

*Status: This version of this schedule contains provisions that are prospective.*

*Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, SCHEDULE 3. (See end of Document for details)*

## SCHEDULES

### SCHEDULE 3

Section 105.

#### TRANSITIONAL PROVISIONS

##### Commencement Information

- II** Sch. 3 wholly in force at 31.10.1994; Sch. 3 not in force at Royal Assent see s. 109; Sch. 3 paras. 10(2), 11(2), 12, 14(5) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as Sch. 3 not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

##### *Introductory*

1 (1) In this Schedule—

“existing registered mark” means a trade mark, certification trade mark or service mark registered under the 1938 Act immediately before the commencement of this Act;

“the 1938 Act” means the <sup>M1</sup>Trade Marks Act 1938; and

“the old law” means that Act and any other enactment or rule of law applying to existing registered marks immediately before the commencement of this Act.

(2) For the purposes of this Schedule—

- (a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before commencement, and
- (b) the date on which it was made shall be taken to be the date of filing under the 1938 Act.

##### Marginal Citations

- M1** 1938 c. 22.

##### *Existing registered marks*

- 2 (1) Existing registered marks (whether registered in Part A or B of the register kept under the 1938 Act) shall be transferred on the commencement of this Act to the register kept under this Act and have effect, subject to the provisions of this Schedule, as if registered under this Act.
- (2) Existing registered marks registered as a series under section 21(2) of the 1938 Act shall be similarly registered in the new register.

Provision may be made by rules for putting such entries in the same form as is required for entries under this Act.

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- (3) In any other case notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement of this Act.

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- 3 (1) A condition entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall cease to have effect on commencement.

Proceedings under section 33 of the 1938 Act (application to expunge or vary registration for breach of condition) which are pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

- (2) A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of section 13 of this Act.

*Effects of registration: infringement*

- 4 (1) Sections 9 to 12 of this Act (effects of registration) apply in relation to an existing registered mark as from the commencement of this Act and section 14 of this Act (action for infringement) applies in relation to infringement of an existing registered mark committed after the commencement of this Act, subject to sub-paragraph (2) below.

The old law continues to apply in relation to infringements committed before commencement.

- (2) It is not an infringement of—  
(a) an existing registered mark, or  
(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue after commencement any use which did not amount to infringement of the existing registered mark under the old law.

*Infringing goods, material or articles*

- 5 Section 16 of this Act (order for delivery up of infringing goods, material or articles) applies to infringing goods, material or articles whether made before or after the commencement of this Act.

*Rights and remedies of licensee or authorised user*

- 6 (1) Section 30 (general provisions as to rights of licensees in case of infringement) of this Act applies to licences granted before the commencement of this Act, but only in relation to infringements committed after commencement.

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- (2) Paragraph 14 of Schedule 2 of this Act (court to take into account loss suffered by authorised users, &c.) applies only in relation to infringements committed after commencement.

#### *Co-ownership of registered mark*

- 7 The provisions of section 23 of this Act (co-ownership of registered mark) apply as from the commencement of this Act to an existing registered mark of which two or more persons were immediately before commencement registered as joint proprietors.

But so long as the relations between the joint proprietors remain such as are described in section 63 of the 1938 Act (joint ownership) there shall be taken to be an agreement to exclude the operation of subsections (1) and (3) of section 23 of this Act (ownership in undivided shares and right of co-proprietor to make separate use of the mark).

#### *Assignment, &c. of registered mark*

- 8 (1) Section 24 of this Act (assignment or other transmission of registered mark) applies to transactions and events occurring after the commencement of this Act in relation to an existing registered mark; and the old law continues to apply in relation to transactions and events occurring before commencement.

- (2) Existing entries under section 25 of the 1938 Act (registration of assignments and transmissions) shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 25 of this Act.

Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.

- (3) An application for registration under section 25 of the 1938 Act which is pending before the registrar on the commencement of this Act shall be treated as an application for registration under section 25 of this Act and shall proceed accordingly.

The registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

- (4) An application for registration under section 25 of the 1938 Act which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

- (5) Where before the commencement of this Act a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after commencement shall be made under section 25 of this Act.

