

SCHEDULES

SCHEDULE 1

Section 1(2).

MODIFICATIONS OF TRADE MARKS ACT 1938 IN APPLICATION TO SERVICE MARKS

General

- 1 Subject to the following provisions of this Schedule—
- (a) references in the Act to a trade mark (except as regards the name of the register) shall have effect as references to a mark falling within subsection (3) of section 1 of this Act; and
 - (b) references in the Act to goods, shall have effect as references to services.

Section 4

- 2 (1) Section 4 (right given by registration in Part A and infringement thereof) shall be modified as follows.
- (2) In subsection (1)—
- (a) for the words " (whether before or after the commencement of this Act)" there shall be substituted the words " after the coming into force of the Trade Marks (Amendment) Act 1984 ";
 - (b) the words " (other than a certification trade mark) " and the words " or be deemed to have given " shall be omitted ;
 - (c) for the words from " a mark identical" to " in the course of trade " there shall be substituted the words " in connection with the provision of any services a mark identical with or nearly resembling it ";
 - (d) for paragraph (b) there shall be substituted the following paragraph—
 - “(b) in a case in which the use is use at or near the place where the services are available for acceptance or performed 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 mark or to services with the provision of which such a person as aforesaid is connected in the course of business.”
- (3) In subsection (2) (effect of conditions and limitations), for the words from " goods to be sold " to " any market" there shall be substituted the words " services for use or available for acceptance in any place, country or territory ".
- (4) In subsection (3) (cases where there is no infringement), for paragraphs (a) and (b) there shall be substituted the following paragraphs—
- “(a) in relation to services to which the proprietor of the mark or a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to

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- indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark ; or
- (b) in relation to services the provision of which is connected in the course of business with the proprietor or a registered user of the mark, where the proprietor or registered user has at any time expressly or impliedly consented to the use of the mark ; or
 - (c) in relation to services available for use with other services in relation to which the mark has been used without infringement of the right given by registration or might for the time being be so used, if—
 - (i) the use of the mark is reasonably necessary in order to indicate that the services are available for such use, and
 - (ii) 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 business between any person and the provision of those services.”

Section 5

- 3 (1) In subsection (1) of section 5 (right given by registration in Part B and infringement thereof), for the words " (whether before or after the commencement of this Act) " there shall be substituted the words " after the commencement of the Trade Marks (Amendment) Act 1984 " and the words " or be deemed to have given " shall be omitted.
- (2) In subsection (2) of that section—
 - (a) the words from " otherwise " to " succeeding section " shall be omitted ; and
 - (b) for the words from " a connection " onwards there shall be substituted the words " that a person having the right either as proprietor or as registered user to use the mark is connected in the course of business with the provision of the services ".

Section 6

- 4 Section 6 (infringement by breach of certain conditions) shall be omitted.

Section 8

- 5 In section 8(b) (registration not to restrict use of descriptions of character or quality of goods) the words from " or in " to " thirty-seven " shall be omitted.

Section 9

- 6 (1) In subsection (1) of section 9 (distinctiveness requisite for registration in Part A), the words " (other than a certification trade mark) " shall be omitted.
- (2) In subsection (2) of that section (meaning of " distinctive "), for the words from " distinguish " to " subsists " there shall be substituted the words " distinguish services with the provision of which the proprietor is or may be connected, in the course of business, from services with the provision of which he is not so connected ".

Section 10

- 7 In section 10(1) (capability of distinguishing requisite for registration in Part B) for the words from " distinguishing " to " subsists " there shall be substituted the words " distinguishing services with the provision of which the proprietor of the mark is or may be connected in the course of business from services with the provision of which he is not so connected " .

Section 12

- 8 (1) Section 12 (prohibition of registration of identical and nearly resembling trade marks) shall be modified as follows.
- (2) In subsection (1), for the words from " a trade mark belonging " to the end there shall be substituted the words " or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services, the same description of services, or goods or a description of goods which are associated with those services or services of that description. "
- (3) In subsection (2), for the words from " of trade marks" to " proprietor " there shall be substituted the words
- “by more than one proprietor, in respect of—
- (a) the same services,
- (b) the same description of services, or
- (c) services and goods or descriptions of services and goods which are associated with each other,
- of marks that are identical or nearly resemble each other.”.
- (4) In subsection (3), for the words from " trade marks" to " description of goods " there shall be substituted the words " marks that are identical or nearly resemble each other, in respect of—
- (a) the same services,
- (b) the same description of services, or
- (c) services and goods or descriptions of services and goods which are associated with each other."

