

## SCHEDULE

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

#### 8. For paragraph 6, substitute—

“6.—(1) Section 10 (infringement of registered trade mark) is amended as follows.

(2) In subsection (3)—

(a) after “course of trade” insert “, in relation to goods or services,”; and

(b) omit paragraph (b) and the word “and” immediately before it.

(3) After subsection (3) insert—

“(3A) Subsection (3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to or not similar to those for which the trade mark is registered.

(3B) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of the trade mark, a person infringes a registered trade mark if the person carries out in the course of trade any of the following acts—

(a) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed; or

(b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.”.

(4) In subsection (4)(c), after “under the sign,” omit “or”.

(5) After subsection (4)(c), insert—

“(ca) uses the sign as a trade or company name or part of a trade or company name;”.

(6) In subsection (4)(d)—

(a) for “or” substitute “and”; and

(b) after “advertising” insert “; or”.

(7) Omit subsections (5) and (6).

6A. After section 10, insert—

#### **“10A Right to prevent goods entering the UK without being released for free circulation**

(1) The proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into the United Kingdom in the course of trade without being released for free circulation if they are goods for which the trade mark is registered which—

(a) come from outside the customs territory of the EU; and

(b) bear without authorisation a sign which is identical with the trade mark or cannot be distinguished in its essential aspects from the trade mark.

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(2) In subsection (1) the reference to goods for which the trade mark is registered includes a reference to the packaging of goods for which the trade mark is registered.

(3) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of application for registration of the trade mark, or (where applicable) the date of the priority claimed in respect of that application.

(4) The entitlement of the proprietor under subsection (1) is to lapse if—

- (a) proceedings are initiated in accordance with the European Customs Enforcement Regulation to determine whether the trade mark has been infringed; and
- (b) during those proceedings evidence is provided by the declarant or the holder of the goods that the proprietor of the trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

(5) References in this Act to the “European Customs Enforcement Regulation” are references to Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights<sup>(1)</sup>.

#### **10B Prohibition on the use of a trade mark registered in the name of an agent or representative**

(1) Subsection (2) applies where a trade mark is registered in the name of an agent or representative of a person (“P”) who is the proprietor of the trade mark, without P’s consent.

(2) Unless the agent or representative justifies the action mentioned in subsection (1), P may do either or both of the following—

- (a) prevent the use of the trade mark by the agent or representative (notwithstanding the rights conferred by this Act in relation to a registered trade mark);
- (b) apply for the rectification of the register so as to substitute P’s name as the proprietor of the registered trade mark.”.

**6B.**—(1) Section 11 (limits on effect of registered trade mark) is amended as follows.

(2) In subsection (1) omit “another registered trade mark in relation to goods and services for which the latter is registered (but see section 47(6) (effect of declaration of invalidity of registration))” and substitute “a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1)”.

(3) After subsection (1) insert—

“(1A) A registered trade mark is not infringed by the use of a later registered European Union trade mark where that later European Union trade mark would not be declared invalid as a result of Article 60(1), (3), (4), 61(1), (2) or 64(2) of the European Union Trade Mark Regulation.

(1B) Where subsection (1) or (1A) applies, the later registered trade mark is not infringed by the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later registered trade mark.”.

(4) In subsection (2)(a) for “a person” substitute “an individual”.

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(1) OJNo. L 181/15, 29.6.2013, p.1.

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(5) In subsection (2)(b) for “indications concerning” substitute “signs or indications which are not distinctive or which concern”.

(6) In subsection (2)(c) for “where it” substitute “for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use”.

**6C.** After section 11, insert—

**“11A Non-use as defence in infringement proceedings**

(1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1)(a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.

(2) Subsection (3) applies in relation to an action for infringement of a registered trade mark where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought.

(3) If the defendant so requests, the proprietor of the trade mark must furnish proof—

(a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in the United Kingdom by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action, or

(b) that there are proper reasons for non-use.

(4) Nothing in subsections (2) and (3) overrides any provision of section 46, as applied by subsection (1) (including the words from “Provided that” to the end of subsection (3)).”.”.