- (6) In cases to which sub-paragraph (3) or (5) applies section 25(3) of the 1938 Act continues to apply (and section 25(3) and (4) of this Act do not apply) as regards the consequences of failing to register.

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*Licensing of registered mark*

- 9 (1) Sections 28 and 29(2) of this Act (licensing of registered trade mark; rights of exclusive licensee against grantor's successor in title) apply only in relation to licences granted after the commencement of this Act; and the old law continues to apply in relation to licences granted before commencement.
- (2) Existing entries under section 28 of the 1938 Act (registered users) shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under section 25 of this Act.
- Provision may be made by rules for putting such entries in the same form as is required for entries made under this Act.
- (3) An application for registration as a registered user which is pending before the registrar on the commencement of this Act shall be treated as an application for registration of a licence under section 25(1) of this Act and shall proceed accordingly.
- The registrar may require the applicant to amend his application so as to conform with the requirements of this Act.
- (4) An application for registration as a registered user which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.
- (5) Any proceedings pending on the commencement of this Act under section 28(8) or (10) of the 1938 Act (variation or cancellation of registration of registered user) shall be dealt with under the old law and any necessary alteration made to the new register.

*Pending applications for registration*

- 10 (1) An application for registration of a mark under the 1938 Act which is pending on the commencement of this Act shall be dealt with under the old law, subject as mentioned below, and if registered the mark shall be treated for the purposes of this Schedule as an existing registered mark.
- (2) The power of the Secretary of State under section 78 of this Act to make rules regulating practice and procedure, and as to the matters mentioned in subsection (2) of that section, is exercisable in relation to such an application; and different provision may be made for such applications from that made for other applications.
- (3) Section 23 of the 1938 Act (provisions as to associated trade marks) shall be disregarded in dealing after the commencement of this Act with an application for registration.

**Commencement Information**

- 12** Sch. 3 para. 10 wholly in force; Sch. 3 para. 10 not in force at Royal Assent see s. 109; Sch. 3 para. 10(2) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by S.I. 1994/2550, arts. 2, 3(1), Sch.

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### *Conversion of pending application*

- 11 (1) In the case of a pending application for registration which has not been advertised under section 18 of the 1938 Act before the commencement of this Act, the applicant may give notice to the registrar claiming to have the registrability of the mark determined in accordance with the provisions of this Act.
- (2) The notice must be in the prescribed form, be accompanied by the appropriate fee and be given no later than six months after the commencement of this Act.
- (3) Notice duly given is irrevocable and has the effect that the application shall be treated as if made immediately after the commencement of this Act.

#### **Commencement Information**

- I3** Sch. 3 para. 11 wholly in force; Sch. 3 para. 11 not in force at Royal Assent see s. 109; Sch. 3 para. 11 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

### *Trade marks registered according to old classification*

- 12 The registrar may exercise the powers conferred by rules under section 65 of this Act (adaptation of entries to new classification) to secure that any existing registered marks which do not conform to the system of classification prescribed under section 34 of this Act are brought into conformity with that system.

This applies, in particular, to existing registered marks classified according to the pre-1938 classification set out in Schedule 3 to the <sup>M2</sup>Trade Marks Rules 1986.

#### **Commencement Information**

- I4** Sch. 3 para. 12 wholly in force; Sch. 3 para. 12 not in force at Royal Assent see s. 109; Sch. 3 para. 12 in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

#### **Marginal Citations**

- M2** [S.I. 1986/1319](#).

### *Claim to priority from overseas application*

- 13 Section 35 of this Act (claim to priority of Convention application) applies to an application for registration under this Act made after the commencement of this Act notwithstanding that the Convention application was made before commencement.
- 14 (1) Where before the commencement of this Act a person has duly filed an application for protection of a trade mark in a relevant country within the meaning of section 39A of the 1938 Act which is not a Convention country (a “relevant overseas application”), he, or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the relevant overseas application.

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- (2) If the application for registration under this Act is made within that six-month period—
- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the relevant overseas application, and
  - (b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

- (3) Any filing which in a relevant country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

A “regular national filing” means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

- (4) A subsequent application concerning the same subject as the relevant overseas application, filed in the same country, shall be considered the relevant overseas application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application—
- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and
  - (b) it has not yet served as a basis for claiming a right of priority.

