

SCHEDULE

Amendments to the Trade Marks (Isle of Man) Order 2013

19. For paragraph 38 substitute—

“38.—(1) Schedule 1 (collective marks) is amended as follows.

(2) In paragraph 5—

- (a) in sub-paragraph (2) omit “, where they exist,”;
- (b) the second sentence of sub-paragraph (2) is renumbered as sub-paragraph (4), and
- (c) before sub-paragraph (4) insert—

“(3) Where the regulations govern use of a mark referred to in paragraph 3(1), they must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.”.

(3) In paragraph 6(1)(a) after “paragraph 5(2)” insert “and (3)”.

(4) In paragraph 11(c) for “Commissioners of Customs and Excise” substitute “the Treasury”.

(5) In paragraph 12—

(a) for sub-paragraph (2), substitute—

“(2) Subject to any agreement to the contrary between the authorised user and the proprietor, an authorised user may only bring proceedings for infringement of a registered collective mark with the consent of the proprietor.”;

(b) omit sub-paragraph (3);

(c) in sub-paragraph (4), omit “Where infringement proceedings are brought by virtue of this paragraph” and substitute “Where proceedings are brought by an authorised user for infringement of a registered collective mark (with the consent of the proprietor or pursuant to any agreement referred to in sub-paragraph (2))”;

(d) after sub-paragraph (6), insert—

“(7) Where the proprietor of a registered collective mark brings infringement proceedings, an authorised user who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.”.

(6) In paragraph 13—

(a) in sub-paragraph (a), for “proprietor” substitute “persons authorised to use it”;

(b) in sub-paragraph (b)—

(i) for “has failed to observe, or to secure the observance of,” substitute “has not taken reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in”; and

(ii) after “mark” insert “(as amended from time to time)”;

(c) in sub-paragraph (c)(i), after “paragraph 5(2)” insert “and (3)”.

(7) In paragraph 14—

(a) for “may” substitute “shall”;

(b) after “the provisions of” insert “section 49(1A) (definition of who may be registered as the proprietor of a certification mark) or”;

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- (c) after “6(1)” insert “unless the breach was only of paragraph 6(1) and the proprietor of the mark, by amending the regulations governing use, complies with the requirements of paragraph 6(1).”.