



Jersey

## DRAFT TRADE MARKS (JERSEY) LAW 202-

### Contents

#### Article

<b>PART 1</b>	<b>8</b>
INTERPRETATION	8
1 Interpretation .....	8
2 Meaning of trade mark [EU Dir Art 3/TMA s1/] .....	13
3 Meaning of collective mark [Art 1 TMJL/; TMA 49/] .....	13
4 Meaning of certification mark [Art 1 TMJL/; TMA 50/] .....	13
5 Meaning of earlier trade mark [TMA s6/].....	14
6 Meaning of registered proprietor.....	14
7 Meaning of “use” in relation to a trade mark .....	14
8 Burden of proving use of trade mark .....	15
9 Similarity of goods and services – Nice Classification [TMA s60A/] .....	15
<b>PART 2</b>	<b>15</b>
RIGHTS CONFERRED BY APPLICATION FOR REGISTRATION	15
10 Applicant’s property rights [TMA s22 as modified by 27/; TMA s26(2) as modified by s27/ and TMA s23 as modified by 27(1) and (2)/] .....	15
11 Co-applicants’ property rights .....	15
12 Application for registration subject to disclaimer or limitation [TMA s13/]) .....	16
13 Transmission of applicant’s property rights [TMA s24 as modified by s27/]) .....	16
14 Licence granted by applicant for registration [TMA s28 as modified by s27/]).....	16
15 Exclusive licence [TMA s29 as modified by s27/]) .....	17
<b>PART 3</b>	<b>17</b>
RIGHTS CONFERRED BY REGISTRATION	17
16 Property rights [TMA s2 and 22)/; TMA s2 and 26(2)/].....	17
17 Exclusive rights [TMA s9/]).....	18
18 Co-ownership of registered trade mark [TMA s23/ Gsy s23/]) .....	18
19 Rights subject to disclaimer or limitation [TMA s13/]).....	18
20 Transmission of registered trade mark [TMA s24/]).....	19
21 Licence to use registered trade mark [TMA s28/]) .....	19
22 Exclusive licence [TMA s29/; TMA s31(1)/]) .....	20
23 Prohibition on use of trade mark registered in name of agent or representative [TMA s10B] .....	20

24	Right to prevent goods entering Jersey without being released for free circulation [TMA s10A; TMA s89/TMJL Art 22 and 23/] .....	20
25	Reproduction of trade marks in dictionaries, encyclopaedias etc. [TMA s99A/] .....	21
<b>PART 4</b>		<b>22</b>
INFRINGEMENT OF REGISTERED TRADE MARK		22
DIVISION 1 – INFRINGEMENT OF REGISTERED TRADE MARK		22
26	Infringement of registered trade mark [TMA s10/].....	22
27	Use that does not constitute infringement of registered trade mark [TMA s11/].....	23
28	Exhaustion of rights conferred by registration [TMA s12/].....	24
DIVISION 2 – INFRINGEMENT PROCEEDINGS		24
29	Right of registered proprietor to bring infringement proceedings [TMA s14/] .....	24
30	Infringement proceedings brought by co-proprietor [TMA 23] .....	24
31	Right of licensee to bring infringement proceedings [TMA s30/] .....	24
32	Right of exclusive licensee to bring infringement proceedings in own name [TMA s31/] .....	25
33	Concurrent rights of action [TMA s31/].....	26
DIVISION 3 – DEFENCES AND REMEDIES IN INFRINGEMENT PROCEEDINGS		26
34	Defence of non-use of trade mark [TMA s11A/] .....	26
35	Order for delivery up of infringing goods, infringing material or infringing articles [TMA s16/] .....	27
36	Period after which remedy of delivery up not available [TMA s18/] .....	27
37	Order for disposal of infringing goods, infringing material or infringing articles [TMA s19/] .....	28
38	Remedies for infringement of property right [TMA 14] .....	29
39	Order for erasure of sign that infringes registered trade mark [TMA s15/].....	29
DIVISION 4 – WELL-KNOWN TRADE MARKS		29
40	Protection of well-known trade marks [TMA s56/TMJL 13A/] .....	29
DIVISION 5 – PROHIBITED GOODS		30
41	Notice of importation of prohibited goods [Art 22 TMJL] [TMA s89] .....	30
42	Specified requirements for a notice of importation [Art 23 TMJL] .....	31
43	Disclosure of information [Art 24 TMJL] [TMA 91].....	31
<b>PART 5</b>		<b>32</b>
UNJUSTIFIED THREAT OF INFRINGEMENT PROCEEDINGS		32
44	Interpretation of Part .....	32
45	Threat of infringement proceedings [TMA s21/; TMA 21F/].....	32
46	Actionable threats [TMA s21A/] .....	33
47	Permitted communications [TMA s21B/] .....	33
48	Proceedings for actionable threats [TMA s21C/] .....	34
49	Professional advisers [TMA s21D/] .....	35
<b>PART 6</b>		<b>35</b>
REGISTRATION OF TRADE MARKS IN JERSEY		35
DIVISION 1 – REGISTER OF TRADE MARKS		35

50	Register of trade marks [TMA s63/] .....	35
51	Classification of goods and services for the purposes of registration [TMA s34/] .....	36
52	Adaptation of entries to new classification [TMA s65/] .....	36
53	Particulars of registrable transactions [TMA s25/] .....	37
54	Amendment of registered particulars [TMA s25/] .....	37
55	Rectification of the register of trade marks [TMA s64/] .....	38
56	Alteration of registered trade mark [TMA s44/] .....	38
57	Notice of trusts [TMA s26(1)/Gsy s26(1)/] .....	39
	<b>DIVISION 2 – DATE OF FILING AND DATE OF PRIORITY</b>	<b>39</b>
58	Date of filing [TMA s33/] .....	39
59	Right of priority on basis of Convention application [TMA s35/] .....	39
60	Right of priority on basis of other overseas application [TMA s36/] .....	40
	<b>DIVISION 3 – APPLICATION FOR REGISTRATION</b>	<b>40</b>
61	Application for registration [TMA s32/] .....	40
62	Examination and acceptance of application for registration [TMA s37/] .....	41
63	Publication of application for registration [TMA s38(1) and TMA s81/] .....	41
64	Withdrawal or amendment of application for registration [TMA s39/] .....	42
65	Provision of information about published applications [TMA s67(1)] .....	42
66	Provision of information before application is published [TMA s67(2)] .....	43
67	Requirement to notify transactions affecting applicant’s property rights [TMA s25 as modified by s27(1) and (3)/] .....	43
	<b>DIVISION 4 – GROUNDS FOR REFUSING REGISTRATION</b>	<b>44</b>
68	Absolute grounds for refusal [TMA s3/] .....	44
69	Absolute grounds for refusal – prohibitions [TMA s3/] .....	44
70	Relative grounds for refusal – identical or similar trade marks [TMA s5/] .....	45
71	Relative grounds for refusal – earlier rights [TMA s5/] .....	45
72	Relative grounds for refusal – application without proprietor’s consent [TMA s5(6)]	46
73	Grounds for refusal relating to only some goods or services [TMA s5A/] .....	46
74	Specially protected emblems [Gsy s4/] .....	46
75	National emblems of Convention countries [TMA s57/TMJL Art 13B/] .....	47
76	Emblems of international organisations [TMA s58/TMJL Art 13B/] .....	48
77	Notification under Article 6ter of the Convention [TMA s59/Gsy s59/] .....	49
	<b>DIVISION 5 – OPPOSITION PROCEEDINGS</b>	<b>49</b>
78	Notice of opposition and observations [TMA s38/] .....	49
79	Relative grounds for refusal in opposition proceedings – non-use [TMA s6A/] .....	50
80	Relative grounds for refusal in opposition proceedings – honest concurrent use [TMA s7/] .....	51
81	Power to require that relative grounds for refusal be raised in opposition proceedings [TMA s8] .....	51
	<b>DIVISION 6 – REGISTRATION OF TRADE MARK</b>	<b>52</b>
82	Registration of trade mark [TMA s40/] .....	52
83	Period of registration [TMA s42/] .....	52
84	Certificate of registration [TMA s40/] .....	52
85	Registration: supplementary provisions [TMA s41/] .....	52
	<b>DIVISION 7 – RENEWAL, RESTORATION AND SURRENDER OF REGISTRATION</b>	<b>53</b>
86	Orders relating to renewal and restoration [TMA s43/] .....	53
87	Renewal of registration [TMA s43/] .....	54

88	Surrender of registered trade mark [TMA s45/68].....	54
	<b>DIVISION 8 – REVOCATION OF REGISTRATION</b>	<b>54</b>
89	Application for revocation [TMA s46].....	54
90	Grounds for revoking registration [TMA s46].....	54
	<b>DIVISION 9 – DECLARATION OF INVALIDITY OF REGISTRATION</b>	<b>55</b>
91	Application for declaration of invalidity [TMA s47(3) and (5A)].....	55
92	Declaration of invalidity [TMA s47(5) and (6)] .....	56
93	Grounds for invalidity of registration [TMA s47(1), (2) and (2ZA)] .....	56
94	Refusal of application for declaration of invalidity – earlier trade mark [TMA s47(2A) and (2G)] .....	57
95	Effect of acquiescence [TMA s48/] .....	58
	<b>DIVISION 10 – LEGAL PROCEEDINGS RELATING TO REGISTRATION</b>	<b>58</b>
96	Costs and security for costs in proceedings before Registrar [TMA s68/] .....	58
97	Evidence in proceedings before Registrar [Gsy Art 67/] .....	58
98	Registration of proprietor prima facie evidence of valid registration [TMA s72/].....	58
99	Certificate of valid registration [TMA s73/] .....	59
100	Registrar’s appearance in Court proceedings [TMA s74 or Gsy Art 72/].....	59
101	Power to release Registrar from Court proceedings [Gsy s79/].....	60
	<b>PART 7</b>	<b>60</b>
	<b>INTERNATIONAL REGISTRATION</b>	<b>60</b>
	<b>DIVISION 1 – INTERPRETATION</b>	<b>60</b>
103	Interpretation of Part [Gsy Reg 21/2008 UK Order Art 2/REF 1/] .....	60
104	Meaning of “protected international trade mark (Jersey)” .....	61
	<b>DIVISION 2 – APPLICATIONS FOR INTERNATIONAL REGISTRATION ORIGINATING FROM JERSEY [REF CHPT A]</b>	<b>61</b>
105	Application of Division [REF 1].....	61
106	Requirements for filing and processing an international application [UK Order 2020 Sched 3 para 1/ REF 3-7/Gsy Reg 1/] .....	61
107	Classification of goods and services [REF 9/Gsy Reg 2/] .....	63
108	Cancellation of international registration [REF 10/Madrid Protocol Art 6(3) and (4)/Gsy Reg 3/].....	63
109	Division or merger of domestic application or domestic registration [Gsy Reg 4/ Common Regulations rule 23] .....	63
	<b>DIVISION 3 – PROTECTED INTERNATIONAL TRADE MARKS (JERSEY) [REF CHPT B]</b>	<b>64</b>
110	Application of Division [REF 1].....	64
111	Rights conferred by request for territorial extension [Art 9][ REF 11(1)/Madrid 4(1)(a)] .....	64
112	Rights in protected international trade mark (Jersey) [Art 14] [REF 11(4)/Madrid 4(1)(a)] .....	64
113	Date of filing [REF 11(2)/Gsy 5(2)(b)].....	65
114	Classification of goods and services for purposes of protected international trade mark (Jersey) [Art 50/ REF 11(3)].....	65
115	Examination of request for territorial extension [REF 12/Gsy 5(1) and (2)/] .....	65
116	Notice of provisional refusal [REF 14/ and REF 13(3)/] .....	65
117	Publication and opposition [REF 15/] .....	66

118	Notice of provisional refusal based on an opposition [REF 16/] .....	66
119	Statement of grant of protection when no grounds for refusal or opposition [REF 17/] .....	67
120	Statement of withdrawal of provisional refusal [REF 18/rule 18ter Common Regulations] .....	67
121	Statement confirming total refusal [REF 19/].....	68
123	Statement of further decision affecting scope of protection [REF 21/] .....	68
124	Declaration of invalidity [REF 22/] .....	69
125	Domestic registration replaced by protected international trade mark (Jersey) [REF 23/Madrid Protocol 4bis].....	69
<b>DIVISION 4 – TRANSFORMATION AND RENEWAL</b>		<b>70</b>
126	Transformation application [REF 24/Gsy Reg 10/] .....	70
127	Renewal of international registration that extends to Jersey [REF 25/] .....	71
<b>DIVISION 5 – CHANGES IN INTERNATIONAL REGISTER</b>		<b>71</b>
128	Effect of changes recorded in International Register [REF 26/] .....	71
129	Declaration that change in ownership has no effect in Jersey [REF 27/] .....	71
130	Declaration that limitation of goods or services has no effect in Jersey [REF 28/].....	72
131	Declaration that recording of licence has no effect in Jersey [REF 29 – ALT 2].....	73
132	Correction of International Register [REF 30/] .....	73
133	Request for division of international registration [REF 31/Common Regs 27bis and ter] .....	74
134	Request for merger of previously divided international registrations [REF 31/] .....	74
<b>DIVISION 6 – GENERAL</b>		<b>75</b>
135	Communications between Registrar and International Bureau [REF 2/Gsy 2020 reg 19/] .....	75
136	Order to amend this Part [TMA s54 /] .....	75
<b>PART 8</b>		<b>76</b>
<b>TRADE MARK AGENTS</b>		<b>76</b>
137	Interpretation .....	76
138	Authorisation of agents [Gsy s80/TMA s82/] .....	76
139	Power of registrar to refuse to deal with certain persons as agents [TMA s88/Gsy Art 85] .....	76
140	Register of trade mark agents [Gsy s81/TMA s83/] .....	77
141	Unregistered trade mark agents [Gsy s82/TMA s84/].....	77
142	Power to specify conditions for mixed partnerships and bodies corporate [Gsy s83/] .....	78
143	Privilege for communications with trade mark agents [Gsy s84/] .....	78
<b>PART 9</b>		<b>79</b>
<b>OFFENCES AND FORFEITURE</b>		<b>79</b>
144	Unauthorised use of trade mark in relation to goods [Art 25 TMJL/TMA s92] .....	79
145	Search warrants [Art 26A TMJL/].....	80
146	Enforcement function of inspectors of weights and measures [TMJL Art 26/].....	81
147	Falsification of register of trade marks [Art 27 TMJL] .....	81
148	False representation in respect of trade marks [Art 28 TMJL/].....	82
149	Unauthorised use of Royal arms [TMA s99/].....	82

150	Criminal liability of directors, managers and others for offences committed by entities [TMJL Art 30].....	82
151	Forfeiture of counterfeit goods [Article 29 TMJL/TMA 97] .....	83
<b>PART 10</b>		<b>84</b>
<b>MISCELLANEOUS AND GENERAL PROVISIONS</b>		<b>84</b>
152	Regulations [Art 31A TMJL/] .....	84
153	Fees [TMA s79] .....	85
102	Appeals to Court against decision of Registrar [TMA s76/ REF 20] .....	85
154	Orders [Art 32 TMJL/TMA s78] .....	85
155	Rules of Court [Art 33 TMJL/] .....	86
156	Judicial notice [Gsy 18/].....	86
157	Matters to be taken into account [Gsy s78/].....	86
158	Saving of vested rights [Art 34 TMJL/].....	87
159	Transitional provisions [Articles 36 and 36A TMJL] .....	87
160	Consequential amendments and repeals .....	87
161	Citation and commencement .....	87
<b>SCHEDULE 1 [TMA SCHEDULE 1]</b>		<b>88</b>
<b>REGISTRATION OF COLLECTIVE MARKS</b>		<b>88</b>
1	Interpretation .....	88
2	Application of this Law to collective marks [TMA Sched 1 para 1/] .....	88
3	Indication of geographical origin [TMA Sched 1 para 3/] .....	88
4	Collective mark not to be misleading about character or significance [TMA Sched 1 para 4/] .....	88
5	Filing of regulations governing use of collective mark [TMA Sched 1 para 5/] .....	88
6	Application for registration of collective mark [TMA s49/ and Sched 1 para 6/].....	89
7	Consideration of application for registration [TMA Sched 1 para 7/] .....	89
8	Publication of regulations, notice of opposition and observations [TMA Sched 1 para 8/] .....	90
9	Inspection of regulations [TMA Sched 1 para 9/] .....	90
10	Amendment of regulations after registration [TMA Sched 1 para 10/] .....	90
11	Infringement – rights of authorised users [TMA Schedule 1 para 11/].....	90
12	Rights of authorised users in relation to infringement [TMA Schedule 1 para 12].....	90
13	Grounds for revocation of registration [TMA Sched 1 para 13/] .....	91
14	Grounds for invalidity of registration [TMA Sched 1 para 14/] .....	91
<b>SCHEDULE 2 [TMA SCHEDULE 2]</b>		<b>93</b>
<b>REGISTRATION OF CERTIFICATION MARKS</b>		<b>93</b>
1	Interpretation .....	93
2	Application of this Law to certification marks [TMA Schedule 2 para 1/] .....	93
3	Indication of geographical origin [TMA Schedule 2 para 3/] .....	93
4	Nature of proprietor’s business [TMA Schedule 2 para 4/].....	93
5	Certification mark not to be misleading about character or significance [TMA Schedule 2 para 5/].....	93
6	Filing of regulations governing use of certification mark [TMA Schedule 2, para 6/].	94

7	Grounds for refusal of application for registration of certification mark [TMA Schedule 2 para 7/]	94
8	Consideration of application for registration [TMA Schedule 2 para 8/]	94
9	Publication of regulations, notice of opposition and observations [TMA Schedule 2 para 9/]	95
10	Inspection of regulations [TMA Schedule 2 para 10/]	95
11	Amendment of regulations after registration [TMA Schedule 2 para 11/]	95
12	Consent to assignment [TMA Schedule 2 para 12/]	96
13	Infringement – rights of authorised users [TMA Schedule 2 para 13/]	96
14	Consideration of loss of authorised users in infringement proceedings [TMA Schedule 2 para 14/]	96
15	Grounds for revocation of registration [TMA Schedule 2 para 15/]	96
16	Grounds for invalidity of registration [TMA Schedule 2 para 16/]	96
<b>SCHEDULE 3</b>		<b>98</b>
TRANSITIONAL PROVISIONS		98
1	Registration of existing registered trade marks	98
2	Renewal of registration due in first 6 months	98
3	Renewal of lapsed registration	98
4	Protected international trade marks (UK) [Art 13 TMJL/]	99
<b>SCHEDULE 4</b>		<b>99</b>
PART 1		99
CONSEQUENTIAL AMENDMENTS		99
1	Criminal Procedure (Jersey) Law 2018 amended	99
2	Intellectual Property (Plant Varieties) (Jersey) Law 2016 amended	99
3	Intellectual Property (Unregistered Rights) (Jersey) Law 2011 amended	99
4	Merchandise Marks (Jersey) Law 1958 amended	100
5	Motor Vehicles (Construction and Use) (Jersey) Order 1998	100
6	Royal Court Rules 2004	100
PART 2		100
REPEALS		100
7	Repeals	100



Jersey

## DRAFT TRADE MARKS (JERSEY) LAW 202-

A **LAW** to make provision for registered trade marks, to give effect to the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on 27 June 1989, and to certain provisions of the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised and amended, and for connected purposes.

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<i>Adopted by the States</i>	<i>[date to be inserted]</i>
<i>Sanctioned by Order of His Majesty in Council</i>	<i>[date to be inserted]</i>
<i>Registered by the Royal Court</i>	<i>[date to be inserted]</i>
<i>Coming into force</i>	<i>[date to be inserted]</i>

**THE STATES**, subject to the sanction of His Most Excellent Majesty in Council, have adopted the following Law –

### PART 1

#### INTERPRETATION

#### 1 Interpretation

(1) In this Law –

“Agent of the Impôts” means the person appointed under Article 4 of the Customs and Excise (Jersey) Law 1999;

“applicant for registration” means the person making an application for registration;

“applicant’s property rights” means the rights in movable property conferred on an applicant for registration under Article 10 [TMA s22] (applicant’s property rights);

“application fee” means the application fee specified by the Minister by Order under Article 153 [TMA s79] (fees);

“application for registration” means an application for the registration of a trade mark under Part 6;

“application for revocation” means an application for the revocation of a trade mark under Part 6;

“authorised user” –

(a) for a collective mark, has the meaning given in Schedule 1;

- (b) for a certification mark, has the meaning given in Schedule 2;
- “business” includes a trade or profession;
- “certification mark” has the meaning given in Article 4 (meaning of certification mark);
- “certified”, in relation to goods or services for which a certification mark is registered, has the meaning given in Article 4(2);
- “class” means a class in a classification system;
- “classification system” –
- (a) in relation to a domestic registration, has the meaning given in Article 51 [TMA s34] (classification of goods and services for the purposes of registration);
- (b) in relation to an international registration, has the meaning given in Article 107 [REF 9/Gsy Reg 2/] (classification of goods and services);
- “collective mark” has the meaning given in Article 3 (meaning of collective mark);
- “commencement date” means the date on which this Law comes into force;
- “Common Regulations” means the Regulations adopted under Article 10 of the Madrid Protocol with effect from 1 April 1996 and as amended with effect from 1 April 2002;
- “Consolidated Fund” means the fund continued under Article 3 of the [Public Finances \(Jersey\) Law 2019](#);
- “Convention application” means an application for protection of a trade mark that is filed in a Convention country other than Jersey under –
- (a) the domestic legislation of that country; or
- (b) an international agreement;
- “Convention country” means –
- (a) a country that is bound by the Paris Convention; or
- (b) a country that is a member of the World Trade Organisation;
- “Court” means the Royal Court;
- “date of application for registration” means the date of filing;
- “date of filing” –
- (a) in relation to an application for registration, has the meaning given in Article 58 [TMA s33/] (date of filing);
- (b) in relation to a protected international trade mark (Jersey), has the meaning given in Article 113 [REF 11(2)/Gsy 5(2)(b)] (date of filing);
- (c) in relation to a transformation application, has the meaning given in Article 126 [REF 24/Gsy Reg 10/] (transformation application);
- “date of priority”, for an application for registration, means the date of the priority claimed for that application under –
- (a) Article 59 [TMA s35/] on the basis of a Convention application; or
- (b) Article 60 [TMA s36/] on the basis of an overseas application;
- “date of registration” means the date of filing;
- “declaration of invalidity” (except in Part 7, Division 3 and Schedules 1 and 2) means a declaration under Part 6, Division 9 that the registration of a trade mark is invalid;

“domestic application” means an application for registration;

“domestic registration” means the registration of a trade mark under Part 6;

“earlier right”, in relation to a trade mark, means –

- (a) an earlier trade mark; or
- (b) a right that would prevent the use of a trade mark under Article 71 [TMA s5] (relative grounds for refusal – earlier rights);

“earlier trade mark” has the meaning given in Article 5 (meaning of earlier trade mark);

“exclusive licensee” means a licensee granted exclusive rights to use a registered trade mark;

“existing registered trade mark” means a trade mark that, immediately before the commencement date, was a registered trade mark under the TMJL 2000;

“grantor”, in respect of a licence, means the person granting the licence;

“holder”, in relation to an international registration, means the person in whose name the international registration is recorded in the International Register;

“infringement”, in relation to a registered trade mark, means an infringement of the registered proprietor’s exclusive rights to use the registered trade mark;

“infringement proceedings” means Court proceedings brought under Part 4 –

- (a) for the infringement of a registered trade mark; or
- (b) for the delivery up of infringing goods, infringing material or infringing articles;

“infringing articles” means articles –

- (a) that are specifically designed or adapted for making copies of a sign that is identical or similar to a registered trade mark; and
- (b) that a person has in their possession, custody or control, knowing or having reason to believe that the articles have been or are to be used to produce infringing goods or infringing material;

