



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART III

#### ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

##### *Legal proceedings and appeals*

#### **72 Registration to be prima facie evidence of validity.**

In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

#### **Modifications etc. (not altering text)**

C1 S. 72 applied (with modifications) (14.8.1996) by S.I. 1996/1908, reg. 3(3)

#### **73 Certificate of validity of contested registration.**

- (1) If in proceedings before the court the validity of the registration of a trade mark is contested and it is found by the court that the trade mark is validly registered, the court may give a certificate to that effect.
- (2) If the court gives such a certificate and in subsequent proceedings—
  - (a) the validity of the registration is again questioned, and
  - (b) the proprietor obtains a final order or judgment in his favour,he is entitled to his costs as between solicitor and client unless the court directs otherwise.

This subsection does not extend to the costs of an appeal in any such proceedings.

*Status: Point in time view as at 01/10/2009.*

*Changes to legislation: There are currently no known outstanding effects for the Trade Marks Act 1994, Cross Heading: Legal proceedings and appeals. (See end of Document for details)*

**Modifications etc. (not altering text)**

**C2** S. 73 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 15(1)**

**74 Registrar’s appearance in proceedings involving the registrar.**

- (1) In proceedings before the court involving an application for—
- (a) the revocation of the registration of a trade mark,
  - (b) a declaration of the invalidity of the registration of a trade mark, or
  - (c) the rectification of the register,
- the registrar is entitled to appear and be heard, and shall appear if so directed by the court.
- (2) Unless otherwise directed by the court, the registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of—
- (a) any proceedings before him in relation to the matter in issue,
  - (b) the grounds of any decision given by him affecting it,
  - (c) the practice of the Patent Office in like cases, or
  - (d) such matters relevant to the issues and within his knowledge as registrar as he thinks fit;
- and the statement shall be deemed to form part of the evidence in the proceedings.
- (3) Anything which the registrar is or may be authorised or required to do under this section may be done on his behalf by a duly authorised officer.

**Modifications etc. (not altering text)**

**C3** S. 74 applied (with modifications) (1.4.1996) by S.I. 1996/714, **art. 15(2)**

S. 74 applied (with modifications) (14.8.1996) by S.I. 1996/1908, **reg. 3(3)**

**75 The court.**

In this Act, unless the context otherwise requires, “the court” means—

- (a) in England and Wales [<sup>F1</sup>and]<sup>F1</sup>, the High Court or a county court having jurisdiction by virtue of an order made under section 1 of the Courts and Legal Services Act 1990,
- (aa) in] Northern Ireland, the High Court, and
- (b) in Scotland, the Court of Session.

**Textual Amendments**

**F1** Words in s. 75(a) substituted (E.W.) (1.4.2005) by [High Court and County Courts Jurisdiction \(Amendment\) Order 2005 \(S.I. 2005/587\)](#), arts. 1, **4(2)**

**76 Appeals from the registrar.**

- (1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules.

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For this purpose “decision” includes any act of the registrar in exercise of a discretion vested in him by or under this Act.

- (2) Any such appeal may be brought either to an appointed person or to the court.
- (3) Where an appeal is made to an appointed person, he may refer the appeal to the court if—
  - (a) it appears to him that a point of general legal importance is involved,
  - (b) the registrar requests that it be so referred, or
  - (c) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.

Before doing so the appointed person shall give the appellant and any other party to the appeal an opportunity to make representations as to whether the appeal should be referred to the court.

- (4) Where an appeal is made to an appointed person and he does not refer it to the court, he shall hear and determine the appeal and his decision shall be final.
- (5) The provisions of sections 68 and 69 (costs and security for costs; evidence) apply in relation to proceedings before an appointed person as in relation to proceedings before the registrar.

[<sup>F2</sup>(6) In the application of this section to England and Wales, “the court” means the High Court.]

