

SCHEDULE 4

Regulation 5

Amendments to the Rules

Amendments to the Rules

1. The Rules are amended in accordance with paragraphs 2 to 11.

2.—(1) Rule 2 is amended as follows.

(2) In the definition of “fast track opposition”, sub-paragraph (b), for “or in the EU, or is protected in one or another of those territories as an international trade mark (UK) or (EU)” substitute “or is protected in the UK as an international trade mark (UK)”.

(3) In paragraph (2) after “in the Act” insert “, a reference to a schedule is a reference to that schedule to the Act”.

3. After rule 2 insert—

“2A Comparable trade mark (EU)

These Rules apply to a comparable trade mark (EU) as they apply to other registered trade marks.”

4.—(1) Rule 4 is amended as follows.

(2) In sub-paragraph (1) omit “by rules under section 79 (fees)”.

(3) In sub-paragraph (2) omit “by those rules”.

(4) After sub-paragraph (2) insert—

“(3) In this rule, “prescribed” means—

(a) in relation to a registered trade mark other than a comparable trade mark (EU), prescribed by rules under section 79 (fees);

(b) in relation to a comparable trade mark (EU), prescribed by virtue of regulations under Schedule 4 to the European Union (Withdrawal) Act 2018.”

5. After rule 5 insert—

“5A Application for registration based upon an existing EUTM application; Schedule 2A paragraph 25

(1) Where an application for registration is made in accordance with paragraph 25 of Schedule 2A, the application for registration under rule 5 must specify—

(a) the number accorded to the existing EUTM application;

(b) the filing date accorded to the existing EUTM application; and

(c) the date of priority (if any) accorded pursuant to a right of priority claimed in respect of the existing EUTM application.

(2) Where—

(a) a right of priority has been claimed (“a priority claim”) in respect of the existing EUTM application; or

(b) the seniority of a registered trade mark or a protected international trade mark (UK) has been claimed (“a seniority claim”) under paragraph 26 of Schedule 2A,

the application for registration under rule 5 must, in addition, specify the information provided in paragraph (3).

(3) The information is—

- (a) in relation to a priority claim, the information specified in rule 6(1)(a) to (c); and
- (b) in relation to a seniority claim, the number of the registered trade mark or protected international trade mark (UK) from which the trade mark the subject of the application claims seniority and the seniority date.

(4) The registrar may, in any particular case, by notice require the applicant to file, within such period of not less than one month as the notice may specify, such documentary evidence as the registrar may require certifying, or verifying to the satisfaction of the registrar—

- (a) the filing date accorded to the existing EUTM application, the representation of the mark and the goods or services covered by the existing EUTM application; and
- (b) in relation to a priority claim, the date of filing of the overseas application, the country or registering or competent authority, the representation of the mark and the goods or services covered by the overseas application.”

6. In rule 11(4) for “another EEA state” substitute “an EEA state”.

7. In rule 14(3) for “section 6(1)(a) or (b)” substitute “section 6(1)(a) or (aa)”.

8. In rule 17A(6)(d), omit “or (EU)”.

9. After rule 29 insert—

“29A Filing of regulations for EU collective and certification marks; Schedule 2A, paragraph 4

Regulations governing the use of a comparable trade mark (EU) which is a collective mark or a certification mark and any translation required to be filed under paragraph 4 of Schedule 2A must be filed within a period of three months following the date of notice from the registrar.”

10. After rule 37 insert—

“37A Restoration of a European Union trade mark; Schedule 2A, paragraph 28

A request for the registration of a comparable trade mark (EU) following the restoration of a European Union trade mark under paragraph 28 of Schedule 2A must include—

- (a) a representation of the European Union trade mark;
- (b) the registration number of that mark;
- (c) the name and address of the proprietor;
- (d) the goods or services in respect of which that mark is registered;
- (e) the priority date (if any) accorded pursuant to a claim of priority filed in respect of that mark pursuant to the European Union Trade Mark Regulation and the information specified in rule 6(1)(a) to (c) in respect of that priority claim;
- (f) the number of the registered trade mark or international trade mark (UK) from which that mark claimed seniority (if any) and the seniority date.”

11.—(1) Rule 47 is amended as follows.

(2) At the end of paragraph (a) insert “or, in the case of a comparable trade mark (EU), as determined in accordance with paragraph 1 of Schedule 2A”.

(3) At the end of paragraph (b) insert “(which in the case of a comparable trade mark (EU) is the date of registration of the corresponding EUTM in the EUTM Register)”.

(4) After paragraph (c) insert—

“(ca) in the case of a comparable trade mark (EU)—

(i) the priority date (if any) accorded pursuant to a claim of priority filed in respect of the corresponding EUTM pursuant to the European Union Trade Mark Regulation; and

(ii) the number of the registered trade mark or international trade mark (UK) from which the corresponding EUTM claimed seniority (if any) and the seniority date;

(cb) where the mark is registered pursuant to an application referred to in paragraph 26 of Schedule 2A—

(i) the priority date (if any) accorded pursuant to a claim to a right to priority made under paragraph 25(2)(a)(ii) of Schedule 2A; and

(ii) the number of the registered trade mark or international trade mark (UK) from which the application claims seniority (if any) and the seniority date;”.

(5) Omit paragraph (l).

(6) After paragraph (m)(1) insert—

“(n) in the case of a comparable trade mark (EU) an indication that it is derived from an existing EUTM, including the number of the corresponding EUTM.”.

(1) Paragraph (m) was inserted by [S.I. 2018/825](#), regulation 43.