

# IP Update: The Trade Marks and International Trade Marks (Amendment) (EU Exit) Regulations 2021

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1. On 26 November 2021 The Trade Marks and International Trade Marks (Amendment) (EU Exit) Regulations 2021 (the “**Regulations**”) came into force, amending the transition provisions in the earlier transitional legislation. The Regulations are intended to prevent the potential unfairness which currently exists following the UK’s departure from the EU, whereby EU trade marks may be relied upon as earlier marks in certain types of UK opposition/ invalidation proceedings, but the owner of an even earlier UK mark or right would not be able to challenge the same EU mark in the EUIPO. The IPO has produced ‘Tribunal Practice Note (1/2021): Legal changes to the end of the Transition Period transitional arrangements’ (the “**TPN**”) which summarises the effect of the Regulations.
2. These changes will only apply to the following types of proceedings and where those proceedings have not been the subject of a final decision on substantive grounds:
  - UK opposition proceedings launched before 11pm on 31 December 2020 (“**IP Completion Day**”);
  - UK opposition proceedings filed on or after IP Completion Day against trade mark applications filed before IP Completion Day.
3. In summary, the Regulations provide that if an EU mark is relied upon in the types of UK opposition proceedings referred to above, the enforceability of the EU mark will depend on the status of the comparable EU mark or re-filed UK mark. A table detailing the main effects of the Regulations in various scenarios is set out in the TPN and is a helpful reference point.
4. The TPN confirms that the IPO will not limit the enforceability of an EU mark of its own motion and accordingly a party who wishes to take action in respect of the changes provided for by the Regulations must make an application in writing to the Tribunal

requesting that it does not enforce the EU mark at all or only in part. The IPO says that it will look favourably on such applications, but that there may be circumstances where it concludes it is not appropriate to grant such a request and the TPN gives the example of where the challenge against a comparable/re-filed UK mark stands no real prospect of success.

5. The recent TPN explains that the IPO expects these changes to impact only a small number of proceedings. However, if parties do believe their proceedings to be affected it is incumbent on them to act quickly. Although neither the Regulations nor the IPO specify a deadline, the IPO's guidance is that all applications should be made as soon as is practical. The TPN provides further guidance on the contents of such applications and the potential opportunity for parties to seek a stay of proceedings pending the determination of invalidation or revocation proceedings.
6. The key take away is that all IP practitioners will want to consider whether the new changes affect any of their proceedings and, if so, whether an application should be made.
7. For further information:
  - The Regulations can be found at [The Trade Marks and International Trade Marks \(Amendment\) \(EU Exit\) Regulations 2021 \(legislation.gov.uk\)](#)
  - The TPN can be found at: [Statutory guidance overview: Tribunal Practice Notice \(1/2021\): Legal changes to the end of Transition Period transitional arrangements - GOV.UK \(www.gov.uk\)](#)

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