

SCHEDULE 7

Regulation 9

Amendments to the Trade Marks Rules

1. The Trade Marks Rules are amended as follows.

Commencement Information

- I1** Sch. 7 para. 1 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1

2. In rule 2, after paragraph (2) insert—

“(2A) Terms defined in Part 5 of Schedules 2A and 2B have the same meaning in these Rules.”.

Commencement Information

- I2** Sch. 7 para. 2 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1

3. Before rule 3 insert—

“Comparable trade mark (IR)

2B These Rules apply to a comparable trade mark (IR) as they apply to other registered trade marks.”

Commencement Information

- I3** Sch. 7 para. 3 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1

4. After rule 4 insert—

“Prescribed comparable trade mark (IR) fees

4A In relation to a comparable trade mark (IR), “prescribed” in rule 4(1) means prescribed by virtue of regulations under Schedule 4 to the European Union (Withdrawal) Act 2018.”.

Commencement Information

- I4** Sch. 7 para. 4 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, Sch. 5 para. 1(1)), see reg. 1

5. Before rule 6 insert—

“Application for registration based upon an existing ITM application, existing request for EU extension or transformation application; Schedule 2B paragraph 28, 29 or 33

5B.—(1) Where an application for registration is made in accordance with paragraph 28, 29 or 33 of Schedule 2B, the application for registration under rule 5 must specify—

- (a) the number of the international registration to which the application relates;
- (b) the date referred to in paragraph 28(2)(a), 29(2)(a) or 33(2)(a) or (3)(a) of Schedule 2B (as the case may be) in respect of that application; and
- (c) the date of priority (if any) accorded pursuant to a right of priority claimed in respect of the existing ITM application the existing request for EU extension or the cancelled international registration the subject of a transformation application.

(2) Where—

- (a) a right of priority has been claimed (“a priority claim”) in respect of the existing ITM application, an existing request for EU extension or the cancelled international registration the subject of a transformation application; or
- (b) the seniority of a registered trade mark or a protected international trade mark (UK) has been claimed (“a seniority claim”) pursuant to paragraph 30 or 33 of Schedule 2B,

the application for registration under rule 5 must, in addition, specify the information provided in paragraph (3).

(3) The information is—

- (a) in relation to a priority claim, the information specified in rule 6(1)(a) to (c); and
- (b) in relation to a seniority claim, the number of the registered trade mark or protected international trade mark (UK) from which the trade mark the subject of the application claims seniority and the seniority date.

(4) The registrar may, in any particular case, by notice require the applicant to file, within such period of not less than one month as the notice may specify, such documentary evidence as the registrar may require certifying, or verifying to the satisfaction of the registrar—

- (a) the date referred to in paragraph (1)(b) in respect of the existing ITM application, existing request for EU extension or transformation application, the representation of the mark and the goods or services covered by that application; and
- (b) in relation to a priority claim, the date of filing of the overseas application, the country or registering or competent authority, the representation of the mark and the goods or services covered by the overseas application.”

Commencement Information

15 Sch. 7 para. 5 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, [Sch. 5 para. 1\(1\)](#)), see reg. 1

6. In rule 14, after paragraph (3) insert—

“(3A) References in paragraph (2) to the proprietor of a trade mark also include a person who has applied for registration of a trade mark which, if registered, would be an earlier trade mark by virtue of section 6(1)(ab).”

Commencement Information

I6 Sch. 7 para. 6 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1

7. Before rule 30 insert—

**“Filing of regulations for International collective and certification marks;
Schedule 2B, paragraph 4**

29B Regulations governing the use of a comparable trade mark (IR) which is a collective mark or a certification mark and any translation required to be filed under paragraph 4 of Schedule 2B must be filed within a period of three months following the date of notice from the registrar.”

Commencement Information

I7 Sch. 7 para. 7 in force at 31.12.2020 on IP completion day (in accordance with 2020 c. 1, **Sch. 5 para. 1(1)**), see reg. 1

8.—(1) Rule 47 is amended as follows.

(2) After paragraph (a) insert—

“(aa) in the case of a comparable trade mark (IR), the date of registration as determined in accordance with paragraph 1 of Schedule 2B”.

(3) After paragraph (b) insert—

“(bb) in the case of a comparable trade mark (IR), the date of completion of the registration procedure which is the date of 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”.

(4) Before paragraph (d) insert—

“(cc) in the case of a comparable trade mark (IR)—

(i) the priority date (if any) accorded pursuant to a claim of priority filed in respect of the corresponding (IR) pursuant to Article 4 of the Paris Convention; and

(ii) the number of the registered trade mark or international trade mark (UK) from which the corresponding (IR) claimed seniority (if any) and the seniority date;

(cd) where the mark is registered pursuant to an application referred to in paragraph 28, 29 or 33 of Schedule 2B—

(i) the priority date (if any) accorded pursuant to a claim to a right to priority made under paragraph 28(2)(b) (taking account of paragraph 28(5)), 29(2)(b) (taking account of paragraph 29(4)) or 33(2)(b) or (3)(b) (taking account of paragraph 33(4)) of Schedule 2B; and

(ii) the number of the registered trade mark or international trade mark (UK) from which the application claims seniority (if any) and the seniority date;”.

(5) After paragraph (n) insert—

Changes to legislation: *There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 7. (See end of Document for details)*

“(o) in the case of a comparable trade mark (IR) an indication that it is derived from an existing IR(EU), including the number of the international registration to which the existing IR(EU) is subject.”.

Commencement Information

I8 Sch. 7 para. 8 in force at 31.12.2020 on IP completion day (in accordance with [2020 c. 1, Sch. 5 para. 1\(1\)](#)), see reg. 1

Changes to legislation:

There are currently no known outstanding effects for the The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SCHEDULE 7.