



# Patents, Designs and Marks Act 1986

## 1986 CHAPTER 39

An Act to amend the enactments relating to the registers of trade marks, designs and patents so as to enable them to be kept otherwise than in documentary form and so as to give the enactment due effect in relation to any portion of a register not kept in documentary form; to make amendments of the Trade Marks Act 1938 in relation to the use of the Royal Arms and other devices, emblems and titles and in relation to the protection of trade marks and service marks for whose protection application has been made overseas; to make other amendments of the Trade Marks Act 1938 in its application to service marks and amendments of other Acts in relation to such marks; and for connected purposes. [18th July 1986]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

### Commencement Information

II Act partly in force at Royal Assent see s. 4(6)(7).

## 1 Registers of trade marks, designs and patents—computerisation etc.

The amendments specified in Schedule 1 to this Act (which relate to computerisation of the registers there mentioned and to associated matters) shall have effect.

## 2 Service marks etc.

(1) In section 1 of the <sup>M1</sup>Trade Marks (Amendment) Act 1984—

(a) the following subsections shall be substituted for subsections (1) and (2)—

“(1) Subject to subsection (2) below, the Trade Marks Act 1938 shall have effect with respect to service marks as it has effect with respect to trade marks (references to goods having effect as references to services).

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- (2) The Act of 1938 shall have effect in relation to service marks as mentioned in Schedule 1 to this Act.”; and
- (b) the following subsection shall be substituted for subsection (7)—
- “(7) In this Act “service mark” means a mark (including a device, name, signature, word, letter, numeral, or any combination thereof) used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person.”.
- (2) Subject to any Order made after the passing of this Act by virtue of subsection (1) (a) of section 3 of the <sup>M2</sup>Northern Ireland Constitution Act 1973, service marks shall not be a transferred matter for the purposes of that Act but shall for the purposes of subsection (2) of that section be treated as specified in Schedule 3 to that Act.
- (3) The enactments mentioned in Schedule 2 to this Act shall have effect subject to the amendments there specified.

#### Marginal Citations

- M1** 1984 c. 19.  
**M2** 1973 c. 36.

### 3 Repeals.

- (1) The enactments mentioned in Part I of Schedule 3 to this Act are repealed to the extent specified in the third column of that Part of that Schedule in consequence of section 1 above and Schedule 1 to this Act.
- (2) The enactments mentioned in Part II of Schedule 3 to this Act are repealed to the extent specified in the third column of that Part of that Schedule in consequence of section 2 above and Schedule 2 to this Act.

### 4 Short title, extent and commencement.

- (1) This Act may be cited as the Patents, Designs and Marks Act 1986.
- (2) The amendment or repeal of any enactment by this Act has the same extent as that enactment.
- (3) Subject to subsection (2) above, this Act extends to Northern Ireland.
- (4) The following provisions of this Act shall extend to the Isle of Man, subject to any exceptions, adaptations or modifications contained in an Order made by Her Majesty in Council—
- (a) section 1 so far as it relates to paragraphs 1 and 2 of Schedule 1;
  - (b) section 2(1);
  - (c) section 2(3) so far as it relates to paragraphs 1(2)(e)(i) and (ii), 2(2)(b), 3 to 7 and 9 to 12 of Schedule 2;
  - (d) section 3(1) so far as it relates to the <sup>M3</sup>Trade Marks Act 1938;
  - (e) section 3(2); and

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- (f) this section.
- (5) Her Majesty may by Order in Council make provision for extending to the Isle of Man, with such exceptions, adaptations or modifications as may be specified in the Order, sections 1 and 3(1) above so far as they relate to the <sup>M4</sup>Registered Designs Act 1949 and the <sup>M5</sup>Patents Act 1977.
- (6) Section 1 above (with Schedule 1) and section 3 above, so far as it relates to Part I of Schedule 3, shall come into force on such day as the Secretary of State may by order made by statutory instrument appoint and different days may be appointed in pursuance of this subsection for different provisions or different purposes of the same provision.
- (7) Section 2 above (with Schedule 2) and section 3 above, so far as it relates to Part II of Schedule 3, shall come into force on the same day as the <sup>M6</sup>Trade Marks (Amendment) Act 1984; but anything done before their commencement which, if it had been done after it, would have constituted an application for the registration of a service mark shall be treated as if it had been done immediately after it.

