



Trade Marks Act 1938

1938 CHAPTER 22 1 and 2 Geo 6

An Act to consolidate the Trade Marks Act 1905, the Trade Marks Act 1919, and the Trade Marks (Amendment) Act 1937. [13th April 1938.]

Extent Information

E1 Act does not extend to Channel Islands and Colonies.

Modifications etc. (not altering text)

- C1** Act amended by [Patents, Designs, Copyright and Trade Marks \(Emergency\) Act 1939](#) (c.107, SIF 129:3), [ss. 4, 6](#)
- C2** Act modified by [S.I. 1986/1319](#), [rules 23\(2\)](#), 78
- C3** Act extended with modifications by [Trade Marks \(Amendment\) Act 1984](#) (c.19, SIF 91), s. 1, [Sch.1](#) and [S.I. 1986/1319](#), [rules 76\(3\)](#), 78, 129(1)
- C4** Act restricted by [S.I. 1986/1319](#), [rule 129\(1\)](#)
- C5** Functions of Board of Trade now exercisable concurrently by Secretary of State: [S.I. 1970/1537](#), [art. 2\(1\)\(a\)](#)

Commencement Information

I1 Act not force at Royal Assent. Act wholly in force at 27.7.1938 see [s. 71\(2\)](#).

REGISTRATION, INFRINGEMENT AND OTHER SUBSTANTIVE PROVISIONS

The register

[^{F1}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—
- all registered trade marks with the names and addresses of their proprietors;
 - notificatons of assignments and transmissions;
 - the names and addresses of all registered users;

Status: Point in time view as at 21/08/1991.

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- (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) 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 sub-section (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 ^{M1}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.]

Textual Amendments

F1 S. 1 substituted by Patents, Designs and Marks Act 1986 (c. 39, SIF 91), s. 1, Sch. 1 para. 1

Marginal Citations

M1 1984 c. 60(95).

Status: Point in time view as at 21/08/1991.

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Effect of registration and the action for infringement

2 No action for infringement of unregistered trade mark.

No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off . . . ^{F2} or the remedies in respect thereof.

Textual Amendments

F2 Words repealed by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(5)(a)

3 Registration to be in respect of particular goods.

A trade mark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be determined by the Registrar, whose decision shall be final.

4 Right given by registration in Part A, and infringement thereof.

- (1) Subject to the provisions of this section, and of sections seven and eight of this Act, the registration (whether before or after the commencement of this Act) of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses [^{F3}in the course of trade a mark identical with or nearly resembling it,], in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—
 - (a) as being use as a trade mark; or
 - (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.
- (2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.
- (3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—
 - (a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated

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it, or has at any time expressly or impliedly consented to the use of the trade mark; or

- (b) In relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.
- (4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

Textual Amendments

F3 Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 1](#)

5 Right given by registration in Part B, and infringement thereof.

- (1) Except as provided by subsection (2) of this section, the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and the provisions of the last foregoing section shall have effect in like manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.
- (2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of the next succeeding section, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

6 Infringement by breach of certain restrictions.

- (1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.
- (2) The acts to which this section applies are—

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- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
 - (b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;
 - (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
 - (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;
 - (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.
- (3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and the expression “upon” includes in relation to any goods a reference to physical relation thereto.

7 Saving for vested rights.

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

- (a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his;

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section twelve of this Act.

8 Saving for use of name, address, or description of goods.

No registration of a trade mark shall interfere with—

- (a) any bona fide use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or
- (b) the use by any person of any bona fide description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in paragraph (b) of subsection (1) of section four, or in paragraph (b) of subsection (3) of section thirty-seven, of this Act.

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Registrability and validity of registration

9 Distinctiveness requisite for registration in Part A.

- (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:—
 - (a) the name of a company, individual, or firm, represented in a special or particular manner;
 - (b) the signature of the applicant for registration or some predecessor in his business;
 - (c) an invented word or invented words;
 - (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
 - (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.
- (2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
- (3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which—
 - (a) the trade mark is inherently adapted to distinguish as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10 Capability of distinguishing requisite for registration in Part B.

- (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
- (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which—
 - (a) the trade mark is inherently capable of distinguishing as aforesaid; and
 - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.
- (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

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11 Prohibition of registration of deceptive, &c., matter.

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

12 Prohibition of registration of identical and resembling trade marks.

- (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with [^{F4}or nearly resembles a mark belonging to a different proprietor and already on the register in respect of—
- (a) the same goods,
 - (b) the same description of goods, or
 - (c) services or a description of services which are associated with those goods or goods of that description.]
- (2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration [^{F5}by more than one proprietor, in respect of—
- (a) the same goods,
 - (b) the same description of goods, or
 - (c) goods and services or descriptions of goods and services which are associated with each other,
- of marks that are identical or nearly resemble each other,] subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.
- (3) Where separate applications are made by different persons to be registered as proprietors respectively of [^{F6}marks that are identical or nearly resemble each other, in respect of—
- (a) the same goods,
 - (b) the same description of goods, or
 - (c) goods and services or descriptions of goods and services which are associated with each other,], the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be.

Textual Amendments

F4 Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 2\(2\)](#)

F5 Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 2\(3\)](#)

F6 Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 2\(4\)](#)

13 Registration in Part A to be conclusive as to validity after seven years.

- (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section thirty-two of this Act) the original registration in

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Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—

- (a) that registration was obtained by fraud, or
- (b) the trade mark offends against the provisions of section eleven of this Act.

- (2) Nothing in subsection (1) of section five of this Act shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

14 Registration subject to disclaimer.

If a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character;

the Registrar or the Board of Trade or the Court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register,—

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the tribunal holds him not to be entitled; or
- (ii) that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

15 Words used as name or description of an article or substance.

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance:

Provided that, if it is proved either—

- (a) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent (being a patent in force on, or granted after, the twenty-third day of December nineteen hundred and nineteen), that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance; the provisions of the next succeeding subsection shall have effect.

- (2) Where the facts mentioned in paragraph (a) or (b) of the proviso to the foregoing subsection are proved with respect to any word or words, then—

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- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section thirty-two of this Act to be an entry wrongly remaining on the register;
 - (b) if the trade mark contains that word or those words and other matter, the Court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
 - (c) for the purposes of any other legal proceedings relating to the trade mark,—
 - (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description, or
 - (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of the proviso to the foregoing subsection first became well known and established, or at the expiration of the period of two years mentioned in paragraph (b) of that proviso.
- (3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section thirteen of this Act, be deemed for the purposes of section thirty-two of this Act to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require: Provided that the foregoing provisions of this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

16 Effect of limitation as to colour, and of absence thereof.

A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark.

If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

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Procedure for, and duration of, registration

17 Application for registration.

- (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.
- (2) Subject to the provisions of this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.
- (3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.
- (4) In the case of a refusal or conditional acceptance, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.
- (5) An appeal under this section shall be made in the prescribed manner, and on the appeal the tribunal shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.
- (6) Appeals under this section shall be heard on the materials stated as aforesaid by the Registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated as aforesaid by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.
- (7) The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Registrar or the Board of Trade or the Court, as the case may be, may think fit.