“infringing goods” means goods or their packaging bearing a sign that is identical or similar to a registered trade mark where –

- (a) the affixing of the sign to the goods or their packaging is an infringement of the registered trade mark;
- (b) the goods are proposed to be imported into Jersey and the affixing of the sign in Jersey to the goods or their packaging would be an infringement of the registered trade mark; or
- (c) the sign has otherwise been used in relation to the goods in a way that infringes the registered trade mark;

“infringing material” means material bearing a sign that is identical or similar to a registered trade mark, where the material is –

- (a) used for labelling or packaging goods, as a business paper in relation to goods or services, or for advertising goods or services, and that use infringes the registered trade mark; or
- (b) intended to be used for any of those purposes, and that use would infringe the registered trade mark;

“international applicant” means the person in whose name an international application is filed with the Registrar;

“international application” means an application for an international registration that is –

- (a) made on the basis of a domestic application or domestic registration; and
- (b) filed with the Registrar as the Office of origin;

“International Bureau” means the International Bureau of WIPO;

“International Register” means the official collection of data concerning international registrations maintained by the International Bureau;

“international registration” means the registration of a trade mark in the International Register;

“international trade mark” means a trade mark that is registered in the International Register;

“Jersey” includes the territorial sea adjacent to Jersey;

“Jersey court” means the Royal Court, Court of Appeal or Judicial Committee of the Privy Council;

“Jersey Intellectual Property Register” means the Jersey Intellectual Property Register established under Article [xx] of the Registrar of Intellectual Property (Jersey) Law 202-;

“Madrid Agreement” means the Madrid Agreement concerning the International Registration of Marks of 14 April 1891, as revised at Stockholm on 14 July 1967, and amended on 28 September 1979;

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27 June 1989;

“Minister” means the Minister for External Relations;

“notice of opposition” means a notice of opposition under Article 78 [TMA s38] (notice of opposition and observations);

“opposition proceedings” means proceedings before the Registrar begun by a notice of opposition;

“overseas application” has the meaning given in Article 60 [TMA 36] (right of priority on basis of other overseas application);

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time;

“prohibited goods” means goods whose importation is notified under Article 41 [TMA s89] (notice of importation of prohibited goods);

“protected international trade mark (Jersey)” means an international trade mark that is granted protection in Jersey under Part 7, Division 3;

“protected international trade mark (UK)” means an international trade mark that is protected in the United Kingdom in accordance with the Trade Marks (International Registration) Order 2008 of the United Kingdom (S.I. 2008/2206);

“publish” means make available to the public;

“register of trade marks” means that part of the Jersey Intellectual Property Register that is maintained under Part 6 of this Law;

“registered particulars” means particulars of a registrable transaction entered in the register;

“registered proprietor” has the meaning given in Article 6;

“registered trade mark” means a trade mark –

- (a) that is registered under Part 6 or has been granted protection in Jersey under Part 7 as a protected international trade mark (Jersey);
- (b) that is currently entered in the register of trade marks; and
- (c) whose registration has not ceased to have effect;

“registered trade mark agent” has the meaning given in Part 8;

“registrable transaction” has the meaning given in Article 53 [TMA 25] (particulars of registrable transactions);

“Registrar” means the person appointed as the Registrar of Intellectual Property under Article [xx] of the Registrar of Intellectual Property (Jersey) Law 202-;

“renewal fee” has the meaning given in Article 86 [TMA s43] (orders relating to renewal and restoration);

“request for territorial extension”, in relation to an international registration, means –

- (a) in relation to Jersey, a request for an extension of protection to Jersey under Article 3ter (1) or (2) of the Madrid Protocol sent by the International Bureau to Jersey;
- (b) in relation to the United Kingdom, a request for an extension of protection to the United Kingdom under Article 3ter (1) or (2) of the Madrid Protocol sent by the International Bureau to the United Kingdom;

“requirements for registration” means –

- (a) the requirements relating to an application for registration set out in Article 61 [TMA s32] (application for registration);
- (b) any requirement of this Law relating to registrability; and
- (c) any requirements relating to an application for registration contained in rules or an Order made under this Law;

“security interest” has the meaning given in Article 1A of the [Security Interests \(Jersey\) Law 2012](#);

“States” means the States Assembly;

“successor in title”, in relation to a trade mark, right or interest, includes a person to whom the trade mark, right or interest is assigned or otherwise transmitted;

“TMA” means the Trade Marks Act 1994 of the United Kingdom;

“TMJL 2000” means the [Trade Marks \(Jersey\) Law 2000](#);

“trade mark” has the meaning given in Article 2 (meaning of trade mark);

“transformation application” means an application for registration made as a result of the cancellation under Article 108 [REF 10] of an international registration;

“well-known trade mark” has the meaning given in Article 40 [TMA s56];

“WIPO” means the World Intellectual Property Organisation;

“WTO agreement” means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15 April 1994.

- (2) In this Law, a reference to registering a trade mark is a reference to entering the trade mark in the register of trade marks.
- (3) In relation to an earlier right under Article 71 [TMA s5] (relative grounds for refusal – earlier rights), “proprietor” has the meaning given in that Article.
- (4) In relation to a well-known trade mark, “proprietor” has the meaning given in Article 40 [TMA s56].

- (5) If a licence has been granted –
  - (a) a reference in this Law to a licence or licensee includes a reference to any sub-licence or sub-licensee; and
  - (b) a reference in this Law to the registered proprietor's consent includes a reference to the consent of the successor in title to a grantor's interest. [TMA 28(3)]
- (6) Nothing in this Law affects rights of action or remedies against a person for passing off. [TMA s2(2)]

## **2 Meaning of trade mark [EU Dir Art 3/TMA s1/]**

- (1) In this Law, “trade mark” means a sign that is –
  - (a) capable of distinguishing goods or services of 1 undertaking from goods or services of other undertakings; and
  - (b) capable of being represented in the register of trade marks in a manner that enables the Registrar, a Jersey court and the public to determine the clear and precise subject matter of the protection afforded to the proprietor.
- (2) A trade mark may consist of a word (including a personal name), a design, a letter, a numeral, a colour, a sound or the shape of goods or their packaging.
- (3) For a certification mark, the reference in paragraph (1)(a) to “distinguishing goods or services of 1 undertaking from goods or services of other undertakings” is to be read as a reference to distinguishing goods or services that are certified by the registered proprietor from goods or services that are not.
- (4) For a collective mark whose proprietor is an association, the reference in paragraph (1)(a) to “distinguishing goods or services of 1 undertaking from goods or services of other undertakings” is to be read as a reference to distinguishing goods or services of members of the association from goods or services of other undertakings.

## **3 Meaning of collective mark [Art 1 TMJL/; TMA 49/]**

- (1) In this Law, “collective mark” means a trade mark that is described as a collective mark in the application for registration of that trade mark.
- (2) Schedule 1 makes further provision for collective marks.

## **4 Meaning of certification mark [Art 1 TMJL/; TMA 50/]**

- (1) In this Law, “certification mark” means a trade mark that is described as a certification mark in the application for registration.
- (2) A certification mark indicates that the goods or services in connection with which it is used are certified by the registered proprietor in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.
- (3) Schedule 2 makes further provision for certification marks.

## 5 Meaning of earlier trade mark [TMA s6/]

- (1) In this Law, “earlier trade mark”, in relation to a trade mark (trade mark A), means –
  - (a) an existing registered trade mark entered in the register of trade marks under Schedule 3 (transitional provisions) with a date of application for registration under the TMA earlier than the date of application for registration of trade mark A (taking account of any date of priority for either application);
  - (b) in the 12-month period beginning with the commencement date, a protected international trade mark (UK) with a date of application for registration under the TMA earlier than the date of application for registration of trade mark A (taking account of any date of priority for either application);
  - (c) a registered trade mark with a date of application for registration under this Law earlier than the date of application for registration of trade mark A (taking account of any date of priority for either application); or
  - (d) a trade mark that, at the date of application for registration of trade mark A (or any date of priority for that application), was a well-known trade mark.
- (2) In this Law, a reference to an earlier trade mark includes a reference to a trade mark –
  - (a) for which an application for registration has been made; and
  - (b) that, if registered, would be an earlier trade mark under paragraph (1)(a) or (b).

## 6 Meaning of registered proprietor

- (1) In this Law, “registered proprietor”, in relation to a registered trade mark, means the person currently entered in the register of trade marks as the proprietor of that trade mark.
- (2) For a collective mark, the registered proprietor must be –
  - (a) an association of manufacturers, producers, suppliers of services or traders that has the capacity in its own name to enter into contracts and to sue or be sued; or
  - (b) a legal person. [TMA 49]
- (3) In Part 4, “registered proprietor” includes a licensee or authorised user who brings infringement proceedings.

## 7 Meaning of “use” in relation to a trade mark

- (1) In this Law, “use” (however that use is described) in relation to a trade mark or a sign identical or similar to or likely to be mistaken for a trade mark, includes use otherwise than by means of a graphic representation. [TMA 103(2)]
- (2) In any reference in this Law to “use conditions” –
  - (a) “use”, in relation to a trade mark, includes use in a variant form, whether or not the variant form is also registered in the name of the proprietor; and
  - (b) “use in Jersey”, in relation to a trade mark, includes affixing the trade mark to goods in Jersey or to their packaging, solely for export purposes.
- (3) A variant form of a trade mark differs in its elements from the form in which the trade mark was registered, but the different elements do not alter the distinctive character of the trade mark.

## 8 Burden of proving use of trade mark

In any civil proceedings under this Law, if a question arises about the use to which a registered trade mark has been put, it is for the registered proprietor to show what use has been made of it. [\[TMA s100/\]](#)

## 9 Similarity of goods and services – Nice Classification [\[TMA s60A/\]](#)

- (1) For the purposes of this Law, goods and services –
  - (a) are not to be regarded as similar to each other on the ground that they appear in the same class under the Nice Classification;
  - (b) are not to be regarded as dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
- (2) In this Article, “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as last amended on 28 September 1979.

## PART 2

### RIGHTS CONFERRED BY APPLICATION FOR REGISTRATION

## 10 Applicant’s property rights [\[TMA s22 as modified by 27/; TMA s26\(2\) as modified by s27/ and TMA s23 as modified by 27\(1\) and \(2\)/\]](#)

- (1) An application for registration that contains everything required by Article 61(2) [\[TMA s32\]](#) (application for registration) is movable property.
- (2) Rights in that movable property –
  - (a) are conferred on the applicant for registration on the date of application for registration; and
  - (b) are enforceable in the same way as rights in other movable property are enforceable.

## 11 Co-applicants’ property rights

- (1) If an application for registration is made by 2 or more persons jointly, each co-applicant is entitled, subject to any agreement to the contrary, to an equal undivided share in the applicant’s property rights.
- (2) Paragraph (3) applies if 2 or more persons are co-applicants, whether under paragraph (1) or otherwise.
- (3) One co-applicant (A) must not, without the consent of each other co-applicant –
  - (a) grant a licence to use the trade mark to which the application for registration relates;
  - (b) assign A’s share in the applicant’s property rights; or
  - (c) create or permit the creation of a security interest in A’s share in the applicant’s property rights.

- (4) Nothing in this Article affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as trustees or personal representatives.

## **12 Application for registration subject to disclaimer or limitation [TMA s13]/]**

- (1) An applicant for registration of a trade mark may –
  - (a) disclaim any right to the exclusive use of a specified element of the trade mark; or
  - (b) agree that the rights to be conferred by the registration of the trade mark will be subject to a specified limitation.
- (2) The Minister must by Order provide for the publication of a disclaimer or limitation.

## **13 Transmission of applicant's property rights [TMA s24 as modified by s27/]**

- (1) An applicant's property rights –
  - (a) are transmissible by assignment, testamentary disposition or operation of law in the same way as other movable property; and
  - (b) may be transmitted either in connection with the goodwill of a business or independently.
- (2) A contractual obligation to transfer a business is taken to include an obligation to transfer an applicant's property rights unless –
  - (a) there is agreement to the contrary; or
  - (b) it is clear in all the circumstances that this presumption should not apply.
- (3) An assignment or other transmission of an applicant's property rights may be partial, in that it is limited to apply –
  - (a) in relation to some but not all of the goods or services for which the application for registration is made; or
  - (b) in a particular manner in relation to the use of the trade mark to which the application for registration relates.
- (4) The assignment of an applicant's property rights is not effective unless it is in writing and signed by or on behalf of the person assigning the applicant's property rights ("assignor").
- (5) If the assignor is a body corporate, the requirement in paragraph (4) may be satisfied if the assignment is sealed with the body corporate's seal.
- (6) Paragraphs (1) to (5) apply to assignment by way of security in the same way as they apply to any other assignment.
- (7) An applicant's property rights may be subject to a security interest in the same way as other movable property.
- (8) Nothing in this Law affects the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

## **14 Licence granted by applicant for registration [TMA s28 as modified by s27/]**

- (1) An applicant for registration may grant a licence to use the trade mark to which the application for registration relates.

- (2) A licence granted under paragraph (1) may be general or limited.
- (3) A limited licence may apply to the use of the trade mark –
  - (a) in relation to some but not all of the goods or services for which the application for registration is made;
  - (b) in a particular manner in relation to the goods or services for which the application for registration is made.
- (4) A licence is not effective unless it is in writing and signed by or on behalf of the grantor.
- (5) If the grantor is a body corporate, the requirement in paragraph (4) may be satisfied if the licence is sealed with the body corporate's seal.
- (6) Unless a licence provides otherwise, the licence is binding on a successor in title to the grantor's interest.
- (7) A licence may state that the licensee may grant a sub-licence.
- (8) The applicant may invoke the applicant's property rights against a licensee who contravenes a provision of the licence relating to –
  - (a) the duration of the licence;
  - (b) the form in which the trade mark may be used;
  - (c) the scope of the goods or services for which the application for registration is made;
  - (d) the quality of the goods manufactured by the licensee; or
  - (e) the quality of the services provided by the licensee.

#### **15 Exclusive licence [[TMA s29 as modified by s27/](#)]**

- (1) A licence granted under Article 14 [TMA 28] (licence granted by applicant for registration) may authorise the licensee to use the trade mark to which the application for registration relates in the manner authorised by the licence to the exclusion of all others (including the grantor).
- (2) An exclusive licence may provide that the licensee has, to the extent provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.
- (3) An exclusive licensee has the same rights against a successor in title who is bound by the licence as the exclusive licensee has against the grantor.
- (4) In this Article, "successor in title" means the successor in title to the grantor's interest.

### **PART 3**

#### **RIGHTS CONFERRED BY REGISTRATION**

#### **16 Property rights [[TMA s2 and 22/](#)]; [TMA s2 and 26\(2\)/](#)]**

- (1) A registered trade mark is movable property.
- (2) Rights in that movable property –
  - (a) are conferred on the registered proprietor on the date of registration; and

- (b) are enforceable in the same way as rights in other movable property are enforceable.
- (3) But –
  - (a) infringement proceedings may not be brought before the date on which the Registrar enters the trade mark in the register of trade marks; and
  - (b) no offence is committed under Article 144 [25 TMJL/ TMA s92] (unauthorised use of trade mark in relation to goods) by anything done before the registration of the trade mark is published under Article 84 [TMA s40] (certificate of registration).

### **17 Exclusive rights [TMA s9/]**

- (1) The proprietor of a registered trade mark has exclusive rights to use the registered trade mark.
- (2) Those rights are infringed if the registered trade mark is used in Jersey in the circumstances set out in Article 26 [TMA s10] (infringement of registered trade mark) without the consent of the registered proprietor.
- (3) In this Article, the consent of the registered proprietor includes the consent of a licensee or an authorised user.
- (4) Paragraphs (1) and (2) do not affect the rights in the registered trade mark acquired by the proprietor before –
  - (a) the date of application for registration; or
  - (b) any date of priority for that application.

### **18 Co-ownership of registered trade mark [TMA s23/ Gsy s23/]**

- (1) If registration of a trade mark is granted to 2 or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.
- (2) The following provisions apply if 2 or more persons are co-proprietors of a registered trade mark, whether under paragraph (1) or otherwise.
- (3) Subject to any agreement to the contrary, each co-proprietor is entitled, by themselves or their agents, to do for their own benefit and without the consent of or the need to account to each other co-proprietor, any act that would otherwise amount to an infringement of the registered trade mark.
- (4) One co-proprietor (A) must not without the consent of each other co-proprietor –
  - (a) grant a licence to use the registered trade mark;
  - (b) assign A's share in the registered trade mark; or
  - (c) create or permit the creation of a security interest in A's share in the rights in the registered trade mark.
- (5) Nothing in this Article affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as trustees or personal representatives.

### **19 Rights subject to disclaimer or limitation [TMA s13/]**

- (1) The proprietor of a registered trade mark may –

- (a) disclaim any right to the exclusive use of a specified element of the trade mark;  
or
  - (b) agree that the rights conferred by the registration of the trade mark are subject to a specified limitation.
- (2) If the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by Article 17 [TMA 9] (exclusive rights) are correspondingly restricted or disclaimed.
- (3) The Minister must by Order provide for the publication and entry in the register of trade marks of a disclaimer or limitation.

## **20 Transmission of registered trade mark [TMA s24/]**

- (1) A registered trade mark –
- (a) is transmissible by assignment, testamentary disposition or operation of law in the same way as other movable property; and
  - (b) may be transmitted either in connection with the goodwill of a business or independently.
- (2) A contractual obligation to transfer a business is taken to include an obligation to transfer a registered trade mark unless –
- (a) there is agreement to the contrary; or
  - (b) it is clear in all the circumstances that this presumption should not apply.
- (3) An assignment or other transmission of a registered trade mark may be partial, in that it is limited to apply in relation to –
- (a) some but not all of the goods or services for which the trade mark is registered;  
or
  - (b) the use of the registered trade mark in a particular manner.
- (4) An assignment of a registered trade mark is not effective unless it is in writing and signed by or on behalf of the person assigning the registered trade mark (“assignor”).
- (5) If the assignor is a body corporate, the requirement in paragraph (4) may be satisfied if the assignment is sealed with the body corporate’s seal.
- (6) Paragraphs (1) to (5) apply to assignment by way of security in the same way as they apply to any other assignment.
- (7) A registered trade mark may be the subject of a security interest in the same way as other movable property.

## **21 Licence to use registered trade mark [TMA s28/]**

- (1) A registered proprietor may grant a licence to use a registered trade mark.
- (2) A licence to use a registered trade mark may be general or limited.
- (3) A limited licence may, in particular, apply in relation to –
- (a) some but not all of the goods or services for which the trade mark is registered;
  - (b) the use of the registered trade mark in a particular manner.
- (4) A licence is not effective unless it is in writing and signed by or on behalf of the grantor.

- (5) If the grantor is a body corporate, the requirement in paragraph (4) may be satisfied if the licence is sealed with the body corporate's seal.
- (6) Unless a licence provides otherwise, the licence is binding on a successor in title to the grantor's interest.
- (7) A licence may state that the licensee may grant a sub-licence.
- (8) The grantor may invoke their rights in the registered trade mark against a licensee who contravenes a provision of the licence relating to –
  - (a) the duration of the licence;
  - (b) the form in which the trade mark is registered for use;
  - (c) the scope of the goods or services for which the licence is granted;
  - (d) the quality of the goods manufactured; or
  - (e) the quality of the services provided by the licensee.

## **22 Exclusive licence [TMA s29/; TMA s31(1)/]**

- (1) A licence granted under Article 21 [TMA s28] (licence to use registered trade mark) may authorise the licensee to use a registered trade mark in the manner authorised by the licence to the exclusion of all others (including the grantor).
- (2) An exclusive licence may provide that the licensee will have, to the extent provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.
- (3) An exclusive licensee has the same rights against a successor in title who is bound by the licence as the exclusive licensee has against the grantor.
- (4) In this Article, "successor in title" means the successor in title to the grantor's interest.

## **23 Prohibition on use of trade mark registered in name of agent or representative [TMA s10B]**

- (1) This Article applies if an agent or representative of the proprietor of a trade mark registers the trade mark in their own name, without the proprietor's consent.
- (2) Unless the agent or representative justifies their action, the proprietor may do either or both of the following –
  - (a) prevent the use of the registered trade mark by the agent or representative (despite the rights conferred by this Law in relation to the registration of a trade mark);
  - (b) apply under Article 55 [TMA s64] (rectification of the register of trade marks) to rectify the register of trade marks to name the proprietor as the registered proprietor.

## **24 Right to prevent goods entering Jersey without being released for free circulation [TMA s10A; TMA s89/TMJL Art 22 and 23/]**

- (1) The proprietor of a registered trade mark is entitled to prevent third parties from bringing into Jersey, in the course of trade, goods that are not released for free circulation if the goods are goods for which the trade mark is registered and the goods bear, without authorisation, a sign –

- (a) that is identical to the registered trade mark; or
  - (b) that cannot be distinguished in its essential aspects from the registered trade mark.
- (2) In paragraph (1) the reference to goods for which the trade mark is registered includes a reference to the packaging of goods for which the trade mark is registered.
- (3) Paragraph (1) does not affect the rights of a proprietor that are acquired before –
  - (a) the date of application for registration; or
  - (b) any date of priority for that application.
- (4) The entitlement of the proprietor under paragraph (1) lapses if –
  - (a) proceedings are initiated in accordance with the European Customs Enforcement Regulation to determine whether the registered trade mark has been infringed; and
  - (b) during those proceedings, evidence is provided by the declarant or the holder of the goods that the registered proprietor is not entitled to prohibit the placing of the goods on the market in the country of final destination.
- (5) In this Article –

“declarant” has the meaning given in the European Customs Enforcement Regulation;

“European Customs Enforcement Regulation” means [Regulation \(EU\) No 608/2013 of the European Parliament and of the Council of 12 June 2013](#) concerning customs enforcement of intellectual property rights, as amended from time to time;

“holder of the goods” has the meaning given in that Regulation.

## **25 Reproduction of trade marks in dictionaries, encyclopaedias etc. [[TMA s99A/1](#)]**

- (1) This Article applies if the reproduction of a registered trade mark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered.
- (2) The publisher of the work must, at the written request of the registered proprietor, ensure that the reproduction of the registered trade mark is accompanied by an indication that the trade mark is a registered trade mark.
- (3) The publisher must take the action required by paragraph (2) without delay and, in the case of works in printed form, at the latest in the next edition of the publication.
- (4) If the publisher fails to take the action required by paragraph (2), the Court may, on an application by the registered proprietor –
  - (a) order the publisher to take the required action;
  - (b) if the work is in printed form, order the publisher to erase or amend the reproduction of the registered trade mark or destroy copies of the work in the publisher’s possession, custody or control; or
  - (c) grant any other order the Court considers appropriate in the circumstances.

