraph applies where—
- (a) a right of priority was claimed in respect of an international application for protection of a trade mark in accordance with Rule 9(4)(iv);
  - (b) immediately before IP completion day there is an entry in the International Register in respect of that trade mark containing particulars of that claim of priority (a “claim of priority”);
  - (c) the trade mark is an existing IR(EU).
- (2) Subject to sub-paragraph (4), the proprietor of the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated on and after IP completion day as having the same claim of priority.
- (3) Accordingly, the relevant date for the purposes of establishing, in relation to the comparable trade mark (IR), which rights take precedence is the date of filing of the application for a trade mark in a Convention country which formed the basis for the claim of priority.
- (4) Where the protection in the European Union of the existing IR(EU) resulted from a request for territorial extension under Article 3ter(2), the proprietor of the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated on and after IP completion day as having the same claim of priority only where the request for territorial extension was recorded in the International Register within a period of six months beginning with the day after the priority date recorded in the International Register in respect of the international application referred to in sub-paragraph (1)(a).

### *Effect of seniority claim*

- 14 (1) This paragraph applies where immediately before IP completion day an existing IR(EU) has a valid claim to seniority of a trade mark which trade mark (the “senior mark”) is a registered trade mark or a protected international trade mark (UK).
- (2) The comparable trade mark (IR) which derives from the existing IR(EU) is to be treated on and after IP completion day as if it had a valid claim to seniority of the senior mark.
- (3) Accordingly, where the proprietor of the comparable trade mark (IR) surrenders the senior mark or allows it to lapse (whether wholly or partially), subject to paragraph 15, the proprietor of the comparable trade mark (IR) is deemed to continue to have the same rights as the proprietor would have had if the senior mark had continued to be registered in respect of all the goods or services for which it was registered prior to the surrender or lapse.
- (4) An existing IR(EU) has a valid claim to seniority of a trade mark where—

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- (a) a claim has been filed in accordance with Article 191 or 192 of the European Union Trade Mark Regulation in respect of the international registration to which the existing IR(EU) is subject; and
- (b) the seniority so claimed has not lapsed in the circumstances referred to in Article 39 of that Regulation (as it applies to international registrations under Article 182 of that Regulation).

*Determination of invalidity and liability to revocation in relation to claims of seniority*

- 15 (1) Where pursuant to paragraph 14 a comparable trade mark (IR) is treated as if it had a valid claim to seniority of a registered trade mark which has been—
- (a) removed from the register under section 43; or
  - (b) surrendered under section 45,

any person may apply to the registrar or to the court for the declaration set out in sub-paragraph (2).

- (2) The declaration is that if the trade mark had not been so removed or surrendered, the registration of the trade mark would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47.
- (3) Where the declaration is that had the trade mark not been so removed or surrendered the registration of it would have been liable to be—
- (a) revoked under section 46 with effect from a date prior to—
    - (i) where there has been no claim of priority pursuant to Article 35 of the European Union Trade Mark Regulation (as it applies to international registrations under Article 182 of that Regulation) in respect of the existing IR(EU) from which the comparable trade mark (IR) derives, the deemed date of registration of the comparable trade mark (IR); or
    - (ii) where there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the existing IR(EU) from which the comparable trade mark (IR) derives; or
  - (b) declared invalid under section 47,

the seniority claimed for the comparable trade mark (IR) is to be treated as if it never had effect.

- (4) Where pursuant to paragraph 14 a comparable trade mark (IR) is treated as if it had a valid claim to seniority of a protected international trade mark (UK) which has been—
- (a) removed from the International Register; or
  - (b) surrendered under the Madrid Protocol,
- any person may apply to the registrar or to the court for the declaration set out in sub-paragraph (5).
- (5) The declaration is that, if the trade mark had not been so removed or surrendered, the protection of the mark in the United Kingdom would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47.



