

SCHEDULES

SCHEDULE 2

SERVICE MARKS ETC.

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—

(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.

Status: This is the original version (as it was originally enacted).

- (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 ;
 - "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.

Status: This is the original version (as it was originally enacted).

- (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 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.".”.

Status: This is the original version (as it was originally enacted).

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)(6) of Schedule 1 to that Act (modifications of 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— ".

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 In paragraph 25(3) of Schedule 1 to that Act (modification of Trade 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 ".