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**Modifications etc. (not altering text)**

**C1** [S. 4\(6\)](#) power of appointment conferred by s. 4(6) fully exercised: [S.I. 1986/1273](#), 1274, 1988/1824

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**Marginal Citations**

**M3** [1938 c. 22.](#)  
**M4** [1949 c. 88.](#)  
**M5** [1977 c. 37.](#)  
**M6** [1984 c. 19.](#)

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## SCHEDULES

### SCHEDULE 1

Section 1.

#### COMPUTERISATION

#### *Trade Marks Act 1938 (c.22)*

- 1 The following section shall be substituted for section 1 of the Trade Marks Act 1938—

**“1 Register of trade marks etc.**

- (1) The Comptroller-General of Patents, Designs and Trade Marks (in this Act referred to as “the Registrar”) shall maintain the register of trade marks, in which shall be entered—
  - (a) all registered trade marks with the names and addresses of their proprietors;
  - (b) notifications of assignments and transmissions;
  - (c) the names and addresses of all registered users;
  - (d) disclaimers, conditions and limitations; and
  - (e) such other matters relating to registered trade marks as may be prescribed.
- (2) The register shall continue to be divided into two parts called respectively Part A and Part B.
- (3) The register need not be kept in documentary form.
- (4) Subject to any rules under this Act, the public shall have a right to inspect the register at the Patent Office at all convenient times.
- (5) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and the rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.
- (6) Application under subsection (5) above or rules made by virtue of that subsection shall be made in such manner as may be prescribed.
- (7) In relation to any portion of the register kept otherwise than in documentary form—
  - (a) the right of inspection conferred by subsection (4) above is a right to inspect the material on the register; and

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- (b) the right to a copy or extract conferred by subsection (5) above or the rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.
  - (8) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorised by this Act or rules to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence, and in Scotland shall be sufficient evidence, of the matters so certified.
  - (9) A copy of an entry in the register or an extract from the register which is supplied under subsection (5) above and purports to be a certified copy or certified extract shall, subject to subsection (10) below, be admitted in evidence without further proof and without production of any original; and in Scotland such evidence shall be sufficient evidence.
  - (10) In the application of this section to England and Wales nothing in it shall be taken as detracting from section 69 or 70 of the Police and Criminal Evidence Act 1984 or any provision made by virtue of either of them.
  - (11) In this section “certified copy” and “certified extract” mean a copy and extract certified by the Registrar and sealed with the seal of the Patent Office.”.
- 2 The words “name or address” shall be substituted for the words “name, address or description” in subsection (1)(a) and (b) and subsection (2) of section 34 of that Act (correction of register).

*Registered Designs Act 1949 (c.88)*

- 3 The following section shall be substituted for section 17 of the Registered Designs Act 1949—

**“17 Register of designs etc.**

- (1) The registrar shall maintain the register of designs, in which shall be entered—
  - (a) the names and addresses of proprietors of registered designs;
  - (b) notices of assignments and of transmissions of registered designs; and
  - (c) such other matters as may be prescribed or as the registrar may think fit.
- (2) No notice of any trust, whether express, implied or constructive, shall be entered in the register of designs, and the registrar shall not be affected by any such notice.
- (3) The register need not be kept in documentary form.
- (4) Subject to the provisions of this Act and to rules made by the Secretary of State under it, the public shall have a right to inspect the register at the Patent Office at all convenient times.

