



Copyright, Designs and Patents Act 1988

1988 CHAPTER 48

PART VII

MISCELLANEOUS AND GENERAL

Fraudulent application or use of trade mark

300 Fraudulent application or use of trade mark an offence

In the Trade Marks Act 1938 the following sections are inserted before section 59, after the heading “*Offences and restraint of use of Royal Arms*”—

“58A Fraudulent application or use of trade mark an offence

- (1) It is an offence, subject to subsection (3) below, for a person—
- (a) to apply a mark identical to or nearly resembling a registered trade mark to goods, or to material used or intended to be used for labelling, packaging or advertising goods, or
 - (b) to sell, let for hire, or offer or expose for sale or hire, or distribute—
 - (i) goods bearing such a mark, or
 - (ii) material bearing such a mark which is used or intended to be used for labelling, packaging or advertising goods, or
 - (c) to use material bearing such a mark in the course of a business for labelling, packaging or advertising goods, or
 - (d) to possess in the course of a business goods or material bearing such a mark with a view to doing any of the things mentioned in paragraphs (a) to (c),

when he is not entitled to use the mark in relation to the goods in question and the goods are not connected in the course of trade with a person who is so entitled.

Status: This is the original version (as it was originally enacted).

- (2) It is also an offence, subject to subsection (3) below, for a person to possess in the course of a business goods or material bearing a mark identical to or nearly resembling a registered trade mark with a view to enabling or assisting another person to do any of the things mentioned in subsection (1)(a) to (c), knowing or having reason to believe that the other person is not entitled to use the mark in relation to the goods in question and that the goods are not connected in the course of trade with a person who is so entitled.
- (3) A person commits an offence under subsection (1) or (2) only if—
- (a) he acts with a view to gain for himself or another, or with intent to cause loss to another, and
 - (b) he intends that the goods in question should be accepted as connected in the course of trade with a person entitled to use the mark in question;
- and it is a defence for a person charged with an offence under subsection (1) to show that he believed on reasonable grounds that he was entitled to use the mark in relation to the goods in question.
- (4) A person guilty of an offence under this section is liable—
- (a) on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both;
 - (b) on conviction on indictment to a fine or imprisonment for a term not exceeding ten years, or both.
- (5) Where an offence under this section committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.
- In relation to a body corporate whose affairs are managed by its members “director” means a member of the body corporate.
- (6) In this section “business” includes a trade or profession.”

58B Delivery up of offending goods and material

- (1) The court by which a person is convicted of an offence under section 58A may, if satisfied that at the time of his arrest or charge he had in his possession, custody or control—
- (a) goods or material in respect of which the offence was committed, or
 - (b) goods of the same description as those in respect of which the offence was committed, or material similar to that in respect of which the offence was committed, bearing a mark identical to or nearly resembling that in relation to which the offence was committed,
- order that the goods or material be delivered up to such person as the court may direct.
- (2) For this purpose a person shall be treated as charged with an offence—
- (a) in England, Wales and Northern Ireland, when he is orally charged or is served with a summons or indictment;
 - (b) in Scotland, when he is cautioned, charged or served with a complaint or indictment.

Status: This is the original version (as it was originally enacted).

- (3) An order may be made by the court of its own motion or on the application of the prosecutor (or, in Scotland, the Lord Advocate or procurator-fiscal), but shall not be made if it appears to the court unlikely that any order will be made under section 58C (order as to disposal of offending goods or material).
- (4) An appeal lies from an order made under this section by a magistrates' court—
 - (a) in England and Wales, to the Crown Court, and
 - (b) in Northern Ireland, to the county court;and in Scotland, where an order has been made under this section, the person from whose possession, custody or control the goods or material have been removed may, without prejudice to any other form of appeal under any rule of law, appeal against that order in the same manner as against sentence.
- (5) A person to whom goods or material are delivered up in pursuance of an order under this section shall retain it pending the making of an order under section 58C.
- (6) Nothing in this section affects the powers of the court under section 43 of the Powers of Criminal Courts Act 1973, section 223 or 436 of the Criminal Procedure (Scotland) Act 1975 or Article 7 of the Criminal Justice (Northern Ireland) Order 1980 (general provisions as to forfeiture in criminal proceedings).

58C Order as to disposal of offending goods or material

- (1) Where goods or material have been delivered up in pursuance of an order under section 58B, an application may be made to the court for an order that they be destroyed or forfeited to such person as the court may think fit.
- (2) Provision shall be made by rules of court as to the service of notice on persons having an interest in the goods or material, and any such person is entitled—
 - (a) to appear in proceedings for an order under this section, whether or not he was served with notice, and
 - (b) to appeal against any order made, whether or not he appeared;and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.
- (3) Where there is more than one person interested in goods or material, the court shall make such order as it thinks just.
- (4) References in this section to a person having an interest in goods or material include any person in whose favour an order could be made under this section or under sections 114, 204 or 231 of the Copyright, Designs and Patents Act 1988 (which make similar provision in relation to infringement of copyright, rights in performances and design right).
- (5) Proceedings for an order under this section may be brought—
 - (a) in a county court in England, Wales and Northern Ireland, provided the value of the goods or material in question does not exceed the county court limit for actions in tort, and
 - (b) in a sheriff court in Scotland;

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but this shall not be construed as affecting the jurisdiction of the High Court or, in Scotland, the Court of Session.

58D Enforcement of section 58A

- (1) The functions of a local weights and measures authority include the enforcement in their area of section 58A.
- (2) The following provisions of the Trade Descriptions Act 1968 apply in relation to the enforcement of that section as in relation to the enforcement of that Act—
section 27 (power to make test purchases),
section 28 (power to enter premises and inspect and seize goods and documents),
section 29 (obstruction of authorised officers), and
section 33 (compensation for loss, &c. of goods seized under s.28).
- (3) Subsection (1) above does not apply in relation to the enforcement of section 58A in Northern Ireland, but the functions of the Department of Economic Development include the enforcement of that section in Northern Ireland.

For that purpose the provisions of the Trade Descriptions Act 1968 specified in subsection (2) apply as if for the references to a local weights and measures authority and any officer of such an authority there were substituted references to that Department and any of its officers.

- (4) Any enactment which authorises the disclosure of information for the purpose of facilitating the enforcement of the Trade Descriptions Act 1968 shall apply as if section 58A above were contained in that Act and as if the functions of any person in relation to the enforcement of that section were functions under that Act.”.