Draft Regulations laid before Parliament under paragraph 12(1) of Schedule 7 to the European Union (Withdrawal) Act 2018, for approval by resolution of each House of Parliament.

DRAFT STATUTORY INSTRUMENTS

2018 No. ****

EXITING THE EUROPEAN UNION
TRADE MARKS

The Trade Marks (Amendment etc.) (EU Exit) Regulations 2018

Made - - - - ***

Coming into force in accordance with regulation 1

The Secretary of State in exercise of the powers conferred by section 8(1) of, and paragraph 1 of Schedule 4 and paragraph 21(b) of Schedule 7 to, the European Union (Withdrawal) Act 2018(**1**) and by section 78 of the Trade Marks Act 1994(**2**) and with the consent of the Treasury makes the following Regulations.

In accordance with paragraph 12(1) of Schedule 7 to the European Union (Withdrawal) Act 2018, a draft of this instrument has been laid before Parliament and approved by resolution of each House of Parliament.

Citation, commencement and interpretation

1.—(1) These Regulations may be cited as the Trade Marks (Amendment etc.) (EU Exit) Regulations 2018 and come into force on exit day.

(2) In these Regulations—

"the 1994 Act" means the Trade Marks Act 1994;

"the Rules" means the Trade Mark Rules 2008(**3**).

Certain trade marks registered as European Union trade marks to have effect under the 1994 Act

2. Schedule 1 contains amendments to the 1994 Act to make provision for certain trade marks registered as European Union trade marks to be treated as registered trade marks from exit day and about certain applications for such marks made before exit day.

(**1**) 2018 c. 16. See section 20(1) of that Act for a definition of "Minister of the Crown".
(**2**) 1994 c. 26.
(**3**) S.I. 2008/1797 amended by S.I. 2009/546, S.I. 2009/2089, S.I. 2012/1003, S.I. 2013/2235, S.I. 2018/825; there are other amending instruments but none are relevant.

Fees payable in respect of a comparable trade mark (EU)

3. Schedule 2, which makes provision for the payment of fees in respect of a comparable trade mark (EU) (as that term is defined for the purposes of Schedule 2A to the 1994 Act as inserted by Schedule 1), has effect.

Other amendments to the 1994 Act

4. Schedule 3, which contains other amendments to the 1994 Act, has effect.

Amendments to the Rules

5. Schedule 4, which contains amendments to the Rules, has effect.

Consequential amendments etc

6. Schedule 5, which contains consequential amendments, repeals, revocations, transitional and saving provisions, has effect.

Name
Minister of State for Universities, Science,
Research and Innovation
Department for Business, Energy and Industrial
Date Strategy

We consent to the making of these regulations

Name
Name
Two of the Lords Commissioners of Her
Date Majesty's Treasury

SCHEDULE 1 Regulation 2

Amendments to the 1994 Act to make provision for certain trade marks registered as European Union trade marks to be treated as registered trade marks and about certain applications for such marks

1. The 1994 Act is amended as follows.

2. After section 52(**4**) (and before the italic heading before section 53), insert—

"**Certain trade marks registered as European Union trade marks to be treated as registered trade marks**

52A. Schedule 2A makes provision for European Union trade marks (including certain expired and removed marks) to be treated as registered trade marks with effect from exit day and about certain applications for a European Union trade mark made before exit day."

3. After Schedule 2, insert—

"SCHEDULE 2A Section 52A

EUROPEAN UNION TRADE MARKS

PART 1

Existing European Union trade marks

A trade mark registered as an existing EUTM to be treated as registered under this Act

1.—(1) A trade mark which is registered in the EUTM Register immediately before exit day (an "existing EUTM") is to be treated on and after exit day as if an application had been made, and the trade mark had been registered, under this Act in respect of the same goods or services as the existing EUTM is registered in the EUTM Register.

(2) A registered trade mark which comes into being by virtue of sub-paragraph (1) is referred to in this Act as a comparable trade mark (EU).

(3) This Act applies to a comparable trade mark (EU) as it applies to other registered trade marks except as otherwise provided in this Schedule.

(4) A comparable trade mark (EU) is deemed for the purposes of this Act to be registered as of the filing date accorded pursuant to Article 32 to the application which resulted in the registration of the corresponding EUTM and that date is deemed for the purposes of this Act to be the date of registration.

(5) Section 40(3) and (4) does not apply to the registration of a comparable trade mark (EU) under this Part.

(6) Section 67(1) applies in relation to the provision of information and the inspection of documents relating to a comparable trade mark (EU) notwithstanding that there will have been no application under this Act for the registration of the trade mark (and so no publication of an application).

(**4**) Section 52 was amended by the Legal Services Act 2007 (c. 29), paragraph 110 of Schedule 21, S.I. 2016/299, regulations 2 and 5, the Intellectual Property (Unjustified Threats) Act 2017 (c. 14), section 2(3) and S.I. 2018/825, regulation 27.

