

SCHEDULE 3

Regulation 4

Other amendments to the 1994 Act

Further amendments to the 1994 Act

1. The 1994 Act is further amended as follows.

Absolute grounds for refusal of registration

- 2.—(1) Section 3(1) is amended as follows.
 - (2) In subsection (4), omit “or by any provision of EU law”.
 - (3) In subsection (4A)—
 - (a) at the end of paragraph (a) insert “or”;
 - (b) omit paragraph (b) (together with the final “or”);
 - (c) in paragraph (c), omit “or the EU”.
 - (4) Omit subsection (4B).
 - (5) In subsection (4D)—
 - (a) at the end of paragraph (a) insert “or”;
 - (b) omit paragraph (b) (together with the final “or”);
 - (c) in paragraph (c), omit “or the EU”.

Relative grounds for refusal of registration

- 3.—(1) Section 5(2) is amended as follows.
 - (2) In subsection (3) omit “(or, in the case of a European Union trade mark or international trade mark (EC), in the European Union)”.
 - (3) In subsection (4)(aa), omit “any provision of EU law, or”.

Meaning of “earlier trade mark”

- 4.—(1) Section 6(3) is amended as follows.
 - (2) In subsection (1)(a)—
 - (a) after “registered trade mark” omit “,” and insert “or”;
 - (b) omit “European Union trade mark or international trade mark (EC)”.
 - (3) After subsection (1)(a) insert—

“(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;”.
 - (4) Omit subsection (1)(b).
 - (5) In subsection (1)(ba)(i)—

(1) Section 3 was amended by [S.I. 2011/1043](#), article 6(2)(a) and [S.I. 2018/825](#), regulation 4.

(2) Section 5 amended by [S.I. 2004/946](#), regulations 3 and 7(1), [S.I. 2004/2332](#), regulations 2 and 3, [S.I. 2011/1043](#), article 4(1), [S.I. 2016/299](#), the Schedule, paragraph 1 and [S.I. 2018/825](#), regulation 5.

(3) Section 6 was amended by [S.I. 1999/1899](#), regulation 13(1), [S.I. 2004/2332](#), regulations 2 and 4, [S.I. 2016/299](#), the Schedule, paragraph 1 and [S.I. 2018/825](#), regulations 7.

- (a) before “has been converted” insert “prior to exit day”; and
 - (b) for “within paragraph (b) from an earlier trade mark” substitute “of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired”.
- (6) After subsection (1) insert—
- “(1A) In subsection (1), “protected international trade mark (UK)” has the same meaning as in the Trade Marks (International Registration) Order 2008.”
- (7) In subsection (2) omit “or (b)”.
- (8) After subsection (2) insert—
- “(2A) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made pursuant to paragraph 25 of Schedule 2A and which if registered would be an earlier trade mark by virtue of subsection (1)(aa), subject to its being so registered.”

Raising of relative grounds in opposition proceedings in case of non-use

- 5.—(1) Section 6A(4) is amended as follows.
- (2) In subsection (1)(b) for “(b)” substitute “(aa)”.
 - (3) Omit subsections (5) and (5A).

Right to prevent goods entering the UK without being released for free circulation

- 6.—(1) Section 10A is amended as follows.
- (2) In subsection (1)(a) for “EU” substitute “United Kingdom”.
 - (3) In subsection (5), after “intellectual property rights” insert “as amended from time to time”.

Limits on effect of registered trade mark

- 7.—(1) Section 11(5) is amended as follows.
- (2) Omit subsection (1A).
 - (3) In subsection (1B), omit “or (1A)”.

Order as to disposal of infringing goods, material or articles

8. In section 19(6)(a)(6) omit “(including that section as applied by regulation 4 of the Community Trade Mark Regulations 2006 (SI 2006/1027))”.

Grounds for invalidity of registration

9. In section 47(7) omit subsections (2D) and (2DA).

(4) Section 6A was inserted by S.I. 2004/946, regulations 3 and 4 and amended by S.I. 2008/1067 regulations 3 and 4, S.I. 2011/1043, article 4(1), S.I. 2016/299, the Schedule, paragraph 1 and S.I. 2018/825, regulation 8.

(5) Section 11 was amended by S.I. 2018/825, regulation 12.

(6) Section 19 was amended by S.I. 2006/1028, Schedule 2, paragraph 6.

(7) Section 47 was amended by S.I. 2004/946, regulations 3 and 6, S.I. 2008/1067, regulations 3 and 5, S.I. 2011/1043 article 4(1), S.I. 2016/299, the Schedule, paragraph 1 and S.I. 2018/825, regulation 23.

Meaning of “European Union trade mark”

10. In section 51(8), in the definition of “the European Union Trade Mark Regulation” at the end insert “(as it had effect immediately before exit day)”.

Power to make provision in connection with European Union Trade Mark Regulation

11. Omit section 52.

Privilege for communications with registered trade mark agents

12.—(1) Section 87(3) is amended as follows.

(2) At the end of paragraph (c) insert “or”.

(3) After paragraph (c) insert—

“(d) a person whose name appears on the list of professional representatives for trade mark matters maintained by the European Union Intellectual Property Office referred to in Article 120 of the European Union Trade Mark Regulation.”

(4) After subsection (3) insert—

“(4) Where a trade mark attorney is a person falling within subsection (3)(d), subsection (2) applies as if the reference to a matter mentioned in subsection (1) were a reference to a matter relating to the protection of a trade mark.”

Minor definitions

13. In section 103(9), omit subsection (3).

14. Index of defined expressions

15.—(1) Section 104 is amended as follows.

(2) After the entry in the table for “commencement (of this Act)” insert—

“comparable trade mark (EU)	Schedule 2A, paragraph 1(2)”
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(3) After the entry in the table for “date of application” insert—

“date of application (comparable trade mark (EU))	Schedule 2A, paragraph 1(8)(b)”
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(4) After the entry in the table for “date of filing” insert—

“date of filing (comparable trade mark (EU))	Schedule 2A, paragraph 1(8)(a)”
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(5) After the entry in the table for “date of registration” insert—

“date of registration (comparable trade mark (EU))	Schedule 2A, paragraph 1(4)”
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(8) Section 51 was amended by [S.I. 2016/299](#), regulations 2 and 4 and [S.I. 2018/825](#), regulation 26.

(9) Section 103 was amended by [S.I. 2011/1043](#), article 6(1)(d).