#### Textual Amendments

**F2** S. 76(6) inserted (E.W.) (1.4.2005) by [High Court and County Courts Jurisdiction \(Amendment\) Order 2005 \(S.I. 2005/587\)](#), [arts. 1, 4\(3\)](#)

#### Modifications etc. (not altering text)

**C4** S. 76 applied (with modifications) (14.8.1996) by [S.I. 1996/1908](#), [reg. 3\(3\)](#)

#### Commencement Information

**II** S. 76 wholly in force at 31.10.1994; s. 76 not in force at Royal Assent see s. 109; s. 76(1) in force for certain purposes at 29.9.1994 and at 31.10.1994 insofar as s. 76 not already in force by [S.I. 1994/2550](#), [arts. 2, 3\(1\)](#), [Sch.](#)

## 77 Persons appointed to hear and determine appeals.

- (1) For the purposes of section 76 an “appointed person” means a person appointed by the Lord Chancellor to hear and decide appeals under this Act.
- (2) A person is not eligible for such appointment unless—
  - [<sup>F3</sup>(a) he satisfies the judicial-appointment eligibility condition on a 5-year basis;]
  - (b) he is an advocate or solicitor in Scotland of at least [<sup>F4</sup>5] years’ standing;
  - (c) he is a member of the Bar of Northern Ireland or [<sup>F5</sup>solicitor of the Court of Judicature of Northern Ireland] of at least [<sup>F6</sup>5] years’ standing; or
  - (d) he has held judicial office.
- (3) An appointed person shall hold and vacate office in accordance with his terms of appointment, subject to the following provisions—

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- (a) there shall be paid to him such remuneration (whether by way of salary or fees), and such allowances, as the Secretary of State with the approval of the Treasury may determine;
  - (b) he may resign his office by notice in writing to the Lord Chancellor;
  - (c) the Lord Chancellor may by notice in writing remove him from office if—
    - (i) he has become bankrupt or made an arrangement with his creditors or, in Scotland, his estate has been sequestrated or he has executed a trust deed for his creditors or entered into a composition contract, or
    - (ii) he is incapacitated by physical or mental illness,
 or if he is in the opinion of the Lord Chancellor otherwise unable or unfit to perform his duties as an appointed person.
- (4) The Lord Chancellor shall consult the Lord Advocate before exercising his powers under this section.
- [<sup>F7</sup>(5) The Lord Chancellor may remove a person from office under subsection (3)(c) only with the concurrence of the appropriate senior judge.
- (6) The appropriate senior judge is the Lord Chief Justice of England and Wales, unless—
- (a) the person to be removed exercises functions wholly or mainly in Scotland, in which case it is the Lord President of the Court of Session, or
  - (b) the person to be removed exercises functions wholly or mainly in Northern Ireland, in which case it is the Lord Chief Justice of Northern Ireland.]

#### Textual Amendments

- F3** S. 77(2)(a) substituted (21.7.2008) by [Tribunals, Courts and Enforcement Act 2007 \(c. 15\)](#), s. 148, [Sch. 10 para. 25\(2\)](#); S.I. 2008/1653, art. 2(d) (with arts. 3, 4)
- F4** Word in s. 77(2)(b) substituted (21.7.2008) by [Tribunals, Courts and Enforcement Act 2007 \(c. 15\)](#), s. 148, [Sch. 10 para. 25\(3\)](#); S.I. 2008/1653, art. 2(d) (with arts. 3, 4)
- F5** Words in Act substituted (1.10.2009) by [Constitutional Reform Act 2005 \(c. 4\)](#), s. 148(1), [Sch. 11 para. 5](#); S.I. 2009/1604, art. 2(d)
- F6** Word in s. 77(2)(c) substituted (21.7.2008) by [Tribunals, Courts and Enforcement Act 2007 \(c. 15\)](#), s. 148, [Sch. 10 para. 25\(3\)](#); S.I. 2008/1653, art. 2(d) (with arts. 3, 4)
- F7** S. 77(5)(6) inserted (3.4.2006) by [Constitutional Reform Act 2005 \(c. 4\)](#), s. 148(1), [Sch. 4 para. 238](#); S.I. 2006/1014, art. 2(a), [Sch. 1 para. 11\(v\)](#)

#### Modifications etc. (not altering text)

- C5** S. 77: Functions of the Lord Advocate transferred to the Secretary of State, and all property, rights and liabilities to which the Lord Advocate is entitled or subject in connection with any such function transferred to the Secretary of State for Scotland (19.5.1999) by [S.I. 1999/678](#), arts. 2, 3, [Sch.](#) (with art. 7)
- S. 77 modified (30.6.1999) by [S.I. 1999/1748](#), art. 3, [Sch. 1 para. 17](#)
- S. 77: transfer of certain functions (1.7.1999) by [S.I. 1999/1750](#), arts. 1, 2, [Sch. 1](#) (with art. 7); [S.I. 1998/3178](#).art. 2(1)

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