18 Opposition to registration.

- (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:
Provided that the Registrar may cause an application to be advertised before acceptance if it is made under paragraph (e) of subsection (1) of section nine of this Act, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may, if he thinks fit, advertise it again when it has been accepted but shall not be bound so to do.
- (2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

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- (3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.
- (4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.
- (5) If the applicant sends such a counter-statement as aforesaid, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.
- (6) The decision of the Registrar shall be subject to appeal to the Court.
- (7) [^{F7}An appeal under this section shall be made in the prescribed manner, and on the appeal the Court][^{F7}On an appeal under this section, the Court] shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.
- (8) On the hearing of an appeal under this section any party may, either in the manner prescribed [^{F8}by rules of court made for the purposes of this subsection under section 55 of the ^{M2}Judicature (Northern Ireland) Act 1978] or by special leave of the Court, bring forward further material for the consideration of the Court.
- (9) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those so stated as aforesaid by the opponent, except by leave of the Court. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.
- (10) On an appeal under this section the Court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.
- (11) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in the United Kingdom, the tribunal may require him to give security for costs of the proceedings before the tribunal relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

Textual Amendments

F7 Words “On” to the “Court” substituted (N.I.) for words “An appeal” to “the Court” by [Judicature \(Northern Ireland\) Act 1978 \(c. 23, SIF 38\)](#), [Sch. 5 Pt. II](#)

F8 Words inserted (N.I.) with saving for rules of court made under [Northern Ireland Act 1962 \(c. 30, SIF 29:1\)](#), [s. 7](#) by [Judicature \(Northern Ireland\) Act 1978 \(c. 23, SIF 38\)](#), [Sch. 5 Pt. II](#), [Sch. 6 para. 3](#)

Marginal Citations

M2 [1978 c. 23\(38\)](#).

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

19 Registration.

- (1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either—
 - (a) the application has not been opposed and the time for notice of opposition has expired, or
 - (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error or unless the Board of Trade otherwise direct, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered [^{F9}, subject to section 39A(2) below,] as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration: . . . ^{F10}
- (2) On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the seal of the Patent Office.
- (3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

Textual Amendments

F9 Words inserted by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 91\)](#), s. 2, [Sch. 2 Pt. III para. 3](#)

F10 Proviso repealed by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 91\)](#), s. 3, [Sch. 3 Pt. II](#)

20 Duration and renewal of registration.

- (1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with the provisions of this section:
Provided that, in relation to a registration as of a date before the appointed day, this subsection shall have effect with the substitution of a period of fourteen years for the said period of seven years.
- (2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as “the expiration of the last registration.”
- (3) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.
- (4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration

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of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register:

Provided that the foregoing provisions of this subsection shall not have effect where the tribunal is satisfied either—

- (a) that there has been no bona fide trade use of the trade mark that has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

Modifications etc. (not altering text)

C6 S. 20 modified by S.I. 1986/1319, rule 8(2)

21 Registration of parts of trade marks and of trade marks as a series.

- (1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to the provisions of subsection (3) of section twenty-three and subsection (2) of section thirty of this Act, have all the incidents of an independent trade mark.

- (2) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—
 - (a) statement of the goods in relation to which they are respectively used or proposed to be used; or
 - (b) statements of number, price quality or names of places; or
 - (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
 - (d) colour

seeks to register those trade marks, they may be registered as a series in one registration.

Assignment and transmission

22 Powers of, and restrictions on, assignment and transmission.

- (1) Notwithstanding any rule of law or equity to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.
- (2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.
- (3) The provisions of the two foregoing subsections shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case

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of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

- (4) Notwithstanding anything in the foregoing subsections, a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to
- [^{F11}(a) the same goods,
 - (b) the same description of goods, or
 - (c) goods and services or descriptions of goods and services which are associated with each other],

of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods [^{F12}or the association of the goods and services or description of goods and services and to the similarity of the trade marks], the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that, where a trade mark is, or has been, assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within the United Kingdom (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside the United Kingdom.

- (5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of [^{F13}the goods or the association of the goods and services or descriptions of goods and services and to the similarity] of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under the last foregoing subsection, and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under the last foregoing subsection of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section twenty-five of this Act of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.
- (6) Notwithstanding anything in subsections (1) to (3) of this section, a trade mark shall not, on or after the appointed day, be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration,

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- (a) [^{F14}an exclusive right in one of the persons concerned to the use of the mark limited to use in relation to goods to be sold, or otherwise traded in, in a place or places in the United Kingdom; and
- (b) an exclusive right in another of the persons concerned to the use of a mark identical with or nearly resembling the mark referred to in paragraph (a) above in relation to—
 - (i) the same goods,
 - (ii) the same description of goods or
 - (iii) services which are associated with those goods or goods of that description,

limited to use in relation to goods to be sold, or otherwise traded in, or services for use or available for acceptance, in another place or places in the United Kingdom;] Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his on or after the appointed day, in any such case, the Registrar, if he is satisfied that in all the circumstances the use of the trade marks in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4) of this section, so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section twenty-five of this Act of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

- (7) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the appointed day, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Registrar may direct.

- (8) Any decision of the Registrar under this section shall be subject to appeal to the Court.

Textual Amendments

- F11** Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 3\(2\)\(a\)](#)
- F12** Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 3\(2\)\(b\)](#)
- F13** Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 3\(3\)](#)
- F14** Words substituted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), s. 1(4), [Sch. 2 para. 3\(4\)](#)

23 Certain trade marks to be associated so as to be assignable and transmissible as a whole only.

- (1) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall be assignable and transmissible only as a whole and not

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separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

- (2) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

Any decision of the Registrar under this subsection shall be subject to appeal to the Board of Trade, or to the Court, at the option of the appellant.

[^{F15}(2A) Where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration, in the name of the same proprietor in respect of goods and in respect of services which are associated with those goods or goods of that description, subsection (2) applies as it applies where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration, in the name of the same proprietor in respect of the same goods or description of goods.]

- (3) Where a trade mark and any part or parts thereof are, by virtue of subsection (1) of section twenty-one of this Act, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be registered as, associated trade marks.
- (4) All trade marks that are, by virtue of subsection (2) of section twenty-one of this Act, registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.
- (5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

Any decision of the Registrar under this subsection shall be subject to appeal to the Board of Trade, or to the Court, at the option of the appellant.

Textual Amendments

F15 S. 23(2A) inserted by Trade Marks (Amendment) Act 1984 (c. 19, SIF 91), s. 1(4), **Sch. 2 para. 4**

Modifications etc. (not altering text)

C7 S. 23 excluded (31.10.1994) by 1994 c. 26, s. 105, **Sch. 3 para. 10(3)**; S.I. 1994/2550, **art. 2**

24 Power of registered proprietor to assign and give receipts.

Subject to the provisions of this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

25 Registration of assignments and transmissions.

- (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.
- (2) Any decision of the Registrar under this section shall be subject to appeal to the Court.
- (3) Except for the purposes of an appeal under this section or of an application under section thirty-two of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) of this section shall not be admitted in evidence in any court in proof of the title to a trade mark unless the court otherwise directs.

Use and non-use

26 Removal from register and imposition of limitations on ground of non-use.

- (1) Subject to the provisions of the next succeeding section, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, on the ground either—
 - (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or
 - (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being:

Provided that (except where the applicant has been permitted under subsection (2) of section twelve of this Act to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark) the tribunal may refuse an application made under paragraph (a) or (b) of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use ^{[^{F16}}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.]
- (2) Where in relation to any goods in respect of which a trade mark is registered—
 - (a) the matters referred to in paragraph (b) of the foregoing subsection are shown so far as regards non-use of the trade mark in relation to goods to be sold, or

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otherwise traded in, in a particular place in the United Kingdom (otherwise than for export from the United Kingdom), or in relation to goods to be exported to a particular market outside the United Kingdom; and

- (b) a person has been permitted under subsection (2) of section twelve of this Act to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from the United Kingdom), or in relation to goods to be exported to that market, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark;

on application by that person to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as the tribunal thinks proper for securing that that registration shall cease to extend to such use as last aforesaid.

- (3) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (2), of this section on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

Textual Amendments

F16 Words substituted by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 91\)](#), s. 3, [Sch. 2 Pt. III para. 4](#)

27 Defensive registration of well known trade marks.

- (1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in the last foregoing section, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under the last foregoing section.
- (2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.
- (3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective

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registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

- (4) On application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.
- (5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.
- (6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

28 Registered users.

- (1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions.

