

*Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Paragraph 31. (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 3

#### APPLICATIONS FOR THE EXTENSION OF PROTECTION OF INTERNATIONAL REGISTRATIONS TO THE EUROPEAN UNION WHICH ARE PENDING ON IP COMPLETION DAY

##### *Determination of invalidity and liability to revocation in relation to claim of seniority under paragraph 30*

- 31 (1) Where a relevant mark has claimed 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 the application for registration of the relevant mark was based on an existing ITM application and there has been no claim of priority, the date of registration accorded pursuant to Article 3(4) to the international trade mark the subject of the existing ITM application;
    - (ii) where the application for registration of the relevant mark was based on an existing request for EU extension and there has been no claim of priority, the date on which the request was recorded in the International Register pursuant to Article 3ter(2);

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- (iii) where the application for registration of the relevant mark was based on an existing ITM application or an existing request for EU extension and there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention; or
  - (b) declared invalid under section 47,  
the seniority claimed for the relevant mark is to be treated as if it never had effect.
- (4) Where a relevant mark has claimed 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 trade 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.
- (6) 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 the application for registration of the relevant mark was based on an existing ITM application and there has been no claim of priority, the date of registration accorded pursuant to Article 3(4) to the international trade mark the subject of the existing ITM application;
    - (ii) where the application for registration of the relevant mark was based on an existing request for EU extension and there has been no claim of priority, the date on which the request was recorded in the International Register pursuant to Article 3ter(2);
    - (iii) where the application for registration of the relevant mark was based on an existing ITM application or an existing request for EU extension and there has been a claim of priority, the priority date accorded pursuant to a right of priority claimed pursuant to Article 4 of the Paris Convention; or
  - (b) declared invalid under section 47,  
the seniority claimed for the relevant mark is to be treated as if it never had effect.
- (7) Where the application for registration of the relevant mark was based on an existing request for EU extension a right of priority claimed pursuant to Article 35 of the European Union Trade Mark Regulation in respect of the request for EU extension is to be disregarded for the purposes of sub-paragraphs (3)(a)(iii) and (6)(a)(iii) 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 EU extension was filed.

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- (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 only some 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.
- (10) The provisions of paragraph 16 apply in relation to an application under this paragraph as they apply to an application under paragraph 15.]

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