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- (5) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules made by the Secretary of State under this Act may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.
- (6) Applications under subsection (5) above or rules made by virtue of that subsection shall be made in such manner as may be prescribed.
- (7) In relation to any portion of the register kept otherwise than in documentary form—
- (a) the right of inspection conferred by subsection (4) above is a right to inspect the material on the register; and
  - (b) the right to a copy or extract conferred by subsection (5) above or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.
- (8) Subject to subsection (11) below, the register shall be prima facie evidence of anything required or authorised by this Act to be entered in it and in Scotland shall be sufficient evidence of any such thing.
- (9) A certificate purporting to be signed by the registrar and certifying that any entry which he is authorised by or under this Act to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence, and in Scotland shall be sufficient evidence, of the matters so certified.
- (10) Each of the following—
- (a) a copy of an entry in the register or an extract from the register which is supplied under subsection (5) above;
  - (b) a copy of any representation, specimen or document kept in the Patent Office or an extract from any such document,
- which purports to be a certified copy or certified extract shall, subject to subsection (11) below, be admitted in evidence without further proof and without production of any original; and in Scotland such evidence shall be sufficient evidence.
- (11) In the application of this section to England and Wales nothing in it shall be taken as detracting from section 69 or 70 of the Police and Criminal Evidence Act 1984 or any provision made by virtue of either of them.
- (12) In this section “certified copy” and “certified extract” mean a copy and extract certified by the registrar and sealed with the seal of the Patent Office.”.

*Patents Act 1977 (c.37)*

4      The following section shall be substituted for section 32 of the Patents Act 1977—

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### **“32 Register of patents etc.**

- (1) The comptroller shall maintain the register of patents, which shall comply with rules made by virtue of this section and shall be kept in accordance with such rules.
- (2) Without prejudice to any other provision of this Act or rules, rules may make provision with respect to the following matters, including provision imposing requirements as to any of those matters—
  - (a) the registration of patents and of published applications for patents;
  - (b) the registration of transactions, instruments or events affecting rights in or under patents and applications;
  - (c) the furnishing to the comptroller of any prescribed documents or description of documents in connection with any matter which is required to be registered;
  - (d) the correction of errors in the register and in any documents filed at the Patent Office in connection with registration; and
  - (e) the publication and advertisement of anything done under this Act or rules in relation to the register.
- (3) Notwithstanding anything in subsection (2)(b) above, no notice of any trust, whether express, implied or constructive, shall be entered in the register and the comptroller shall not be affected by any such notice.
- (4) The register need not be kept in documentary form.
- (5) Subject to rules, the public shall have a right to inspect the register at the Patent Office at all convenient times.
- (6) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.
- (7) Applications under subsection (6) above or rules made by virtue of that subsection shall be made in such manner as may be prescribed.
- (8) In relation to any portion of the register kept otherwise than in documentary form—
  - (a) the right of inspection conferred by subsection (5) above is a right to inspect the material on the register; and
  - (b) the right to a copy or extract conferred by subsection (6) above or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.
- (9) Subject to subsection (12) below, the register shall be prima facie evidence of anything required or authorised by this Act or rules to be registered and in Scotland shall be sufficient evidence of any such thing.
- (10) A certificate purporting to be signed by the comptroller and certifying that any entry which he is authorised by this Act or rules to make has or has not been made, or that any other thing which he is so authorised to do has or

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has not been done, shall be prima facie evidence, and in Scotland shall be sufficient evidence, of the matters so certified.