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- (6) Where the declaration is that had the trade mark not been so removed or surrendered the protection of the mark in the United Kingdom would have been liable to be—
- (a) revoked under section 46 with effect from a date prior to—
    - (i) where there has been no claim of priority pursuant to Article 35 of the European Union Trade Mark Regulation (as it applies to international registrations under Article 182 of that Regulation) in respect of the existing IR(EU) from which the comparable trade mark (IR) derives, the deemed date of registration of the comparable trade mark (IR); or
    - (ii) where there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the existing IR(EU) from which the comparable trade mark (IR) derives; or
  - (b) declared invalid under section 47,
- the seniority claimed for the comparable trade mark (IR) is to be treated as if it never had effect.
- (7) Where the protection in the European Union of an existing IR(EU) resulted from a request for territorial extension under Article 3ter(2), a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the existing IR(EU) is to be disregarded for the purposes of sub-paragraphs (3)(a)(ii) and (6)(a)(ii) unless the request for territorial extension was recorded in the International Register within a period of six months beginning with the day after the priority date recorded in the International Register in respect of the international application for protection of the trade mark which is the same as the one in respect of which the request for territorial extension was filed.
- (8) References in sub-paragraphs (5) and (6) to sections 46 and 47 are to those sections as they apply to a protected international trade mark (UK) under an order made pursuant to section 54.
- (9) Where a trade mark has been surrendered or allowed to lapse in respect of some only of the goods or services for which it is registered, the declaration in sub-paragraphs (2) and (5) is that if the goods or services had not been removed from the registration, the registration of the trade mark would have been liable to be revoked under section 46 with effect from a date specified in the declaration or declared invalid under section 47 and sub-paragraphs (3) and (6) shall be construed accordingly.

*Procedure for declaration that trade mark would have been liable to be revoked or declared invalid*

- 16 (1) In the case of proceedings on an application under paragraph 15 before the registrar, the rules relating to applications for and proceedings relating to the revocation or invalidation of a trade mark apply, with necessary modifications.
- (2) In the case of proceedings on an application under paragraph 15 before the court, section 74 applies to the proceedings as it applies to proceedings involving an application of the type referred to in section 74(1)(a) to (c).

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*Assignment of an existing IR(EU) not registered on IP completion day*

- 17 (1) This paragraph applies where before IP completion day an existing IR(EU) (or any right in it) is the subject of an assignment (a “relevant assignment”) which immediately before IP completion day is not recorded in the International Register.
- (2) Section 25 applies in relation to a relevant assignment as if it were a registrable transaction affecting a comparable trade mark (IR), subject to the modification set out below.
- (3) An application under section 25(1) may only be made by—
- (a) a person claiming to be entitled to an interest in or under a comparable trade mark (IR) by virtue of a relevant assignment of the corresponding (IR); or
  - (b) the proprietor of the comparable trade mark (IR).

*Effect of a licence of an existing IR(EU)*

- 18 (1) This paragraph applies where immediately before IP completion day an existing IR(EU) is the subject of a licence (a “relevant licence”) which—
- (a) authorises the doing of acts in the United Kingdom which would otherwise infringe the international trade mark; and
  - (b) does not expire on IP completion day.
- (2) Subject to any agreement to the contrary between the licensee and the licensor, a relevant licence continues to authorise the doing of acts in the United Kingdom which would otherwise infringe the comparable trade mark (IR) which derives from the existing IR(EU).
- (3) Sub-paragraph (2) is subject to—
- (a) the terms on which the relevant licence was granted; and
  - (b) such modifications to the terms referred to in paragraph (a) as are necessary for their application in the United Kingdom.
- (4) Section 25 applies in relation to a relevant licence as if it were a registrable transaction affecting a comparable trade mark (IR), subject to the modifications set out below.
- (5) An application under section 25(1) may only be made by—
- (a) a person claiming to be a licensee by virtue of the relevant licence; or
  - (b) the proprietor of the comparable trade mark (IR).
- (6) Where immediately before IP completion day there is an entry in the International Register relating to a relevant licence—
- (a) section 25(3) and (4) does not apply until after the expiry of the relevant period; and
  - (b) section 25(4)(a) applies after the expiry of the relevant period but as if the reference to six months beginning with the date of the transaction were a reference to eighteen months beginning with IP completion day.
- (7) In sub-paragraph (6)(a), the “relevant period” means the period of twelve months beginning with the day after that on which IP completion day falls.

