

SCHEDULE 8

Regulation 10(1)

Other amendments to legislation

PART 1

Further amendments to the 1949 Act

1. The 1949 Act is further amended as follows.

2. In section 1B(1) (requirement of novelty and individual character), in subsection (6)(a), for “the European Economic Area”, substitute “the geographical area comprising the United Kingdom and the European Economic Area”.

3. In section 11ZA(2) (grounds for invalidity of registration), in subsection (1A)(b) omit subparagraphs (i) and (ii) and insert “by virtue of registration under this Act or an application for such registration.”

4. In section 11ZB(3) (applications for declaration of invalidity), in subsection (4)—

- (a) omit “or the Community Design Regulation”;
- (b) omit “, the holder of the registered Community design”.

5. In section 20(4) (rectification of register), in subsection (1B)—

- (a) omit “or the Community Design Regulation”;
- (b) omit “, the holder of the registered Community design”.

6. In section 24D(5) (order as to disposal of infringing articles etc), in subsection (5)—

- (a) in paragraph (b) at the end of the paragraph (after the semi-colon in that paragraph) insert “or”;
- (b) at the end of paragraph (c) omit “or”;
- (c) omit paragraph (d).

7. In section 24G(6) (meaning of “infringing article”), omit subsection (5).

8. After section 25(7) (certificate of contested validity of registration), insert—

“25A Privilege for communications with those on the special list of professional designs representatives

(1) This section applies to communications as to any matter relating to the protection of a design as a registered design.

(2) Any such communication—

- (a) between a person and a professional designs representative; or

(1) Section 1B was inserted by [S.I. 2001/3949](#), regulation 2.
(2) Section 11ZA was inserted by [S.I. 2001/3949](#), regulation 7 and amended by [S.I. 2006/1974](#), article 7(2), [S.I. 2007/3378](#), regulation 2.
(3) Section 11ZB was inserted by [S.I. 2001/3949](#), regulation 7 and amended by [S.I. 2003/550](#), regulation 2(3)(a) and (b), [S.I. 2006/1974](#), article 8(2),(3),(4) and (5).
(4) Section 20 was amended by the Copyright, Designs and Patents Act 1988 (c.48), section 272, Schedule 3, paragraph 11, [S.I. 2001/3949](#), regulation 8(2),(3),(4), [S.I. 2003/550](#), regulation 2(4)(a) and (b) and [S.I. 2006/1974](#), article 10(2) and (3).
(5) Section 24D was inserted by [S.I. 2006/1028](#), Schedule 1, paragraph 3.
(6) Section 24G was inserted by [S.I. 2006/1028](#), Schedule 1, paragraph 3 and amended by [S.I. 2011/1043](#), article 6(1)(f).
(7) Section 25 was amended by the Copyright, Designs and Patents Act 1988 (c.48), section 272, Schedule 3, paragraph 14, [S.I. 2001/3949](#), Schedule 1, paragraph 8(2) and (3).

- (b) for the purposes of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a professional designs representative,

is privileged from, or in Scotland protected against, disclosure in legal proceedings in the same way as a communication between a person and a solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a solicitor.

(3) In subsection (2) “professional designs representative” means a person whose name appears on the special list of professional representatives for design matters maintained by the European Union Intellectual Property Office referred to in Article 78(4) of Council Regulation (EC) 6/2002 of 12th December 2001 on Community designs as it has effect in EU law.”.

9. In section 35ZA(8) (offence of unauthorised copying etc of design in course of business), omit subsection (7).

10. In section 44(9) (interpretation), in subsection (1), omit the definitions of “Community Design Regulation” and “registered Community design”.

PART 2

Amendments to the Copyright, Designs and Patents Act 1988

- 11.** The Copyright, Designs and Patents Act 1988(10) is amended as follows—
- (a) in section 217(11) (qualifying persons and qualifying countries), in subsection (3)—
- (i) in paragraph (b), at the end insert “or”;
 - (ii) omit paragraph (c) together with “or” at the end;
- (b) in section 220(12) (qualification by reference to first marketing), in subsection (1)(b)—
- (i) after “Kingdom” insert “or”;
 - (ii) omit “or another member State of the European Economic Community”.