The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the “permitted use” thereof.

- (2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section twenty-six of this Act and for any other purpose for which such use is material under this Act or at common law.
- (3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

- (4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Registrar in the prescribed manner and must furnish him with a statutory declaration made by the proprietor, or by some person authorised to act on his behalf and approved by the Registrar,—

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- (a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
- (b) stating the goods in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof;

and with such further documents, information or evidence as may be required under the rules or by the Registrar.

- (5) When the requirements of the last foregoing subsection have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject as aforesaid.
- (6) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.
- (7) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the register) is not disclosed to rivals in trade.
- (8) Without prejudice to the provisions of section thirty-two of this Act, the registration of a person as a registered user—
 - (a) may be varied by the Registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;
 - (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
 - (c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say,—
 - (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;
 - (ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;

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- (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.
- (9) Provision shall be made by the rules for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under the last foregoing subsection to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.
- (10) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.
- (11) Any decision of the Registrar under the foregoing provisions of this section shall be subject to appeal to the Court.
- (12) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

29 Proposed use of trade mark by corporation to be constituted, &c.

- (1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark,—
- (a) if the tribunal is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the tribunal is satisfied that the proprietor intends it to be used by that person in relation to those goods and the tribunal is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.
- (2) The provisions of section twenty-six of this Act shall have effect, in relation to a trade mark registered under the power conferred by the foregoing subsection, as if for the reference, in paragraph (a) of subsection (1) of that section, to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.
- (3) The tribunal may, as a condition of the exercise of the power conferred by subsection (1) of this section in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the tribunal relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.
- (4) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) of this section in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation

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has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

Modifications etc. (not altering text)

C8 S. 29(4) amended by S.I. 1986/1319, rule 76(3)

30 Use of one of associated or substantially identical trade marks equivalent to use of another.

- (1) Where under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as the tribunal thinks right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.
- (2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of subsection (1) of section twenty-one of this Act.

31 Use of trade mark for export trade.

The application in the United Kingdom of a trade mark to goods to be exported from the United Kingdom, and any other act done in the United Kingdom in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within the United Kingdom, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

Rectification and correction of the register

32 General power to rectify entries in register.

- (1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, [^{F17}may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar,][^{F17}may apply to the Court or, at the option of the applicant and subject to the provisions of section 54 of this Act, in the prescribed manner to the Registrar,] and the tribunal may make such order for making, expunging or varying the entry as the tribunal may think fit.
- (2) The tribunal may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.
- (3) In case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.
- (5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

Textual Amendments

F17 Words “may apply to the Court” to “the Registrar” substituted (N.I.) for words “may apply in the prescribed manner” to “the Registrar” by [Judicature \(Northern Ireland\) Act 1978 \(c. 23, SIF 38\)](#), [Sch. 5 Pt. II](#).

33 Power to expunge or vary registration for breach of condition.

On application by any person aggrieved to the Court, or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, or on application by the Registrar to the Court, the tribunal may make such order as the tribunal may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

34 Correction of register.

- (1) The Registrar may, on request made in the prescribed manner by the registered proprietor,—
 - (a) correct any error in the [^{F18}name or address] of the registered proprietor of a trade mark;
 - (b) enter any change in the [^{F18}name or address] of the person who is registered as proprietor of a trade mark;
 - (c) cancel the entry of a trade mark on the register;
 - (d) strike out any goods or classes of goods from those in respect of which a trade mark is registered; or
 - (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.
- (2) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the [^{F18}name or address] of the registered user.
- (3) Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade, or to the Court, at the option of the appellant.

Textual Amendments

F18 Words substituted by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 91\)](#), s. 1, [Sch. 1 para. 2](#)

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

35 Alteration of registered trade mark.

- (1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.
- (2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.
- (3) Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade, or to the Court, at the option of the appellant.
- (4) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2) of this section.

36 Adaptation of entries in register to amended or substituted classification of goods.

- (1) The Board of Trade may from time to time make such rules, prescribe such forms and generally do such things as they think expedient, for empowering the Registrar to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.
- (2) The Registrar shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of any goods
Provided that this subsection shall not have effect in relation to goods as to which the Registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.
- (3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of the trade mark affected, shall be subject to appeal by the registered proprietor to the Board of Trade, or at his option to the Court, shall be advertised with any modifications, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of the last foregoing subsection, and the decision of the Registrar on any such opposition shall be subject to appeal to the Court.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Certification trade marks

37 Certification trade marks.

- (1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person:
Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.
- (2) In determining whether a mark is adapted to distinguish as aforesaid, the tribunal may have regard to the extent to which—
 - (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods in question; and
 - (b) by reason of the use of the mark or any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods in question.
- (3) Subject to the provisions of subsections (4) to (6) of this section, and of sections seven and eight of this Act, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorised by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—
 - (a) as being use as a trade mark; or
 - (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorisation under the relevant regulations to use the trade mark or to goods certified by the proprietor.
- (4) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.
- (5) The right to the use of a certification trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—
 - (a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that paragraph (a) of this subsection shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

- (6) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.
- (7) There shall be deposited at the Patent Office in respect of every trade mark registered under this section regulations approved by the Board of Trade for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the trade mark, and may contain any other provisions that the Board of Trade may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the trade mark in accordance with the regulations). Regulations so deposited shall be open to inspection in like manner as the register.
- (8) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Board of Trade.
- (9) The provisions of the First Schedule to this Act shall have effect with respect to the registration of a mark under this section and to marks so registered.

Sheffield marks

38 Sheffield marks.

The provisions of the Second Schedule to this Act shall have effect with respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called “the Cutlers’ Company”), and the marks or devices assigned or registered by the master, wardens, searchers and assistants of that Company.

Manchester Branch

39 Trade marks for textile goods.

- (1) The Manchester Branch of the Trade Marks Registry of the Patent Office (in this section referred to as “the Manchester Branch”) shall be continued under a chief officer, who shall be styled “the Keeper of the Manchester Branch” and shall act under the direction of the Registrar.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (2) The rules shall specify certain of the classes for the time being established for the purposes of the registration of trade marks (being such of those classes as consist of, or appear to the Board of Trade to relate materially to, any of the following goods, that is to say, goods included immediately before the appointed day in any of the classes numbered twenty-three to thirty-five and thirty-eight respectively and similar goods made from artificial silk or from other artificial fibres) as being classes to which this section applies.

In this section the expression “textile goods” means goods of any of the classes for the time being so specified other than goods of a kind as to which it may be provided by the rules that this section is not to apply thereto.

- (3) The rules for prescribing the manner in which applications for the registration of trade marks are to be made shall make provision for the sending of an application for the registration of a trade mark in respect of textile goods to the Registrar either at the Patent Office or at the Manchester Branch, at the option of the applicant.
- (4) The keeper of the Manchester Branch shall furnish the Registrar with a report on every application for the registration of a trade mark sent to the Manchester Branch, and, before deciding under subsection (2) of section seventeen of this Act on any such application, the Registrar shall consider the report.
- (5) In respect of textile goods being piece goods—
- (a) no mark consisting of a line heading alone shall be registrable as a trade mark;
 - (b) a line heading shall not be deemed to be adapted to distinguish or capable of distinguishing;
 - (c) the registration of a trade mark shall not give any exclusive right to the use of a line heading.
- (6) There shall be kept at the Manchester Branch for the purposes of this Act a record called the Manchester Record wherein shall be entered copies of all entries in the register relating to trade marks registered in respect of textile goods on or after the appointed day and, as soon as may be, copies of all entries relating to trade marks so registered before the appointed day and for the time being subsisting, and the Manchester Record shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed.
- (7) The right of inspection conferred by the last foregoing subsection shall extend to and include the right to inspect all applications whatsoever for registration that were made to the Manchester Branch, between the passing of the ^{M³}Trade Marks Registration Act 1875, and the appointed day, in respect of cotton goods, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled or pending.
- (8) Refused marks which, immediately before the appointed day, were included in the collection of refused marks kept under rules one hundred and twelve to one hundred and sixteen of the Trade Marks Rules, 1920, and are at the time of the application for the registration of a trade mark included in that collection under the rules shall be treated for the purposes of subsections (1) and (2) of section twelve of this Act, but for no other purpose, as if they had been registered trade marks.
- (9) Before making any rule, or prescribing any form, that is to deal specially with trade marks registered or proposed to be registered in respect of textile goods other than clothing, the Board of Trade shall send a draft thereof to the Trade and Merchandise

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Marks Committee of the Manchester Chamber of Commerce, and shall, if the said committee so request, give them an opportunity of being heard.