## PART 4

### INFRINGEMENT OF REGISTERED TRADE MARK

#### DIVISION 1 – INFRINGEMENT OF REGISTERED TRADE MARK

#### 26 Infringement of registered trade mark [TMA s10/]

- (1) A person infringes a registered trade mark if, in the course of trade, the person uses a sign that is identical to the registered trade mark in relation to identical goods or services.
- (2) A person infringes a registered trade mark if, in the course of trade –
  - (a) the person uses a sign; and
  - (b) there is a likelihood of confusion on the part of the public because –
    - (i) the sign is identical to the registered trade mark in relation to similar goods or services; or
    - (ii) the sign is similar to the registered trade mark in relation to identical or similar goods or services.
- (3) In paragraph (2), “likelihood of confusion” includes the likelihood of association with the registered trade mark.
- (4) A person infringes a registered trade mark if –
  - (a) in the course of trade, the person uses a sign that is identical or similar to the registered trade mark in relation to goods or services, whether or not the goods or services are identical or similar goods or services;
  - (b) the registered trade mark has a reputation in Jersey; and
  - (c) the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the registered trade mark.
- (5) A person infringes a registered trade mark if, in the course of trade –
  - (a) the person affixes a sign that is identical or similar to the registered trade mark on any packaging; and
  - (b) the conditions in paragraph (6) are met.
- (6) The conditions are –
  - (a) there is a risk the packaging will be used in relation to goods; and
  - (b) that use would constitute an infringement of the registered trade mark.
- (7) A person infringes a registered trade mark if, in the course of trade –
  - (a) the person offers or exposes for sale or places on the market, stocks for those purposes, or imports or exports, any packaging to which is affixed a sign that is identical or similar to the registered trade mark; and
  - (b) the conditions in paragraph (8) are met.
- (8) The conditions are –
  - (a) there is a risk the packaging will be used in relation to goods; and
  - (b) that use would constitute an infringement of the registered trade mark.
- (9) For the purposes of this Article, use of a sign includes –

- (a) affixing the sign to goods or their packaging;
  - (b) offering or exposing goods for sale, placing goods on the market, or stocking goods for the purpose of doing so, under the sign;
  - (c) offering or supplying services under the sign;
  - (d) importing or exporting goods under the sign;
  - (e) using the sign as a trade or company name or part of a trade or company name;
  - (f) using the sign on business papers and in advertising.
- (10) In this Article –
- “identical goods or services” means goods or services that are identical to those for which the trade mark is registered;
- “identical or similar goods or services” means goods or services that are identical or similar to those for which the trade mark is registered;
- “packaging” includes labels, tags, security or authenticity features or devices or other means to which a trade mark may be affixed;
- “similar goods or services” means goods or services that are similar to those for which the trade mark is registered.

## **27 Use that does not constitute infringement of registered trade mark [TMA s11/]**

- (1) An earlier trade mark is not infringed by the use of a later registered trade mark if the later registered trade mark would not be declared invalid under Article 94 [TMA 47(2A) or (2G)] (refusal of application for declaration of invalidity – earlier trade mark) or Article 95 [TMA 48(1)] (effect of acquiescence).
- (2) If paragraph (1) applies, the later registered trade mark is not infringed by the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later registered trade mark.
- (3) A registered trade mark is not infringed by –
  - (a) the use by an individual of their own name or address;
  - (b) the use of signs or indications that are not distinctive;
  - (c) the use of signs or indications that concern –
    - (i) the kind, quality, quantity, intended purpose, value or geographical origin of goods or services;
    - (ii) the time of production of goods or of rendering of services; or
    - (iii) other characteristics of goods or services;
  - (d) the use of the registered trade mark to identify or refer to goods or services of the registered proprietor, in particular if that use is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts).
- (4) In paragraph (3), “use” means use in accordance with honest practices in industrial or commercial matters.

**28 Exhaustion of rights conferred by registration [TMA s12]/]**

- (1) A registered trade mark is not infringed by the use of the trade mark in relation to goods that have been placed on the market in Jersey under that trade mark by the registered proprietor or with the registered proprietor's consent.
- (2) Paragraph (1) does not apply if –
  - (a) legitimate reasons exist for the registered proprietor to oppose further dealings in the goods for the purpose of protecting the registered proprietor's property (in particular, if the condition of the goods has been changed or impaired after the goods have been placed on the market); and
  - (b) the registered proprietor's opposition to those further dealings does not interfere with the rights of another person any more than is necessary to achieve that purpose.

## DIVISION 2 – INFRINGEMENT PROCEEDINGS

**29 Right of registered proprietor to bring infringement proceedings [TMA s14/]**

- (1) A registered proprietor may bring Court proceedings for the infringement of a registered trade mark (“infringement proceedings”).
- (2) Infringement proceedings may not be brought before –
  - (a) the date on which the Registrar enters the trade mark in the register of trade marks; or
  - (b) for an international registration that is the subject of a request for territorial extension to Jersey, the date on which the international trade mark is granted protection as a protected international trade mark (Jersey).

**30 Infringement proceedings brought by co-proprietor [TMA 23]**

- (1) Infringement proceedings may be brought by any co-proprietor of a registered trade mark, but that co-proprietor must not continue with the infringement proceedings without the leave of the Court unless each other co-proprietor –
  - (a) is joined as a plaintiff; or
  - (b) added as a defendant.
- (2) A co-proprietor who is added as a defendant under paragraph (1) is not liable for any costs in the infringement proceedings unless that co-proprietor takes part in the proceedings.
- (3) Nothing in paragraph (1) affects the granting of interlocutory relief on the application of 1 co-proprietor.

**31 Right of licensee to bring infringement proceedings [TMA s30/]**

- (1) Unless a licence provides otherwise, a licensee must not bring infringement proceedings in relation to a registered trade mark without the registered proprietor's consent (but see paragraphs (2) and (3)).
- (2) An exclusive licensee may request the registered proprietor to take infringement proceedings in relation to any matter that affects the licensee's interests.

- (3) The exclusive licensee may bring infringement proceedings in their own name (as if they were the registered proprietor) if the registered proprietor –
  - (a) refuses to do so; or
  - (b) fails to do so within 2 months after being called on.
- (4) If a licensee brings infringement proceedings under this Article or under the licence, the licensee must not continue with those proceedings without the leave of the Court unless the registered proprietor is –
  - (a) joined as a plaintiff; or
  - (b) added as a defendant.
- (5) Paragraph (4) does not affect the granting of interlocutory relief on an application by a licensee alone.
- (6) A registered proprietor who is added as a defendant under paragraph (4) is not liable for any costs in the infringement proceedings unless they take part in those proceedings.
- (7) In infringement proceedings brought by the registered proprietor, the Court –
  - (a) must take into account any loss suffered or likely to be suffered by licensees; and
  - (b) may give directions it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of licensees.
- (8) If the registered proprietor brings infringement proceedings, a licensee who has suffered loss is entitled to intervene in the infringement proceedings for the purpose of obtaining compensation for that loss.
- (9) This Article does not apply to the extent that an exclusive licensee has a right to bring infringement proceedings in their own name under Article 32 [TMA s31] (right of exclusive licensee to bring infringement proceedings in own name).
- (10) A licensee who brings infringement proceedings has the same rights and remedies under this Part as the registered proprietor.

### **32 Right of exclusive licensee to bring infringement proceedings in own name** **[TMA s31/]**

- (1) This Article applies to the extent that an exclusive licence provides under Article 22 [TMA s29(2)] (exclusive licence) that the exclusive licensee has the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.
- (2) Unless the exclusive licence provides otherwise, the exclusive licensee –
  - (a) may bring infringement proceedings in respect of the registered trade mark in their own name against any person other than the registered proprietor; and
  - (b) has the same rights and remedies under this Part as the registered proprietor.
- (3) In infringement proceedings brought by an exclusive licensee in their own name, the defendant may rely on the same defences available to the defendant in infringement proceedings brought by the registered proprietor.
- (4) The rights and remedies of the exclusive licensee are concurrent with those of the registered proprietor.

**33 Concurrent rights of action [TMA s31/]**

- (1) This Article applies if the registered proprietor and exclusive licensee have concurrent rights of action in respect of an infringement of a registered trade mark.
- (2) If one of them brings infringement proceedings, they must not continue with the infringement proceedings without the leave of the Court unless the other is –
  - (a) joined as a plaintiff; or
  - (b) added as a defendant.
- (3) Paragraph (2) does not affect the granting of interlocutory relief on an application by a registered proprietor or exclusive licensee alone.
- (4) A person who is added as a defendant under paragraph (2) is not liable for any costs in the infringement proceedings unless they take part in those proceedings.
- (5) In infringement proceedings brought by one of them –
  - (a) the Court, in assessing damages, must take into account the terms of the licence and any pecuniary remedy that the Court has awarded, or may award, to either of them in respect of the infringement;
  - (b) the Court must not direct an account of profits if the Court has awarded damages, or has directed an account of profits, in favour of the other one in respect of the infringement; and
  - (c) if the Court directs an account of profits, the Court must allocate the profits between the registered proprietor and exclusive licensee as the Court considers just, unless the proprietor and licensee agree otherwise.
- (6) Paragraph (5) applies whether or not the registered proprietor and exclusive licensee are both parties to the infringement proceedings.
- (7) If the registered proprietor and exclusive licensee are not both parties to the proceedings, the Court may give any directions it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.
- (8) Paragraphs (5) and (7) have effect subject to any agreement to the contrary between the registered proprietor and the exclusive licensee.

**DIVISION 3 – DEFENCES AND REMEDIES IN INFRINGEMENT PROCEEDINGS****34 Defence of non-use of trade mark [TMA s11A/]**

- (1) A registered proprietor is entitled to bring infringement proceedings to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked under Article 90(1)(a) or (b) [TMA s46(1)(a) or (b)] (grounds for revoking registration) for non-use on the date the infringement proceedings are brought.
- (2) Paragraph (3) applies in relation to proceedings for infringement of a trade mark that was registered before the start of the 5 year-period ending with the date the infringement proceedings are brought.
- (3) The registered proprietor must, if requested by the defendant, provide proof that –
  - (a) during that 5-year period, the registered trade mark has been put to genuine use in Jersey with the registered proprietor's consent in relation to the goods or services –

- (i) for which the trade mark is registered; and
  - (ii) to which the proceedings relate; or
- (b) there are proper reasons for non-use.
- (4) Nothing in paragraphs (2) and (3) overrides any provision of Article 90 [TMA s46] (grounds for revoking registration), as applied by paragraph (1).
- (5) In paragraph (2), “registered” means –
  - (a) registered under this Law; or
  - (b) if the 5-year period started before the commencement date, registered under the TMJL 2000.

### **35 Order for delivery up of infringing goods, infringing material or infringing articles [TMA s16/]**

- (1) A registered proprietor may apply to the Court for an order for the delivery up to them (or to another person the Court may direct) of any infringing goods, infringing material or infringing articles that a person has in their possession, custody or control in the course of a business.
- (2) But an order under paragraph (1) is not available after the end of the 6-year period mentioned in Article 36 [TMA 18(1) or (3)] (period after which remedy of delivery up not available).
- (3) The Court must not make an order under paragraph (1) unless the Court also makes, or it appears to the Court that there are grounds for making, an order under Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles).
- (4) A person to whom infringing goods, infringing material or infringing articles are delivered up under an order under paragraph (1) must, if an order under Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles) has not been made, retain the goods, material or articles until the Court –
  - (a) makes an order under Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles); or
  - (b) decides that it should not make an order under that Article.
- (5) Nothing in this Article affects any other power of the Court.
- (6) If the registered proprietor and an exclusive licensee have concurrent rights of action under Article 33 [TMA 31] (concurrent rights of action) –
  - (a) the registered proprietor must notify the exclusive licensee before applying for an order under paragraph (1), unless they have agreed otherwise; and
  - (b) the Court may, on the application of the exclusive licensee, make any order under this Article that it thinks fit having regard to the terms of the licence, subject to any agreement between the proprietor and licensee.

### **36 Period after which remedy of delivery up not available [TMA s18/]**

- (1) The Court must not make an order under Article 35(1) [TMA 16] (order for delivery up of infringing goods, infringing material or infringing articles) on an application made –

- (a) for infringing goods, after the 6-year period beginning with the date on which the trade mark was affixed to the goods or their packaging;
  - (b) for infringing material, after the 6-year period beginning with the date on which the trade mark was affixed to the material;
  - (c) for infringing articles, after the 6-year period beginning with the date on which the articles were made.
- (2) Paragraph (3) applies if, during the whole or part of the 6-year period mentioned in paragraph (1), the registered proprietor is –
  - (a) under a disability; or
  - (b) prevented by fraud or concealment from discovering the facts entitling them to apply for an order under Article 35(1) [TMA 16] (order for delivery up of infringing goods, infringing material or infringing articles).
- (3) The Court must not make an order under Article 35(1) [TMA 16] (order for delivery up of infringing goods, infringing material or infringing articles) on an application made after the 6-year period beginning with the date on which the registered proprietor –
  - (a) ceased to be under a disability; or
  - (b) could have discovered, with reasonable diligence, the facts entitling them to apply for an order under Article 35(1) [TMA 16] (order for delivery up of infringing goods, infringing material or infringing articles).
- (4) For the purposes of this Article, a person is under a disability if –
  - (a) they have not reached the age of majority, within the meaning given in Articles 1 and 2 of the [Age of Majority \(Jersey\) Law 1999](#); or
  - (b) they lack capacity to conduct legal proceedings, within the meaning of Article 4 of the Capacity and Self-Determination (Jersey) Law 2016.

### **37 Order for disposal of infringing goods, infringing material or infringing articles** **[\[TMA s19/\]](#)**

- (1) If infringing goods, infringing material or infringing articles have been delivered up under an order under Article 35(1) [TMA 16] (order for delivery up of infringing goods, material or articles), a person may apply to the Court –
  - (a) for an order that they be destroyed, or forfeited to a person that the Court thinks fit; or
  - (b) for a decision that an order should not be made under sub-paragraph (a).
- (2) In considering what order (if any) should be made under paragraph (1), the Court must consider whether other remedies that the Court may grant in infringement proceedings would be adequate to compensate the registered proprietor and any licensee, and protect their interests.
- (3) The Court may make any order it considers appropriate in relation to the service of notice on a person who has an interest in the infringing goods, infringing material or infringing articles.
- (4) A person who has an interest in the infringing goods, infringing material or infringing articles is entitled –
  - (a) to appear in proceedings for an order under paragraph (1), whether or not the person was served with notice; and

- (b) to appeal against an order made under paragraph (1), whether or not the person appeared in the proceedings.
- (5) An order under paragraph (1) does not take effect –
  - (a) until the end of the period for giving notice of appeal; or
  - (b) if notice of appeal is given, until the final determination or abandonment of the appeal proceedings.
- (6) If more than 1 person is interested in the infringing goods, infringing material or infringing articles, the Court must make an order that it considers just.
- (7) If the Court decides that an order should not be made under paragraph (1), the person who had possession, custody or control of the infringing goods, infringing material or infringing articles before they were delivered up is entitled to their return.
- (8) For the purpose of this Article, a reference to a person having an interest in infringing goods, infringing material or infringing articles includes any person in whose favour an order could be made under –
  - (a) paragraph (1);
  - (b) the [Registered Designs \(Jersey\) Law 1957](#);
  - (c) Articles 143, 321 and 377 of the [Intellectual Property \(Unregistered Rights\) \(Jersey\) Law 2011](#); or
  - (d) the [Community Provisions \(Goods Suspected of Infringing Intellectual Property Rights\) \(Jersey\) Regulations 2014](#).

### **38 Remedies for infringement of property right [TMA 14]**

In infringement proceedings brought by a registered proprietor, the Court may grant the registered proprietor any relief that it may grant for the infringement of a property right.

### **39 Order for erasure of sign that infringes registered trade mark [TMA s15/]**

- (1) If a person is found to have infringed a registered trade mark, the Court may make an order requiring the person –
  - (a) to erase the offending sign from any infringing goods, infringing material or infringing articles in their possession, custody or control; or
  - (b) if it is not reasonably practicable for the offending sign to be erased, to destroy the infringing goods, infringing material or infringing articles.
- (2) If an order under paragraph (1) is not complied with, or it appears to the Court that it is likely that the order would not be complied with, the Court may order that the infringing goods, infringing material or infringing articles are delivered to a person that the Court directs for erasure or destruction of the sign.

## **DIVISION 4 – WELL-KNOWN TRADE MARKS**

### **40 Protection of well-known trade marks [TMA s56/TMJL 13A/]**

- (1) The proprietor of a well-known trade mark is entitled to restrain by injunction the use in Jersey of an identical or similar trade mark –

- (a) in relation to identical or similar goods or services if the use of the identical or similar trade mark is likely to cause confusion; or
  - (b) if the well-known trade mark has a reputation in Jersey, and the use of the identical or similar trade mark is –
    - (i) without due cause; and
    - (ii) takes unfair advantage of or is detrimental to the distinctive character or the reputation of the well-known trade mark.
- (2) The right in paragraph (1) is subject to Article 95 [TMA 48] (effect of acquiescence).
- (3) Paragraph (1)(b) applies whether or not the goods or services in relation to which the identical or similar trade mark is used are identical or similar goods or services.
- (4) Nothing in this Article affects the continuation of a genuine use of a trade mark that began before this Article comes into force.
- (5) In this Article –  
“identical or similar goods or services” means goods or services that are identical or similar to those for which the well-known trade mark is entitled to protection under the Paris Convention or the WTO Agreement;  
“identical or similar trade mark” means a trade mark (or the essential part of a trade mark) that is identical or similar to a well-known trade mark.
- (6) For the purposes of this Law, “well-known trade mark” means a trade mark that –
  - (a) is entitled to protection under the Paris Convention or the WTO Agreement as a well-known trade mark; and
  - (b) is well known in Jersey as being the trade mark of a person (whether or not that person carries on business, or has any goodwill, in Jersey) who –
    - (i) is a British citizen or national of a Convention country; or
    - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, Jersey or a Convention country.
- (7) References in this Law to the proprietor of a well-known trade mark must be construed in accordance with paragraph (6).

## DIVISION 5 – PROHIBITED GOODS

### **41 Notice of importation of prohibited goods [Art 22 TMJL] [TMA s89]**

- (1) A registered proprietor or a licensee of a registered trade mark may give written notice to the Agent of the Impôts –
- (a) that they are the proprietor or licensee of a registered trade mark;
  - (b) that, at a time and place specified in the notice, infringing goods, infringing material or infringing articles in relation to the registered trade mark are expected to arrive in Jersey –
    - (i) from outside the European Economic Area; or
    - (ii) from within that Area but not having been entered for free circulation; and
  - (c) that the proprietor or licensee requests the Agent of the Impôts to treat the infringing goods, infringing material or infringing articles as prohibited goods.

- (2) If a notice is in force under paragraph (1) –
  - (a) the importation of the goods, other than by a person for their private and domestic use, is prohibited; and
  - (b) the goods are liable to forfeiture.
- (3) A person who imports prohibited goods is not liable to any penalty other than forfeiture of the goods.
- (4) This Article does not apply to goods placed in, or expected to be placed in, any of the situations mentioned in Article 1(1) of the EU Regulation.
- (5) In this Article, “EU Regulation” has the meaning given in Article 1(1) of the [Community Provisions \(Goods Suspected of Infringing Intellectual Property Rights\) \(Jersey\) Regulations 2014](#).

#### **42 Specified requirements for a notice of importation [Art 23 TMJL]**

- (1) The Minister may by Order specify –
  - (a) the form in which a notice under Article 41 [TMA s89] (notice of importation of prohibited goods) is to be given;
  - (b) any evidence required to support the notice;
  - (c) any fees payable in respect of the notice; and
  - (d) any security to be given for liability or expense incurred by the Agent of the Impôts as a result of detaining prohibited goods or doing anything to the detained goods.
- (2) The Order may require the person giving a notice –
  - (a) to provide the Agent of the Impôts with specified evidence at either or both of the following times –
    - (i) when the person gives the notice;
    - (ii) when the goods are imported; and
  - (b) to comply with any other specified conditions.
- (3) An Order may, in particular, require a person giving notice –
  - (a) to pay any specified fees;
  - (b) to give any specified security; and
  - (c) to indemnify the Agent of the Impôts against any liability or expense, whether or not security is given.
- (4) The Agent of the Impôts must pay to the Treasurer of the States all fees received under the Order in the manner the Treasurer requires.
- (5) In this Article, “specified” means specified in the Order.

#### **43 Disclosure of information [Art 24 TMJL] [TMA 91]**

- (1) This Article applies to information held or obtained by the Agent of the Impôts in relation to infringing goods, infringing material or infringing articles if that information is held or was obtained for the purposes of, or in connection with, the exercise of the functions of the Agent of the Impôts in relation to imported goods.

- (2) The Agent of the Impôts may authorise the disclosure of that information for the purpose of facilitating the exercise by any person of a function in connection with the investigation or prosecution of an offence under –
- (a) Article 144 [25 TMJL /TMA s92] (unauthorised use of trade mark in relation to goods);
  - (b) the [Consumer Safety \(Jersey\) Law 2006](#);
  - (c) the [Supply of Goods and Services \(Jersey\) Law 2009](#); or
  - (d) the [Consumer Protection \(Unfair Practices\) \(Jersey\) Law 2018](#).
- (3) The Minister may by Order amend paragraph (2) to add or remove enactments that relate to trade descriptions, consumer protection or consumer safety or contain similar provision.

## PART 5

### UNJUSTIFIED THREAT OF INFRINGEMENT PROCEEDINGS

#### 44 Interpretation of Part

In this Part –

“actionable threat” means a threat of infringement proceedings that is actionable under Article 46 [TMA s21A] (actionable threats);

“aggrieved person” means a person aggrieved by a threat of infringement proceedings;

“infringement of the registered trade mark” means infringement of –

- (a) a registered trade mark; or
- (b) a trade mark registered as a result of an application for registration that has been published under Article 63 [TMA s38] (publication of application for registration);

“permitted communication” has the meaning given in Article 47 [TMA s21B];

“recipient”, in relation to a communication directed to the public or a section of the public, includes a person to whom the communication is directed;

“threat of infringement proceedings” has the meaning given in Article 45 [[TMA s21](#)].

#### 45 Threat of infringement proceedings [[TMA s21](#)/; TMA 21F/]

- (1) A communication contains a “threat of infringement proceedings” if a reasonable person in the position of a recipient would understand from the communication that –
- (a) a registered trade mark exists, or an application for registration of a trade mark has been published under Article 63 [TMA s38] (publication of application for registration); and
  - (b) a person intends to bring court proceedings, whether in Jersey or elsewhere, against another person for infringement of the registered trade mark by –
    - (i) an act done in Jersey; or
    - (ii) an act which, if done, would be done in Jersey.

- (2) In paragraph (1)(b), “court proceedings” includes –
  - (a) infringement proceedings; and
  - (b) proceedings for an order under Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles).

#### **46 Actionable threats [TMA s21A/]**

- (1) A threat of infringement proceedings is actionable by an aggrieved person unless any of the following paragraphs apply.
- (2) A threat of infringement proceedings is not actionable if the infringement of the registered trade mark is alleged to consist of –
  - (a) affixing, or causing another person to affix, a sign to goods or their packaging;
  - (b) importing, for disposal, goods to which, or to the packaging of which, a sign has been affixed; or
  - (c) supplying services under a sign.
- (3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in paragraph (2).
- (4) A threat of infringement proceedings is not actionable if –
  - (a) the threat is made to a person who has done, or intends to do, an act mentioned in paragraph (2)(a) or (b) in relation to goods or their packaging; and
  - (b) the infringement is alleged to consist of doing anything else in relation to those goods or their packaging.
- (5) A threat of infringement proceedings is not actionable if –
  - (a) the threat is made to a person who has done, or intends to do, an act mentioned in paragraph (2)(c) in relation to services; and
  - (b) the infringement is alleged to consist of doing anything else in relation to those services.
- (6) A threat of infringement proceedings that is not an express threat is not actionable if it is contained in a permitted communication.