- (11) Each of the following, that is to say—
  - (a) a copy of an entry in the register or an extract from the register which is supplied under subsection (6) above;
  - (b) a copy of any document kept in the Patent Office or an extract from any such document, any specification of a patent or any application for a patent which has been published,
 which purports to be a certified copy or a certified extract shall, subject to subsection (12) below, be admitted in evidence without further proof and without production of any original; and in Scotland such evidence shall be sufficient evidence.
- (12) In the application of this section to England and Wales nothing in it shall be taken as detracting from section 69 or 70 of the Police and Criminal Evidence Act 1984 or any provision made by virtue of either of them.
- (13) In this section “certified copy” and “certified extract” mean a copy and extract certified by the comptroller and sealed with the seal of the Patent Office.
- (14) In this Act, except so far as the context otherwise requires—
  - “register”, as a noun, means the register of patents;
  - “register”, as a verb, means, in relation to any thing, to register or register particulars, or enter notice, of that thing in the register and, in relation to a person, means to enter his name in the register;
 and cognate expressions shall be construed accordingly.”.

SCHEDULE 2

Section 2

SERVICE MARKS ETC.

PART I

REFERENCES TO TRADE MARKS TO INCLUDE REFERENCES TO SERVICE MARKS

- 1 (1) Any reference to a trade mark in a provision to which this paragraph applies shall include a reference to a service mark and accordingly any reference to a registered trade mark includes a reference to a registered service mark.
- (2) The provisions to which this paragraph applies are—
  - (a) ..... F1
  - (b) in the <sup>M7</sup>Printer’s Imprint Act 1961, subsection (1) of section 1 (relaxation of requirements as to printer’s imprint etc.);
  - (c) ..... F2
  - (d) in the <sup>M8</sup>Tribunals and Inquiries Act 1971, paragraph 22 of Schedule 1 (tribunals under general supervision of Council on Tribunals);



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- (e) in the <sup>M9</sup>Patents Act 1977—
  - (i) subsection (2) of section 19 (general power to amend application for patent before grant);
  - (ii) subsection (4) of section 27 (general power to amend specification after grant of patent);
  - (iii) subsection (7) of section 123 (publication of reports of cases);
- (f) in the <sup>M10</sup>Unfair Contract Terms Act 1977, paragraph 1(c) of Schedule 1 (scope of sections 2 to 4 and 7 of Act);
- (g) in the <sup>M11</sup>State Immunity Act 1978, section 7 (liability of States as respects proceedings relating to intellectual property etc.);
- (h) the definition of “intellectual property” in subsection (5) of section 72 of the <sup>M12</sup>Supreme Court Act 1981, subsection (5) of section 15 of the <sup>M13</sup>Law Reform (Miscellaneous Provisions) (Scotland) Act 1985 and subsection (5) of section 94A of the <sup>M14</sup>Judicature (Northern Ireland) Act 1978 (all relating to the withdrawal of privilege against incrimination of self or spouse in certain proceedings);
- (i) in the Supreme Court Act 1981, paragraph 1 of Schedule 1 (causes and matters assigned to Chancery Division);
- (j) in the <sup>M15</sup>Civil Jurisdiction and Judgments Act 1982, paragraph 2 of Schedule 5 (proceedings excluded from Schedule 4 to that Act) and paragraphs 2(14) and 4(2) of Schedule 8 (rules as to jurisdiction in Scotland);
- (k) in the <sup>M16</sup>Companies Act 1985—
  - (i) ..... <sup>F3</sup>
  - [<sup>F4</sup>(ii) Part I of Schedule 4 and paragraphs 5(2)(d) and 10(1)(b) and (2) of Schedule 9 (form of company balance sheets); and]
- [<sup>F5</sup>(l) in the Companies (Northern Ireland) Order 1986—
  - (i) paragraph (1)(j) of Article 403 (charges which have to be registered); and
  - (ii) Part I of Schedule 4 and paragraphs 5(2)(d) and 10(1)(b) and (2) of Schedule 9 (form of company balance sheets).]