- (10) The Registrar, or the Keeper of the Manchester Branch, may consult the said committee where it appears to him to be expedient so to do with respect to any circumstances peculiar to the cotton trade arising on an application to register a trade mark in respect of textile goods other than clothing.
- (11) A certificate purporting to be under the hand of the Keeper of the Manchester Branch as to any copy entered in the Manchester Record of an entry in the register shall be prima facie evidence of the entry having been made in the register and of the contents thereof.
- (12) F19

Textual Amendments

F19 S. 39(12) repealed by [Courts Act 1971 \(c. 23\)](#), [Sch. 11 Pt. II](#)

Marginal Citations

M3 1875 c. 91.

[^{F20}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—
- 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
 - 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.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (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.]

Textual Amendments

F20 S. 39A inserted by Patents, Designs and Marks Act 1986 (c. 39, SIF 91), s. 2, Sch. 2 Pt. III para. 5

GENERAL AND MISCELLANEOUS

Rules and fees

40 Power of Board of Trade to make rules.

- (1) The Board of Trade may from time to time make such rules, prescribe such forms and generally do such things as they think expedient—
 - (a) for regulating the practice under this Act, including the service of documents;
 - (b) for classifying goods for the purposes of registration of trade marks;
 - (c) for making or requiring duplicates of trade marks and other documents;
 - (d) for securing and regulating the publishing and selling or distributing, in such manner as the Board of Trade think fit, of copies of trade marks and other documents;
 - (e) generally, for regulating the business of the Patent Office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar or of the Board of Trade.
- (2) ^{F21}
- (3) Before making any rules under this Act, the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained, in such manner as the Board consider most expedient so as to enable persons affected to make representations to the Board before the rules are finally settled.
- (4) Any rules so made shall be forthwith advertised twice in the Trade Marks Journal, and shall be laid before both Houses of Parliament, . . . ^{F22}
- (5) If either House of Parliament, within the next forty days after any rules have been so laid before it, resolves that the rules or any of them ought to be annulled, the rule or rules shall henceforth be of no effect, but without prejudice to the validity of anything previously done thereunder or to the making of any new rule or rules.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Subordinate Legislation Made

- P1** S. 40: for previous exercises of power see Index to Government Orders
- P2** S. 40: s. 40 (with s. 68(1)) power exercised by [S.I.1991/1431](#).
S. 40: s. 41 (with ss. 40 and 68(1)) power exercised by [S.I.1991/1898](#)
- P3** S. 40(1)(e) : power exercised by [S.I. 1991/675](#)

Textual Amendments

- F21** S. 40(2) repealed by [Statute Law \(Repeals\) Act 1986 \(c. 12\)](#), s. 1(1), [Sch. 1 Pt. XII](#)
- F22** Words repealed by [Statute Law \(Repeals\) Act 1986 \(c. 12\)](#), s. 1(1), [Sch. 1 Pt. XII](#)

[^{F23} 40A Hours of business and excluded days.

- (1) Rules under section 40 of this Act may specify the hour at which the Patent Office shall be deemed to be closed on any day for purposes of the transaction by the public of business under this Act or of any class of such business, and may specify days as excluded days for any such purposes.
- (2) Any business done under this Act on any day after the hour specified as aforesaid in relation to business of that class, or on a day which is an excluded day in relation to business of that class, shall be deemed to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day, that time shall be extended to the next following day not being an excluded day.]

Textual Amendments

- F23** S. 40A inserted by [Statute Law \(Repeals\) Act 1986 \(c. 12\)](#), s. 1(2), [Sch. 2 para. 2](#)

41 Fees.

There shall be paid in respect of applications and registration and other matters under this Act such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade.

Subordinate Legislation Made

- P4** S. 41: s. 41 (with ss. 40 and 68(1)) power exercised by [S.I.1991/1898](#)
For previous exercises of this power see Index to Government Orders

Powers and duties of Registrar

42 Preliminary advice by Registrar as to distinctiveness.

- (1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar prima facie to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (2) Any such person who is desirous of obtaining such advice must make application to the Registrar therefor in the prescribed manner.
- (3) If on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

43 Hearing before exercise of Registrar's discretion.

Where any discretionary or other power is given to the Registrar by this Act or the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

44 Power of Registrar to award costs.

In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court or a judge thereof, be enforced in the same manner as a judgment or order of the Court to the same effect.

45 Annual reports of Registrar.

The Comptroller-General of Patents, Designs and Trade Marks shall, in his annual report on the execution by or under him of the ^{M4}Patents and Designs Act 1907, and Acts amending that Act, include a report respecting the execution by or under him of this Act as if it formed a part of or was included in those Acts.

Marginal Citations

M4 1907 c. 29(91).

Legal proceedings and appeals

46 Registration to be prima facie evidence of validity.

In all legal proceedings relating to a registered trade mark (including applications under section thirty-two of this Act) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

47 **Certificate of validity.**

In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

48 **Costs of Registrar in proceedings before Court, and payment of costs by Registrar.**

- (1) In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but in any proceedings in England or Northern Ireland, the Registrar shall not, except in accordance with the provisions of subsection (2) of this section in a case in which he has appeared in the proceedings, be ordered to pay the costs of any other of the parties.
- (2) Where the Registrar appears in any proceedings before the Court in England or Northern Ireland under this Act, section seven of the ^{M5}Administration of Justice (Miscellaneous Provisions) Act 1933, or any corresponding enactment which may be passed by the Parliament of Northern Ireland, as the case may be, shall have effect as it has effect in relation to other proceedings to which the Crown is a party in a court having the power to award costs in cases between subjects.

Modifications etc. (not altering text)

- C9** Reference to enactment of Parliament of Northern Ireland to be construed as including reference to Measure of Northern Ireland Assembly: [Northern Ireland Constitution Act 1973 \(c. 36, SIF 29:3\)](#), [Sch. 5 para. 1](#)

Marginal Citations

- M5** [1933 c. 36\(39A\)](#).

49 **Trade usage, &c. to be considered.**

In any action or proceeding relating to a trade mark or trade name, the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

50 **Registrar's appearance in proceedings involving rectification.**

- (1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.
- (2) Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the Patent Office in like cases or of such other matters relevant to the issues, and within his knowledge as Registrar,

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

51 Court's power to review Registrar's decision.

The Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-two of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

52 Discretion of Court in appeals.

In any appeal from a decision of the Registrar to the Court under this Act, the Court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

53 Procedure on appeal to Board of Trade.

Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer the appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

54 Procedure in cases of option to apply to Court or Registrar.

Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the Court or to the Registrar—

- (a) if an action concerning the trade mark in question is pending, the application must be made to the Court;
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the Court, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

Evidence

55 Mode of giving evidence.

In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the tribunal thinks it right so to do, the tribunal may take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *viva voce*, the Board of Trade or the Registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as [^{F24}a Circuit judge discharging the functions of an official referee] of the Supreme Court.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Textual Amendments

F24 Words substituted by virtue of [Courts Act 1971 \(c. 23, SIF 37\)](#), **s. 25(3)**

56 Evidence of orders, &c. of Board of Trade.

- (1) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or an under-secretary or an assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.
- (2) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Modifications etc. (not altering text)

C10 Functions of President of Board of Trade under s. 56 now exercisable concurrently by Secretary of State: [S.I. 1970/1537](#), **art. 2(1)(b)**

57, 58. ^{F25}

Textual Amendments

F25 [Ss. 57, 58](#) repealed by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 91\)](#), s. 3, **Sch. 3 Pt. I**

Offences and restraint of use of Royal Arms

[^{F26}58A Fraudulent application or use of trade mark an offence.

