

SCHEDULES

FIRST SCHEDULE

Section 37.

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 sub-paragraph (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 sub-paragraph (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 sub-paragraph (2) of this paragraph of any opposition relating to any of the matters referred to in sub-paragraph (5) of the last foregoing paragraph.

- (2) When notice of opposition is given relating to any of the matters referred to in sub-paragraph (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;

and neither the Court nor the 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

Section 38.

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 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

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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 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

Section 69.

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 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 Trade Marks (Amendment) Act, 1937, and which, having regard to any amendment by that Act of the Trade Marks Act, 1905, or of the Trade Marks Act, 1919, whether as respects limitations that might be imposed on registration or as respects any other matter, was then a registrable trade mark under the Trade Marks Acts, 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 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 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.

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) of 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

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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.

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.

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*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 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 :—
- (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.

Cotton marks registered before appointed day

- 8 No registration as of a date before the appointed day of a cotton mark as denned in section sixty-four of the 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, fine heading, or any combination thereof.