

2020 No. 1317

EXITING THE EUROPEAN UNION
INTELLECTUAL PROPERTY

**The Patents, Trade Marks and Designs (Address for Service)
(Amendment) (EU Exit) Rules 2020**

<i>Made</i> - - - -	<i>19th November 2020</i>
<i>Laid before Parliament</i>	<i>23rd November 2020</i>
<i>Coming into force</i> - -	<i>1st January 2021</i>

The Secretary of State makes these Rules in exercise of the powers conferred by section 8B(1)(a) of, and paragraph 21(b) of Schedule 7 to, the European Union (Withdrawal) Act 2018(a), section 123 of the Patents Act 1977(b), section 78 of the Trade Marks Act 1994(c), section 250 of the Copyright, Designs and Patents Act 1998(d) and section 36 of the Registered Designs Act 1949(e).

Citation, commencement and interpretation

1.—(1) These Rules may be cited as the Patents, Trade Marks and Designs (Address for Service) (Amendment) (EU Exit) Rules 2020 and come into force on 1st January 2021 (the “Commencement Date”).

(2) In these Rules—

“address for service rules” means—

- (a) rule 103 of the Patents Rules;
- (b) rule 11 of the Trade Marks Rules;
- (c) rule 42 of the Designs Rules;
- (d) rule 23(1A) of and Schedule 1 to the Design Right Rules;

“Designs Rules” means the Registered Designs Rules 2006(f);

“Design Right Rules” means the Design Right (Proceedings before Comptroller) Rules 1989(g);

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- (a) 2018 c. 16. Section 8B was inserted by section 18 of the European Union (Withdrawal Agreement) Act 2020 c. 1.
 - (b) 1977 c. 37; Section 123 was amended by the Patents Act 2004 (c. 16), Schedule 2, paragraphs 1 and 26 and Schedule 3 and by the Copyright, Patents and Designs Act 1988 (c. 48), Schedule 5, paragraph 29, Schedule 7, paragraph 22 and Schedule 8.
 - (c) 1994 c. 26.
 - (d) 1988 c. 48.
 - (e) 1949 c. 88.
 - (f) S.I. 2006/1975; relevant amending instruments are S.I. 2009/546, 2013/444, 2019/638 and 2020/1050.
 - (g) S.I. 1989/1130; relevant amending instruments are S.I. 2006/760, 2009/546 and 2019/638.

“EEA address for service” means an address for service in an EEA state outside the United Kingdom;

“Patents Rules” means the Patents Rules 2007(a);

“Trade Marks Rules” means the Trade Marks Rules 2008(b).

(3) In the definition of “EEA address for service”, “EEA state” has the meaning it had for the purposes of the address for service rules immediately prior to IP completion day.

Amendment to the Patents Rules

2. In rule 103(4) of the Patents Rules, for “an EEA state” substitute “Gibraltar”.

Amendment to the Trade Marks Rules

3. In rule 11(4) of the Trade Marks Rules, for “an EEA state” substitute “Gibraltar”.

Amendments to the Designs Rules

4. In rule 42 of the Designs Rules—

- (a) in paragraph (4), for “an EEA state” substitute “Gibraltar”;
- (b) omit paragraph (6).

Amendments to the Design Right Rules

5.—(1) The Design Right Rules are amended as follows.

(2) In rule 23(1A), for “an EEA state” substitute “Gibraltar”.

(3) In Schedule 1 (Forms), each time it appears, for “an EEA state” substitute “Gibraltar”.

Transitional and Saving Provision - pending proceedings

6.—(1) This rule applies where—

- (a) before the Commencement Date, a person has filed an EEA address for service for the purposes of proceedings in accordance with the address for service rules and proceedings (“relevant proceedings”) have been instituted by or against that person, and
- (b) immediately before the Commencement Date the relevant proceedings have not been finally determined.

(2) Where this rule applies—

- (a) the EEA address for service continues on and after the Commencement Date to be that person’s address for service for the purposes of the relevant proceedings unless and until that person substitutes a new address for service, and
- (b) if that person substitutes a new address for service for the purposes of the relevant proceedings, the new address for service may be any address for service permitted by the address for service rules as in force immediately before the Commencement Date.

(3) For the purposes of this rule, proceedings are finally determined when—

- (a) they have been determined, and
- (b) there is no further possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time).

(a) S.I. 2007/3291; relevant amending instruments are S.I. 2009/546, 2011/2052 and 2019/801.

(b) S.I. 2008/1797; relevant amending instruments are S.I. 2009/546, 2019/269 and 2020/1050.