#### **47 Permitted communications [TMA s21B/]**

- (1) For the purposes of Article 46(6) [TMA s21A] (actionable threats), a communication containing a threat of infringement proceedings is a “permitted communication” if –
  - (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose;
  - (b) all the information that relates to the threat is information –
    - (i) that is necessary for that purpose; and
    - (ii) that the person making the communication reasonably believes is true.
- (2) Each of the following is a “permitted purpose” –
  - (a) giving notice that a registered trade mark exists, or that an application for registration of a trade mark has been published under Article 63 [TMA s38] (publication of application for registration);

- (b) discovering whether, or by whom, there has been an infringement of the registered trade mark by an act mentioned in Article 46(2)(a), (b) or (c) [TMA s21A] (actionable threats);
  - (c) giving notice that a person has a right in or under a registered trade mark (or in or under a trade mark for which an application for registration has been published under Article 63 [TMA s38] (publication of application for registration), if another person's awareness of the right is relevant to any proceedings that may be brought in respect of the trade mark.
- (3) The Court may, having regard to the nature of the purposes listed in paragraph (2), treat any other purpose as a permitted purpose if it considers that it is in the interests of justice to do so.
- (4) But none of the following is to be treated as a permitted purpose –
- (a) requesting a person to cease using, in the course of trade, a sign in relation to goods or services;
  - (b) requesting a person to deliver up or destroy goods;
  - (c) requesting a person to give an undertaking relating to the use of a sign in relation to goods or services.
- (5) If any of the following information is included in a communication made for a permitted purpose, it is information that is “necessary for that purpose” –
- (a) a statement that a registered trade mark exists and is in force;
  - (b) a statement that an application for registration of a trade mark has been made, or has been published under Article 63 [TMA s38] (publication of application for registration);
  - (c) particulars of a registered trade mark (or of a right in or under the registered trade mark) –
    - (i) that are accurate in all material respects; and
    - (ii) that are not misleading in any material respect;
  - (d) particulars of a trade mark (or of a right in or under the trade mark) for which an application for registration has been made, or has been published under Article 63 [TMA s38] (publication of application for registration) –
    - (i) that are accurate in all material respects; and
    - (ii) that are not misleading in any material respect;
  - (e) information enabling the identification of the goods or their packaging, or the services, in relation to which it is alleged that the use of a sign constitutes an infringement of the registered trade mark.

#### **48 Proceedings for actionable threats [TMA s21C/]**

- (1) An aggrieved person may bring any of the following proceedings against a person who makes an actionable threat –
- (a) proceedings for a declaration that the threat is unjustified;
  - (b) proceedings for an injunction against the continuance of the threat;
  - (c) proceedings for damages in respect of any loss sustained by the aggrieved person by reason of the threat.

- (2) It is a defence for the person who made the threat to show that the act in respect of which infringement proceedings were threatened constitutes, or if done would constitute, an infringement of the registered trade mark.
- (3) It is a defence for the person who made the threat to show –
  - (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in Article 46(2) [TMA s21A] (actionable threats) in relation to the goods or their packaging or the services that are the subject of the threat; and
  - (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

#### **49 Professional advisers [TMA s21D/]**

- (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser, or any person vicariously liable for the actions of a professional adviser, if the conditions in paragraph (2) are met.
- (2) The conditions are that –
  - (a) in making the communication containing the threat, the professional adviser was acting on the instructions of another person; and
  - (b) when the communication is made, the professional adviser identifies the person on whose instructions the adviser was acting.
- (3) This Article does not affect any liability of the person on whose instructions the adviser was acting.
- (4) A person asserting that paragraph (1) applies must prove (if required) that at the material time –
  - (a) the person who made the communication containing the threat was acting as a professional adviser; and
  - (b) the conditions in paragraph (2) were met.
- (5) In this Article, “professional adviser” means a person who, when the communication containing the threat was made –
  - (a) was acting in a professional capacity in providing legal services or the services of a registered trade mark agent; and
  - (b) was regulated in the provision of legal services, or the services of a registered trade mark agent, by 1 or more regulatory bodies, whether through membership of a regulatory body, the issue of a licence to practise or any other means.

## **PART 6**

### **REGISTRATION OF TRADE MARKS IN JERSEY**

#### **DIVISION 1 – REGISTER OF TRADE MARKS**

#### **50 Register of trade marks [TMA s63/]**

- (1) The Registrar must maintain a register of trade marks.

- (2) The Registrar must enter in the register –
  - (a) registered trade marks;
  - (b) the name and address of the proprietor of a registered trade mark;
  - (c) the name and address of any licensee of a registered trade mark;
  - (d) particulars of any security interest granted over a registered trade mark;
  - (e) the date of registration;
  - (f) the number of the registration;
  - (g) particulars of registrable transactions that are required to be registered under Article 53 [TMA 25] (particulars of registrable transactions);
  - (h) the date of any renewal;
  - (i) other matters specified in an Order under paragraph (3).
- (3) The Minister may by Order specify other matters relating to registered trade marks that must be entered in the Register.

## **51 Classification of goods and services for the purposes of registration [TMA s34/]**

- (1) The Minister must by Order specify a system for classifying goods and services (“classification system”) for the purpose of the registration of trade marks.
- (2) Goods and services must be classified according to the classification system.
- (3) A question arising about the class within which any goods or services fall must be determined by the Registrar, whose decision is final.

## **52 Adaptation of entries to new classification [TMA s65/]**

- (1) The Minister may, by Order, provide that the Registrar may do anything the Registrar considers necessary to implement an amended or substituted classification of goods or services for the purposes of the registration of trade marks.
- (2) The Order may in particular provide for the Registrar to amend existing entries in the register of trade marks so that the entries accord with the new classification.
- (3) The Registrar must not exercise the power of amendment in paragraph (2) so as to extend the rights conferred by a registration unless it appears to the Registrar that –
  - (a) compliance with this requirement would involve unnecessary complexity; and
  - (b) any extension of rights would not be substantial and would not adversely affect the rights of any person.
- (4) The Order may provide that the Registrar may –
  - (a) require the registered proprietor, within a specified time, to file a proposal for amendment of the register; and
  - (b) cancel or refuse to renew the registration of the trade mark if the registered proprietor fails to file a proposal for amendment.
- (5) The Registrar must publish a proposal for amendment –
  - (a) in a manner specified in the Order; or
  - (b) if the Order does not specify a manner, in a manner the Registrar thinks fit.
- (6) A proposal for amendment may be opposed –
  - (a) in a manner specified in the Order; or

- (b) if the Order does not specify a manner, in a manner the Registrar thinks fit.

### **53 Particulars of registrable transactions [TMA s25/]**

- (1) The Minister must by Order specify the particulars of a registrable transaction that must be registered.
- (2) The Registrar must register the particulars on receipt of an application made by –
  - (a) a person claiming to be entitled to an interest in or under a registered trade mark as a result of the registrable transaction; or
  - (b) any other person claiming to be affected by the registrable transaction.
- (3) The following are registrable transactions –
  - (a) the assignment or other transmission of a registered trade mark or a right in it;
  - (b) the grant of a licence under a registered trade mark;
  - (c) the grant of a security interest over a registered trade mark or a right in or under it.
- (4) Until an application has been made for registration of the particulars of a registrable transaction –
  - (a) the registrable transaction does not affect a person acquiring a conflicting interest in or under the registered trade mark in ignorance of the registrable transaction; and
  - (b) a person claiming to be a licensee as a result of the registrable transaction does not have the protection of Articles 31 [TMA 30] (right of licensee to bring infringement proceedings) and 32 [TMA 31] (right of exclusive licensee to bring infringement proceedings in own name).
- (5) Paragraph (6) applies if –
  - (a) a person becomes the proprietor or a licensee of a registered trade mark as a result of a registrable transaction; and
  - (b) the trade mark is infringed before the particulars of the registrable transaction are registered.
- (6) In infringement proceedings brought by the registered proprietor or a licensee, the Court must not award costs to the proprietor or licensee unless –
  - (a) an application for registration of the particulars of a registrable transaction is made before the end of the 6-month period beginning with the date of the registrable transaction; or
  - (b) the Court is satisfied that –
    - (i) it was not practicable for the application to be made before the end of that period; and
    - (ii) the application was made as soon as practicable after the end of that period.

### **54 Amendment of registered particulars [TMA s25/]**

- (1) The Minister may by Order provide for the Registrar –
  - (a) to amend registered particulars to reflect an alteration of the terms of a licence;

- (b) to remove registered particulars relating to the grant of a licence from the register of trade marks if it appears to the Registrar from the registered particulars that the licence was granted for a fixed period and that period has ended; or
  - (c) if a fixed period is not indicated, to remove registered particulars relating to the grant of a licence from the register if –
    - (i) the Registrar has notified the parties of the intention to remove the registered particulars from the register; and
    - (ii) the period specified in the Order has ended.
- (2) The Minister may by Order provide for the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.
- (3) If the Minister does not make an Order under paragraph (1) or (2), the Registrar may amend the registered particulars as the Registrar thinks fit.

## **55 Rectification of the register of trade marks [TMA s64/]**

- (1) A person with sufficient interest may apply for the rectification of an error or omission in the register of trade marks.
- (2) But an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.
- (3) An application for rectification may be made to the Registrar or the Court, but if Court proceedings relating to the trade mark are pending, the application must be made to the Court.
- (4) If the application is made to the Registrar, the Registrar may refer the application to the Court at any stage of the Court proceedings.
- (5) The effect of rectification of the register is that the error or omission is taken never to have been made, unless the Registrar or Court directs otherwise.
- (6) The Registrar may enter in the register any change in the name or address of the registered proprietor or a licensee on receipt of a request from them made in a manner –
  - (a) specified by the Minister by Order; or
  - (b) if the Minister does not make an Order, specified by the Registrar.
- (7) The Registrar may remove from the register any matter appearing to the Registrar to have ceased to have effect.

## **56 Alteration of registered trade mark [TMA s44/]**

- (1) A registered trade mark must not be altered in the register of trade marks either during the original period of registration or on renewal.
- (2) But the Registrar may, at the request of the registered proprietor, allow the alteration of a registered trade mark if –
  - (a) the trade mark includes the registered proprietor's name or address; and
  - (b) the alteration –
    - (i) is limited to alteration of that name or address; and
    - (ii) does not substantially affect the identity of the trade mark.

- (3) The Minister must by Order provide for –
  - (a) the publication of an alteration to a registered trade mark under this Article; and
  - (b) the making of objections by a person claiming to be affected by the alteration.

#### **57 Notice of trusts [TMA s26(1)/Gsy s26(1)/]**

No notice of any trust (express, implied or constructive) may be entered in the register, and the Registrar is not affected by any such notice.

### **DIVISION 2 – DATE OF FILING AND DATE OF PRIORITY**

#### **58 Date of filing [TMA s33/]**

- (1) The date of filing, in relation to an application for registration, is the date on which the applicant provides to the Registrar documents containing everything required by Article 61(2) [TMA s32] (application for registration).
- (2) If documents required to be provided to the Registrar under Article 61(2) [TMA s32] (application for registration) are provided on different days, the date of filing is the last of those days.

#### **59 Right of priority on basis of Convention application [TMA s35/]**

- (1) This Article applies if –
  - (a) an applicant for registration of a trade mark has filed a Convention application in relation to –
    - (i) the same trade mark; and
    - (ii) some or all of the same goods or services; and
  - (b) the filing of the Convention application was adequate to establish the date of filing of the application in the Convention country, regardless of the outcome of the application.
- (2) The applicant for registration has a right of priority on the basis of the Convention application for the 6-month period beginning with the date of filing of the Convention application (“priority period”).
- (3) The right of priority may be assigned or otherwise transmitted during the priority period, either with the Convention application or independently.
- (4) If the applicant or the applicant’s successor in title claims the right of priority within the priority period –
  - (a) the date of priority for the application for registration is the date of filing of the Convention application; and
  - (b) the registrability of the trade mark is not affected by any use of the trade mark in Jersey in the period between the date of priority and the date of application for registration.
- (5) The Minister may by Order provide for how a person may claim a right of priority on the basis of a Convention application.

- (6) For the purpose of paragraph (4)(a), if more than 1 Convention application has been filed in relation to the same trade mark, the date of priority is the date of filing of the Convention application that was filed first (“first Convention application”).
- (7) A subsequent Convention application filed in the same Convention country in relation to the same trade mark is taken to be the first Convention application if –
  - (a) the previous Convention application is withdrawn, abandoned or refused without being laid open to public inspection and without leaving any rights outstanding; and
  - (b) the applicant or the applicant’s successor in title has not yet claimed the right of priority on the basis of the previous Convention application.
- (8) If paragraph (7) applies, the previous Convention application may not subsequently serve as a basis for claiming a right of priority under this Article.
- (9) This Article applies in relation to a Convention application filed before, on or after the commencement date.

## **60 Right of priority on basis of other overseas application [TMA s36/]**

- (1) The States may, by Regulations, provide for conferring on an applicant for registration of a trade mark a right of priority, for a specified period, on the basis of an overseas application filed by the applicant in relation to –
  - (a) the same trade mark; and
  - (b) some or all of the same goods or services.
- (2) The Regulations may –
  - (a) make provision corresponding to that made by Article 59 [TMA s35] (right of priority on basis of Convention application) in relation to Convention applications; and
  - (b) make other provision that the States consider appropriate.
- (3) If Regulations are made under this Article, the Minister may by Order provide for how an applicant or the applicant’s successor in title may claim the right of priority.
- (4) In this Article –

“overseas application” means an application for protection of a trade mark that is filed before or after the commencement date in –

  - (a) the Bailiwick of Guernsey;
  - (b) a British Overseas Territory; or
  - (c) a country or territory in relation to which the Government of the United Kingdom have entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks;

“specified period” means a period specified in the Regulations beginning with the date of filing of the overseas application.

### **DIVISION 3 – APPLICATION FOR REGISTRATION**

## **61 Application for registration [TMA s32/]**

- (1) An application for registration of a trade mark must be made to the Registrar.

- (2) The application for registration must contain –
  - (a) a request to register a trade mark;
  - (b) the name and address of the applicant for registration;
  - (c) a statement of the goods or services for which the application for registration is made;
  - (d) a representation of the trade mark that is capable of being represented in the register of trade marks in a manner that enables the Registrar, a Jersey court and the public to determine the clear and precise subject matter of the protection afforded to the proprietor.
- (3) The application for registration must state –
  - (a) that the trade mark is being used by, or with the consent of, the applicant in relation to the goods or services for which the application is made; or
  - (b) that the applicant has a bona fide intention that it will be used in that way.
- (4) The application for registration is subject to the payment of –
  - (a) an application fee; and
  - (b) a fee appropriate to the class or number of classes within which the goods or services fall.

## **62 Examination and acceptance of application for registration [TMA s37/]**

- (1) The Registrar must examine whether an application for registration meets the requirements for registration.
- (2) If it appears to the Registrar that the application does not meet the requirements for registration, the Registrar must –
  - (a) inform the applicant; and
  - (b) give the applicant an opportunity, within a period specified by the Registrar, to make representations or to amend the application.
- (3) The Registrar must refuse to accept the application if the applicant –
  - (a) fails to satisfy the Registrar that the application meets the requirements for registration;
  - (b) fails to amend the application to meet those requirements; or
  - (c) fails to respond before the end of the period specified under paragraph (2).
- (4) The Registrar must accept the application if it appears to the Registrar that the application meets the requirements for registration.

## **63 Publication of application for registration [TMA s38(1) and TMA s81/]**

- (1) If the Registrar accepts an application for registration under Article 62 [TMA 37(5)] (examination and acceptance of application for registration), the Registrar must publish the application in the manner specified by the Minister by Order.
- (2) If the Minister does not make an Order under paragraph (1), the Registrar must publish the application in the manner the Registrar thinks fit.
- (3) The notice of publication must –

- (a) inform the public of the right to give a notice of opposition and make observations under Article 78 [TMA s38(2), (2A), (2B) and (3)] (notice of opposition and observations); and
  - (b) specify the number allocated to the application for registration.
- (4) The Minister must by Order provide for the Registrar to publish in the Jersey Gazette or in some other manner –
- (a) particulars of any application for registration (including a representation of the trade mark); and
  - (b) any other information relating to trade marks that is specified in the Order or that the Registrar thinks fit.

#### **64 Withdrawal or amendment of application for registration [TMA s39/]**

- (1) An applicant for registration may at any time –
- (a) withdraw the application for registration; or
  - (b) amend the application to restrict the goods or services for which the application for registration is made.
- (2) If the application for registration has been published under Article 63 [TMA s38] (publication of application for registration), the Registrar must publish a withdrawal or amendment of the application under paragraph (1) –
- (a) in the manner specified by the Minister by Order; or
  - (b) if the Minister does not make an Order under sub-paragraph (a), in the manner the Registrar thinks fit.
- (3) The Registrar may amend an application for registration on the request of the applicant to correct the following matters only –
- (a) the name or address of the applicant;
  - (b) errors of wording or copying;
  - (c) obvious mistakes.
- (4) The Registrar may make a correction under paragraph (3) only if the correction does not –
- (a) substantially affect the identity of the trade mark; or
  - (b) extend the goods or services for which the application for registration is made.
- (5) The Minister must by Order provide for –
- (a) the publication of an amendment to an application for registration of a trade mark that affects –
    - (i) the representation of the trade mark; or
    - (ii) the goods or services for which the application for registration is made; and
  - (b) the making of objections by a person claiming to be affected by the amendment.

#### **65 Provision of information about published applications [TMA s67(1)]**

- (1) This Article applies if an application for registration has been published under Article 63 [TMA s38] (publication of application for registration).

- (2) The Registrar must on request provide a person with information and allow them to inspect documents relating to –
  - (a) the application for registration; or
  - (b) the registered trade mark resulting from it.
- (3) The request must –
  - (a) be made in a manner specified by the Minister by Order;
  - (b) be accompanied by the appropriate fee; and
  - (c) specify the information or documents to be provided or inspected.
- (4) The Minister may by Order provide for restrictions on the provision of information or inspection of documents under this Article.

#### **66 Provision of information before application is published [TMA s67(2)]**

- (1) The Registrar must not publish or communicate to any person information or documents relating to or constituting an application for registration before the application is published under Article 63 [TMA s38] (publication of application for registration).
- (2) Paragraph (1) does not apply if –
  - (a) the applicant has consented to the publication or communication of the information or documents;
  - (b) paragraph (3) applies, and the person makes a request under Article 65 [TMA s67(1)] (provision of information about published applications); or
  - (c) circumstances specified by the Minister by Order apply.
- (3) This paragraph applies if the person has been notified that the applicant will, following registration of the trade mark, bring infringement proceedings against the person in respect of acts done after the application is published under Article 63 [TMA s38] (publication of application for registration).

#### **67 Requirement to notify transactions affecting applicant's property rights [TMA s25 as modified by s27(1) and (3)]**

- (1) The following persons must give written notice to the Registrar of a transaction listed in paragraph (2) –
  - (a) a person claiming that, as a result of the transaction, they are entitled to an interest in an applicant's property rights;
  - (b) any other person claiming to be affected by the transaction.
- (2) The transactions are –
  - (a) an assignment or other transmission of the applicant's property rights;
  - (b) the grant of a licence to use the trade mark to which an application for registration relates;
  - (c) the grant of a security interest over an applicant's property rights.
- (3) Until notice of a transaction is given under paragraph (1), the transaction does not affect a person acquiring a conflicting interest in or under the application for registration in ignorance of the transaction.

## DIVISION 4 – GROUNDS FOR REFUSING REGISTRATION

**68 Absolute grounds for refusal [TMA s3/]**

- (1) The Registrar must refuse registration of any of the following –
  - (a) a sign that does not fall within the definition of a trade mark;
  - (b) a trade mark that is devoid of any distinctive character;
  - (c) a trade mark that consists only of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services;
  - (d) a trade mark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade.
- (2) The Registrar must not refuse registration of a trade mark on the basis of paragraph (1)(b), (c) or (d) if, before the date of application for registration, the trade mark has acquired a distinctive character as a result of the use made of it.
- (3) Schedule 1 (collective marks) provides an exception to paragraph (1)(c) in relation to indications of geographical origin of goods or services.
- (4) The Registrar must refuse registration of a sign that consists only of –
  - (a) the shape, or another characteristic, that results from the nature of the goods themselves;
  - (b) the shape, or another characteristic, of goods that is necessary to obtain a technical result;
  - (c) the shape, or another characteristic, that gives substantial value to the goods.
- (5) The Registrar must refuse registration of a trade mark that –
  - (a) is contrary to public policy or contrary to accepted principles of morality; or
  - (b) would, by its nature, deceive the public (for example, in relation to the nature, quality or geographical origin of the goods or services).
- (6) The Registrar must refuse registration of a trade mark –
  - (a) that consists of, or reproduces in its essential elements, an earlier plant variety denomination that is registered under the [Intellectual Property \(Plant Varieties\) \(Jersey\) Law 2016](#) or under an international agreement that extends to Jersey and provides for the protection of plant variety rights; and
  - (b) that relates to plant varieties of the same or closely related species.
- (7) The Registrar must refuse registration of a trade mark if, or to the extent that, the application for registration is made in bad faith.

**69 Absolute grounds for refusal – prohibitions [TMA s3/]**

- (1) The Registrar must refuse registration of a trade mark so far as the use of that trade mark is prohibited under any other enactment or under customary law.
- (2) The Registrar must refuse registration of a trade mark if the registration of that trade mark is prohibited under any of the following that provide for the protection of designations of origin or geographical indications –
  - (a) any other enactment;

- (b) customary law;
  - (c) an international agreement that extends to Jersey.
- (3) The Registrar must refuse registration of a trade mark if the registration of that trade mark is prohibited under any of the following that provide for the protection of traditional terms for wine or traditional specialities guaranteed –
- (a) any other enactment;
  - (b) customary law;
  - (c) an international agreement that extends to Jersey.

## **70 Relative grounds for refusal – identical or similar trade marks [TMA s5/]**

- (1) The Registrar must refuse registration of a trade mark if –
- (a) the trade mark is identical to an earlier trade mark; and
  - (b) the goods or services for which the application for registration of the trade mark is made are identical to the goods or services for which the earlier trade mark is registered.
- (2) The Registrar must refuse registration of a trade mark if there is a likelihood of confusion on the part of the public if the trade mark is registered because –
- (a) the trade mark is identical or similar to an earlier trade mark; and
  - (b) the goods or services for which the application for registration of the trade mark is made are identical or similar to those for which the earlier trade mark is registered.
- (3) In paragraph (2), “likelihood of confusion” includes the likelihood of association with the earlier trade mark.
- (4) The Registrar must refuse registration of a trade mark that is identical or similar to an earlier trade mark if –
- (a) the earlier trade mark has a reputation in Jersey; and
  - (b) the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark.
- (5) Paragraph (4) applies whether or not the goods or services for which the application for registration of the trade mark is made are identical or similar to those for which the earlier trade mark is registered.
- (6) This Article does not prevent the registration of a later trade mark if the proprietor of the earlier trade mark consents to the registration.

## **71 Relative grounds for refusal – earlier rights [TMA s5/]**

- (1) The Registrar must refuse registration of a trade mark if –
- (a) the use in Jersey of the trade mark is likely to be prevented by customary law (in particular, the law of passing off) that protects an unregistered trade mark or other sign used in the course of trade; and
  - (b) the rights to the unregistered trade mark or other sign were acquired before –
    - (i) the date of application for registration of the trade mark; or
    - (ii) any date of priority for that application.

- (2) The Registrar must refuse registration of a trade mark if –
  - (a) the use in Jersey of the trade mark is likely to be prevented by an enactment or customary law that protects designations of origin or geographical indications;
  - (b) an application for a designation of origin or geographical indication has been made before the date of application for registration of the trade mark or any date of priority for that application; and
  - (c) the designation of origin or geographical indication is subsequently registered.
- (3) The Registrar must refuse registration of a trade mark if the use of the trade mark in Jersey is likely to be prevented by an earlier right, in particular an earlier right arising from the law of copyright or the law relating to industrial property rights.
- (4) In this Law, the proprietor of an earlier right in relation to a trade mark means a person who is entitled under this Article to prevent the use of the trade mark.
- (5) This Article does not prevent the registration of a trade mark if the proprietor of the earlier right consents to the registration of the trade mark.

