

SCHEDULE 5

Regulation (EU) 2019/787: new provisions

PART 2

New Articles 36a to 36d

“Article 36a

Transitional provision: relationship between trade marks and geographical indications

1. Unless paragraph 4 applies, an application to register a trade mark that was pending immediately before IP completion day or made during the relevant period must be refused where, if the trade mark is registered, the use of the trade mark will contravene Article 21(2) in relation to a category A geographical indication.

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

- (a) if the trade mark is registered, the use of the trade mark will contravene Article 21(2) in relation to a category B 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 2B geographical indication:
 - (aa) the international agreement referred to in paragraph (c) of column 2 of row 2 of the Types Table enters into force or the bridging arrangements referred to in that column are made, and
 - (bb) the entry into force of the international agreement or the making of the bridging arrangements is brought to the attention of the registrar before the trade mark is registered;
 - (ii) in the case of any other category B geographical indication:
 - (aa) the Secretary of State publishes an Article 30(5) approval notice relating to the geographical indication, and
 - (bb) the Article 30(5) 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 36b(1) and modified by Article 36b(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 made during the relevant period,
- (b) the use of the trade mark contravenes, or will, if used, contravene, Article 21(2) in relation to a category B geographical indication, and
- (c) in the case of a type 3B, 4B or 5B geographical indication, the Secretary of State publishes an Article 30(5) approval notice relating to the geographical indication on or after the day on which the trade mark application is accepted.

4. This paragraph applies where a column 5 date applies in relation to the category A or B geographical indication and, taking account of any priority claimed in respect of an application

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to register the 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 geographical indication.

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

6. As regards paragraph 3, a column 5 date does not apply in relation to a type 2B, 3B or 4B geographical indication where the EUIA referred to in paragraph (b) in column 2 of the row of the Types Table relating to the 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 made, the use of the trade mark contravenes a provision in the EUIA providing for the protection of the use of the geographical indication.

7. Where a geographical indication falls within the definition of more than one type of geographical indication in Article 4, 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 geographical indication.

8. In a case of a category A or B geographical indication that is not on Great Britain's GIs Register at the time an assessment is carried out under paragraph 1, 2 or 3, the geographical indication is to be treated, for the purpose of the assessment, as being a geographical indication protected under this Regulation in determining whether the use of the trade mark will contravene Article 21(2) in relation to that geographical indication.

9. A trade mark that could be used in the United Kingdom under Article 36(2) of EU Regulation 2019/787 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 21(2) of this Regulation in relation to a 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 36(2) of EU Regulation 2019/787 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 21(2) in Great Britain in relation to a 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 geographical indication entered on Great Britain's GIs Register by the Secretary of State following a decision by the Secretary of State to approve an application made under Article 24;

- (b) a geographical indication entered on Great Britain's GIs Register by the Secretary of State under Article 33(3) or Article 36c(1);
- (c) an established geographical indication entered on Great Britain's GIs Register pursuant to Article 37(1).

12. In this Article:

- (a) 'a category A geographical indication' means a type 1, 2A, 3A, 4A or 5A geographical indication;
- (b) 'a category B geographical indication' means a type 2B, 3B, 4B or 5B geographical indication;
- (c) 'column 5 date', in relation to a geographical indication that is a category A or B 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 geographical indication;
- (d) '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(1) 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(2) 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;
- (e) '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;
- (f) 'existing EUTM application' has the same meaning as in paragraph 24 of Schedule 2A to the TMA;
- (g) 'existing ITM application' has the same meaning as in paragraph 27(1)(a) of Schedule 2B to the TMA;
- (h) 'existing request for EU extension' has the same meaning as in paragraph 27(1)(b) of Schedule 2B to the TMA;
- (i) '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;
- (j) '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':

(1) Schedule 2A is prospectively inserted in the Trade Marks Act 1994 by [S.I. 2019/269](#).

(2) Schedule 2B is prospectively inserted in the Trade Marks Act 1994 by [S.I. 2019/638](#).

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- (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⁽³⁾;
 - (ii) a certification mark as defined in section 50(1) of the TMA⁽⁴⁾.

Article 36b

Application and modification of trade mark provisions

1. For the purpose of Article 36a, 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 36a(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⁽⁵⁾ (definition of ‘the court’);
- (f) section 76⁽⁶⁾ (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 36b(1) 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,’;

⁽³⁾ Section 49(1) was substituted by [S.I. 2018/825](#).

⁽⁴⁾ Section 50(1) was amended by [S.I. 2018/825](#).

