
EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations are made in exercise of the powers conferred by section 8(1) of the European Union (Withdrawal) Act 2018 (c. 16) (“the EUWA”) in order to address failures of retained EU law to operate effectively and other deficiencies (in particular under paragraph (e) of section 8(2) of the EUWA) and paragraph 21(b) of Schedule 7 to the EUWA. These Regulations amend the transitional provisions contained in paragraph 7 of Schedule 5 to the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and regulation 10(2) of the Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 (“the existing regulations”).

The Regulations qualify the application of the transitional provisions in the existing regulations to provide that, in the case of opposition or invalidation proceedings, such proceedings shall be dealt with under the Trade Marks Act 1994 (“the 1994 Act”) as it had effect prior to the coming into force of the amendments made to that Act by the existing regulations, but subject to certain qualifications.

Where the opposition or invalidation proceedings are based on the ground that there exists an earlier trade mark which is an existing EUTM or existing IR(EU) (as those terms are defined in Schedules 2A and 2B to the 1994 Act) and the relevant comparable trade mark has been the subject of a declaration of invalidity under section 47 of the 1994 Act or a revocation decision based on certain grounds under section 46 of the 1994 Act, the registrar may decide that the extent to which reliance may be placed on the earlier trade mark will depend upon the extent to which the relevant comparable mark is not declared invalid or the registration is not revoked (see new paragraphs 8(6)(a) and (7)(a) and new regulations 10A(6)(a) and (7)(a) inserted in the existing regulations by these Regulations).

Similar provisions apply where the earlier trade mark is an existing EUTM application, an existing ITM application or existing request for EU extension (as those terms are defined in Schedules 2A and 2B to the 1994 Act) (“a relevant earlier application”) and an application for registration of the same trade mark under the 1994 Act has resulted in the registration of the same trade mark, which trade mark has been the subject of a declaration of invalidity or revocation decision as referred to above (see new paragraphs 8(6)(c) and (7)(c) and new regulations 10A(6)(c) and (7)(c) inserted in the existing regulations by these Regulations).

Where the opposition or invalidation proceedings are based on the ground that there exists an earlier trade mark which is a relevant earlier application and an application for registration of the same trade mark under the 1994 Act has resulted in the registration of the trade mark in part only, the registrar may decide that reliance may be placed on the earlier trade mark only to the same extent that the domestic trade mark is registered (see new paragraphs 8(6)(b) and (7)(b) and new regulations 10A(6)(b) and (7)(b) inserted in the existing regulations by these Regulations).

The registrar may defer the hearing of the relevant proceedings pending the determination of invalidation or revocation proceedings or the outcome of the application for a domestic trade mark based upon a relevant earlier application (see new paragraph 8(5) and new regulation 10A(5) inserted in the existing regulations by these Regulations).

In addition, where relevant proceedings are based on an earlier trade mark which is—

- (a) an existing EUTM or existing IR(EU) which is the subject of an opt out notice (in accordance with paragraph 2 of Schedule 2A and 2B to the 1994 Act),
- (b) a relevant earlier application and no application has been made for registration of a domestic trade mark based upon it under Schedules 2A or 2B to the 1994 Act and the relevant time period for making such application has expired, or

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(c) a relevant earlier application where an application has been made for registration of a domestic trade mark based upon it under Schedules 2A or 2B to the 1994 Act but the application has not resulted in the registration of the trade mark whether in whole or in part, the registrar may determine that such earlier trade marks may not be relied upon in the invalidation or opposition proceedings (see new paragraph 8(8) and new regulation 10A(8) inserted in the existing regulations by these Regulations).

A full impact assessment has not been produced for this instrument as no significant impact on the private, voluntary or public sector is foreseen.

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