## **72 Relative grounds for refusal – application without proprietor’s consent [TMA s5(6)]**

- (1) This Article applies if an agent or representative of the proprietor of a trade mark applies for the registration of the trade mark in their own name, without the proprietor’s consent.
- (2) The Registrar must refuse registration of the trade mark unless the agent or representative justifies the action mentioned in paragraph (1).

## **73 Grounds for refusal relating to only some goods or services [TMA s5A/]**

If grounds for refusing registration exist in relation to only some of the goods or services for which an application for registration is made, the Registrar must refuse registration in relation to only those goods or services.

## **74 Specially protected emblems [Gsy s4/]**

- (1) The Registrar must refuse registration of a trade mark that consists of or contains anything to which paragraph (2) applies, unless it appears to the Registrar that consent to the registration has been given by or on behalf of His Majesty or other member of the Royal family.
- (2) This paragraph applies to –
  - (a) the Royal arms or any of the principal armorial bearings of the Royal arms;
  - (b) any insignia or device that so closely resembles the Royal arms or any of the principal armorial bearings that it is likely to be mistaken for them;
  - (c) a representation of the Royal crown or any of the Royal flags;
  - (d) a representation of His Majesty or other member of the Royal family, or a colourable imitation of the representation;
  - (e) words, letters or devices that are likely to lead the public to think that the applicant for registration has or has recently had Royal patronage or authorisation.

- (3) The Registrar must refuse registration of a trade mark that consists of or contains a representation of anything to which paragraph (4) applies if it appears to the Registrar that the use of that trade mark would be misleading or grossly offensive.
- (4) This paragraph applies to –
  - (a) the national flag of the United Kingdom (commonly known as the Union Jack); or
  - (b) the flag of England, Wales, Scotland, Northern Ireland, the Isle of Man, Jersey or any of the islands of the Bailiwick of Guernsey.
- (5) The Minister may by Order identify the flags mentioned in paragraph (4)(b).
- (6) The Registrar must, in specified circumstances, refuse registration of a trade mark that consists of or contains –
  - (a) arms to which a person is entitled to use as a result of a grant of arms by the Crown; or
  - (b) insignia that resembles the arms so closely that the insignia is likely to be mistaken for them.
- (7) The Minister may by Order –
  - (a) specify the circumstances for the purpose of paragraph (6); and
  - (b) identify the arms mentioned in paragraph (6)(a).
- (8) Paragraph (6) does not apply in relation to the arms mentioned in paragraph (6)(a) if it appears to the Registrar that the person mentioned in paragraph (6)(a) has consented to the registration of the trade mark.
- (9) Nothing in this Law authorises the use of a registered trade mark in a way that is contrary to the laws of arms.
- (10) The Registrar must refuse registration of a trade mark that consists of or contains a controlled representation within the meaning of the Olympic Symbol etc. (Protection) Act 1995 of the United Kingdom (the “1995 Act”) unless it appears to the Registrar –
  - (a) that the application for registration is made by the person for the time being appointed under section 1(2) of the 1995 Act (power of Secretary of State to appoint a person as the proprietor of the Olympics association right); or
  - (b) that consent has been given by or on behalf of the person mentioned in subparagraph (a).

## **75 National emblems of Convention countries [TMA s57/TMJL Art 13B/]**

- (1) The Registrar must refuse registration of a trade mark that consists of or contains the flag of a Convention country unless –
  - (a) the competent authorities of that Convention country have authorised the registration; or
  - (b) it appears to the Registrar that use of the flag in the manner proposed is permitted without that authorisation.
- (2) The Registrar must refuse registration of a trade mark that consists of or contains the armorial bearings or any other state emblem of a Convention country that is protected under the Paris Convention or the WTO agreement, unless the competent authorities of that Convention country have authorised the registration.

- (3) The Registrar must, in the circumstances in paragraph (4), refuse registration of a trade mark that consists of or contains an official sign or hallmark that is protected under the Paris Convention or the WTO agreement, unless the competent authorities of the Convention country have authorised the registration.
- (4) The circumstances are –
  - (a) the official sign or hallmark has been adopted by a Convention country to indicate control and warranty in relation to goods or services; and
  - (b) the trade mark relates to goods or services of the same, or a similar kind, as those in relation to which the official sign or hallmark indicates control and warranty.
- (5) In this Article, any provision about a national flag or other state emblem, or an official sign or hallmark, applies equally to anything that from a heraldic point of view imitates the national flag, other state emblem, official sign or hallmark.
- (6) This Article does not prevent the registration of a trade mark on the application of a person who is a national of a country if –
  - (a) the person is authorised by their country to make use of the state emblem, or official sign or hallmark, of their country; and
  - (b) the trade mark consists of that emblem, official sign or hallmark, despite the emblem, official sign or hallmark being similar to that of another country.
- (7) The competent authorities of a Convention country whose authorisation for registration of a trade mark is required under this Article are entitled to restrain by injunction any use in Jersey of the trade mark without their authorisation.

## **76 Emblems of international organisations [TMA s58/TMJL Art 13B/]**

- (1) The Registrar must refuse registration of a trade mark that consists of an emblem, abbreviation or name that is protected under the Paris Convention or the WTO Agreement unless –
  - (a) the international organisation has authorised its registration; or
  - (b) it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed –
    - (i) would not suggest to the public that a connection exists between the international organisation and the trade mark; or
    - (ii) is not likely to mislead the public about the existence of a connection between the user and the international organisation.
- (2) An international organisation mentioned in paragraph (1) is entitled to restrain by injunction the use in Jersey, without its authorisation, of a trade mark mentioned in that paragraph.
- (3) This Article does not affect the rights of a person whose genuine use of a trade mark began –
  - (a) for trade marks protected under the Paris Convention, before 1 October 2000;
  - (b) for trade marks protected under the WTO Agreement, before this Article comes into force.
- (4) In this Article –
  - (a) “international organisation” means an international intergovernmental organisation of which 1 or more Convention countries are members;

- (b) a reference to an emblem, abbreviation or name of an international organisation is a reference to –
  - (i) the armorial bearings, flag or other emblem of that organisation;
  - (ii) an abbreviation of the name of that organisation; or
  - (iii) the name of that organisation; and
- (c) any provision about an emblem of an international organisation applies equally to anything that from a heraldic point of view imitates the emblem.

## **77 Notification under Article 6ter of the Convention [TMA s59/Gsy s59/]**

- (1) For the purposes of Article 75 [TMA s57] (national emblems of Convention countries), state emblems of a Convention country (other than the national flag), and official signs or hallmarks, are taken to be protected under the Paris Convention only if, or to the extent that –
  - (a) the Convention country has notified Jersey in accordance with Article 6ter(3) of the Paris Convention that it desires to protect that emblem, sign or hallmark;
  - (b) the notification remains in force; and
  - (c) Jersey has not objected to it in accordance with Article 6ter(4) of the Paris Convention, or any objection has been withdrawn.
- (2) For the purposes of Article 76 [TMA s58] (emblems of international organisations), the emblems, abbreviations and names of an international organisation are taken to be protected under the Paris Convention only if, or to the extent that –
  - (a) the international organisation has notified Jersey in accordance with Article 6ter(3) of the Paris Convention that it wishes to protect that emblem, abbreviation or name;
  - (b) the notification remains in force; and
  - (c) Jersey has not objected to it in accordance with Article 6ter(4), or any objection has been withdrawn.
- (3) Notification under Article 6ter(3) of the Paris Convention has effect only in relation to applications for registration made more than 2 months after the receipt of the notification.
- (4) The Registrar must keep and make available for public inspection, at all reasonable hours and free of charge, a list of the emblems, abbreviations and names under this Part that have Paris Convention protection because of a notification under Article 6ter(3).
- (5) In this Article, references to Article 6ter of the Paris Convention include a reference to that Article as applied by the WTO agreement.

## **DIVISION 5 – OPPOSITION PROCEEDINGS**

### **78 Notice of opposition and observations [TMA s38/]**

- (1) This Article applies if an application for registration of a trade mark has been published under Article 63 [TMA 38] (publication of application for registration).
- (2) A person may give written notice to the Registrar of opposition to the registration of the trade mark (“notice of opposition”).

- (3) The Minister must by Order specify the time and manner for giving a notice of opposition.
- (4) A notice of opposition must –
  - (a) include a statement of the grounds of opposition; and
  - (b) be given within the time and in the manner specified by the Order.
- (5) If a notice of opposition is filed on the basis of 1 or more earlier trade marks or other earlier rights –
  - (a) the rights, if plural, must all belong to the same proprietor;
  - (b) the notice may be filed on the basis of some or all of the goods or services for which the earlier right –
    - (i) is registered; or
    - (ii) an application for registration of the earlier right has been made.
- (6) A person may, at any time before the registration of the trade mark, make observations in writing to the Registrar as to whether the trade mark should be registered.
- (7) The Registrar must inform the applicant for registration of any observations made under paragraph (6).
- (8) A person does not become a party to opposition proceedings by making observations under paragraph (6).

#### **79 Relative grounds for refusal in opposition proceedings – non-use [TMA s6A/]**

- (1) In opposition proceedings, the Registrar must not refuse registration of a trade mark (“trade mark A”) on the basis of an earlier trade mark to which paragraph (2) applies, unless the use conditions are met.
- (2) This paragraph applies to an earlier trade mark –
  - (a) that was registered more than 5 years before the date of application for registration of trade mark A (or any date of priority for that application); and
  - (b) to which Article 70 [TMA s5] (relative grounds for refusal of registration – identical or similar trade marks) applies.
- (3) The use conditions are met if –
  - (a) within the 5-year period mentioned in paragraph (2), the earlier trade mark has been put to genuine use in Jersey by, or with the consent of, its proprietor in relation to the goods or services for which it is registered; or
  - (b) the earlier trade mark has not been used in accordance with sub-paragraph (a), but there are proper reasons for that non-use.
- (4) If the earlier trade mark meets the use conditions in relation to only some of the goods or services for which it is registered, it is taken for the purposes of this Article to be registered only in relation to those goods or services.
- (5) Nothing in this Article affects –
  - (a) the refusal of registration on the grounds mentioned in Article 68 [TMA s3] (absolute grounds for refusal) or Article 71 [TMA s5(4)] (relative grounds for refusal of registration – earlier rights); or
  - (b) the making of an application for a declaration of invalidity on the grounds in Article 93(3) [TMA s47(2)] (grounds for invalidity of registration).

**80 Relative grounds for refusal in opposition proceedings – honest concurrent use [TMA s7/]**

- (1) This Article applies if –
  - (a) on examining an application for registration of a trade mark, it appears to the Registrar that there is –
    - (i) an earlier trade mark to which Article 70 [TMA s5(1), (2) or (3)] (relative grounds for refusal – identical or similar trade marks)] applies; or
    - (ii) an earlier right to which Article 71 [TMA s5(4)] (relative grounds for refusal – earlier rights) applies; but
  - (b) the applicant for registration satisfies the Registrar there has been honest concurrent use of the trade mark to which the application relates.
- (2) The Registrar must not refuse registration on the basis of the earlier trade mark or earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or earlier right.
- (3) In this Article, “honest concurrent use” means use in Jersey of a trade mark by, or with the consent of, the proprietor that would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938 of the United Kingdom.
- (4) Nothing in this Article affects –
  - (a) the refusal of registration on the grounds mentioned in Article 68 [TMA s3] (absolute grounds for refusal); or
  - (b) the making of an application for a declaration of invalidity on the grounds in Article 93(3) [TMA s47(2)] (grounds for invalidity of registration).
- (5) This Article does not apply if there are Regulations in force under Article 81 [TMA s8].

**81 Power to require that relative grounds for refusal be raised in opposition proceedings [TMA s8]**

- (1) The States may by Regulations provide that the Registrar must not refuse registration of a trade mark on a ground mentioned in Article 70, 71 or 72 [TMA s5] (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.
- (2) The Regulations may make consequential provision that the States consider appropriate in relation to the persons who can apply for a declaration of invalidity on the grounds in Article 93(3) [TMA s47(2)] (grounds for invalidity of registration).
- (3) Regulations making provision under paragraph (2) may provide that Article 91 [TMA s47(3)] (application for declaration of invalidity) has effect subject to the Regulations.

## DIVISION 6 – REGISTRATION OF TRADE MARK

**82 Registration of trade mark [TMA s40/]**

- (1) The Registrar must register a trade mark if the Registrar has accepted an application for registration of the trade mark under Article 62 [TMA 37] (examination and acceptance of application for registration) and –
  - (a) no notice of opposition is given within the time mentioned in Article 78(3) [TMA s38(2)] (notice of opposition and observations); or
  - (b) all opposition proceedings are withdrawn or decided in favour of the applicant.
- (2) The Registrar must not register a trade mark if –
  - (a) matters have come to the notice of the Registrar since accepting the application for registration of the trade mark; and
  - (b) it appears to the Registrar from those matters that the requirements for registration were not met when the Registrar accepted the application.
- (3) The Minister must by Order specify –
  - (a) a registration fee; and
  - (b) the period in which the fee must be paid.
- (4) The Registrar must not register a trade mark unless the registration fee is paid within the period specified in the Order.
- (5) An applicant for registration is taken to have withdrawn the application if the registration fee is not paid within that period.

**83 Period of registration [TMA s42/]**

- (1) The Registrar must enter in the register of trade marks a date of registration that is the same date as the date of application for registration.
- (2) The Registrar must register a trade mark for a 10-year period beginning with the date of registration.
- (3) The Registrar may renew the registration of a trade mark under Article 87 [TMA 43] (renewal of registration) for further periods of 10 years.

**84 Certificate of registration [TMA s40/]**

On the registration of a trade mark, the Registrar must –

- (a) publish the registration –
  - (i) in the manner specified by the Minister by Order; or
  - (ii) if the Minister does not make an Order, in the manner the Registrar thinks fit; and
- (b) issue a certificate of registration to the registered proprietor.

**85 Registration: supplementary provisions [TMA s41/]**

- (1) The Minister may by Order provide for the following –

- (a) dividing an application for registration into several applications for registration;
  - (b) dividing the registration of a trade mark into several registrations of a trade mark;
  - (c) merging separate applications or separate registrations;
  - (d) the registration of a series of trade marks.
- (2) An Order under paragraph (1) may specify –
- (a) the circumstances in which, and conditions subject to which, a division, merger or registration of series of trade marks is permitted; and
  - (b) the purposes for which an application for registration or the registration of a trade mark is to be treated as –
    - (i) a single application or a single registration; or
    - (ii) a number of separate applications or separate registrations.
- (3) In this Article, “series of trade marks” means a number of trade marks that resemble each other in their material particulars and differ only in matters of a non-distinctive character that do not substantially affect the identity of the trade mark.

## DIVISION 7 – RENEWAL, RESTORATION AND SURRENDER OF REGISTRATION

### **86 Orders relating to renewal and restoration [TMA s43/]**

- (1) The Minister must by Order require the Registrar to inform a registered proprietor of the following matters relating to a renewal of registration before the current period of registration ends –
- (a) the date the current period of registration ends; and
  - (b) the manner in which the registration may be renewed.
- (2) The Minister must by Order specify a renewal fee determined by reference to whether a request for renewal of registration relates to –
- (a) the same classes of goods or services for which the trade mark is registered, or any additional class of goods or services;
  - (b) some or all of the goods or services for which the trade mark is registered, or additional goods or services.
- (3) The Minister may by Order –
- (a) extend the period for requesting a renewal of registration by at least 6 months; and
  - (b) specify an additional renewal fee to be paid.
- (4) The Minister may by Order –
- (a) provide for the restoration of a registration that has been removed from the register; and
  - (b) specify conditions that must be met before a registration can be restored.
- (5) The Minister must by Order specify the manner in which a renewal or restoration must be published.

**87 Renewal of registration [TMA s43/]**

- (1) The Registrar must renew the registration of a trade mark –
  - (a) at the request of the registered proprietor; and
  - (b) on payment of the renewal fee.
- (2) The Registrar must not renew the registration of a trade mark unless the request for renewal –
  - (a) is made before the end of the current period of registration of the trade mark (or any longer period provided by Order under TMA s43); and
  - (b) is accompanied by the renewal fee (including any additional renewal fee to be paid).
- (3) If a request for renewal is made, or the renewal fee is paid, in relation to only some of the goods or services for which the trade mark is registered, the registration is to be renewed for those goods or services only.
- (4) A request for renewal may include a request for the registration of the trade mark to be renewed in relation to additional classes of goods or services.
- (5) Renewal takes effect from the end of the previous period of registration.
- (6) If the registration of a trade mark is not renewed in accordance with this Article, the Registrar must remove the trade mark from the register.
- (7) The Registrar must publish the renewal or restoration of the registration of a trade mark in the manner specified by the Minister by Order under TMA s43.

**88 Surrender of registered trade mark [TMA s45/68]**

- (1) The proprietor of a registered trade mark may surrender the registered trade mark in relation to some or all of the goods or services for which the trade mark is registered.
- (2) The Minister may by Order provide for –
  - (a) the manner and effect of a surrender;
  - (b) protecting the interests of other persons with a right in the registered trade mark.

**DIVISION 8 – REVOCATION OF REGISTRATION****89 Application for revocation [TMA s46]**

- (1) Any person may apply for the revocation of the registration of a trade mark.
- (2) An application for revocation may be made to the Registrar or to the Court, but if Court proceedings relating to the trade mark are pending, the application for revocation must be made to the Court.
- (3) If Court proceedings begin after an application for revocation is made to the Registrar, the Registrar may refer the application for revocation to the Court at any stage of the Court proceedings.

**90 Grounds for revoking registration [TMA s46]**

- (1) The registration of a trade mark may be revoked on any of the following grounds –

- (a) that within the 5-year period beginning with the date the trade mark is registered –
    - (i) the registered trade mark has not been put to genuine use in Jersey (by the registered proprietor or with the registered proprietor's consent) in relation to the goods or services for which the trade mark is registered; and
    - (ii) there are no proper reasons for that non-use;
  - (b) that the use in Jersey of the registered trade mark (by the registered proprietor or with the registered proprietor's consent) has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for the non-use;
  - (c) that, as a result of acts or inactivity of the registered proprietor, the registered trade mark has become the common name in the trade for any of the goods or services for which the trade mark is registered;
  - (d) that as a result of the use of the registered trade mark (by the registered proprietor or with the registered proprietor's consent), the registered trade mark is liable to mislead the public, particularly in relation to the nature, quality or geographical origin of the goods or services for which the trade mark is registered.
- (2) The registration of a trade mark must not be revoked on the grounds in sub-paragraph (a) or (b) of paragraph (1) if use of the registered trade mark in accordance with that sub-paragraph begins or resumes –
- (a) after the end of the 5-year period mentioned in that sub-paragraph; and
  - (b) before an application for revocation is made.
- (3) But any use that begins or resumes within the 3-month period ending with the date the application for revocation is made must be disregarded unless preparations for beginning or resuming that use began before the registered proprietor became aware that the application for revocation might be made.
- (4) If grounds for revocation exist in relation to only some of the goods or services for which the trade mark is registered, revocation must relate to those goods or services only.
- (5) If the registration of a trade mark is revoked to any extent, the rights of the registered proprietor are taken to have ceased to that extent from –
- (a) the date the application for revocation is made; or
  - (b) if the Registrar or Court is satisfied that the grounds for revocation existed at an earlier date, that date.

## DIVISION 9 – DECLARATION OF INVALIDITY OF REGISTRATION

### **91 Application for declaration of invalidity [TMA s47(3) and (5A)]**

- (1) Any person may apply for a declaration that the registration of a trade mark is invalid.
- (2) An application for a declaration of invalidity may be made to the Registrar or the Court, but if Court proceedings relating to the registered trade mark are pending, the application must be made to the Court.

- (3) If Court proceedings begin after an application for a declaration of invalidity is made to the Registrar, the Registrar may refer the application to the Court at any stage of the Court proceedings.
- (4) The Registrar may apply to the Court for a declaration of invalidity if an application for registration of a trade mark is made in bad faith.
- (5) If a person is the proprietor of 1 or more earlier trade marks or other earlier rights, the person may apply for a declaration of invalidity on the basis of 1 or more of those rights.

## **92 Declaration of invalidity [TMA s47(5) and (6)]**

- (1) If grounds of invalidity exist in relation to only some of the goods or services for which a trade mark is registered, the trade mark must be declared invalid as regards those goods or services only.
- (2) If the registration of a trade mark is declared invalid to any extent, the registration is taken, to that extent, never to have been made.
- (3) Paragraph (2) does not affect transactions past and closed.

## **93 Grounds for invalidity of registration [TMA s47(1), (2) and (2ZA)]**

- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of –
  - (a) Articles 68 [TMA s3] (absolute grounds for refusal) or 69 [TMA s3] (absolute grounds for refusal - prohibitions); or
  - (b) any provision mentioned in those Articles.
- (2) If the trade mark was registered in breach of Article 68 [TMA s3(1)(b), (c) or (d)] (absolute grounds for refusal), the registration must not be declared invalid if, as a result of the use which has been made of the trade mark, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
- (3) Subject to Article 94 [TMA 47(2A) and (2G)] (refusal of application for declaration of invalidity – earlier trade mark), the registration of a trade mark may be declared invalid on the ground that –
  - (a) there is an earlier trade mark to which Article 71 [TMA s5(1), (2) or (3)] applies (relative grounds for refusal - earlier rights); or
  - (b) there is an earlier right to which Article 71 [TMA s5(4)] (relative grounds for refusal - earlier rights) applies.
- (4) But paragraph (3) does not apply if the proprietor of the earlier trade mark or other earlier right has consented to the registration.
- (5) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of Article 72 [TMA s5(6)] (application without proprietor's consent).

#### **94 Refusal of application for declaration of invalidity – earlier trade mark [TMA s47(2A) and (2G)]**

- (1) The registration of a trade mark must not be declared invalid on the ground that there is an earlier trade mark unless –
  - (a) the earlier trade mark was registered within the 5-year period ending with the date the application for a declaration of invalidity is made;
  - (b) the earlier trade mark was not registered before that date; or
  - (c) the use conditions are met.
- (2) Paragraph (1) does not apply if the earlier trade mark is a trade mark within Article 5 [TMA s6(1)(c)] (meaning of earlier trade mark).
- (3) The use conditions are met if –
  - (a) the earlier trade mark has been put to genuine use in Jersey by, or with the consent of, its proprietor in relation to the goods or services for which it is registered –
    - (i) within the 5-year period ending with the date the application for a declaration of invalidity is made; and
    - (ii) within the 5-year period ending with the date of application for registration of the later trade mark (or any date of priority for that application) if, at that date, the 5-year period within which the earlier trade mark should have been put to genuine use as provided in Article 90(1)(a) [TMA s46(1)(a)] (grounds for revoking registration) has ended; or
  - (b) the earlier trade mark has not been put to genuine use in Jersey in accordance with sub-paragraph (a), but there are proper reasons for non-use.
- (4) If an earlier trade mark meets the use conditions in relation to only some of the goods or services for which it is registered, for the purposes of this Article it is taken to be registered in relation to those goods or services only.
- (5) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons in paragraph (6), had the application for the declaration been made on the date of application for registration of the later trade mark (or any date of priority for that application).
- (6) The reasons are –
  - (a) that on that date the earlier trade mark was liable to be declared invalid on the basis of Article 68 [TMA s3(1)(b), (c) or (d)] (absolute grounds for refusal), and it had not yet acquired a distinctive character as a result of the use made of it;
  - (b) that the application for a declaration of invalidity is based on Article 71 [TMA s5(2)] (relative grounds for refusal - earlier rights) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of Article 71 [TMA s5(2)] (relative grounds for refusal - earlier rights);
  - (c) that the application for a declaration of invalidity is based on Article 71 [TMA s5(3)(a)] (relative grounds for refusal - earlier rights) and the earlier trade mark had not yet acquired a reputation within the meaning of Article 71 [TMA s5(3)] (relative grounds for refusal - earlier rights).