Section 14

- 9 In section 14 (registration subject to disclaimer), in paragraph (b), for the words " the trade" there shall be substituted the words " the provision of services of that description " .

Section 15

- 10 (1) Section 15 (words used as name or description of an article or substance not to invalidate registration of a mark) shall be modified as follows.
- (2) In subsection (1). for the words " an article or substance" where they occur immediately before the proviso there shall be substituted the words " some activity: " and the following shall be substituted for the proviso—
- “Provided that, if it is proved that there is a well-known and established use of the word or words as the name or description of some activity by a person

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or persons providing services which include that activity, not being use in relation to services with the provision of which the proprietor or a registered user of the mark is connected in the course of business, the provisions of subsection (2) below shall have effect”.

- (3) In subsection (2)—
- (a) the words " paragraph (a) or (b) of " shall be omitted ;
 - (b) in paragraph (a), for the words " article or substance in question or of any goods of the same description" there shall be substituted the words " activity in question ";
 - (c) in paragraph (b) for the words "article or substance in question and of any goods of the same description " there shall be substituted the words " activity in question " and for the words " that article or substance and any goods of the same description" there shall be substituted the words " that activity "; and
 - (d) in paragraph (c), for the words " article or substance in question or to any goods of the same description" there shall be substituted the words " activity in question " and the words " paragraph (a) of " and the words after " established " shall be omitted.
- (4) Subsection (3) shall be omitted.

Section 20

- 11 In section 20 (duration and renewal of registration) the proviso to subsection (1) shall be omitted and in paragraph (a) of the proviso to subsection (4), for the words " trade use " there shall be substituted the words " business use ".

Section 22

- 12 (1) Section 22 (assignability and transmissibility of trade marks) shall be modified as follows.
- (2) In subsection (1) the words from " Notwithstanding " to " contrary " and the words " and shall be deemed always to have been " shall be omitted.
 - (3) In subsection (2) the words " and shall be deemed always to have been " and the words " or was registered, as the case may be " shall be omitted.
 - (4) In subsection (3) the words "or was" wherever they occur shall be omitted.
 - (5) For subsection (4) there shall be substituted the following subsection—
 - “(4) Notwithstanding anything in subsections (1) to (3) of this section a mark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to—
 - (a) the same services,
 - (b) the same description of services, or
 - (c) services and goods or descriptions of services and goods which are associated with each other,
 of marks nearly resembling each other or of identical marks, if, having regard to the similarity of the services or the association of the goods and services or description of goods and services, and to the similarity of the marks, the

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use of the marks in exercise of those rights would be likely to deceive or cause confusion :

Provided that, where a mark is assigned or transmitted in such a case, the assignment or transmission shall not be deemed to be invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to services for use in the United Kingdom, in relation to services for use in the same country or territory outside the United Kingdom or in relation to services available for acceptance in the United Kingdom (wherever they are to be used).”

- (6) In subsection (5), for the words " the goods and " there shall be substituted the words " the services or the association of the services and goods or descriptions of services and goods and to the similarity ".
- (7) In subsection (6) the words " on or after the appointed day " shall be omitted in both places where they occur and, in the words before the proviso, for the words following " by registration " there shall be substituted the words—
- “(a) an exclusive right in one of the persons concerned to the use of the mark limited to use in relation to services for use or services available for acceptance 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 services,
 - (ii) the same description of services, or
 - (iii) goods which are associated with those services or services of that description, limited to use in relation to services for use, services available for acceptance or goods to be sold or otherwise traded in, in another place or places in the United Kingdom.”
- (8) In subsection (7), for the words " in those goods is made, on or after the appointed day " there shall be substituted the words " of providing those services is made ".

Section 23

13 Section 23 (certain marks to be associated) shall be modified by the insertion, after subsection (2), of the following subsection—

“(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 services and in respect of goods which are associated with those services or services of that description, subsection (2) above 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 services or description of services.”