#### Textual Amendments

- F1** Sch. 2 para. 1(2)(a) repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 303(2), **Sch. 8**
- F2** Sch. 2 para. 1(2)(c) repealed by [Income and Corporation Taxes Act 1988 \(c. 1, SIF 63:1\)](#), s. 844(3)(4)(5)(6), Sch. 30 para. 6(1), **Sch. 31**
- F3** Words repealed by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 303(2), **Sch. 8**
- F4** Sch. 2 para. 1(2)(ii) substituted by [Companies Act 1989 \(c. 40, SIF 27\)](#), s. 23, **Sch. 10 para. 34**
- F5** Sch. 2 para. 1(2)(l) substituted by [S.I. 1990/593 \(NI 5\)](#), art. 25, Sch. 10 Pt. II para. 28

#### Marginal Citations

- M7** 1961 c. 31.
- M8** 1971 c. 62.
- M9** 1977 c. 37.
- M10** 1977 c. 50.
- M11** 1978 c. 33.
- M12** 1981 c. 54.
- M13** 1985 c. 72.

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- M14** 1978 c. 23.  
**M15** 1982 c. 27.  
**M16** 1985 c. 6.

## PART II

### REFERENCES TO 1938 ACT TO INCLUDE REFERENCES TO ACT AS EXTENDED

- 2 (1) Any reference to the <sup>M17</sup>Trade Marks Act 1938 in a provision to which this paragraph applies shall include a reference to that Act as it has effect by virtue of section 1 of the <sup>M18</sup>Trade Marks (Amendment) Act 1984.
- (2) The provisions to which this paragraph applies are—
- (a) in the <sup>M19</sup>Patents and Designs Act 1907, subsection (1) of section 62 (Patent Office) and subsection (2) of section 63 (officers and clerks);
  - (b) in the <sup>M20</sup>Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939, subsection (1)(c) of section 4 (effect of war on registration), subsection (1) of section 6 (power to extend time limits), subsection (1) of section 7 (evidence) and subsection (1) of section 10 (interpretation); and
  - (c) the entry relating to a person appointed to hear and decide appeals under the Trade Marks Act 1938 in Part III of Schedule 1 to the <sup>M21</sup>House of Commons Disqualification Act 1975 (other disqualifying offices).

#### Marginal Citations

- M17** 1938 c. 22.  
**M18** 1984 c. 19.  
**M19** 1907 c. 29.  
**M20** 1939 c. 107.  
**M21** 1975 c. 24.

## PART III

### OTHER AMENDMENTS

#### *Trade Marks Act 1938 (c.22)*

- 3 In subsection (1) of section 19 of the Trade Marks Act 1938 (registration) after the word “registered”, in the second place where it occurs, there shall be inserted the words “, subject to section 39A(2) below,”.
- 4 In the proviso to subsection (1) of section 26 of that Act (removal from register and imposition of limitations on ground of non-use) for the words after “bona fide use” there shall be substituted the words “of the mark by the proprietor thereof for the time being in relation to—

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- (i) goods of the same description; or
- (ii) services associated with those goods or goods of that description,

being goods or, as the case may be, services in respect of which the mark is registered.”.

5 The following section shall be inserted after section 39 of that Act—

**“39A Registration of trade mark following overseas application.**

- (1) Any person who has applied for protection for any trade mark in a relevant country or his legal representative or assignee shall be entitled on an application for registration made within six months of the application for protection in the relevant country to registration of his mark under this Act in priority to other applicants.
- (2) A mark registered on an application made under this section shall be registered as of the date of the application in the relevant country and that date shall be deemed for the purposes of this Act to be the date of registration.
- (3) Nothing in this section shall entitle the proprietor of the mark to recover damages for infringements happening prior to the date of the application for registration under this Act.
- (4) The registration of a mark under this section shall not be invalidated by reason only of the use of the mark in the United Kingdom during the period of 6 months within which the application may be made.
- (5) The application for the registration of a mark under this section must be made in the same manner as an ordinary application under this Act.
- (6) Where a person has applied for protection for any mark by an application which—
  - (a) in accordance with the terms of a treaty subsisting between any two or more relevant countries, is equivalent to an application duly made in any one of those countries; or
  - (b) in accordance with the law of any relevant country, is equivalent to an application duly made in that country,he shall be deemed for the purposes of this section to have applied in that country.
- (7) Subject to subsection (8) below, Her Majesty may by Order in Council direct that this section shall apply to a country specified in the Order.
- (8) If a country is not a dependent territory, an Order in Council under this section may only be made in relation to it with a view to the fulfilment of a treaty, convention, arrangement or engagement.
- (9) An Order in Council under this section shall be subject to annulment in pursuance of a resolution of either House of Parliament and may be varied or revoked by a subsequent Order.
- (10) In this section—
  - “country” includes any territory;