**95 Effect of acquiescence [TMA s48/]**

- (1) This Article applies if the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of 5 years in the use in Jersey of a registered trade mark (“later trade mark”), being aware of that use.
- (2) The proprietor of the earlier trade mark or other earlier right ceases to be entitled, on the basis of the earlier trade mark or other earlier right –
  - (a) to apply for a declaration that the registration of the later trade mark is invalid; or
  - (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used.
- (3) Despite paragraph (2), the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or the exploitation of the other earlier right.
- (4) Paragraph (2) does not apply if the application for registration of the later trade mark is made in bad faith.

**DIVISION 10 – LEGAL PROCEEDINGS RELATING TO REGISTRATION****96 Costs and security for costs in proceedings before Registrar [TMA s68/]**

- (1) This Article applies to the award of costs in any proceedings before the Registrar under this Law.
- (2) The Minister may by Order provide that the Registrar may –
  - (a) award costs that the Registrar considers reasonable to any party to those proceedings;
  - (b) direct a party to those proceedings to pay the costs of another party;
  - (c) require a party, in circumstances specified by the Order, to give security for the costs of another party, in relation to those proceedings or to proceedings on appeal; and
  - (d) determine the consequences if the required security is not given.

**97 Evidence in proceedings before Registrar [Gsy Art 67/]**

- (1) This Article applies in relation to proceedings before the Registrar under this Law.
- (2) The Minister may by Order –
  - (a) provide for the giving of evidence by affidavit;
  - (b) give the Registrar powers in relation to the administration of the oath, the examination of witnesses on oath, the discovery and production of documents and the summoning and attendance of witnesses.

**98 Registration of proprietor prima facie evidence of valid registration [TMA s72/]**

In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register), an entry in the register of trade marks showing a person as proprietor of a registered trade mark is prima facie evidence of the validity of –

- (a) the original registration of the trade mark; and

- (b) any assignment or other transmission of the registered trade mark.

## **99 Certificate of valid registration [TMA s73/]**

- (1) If the Court finds in proceedings contesting the validity of the registration of a trade mark that the trade mark is validly registered, the Court may give a certificate to that effect.
- (2) If the Court gives a certificate under paragraph (1), the registered proprietor is entitled to the costs of any subsequent Court proceedings on the indemnity basis (unless the Court directs otherwise) if, in the subsequent proceedings –
  - (a) the validity of the registration is again questioned; and
  - (b) the proprietor obtains a final order or judgment that the trade mark is validly registered.
- (3) Paragraph (2) does not apply to the costs of an appeal in any subsequent Court proceedings.

## **100 Registrar's appearance in Court proceedings [TMA s74 or Gsy Art 72/]**

- (1) The Registrar is entitled to appear and be heard in Court proceedings relating to an application for –
  - (a) the revocation of a trade mark under Article 89 [TMA s46] (application for revocation);
  - (b) a declaration of invalidity under Article 91 [TMA s47(3) and (5A)] (application for declaration of invalidity);
  - (c) the rectification of the register of trade marks under Article 55 [TMA s64] (rectification of the register of trade marks).
- (2) The Registrar must appear in the Court proceedings mentioned in paragraph (1) if the Court directs the Registrar to do so.
- (3) Unless the Court directs the Registrar to appear in the Court proceedings, the Registrar may, instead of appearing in the proceedings, provide the Court with a signed written statement giving particulars of –
  - (a) any proceedings before the Registrar in relation to the matter in issue;
  - (b) the grounds of any decision given by the Registrar affecting that matter;
  - (c) the practice of the Registrar in similar cases;
  - (d) any other matters the Registrar thinks fit that are –
    - (i) relevant to the issues; and
    - (ii) within their knowledge as Registrar.
- (4) A statement provided under paragraph (3) forms part of the evidence in the Court proceedings.
- (5) Anything that the Registrar is or may be authorised or required to do under this Article may be done on the Registrar's behalf by an officer of the Jersey Financial Services Commission that is authorised to act for the Registrar in that regard under [Article [X] (appointment of Registrar of Intellectual Property) of the Registrar of Intellectual Property (Jersey) Law 202-].

**101 Power to release Registrar from Court proceedings [Gsy s79/]**

- (1) This Article applies if the Registrar is a party to any Court proceedings under this Law, including proceedings relating to an application for –
  - (a) the revocation of a trade mark under Article 89 [TMA s46] (application for revocation);
  - (b) a declaration of invalidity under Article 91 [TMA s47(3) and (5A)];
  - (c) the rectification of the register of trade marks under Article 55 [TMA s64] (rectification of the register of trade marks);
  - (d) an appeal under Article 102 [TMA s76] (appeals to Court against decision of Registrar).
- (2) The Registrar may apply to the Court to be released from the Court proceedings so far as the proceedings relate to the determination of a question between –
  - (a) the registered proprietor or an applicant for registration; and
  - (b) another person.
- (3) On an application by the Registrar under paragraph (2), the Court may –
  - (a) order that the Registrar is released subject to any terms and conditions, and to the extent, that the Court thinks fit; and
  - (b) make any consequential order that the Court thinks fit for the costs of determining –
    - (i) the application or appeal; and
    - (ii) the question in issue.
- (4) An order for costs may include an order that the Registrar –
  - (a) is to be awarded costs; and
  - (b) is not liable for the costs of any other party.
- (5) The powers conferred on the Court by this Article do not affect any other powers of the Court.

**PART 7**

## INTERNATIONAL REGISTRATION

## DIVISION 1 – INTERPRETATION

**103 Interpretation of Part [Gsy Reg 21/2008 UK Order Art 2/REF 1/]**

In this Part –

“date of international registration” means the date determined under Article 3(4) of the Madrid Protocol;

“date of request for territorial extension to Jersey” means the date on which a request for territorial extension to Jersey is sent to the Registrar;

“notice of provisional refusal”, in relation to a request for territorial extension, means a notice under Article 116 [REF 14] (notice of provisional refusal) or Article 118 [REF 16] (notice of provisional refusal based on an opposition);

“Office of origin” has the meaning given in Article 2(2) of the Madrid Protocol.

“opponent” means a person who opposes a request for territorial extension;

“refusal period” means 1 year beginning with the day on which a request for territorial extension is sent to the Registrar, or any longer period specified by the Minister by Order.

#### **104 Meaning of “protected international trade mark (Jersey)”**

- (1) In this Law, “protected international trade mark (Jersey)” means an international trade mark that has been granted protection in Jersey under Division 3 following a request for territorial extension to Jersey.
- (2) References to “protected” and “protection” in this Part must be construed accordingly.

### **DIVISION 2 – APPLICATIONS FOR INTERNATIONAL REGISTRATION ORIGINATING FROM JERSEY [REF CHPT A]**

#### **105 Application of Division [REF 1]**

This Division applies to an application for international registration filed with the Registrar as the Office of origin on the basis of –

- (a) a domestic application; or
- (b) a domestic registration.

#### **106 Requirements for filing and processing an international application [UK Order 2020 Sched 3 para 1/ REF 3-7/Gsy Reg 1/]**

- (1) A person is eligible to make an international application if –
  - (a) they are –
    - (i) a British citizen, a British overseas territories citizen, a British overseas citizen, a British subject or a British protected person;
    - (ii) an individual domiciled in Jersey;
    - (iii) a body incorporated under the law of Jersey; or
    - (iv) a person who has a real and effective industrial or commercial establishment in Jersey; and
  - (b) they are the registered proprietor of the trade mark or have filed with the Registrar a domestic application. [REF 3]
- (2) An international application must be made to the Registrar in the form and manner required by the Registrar and must –
  - (a) include the information required by Rule 9(4)(a) of the Common Regulations;
  - (b) include or be accompanied by any other document or information that the Registrar may require or that may be specified by the Minister by Order; and [REF 4]
  - (c) be accompanied by the application fee specified by the Minister by Order under Article 153 [TMA 79] (fees). [REF 5]

- (3) The Registrar must give the international application a number and a date of receipt.
- (4) The Registrar must not delay that date of receipt if the international application is not accompanied by the application fee when it is made [Notes on REF 5].
- (5) If the Registrar considers that an international applicant is ineligible or that an international application fails to meet the requirements of paragraph (2), the Registrar must –
  - (a) inform the international applicant; and
  - (b) give that international applicant the opportunity to, within 2 weeks –
    - (i) provide evidence in support of their eligibility;
    - (ii) correct an error or omission; or
    - (iii) pay the application fee [REF 6].
- (6) If an international applicant fails, within 2 weeks, to provide sufficient evidence of eligibility, correct the error or omission, or pay the application fee –
  - (a) the international applicant is taken to have abandoned the international application; and
  - (b) the Registrar must not send the international application to the International Bureau. [REF 6]
- (7) The Registrar must send the international application to the International Bureau if the Registrar is satisfied that – [REF 4/UK Order Sched 3(4)]
  - (a) the international applicant is eligible to make the international application;
  - (b) the requirements of paragraph (2) are met; and
  - (c) the relevant particulars appearing in the international application correspond to the relevant particulars in the domestic application or in the register of trade marks.
- (8) At the time of sending under paragraph (7), the Registrar must –
  - (a) certify that the Registrar is the Office of origin for the international application;
  - (b) certify that the relevant particulars appearing in the international application correspond with the relevant particulars in the domestic application or in the register of trade marks; and
  - (c) confirm the date of receipt of the international application. [REF 7]
- (9) If, under Rule 11, 12 or 13 of the Common Regulations, the International Bureau notifies the Registrar of irregularities in the international application, the Registrar must –
  - (a) respond as requested by the International Bureau within the 3-month period specified by the Common Regulations; and
  - (b) if the irregularity is to be remedied by the Registrar, consult with the international applicant and give the international applicant 28 days to provide the requested information to enable the Registrar to comply with subparagraph (a). [REF 8/Gsy Reg 1(5)]
- (10) In this Article –

“British citizen”, “British overseas territories citizen”, “British overseas citizen”, “British subject” and “British protected person” have the meaning given in the British Nationality Act 1981 of the United Kingdom;

“Contracting Party” means a country or intergovernmental organisation that is party to the Madrid Protocol.

### **107 Classification of goods and services [REF 9/Gsy Reg 2/]**

The International Bureau must determine the classification of goods and services to which an international application relates.

### **108 Cancellation of international registration [REF 10/Madrid Protocol Art 6(3) and (4)/Gsy Reg 3/]**

- (1) This Article applies if the domestic application or domestic registration on which an international registration is based ceases to have effect (wholly or partially) –
  - (a) before the end of the 5-year period beginning with the date of international registration; or
  - (b) after the end of that period, as a result of a final decision in proceedings begun before the end of that period.
- (2) The Registrar must –
  - (a) notify the International Bureau in accordance with Rule 22 of the Common Regulations; and
  - (b) request that the international registration is cancelled to the extent applicable.
- (3) A domestic application ceases to have effect to the extent that –
  - (a) registration is refused; or
  - (b) the application is withdrawn or amended.
- (4) A domestic registration ceases to have effect to the extent that the registration is surrendered, revoked or declared invalid.
- (5) If a domestic application or domestic registration ceases to have effect in relation to only some of the goods or services to which the application or registration relates, the request to cancel the international registration must relate to those goods or services only. [REF 10(2)]
- (6) In paragraph (1)(b), “proceedings” means –
  - (a) an appeal against a decision refusing registration;
  - (b) an action requesting the withdrawal or amendment of the domestic application;
  - (c) a notice of opposition filed in respect of the domestic application;
  - (d) an action requesting the surrender or revocation of, or a declaration of invalidity in relation to, the domestic registration.

### **109 Division or merger of domestic application or domestic registration [Gsy Reg 4/ Common Regulations rule 23]**

- (1) This Article applies if the Registrar sends an international application to the International Bureau under Article 106 [REF 3-7] (requirements for filing and processing an international application) and before the end of the 5-year period beginning with the date of international registration –
  - (a) the domestic application is divided into 2 or more domestic applications;

- (b) 2 or more domestic applications are merged into a single domestic application;
  - (c) the domestic registration is divided into 2 or more domestic registrations; or
  - (d) the domestic registration is merged with another domestic registration into a single domestic registration.
- (2) The Registrar must notify the International Bureau of the following –
- (a) the registration number of the international registration or, if the international registration has not yet been registered, the registration number of the domestic application;
  - (b) the name of the international applicant or the person in whose name the international registration is recorded in the International Register;
  - (c) the number of each –
    - (i) domestic application or domestic registration resulting from the division; or
    - (ii) domestic application or domestic registration resulting from the merger.

### DIVISION 3 – PROTECTED INTERNATIONAL TRADE MARKS (JERSEY) [REF CHPT B]

#### **110 Application of Division [REF 1]**

This Division applies to an international registration that is the subject of a request for territorial extension to Jersey.

#### **111 Rights conferred by request for territorial extension [Art 9][ REF 11(1)/Madrid 4(1)(a)]**

- (1) A request for territorial extension of an international registration to Jersey is movable property.
- (2) Rights in that movable property are conferred on the holder on –
  - (a) the date of international registration; or
  - (b) if later, the date of request for territorial extension to Jersey.
- (3) Rights arising from a request for territorial extension to Jersey are enforceable in the same way as rights in other movable property are enforceable.
- (4) But infringement proceedings may not be brought before the date on which the international trade mark is granted protection as a protected international trade mark (Jersey).
- (5) Part 2 (rights conferred by application for registration) applies to a request for territorial extension of an international registration to Jersey in the same way that it applies to a domestic application.

#### **112 Rights in protected international trade mark (Jersey) [Art 14] [REF 11(4)/Madrid 4(1)(a)]**

- (1) A trade mark that is a protected international trade mark (Jersey) is movable property.
- (2) Rights in that movable property are conferred on the holder on –

- (a) the date of international registration of the trade mark; or
  - (b) if later, the date of request for territorial extension to Jersey.
- (3) Rights in a protected international trade mark (Jersey) are enforceable in the same way as rights in other movable property are enforceable.
- (4) The following apply to a protected international trade mark (Jersey) in the same way as they apply to a domestic registration –
- (a) Part 3 (rights conferred by registration) except Article 24 [TMA s89] (right to prevent goods entering Jersey without being released for free circulation);
  - (b) Part 4 (infringement of registered trade mark) except Division 5 (prohibited goods).
- (5) The Minister may by Order amend paragraph (4) to apply all of Parts 3 to 5 to a protected international trade mark (Jersey). [Gsy s54/TMA s54/]

#### **113 Date of filing [REF 11(2)/Gsy 5(2)(b)]**

The date of filing for a trade mark that is a protected international trade mark (Jersey) is –

- (a) the date of international registration of the trade mark; or
- (b) if later, the date of request for territorial extension to Jersey.

#### **114 Classification of goods and services for purposes of protected international trade mark (Jersey) [Art 50/ REF 11(3)]**

The classification of goods or services indicated in the international registration does not bind the Registrar in the Registrar's determination of the scope of protection to be granted to a protected international trade mark (Jersey). [REF 11(3)]

#### **115 Examination of request for territorial extension [REF 12/Gsy 5(1) and (2)/]**

- (1) The Registrar must examine a request for territorial extension of an international registration to Jersey as if it were a domestic application, and must decide if it –
  - (a) meets the requirements for registration; or
  - (b) should be refused on any of the grounds under Part 6, Division 4.
- (2) The Registrar must establish whether the request for territorial extension includes a translation into English of any word in the international trade mark that is in a language other than English, unless the holder of the international registration has declared that the word has no meaning.
- (3) If the Registrar accepts the request for territorial extension –
  - (a) the Registrar must publish the request as if it were a domestic application; and
  - (b) the provisions for opposition proceedings in Part 6, Division 5 apply to the request as if it were a domestic application.

#### **116 Notice of provisional refusal [REF 14/ and REF 13(3)/]**

- (1) If the conditions in paragraph (3) are met, the Registrar must, before the end of the refusal period, send a notice of provisional refusal to the International Bureau.

- (2) A notice of provisional refusal must be sent in accordance with the requirements of Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.
- (3) The conditions are –
  - (a) the Registrar, following examination of a request for territorial extension, finds that –
    - (i) a ground for refusing registration under Part 6, Division 4 applies, with the result that the international trade mark cannot be granted protection in Jersey or can only be granted protection in Jersey with conditions; or
    - (ii) an English translation required by Article 115 [REF 12] (examination of request for territorial extension) is not included in the request for territorial extension to Jersey; or
  - (b) for a collective mark or certification mark that is the subject of a request for territorial extension to Jersey, regulations governing the use of the collective mark or certification mark have not been filed with the Registrar in accordance with Schedule 1 or Schedule 2.
- (4) The holder of the international registration enjoys the same remedies as an applicant for registration.
- (5) The holder may file with the Registrar a written request for a review of a provisional refusal no later than 2 months after the date of the notice of provisional refusal.
- (6) The request for review must include an address for service in Jersey.
- (7) If the holder has no address for service in Jersey, the request for review must be –
  - (a) filed with the Registrar through a duly appointed agent domiciled in Jersey; and
  - (b) accompanied by a power of attorney for that agent.
- (8) If the holder does not respond to the notice of provisional refusal by making a request under paragraph (5) within the 2-month period mentioned in that paragraph, the holder is taken to have abandoned the request for territorial extension to Jersey.

### **117 Publication and opposition [REF 15/]**

- (1) If, after examining a request for territorial extension, the Registrar does not find that any of the grounds for refusing registration under Part 6, Division 4 apply, the Registrar must publish the request for territorial extension and particulars of the international registration in the same manner as a domestic application is published under Article 63 [TMA s38] (publication of application for registration).
- (2) An opponent may file a notice of opposition with the Registrar within the 20 days beginning with the date of publication of the request for territorial extension.
- (3) Part 6, Division 5 (opposition proceedings) applies to a request for territorial extension to Jersey in the same way that it applies to a domestic application.

### **118 Notice of provisional refusal based on an opposition [REF 16/]**

- (1) If a notice of opposition is filed with the Registrar within the time specified in Article 117 [REF 15] (publication and opposition), the Registrar must, before the end of the refusal period, send to the International Bureau a notice of provisional refusal based on an opposition.

- (2) A notice of provisional refusal must be sent in accordance with the requirements of Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.
- (3) The holder of the international registration may file with the Registrar a written counter-statement no later than 2 months after the date of the notice of provisional refusal.
- (4) But the Registrar may extend the period for filing a counter-statement if –
  - (a) the holder requests the territorial extension before the end of the 2-month period; and
  - (b) the Registrar considers it is reasonable to do so taking into account the remaining time before the refusal period ends.
- (5) If the holder has no address for service in Jersey, the counter-statement must be –
  - (a) filed with the Registrar through a duly appointed agent domiciled in Jersey; and
  - (b) accompanied by a power of attorney for that agent.
- (6) If the holder does not file a counter-statement before the time limit (or extended time limit) ends, the holder is taken to have abandoned the request for territorial extension to Jersey.
- (7) After giving the holder and the opponent the opportunity to present their argument, the Registrar must make a final decision on the opposition and decide whether to send to the International Bureau –
  - (a) a statement of grant of protection; or
  - (b) a statement confirming total refusal.

#### **119 Statement of grant of protection when no grounds for refusal or opposition [REF 17/]**

- (1) If the conditions in paragraph (2) are met, the Registrar must, before the end of the refusal period, send to the International Bureau a statement that the international trade mark is granted protection in Jersey as a protected international trade mark (Jersey).
- (2) The conditions are –
  - (a) all procedures before the Registrar have been completed and there is no obligation for the Registrar under Article 116 [REF 14] (notice of provisional refusal) to send the International Bureau a notice of provisional refusal; and
  - (b) the Registrar has not received a notice of opposition within the time specified in Article 117 [REF 15] (publication and opposition) and there is no obligation for the Registrar under Article 118 [REF 16] (notice of provisional refusal based on an opposition) to send the International Bureau a notice of provisional refusal based on an opposition.
- (3) A statement under paragraph (1) must be sent in accordance with Rule 18ter(1) of the Common Regulations.

#### **120 Statement of withdrawal of provisional refusal [REF 18/rule 18ter [Common Regulations](#)]**

- (1) If the conditions in paragraph (2) are met, the Registrar must send to the International Bureau, in accordance with the Common Regulations –

- (a) a statement that provisional refusal is withdrawn; and
  - (b) a statement that the international trade mark is granted total or partial protection in Jersey as a protected international trade mark (Jersey), indicating the goods or services for which, or the conditions under which, protection is granted.
- (2) The conditions are –
- (a) the Registrar has sent the International Bureau a notice of provisional refusal under Article 116 [REF 14] (notice of provisional refusal) or 118 [REF 16] (notice of provisional refusal based on an opposition);
  - (b) all procedures before the Registrar have been completed and there are no grounds for the Registrar to refuse protection; and
  - (c) the Registrar has reached a final decision to grant protection to the international trade mark in Jersey, either totally or partially.

### **121 Statement confirming total refusal [REF 19/]**

- (1) If the conditions in paragraph (2) are met, the Registrar must send to the International Bureau, in accordance with Rule 18<sup>ter</sup> of the Common Regulations, a statement that the Registrar has decided to confirm a total refusal.
- (2) The conditions are –
- (a) the Registrar has sent a notice of provisional refusal to the International Bureau under Article 116 [REF 14] (notice of provisional refusal) or 118 [REF 16] (notice of provisional refusal based on an opposition);
  - (b) all procedures before the Registrar have been completed; and
  - (c) the Registrar has decided to confirm the total refusal of protection of the international trade mark in Jersey, for all goods or services.

### **123 Statement of further decision affecting scope of protection [REF 21/]**

- (1) This Article applies if –
- (a) the refusal period has ended and the Registrar has not sent a notice of provisional refusal;
  - (b) the Registrar has sent a statement of grant of total protection under Article 119 [REF 17] (statement of grant of protection when no grounds for refusal or opposition);
  - (c) the Registrar has sent a statement of total or partial grant of protection following a provisional refusal under Article 120 [REF 18] (statement of withdrawal of provisional refusal); or
  - (d) the Registrar has sent a statement confirming total refusal under Article 121 [REF 19] (statement confirming total refusal).
- (2) The Registrar must send to the International Bureau a further statement indicating the goods or services for which protection is granted, if a further decision is taken by the Court or the Registrar that reduces or extends the scope of that protection (to the extent that the Registrar is aware of the further decision by the Court).
- (3) This Article does not limit the application of Rule 19 of the Common Regulations (invalidations in designated contracting parties) or Article 124 [REF 22] (notification of subsequent invalidation).

**124 Declaration of invalidity [REF 22/]**

- (1) The Registrar must notify the International Bureau in accordance with the Madrid Protocol and Common Regulations if, in relation to a protected international trade mark (Jersey) –
  - (a) the Registrar makes a declaration of invalidity; or
  - (b) the Registrar becomes aware that the Court has made a declaration of invalidity.
- (2) In this Article, “declaration of invalidity” means a final decision by the Registrar or the Court that revokes or declares invalid a protected international trade mark (Jersey) in relation to all or some of the goods or services for which protection was granted.

