
DRAFT STATUTORY INSTRUMENTS

2020 No.

**The Intellectual Property (Amendment
etc.) (EU Exit) Regulations 2020**

PART 4

Amendments to the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019

11. Schedule 4 (Amendments to the Rules) is amended as follows—

(a) for paragraph 6 substitute—

“**6.**—(1) Rule 11 is amended as follows.

(2) At the end of paragraph (1)(d), omit “.” and substitute “;”.

(3) After paragraph (1)(d) insert—

“(e) a proprietor of a comparable trade mark (EU) who sends a derogation notice to the registrar under rule 43A.”.

(4) In paragraph (4), for “another EEA state” substitute “an EEA state”.

(b) after paragraph 6 insert—

“**6A.**—(1) Rule 12 is amended as follows.

(2) At the end of paragraph (4)(d), omit “.” and substitute “;”.

(3) After paragraph (4)(d), insert—

“(e) in the case of the proprietor who sends a derogation notice to the registrar, the registrar must proceed as if the proprietor had not sent a derogation notice.”.

(c) after paragraph 10 insert—

“**10A.**—(1) Rule 43 is amended as follows.

(2) At the end of paragraph (1)(b), omit “, or” and substitute “;”.

(3) At the end of paragraph (1)(c), omit “,” and substitute “; or”.

(4) After paragraph (1)(c), insert—

“(d) the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent under rule 43A(6),”.

(5) In paragraph (2), after “application and shall” insert “, in the cases referred to in paragraph (1)(a) to (c),”.

(6) In paragraph (3)—

(a) after “TM8” insert “or the derogation notice”;

(b) after “TM26(O)” omit “or” and substitute “;”;

- (c) after “TM 26(I)” insert “or notification from the registrar under rule 43(4)(b) that the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM”.

10B. After rule 43 insert—

“Invalidation or revocation of Existing EUTM: Cancellation notice and procedure on application for derogation; Schedule 2A paragraph 21A

43A.—(1) A cancellation notice under paragraph 21A of Schedule 2A must—

- (a) identify the existing EUTM by the number under which the existing EUTM was registered in the EUTM Register immediately before IP completion day, together with a representation of the mark,
- (b) include the following details with regard to the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially)—
 - (i) the date of the decision (including any decision determined on appeal),
 - (ii) whether the revocation or declaration of invalidity related to all or part of the goods or services for which the existing EUTM was registered,
 - (iii) where the existing EUTM was revoked (whether wholly or partially) the date on which the revocation took effect,
- (c) be accompanied by a copy of the decision (including any decision determined on appeal) pursuant to which the existing EUTM was revoked or declared to be invalid, and
- (d) include a statement confirming that the decision pursuant to which the existing EUTM was revoked or declared invalid (whether wholly or partially) has been finally determined.

(2) Where a cancellation notice is submitted to the registrar by the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the cancellation notice must be accompanied by—

- (a) a notice (a “derogation notice”) in writing to the registrar that, based upon the provisions in paragraph 21A(4) of Schedule 2A, the comparable trade mark (EU) should not be revoked or declared invalid (whether wholly or partially), and
- (b) a statement of the reasons why paragraph 21A(4) of Schedule 2A applies (a “statement”) together with relevant supporting evidence (“supporting evidence”).

(3) Where the proprietor of a comparable trade mark (EU) submits a cancellation notice to the registrar but fails to send a derogation notice, a statement or supporting evidence, the registration of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice must be revoked or declared invalid to the same extent as the existing EUTM, unless the registrar directs otherwise.

(4) Where the registrar receives a cancellation notice submitted by a person other than the proprietor of the comparable trade mark (EU) which derives from the existing EUTM, the registrar must as soon as reasonably practicable after receipt of the cancellation notice—

- (a) send a copy of the cancellation notice to the proprietor of the comparable trade mark (EU) which derives from the existing EUTM identified in the cancellation notice, and
 - (b) notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM that based upon the revocation or declaration of invalidity of the existing EUTM, the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM.
- (5) Where the registrar has become aware of the situation referred to in paragraph 21A(2)(a) of Schedule 2A otherwise than by a cancellation notice, the registrar must as soon as reasonably practicable after becoming aware of that situation, notify the proprietor of the comparable trade mark (EU) which derives from the existing EUTM in the terms provided in paragraph (4)(b).
- (6) The proprietor of a comparable trade mark (EU) referred to in paragraph (4) and (5) must, within such period of not less than one month as may be specified in the notice referred to in paragraph (4)(b) and (5), send to the registrar a derogation notice accompanied by a statement and supporting evidence as referred to in paragraph (2), failing which the registration of the comparable trade mark (EU) must be revoked or declared invalid to the same extent as the corresponding EUTM, unless the registrar directs otherwise.
- (7) The registrar must, in reaching a decision as to whether paragraph 21A(4) of Schedule 2A applies to a comparable trade mark (EU), have regard to the statement and supporting evidence filed by the proprietor of the comparable trade mark (EU) and must send written notice of the decision to the proprietor, stating the reasons for that decision.
- (8) For the purposes of any appeal against a decision referred to in subparagraph (7), the date on which the notice is sent must be taken to be the date of the decision.”.”.
- (d) in rule 47(n) (to be inserted by paragraph 11(6)), after “corresponding EUTM” insert “, and where the corresponding EUTM is subject to cancellation proceedings, that cancellation is pending”.