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Section 26

- 14 (1) Section 26 (removal from register and imposition of limitations on ground of non-use) shall be modified as follows.
- (2) In subsection (1)—
- (a) the words " Subject to the provisions of the next succeeding section " shall be omitted ; and
- (b) in the proviso, for the words after "bona fide use" there shall be substituted the words
- “of the mark by any proprietor thereof for the time being in relation to—
- (i) services of the same description, or
- (ii) goods associated with those services or services of that description,
- being services or, as the case may be, goods in respect of which the mark is registered.”
- (3) In subsection (2), for the words from the beginning to the end of paragraph (b) there shall be substituted the following—
- “(2) Where in relation to any services in respect of which a mark is registered—
- (a) the matters referred to in paragraph (b) of subsection (1) above are shown so far as regards non-use of the mark in relation to services for use or available for acceptance in a particular place in the United Kingdom, or for use in a country or territory outside the United Kingdom; and
- (b) a person has been permitted under subsection (2) of section 12 of this Act to register an identical or nearly-resembling mark in respect of those services under a registration extending to use in relation to services for use or available for acceptance in that place or for use in that country or territory, or the tribunal is of opinion that he might properly be permitted so to register such a mark;”.
- (4) In subsection (3), for the words " that is shown to have been due to special circumstances in the trade " there shall be substituted the words " in relation to particular services that is shown to have been due to special circumstances affecting the provision of those services ".

Section 27

- 15 Section 27 (defensive registrations) shall be omitted.

Section 28

- 16 (1) In subsection (1) of section 28 (registered users) the words " (otherwise than as a defensive trade mark)" shall be omitted and for the words " goods with which he is connected in the course of trade " there shall be substituted the words " services with the provision of which he is connected in the course of business ".
- (2) In subsection (7) of that section, for the word " trade " there shall be substituted the word " business ".

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Section 31

17 For section 31 (use of trade mark for export trade) there shall be substituted the following section—

“31 Any act done in the United Kingdom in relation to services for use outside the United Kingdom which, if done in relation to services provided within the United Kingdom for use there, would constitute use of a mark in the United Kingdom, shall be deemed to constitute use of the mark in relation to those services for any purpose for which such use is material under this Act or at common law.”

Section 37

18 Section 37 and Schedule 1 (certification trade marks) shall be omitted.

Section 49

19 In section 49 (trade usage to be considered), for the words " trade name " there shall be substituted the words " business name " and for the words " the usages of the trade concerned " there shall be substituted the words " business usages in the provision of the services in question ".

Section 60

20 In subsection (2)(c) of section 60 (offences of false representation), for the words " goods to be exported to that country " there shall be substituted the words " services for use in that country ".

Section 61

21 In section 61 (restraint of use of Royal Arms, etc.), for the words " supplies goods " there shall be substituted the words " provides services ".

Section 62

22 In section 62 (change of form of trade connection not deceptive)—
(a) for the words " goods between ", in both places where they occur, there shall be substituted the words " services between the provision of "; and
(b) for the word " trade ", in both places where it occurs, there shall be substituted the word " business ".

Section 63

23 In section 63 (jointly owned marks), for paragraph (b) there shall be substituted the following paragraph—
“(b) in relation to services with the provision of which both or all of them are connected in the course of business,”.

Section 64A

24 Section 64A (restriction on importation of goods bearing infringing trade marks) shall be omitted.

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Section 68

- 25 (1) Section 68 (interpretation of Act) shall be modified as follows.
- (2) In subsection (1)—
- (a) in the definition of " limitations ", for the words from " goods to be sold " to the end there shall be substituted the words " services for use or available for acceptance in any place within the United Kingdom or in relation to services for use in any place outside the United Kingdom; "
 - (b) in the definition of "mark" the words "brand, heading, label, ticket" shall be omitted ; and
 - (c) after the definition of "prescribed" there shall be inserted the following definition—
 “ provision', relation to services, means their provision for money or money's worth ;”
- (3) In subsection (2) (what is use of a mark) for the words from " goods " to the end there shall be substituted the words " services shall be construed as references to the use of the mark as or as part of any statement about the availability or performance of services ".

Section 69

- 26 Section 69 and Schedule 3 shall be omitted.