(7) Nothing in this Act authorises the imposition of a fee, or the making of provision by rules or regulations which authorises the imposition of a fee, in respect of any matter relating to a comparable trade mark (EU) (see instead provision made by regulations under Schedule 4 to the European Union (Withdrawal) Act 2018).

(8) For the purposes of this Act—

(a) the date of filing of an application for registration of a comparable trade mark (EU) is the filing date accorded pursuant to Article 32 to the application which resulted in the registration of the corresponding EUTM;

(b) references to the date of application for registration of a comparable trade mark (EU) are to the date of filing of the application;

(c) where an earlier trade mark is a comparable trade mark (EU), references to the completion of the registration procedure for the earlier trade mark are to the completion of the registration procedure in respect of the corresponding EUTM.

(9) In this Schedule—

(a) "corresponding EUTM", in relation to a comparable trade mark (EU), means the existing EUTM from which the comparable trade mark (EU) derives;

(b) "the EUTM Register" means the register of European Union trade marks maintained by the European Union Intellectual Property Office.

Opt out

2.—(1) Subject to sub-paragraph (2), the proprietor of an existing EUTM may, at any time on or after exit day, serve notice on the registrar that the trade mark is not to be treated as if the trade mark had been registered under this Act (an "opt out notice").

(2) An opt out notice may not be served where on or after exit day—

(a) the comparable trade mark (EU) has been put to use in the United Kingdom by the proprietor or with the proprietor's consent (which use includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes);

(b) the comparable trade mark (EU) (or any right in or under it) has been made the subject of an assignment, licence, security interest or any other agreement or document except for an assent by personal representatives in relation to the comparable trade mark (EU); or

(c) proceedings based on the comparable trade mark (EU) have been initiated by the proprietor or with the proprietor's consent.

(3) An opt out notice must—

(a) identify the existing EUTM; and

(b) include the name and address of any person having an interest in the existing EUTM which had effect before exit day in the United Kingdom, and in respect of which an entry was recorded in the EUTM Register.

(4) An opt out notice is of no effect unless the proprietor in that notice certifies that any such person—

(a) has been given not less than three months' notice of the proprietor's intention to serve an opt out notice; or

(b) is not affected or if affected, consents to the opt out.

(5) Where a notice has been served in accordance with this paragraph—

(a) the comparable trade mark (EU) which derives from the existing EUTM ceases with effect from exit day to be treated as if it had been registered under this Act; and

(b) the registrar must, where particulars of the comparable trade mark (EU) have been entered in the register, remove the comparable trade mark (EU) from the register.

Entries to be made in the register in relation to a comparable trade mark (EU)

3.—(1) The registrar must as soon as reasonably practicable after exit day enter a comparable trade mark (EU) in the register.

(2) The particulars of the goods or services in respect of which the comparable trade mark (EU) is treated as if it had been registered must be taken from the English language version of the entry for the corresponding EUTM in the EUTM Register.

(3) Where—

(a) the application for registration of the corresponding EUTM was not filed in English; or

(b) the second language indicated by the applicant pursuant to Article 146(3) was a language other than English,

a person having a sufficient interest who considers that the English language version is inaccurate may apply to the registrar for rectification of the register by the substitution of an English translation of the relevant authentic text (as determined in accordance with Article 147(3)) verified to the satisfaction of the registrar as corresponding to the authentic text.

Comparable trade mark (EU) which derives from an EU Collective Mark or EU Certification Mark

4.—(1) This paragraph applies where the European Union trade mark from which a comparable trade mark (EU) derives is an EU collective mark or an EU certification mark.

(2) The comparable trade mark (EU) is to be treated as either a collective mark or a certification mark, as the case may be.

(3) The proprietor of the comparable trade mark (EU) must, following notice from the registrar, file with the registrar regulations governing the use of the European Union trade mark, submitted pursuant to the European Union Trade Mark Regulation, which had effect immediately before exit day.

(4) Where the regulations referred to in sub-paragraph (3) are in a language other than English they must be filed together with a translation into English verified to the satisfaction of the registrar as corresponding to the original text.

(5) Paragraph 9 of Schedule 1 and paragraph 10 of Schedule 2 apply in relation to the translation referred to in sub-paragraph (4) as they apply in relation to the regulations referred to in sub-paragraph (3).

(6) Where the regulations or any translation are not filed in accordance with the above provisions—

(a) the registrar must remove the comparable trade mark (EU) from the register; and

(b) the rights of the proprietor shall be deemed to have ceased as from the date of removal.

Renewal of a comparable trade mark (EU) which expires within six months after exit day

5.—(1) This paragraph applies to the renewal of the registration of a comparable trade mark (EU) which expires within the period beginning with exit day and ending with the end of the relevant period (and accordingly section 43(1) to (3A) does not apply).

(2) The registration of the comparable trade mark (EU) may be renewed at the request of the proprietor before the expiry of the registration.