⁽⁵⁾ Section 75 was amended by the Crime and Courts Act 2013 (c. 22), Schedule 9, paragraph 134, [S.I. 2005/587](#).

⁽⁶⁾ Section 76(6) was inserted by [S.I. 2005/587](#).

- (ii) in subsection (5), for ‘grounds of invalidity’ there were substituted ‘ground for invalidity specified in Article 36a(3) of Regulation (EU) 2019/787 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 36a(3) of Regulation (EU) 2019/787 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 36b(1) of Regulation (EU) 2019/787 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 36a(3);
 - (b) an appeal to an appointed person from a decision of the registrar in relation to an application referred to in paragraph (a).

Article 36c

Third Country geographical indications covered by bridging arrangements

1. A geographical indication to which paragraph 2 applies is, for the protection period, to be entered on Great Britain’s GIs Register⁽⁷⁾.
2. This paragraph applies to a geographical indication which relates to a geographical area in a third country (“C”) which:
 - (a) was, immediately before IP completion day, protected in the European Union under an EUIA⁽⁸⁾ to which the European Union and C were contracting parties, and
 - (b) is, before a qualifying international agreement enters into force⁽⁹⁾, to be protected in Great Britain pursuant to any written arrangements made by the United Kingdom and C (“bridging arrangements”).
3. For the purposes of this Article, “the protection period”, in relation to a geographical indication, is the period for which:
 - (a) the relevant bridging arrangements have effect, or
 - (b) if only part of the relevant bridging arrangements relates to the geographical indication, that part has effect.
4. In this Article “qualifying international agreement” means an international agreement between the United Kingdom and C, which has been initialled.

⁽⁷⁾ “Great Britain’s GIs Register” is defined in Article 3(13). Point (13) was inserted by [S.I. 2020/1637](#).

⁽⁸⁾ “EUIA” is defined in Article 3(10a). Point 10(a) is inserted by regulation 10(2)(b).

⁽⁹⁾ “Enters into force” is defined in Article 3(9f). Point (9f) is inserted by regulation 10(2)(a).

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Article 36d

Transitional provisions: relations between trade marks and geographical indications when bridging arrangements are in effect

1. Where a geographical indication is treated as entered on Great Britain's GIs Register under Article 36c, Articles 36a and 36b and Annex 1A⁽¹⁰⁾ apply for the purposes of determining:

- (a) whether an application to register a trade mark which was pending before IP completion day or made during the relevant period⁽¹¹⁾, must be refused, or
- (b) if a relevant invalidity application was made, whether the registration of a trade mark must be declared invalid,

but subject to the general modifications specified in paragraphs 2 and 3 and any further modifications made by regulations (if any) (see paragraph 4).

2. The modifications mentioned in paragraph 1 are that Articles 36a and 36b and Annex 1A are to be read as if:

- (a) in the case of a type A term, any reference to a type 2A geographical indication included a reference to a type A term;
- (b) in the case of a type B term, any reference to a type 2B geographical indication included a reference to a type B term.

3. In addition, Article 36b and Annex 1A are to be read as if any reference to Article 36a included a reference to that Article as applied by this Article.

4. The Secretary of State may, by regulations, make such further modifications to Article 36a or 36b or Annex 1A as the Secretary of State considers necessary for the purpose of ensuring that the relative priorities afforded to geographical indications and trade marks before IP completion day continue to apply appropriately during the relevant period⁽¹²⁾.

5. In this Article:

‘relevant invalidity application’ means an application for a declaration of invalidity made under the TMA (as applied by Article 36b(1) and modified by Article 36b(2)) in relation to the registration of a trade mark;

‘type A term’ means a geographical indication which—

- (i) is, immediately before the application to register a trade mark is accepted, entered in Great Britain's GIs Register under Article 36c, or
- (ii) is not so entered when the application to register a trade mark is accepted, but is to be protected under bridging arrangements which come into effect before the application to register a trade mark is accepted;

‘type B term’ means a geographical indication which is not entered in Great Britain's GIs Register under Article 36c when the relevant trade mark application is accepted but must be protected in Great Britain pursuant to bridging arrangements made on or after the day on which the relevant trade mark application is accepted.”

⁽¹⁰⁾ Articles 36a and 36b and Annex 1A are inserted by [S.I. 2019/1366](#).

⁽¹¹⁾ “The relevant period” is defined in Article 3(14a). Point (14a) is inserted by regulation 10(2)(c).

⁽¹²⁾ See Article 46 inserted prospectively by [S.I. 2020/1637](#), which insertion is amended by regulation 16(6), for provisions concerning the procedural requirements associated with regulations made under Regulation (EU) 2019/787.