



Trade Marks Act 1938

1938 CHAPTER 22

GENERAL AND MISCELLANEOUS.

Rules and fees

40 Power of Board of Trade to make rules

- (1) The Board of Trade may from time to time make such rules, prescribe such forms and generally do such things as they think expedient—
 - (a) for regulating the practice under this Act, including the service of documents;
 - (b) for classifying goods for the purposes of registration of trade marks;
 - (c) for making or requiring duplicates of trade marks and other documents;
 - (d) for securing and regulating the publishing and selling or distributing, in such manner as the Board of Trade think fit, of copies of trade marks and other documents;
 - (e) generally, for regulating the business of the Patent Office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar or of the Board of Trade.
- (2) Rules made under this Act shall, while in force, be of the same effect as if they were contained in this Act.
- (3) Before making any rules under this Act, the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained, in such manner as the Board consider most expedient so as to enable persons affected to make representations to the Board before the rules are finally settled.
- (4) Any rules so made shall be forthwith advertised twice in the Trade Marks Journal, and shall be laid before both Houses of Parliament, if Parliament be in session at the time of the making thereof, or, if not, as soon as practicable after the beginning of the then next session of Parliament.
- (5) If either House of Parliament, within the next forty days after any rules have been so laid before it, resolves that the rules or any of them ought to be annulled, the rule or

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rules shall thenceforth be of no effect, but without prejudice to the validity of anything previously done thereunder or to the making of any new rule or rules.

41 Fees

There shall be paid in respect of applications and registration and other matters under this Act such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade.

Powers and duties of Registrar

42 Preliminary advice by Registrar as to distinctiveness

- (1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar prima facie to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.
- (2) Any such person who is desirous of obtaining such advice must make application to the Registrar therefor in the prescribed manner.
- (3) If on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

43 Hearing before exercise of Registrar's discretion

Where any discretionary or other power is given to the Registrar by this Act or the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

44 Power of Registrar to award costs

In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court or a judge thereof, be enforced in the same manner as a judgment or order of the Court to the same effect.

45 Annual reports of Registrar

The Comptroller-General of Patents, Designs and Trade Marks shall, in his annual report on the execution by or under him of the Patents and Designs Act, 1907, and Acts amending that Act, include a report respecting the execution by or under him of this Act as if it formed a part of or was included in those Acts.

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Legal proceedings and appeals

46 Registration to be prima facie evidence of validity

In all legal proceedings relating to a registered trade mark (including applications under section thirty-two of this Act) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

47 Certificate of validity

In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

48 Costs of Registrar in proceedings before Court, and payment of costs by Registrar

- (1) In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but, in any proceedings in England or Northern Ireland, the Registrar shall not, except in accordance with the provisions of subsection (2) of this section in a case in which he has appeared in the proceedings, be ordered to pay the costs of any other of the parties.
- (2) Where the Registrar appears in any proceedings before the Court in England or Northern Ireland under this Act, section seven of the Administration of Justice (Miscellaneous Provisions) Act, 1933, or any corresponding enactment which may be passed by the Parliament of Northern Ireland, as the case may be, shall have effect as it has effect in relation to other proceedings to which the Crown is a party in a court having the power to award costs in cases between subjects.

49 Trade usage, and c. to be considered

In any action or proceeding relating to a trade mark or trade name, the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade -name or get-up legitimately used by other persons.

50 Registrar's appearance in proceedings involving rectification

- (1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.
- (2) Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the Patent Office in like cases or of such other matters relevant to the issues, and within his knowledge as Registrar,

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as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

51 Court's power to review Registrar's decision

The Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-two of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

52 Discretion of Court in appeals

In any appeal from a decision of the Registrar to the Court under this Act, the Court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

53 Procedure on appeal to Board of Trade

Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer the appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

54 Procedure in cases of option to apply to Court or Registrar

Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the Court or to the Registrar—

- (a) if an action concerning the trade mark in question is pending, the application must be made to the Court;
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the Court, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

Evidence

55 Mode of giving evidence

In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the tribunal thinks it right so to do, the tribunal may take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *viva voce*, the Board of Trade or the Registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

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56 Evidence of orders, and c. of Board of Trade

- (1) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or an under-secretary or an assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.
- (2) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

57 Evidence of entries in register

- (1) A printed or written copy of any entry in the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original.
- (2) Any person requiring such a certified copy as aforesaid shall be entitled to obtain it on payment of the prescribed fee.

58 Evidence of things done by Registrar

A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act 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.

Offences and restraint of use of Royal Arms

59 Falsification of entries in register a misdemeanour

- (1) If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.
- (2) In the Isle of Man the punishment for an offence under this section shall be imprisonment for any term not exceeding two years, with or without hard labour and with or without a fine not exceeding one hundred pounds, at the discretion of the court.

