



Trade Marks Act 1938 (repealed 31.10.1994)

1938 CHAPTER 22 1 and 2 Geo 6

REGISTRATION, INFRINGEMENT AND OTHER SUBSTANTIVE PROVISIONS

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

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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.
- (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) ^{F1}An appeal under this section shall be made in the prescribed manner, and on the appeal the Court^{F1} 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 ^{F2}by rules of court made for the purposes of this subsection under section 55 of the ^{M1}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.

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- (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

- F1** 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](#)
- F2** 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

- M1** [1978 c. 23\(38\)](#).

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—
- the application has not been opposed and the time for notice of opposition has expired, or
 - 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 [^{F3}, 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: . . . ^{F4}
- (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

- F3** Words inserted by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 91\)](#), [s. 2](#), [Sch. 2 Pt. III para. 3](#)
- F4** Proviso repealed by [Patents, Designs and Marks Act 1986 \(c. 39, SIF 91\)](#), [s. 3](#), [Sch. 3 Pt. II](#)

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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 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)

C1 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—

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- (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.

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