

SCHEDULE 8

Other amendments to legislation

PART 4

Further amendments to the 1994 Act

16. The 1994 Act is further amended as follows.

17.—(1) Section 6(1) 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(2) 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)”

(1) 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.

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

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

“date of application (comparable trade mark (IR))	Schedule 2B, paragraph 1(10)(b)”
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(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)”
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(5) Before the entry in the table for “defendant (in Scotland)” insert—

“date of registration (comparable trade mark (IR))	Schedule 2B, paragraph 1(6)”
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(6) Omit the entry in the table for—

“international trade mark (EC)	Section 53”
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