- (1) It is an offence, subject to subsection (3) below, for a person—
 - (a) to apply a mark identical to or nearly resembling a registered trade mark to goods, or to material used or intended to be used for labelling, packaging or advertising goods, or
 - (b) to sell, let for hire, or offer or expose for sale or hire, or distribute—
 - (i) goods bearing such a mark, or
 - (ii) material bearing such a mark which is used or intended to be used for labelling, packaging or advertising goods, or
 - (c) to use material bearing such a mark in the course of a business for labelling, packaging or advertising goods, or
 - (d) to possess in the course of a business goods or material bearing such a mark with a view to doing any of the things mentioned in paragraphs (a) to (c),
 when he is not entitled to use the mark in relation to the goods in question and the goods are not connected in the course of trade with a person who is so entitled.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (2) It is also an offence, subject to subsection (3) below, for a person to possess in the course of a business goods or material bearing a mark identical to or nearly resembling a registered trade mark with a view to enabling or assisting another person to do any of the things mentioned in subsection (1)(a) to (c), knowing or having reason to believe that the other person is not entitled to use the mark in relation to the goods in question and that the goods are not connected in the course of trade with a person who is so entitled.
- (3) A person commits an offence under subsection (1) or (2) only if—
- (a) he acts with a view to gain for himself or another, or with intent to cause loss to another, and
 - (b) he intends that the goods in question should be accepted as connected in the course of trade with a person entitled to use the mark in question;
- and it is a defence for a person charged with an offence under subsection (1) to show that he believed on reasonable grounds that he was entitled to use the mark in relation to the goods in question.
- (4) A person guilty of an offence under this section is liable—
- (a) on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both;
 - (b) on conviction on indictment to a fine or imprisonment for a term not exceeding ten years, or both.
- (5) Where an offence under this section committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.
- In relation to a body corporate whose affairs are managed by its members’ “director” means a member of the body corporate.
- (6) In this section “business” includes a trade or profession.]

Textual Amendments

F26 Ss. 58A–58D inserted by [Copyright, Designs and Patents Act 1988 \(c. 48, SIF 67A\)](#), s. 300

58B Delivery up of offending goods and material.

- (1) The court by which a person is convicted of an offence under section 58A may, if satisfied that at the time of his arrest or charge he had in his possession, custody or control—
- (a) goods or material in respect of which the offence was committed, or
 - (b) goods of the same description as those in respect of which the offence was committed, or material similar to that in respect of which the offence was committed, bearing a mark identical to or nearly resembling that in relation to which the offence was committed,
- order that the goods or material be delivered up to such person as the court may direct.
- (2) For this purpose a person shall be treated as charged with an offence—

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (a) In England, Wales and Northern Ireland, when he is orally charged or is served with a summons or indictment;
 - (b) in Scotland, when he is cautioned, charged or served with a complaint or indictment.
- (3) An order may be made by the court of its own motion or on the application of the prosecutor (or, in Scotland, the Lord Advocate or procurator-fiscal), but shall not be made if it appears to the court unlikely that any order will be made under section 58C (order as to disposal of offending goods or material).
- (4) An appeal lies from an order made under this section by a magistrates' court—
- (a) in England and Wales, to the Crown Court, and
 - (b) in Northern Ireland, to the county court;
- and in Scotland, where an order has been made under this section, the person from whose possession, custody or control the goods or material have been removed may, without prejudice to any other form of appeal under any rule of law, appeal against that order in the same manner as against sentence.
- (5) A person to whom goods or material are delivered up in pursuance of an order under this section shall retain it pending the making of an order under section 58C.
- (6) Nothing in this section affects the powers of the court under section 43 of the Powers of Criminal Courts Act 1973, section 223 or 436 of the Criminal Procedure (Scotland) Act 1975 or Article 7 of the Criminal Justice (Northern Ireland) Order 1980 (general provisions as to forfeiture in criminal proceedings).

58C Order as to disposal of offending goods or material.

- (1) Where goods or material have been delivered up in pursuance of an order under section 58B, an application may be made to the court for an order that they be destroyed or forfeited to such person as the court may think fit.
- (2) Provision shall be made by rules of court as to the service of notice on persons having an interest in the goods or material, and any such person is entitled—
- (a) to appear in proceedings for an order under this section, whether or not he was served with notice, and
 - (b) to appeal against any order made, whether or not he appeared;
- and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.
- (3) Where there is more than one person interested in goods or material, the court shall make such order as it thinks just.
- (4) References in this section to a person having an interest in goods or material include any person in whose favour an order could be made under this section or under sections 114, 204 or 231 of the Copyright, Designs and Patents Act 1988 (which make similar provision in relation to infringement of copyright, rights in performances and design right).
- (5) Proceedings for an order under this section may be brought—
- (a) in a county court in England, Wales and Northern Ireland, ^{F27}save that in Northern Ireland such proceedings may be brought in a county court only

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where] the value of the goods or material in question does not exceed the county court limit for actions in tort, and

(b) in a sheriff court in Scotland;

but this shall not be construed as affecting the jurisdiction of the High Court or, in Scotland, the Court of Session.

Textual Amendments

F27 Words in s. 58C(5)(a) substituted by S.I. 1991/724, art. 2(8), Schedule.

58D Enforcement of section 58A.

- (1) The functions of a local weights and measures authority include the enforcement in their area of section 58A.
- (2) The following provisions of the Trade Descriptions Act 1968 apply in relation to the enforcement of that section as in relation to the enforcement of that Act—
 - section 27 (power to make test purchases),
 - section 28 (power to enter premises and inspect and seize goods and documents),
 - section 29 (obstruction of authorised officers), and
 - section 33 (compensation for loss, &c. of goods seized under s. 28).
- (3) Subsection (1) above does not apply in relation to the enforcement of section 58A in Northern Ireland, but the functions of the Department of Economic Development include the enforcement of that section in Northern Ireland.

For that purpose the provisions of the Trade Descriptions Act 1968 specified in subsection (2) apply as if for the references to a local weights and measures authority and any officer of such an authority there were substituted references to that Department and any of its officers.

- (4) Any enactment which authorises the disclosure of information for the purpose of facilitating the enforcement of the Trade Descriptions Act 1968 shall apply as if section 58A above were contained in that Act and as if the functions of any person in relation to the enforcement of that section were functions under that Act.

59 Falsification of entries in register a misdemeanour.

- (1) If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.
- (2) In the Isle of Man the punishment for an offence under this section shall be imprisonment for any term not exceeding two years, with or without hard labour and with or without a fine not exceeding one hundred pounds, at the discretion of the court.

