

Status: Point in time view as at 05/05/2004.

Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, SCHEDULE 2. (See end of Document for details)

SCHEDULES

SCHEDULE 2

Section 50.

CERTIFICATION MARKS

Commencement Information

- II** Sch. 2 wholly in force; Sch. 2 not in force at Royal Assent see s. 109; Sch. 2 para. 7(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 2 not already in force by S.I. 1994/2550, arts. 2, 3(1), Sch.

General

- 1 The provisions of this Act apply to certification marks subject to the following provisions.

Signs of which a certification mark may consist

- 2 In relation to a certification mark the reference in section 1(1) (signs of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin

- 3 (1) Notwithstanding section 3(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.
- (2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Nature of proprietor's business

- 4 A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

- 5 (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.
- (2) The registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

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Notwithstanding section 39(2), an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

- 6 (1) An applicant for registration of a certification mark must file with the registrar regulations governing the use of the mark.
- (2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

Further requirements with which the regulations have to comply may be imposed by rules.

Approval of regulations, &c.

- 7 (1) A certification mark shall not be registered unless—
- (a) the regulations governing the use of the mark—
- (i) comply with paragraph 6(2) and any further requirements imposed by rules, and
- (ii) are not contrary to public policy or to accepted principles of morality, and
- (b) the applicant is competent to certify the goods or services for which the mark is to be registered.
- (2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the registrar and pay the prescribed fee.

If he does not do so, the application shall be deemed to be withdrawn.

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- 8 (1) The registrar shall consider whether the requirements mentioned in paragraph 7(1) are met.
- (2) If it appears to the registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations.
- (3) If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse the application.
- (4) If it appears to the registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 38 (publication, opposition proceedings and observations).

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- 9 The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

This is in addition to any other grounds on which the application may be opposed or observations made.

Regulations to be open to inspection

- 10 The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

Amendment of regulations

- 11 (1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the registrar and accepted by him.
- (2) Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published.
- (3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

Consent to assignment of registered certification mark

- 12 The assignment or other transmission of a registered certification mark is not effective without the consent of the registrar.

Infringement: rights of authorised users

- 13 The following provisions apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark—
- (a) section 10(5) (definition of infringement: unauthorised application of mark to certain material);
 - (b) section 19(2) (order as to disposal of infringing goods, material or articles: adequacy of other remedies);
 - (c) section 89 (prohibition of importation of infringing goods, material or articles: request to Commissioners of Customs and Excise).

- 14 In infringement proceedings brought by the proprietor of a registered certification mark any loss suffered or likely to be suffered by authorised users shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

- 15 Apart from the grounds of revocation provided for in section 46, the registration of a certification mark may be revoked on the ground—
- (a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4,

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- (b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1),
- (c) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark,
- (d) that an amendment of the regulations has been made so that the regulations—
 - (i) no longer comply with paragraph 6(2) and any further conditions imposed by rules, or
 - (ii) are contrary to public policy or to accepted principles of morality, or
- (e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

Grounds for invalidity of registration

- 16 Apart from the grounds of invalidity provided for in section 47, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4, 5(1) or 7(1).

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