

SCHEDULE 8

Commission Delegated Regulation (EU) 2019/33: new provisions

PART 3

New Articles 32a and 32b

“Article 32a

Transitional provision: relationship with trade marks

1. Unless paragraph 4 applies, an application to register a trade mark that was pending immediately before IP completion day or filed during the relevant period must be refused where, if the trade mark is registered, the use of the trade mark will not respect the definition in Article 112 of Regulation (EU) No 1308/2013 and the conditions of use in Article 113 of that Regulation in relation to a category A traditional term.

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

- (a) if the trade mark is registered, the use of the trade mark will not respect the definition in Article 112 of Regulation (EU) No 1308/2013 and conditions of use in Article 113 of that Regulation in relation to a category B traditional term, 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 traditional term:
 - (aa) the international agreement referred to in paragraph (c) of column 2 of row 2 of the Types Table enters into force, and
 - (bb) the entry into force of the international agreement is brought to the attention of the registrar before the trade mark is registered;
 - (ii) in the case of any other category B traditional term:
 - (aa) the Secretary of State publishes an Article 115(2) approval notice relating to the traditional term, and
 - (bb) the Article 115(2) 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 32b(1) and modified by Article 32b(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 filed during the relevant period,
- (b) the use of the trade mark does not, or will not, if used, respect the definition in Article 112 of Regulation (EU) No 1308/2013 and conditions of use in Article 113 of that Regulation in relation to a category B traditional term, and
- (c) in the case of a type 3B, 4B or 5B traditional term, the Secretary of State publishes an Article 115(2) approval notice relating to the traditional term on or after the day on which the trade mark application is accepted.

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

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

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

7. Where a traditional term falls within the definition of more than one type of traditional term in Article 1b, 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 traditional term.

8. In a case of a category A or B traditional term that is not on Great Britain's Traditional Terms Register at the time an assessment is carried out under paragraph 1, 2 or 3, the traditional term is to be treated, for the purpose of the assessment, as being a protected traditional term in determining whether the use of the trade mark will contravene Article 113 in relation to that traditional term.

9. A trade mark that could be used under Article 32(3) of EU Regulation 2019/33 in the United Kingdom 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 not respect the definition in Article 112 of Regulation (EU) No 1308/2013 and conditions of use in Article 113 of that Regulation in relation to a traditional term 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 32(3) of EU Regulation 2019/33 immediately before IP completion day from being renewed after IP completion day:

- (a) notwithstanding that the use of the renewed trade mark would not respect the definition in Article 112 of Regulation (EU) No 1308/2013 and conditions of use in Article 113 of that Regulation in relation to a traditional term 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) an established protected traditional term entered on Great Britain's Traditional Terms Register pursuant to Article 39;

- (b) a traditional term entered on Great Britain's Traditional Terms Register by the Secretary of State following a decision by the Secretary of State to approve an application to protect the traditional term submitted under Article 21 of Implementing Regulation (EU) 2019/34;
- (c) a traditional term entered on Great Britain's Traditional Terms Register by the Secretary of State under Article 25(3) of Implementing Regulation (EU) 2019/34.

12. In this Article:

- (a) 'an application to register a trade mark' means an application to register a trade mark filed under the TMA;
- (b) 'a category A traditional term' means a type 1, 2A, 3A, 4A or 5A traditional term;
- (c) 'a category B traditional term' means a type 2B, 3B, 4B or 5B traditional term;
- (d) 'column 5 date', in relation to a traditional term that is a category A or B traditional term, means the date specified, or provided for, in column 5 of the Types Table in the row relating to the relevant type of traditional term;
- (e) '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 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 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;
- (f) '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;
- (g) 'existing EUTM application' has the same meaning as in paragraph 24 of Schedule 2A to the TMA;
- (h) 'existing ITM application' has the same meaning as in paragraph 27(1)(a) of Schedule 2B to the TMA;
- (i) 'existing request for EU extension' has the same meaning as in paragraph 27(1)(b) of Schedule 2B to the TMA;
- (j) '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;
- (k) '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':

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

Article 32b

Application and modification of trade mark provisions

1. For the purpose of Article 32a, 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 32a(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 (definition of ‘the court’);
- (f) section 76 (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 32b(1) of Commission Delegated Regulation (EU) 2019/33 supplementing Regulation (EU) No 1308/2013 of the European Parliament and of the Council as regards applications for protection of designations of origin, geographical indications and traditional terms in the wine sector, the objection procedure, restrictions of use, amendments to product specifications, cancellation of protection, and labelling and presentation,’;
 - (ii) in subsection (5), for ‘grounds of invalidity’ there were substituted ‘ground for invalidity specified in Article 32a(3) of Commission Delegated Regulation (EU) 2019/33 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 32a(3) of Commission Delegated Regulation (EU) 2019/33’;
 - (ii) the second paragraph were omitted;
- (d) section 77(1) applies as if, at the end there were inserted ‘as applied by Article 32b(1) of Commission Delegated Regulation (EU) 2019/33’.

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 32a(3);
- (b) an appeal to an appointed person from a decision of the registrar in relation to an application referred to in paragraph (a).”