**125 Domestic registration replaced by protected international trade mark (Jersey) [REF 23/Madrid Protocol 4bis]**

- (1) A protected international trade mark (Jersey) replaces a trade mark entered in the register of trade marks if –
  - (a) the registered trade mark and the protected international trade mark (Jersey) are the same trade mark;
  - (b) the proprietor of the registered trade mark is also the holder of the international registration that extends to Jersey;
  - (c) all the goods or services to which the domestic registration relates are also listed in respect of Jersey in the international registration; and
  - (d) the date of filing for the international trade mark falls after the date of filing for the domestic application.
- (2) The replacement under paragraph (1) –
  - (a) occurs automatically;
  - (b) is not dependent on the actions of the holder of the international registration or the Registrar; and
  - (c) has effect from –
    - (i) the date of international registration of the trade mark; or
    - (ii) if later, the date of request for territorial extension to Jersey.
- (3) The holder of the international registration may request the Registrar to make a note in the register of trade marks of the replacement.
- (4) A request under paragraph (3) must be in writing and accompanied by the fee specified by the Minister by Order.
- (5) The Registrar must examine a request made under paragraph (3) for compliance with the conditions under paragraph (1) and (4).
- (6) If the Registrar accepts the request and makes a note of a protected international trade mark (Jersey) in the register of trade marks, the Registrar must notify the International Bureau and include the following particulars in that notification –
  - (a) the number of the international registration that is extended to Jersey;
  - (b) if only some of the goods or services listed in the international registration are affected by the replacement, those goods or services;

- (c) the date of filing for the protected international trade mark (Jersey) and number of the application for registration;
  - (d) the date of registration and number of the registered trade mark;
  - (e) any date of priority for the protected international trade mark (Jersey) that is recorded in the International Register; and
  - (f) information relating to other rights acquired as a result of the domestic registration.
- (7) The registration of a trade mark does not cease to have effect as a result of –
- (a) the automatic replacement of the registered trade mark under paragraph (1); or
  - (b) a note of the protected international trade mark (Jersey) made in the register of trade marks under paragraph (6).
- (8) The scope of replacement under paragraph (1) is limited to the goods or services to which the domestic registration relates.

#### DIVISION 4 – TRANSFORMATION AND RENEWAL

### **126 Transformation application [REF 24/Gsy Reg 10/]**

- (1) This Article applies if the International Bureau, under Article 6(4) of the Madrid Protocol, cancels an international registration that extends to Jersey.
- (2) The person who was the holder of the international registration when it was cancelled may apply for registration of the trade mark in Jersey within the 3-month period beginning with the date on which the international registration was cancelled (“transformation application”).
- (3) Part 6 applies to a transformation application in the same way that it applies to a domestic application.
- (4) For a transformation application, the date of filing is –
  - (a) the date of international registration of the trade mark; or
  - (b) if later, the date of request for territorial extension to Jersey.
- (5) In addition to the requirements in Article 61 [TMA s32] (application for registration), the transformation application must –
  - (a) contain a statement that it is made by way of transformation;
  - (b) contain confirmation that the application is made by the person who was the holder of the international registration immediately before it was cancelled;
  - (c) contain the following information –
    - (i) the international registration number of the cancelled international registration;
    - (ii) the date of filing under paragraph (4);
    - (iii) the date on which the cancellation of the international registration was recorded in the International Register;
    - (iv) any date of priority for the international registration that is recorded in the International Register; and
  - (d) be accompanied by the appropriate fee specified by the Minister by Order.

- (6) The Registrar must accept the transformation application and register the trade mark under Part 6 if –
  - (a) all the requirements under Part 6 and paragraph (5) are met; and
  - (b) immediately before the date on which the international registration was cancelled, the trade mark was a protected international trade mark (Jersey).
- (7) The Registrar must enter in the register of trade marks a date of registration that is the same as the date of filing under paragraph (4).
- (8) If the trade mark was not a protected international trade mark (Jersey) immediately before the date on which the international registration was cancelled, the Registrar must treat any procedures or measures already completed for the purpose of the cancelled international registration or request for territorial extension to Jersey as having been completed for the purpose of the transformation application.

### **127 Renewal of international registration that extends to Jersey [REF 25/]**

If the international registration of a trade mark that is a protected trade mark (Jersey) is renewed in accordance with Article 7 of the Madrid Protocol, the trade mark continues to be a protected international trade mark (Jersey).

## **DIVISION 5 – CHANGES IN INTERNATIONAL REGISTER**

### **128 Effect of changes recorded in International Register [REF 26/]**

- (1) A change recorded in the International Register in relation to a trade mark that is a protected international trade mark (Jersey) has effect in Jersey as if it is entered in the register of trade marks.
- (2) On receipt of a notice from the International Bureau of a change recorded in the International Register, the Registrar must amend the register of trade marks to record the change.
- (3) But if the Registrar considers that the recording has no effect in Jersey as a matter of Jersey law, the Registrar must, if it is provided for in the Common Regulations, send a declaration to the International Bureau stating this fact, under Article 129 [REF 27] (declaration that change in ownership has no effect in Jersey), Article 130 [REF 28] (declaration that limitation of goods or services in an international registration has no effect in Jersey) or Article 131 [REF 29] (declaration that the recording of licence has no effect in Jersey).

### **129 Declaration that change in ownership has no effect in Jersey [REF 27/]**

- (1) If the International Bureau sends a notice under Article 128 [REF 26] (effect of changes recorded in International Register) to the Registrar of a change in ownership of an international registration that affects a territorial extension to Jersey, the Registrar may declare that the change in ownership has no effect in Jersey.
- (2) A declaration under paragraph (1) must indicate –
  - (a) the reasons why the change in ownership has no effect;
  - (b) the corresponding essential provisions of this Law; and
  - (c) whether the declaration may be reviewed or appealed.

- (3) The Registrar must send the declaration to the International Bureau in accordance with Rule 27(4)(c) of the Common Regulations.
- (4) The effect of a declaration under paragraph (1) is that the international registration remains in the name of the transferor.
- (5) The holder of the international registration may file with the Registrar a written request for a review of a declaration made under paragraph (1).
- (6) A request for review must be made within the 2-month period beginning with the date the holder was notified by the International Bureau under Rule 27(4)(d) of the Common Regulations.
- (7) If the holder has no address for service in Jersey, the request for review must be –
  - (a) filed with the Registrar through a duly appointed agent domiciled in Jersey; and
  - (b) accompanied by a power of attorney for that agent.
- (8) The Registrar must notify the International Bureau of a final decision on a request for a review made under paragraph (6).

### **130 Declaration that limitation of goods or services has no effect in Jersey [REF 28]**

- (1) If the International Bureau notifies the Registrar of a limitation of the list of goods or services in an international registration that affects a territorial extension to Jersey, the Registrar may declare that the limitation has no effect in Jersey.
- (2) A declaration under paragraph (1) must state –
  - (a) the reasons why the limitation has no effect;
  - (b) if the declaration does not affect all the goods or services to which the limitation relates, those which are affected by the declaration or those which are not affected by the declaration;
  - (c) the corresponding essential provisions of this Law; and
  - (d) whether the declaration may be reviewed or appealed.
- (3) The Registrar must send the declaration to the International Bureau in accordance with Rule 27(5)(c) of the Common Regulations.
- (4) The effect of a declaration under paragraph (1) is that, with respect to the territorial extension, the limitation does not apply to the goods or services affected by the declaration.
- (5) The holder of the international registration may file with the Registrar a written request for a review of a declaration made under paragraph (1).
- (6) A request for review must be made within the 2-month period beginning with the date the holder was notified by the International Bureau under Rule 27(5)(d) of the Common Regulations.
- (7) If the holder has no address for service in Jersey, the request for review must be –
  - (a) filed with the Registrar through a duly appointed agent domiciled in Jersey; and
  - (b) accompanied by a power of attorney for that agent.
- (8) The Registrar must notify the International Bureau of a final decision on a request for a review made under paragraph (6).

**131 Declaration that recording of licence has no effect in Jersey [REF 29 – ALT 2]**

- (1) If the International Bureau under Article 128 [REF 26] (effect of changes recorded in International Register) notifies the Registrar of a recording of a licence in respect of an international registration that affects a territorial extension to Jersey, the Registrar may declare that the recording of the licence has no effect in Jersey.
- (2) A declaration under paragraph (1) must indicate –
  - (a) the reasons why the recording of the licence has no effect;
  - (b) if the declaration does not affect all the goods or services for which the licence is granted, those that are affected by the declaration or those that are not affected by the declaration;
  - (c) the corresponding essential provisions of this Law; and
  - (d) whether the declaration may be reviewed or appealed.
- (3) The Registrar must send the declaration to the International Bureau in accordance with Rule 20*bis*(5)(c) of the Common Regulations.
- (4) The effect of a declaration under paragraph (1) is that, with respect to the territorial extension, the licence does not apply to the goods or services affected by the declaration.
- (5) The holder of the international registration may file with the Registrar a written request for a review of a declaration made under paragraph (1).
- (6) A request for review must be made within the 2-month period beginning with the date the holder was notified by the International Bureau under Rule 20*bis*(5)(d) of the Common Regulations.
- (7) If the holder has no address for service in Jersey, the request for review must be –
  - (a) filed with the Registrar through a duly appointed agent domiciled in Jersey; and
  - (b) accompanied by a power of attorney for that agent.
- (8) The Registrar must notify the International Bureau of a final decision on a request for review made under paragraph (6).

**132 Correction of International Register [REF 30/]**

- (1) On receiving a notification from the International Bureau of a correction of an international registration that extends to Jersey or is the subject of a request for territorial extension to Jersey, the Registrar may declare in a notice of provisional refusal to the International Bureau that the Registrar considers, on the basis of the correction, that protection in Jersey for the international trade mark cannot, or can no longer, be granted.
- (2) A notice of provisional refusal must be sent in accordance with the requirements of Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations, within the 12-month period beginning with the date on which the International Bureau sent the notification of the correction to the Registrar.

**133 Request for division of international registration [REF 31/Common Regs 27bis and ter]**

- (1) The holder of an international registration may request that the International Bureau divide an international registration that is the subject of a request for territorial extension to Jersey.
- (2) A request under paragraph (1) must –
  - (a) be made in writing;
  - (b) contain the information specified in Rule 27bis of the Common Regulations; and
  - (c) be accompanied by the appropriate fee specified by the Minister by Order.
- (3) If the request does not comply with the requirements in paragraph (2), the Registrar must give the holder the opportunity to provide the specified information or pay the specified fee within a specified period.
- (4) If the holder does not provide the information or pay the fee within the specified period –
  - (a) the holder is taken to have abandoned the request for division; and
  - (b) the Registrar must not send it to the International Bureau.
- (5) The Registrar must send the request to the International Bureau if the Registrar finds that the request for division meets the requirements in paragraph (2).
- (6) The Registrar must respond to any irregularities notified by the International Bureau concerning the request for division within the time limit set by the International Bureau and, if necessary, the Registrar must consult with the holder.
- (7) On receipt of a notification of a division and creation of a divisional international registration that is the subject of a request for territorial extension to Jersey sent by the International Bureau under Rule 27bis(4)(a) of the Common Regulations, the Registrar must update the register of trade marks with the new international registration number for the divisional international registration.
- (8) The Registrar must continue processing the request for territorial extension to Jersey and the request for dividing the international registration.

**134 Request for merger of previously divided international registrations [REF 31/]**

- (1) The holder of an international registration may request that the International Bureau merge a previously divided international registration that is the subject of a request for territorial extension to Jersey.
- (2) A request under paragraph (1) must –
  - (a) be made in writing;
  - (b) contain the information specified in Rule 27ter of the Common Regulations; and
  - (c) be accompanied by the fee specified by the Minister by Order.
- (3) If the request does not comply with the requirements in paragraph (2), the Registrar must give the holder the opportunity to provide the specified information or pay the specified fee within a specified period.
- (4) If the holder does not provide the information or pay the fee within the specified period –

- (a) the holder is taken to have abandoned the request for merger; and
  - (b) the Registrar must not send it to the International Bureau.
- (5) The Registrar must send the request to the International Bureau if the Registrar finds that the request for merger meets the requirements in paragraph (2).
- (6) The Registrar must respond to any irregularities notified by the International Bureau concerning the request for merger within the time limit set by the International Bureau and, if necessary, the Registrar must consult with the holder.
- (7) On receipt of a notification of the record of a merger in relation to an international registration that is the subject of a request for territorial extension to Jersey sent by the International Bureau under Rule 27ter(2)(a) of the Common Regulations, the Registrar must update the register of trade marks with the new international registration number for the merged international registrations.

## DIVISION 6 – GENERAL

### **135 Communications between Registrar and International Bureau [REF 2/Gsy 2020 reg 19/]**

- (1) A person must ensure that a communication to the Registrar that is for sending to the International Bureau, including an international application, is in English.
- (2) The Registrar must ensure that a communication addressed to the International Bureau in relation to an international application or international registration is in English.
- (3) Despite any other enactment or rule of law, the Registrar may communicate to the International Bureau information that Jersey is required to communicate under this Part, the Madrid Protocol or the Common Regulations.

### **136 Order to amend this Part [TMA s54 /]**

- (1) The Minister may by Order amend this Part as the Minister thinks fit for the purpose of implementing changes to the Madrid Protocol that are extended to Jersey.
- (2) The Minister may by Order apply the following provisions to a protected international trade mark (Jersey) –
  - (a) Article 144 [TMA s92/ TMJL Art 25] (unauthorised use of trade mark in relation to goods);
  - (b) Article 146 [TMA s93/TMJL Art 26] (enforcement function of inspectors of weights and measures);
  - (c) Article 148 [TMA s95/ TMJL Art 28] (false representation in respect of trade marks).

## PART 8

### TRADE MARK AGENTS

#### 137 Interpretation

- (1) In this Part –
- “register of trade mark agents” means the register kept in accordance with an Order under Article 140 [Gsy s81/TMA s83] (register of trade mark agents);
- “registered trade mark agent” means an individual, a member of an unincorporated body, a body corporate or a partner of a partnership who is named in the register of trade mark agents;
- “trade mark agent” means an agent authorised under Article 138 [TMA s82] (authorisation of agents).
- (2) For the purpose of the definition of “registered trade mark agent”, if a member of an unincorporated body is a partnership, a partner must be named in the register of trade mark agents.

#### 138 Authorisation of agents [Gsy s80/TMA s82/]

- (1) A person may authorise an agent to act on the person’s behalf in relation to –
- (a) any act required or authorised by this Law to be done by or in relation to the person in connection with the registration of a trade mark;
- (b) any procedure relating to a registered trade mark.
- (2) An authorisation may be written or oral.
- (3) The Minister may by Order provide for exceptions to paragraph (1).
- (4) An exception may provide that only registered trade mark agents may be authorised under this Article.

#### 139 Power of registrar to refuse to deal with certain persons as agents [TMA s88/Gsy Art 85]

- (1) The Minister may by Order authorise the Registrar to refuse to deal with as agent in respect of any business under this Law –
- (a) a person who has been convicted of an offence under Article 141 [Gsy Art 82/TMA s84] (unregistered trade mark agents);
- (b) an individual whose name has been removed and not restored to, or who is suspended from, the register of trade mark agents on the ground of misconduct;
- (c) a person who is found by the Registrar to have conducted themselves in a manner that would, in the case of an individual registered in the register of trade mark agents, render them liable to have their name removed from that register on the ground of misconduct;
- (d) a partnership or body (corporate or unincorporate) of which 1 of the partners, members or directors is a person whom the Registrar could refuse to deal with under (a), (b) or (c).

- (2) The Minister may by Order specify the circumstances which constitute a ground of misconduct.

#### **140 Register of trade mark agents [Gsy s81/TMA s83/]**

- (1) The Minister may by Order require the Registrar or other person specified in the Order to keep and maintain a register of trade mark agents (“the register”).
- (2) The Order may make any provision the Minister thinks fit for the registration of trade mark agents, including in particular –
  - (a) the requirements that must be met before a person is named in the register as a registered trade mark agent;
  - (b) the matters relating to registered trade mark agents that must be entered in the register;
  - (c) the requirement to pay specified fees; [Gsy s81(2)(a)/TMA 83A(2)(f)]
  - (d) the circumstances in which the register may be amended or corrected;
  - (e) the circumstances in which the name of a registered trade mark agent may be removed from the register; [Gsy s81(2)(b)/TMA 83A(2)(e)]
  - (f) the circumstances in which the registration of a trade mark agent may be suspended. [Gsy s81(2)(b)/TMA 83A(2)(e)]
- (3) The Order may provide that the person who keeps the register has specified functions including –
  - (a) disciplinary functions; and
  - (b) a power to make rules –
    - (i) for the payment of fees, subject to specified limits and in specified circumstances;
    - (ii) for any other matter that the Minister could provide for in the Order.

#### **141 Unregistered trade mark agents [Gsy s82/TMA s84/]**

- (1) This Article applies if the Minister has made an Order under Article 140 [Gsy s81/TMA s83] (register of trade mark agents).
- (2) An individual who is not a registered trade mark agent must not –
  - (a) carry on a business (unless the individual carries on that business in partnership with a registered trade mark agent) under any name or other description that contains the words “registered trade mark agent”; or
  - (b) in the course of a business otherwise describe or hold themselves out, or permit themselves to be described or held out, as a registered trade mark agent.
- (3) Unless the requirements in paragraph (4) are met, a partnership or other unincorporated body must not –
  - (a) carry on a business under any name or other description that contains the words “registered trade mark agent”; or
  - (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a firm of registered trade mark agents.
- (4) The requirements are that –
  - (a) all the partners or members are registered trade mark agents; or

- (b) the partnership or other unincorporated body meets the conditions specified in an Order under Article 142 [Gsy s83].
- (5) Unless the requirements in paragraph (6) are met, a body corporate must not –
  - (a) carry on a business (unless the body corporate carries on that business in partnership with a registered trade mark agent) under any name or other description that contains the words “registered trade mark agent”; or
  - (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trade mark agent.
- (6) The requirements are that –
  - (a) all the directors are registered trade mark agents; or
  - (b) the body corporate meets the conditions specified in an Order under Article 142 [Gsy s83] (power to specify conditions for mixed partnerships and bodies corporate).
- (7) A person who contravenes this Article commits an offence and is liable to a fine of level 3 on the standard scale.

#### **142 Power to specify conditions for mixed partnerships and bodies corporate [Gsy s83/]**

- (1) The Minister may by Order specify conditions that must be met under Article 141 [Gsy Art 82] (unregistered trade mark agents) –
  - (a) if not all the partners of a partnership are registered trade mark agents;
  - (b) if not all the members of an unincorporated body are registered trade mark agents; or
  - (c) if not all the directors of a body corporate are registered trade mark agents.
- (2) The conditions may include –
  - (a) the number or proportion of partners, members or directors who must be registered trade mark agents;
  - (b) the requirement for a partnership or body corporate to list in its business documentation names of partners or directors who are registered trade mark agents or unregistered trade mark agents;
  - (c) the manner in which a partnership or body (corporate or unincorporate) must organise its affairs to ensure that registered trade mark agents within the partnership or body (corporate or unincorporate) exercise a sufficient degree of control over the activities of unregistered trade mark agents within that partnership or body (corporate or unincorporate).
- (3) In this Article, “business documentation” means professional advertisements, circulars or letters issued by or with the consent of the partnership or body (corporate or unincorporate) that relate to its business.
- (4) A person who contravenes this Article commits an offence and is liable to a fine of level 3 on the standard scale.

#### **143 Privilege for communications with trade mark agents [Gsy s84/]**

- (1) A communication between a person and their trade mark agent in relation to the protection of a design or trade mark or a matter involving passing off, is privileged

from disclosure in the same way as a communication between a person and their advocate or solicitor.

- (2) A communication for the purposes of obtaining, or in response to a request for, information that a person is seeking for the purpose of instructing their trade mark agent in relation to the protection of a design or trade mark or a matter involving passing off, is privileged from disclosure in the same way as if that communication was for the purpose of instructing their advocate or solicitor.
- (3) In this Article, “trade mark agent” means –
  - (a) a registered trade mark agent;
  - (b) a partnership or unincorporated association entitled to describe itself as a firm of registered trade mark agents; or
  - (c) a body corporate entitled to describe itself as a registered trade mark agent.

## PART 9

### OFFENCES AND FORFEITURE

#### **144 Unauthorised use of trade mark in relation to goods [Art 25 TMJL/TMA s92]**

- (1) A person commits an offence if, with a view to gain for themselves or another, or with intent to cause loss to another, and without the registered proprietor’s consent –
  - (a) they affix to goods or their packaging a sign identical to or likely to be mistaken for a registered trade mark;
  - (b) they sell or let for hire, offer or expose for sale or hire or distribute goods or their packaging bearing a sign mentioned in sub-paragraph (a); or
  - (c) they have goods bearing a sign mentioned in sub-paragraph (a) in their possession, custody or control in the course of a business, with a view to the doing of anything, by themselves or another, that would be an offence under sub-paragraph (b).
- (2) A person commits an offence if, with a view to gain for themselves or another, or with intent to cause loss to another, and without the registered proprietor’s consent –
  - (a) they affix a sign identical to or likely to be mistaken for a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods;
  - (b) they use, in the course of a business, material bearing a sign mentioned in sub-paragraph (a) for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or
  - (c) they have material bearing a sign mentioned in sub-paragraph (a) in their possession, custody or control in the course of a business, with a view to the doing of anything, by themselves or another, that would be an offence under sub-paragraph (b).
- (3) A person commits an offence if the person –
  - (a) with a view to gain for themselves or another, or with intent to cause loss to another, and without the registered proprietor’s consent –

- (i) makes an article specifically designed or adapted for making copies of a sign identical to or likely to be mistaken for a registered trade mark; or
    - (ii) has an article mentioned in sub-paragraph (a) in their possession, custody or control in the course of a business; and
  - (b) knows or has reason to believe that the article has been, or is to be, used to produce goods or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods.
- (4) A person does not commit an offence under this Article unless –
- (a) the goods are goods for which the trade mark is registered; or
  - (b) the trade mark has a reputation in Jersey and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the reputation of the trade mark.
- (5) A person has a defence to an offence under this Article if they prove that they believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark.
- (6) A person who commits an offence under this Article is liable to imprisonment for a term of 10 years and to a fine.

#### **145 Search warrants [Art 26A TMJL/]**

- (1) The Bailiff or a Jurat may issue a warrant authorising a police officer to use necessary and reasonable force to enter and search premises, if the Bailiff or Jurat is satisfied by evidence on oath given by a police officer that there are reasonable grounds for believing –
- (a) that an offence under Article 144 [TMA 92] (unauthorised use of trade mark in relation to goods) has been or is about to be committed in those premises; and
  - (b) that evidence that the offence has been or is about to be committed is in those premises.
- (2) The power conferred by paragraph (1) does not extend to authorising a search for materials of the kinds mentioned in Article 16(2) of the [Police Procedures and Criminal Evidence \(Jersey\) Law 2003](#) (special provisions as to access).
- (3) A warrant under this Article –
- (a) may authorise individuals to accompany a police officer executing the warrant; and
  - (b) remains in force for a period of 28 days beginning with the date of its issue.
- (4) In executing a warrant under paragraph (1) a police officer may seize an article if they reasonably believe that it is evidence that an offence under Article 144 [TMA s 92] (unauthorised use of trade mark in relation to goods) has been or is about to be committed.
- (5) In this Article, “premises” includes land, buildings, fixed or movable structures, vehicles, vessels, aircraft and hovercraft.