60 Fine for falsely representing a trade mark as registered

- (1) Any person who makes a representation—
 - (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
 - (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
 - (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or

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- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right;
shall be liable on summary conviction to a fine not exceeding five pounds.
- (2) For the purposes of this section, the use in the United Kingdom in relation to a trade mark of the word "registered", or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—
- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside the United Kingdom, being a country under the law of which the registration referred to is in fact in force;
 - (b) where that word (being a word other than the word "registered") is of itself such as to indicate that the reference is to such registration as last aforesaid; or
 - (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside the United Kingdom and in relation to goods to be exported to that country.
- (3) An offence under this section committed in the Isle of Man may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

61 Restraint of use of Royal Arms, and c

If any person, without the authority of His Majesty, uses, in connection with any trade, business, calling or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person, without the authority of His Majesty or of a member of the Royal Family, uses, in connection with any trade, business, calling or profession, any device, emblem or title in such manner as to be calculated to lead to the belief that he is employed by, or supplies goods to, His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction from continuing so to use the same :

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem or title to continue to use such trade mark.

Miscellaneous

62 Change of form of trade connection not to be deemed to cause deception

The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

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63 Jointly owned trade marks

Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

- (a) on behalf of both or all of them, or
- (b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

Subject as aforesaid, nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

64 Trusts and equities

- (1) There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.
- (2) Subject to the provisions of this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

65 Recognition of agents

Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may under and in accordance with the rules, or in particular cases by special leave of the Board of Trade, be done by or to an agent of that person duly authorised in the prescribed manner.

66 Saving for jurisdiction of courts in Scotland, Northern Ireland and Isle of Man

- (1) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Northern Ireland in any proceedings relating to trade marks; and with reference to any such proceedings in Scotland the expression "the Court" means the Court of Session; and with reference to any such proceedings in Northern Ireland the expression "the Court" means the High Court of Justice in Northern Ireland.
- (2) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement or in any action or proceeding respecting a trade mark competent to those courts.

67 Exercise of powers of Board of Trade

All things required or authorised under this Act to be done by, to or before the Board of Trade may be done by, to or before the President or a secretary or an under-secretary or an assistant secretary of the Board or any person authorised in that behalf by the President of the Board.

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Supplemental

68 Interpretation

(1) In this Act, unless the context otherwise requires, the following expressions have the meanings hereby assigned to them respectively, that is to say:—

" the appointed day " has the meaning assigned to it by section seventy-one of this Act;

" assignment " means assignment by act of the parties concerned;

" the Court " means (subject to provisions relating to Scotland, Northern Ireland or the Isle of Man) His Majesty's High Court of Justice in England;

" limitations " means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place within the "United Kingdom, or as to use in relation to goods to be exported to any market outside the United Kingdom;

" mark " includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;

" permitted use " has the meaning assigned to it by subsection (1) of section twenty-eight of this Act;

" prescribed " means, in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules;

" the register " means the register of trade marks kept under this Act;

" registered trade mark " means a trade mark that is actually on the register;

" registered user " means a person who is for the time being registered as such under section twenty-eight of this Act;

" the Registrar " means the Comptroller-General of Patents, Designs and Trade Marks;

" the rules " means rules made by the Board of Trade under section thirty-six or section forty of this Act;

" trade mark " means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section thirty-seven of this Act;

" transmission " means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode" of transfer not being assignment;

" United Kingdom " includes the Isle of Man.

(2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references therein to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.

(3) In the application of this Act to Scotland, the expressions "injunction," " plaintiff " and " defendant " mean respectively " interdict," " pursuer" and " defender."

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69 Transitional provisions

The transitional provisions set out in the Third Schedule to this Act shall have effect with respect to the matters therein mentioned respectively.

70 Repeal and savings

- (1) The enactments set out in the Fourth Schedule to this Act are hereby repealed to the extent specified in the third column of that Schedule.
- (2) Nothing in this Act shall affect any order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made, or thing done, under any enactment repealed by this Act; and every such order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force at the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given or done under this Act, have effect as if made, issued, given or done under the corresponding enactment of this Act.
- (3) Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.
- (4) Nothing in this section shall be taken to prejudice the provisions of section thirty-eight of the Interpretation Act, 1889.

71 Short title, commencement and extent

- (1) This Act may be cited as the Trade Marks Act, 1938.
- (2) This Act shall come into operation on the date fixed by order made under subsection (5) of section thirty-three of the Trade Marks (Amendment) Act, 1937, for the coming into operation of that Act (in this Act referred to as " the appointed day "), immediately after the coming into operation of that Act.
- (3) It is hereby declared that this Act extends to Northern Ireland.
- (4) This Act shall extend to the Isle of Man.