The previous application may not thereafter serve as a basis for claiming a right of priority.

- (5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a relevant overseas application.
- (6) A right to priority arising as a result of a relevant overseas application may be assigned or otherwise transmitted, either with the application or independently.

The reference in sub-paragraph (1) to the applicant’s “successor in title” shall be construed accordingly.

- (7) Nothing in this paragraph affects proceedings on an application for registration under the 1938 Act made before the commencement of this Act (see paragraph 10 above).

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**Commencement Information**

- I5** Sch. 3 wholly in force; Sch. 3 not in force at Royal Assent see s. 109; Sch. 3 para. 14(5) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as not already in force by [S.I. 1994/2550](#), arts. 2, 3(1), [Sch.](#)

*Duration and renewal of registration*

- 15 (1) Section 42(1) of this Act (duration of original period of registration) applies in relation to the registration of a mark in pursuance of an application made after the commencement of this Act; and the old law applies in any other case.

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- (2) Sections 42(2) and 43 of this Act (renewal) apply where the renewal falls due on or after the commencement of this Act; and the old law continues to apply in any other case.
- (3) In either case it is immaterial when the fee is paid.

*Pending application for alteration of registered mark*

PROSPECTIVE

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| 16 | An application under section 35 of the 1938 Act (alteration of registered trade mark) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register. |
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*Revocation for non-use*

- 17 (1) An application under section 26 of the 1938 Act (removal from register or imposition of limitation on ground of non-use) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.
- (2) An application under section 46(1)(a) or (b) of this Act (revocation for non-use) may be made in relation to an existing registered mark at any time after the commencement of this Act.  
Provided that no such application for the revocation of the registration of an existing registered mark registered by virtue of section 27 of the 1938 Act (defensive registration of well-known trade marks) may be made until more than five years after the commencement of this Act.

*Application for rectification, &c.*

- 18 (1) An application under section 32 or 34 of the 1938 Act (rectification or correction of the register) which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.
- (2) For the purposes of proceedings under section 47 of this Act (grounds for invalidity of registration) as it applies in relation to an existing registered mark, the provisions of this Act shall be deemed to have been in force at all material times.  
Provided that no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection (3) of section 5 of this Act (relative grounds for refusal of registration: conflict with earlier mark registered for different goods or services).

*Regulations as to use of certification mark*

- 19 (1) Regulations governing the use of an existing registered certification mark deposited at the Patent Office in pursuance of section 37 of the 1938 Act shall be treated after the commencement of this Act as if filed under paragraph 6 of Schedule 2 to this Act.
- (2) Any request for amendment of the regulations which was pending on the commencement of this Act shall be dealt with under the old law.

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### *Sheffield marks*

- 20 (1) For the purposes of this Schedule the Sheffield register kept under Schedule 2 to the 1938 Act shall be treated as part of the register of trade marks kept under that Act.
- (2) Applications made to the Cutlers' Company in accordance with that Schedule which are pending on the commencement of this Act shall proceed after commencement as if they had been made to the registrar.

### *Certificate of validity of contested registration*

- 21 A certificate given before the commencement of this Act under section 47 of the 1938 Act (certificate of validity of contested registration) shall have effect as if given under section 73(1) of this Act.

### *Trade mark agents*

- 22 (1) Rules in force immediately before the commencement of this Act under section 282 or 283 of the <sup>M3</sup>Copyright, Designs and Patents Act 1988 (register of trade mark agents; persons entitled to described themselves as registered) shall continue in force and have effect as if made under section 83 or 85 of this Act.
- (2) Rules in force immediately before the commencement of this Act under section 40 of the 1938 Act as to the persons whom the registrar may refuse to recognise as agents for the purposes of business under that Act shall continue in force and have effect as if made under section 88 of this Act.
- (3) Rules continued in force under this paragraph may be varied or revoked by further rules made under the relevant provisions of this Act.

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#### **Marginal Citations**

**M3** 1988 c. 48.

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