

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, PART 4. (See end of Document for details)

SCHEDULES

[^{F1}SCHEDULE 2B U.K.]

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 4 U.K.

TRANSFORMATION APPLICATIONS WHICH ARE PENDING ON IP COMPLETION DAY

Transformation applications

- 32 (1) In this Part, references to a “transformation application” are to an application for transformation of an international registration which has been cancelled (a “cancelled international registration”) into an application for registration of a European Union trade mark filed under Article 204 of the European Union Trade Mark Regulation in respect of which the conditions in sub-paragraph (2) are satisfied.
- (2) The conditions referred to in sub-paragraph (1) are—
- (a) the transformation application was filed before IP completion day with the European Union Intellectual Property Office;
 - (b) as at the time immediately before IP completion day the transformation application has neither been granted nor refused by the European Union Intellectual Property Office under the European Union Trade Mark Regulation; and
 - (c) the international registration was not cancelled at the request of the Patent Office as Office of origin for the international registration of the trade mark.
- (3) In sub-paragraph (2)(b)—
- (a) the reference to the transformation application being “granted” means a European Union trade mark being registered under the European Union Trade Mark Regulation pursuant to the transformation application; and
 - (b) the reference to the transformation application being “refused” means the transformation application being subject to the provisions in Article 204(5) of the European Union Trade Mark Regulation.

Application for registration based upon a cancelled international registration

- 33 (1) This paragraph applies where—

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- (a) a person who has filed a transformation application in respect of a cancelled international registration, or a successor in title of that person, applies for registration under this Act of a trade mark which is the same as the trade mark which was the subject of the cancelled international registration and in respect of some or all of the same goods or services included in the international registration;
 - (b) the application for registration under this Act is made within the period beginning with IP completion day and ending with the end of the relevant period; and
 - (c) on or before the date of the transformation application on which the application for registration under this Act is based the trade mark that was the subject of the cancelled international registration—
 - (i) was protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation; or
 - (ii) was the subject of an existing ITM application or an existing request for EU extension which, as at that date, had neither been granted nor refused by the European Union Intellectual Property Office (the references to “granted” and “refused” having the same meaning as given by paragraph 27(4)).
- (2) Where this paragraph applies by virtue of sub-paragraph (1)(c)(i), the relevant date for the purposes of establishing which rights take precedence is the earliest of—
- (a) where—
 - (i) the protection in the European Union of the trade mark that was the subject of the cancelled international registration resulted from a request for territorial extension under Article 3*ter*(1), the date of registration accorded to the international registration pursuant to Article 3(4); or
 - (ii) the protection in the European Union of the trade mark that was the subject of the cancelled international registration resulted from a request for territorial extension under Article 3*ter*(2), the date on which the request was recorded in the International Register; and
 - (b) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention in respect of the request referred to in paragraph (a)(i) or (ii).
- (3) Where this paragraph applies by virtue of sub-paragraph (1)(c)(ii), the relevant date for the purposes of establishing which rights take precedence is the earliest of—
- (a) the date accorded to the trade mark that was the subject of the existing ITM application pursuant to Article 3(4) or, in the case of an existing request for EU extension, the date on which the request was recorded in the International Register pursuant to Article 3*ter*(2); and
 - (b) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention in respect of the request referred to in paragraph (a).
- (4) A right of priority claimed pursuant to Article 4 of the Paris Convention in respect of a request for territorial extension to the European Union made under Article 3*ter*(2) is to be disregarded for the purposes of sub-paragraphs (2)(b) and (3)(b) unless the request for 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

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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 extension was filed.

- (5) The registrability of the trade mark the subject of an application under this Act of the type mentioned in sub-paragraph (1)(a) and made within the period mentioned in sub-paragraph (1)(b) shall not be affected by any use of the mark in the United Kingdom which commenced in the period between the date referred to in sub-paragraph (2) or (3) (as the case may be) and the date of the application for registration of the trade mark under this Act.
- (6) Paragraphs 30 and 31 apply in relation to an application for a trade mark under this Act of the type mentioned in sub-paragraph (1)(a) and made within the period mentioned in sub-paragraph (1)(b), as they apply in relation to an application for registration of a trade mark pursuant to Part 3, but as if—
- (a) the references to an existing ITM application or an existing request for EU extension and an existing ITM application and an existing request for EU extension had the same meaning as they have in this paragraph; and
 - (b) the references to an existing ITM application included references to a “protected EU designation”.
- (7) In this paragraph—
- (a) an “existing ITM application” means an international application which contains a request for extension of the protection resulting from an international registration to the European Union under Article 3ter(1) which has been filed with the Office of origin in accordance with Article 2(2);
 - (b) an “existing request for EU extension” means a request for extension to the European Union of the protection resulting from an international registration made subsequent to the international registration pursuant to Article 3ter(2) which has been filed with the Office of origin or the International Bureau (as the case may be) in accordance with Rule 24(2);
 - (c) the “relevant period” means the period of nine months beginning with the day after that on which IP completion day falls;
 - (d) a “protected EU designation” means an international registration which prior to its cancellation was protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation.]

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