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“dependent territory” means any of the Channel Islands or a colony;

“relevant country” means a country which was specified in an Order in Council under this section at the time of the application under this section or such other time as may be specified in the Order in Council.”.

- 6 In section 61 of that Act (restraint of use of Royal Arms etc.) for the words “or supplies goods to” there shall be substituted the words “supplies goods to or provides services for”.

*Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 (c.107)*

- 7 The Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 shall have effect with respect to service marks as it has effect with respect to trade marks, except that in the application of that Act to service marks it shall have effect as if the following section were substituted for section 3 (power of comptroller to suspend trade mark rights of an enemy or an enemy subject)—

**“3 Power of comptroller to suspend service mark rights of an enemy or an enemy subject.**

- (1) Where it is made to appear to the comptroller that it is difficult or impracticable to describe or refer to some activity without the use of a service mark registered in respect of that activity, being a service mark which is registered in the name of an enemy or an enemy subject, whether alone or jointly with another, or which is, or has at any such time as aforesaid been, in the proprietorship of an enemy or an enemy subject, whether alone or jointly with another, the following provisions of this section shall have effect.
- (2) On the application of any person who proposes to provide in the course of business in the United Kingdom or the Isle of Man services including an activity which is or is intended to be the same as or equivalent to or a substitute for the activity in respect of which the service mark is registered, the comptroller may order that the right to the use of the service mark given by the registration thereof shall be suspended—
  - (a) so far as regards use thereof by the applicant and any such use thereof by any other person in relation to services connected in the course of business with the applicant as would not be an infringement of the said right if the applicant were the proprietor of the service mark,
  - (b) to such extent and for such period as the comptroller may consider necessary for enabling the applicant to render well-known and established some description of, or means of reference to, the activity which he proposes to carry on in the course of business, being a description or means of reference which does not involve the use of the service mark.
- (3) Where an order has been made under the last foregoing subsection, no action for passing off shall lie on the part of any person interested in the service

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mark in respect of any use thereof which, by virtue of the order, is not an infringement of the right to the use thereof given by the registration thereof.

- (4) An order under this section may be varied or revoked by a subsequent order made by the comptroller.”.

*Restrictive Trade Practices Act 1976 (c.34)*

8 In paragraph 4(2) of Schedule 3 to the Restrictive Trade Practices Act 1976 (excepted agreements—trade marks)—

- (a) in paragraph (a) after “certification trade mark)” there shall be inserted “or of a service mark”; and
- (b) in paragraph (b)—
- (i) after “6(1)” there shall be inserted “or 11(2)”;
  - (ii) after “7(1)” there shall be inserted “or 12(2)”;
  - (iii) after “is to be applied” there shall be inserted “or
  - (iii) the kinds of services in relation to which the mark is to be used which are to be made available or supplied; or
  - (iv) the form or manner in which services in relation to which the mark is used are to be made available or supplied; or
  - (v) the descriptions of goods which are to be produced or supplied in connection with the supply of services in relation to which the mark is to be used; or
  - (vi) the process of manufacture to be applied to goods which are to be produced or supplied in connection with the supply of services in relation to which the mark is to be used.”.

*Trade Marks (Amendment) Act 1984 (c.19)*

9 The following subsection shall be inserted after section 2(3) of the Trade Marks (Amendment) Act 1984 (extent)—

- “(4) This Act shall extend to the Isle of Man subject to any exceptions, adaptations or modifications contained in an Order made by Her Majesty in Council.”.