60 Fine for falsely representing a trade mark as registered.

- (1) Any person who makes a representation—
 - (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
 - (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or
 - (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right;
- shall be liable on summary conviction to a fine not exceeding [^{F28}level 3 on the standard scale]
- (2) For the purposes of this section, the use in the United Kingdom in relation to a trade mark of the word “registered”, or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—
- (a) where the word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside the United Kingdom, being a country under the law of which the registration referred to is in fact in force;
 - (b) where that word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to such registration as last aforesaid; or
 - (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside the United Kingdom and in relation to goods to be exported to that country.
- (3) An offence under this section committed in the Isle of Man may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Textual Amendments

F28 Words substituted by virtue of (E.W.) [Criminal Justice Act 1982 \(c. 48, SIF 39:1\)](#), [ss. 38, 46](#), (S.) by [Criminal Procedure \(Scotland\) Act 1975 \(c. 21, SIF 39:1\)](#), [ss. 289F, 289G](#) and (N.I.) by [S.I. 1984/703 \(N.I.3\)](#), [arts. 5, 6](#)

61 Restraint of use of Royal Arms, &c.

If any person, without the authority of His Majesty, uses, in connection with any trade, business, calling or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person, without the authority of His Majesty or of a member of the Royal Family, uses, in connection with any trade, business, calling or profession, any device, emblem or title in such manner as to be calculated to lead to the belief that he is employed by, [^{F29}supplies goods to or provides services for], His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction from continuing so to use the same:

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Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem or title to continue to use such trade mark.

Textual Amendments

- F29** Words substituted by [Patents, Designs and Trade Marks Act 1986 \(c. 39, SIF 91\)](#), s. 1(2), [Sch. 2 Pt. III para. 6](#)

Miscellaneous

62 Change of form of trade connection not to be deemed to cause deception.

The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

63 Jointly owned trade marks.

Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

- (a) on behalf of both or all of them, or
- (b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

Subject as aforesaid, nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

64 Trusts and equities.

- (1) There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.
- (2) Subject to the provisions of this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

[^{F30}64A Recognition of agents.

- (1) The person who is registered as the proprietor or registered user of a trade mark in respect of any goods may give notice in writing to the Commissioners of Customs and Excise (in this section referred to as the Commissioners)—
 - (a) that he is the proprietor or registered user of that trade mark, and
 - (b) that such goods bearing the trade mark are expected to arrive in the United Kingdom at a time and place and by a consignment specified in the notice, and

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (c) that the use within the United Kingdom of the trade mark in relation to the goods would infringe the proprietor's exclusive right to that use, and
 - (d) that he requests the Commissioners to treat the goods as prohibited goods.
- (2) Where a notice has been given under this section in respect of any goods bearing a trade mark and has not been withdrawn and the requirements of any regulations made under this section are complied with, then, subject to the following provisions of this section, the importation into the United Kingdom of the goods shall, if the condition of paragraph (c) of the preceding subsection is satisfied, be deemed to be prohibited unless the importation is for the private and domestic use of the person importing the goods.
- (3) The Commissioners may make regulations prescribing the form in which notices are to be given under this section, and requiring a person giving such a notice, either at the time of giving the notice or at the time when the goods in question are imported, or at both those times, to furnish the Commissioners with such evidence, and to comply with such other conditions (if any), as may be specified in the regulations, and any such regulations may include such incidental and supplementary provisions as the Commissioners consider expedient for the purposes of this section.
- (4) Without prejudice to the generality of the preceding subsection, regulations made under that subsection may include provision for requiring a person who has given a notice under subsection (1) of this section, or a notice purporting to be a notice under that subsection,—
- (a) to pay such fees in respect of the notice as may be prescribed by the regulations;
 - (b) to give to the Commissioners such security as may be so prescribed, in respect of any liability or expense which they may incur in consequence of the detention of any goods to which the notice relates, or in consequence of anything done in relation to goods so detained;
 - (c) whether any such security is given or not, to keep the Commissioners indemnified against any such liability or expense as is mentioned in the preceding paragraph.
- (5) For the purposes of ^{F31}section 17 of the ^{M6}Customs and Excise Management Act 1979] (which relates to the disposal of duties) any fees paid in pursuance of regulations made under this section shall be treated as money collected on account of ^{F31}duties (whether of customs or excise) charged on imported goods].
- (6) Regulations under subsection (3) of this section shall be made by statutory instrument, which shall be subject to annulment in pursuance of a resolution of either House of Parliament].

Textual Amendments

F30 S. 64A inserted by [Trade Descriptions Act 1968 \(c. 29, SIF 109:1\)](#), [s. 17](#)

F31 Words substituted by [Customs and Excise Management Act 1979 \(c. 2, SIF 40:1\)](#), [Sch. 4 para. 12](#)
Table Pt. I

Modifications etc. (not altering text)

C11 S. 64A excluded by [S.I. 1987/1521](#), [art. 2](#)

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Marginal Citations

M6 1979 c. 2(40:1).

65 Saving for jurisdiction of courts in Scotland, Northern Ireland and Isle of Man.

Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may under and in accordance with the rules, or in particular cases by special leave of the Board of Trade, be done by or to an agent of that person duly authorised in the prescribed manner.

66 Interpretation.

- (1) The provision of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Northern Ireland in any proceedings relating to trade marks; and with reference to any such proceedings in Scotland the expression “the Court” means the Court of Session; and with reference to any such proceedings in Northern Ireland the expression “the Court” means the High Court of Justice in Northern Ireland.
- (2) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement or in any action or proceeding respecting a trade mark competent to those courts.

67 ^{F32}

Textual Amendments

F32 S. 67 repealed by [Industrial Expansion Act 1968 \(c. 32, SIF 64\)](#), [Sch. 4](#)

Supplemental

68 Transitional provisions.

- (1) In this Act, unless the context otherwise requires, the following expressions have the meanings hereby assigned to them respectively, that is to say:—
 - “the appointed day” has the meaning assigned to it by section seventy-one of this Act;
 - “assignment” means assignment by act of the parties concerned;
 - “the Court” means (subject to provisions relating to Scotland, Northern Ireland or the Isle of Man) His Majesty’s High Court of Justice in England;
 - “limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place within the United Kingdom, or as to use in relation to goods to be exported to any market outside the United Kingdom;

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“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;

“permitted use” has the meaning assigned to it by subsection (1) of section twenty-eight of this Act;

“prescribed” means, [^{F33}(subject to provisions relating to Northern Ireland)] in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules;

“the register” means the register of trade marks kept under this Act;

“registered trade mark” means a trade mark that is actually on the register;

“registered user” means a person who is for the time being registered as such under section twenty-eight of this Act;

“the Registrar” means the Comptroller-General of Patents, Designs and Trade Marks;

“the rules” means rules made by the Board of Trade under section thirty-six or section forty of this Act;

“trade mark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section thirty-seven of this Act;

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer not being assignment;

“United Kingdom” includes the Isle of Man.

- (2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references therein to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.

[^{F34}(2A) For the purposes of this Act goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services.

- (2B) References in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.]

- (3) In the application of this Act to Scotland, the expressions “injunction,” “plaintiff” and “defendant” means respectively “interdict,” “pursuer” and “defender.”

Subordinate Legislation Made

P5 S. 68: power previously exercised by [S.I. 1990/1799](#), /1800 and /1801.

P6 S. 68(1): s. 40 (with s. 68(1)) power exercised by [S.I.1991/1431](#).

S. 68(1): s. 41 (with ss. 40 and 68(1)) power exercised by [S.I.1991/1898](#)

Textual Amendments

F33 Words inserted by [Judicature \(Northern Ireland\) Act 1978 \(c. 23, SIF 38\)](#), **Sch. 5 Pt. II**.

F34 S. 68(2A)(2B) inserted by [Trade Marks \(Amendment\) Act 1984 \(c. 19, SIF 91\)](#), **s. 1(5)(b)**

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Modifications etc. (not altering text)

C12 S. 68(2) applied by [Consumer Protection Act 1987 \(c. 43, SIF 109:1\)](#), s. 45(4)

69 Repeal and savings.

The transitional provisions set out in the Third Schedule to this Act shall have effect with respect to the matters therein mentioned respectively.