PART 3

Amendments to the Design Right (Proceedings before the Comptroller) Rules 1989

12. The Design Right (Proceedings before the Comptroller) Rules 1989(13) are amended as follows.

13. In rule 22 (costs), in paragraph (2), omit “or another member State of the European Union”.

14. In rule 23 (service and translation of documents), in paragraph (1A), for “another”, substitute “an”.

(8) Section 35ZA was inserted by the Intellectual Property Act 2014 (c.18), section 13.

(9) Section 44 was amended by the Copyright, Designs and Patents Act 1988 (c.48), section 272, Schedule 3, paragraph 31(3), (4),(6),(7),(8),(9) and (10), S.I. 2001/3949, Schedule 2, paragraph 1, 14(2),(3) and (4), S.I. 2003/550, regulation 2(5), S.I. 2006/1229, article 3 and the Intellectual Property Act 2014 (c.18), section 10(6).

(10) 1988 c.48.

(11) Section 217 was amended by the Intellectual Property Act 2014 (c.18), section 3(1)(a),(b) and (2).

(12) Section 220 was amended by S.I. 2011/1043, article 4(1), Intellectual Property Act 2014 (c.18), section 2(2)(g) and 3(4)(a), (b),(c) and (d).

(13) S.I. 1989/1130 as amended by S.I. 2006/546 and S.I. 2011/1043; there are other amending instruments but none are relevant.

15. In Schedule 1 (forms) for “another”, each time it appears before “EEA state”, substitute “an”.

PART 4

Further amendments to the 1994 Act

16. The 1994 Act is further amended as follows.

17.—(1) Section 6(14) is amended as follows.

(2) Before subsection (1)(b) insert—

“(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B 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;”.

(3) At the end of subsection (2) insert “(taking account of subsection (2C))”.

(4) Before subsection (3) insert—

“(2B) 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 28, 29 or 33 of Schedule 2B and which if registered would be an earlier trade mark by virtue of subsection (1)(ab), subject to its being so registered.

(2C) Where an application for registration of a trade mark has been made pursuant to paragraph 25 of Schedule 2A or paragraph 28, 29 or 33 of Schedule 2B, subsection (1)(a) is to apply as if the date of application for registration of the trade mark were—

- (a) in the case of an application made pursuant to paragraph 25 of Schedule 2A, the relevant date referred to in paragraph 25(2) in respect of that application;
- (b) in the case of an application made pursuant to paragraph 28 of Schedule 2B, the relevant date referred to in paragraph 28(2) in respect of that application (taking account of paragraph 28(5));
- (c) in the case of an application made pursuant to paragraph 29 of Schedule 2B, the relevant date referred to in paragraph 29(2) in respect of that application (taking account of paragraph 29(4));
- (d) in the case of an application made pursuant to paragraph 33 of Schedule 2B, the relevant date referred to in paragraph 33(2) or (3) (as the case may be) in respect of that application (taking account of paragraph 33(4)).”

18. In section 53(15) omit ““international trade mark (EC)” means a trade mark which is entitled to protection in the European Union under that Protocol;”.

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

(2) Before the entry in the table for “Convention country” insert—

“comparable trade mark (IR)

Schedule 2B, paragraph 1(4)”

(3) Before the entry in the table for “date of filing” insert—

(14) 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](#), regulation 7.

(15) Section 53 was amended by [S.I. 2004/2332](#), regulation 5 and [S.I. 2011/1043](#), article 4(1).

“date of application (comparable trade mark (IR))	Schedule 2B, paragraph 1(10)(b)”
---	----------------------------------

(4) Before the entry in the table for “date of registration” insert—

“date of filing (comparable trade mark (IR))	Schedule 2B, paragraph 1(10)(a)”
--	----------------------------------

(5) Before the entry in the table for “defendant (in Scotland)” insert—

“date of registration (comparable trade mark (IR))	Schedule 2B, paragraph 1(6)”
--	------------------------------

(6) Omit the entry in the table for—

“international trade mark (EC)	Section 53”
--------------------------------	-------------
