

2004 No. 1497

TRADE MARKS

**The Trade Marks Act 1994 (Isle of Man) (Amendment)
Order 2004**

Made - - - - *10th June 2004*

Coming into force - - *1st July 2004*

At the Court at Buckingham Palace, the 10th day of June 2004

Present,

The Queen's Most Excellent Majesty in Council

Her Majesty, in exercise of the powers conferred upon Her by section 108(2) of the Trade Marks Act 1994^(a), is pleased, by and with the advice of her Privy Council, to order, and it is hereby ordered, as follows:

1. This Order may be cited as the Trade Marks Act 1994 (Isle of Man) (Amendment) Order 2004 and shall come into force on 1st July 2004.

2. The Schedule to the Trade Marks Act 1994 (Isle of Man) Order 1996^(b) is amended in accordance with the Schedule to this Order.

A. K. Galloway
Clerk of the Privy Council

^(a) 1994 c.26.

^(b) SI 1996/729, to which there are amendments not material to this Order.

SCHEDULE

Article 2

Amendments of Schedule to Trade Marks Act 1994 (Isle of Man) Order 1996

1. After paragraph 1 there shall be inserted—

“1A. In section 5, subsection (3)(b) and the word “and” immediately preceding it shall be omitted.

1B. After section 6 there shall be inserted—

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”.

1C. In section 10(3)—

- (a) after the words “course of trade” there shall be inserted “, in relation to goods or services,”;
- (b) paragraph (b) and the word “and” immediately preceding it shall be omitted.”.

2. After paragraph 4 there shall be inserted—

“4A. In section 40 (registration), in subsection (1), for the words after “his notice” there shall be substituted “since the application was accepted that the registration requirements (other than those mentioned in section 5(1), (2) or (3)) were not met at that time.”.

4B. In section 47 (grounds for invalidity of registration), after subsection (2) there shall be inserted—

“(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if—

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”.

3. For paragraph 10(3) there shall be substituted—

“(3) In section 89, for subsection (3) there shall be substituted—

“(3) This section does not apply to goods placed in, or expected to be placed in, one of the situations referred to in Article 1(1), in respect of which an application may be made under Article 5(1), of Council Regulation (EC) No. 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights (a).

(4) In this section and sections 90 and 91, “the Treasury” means the Department of that name established under the Government Departments Act 1987 (an Act of Tynwald).”.

4. The foregoing amendments have effect subject as follows—

- (a) paragraphs 1B and 4A of the Schedule to the Trade Marks Act 1994 (Isle of Man) Order 1996 shall not apply in respect of an application for the registration of a trade mark which was published before 5th May 2004;
- (b) an application under section 47(3) of the Trade Marks Act 1994 (application for declaration of invalidity) which was made before 5th May 2004 shall be dealt with under section 47 as it had effect before that date.

(a) OJ No L 196, 2.8.03, p7.

EXPLANATORY NOTE

(This note is not part of the Order)

This Order amends the Trade Marks Act 1994 (Isle of Man) Order 1996, which modifies the Trade Marks Act 1994 (“the Act”) in its application to the Isle of Man, by making further modifications corresponding to the amendments of the Act (as it applies in the United Kingdom) made by the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946).

In addition, this Order makes a consequential amendment to the original modification to section 10(3) of the Act to take account of Council Regulation (EC) No.1383/2003 of 22nd July 2003 (“the Regulation”). The Regulation, which concerns customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, takes effect on 1st July 2004 and replaces Council Regulation (EC) No. 3294/1994 (OJ No L 341, 30.12.94, p7).

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