70

F35

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- (2) Nothing in this Act shall affect any order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made, or thing done, under any enactment repealed by this Act; and every such order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force at the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given or done under this Act, have effect as if made, issued, given or done under the corresponding enactment of this Act.
- (3) Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.
- (4) Nothing in this section shall be taken to prejudice the provisions of [^{F36}sections 16 and 17 (2)(a) of the ^{M7}Interpretation Act 1978].

Textual Amendments

F35 S. 70(1), Sch. 4 repealed by [Statute Law Revision Act 1950 \(c. 6\)](#), Sch. 1

F36 Words substituted by virtue of [Interpretation Act 1978 \(c. 30, SIF 115:1\)](#), s. 25(2)

Marginal Citations

M7 1978 c. 30(115:1).

71 Short title and extent.

- (1) This Act may be cited as the Trade Marks Act 1938.
- [^{F37}(2) *This Act shall come into operation on the date fixed by order made under subsection (5) of section thirty-three of the ^{M8}Trade Marks (Amendment) Act, 1937, for the coming into operation of that Act (in this Act referred to as “the appointed day”), immediately after the coming into operation of that Act.]*
- (3) It is hereby declared that this Act extends to Northern Ireland.
- (4) This Act shall extend to the Isle of Man.

Textual Amendments

F37 S. 71(2) repealed by [Statute Law Revision Act 1950 \(c. 6\)](#), Sch. 1 but is included for interpretation of the words “the appointed day” in s. 68: 27.7.1938 appointed by [S.I. 1938/657](#) as date for coming into operation of Trade Marks (Amendment) Act 1937

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Marginal Citations

M8 1937 c. 49.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

SCHEDULES

FIRST SCHEDULE

CERTIFICATION TRADE MARKS

- 1 (1) An application for the registration of a mark under section thirty-seven of this Act must be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.
- (2) The provisions of subsection (2) and of subsections (4) to (7) of section seventeen of this Act shall have effect in relation to an application under the said section thirty-seven as they have effect in relation to an application under subsection (1) of the said section seventeen, except that for references therein to acceptance of an application there shall be substituted references to authorisation to proceed with the application.
- (3) In dealing under the said provisions with an application under the said section thirty-seven the tribunal shall have regard to the like considerations, so far as relevant, as if the application were an application under section seventeen of this Act and to any other considerations (not being matters within the competence of the Board of Trade under subparagraph (5) of this paragraph) relevant to applications under the said section thirty-seven, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.
- (4) An applicant for the registration of a mark under the said section thirty-seven shall transmit to the Registrar draft regulations for governing the use thereof at such time before the decision of the Registrar on the application as he may require in order to enable him to consider the draft, and the Registrar shall report thereon to the Board of Trade.
- (5) When authorisation to proceed with an application has been given, the Board of Trade shall consider the application with regard to the following matters, that is to say:—
- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
 - (b) whether the draft regulations are satisfactory; and
 - (c) whether in all the circumstances the registration applied for would be to the public advantage;
- and may either—
- (i) direct that the application shall not be accepted; or
 - (ii) direct the Registrar to accept the application, and approve the regulations, either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which they think requisite having regard to any of the matters aforesaid;
- but, except in the case of a direction for acceptance and approval without modification and unconditionally, the Board shall not decide the matter without giving to the applicant an opportunity of being heard;

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Provided that the Board may, at the request of the applicant made with the concurrence of the Registrar, consider the application with regard to any of the matters aforesaid before authorisation to proceed with the application has been given, so however that the Board shall be at liberty to reconsider any matter on which they have given a decision under this proviso if any amendment or modification is thereafter made in the application or in the draft regulations.

- 2 (1) When an application has been accepted, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of subsections (2) to (11) of section eighteen of this Act shall have effect in relation to the registration of the mark as if the application had been an application under section seventeen of this Act;
Provided that, in deciding under the said provisions, the tribunal shall have regard only to the considerations referred to in subparagraph (3) of the last foregoing paragraph, and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the Board of Trade under subparagraph (2) of this paragraph of any opposition relating to any of the matters referred to in subparagraph (5) of the last foregoing paragraph.
- (2) When notice of opposition is given relating to any of the matters referred to in subparagraph (5) of the last foregoing paragraph, the Board of Trade shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.
- 3 (1) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar, with the consent of the Board of Trade.
- (2) The Board of Trade may cause an application for their consent to be advertised in any case where it appears to the Board that it is expedient so to do, and, where the Board cause an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Board of opposition to the application, the Board shall not decide the matter without giving the parties an opportunity of being heard.
- 4 (1) The Board of Trade may, on the application in the prescribed manner of any person aggrieved, or on the application of the Registrar, make such order as they think fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on the ground—
- (a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;
 - (b) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;
 - (c) that it is no longer to the public advantage that the trade mark should be registered; or
 - (d) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied;

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

and neither the Court nor Registrar shall have any jurisdiction to make an order under section thirty-two of this Act on any of those grounds.

- (2) The Registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under the foregoing subparagraph.

- 5 Notwithstanding anything in section forty-four of this Act, the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the trade mark.

- 6 The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, section four, section six, section nine, sections seventeen and eighteen (except as expressly applied by this Schedule), subsections (4) to (8) of section twenty-two, sections twenty-six to twenty-nine, section sixty-two, and any provisions the operation of which is limited by the terms thereof to registration in Part B of the Register.

SECOND SCHEDULE

SHEFFIELD MARKS

- 1 The Cutlers' Company shall continue to keep at Sheffield the register of trade marks (in this Schedule called "the Sheffield register") kept by them immediately before the appointed day, and, save as otherwise provided by this Schedule, the Sheffield register shall for all purposes form part of the register.

- 2 An application by a person carrying on business in Hallamshire, or within six miles thereof, for the registration of a trade mark in respect of metal goods may be made either to the Registrar or to the Cutlers' Company, at the option of the applicant.

- 3 An application for the registration of a trade mark made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner, and the Cutlers' Company shall not proceed with such an application until authorised so to do by the Registrar.

- 4 The Registrar shall consider an application notified to him as aforesaid and shall either authorise the Cutlers' Company to proceed therewith or, if it appears to him that there is any objection to the application, shall give notice of his objection to the Cutlers' Company, who shall communicate it to the applicant.

- 5 Within the prescribed time after receipt of a notice of objection under the last foregoing paragraph, the applicant may submit to the Cutlers' Company either orally or in writing arguments against, or proposals for meeting, the objection, and

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the Cutlers' Company shall notify to the Registrar any arguments or proposals so submitted to them together with any observations that they may desire to make thereon.

- 6 The Registrar shall consider any arguments, proposals or observations notified to him as aforesaid and shall, if so required by an applicant who has submitted arguments or proposals as aforesaid, give the applicant an opportunity of being heard by him, and may refuse authorisation to proceed with the application or may authorise the Cutlers' Company to proceed therewith either without modification and unconditionally or subject to such conditions, amendments or modifications, or to such limitations, if any, as he may think right.
- 7 Where the Registrar refuses authorisation to proceed with an application, or authorises the Cutlers' Company to proceed therewith subject as aforesaid, the provisions of subsections (4) to (6) of section seventeen of this Act shall have effect in relation to the refusal or conditional authorisation as they have effect in relation to a refusal to accept, or a conditional acceptance of, an application, except that for references therein to acceptance of the application there shall be substituted references to authorisation to the Cutlers' Company to proceed with the application.
- 8 Upon the registration of a trade mark in the Sheffield register, the Cutlers' Company shall give notice thereof to the Registrar, who shall thereupon enter the trade mark in the register, and such registration shall bear date as of the day of the application to the Cutlers' Company and have the same effect as if the application had been made to the Registrar on that day.
- 9 The provisions of this Act and of the rules with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this Schedule (and notwithstanding anything in any Act relating to the Cutlers' Company), apply to the registration of trade marks in respect of metal goods by the Cutlers' Company and to all matters relating thereto, and this Act and the rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the Registrar, the Patent Office, and the register respectively, and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Registrar by the Cutlers' Company: Provided that anything that by virtue of this Schedule is required or authorised to be done by, before or in relation to the Cutlers' Company or at their office may, with the consent of the party or parties concerned, be done by, before or in relation to the Registrar or at the Patent Office, as the case may be.
- 10 When the Registrar receives an application for the registration of a trade mark in respect of metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company.
- 11 Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Court or, in a case in which, if the decision had been a decision of the Registrar, the person

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aggrieved would have had an option under this Act of appealing to the Board of Trade, to the Court or the Board at the option of the appellant.

