

## SCHEDULE

### Amendments to the Trade Marks (Isle of Man) Order 2013

#### 12. For paragraph 13 substitute—

“13.—(1) Section 47 (grounds for invalidity of registration) is amended as follows.

(2) At the beginning of subsection (2) insert “Subject to subsections (2A) and (2G),”.

(3) After subsection (2) insert—

“(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date,
- (c) the use conditions are met.

(2B) The use conditions are met if—

- (a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—
  - (i) within the period of 5 years ending with the date of application for the declaration, and
  - (ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2DA) In relation to an international trade mark (EC), the reference in subsection (2A) (a) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

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(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));
- (b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);
- (c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).”.

(4) After subsection (5) insert—

“(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.”.

**13A.**—(1) Section 49 (collective marks) is amended as follows.

(2) For subsection (1) substitute—

“(1) A collective mark is a mark which is described as such when it is applied for and is capable of distinguishing the goods and services of members of the association which is the proprietor of the mark from those of other undertakings.

(1A) The following may be registered as the proprietor of a collective mark—

- (a) an association of manufacturers, producers, suppliers of services or traders which has the capacity in its own name to enter into contracts and to sue or be sued; and
- (b) a legal person governed by public law.”.

**13B.**—(1) Section 50 (certification marks) is amended as follows.

(2) In subsection (1) for “indicating” substitute “which is described as such when the mark is applied for and indicates”.

**13C.** In the heading of Part II and in the italic heading before section 51, for “Community” substitute “European Union”.

**13D.** For section 51 (meaning of “Community trade mark”) substitute—

#### **“51 Meaning of “European Union trade mark”**

In this Act—

“European Union trade mark” has the meaning given by Article 1(1) of the European Union Trade Mark Regulation; and

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“the European Union Trade Mark Regulation” means Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark<sup>(1)</sup>.”.

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(1) OJNo. L 154/1, 16.6.2017, p.1.