



# Trade Marks Act 1938

## 1938 CHAPTER 22

### GENERAL AND MISCELLANEOUS.

#### *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.

#### **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 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

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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.

#### **49 Trade usage, and 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, 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

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hearing the parties, determine the question between them, subject to appeal to the Court.