10 In paragraph 14(2)(b) of Schedule 1 to that Act (modifications of <sup>M22</sup>Trade Marks Act 1938 in application to service marks) for the words from “the words”, in the first place where that phrase occurs, to “in relation to” there shall be substituted the words “paragraphs (i) and (ii) and the words following them there shall be substituted—”

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**Marginal Citations**

M22 1938 c. 22.

11 After paragraph 18 of that Schedule there shall be inserted—

**Section 38**

“18A Section 38 and Schedule 2 (Sheffield marks) shall be omitted.

**Section 39**

18B Section 39 (trade marks for textile goods) shall be omitted.

**Section 39A**

18C In section 39A (registration of trade marks following overseas application)—

- (a) in subsection (2), for the word “A” there shall be substituted the words “Subject to subsection (2A) below, a”;
- (b) the following subsection shall be inserted after that subsection—  
 “(2A) Where an application for protection for a service mark was made in a relevant country before the date on which the Trade Marks (Amendment) Act 1984 came into force, a service mark registered on an application under this section shall be registered as of that date.”;
- (c) the following subsection shall be substituted for subsection (8)

—  
 “(8) If a country is not a dependent territory, an Order in Council under this section may only be made in relation to it—”

“(a) with a view to the fulfilment of a treaty, convention, arrangement or engagement; or”

“(b) if Her Majesty is satisfied that provision has been or will be made under the laws of that country whereby priority for the protection of service marks in respect of which application for registration under this Act has been made will be given on a basis comparable to that for which provision is made by this section in relation to applications for registration made in a relevant country.””.

12 <sup>M23</sup>In paragraph 25(3) of Schedule 1 to that Act (modification of Trades Marks Act 1938 in application to service marks) after the last word “services” there shall be inserted the words “or otherwise in relation to services”.

**Marginal Citations**

M23 1938 c. 22.

*Status: Point in time view as at 01/02/1991.*

*Changes to legislation: There are currently no known outstanding effects for the Patents, Designs and Marks Act 1986. (See end of Document for details)*

## SCHEDULE 3

Section 3.

### REPEALS

#### PART I

##### REPEALS CONSEQUENTIAL ON SECTION 1 AND SCHEDULE 1

Chapter	Short title	Extent of repeal
1 & 2 Geo. 6 c. 22.	Trade Marks Act 1938.	Sections 57 and 58.
12, 13 & 14 Geo. 6 c. 88.	Registered Designs Act 1949.	Section 24.
1977 c. 37.	Patents Acts 1977.	Section 35.

#### PART II

##### REPEALS CONSEQUENTIAL ON SECTION 2 AND SCHEDULE 2

Chapter	Short title	Extent of repeal
7 Edw. 7 c. 29.	Patents and Designs Act 1907.	Sections 88, 91 and 91A.
4 & 5 Geo. 5 c. 18.	Patents and Designs Act 1914.	The whole Act.
18 & 19 Geo. 5 c. 3.	Patents and Designs (Convention) Act 1928.	The whole Act.
1 & 2 Geo. 6. c. 22.	Trade Marks Act 1938.	In section 19(1), the proviso.
1 & 2 Geo. 6. c. 29.	Patents &c. (International Conventions) Act 1938.	The whole Act.
12, 13 & 14 Geo. 6 c. 62.	Patents and Designs Act 1949.	The whole Act.
1984 c. 19.	Trade Marks (Amendment) Act 1984.	Section 1(3).  In section 2(3), the words “and the Isle of Man”.  In Schedule 1, paragraphs 1 and 21.  In Schedule 2, paragraph 5 and the heading preceding it.

**Status:**

Point in time view as at 01/02/1991.

**Changes to legislation:**

There are currently no known outstanding effects for the Patents, Designs and Marks Act 1986.