Transitional and Saving Provision – pending applications

- 7.—(1) This rule applies where—
- (a) before the Commencement Date, a person (“an applicant”) has filed an application for the grant of a patent or the registration of a trade mark or a registered design (“an application”),
 - (b) the applicant has filed an EEA address for service in accordance with the address for service rules, and
 - (c) as at the time immediately before the Commencement Date, the application has been neither granted or registered nor finally refused.
- (2) Where this rule applies—
- (a) in relation to an application for the grant of a patent or the registration of a registered design—
 - (i) the EEA address for service continues on and after the Commencement Date to be the applicant’s address for service pending the grant of the patent or registration of the registered design or final refusal of the application unless and until the applicant substitutes a new address for service, and
 - (ii) if the applicant substitutes a new address for service, the new address for service may be any address for service permitted by the address for service rules as in force immediately before the Commencement Date;
 - (b) in relation to an application for the registration of a trade mark—
 - (i) subject to sub-paragraph (ii) below, paragraph (2)(a) applies in relation to the application as it applies in relation to an application for registration of a registered design;
 - (ii) where opposition proceedings are initiated in respect of the application on or after the Commencement Date, the applicant must provide a new address for service which complies with the address for service rules in force on the Commencement Date.
- (3) For the purposes of this rule, an application is finally refused when—
- (a) it has been determined, and
 - (b) there is no further possibility of the determination being varied or set aside (disregarding any power to grant permission to appeal out of time).

Transitional and Saving Provision – comparable rights

- 8.—(1) This rule applies to the proprietor of a comparable trade mark (EU) or a re-registered design (a “relevant proprietor”).
- (2) During the relevant period, the address for service rules as in force immediately before the Commencement Date apply to a relevant proprietor in relation to a comparable trade mark (EU) or a re-registered design of which they are the proprietor.
- (3) Where during the relevant period a comparable trade mark (EU) or a re-registered design is the subject of or forms the basis for any proceedings to which the address for service rules relate, which have been commenced but not finally determined before the end of the relevant period, the address for service rules as in force immediately before the Commencement Date apply to the relevant proprietor until the proceedings are finally determined.
- (4) Paragraph (3) applies notwithstanding the removal during the proceedings of any comparable trade mark (EU) or re-registered design from the claim which formed the basis for the proceedings.
- (5) For the purposes of this rule—
- (a) proceedings are commenced where a claim, petition or other application has been filed with the Patent Office or the court, and

(b) proceedings are finally determined in the circumstances referred to in rule 6(3).

(6) In this rule, “relevant period” means the period of three years beginning with the Commencement Date.

Amanda Solloway
Parliamentary Under-Secretary of State for Science, Research and Innovation
19th November 2020
Department for Business, Energy and Industrial Strategy

EXPLANATORY NOTE

(This note is not part of the Rules)

These Rules amend the address for service rules contained in;

- (a) Rule 103 of the Patents Rules 2007 (S.I. 2007/3291),
- (b) Rule 11 of the Trade Marks Rules 2008 (S.I. 2008/1797),
- (c) Rule 42 of the Registered Designs Rules 2006 (S.I. 2006/1975), and
- (d) Rule 23(1A) of and Schedule 1 to the Design Right (Proceedings before Comptroller) Rules 1989 (S.I. 1989/1130).

The amendments in rules 2 to 5 remove references to “an EEA State” in the above rules and insert a reference to Gibraltar so that with effect from 1st January 2021 (“the Commencement Date”) an address for service for the purposes of any proceedings to which the above rules relate, must be an address in the United Kingdom, Gibraltar or the Channel Islands.

Rule 6 provides a transitional and saving provision in relation to cases where proceedings are pending as at the Commencement Date.

Rule 7 provides a transitional and saving provision in relation to applications for the grant of a patent or the registration of a trade mark or registered design which are pending as at the Commencement Date.

Rule 8 provides a transitional and saving provision for proprietors of comparable trade marks (EU) and re-registered designs. Such proprietors may retain an address for service in an EEA State in respect of those rights for a period of 3 years from the Commencement Date (or longer if, at the expiry of that period, they are engaged in proceedings at that date).

A de minimis impact assessment of the effect that this instrument will have on the costs of business, the voluntary sector and the public sector has been produced.

A copy of this instrument, the impact assessment and the Explanatory Memorandum is available from the Intellectual Property Office, Concept House, Cardiff Road, Newport, NP20 8QQ. The Explanatory Memorandum and impact assessment are also available alongside the instrument on the Legislation UK website www.legislation.gov.uk (copies have also been placed in the libraries of both Houses of Parliament).

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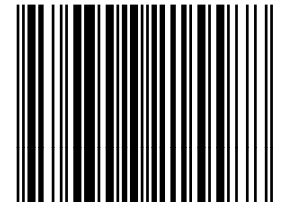
Printed and published in the UK by The Stationery Office Limited under the authority and superintendence of Jeff James, Controller of Her Majesty's Stationery Office and Queen's Printer of Acts of Parliament.

£4.90

UK202011191019 11/2020 19585

<http://www.legislation.gov.uk/id/uksi/2020/1317>

ISBN 978-0-34-821558-8



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