### *Effect of a security interest in an existing IR(EU)*

- 19 (1) This paragraph applies where immediately before IP completion day an existing IR(EU) (or any right in or under it) is the subject of a security interest (a “relevant security interest”) which—
- (a) restricts the proprietor's right to dispose in the European Union of the existing IR(EU); and
  - (b) does not terminate on IP completion day.
- (2) References to the existing IR(EU), or the international registration to which the existing IR(EU) is subject, in any document which grants or refers to the relevant security interest are to be read as including references to the comparable trade mark (IR) which derives from the existing IR(EU).
- (3) Section 25 applies in relation to a relevant security interest as if it were a registrable transaction affecting a comparable trade mark (IR), subject to the modifications set out below.
- (4) An application under section 25(1) may only be made by—
- (a) a person claiming to be entitled to an interest in or under a comparable trade mark (IR) by virtue of the relevant security interest; or
  - (b) the proprietor of the comparable trade mark (IR).
- (5) Where immediately before IP completion day there is an entry in the International Register relating to a relevant security interest—
- (a) section 25(3) and (4) do not apply until after the expiry of the relevant period; and
  - (b) section 25(4)(a) applies after the expiry of the relevant period but as if the reference to six months beginning with the date of the transaction were a reference to eighteen months beginning with IP completion day.
- (6) In sub-paragraph (5)(a), the “relevant period” means the period of twelve months beginning with the day after that on which IP completion day falls.

### *Continuity of rights in relation to a comparable trade mark (IR)*

- 20 (1) References to an existing IR(EU), or the international registration to which an existing IR(EU) is subject, in any document made before IP completion day shall, unless there is evidence that the document was not intended to have effect in the United Kingdom, be read on and after IP completion day as including references to the comparable trade mark (IR) or the registration of the comparable trade mark (IR) which derives from the existing IR(EU).
- (2) Subject to any agreement to the contrary, a consent granted before IP completion day by the proprietor of an existing IR(EU) to the doing on or after IP completion day of an act in the United Kingdom which would otherwise infringe the comparable trade mark (IR) which derives from the existing IR(EU) is to be treated for the purposes of section 9 as a consent to the doing of that act.

### *Existing IR(EU): pending proceedings*

- 21 (1) This paragraph applies where on IP completion day an existing IR(EU) is the subject of proceedings which are pending (“pending proceedings”) before a court in the

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United Kingdom designated for the purposes of Article 123 of the European Union Trade Mark Regulation (“EU trade mark court”).

- (2) Subject to sub-paragraphs (3) and (4), the provisions contained or referred to in Chapter 10 of the European Union Trade Mark Regulation (with the exception of Articles 128(2), (4), (6) and (7) and 132) continue to apply to the pending proceedings as if the United Kingdom were still a Member State with effect from IP completion day.
- (3) Where the pending proceedings involve a claim for infringement of an existing IR(EU), without prejudice to any other relief by way of damages, accounts or otherwise available to the proprietor of the existing IR(EU), the EU trade mark court may grant an injunction to prohibit unauthorised use of the comparable trade mark (IR) which derives from the existing IR(EU).
- (4) Where the pending proceedings involve a counterclaim for the revocation of, or a declaration of invalidity in relation to, an existing IR(EU), the EU trade mark court may revoke the registration of the comparable trade mark (IR) which derives from the existing IR(EU) or declare the registration of the comparable trade mark (IR) which derives from the existing IR(EU) to be invalid.
- (5) Where the grounds for revocation or invalidity exist in respect of only some of the goods or services for which the existing IR(EU) is registered, the revocation or declaration of invalidity in respect of the registration of the comparable trade mark (IR) which derives from the existing IR(EU) relates to those goods or services only.
- (6) Where (by virtue of sub-paragraph (4)) the registration of a comparable trade mark (IR) is revoked to any extent, the rights of the proprietor are deemed to have ceased to that extent as from—
  - (a) the date of the counterclaim for revocation, or
  - (b) if the court is satisfied that the grounds for revocation existed at an earlier date, that date.
- (7) Where (by virtue of sub-paragraph (4)) the registration of a comparable trade mark (IR) is declared invalid to any extent, the registration is to that extent to be deemed never to have been made, provided that this does not affect transactions past and closed.
- (8) For the purposes of this paragraph proceedings are treated as pending on IP completion day if they were instituted but not finally determined before IP completion day.

*Existing IR(EU): effect of injunction*

- 22 (1) This paragraph applies where immediately before IP completion day an injunction is in force prohibiting the performance of acts in the United Kingdom which infringe or would infringe an existing IR(EU) (a “relevant injunction”).
- (2) Subject to any order of the court to the contrary, a relevant injunction will have effect and be enforceable to prohibit the performance of acts which infringe or would infringe a comparable trade mark (IR) to the same extent as in relation to the existing IR(EU) from which the comparable trade mark (IR) derives as if it were an injunction granted by the court.]

**Changes to legislation:**

There are currently no known outstanding effects for the Trade Marks Act 1994, PART 1.