- 12 (1) For the purposes of this Schedule the expression “metal goods” means all metals, whether wrought, unwrought, or partly wrought, and all goods which are comprised in any of such classes as may be prescribed as being classes which refer predominantly to metal goods, and are goods composed wholly or principally of any metal; and for the purpose of determining whether any goods are goods principally of any metal regard shall be had to the importance and nature of the metal part or parts of the goods having regard to the purposes for which the goods are adapted.
- (2) Any question arising in connection with an application made to the Cutlers’ Company for the registration of a trade mark, as to whether the goods in respect of which the trade mark is proposed to be registered are metal goods, shall be referred to and determined by the Registrar, whose decision shall be final.
- (3) The validity of the registration by the Cutlers’ Company of a trade mark shall not be questioned on the ground only that the goods in respect of which it is so registered are not metal goods.
- 13 A certificate purporting to be under the hand of the master of the Cutlers’ Company as to any entry, matter or thing that the Cutlers’ Company are authorised by this Schedule or the rules to make or do shall be prima facie evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or not done.

THIRD SCHEDULE

TRANSITIONAL PROVISIONS

Validity of registrations under previous Acts

- 1 (1) Subject to the provisions of this paragraph and of section thirteen of this Act, the validity of the original entry of a trade mark on the register of trade marks existing at the commencement of the ^{M9}Trade Marks Act 1905, or on any of the registers of trade marks kept under previous Acts that were deemed part of the same record as the last-mentioned register, shall be determined in accordance with the Acts in force at the date of such entry, and any such trade mark shall retain its original date, but for all other purposes it shall be deemed to have been registered under the Trade Marks Act 1905.
- (2) No trade mark which was on the register at the commencement of the Trade Marks Act 1905, and which under that Act was then a registrable trade mark, shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration.
- (3) No trade mark which was on the register at the commencement of the ^{M10}Trade Marks (Amendment) Act 1937, and which, having regard to any amendment by that Act of

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the Trade Marks Act 1905, or of the ^{M11}Trade Marks Act 1919, whether as respect limitations that might be imposed on registration or as respects any other matter, was then a registrable trade mark under the Trade Marks Act 1905 to 1937, shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration.

- (4) Nothing in the ^{M12}Trade Marks (Amendment) Act 1937, shall be taken to have invalidated the original registration of a trade mark that immediately before the commencement of that Act was validly on the register.
- (5) Nothing in section thirty-six of the ^{M13}Trade Marks Act 1905, or in the Trade Marks (Amendment) Act 1937, shall be construed as having subjected any person to any liability in respect of any act or thing done before the commencement of those Acts respectively to which he would not have been subject under the Acts then in force.

Marginal Citations

- M9** 1905 c. 15.
M10 1937 c. 49.
M11 1919 c. 79.
M12 1937 c. 49.
M13 1905 c. 15.

Assignments and transmissions (before appointed day) giving exclusive rights in different places in the United Kingdom

- 2 (1) The validity of an assignment or transmission of a trade mark effected or claimed to have been effected before the appointed day, in any such case as is mentioned in subsection (6) or section twenty-two of this Act, shall be determined as if the provisions contained in subsections (1) to (5) of that section had not been enacted: Provided that, on application made in the prescribed manner within two years from the commencement of this Act, by a person who claims that an assignment or transmission of a registered trade mark to him or to a predecessor in title of his has been so effected, the Registrar shall have the like jurisdiction as under the proviso to subsection (6) of section twenty-two of this Act, and an assignment or transmission approved by him shall not be deemed to have been invalid on the ground of the subsistence of such rights as are mentioned in the said subsection (6) or on the ground that the assignment or transmission was effected otherwise than in connection with the goodwill of a business or was effected in respect of some (but not all) of the goods in respect of which the trade mark was registered, if application for the registration under section twenty-five of this Act of the title of the person becoming entitled is made within six months from the date on which the approval is given, or was made before that date.
- (2) Any decision of the Registrar under this paragraph shall be subject to appeal to the Court.

Status: Point in time view as at 21/08/1991.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

Saving as to retrospective provisions relating to assignments and transmissions

- 3 The retrospective provisions contained in section twenty-two of this Act, and in the last foregoing paragraph, shall have effect without prejudice to any determination of a competent tribunal that was made before the appointed day, or to the determination of any appeal from a determination so made, or to any title acquired for valuable consideration before the appointed day.

*Association of trade marks assignable or transmissible
as a whole only under the Trade Marks Act, 1919*

- 4 Where immediately before the appointed day a trade mark was registered in Part B of the register subject to a condition rendering it assignable or transmissible only as a whole with another trade mark registered in the name of the same proprietor or with two or more other trade marks so registered, and not separately, the trade marks shall be deemed to be associated trade marks, and the entries in the register relating thereto may be amended accordingly.

*Previous use of a trade mark by person becoming registered
user on application made within one year of appointed day*

- 5 Where a person is registered as a registered user of a trade mark on an application made within one year from the commencement of this Act, subsection (2) of section twenty-eight of this Act shall have effect in relation to any previous use (whether before or after the commencement of this Act) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use.

Use of trade mark for export trade before appointed day

- 6 Section thirty-one of this Act shall be deemed to have had effect in relation to an act done before the appointed day as it has effect in relation to an act done after the commencement of this Act, without prejudice, however, to any determination of a competent tribunal which was made before the appointed day, or to the determination of any appeal from a determination so made.

*Trade marks registered under section sixty-two of the Trade Marks Act 1905,
to be deemed to have been registered under section thirty-seven of this Act*

- 7 Section thirty-seven of this Act shall have effect, in relation to a trade mark that immediately before the appointed day was on the register by virtue of section sixty-two of the ^{M14}Trade Marks Act 1905, as if the said section thirty-seven had been in force at the date of the registration of the trade mark and it had been registered under that section, subject however to the following modifications, that is to say:—

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Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994). (See end of Document for details)

- (a) the proviso to subsection (1) of the said section thirty-seven shall not apply;
- (b) in a case in which regulations for governing the use of the trade mark are deposited at the Patent Office at the commencement of this Act, those regulations shall be deemed to have been deposited under the said section thirty-seven;
- (c) in a case in which no such regulations are deposited at the commencement of this Act, the proprietor shall be at liberty, or may be required by the Board of Trade as a condition of the continuance of the registration, to deposit at any time thereafter such regulations as the Board may permit or require; and
- (d) in a case in which no such regulations are for the time being deposited, the said section thirty-seven shall have effect as if references therein, and in the First Schedule to this Act, to the regulations had been omitted.

Marginal Citations

M14 1905 c. 15.

Cotton marks registered before appointed day

- 8 No registration as of a date before the appointed day of a cotton mark as defined in section sixty-four of the ^{M15}Trade Marks Act 1905, in respect of cotton piece goods or cotton yarn shall give any exclusive right to the use of any letter, numeral, line heading, or any combination thereof.

Marginal Citations

M15 1905 c. 15.

F38F38 FOURTH SCHEDULE

Textual Amendments

F38 S. 70(1), Sch. 4 repealed by Statute Law Revision Act 1950 (c. 6), **Sch. 1**

Status:

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Changes to legislation:

There are currently no known outstanding effects for the Trade Marks Act 1938 (repealed 31.10.1994).