**146 Enforcement function of inspectors of weights and measures [TMJL Art 26/]**

- (1) An inspector of weights and measures appointed under Article 2 of the Weights and Measures Law must enforce the provisions of Article 144 [TMA s92] (unauthorised use of trade mark in relation to goods).
- (2) The following provisions of the Weights and Measures Law apply in relation to the enforcement of Article 144 [TMA 92] (unauthorised use of trade mark in relation to goods) as they apply in relation to the enforcement of that Law –
  - (a) Article 29 excluding paragraph (3);
  - (b) Article 31;
  - (c) Article 33 excluding paragraphs (1)(a) and (2)(b);
  - (d) Article 34 excluding the reference to Article 28 in paragraph (1)(b).
- (3) An inspector of weights and measures may ascertain, by testing or otherwise, any goods seized or detained under the powers applied under paragraph (2)(c), whether or not an offence under this Law has been committed.
- (4) An inspector of weights and measures seizing any goods or documents in the exercise of the powers applied as a result of paragraph (2)(a) or (c) must inform the person from whom they are seized.
- (5) The Minister is liable to compensate for loss suffered if, after a seizure under paragraph (4), the owner of the goods –
  - (a) suffers loss by reason of that seizure or by the goods being lost or damaged or deteriorating while being detained as a result of those powers; and
  - (b) is not convicted of an offence under this Law in relation to those goods.
- (6) A disputed question about the right to, or the amount of, compensation payable under paragraph (5) must be determined by a single arbiter appointed by the parties or, failing agreement between the parties, the Registrar.
- (7) A person commits an offence if they disclose to a person information obtained by the person under this Law other than in, or for the purpose of, the performance by the person, or any other person, of functions under this Law.
- (8) A person who commits an offence under this Article is liable to imprisonment for a term of 2 years and to a fine.
- (9) An enactment that authorises the disclosure of information for the purpose of enforcing the Weights and Measures Law applies as if –
  - (a) Article 144 [TMA 92] (unauthorised use of trade mark in relation to goods) of this Law were contained in the Weights and Measures Law; and
  - (b) the functions of a person in relation to the enforcement of that Article were functions under the Weights and Measures Law.
- (10) In this Article, “Weights and Measures Law” means the [Weights and Measures \(Jersey\) Law 1967](#).

**147 Falsification of register of trade marks [Art 27 TMJL]**

- (1) A person commits an offence if they make or cause to be made a false entry in the register of trade marks, knowing or having reason to believe that it is false.
- (2) A person commits an offence if they make, or cause to be made, something falsely purporting to be a copy of an entry in the register of trade marks, knowing or having reason to believe that it is false.

- (3) A person commits an offence if they produce or tender, or cause to be produced or tendered, something falsely purporting to be a copy of an entry in the register of trade marks, knowing or having reason to believe that it is false.
- (4) A person who commits an offence under this Article is liable to a term of imprisonment of 2 years and to a fine.

#### **148 False representation in respect of trade marks [Art 28 TMJL/]**

- (1) A person commits an offence if they falsely represent that a mark is a registered trade mark, knowing or having reason to believe the representation to be false.
- (2) A person commits an offence if they make a false representation about the goods or services for which a trade mark is registered, knowing or having reason to believe the representation to be false.
- (3) A person who commits an offence under this Article is liable to a fine.
- (4) If a person uses in Jersey, in relation to a trade mark, the words “Registered in Jersey”, or words or symbols referring, expressly or impliedly, to registration, those words or symbols are taken to refer to registration under this Law.

#### **149 Unauthorised use of Royal arms [TMA s99/]**

- (1) A person commits an offence if, without the authority of His Majesty’s Receiver-General, they use in connection with any business the Royal arms, or arms so closely resembling the Royal arms as to be calculated to deceive, in a manner that is calculated to lead to the belief that they are authorised to use the Royal arms.
- (2) A person commits an offence if, without the authority of His Majesty’s Receiver-General or a member of the Royal family, they use in connection with any business any device, emblem or title in a manner that is calculated to lead to the belief that they are employed by, or supply goods or services to, His Majesty or that member of the Royal family.
- (3) A person who commits an offence under paragraph (1) is liable to a fine of level 2 on the standard scale.
- (4) The Court may grant an injunction to restrain a person from contravening paragraph (1) or (2) on an application to it by –
  - (a) a person who is authorised to use the arms, device, emblem or title in question; or
  - (b) a person authorised by His Majesty’s Receiver-General to make an application under this paragraph.
- (5) This Article does not affect any right of the proprietor of a trade mark containing such arms, device, emblem or title to use that trade mark.

#### **150 Criminal liability of directors, managers and others for offences committed by entities [TMJL Art 30]**

- (1) A reference to an offence under this Law includes a reference to an offence under Article 1 of the [Criminal Offences \(Jersey\) Law 2009](#).
- (2) In paragraphs (3) and (4), “relevant person” means –

- (a) if the relevant offence is committed by a limited liability partnership, a partner of the partnership;
  - (b) if the relevant offence is committed by a separate limited partnership or an incorporated limited partnership –
    - (i) a general partner; or
    - (ii) a limited partner who is participating in the management of the partnership;
  - (c) if the relevant offence is committed by a body corporate other than an incorporated limited partnership –
    - (i) a director, manager, secretary or other similar officer of the body corporate; and
    - (ii) if the affairs of the body corporate are managed by its members, a member who is acting in connection with the member's functions of management; and
  - (d) a person purporting to act in any capacity described in sub-paragraphs (a) to (c) in relation to the partnership or body that commits the relevant offence.
- (3) If the offence under this Law is proved to have been committed with the consent or connivance of a relevant person, that relevant person is also guilty of the offence and liable in the same manner as the partnership or body corporate to the penalty provided for that offence.
- (4) A relevant person is guilty of an offence under this Law, and liable in the same manner as the partnership or body corporate to the penalty provided for that offence, if the offence –
- (a) is committed by neglect; and
  - (b) is proved to be attributable to neglect on the part of the relevant person.
- (5) A fine imposed on an unincorporated association on its conviction of an offence under this Law must be paid out of the funds of the association.
- (6) Paragraphs (7) and (8) apply if it is alleged that an offence under this Law has been committed by an unincorporated association (that is, not by a member of the association).
- (7) Proceedings for the offence must be brought in the name of the association.
- (8) For the purposes of the proceedings, any provision made by Rules of Court or by the Minister by Order under Article 154 [TMA s78] (orders) relating to the service of documents has effect as if the association were a body corporate (to the extent that the Order or Rules do not make specific provision for service on unincorporated associations).

### **151 Forfeiture of counterfeit goods [Article 29 TMJL/TMA 97]**

- (1) This Article applies if, in connection with an investigation or prosecution of a relevant offence in relation to any goods, material or articles, any of the following come into a person's possession –
- (a) goods or their packaging that bear a sign identical to or likely to be mistaken for a registered trade mark;
  - (b) material bearing a sign mentioned in sub-paragraph (a) that is intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods;

- (c) articles specifically designed or adapted for making copies of a sign mentioned in sub-paragraph (a).
- (2) If this Article applies –
  - (a) a person who has the goods, material or articles in their possession may apply to the Court for an order for the forfeiture of the goods, material or articles; and
  - (b) the Court must make the order for forfeiture in relation to any of the goods, material or articles in respect of which the Court is satisfied that a relevant offence has been committed.
- (3) The Court may infer that a relevant offence has been committed in respect of goods, material or articles if satisfied that a relevant offence has been committed in relation to “representative goods, material or articles”.
- (4) In paragraph (3), “representative goods, material or articles” means goods, material or articles that the Court considers are representative of the goods, material or articles in the applicant’s possession –
  - (a) because they are of the same design or part of the same consignment or batch; or
  - (b) for any other reason.
- (5) If the Court orders the forfeiture of goods, material or articles under this Article, the Court must –
  - (a) direct that the goods, material or articles are destroyed in accordance with any directions that the Court gives; or
  - (b) if the Court thinks fit, direct that the goods, material or articles must be released to a person specified by the Court, on condition that the person –
    - (i) erases the offending sign; and
    - (ii) complies with any order to pay costs that has been made against the person in proceedings for the order for forfeiture.
- (6) In this Article, “relevant offence” means –
  - (a) an offence under Article 144 [TMA s92] (unauthorised use of trade mark in relation to goods);
  - (b) an offence under the [Consumer Safety \(Jersey\) Law 2006](#);
  - (c) an offence under the [Consumer Protection \(Unfair Practices\) \(Jersey\) Law 2018](#); or
  - (d) an offence involving dishonesty or deception.

## PART 10

### MISCELLANEOUS AND GENERAL PROVISIONS

#### 152 Regulations [Art 31A TMJL/]

- (1) The States may by Regulations make provision, including amendment to this Law or another enactment, that the States consider to be necessary and appropriate –
  - (a) to ensure consistency with an international treaty or agreement that applies to Jersey and relates to trade marks;

- (b) to give effect in Jersey to an international treaty or agreement that is ratified by or on behalf of Jersey or is extended to Jersey;
  - (c) to give effect in Jersey to a revision or amendment made after the commencement date of an international treaty or agreement mentioned in subparagraph (b);
  - (d) to enable the ratification by or on behalf of Jersey, or extension to Jersey, of an international treaty or agreement;
  - (e) to give effect in Jersey to a revision or amendment of the Paris Convention or the WTO agreement made after the commencement date; [TMA s55]
  - (f) to give effect in Jersey to a provision that applies in the United Kingdom.
- (2) Regulations under paragraph (1) may do any of the following –
- (a) confer rights on a person or body in relation to the administration of, and decisions relating to, title or interest in a trade mark, including allowing the Minister to make provision by Order;
  - (b) provide for appeals;
  - (c) provide for enforcement including civil remedies or criminal penalties for infringement of a registered trade mark;
  - (d) provide for transitional provisions the States consider to be necessary or expedient.

### **153 Fees [TMA s79]**

- (1) The Minister may by Order, following consultation with the Registrar, specify the fees to be paid for applications and registration and other matters under this Law.
- (2) The Minister may by Order provide for –
  - (a) the payment of a single fee in respect of 2 or more matters; and
  - (b) the circumstances, if any, in which a fee may be repaid or remitted.
- (3) The Order may specify application fees payable according to the class, or the number of classes, of the goods or services applied for.

### **102 Appeals to Court against decision of Registrar [TMA s76/ REF 20]**

- (1) A person may appeal to the Court against a decision of the Registrar under this Law, unless an Order specifically provides that an appeal does not lie.
- (2) An appeal under this Article must be made before the end of 28 days beginning with the date of the Registrar's decision, or any longer period with the leave of the Court.

### **154 Orders [Art 32 TMJL/TMA s78]**

- (1) The Minister may make an Order –
  - (a) under a provision of this Law authorising the making of an Order;
  - (b) generally for regulating practice and procedure under this Law.
- (2) The Minister may by Order provide for –
  - (a) the manner of filing applications and other documents;

- (b) the requirement for, and regulation of, the translation of documents and the filing and authentication of a translation;
  - (c) the service of documents;
  - (d) authorisation of the rectification of irregularities of procedure;
  - (e) specified time limits for anything required to be done in connection with any proceeding under this Law, or an extension of a specified time limit whether or not it has already expired;
  - (f) the extension of a time limit specified by the Registrar, whether or not it has already expired;
  - (g) transitional provisions the Minister considers to be necessary or expedient.
- (3) If the Minister does not make an Order under this Law, the Registrar may adopt the practice and procedure that the Registrar thinks fit for the matters in respect of which an Order may be made.

### 155 Rules of Court [Art 33 TMJL/]

- (1) The power to make Rules of Court under Article 13 of the [Royal Court \(Jersey\) Law 1948](#) includes the power to make rules regulating practice and procedure in connection with Court proceedings under this Law.
- (2) In particular, Rules of Court may provide for –
- (a) the appointment and regulation of an adviser to assist the Court in infringement proceedings and other Court proceedings under this Law;
  - (b) enabling persons to bring proceedings under this Law *in forma pauperis* or with an exemption from liability to pay all Court fees.
- (3) The remuneration of an adviser appointed under paragraph (2) must be paid out of the Consolidated Fund.

### 156 Judicial notice [Gsy 18/]

- (1) A Jersey court must take judicial notice of the following –
- (a) the Madrid Protocol and the Common Regulations;
  - (b) copies of entries in the International Register issued by the International Bureau;
  - (c) copies of the periodical gazette published by the International Bureau in accordance with Rule 32 of the Common Regulations.
- (2) A document mentioned in paragraph (1)(b) or (c) is admissible as evidence of the instrument or other act of the International Bureau to which it relates.

### 157 Matters to be taken into account [Gsy s78/]

The Court and the Registrar must have regard to the following in exercising their powers and duties under this Law –

- (a) the [Paris Union and WIPO Joint Recommendation concerning provisions on the Protection of Well-known Marks 1999](#);
- (b) the [Paris Union and WIPO Joint Recommendation concerning Trade Mark Licences 2000](#);

- (c) the [Paris Union and WIPO Joint Recommendation concerning provisions on the Protection of Marks and other Industrial Property Signs on the Internet 2001](#).

### **158 Saving of vested rights [Art 34 TMJL/]**

- (1) Nothing in this Law derogates from the rights possessed by a person as a result of the registration in the rolls of the Court before the coming into force of the Trade Marks (Jersey) Law 1958 of any document relating to a trade mark.
- (2) Nothing in this Law entitles the proprietor or a licensee (“X”) of a registered trade mark (“trade mark A”) to interfere with or restrain the use by a person (“Y”) of a trade mark identical or similar to trade mark A in relation to goods or services for which Y or a predecessor in title of Y has continuously used that trade mark from a date prior to the registration in the United Kingdom of trade mark A in relation to those goods in the name of X or their predecessor in title.

### **159 Transitional provisions [Articles 36 and 36A TMJL]**

Schedule 3 (transitional provisions) has effect with respect to transitional matters, including the treatment of trade marks registered under the [Trade Marks \(Jersey\) Law 2000](#), and applications for registration and other proceedings under that Law, on the commencement date.

### **160 Consequential amendments and repeals**

- (1) Schedule 4, Part 1 makes amendments consequential on this Law.
- (2) The enactments specified in Schedule 4, Part 2 are repealed.

### **161 Citation and commencement**

This Law may be cited as the Trade Marks (Jersey) Law 202- and comes into force on a date specified by the Minister for External Relations by Order.

## **SCHEDULE 1 [TMA SCHEDULE 1]**

(Articles 3, 68 and 116)

### **REGISTRATION OF COLLECTIVE MARKS**

#### **1 Interpretation**

In this Schedule –

“amended regulations” means amended regulations governing the use of a collective mark;

“authorised user” means a person specified in regulations governing the use of a collective mark as a person authorised to use that collective mark;

“the regulations” means regulations governing the use of a collective mark.

#### **2 Application of this Law to collective marks [TMA Sched 1 para 1/]**

This Law applies to collective marks, subject to this Schedule.

#### **3 Indication of geographical origin [TMA Sched 1 para 3/]**

- (1) Despite Article 68 [TMA s3(1)(c)] (absolute grounds for refusal), the Registrar may register a collective mark that consists of signs or indications that may serve in trade to designate the geographical origin of the goods or services.
- (2) But the registered proprietor is not entitled to prohibit a person (in particular, a person who is entitled to use a geographical name) from using the signs or indications in accordance with honest practices in industrial or commercial matters.

#### **4 Collective mark not to be misleading about character or significance [TMA Sched 1 para 4/]**

- (1) The Registrar must refuse registration of a collective mark if the public is liable to be misled about the character or significance of the trade mark, in particular if the trade mark is likely to be taken to be something other than a collective mark.
- (2) The Registrar may require that a trade mark for which an application for registration of a collective mark is made includes an indication that the trade mark is a collective mark.
- (3) Despite Article 64 [TMA s39(2)] (withdrawal or amendment of application for registration), an applicant for registration may amend the representation of the trade mark to comply with a requirement of the Registrar under sub-paragraph (2).

#### **5 Filing of regulations governing use of collective mark [TMA Sched 1 para 5/]**

- (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the collective mark.
- (2) The Minister must by Order specify –
  - (a) the period within which the applicant must file the regulations; and

- (b) the fee to accompany the filing of the regulations (“filing fee”).
- (3) The regulations must specify –
  - (a) the persons authorised to use the collective mark;
  - (b) the conditions of membership of the association; and
  - (c) the conditions of use of the collective mark and sanctions for misuse.
- (4) Regulations governing the use of a collective mark that designates the geographical origin of goods or services must authorise any person whose goods or services originate in a designated geographical area to become a member of the association, but only if the person meets all the other conditions of the regulations.
- (5) The Minister may by Order impose further requirements in relation to the regulations.
- (6) If the Minister does not make an Order under sub-paragraph (5), the Registrar may publish further requirements on a website maintained by the Registrar.
- (7) In this paragraph, “the association” means the association that is the proprietor of the collective mark.

## **6 Application for registration of collective mark [TMA s49/ and Sched 1 para 6/]**

- (1) The Registrar must refuse registration of a collective mark unless regulations governing the use of the collective mark –
  - (a) comply with paragraph 5(3) and (4) and any further requirements under paragraph 5(5) or (6); and
  - (b) are not contrary to public policy or to accepted principles of morality.
- (2) If the applicant for registration does not file the regulations and pay the filing fee before the end of the period specified under paragraph 5(2), the applicant is taken to have withdrawn the application.

## **7 Consideration of application for registration [TMA Sched 1 para 7/]**

- (1) The Registrar must decide whether regulations governing the use of a collective mark meet the requirements in paragraph 6(1) (application for registration of collective mark).
- (2) If the Registrar decides that the regulations do not meet the requirements in paragraph 6(1), the Registrar must –
  - (a) inform the applicant for registration; and
  - (b) give the applicant an opportunity, within a period specified by the Registrar, to make representations or to file amended regulations.
- (3) The Registrar must refuse to accept the application for registration if –
  - (a) the applicant fails to satisfy the Registrar that the regulations meet the requirements in paragraph 6(1);
  - (b) the applicant fails to file amended regulations that meet those requirements; or
  - (c) the applicant fails to make representations or to file amended regulations before the end of the period specified under sub-paragraph (2).
- (4) The Registrar must accept the application for registration if the requirements in paragraph 6(1) and the other requirements for registration are met.

## **8 Publication of regulations, notice of opposition and observations [TMA Sched 1 para 8/]**

- (1) The Registrar must publish regulations governing the use of a collective mark (and any amended regulations filed under paragraph 7) in the same manner as the application for registration is published.
- (2) A person may give a notice of opposition and make observations in relation to the matters in paragraph 6(1) (application for registration).
- (3) The provision in sub-paragraph (2) is in addition to any other grounds on which an application for registration may be opposed or observations made under this Law.
- (4) The procedure in Article 78 [TMA s38] (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

## **9 Inspection of regulations [TMA Sched 1 para 9/]**

The duty on the Registrar under [Article [xx] (inspection of register) of the Registrar of Intellectual Property (Jersey) Law 202-] to make the register of trade marks available for public inspection applies in the same way to regulations governing the use of a collective mark that is a registered trade mark.

## **10 Amendment of regulations after registration [TMA Sched 1 para 10/]**

- (1) Any amendment of regulations governing the use of a collective mark after the collective mark is registered is not effective unless –
  - (a) the registered proprietor files the amended regulations with the Registrar; and
  - (b) the Registrar accepts the amended regulations.
- (2) Before accepting the amended regulations, the Registrar may, if it appears expedient to do so, publish the amended regulations in the same manner as the application for registration was published.
- (3) If the Registrar publishes the amended regulations, a person may give a notice of opposition and make observations in relation to the matters in paragraph 6(1).
- (4) The procedure in Article 78 [TMA s38] (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

## **11 Infringement – rights of authorised users [TMA Schedule 1 para 11/]**

The following Articles apply in relation to an authorised user of a collective mark that is a registered trade mark as they apply in relation to a licensee –

- (a) Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles);
- (b) Article 41 [TMA s89] (notice of importation of prohibited goods).

## **12 Rights of authorised users in relation to infringement [TMA Schedule 1 para 12]**

- (1) Unless an agreement between an authorised user and the registered proprietor of a collective mark provides otherwise, the authorised user must not bring infringement

proceedings in relation to the registered trade mark without the registered proprietor's consent.

- (2) If an authorised user brings infringement proceedings (under this paragraph or under an agreement between the authorised user and the registered proprietor), the authorised user must not continue with those proceedings without the leave of the Court unless the registered proprietor is –
  - (a) joined as a plaintiff;
  - (b) added as a defendant.
- (3) Sub-paragraph (2) does not affect the granting of interlocutory relief on an application by an authorised user alone.
- (4) A registered proprietor who is added as a defendant under sub-paragraph (2) is not liable for any costs in the infringement proceedings unless they take part in those proceedings.
- (5) In infringement proceedings brought by the registered proprietor, the Court –
  - (a) must take into account any loss suffered or likely to be suffered by authorised users; and
  - (b) may give directions it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of authorised users.
- (6) If the registered proprietor brings infringement proceedings, an authorised user who has suffered loss is entitled to intervene in the infringement proceedings for the purpose of obtaining compensation for that loss.

### **13 Grounds for revocation of registration [TMA Sched 1 para 13/]**

In addition to the grounds for revocation in Article 90 [TMA s46] (grounds for revoking registration), the registration of a collective mark may be revoked on any of the following grounds –

- (a) that the manner in which the collective mark has been used by authorised users has caused it to become liable to mislead the public in the manner mentioned in paragraph 4(1) (collective mark not to be misleading about character or significance);
- (b) that the registered proprietor has not taken reasonable steps to prevent the collective mark being used in a manner that is incompatible with the conditions of use specified in the regulations (as amended from time to time);
- (c) that an amendment of the regulations has been made so that the regulations –
  - (i) no longer comply with paragraph 5(3) and (4) and any further requirements under paragraph 5(5) or (6); or
  - (ii) are contrary to public policy or to accepted principles of morality.

### **14 Grounds for invalidity of registration [TMA Sched 1 para 14/]**

- (1) In addition to the grounds of invalidity in Article 93 [TMA s47(1), (2) and (2ZA)] (grounds for invalidity of registration), the registration of a collective mark must be declared invalid on the grounds that the collective mark was registered in breach of –
  - (a) Article 6(2) [TMA s49(1A)] (meaning of registered proprietor);
  - (b) paragraph 4(1) (collective mark not to be misleading about character or significance); or

- (c) paragraph 6(1) (application for registration of collective mark).
- (2) But a declaration of invalidity must not be made if –
  - (a) sub-paragraph (1)(c) applies; and
  - (b) the registered proprietor amends the regulations under paragraph 10 so that the regulations comply with the requirements of paragraph 6(1).

Consultation draft

## **SCHEDULE 2 [TMA SCHEDULE 2]**

(Articles 4 and 116)

### **REGISTRATION OF CERTIFICATION MARKS**

#### **1 Interpretation**

In this Schedule –

“amended regulations” means amended regulations governing the use of a certification mark;

“authorised user” means a person specified in regulations governing the use of a certification mark as a person authorised to use that certification mark;

“the regulations” means regulations governing the use of a certification mark.

#### **2 Application of this Law to certification marks [TMA Schedule 2 para 1/]**

This Law applies to certification marks, subject to this Schedule.

#### **3 Indication of geographical origin [TMA Schedule 2 para 3/]**

- (1) Despite Article 68 [TMA s3(1)(c)] (absolute grounds for refusal), the Registrar may register a certification mark that consists of signs or indications that may serve in trade to designate the geographical origin of the goods or services.
- (2) But the registered proprietor is not entitled to prohibit a person (in particular, a person who is entitled to use a geographical name) from using the signs or indications in accordance with honest practices in industrial or commercial matters.

#### **4 Nature of proprietor’s business [TMA Schedule 2 para 4/]**

The Registrar must refuse registration of a certification mark if the proprietor of the certification mark carries on a business involving the supply of goods or services of the kind certified.

#### **5 Certification mark not to be misleading about character or significance [TMA Schedule 2 para 5/]**

- (1) The Registrar must refuse registration of a certification mark if the public is liable to be misled about the character or significance of the trade mark, in particular if the trade mark is likely to be taken to be something other than a certification mark.
- (2) The Registrar may require that a trade mark for which an application for registration of a certification mark is made includes an indication that the trade mark is a certification mark.
- (3) Despite Article 64 [TMA s39(2)] (withdrawal or amendment of application for registration), the applicant for registration may amend the representation of the trade mark to comply with a requirement of the Registrar under sub-paragraph (2).

## **6 Filing of regulations governing use of certification mark [TMA Schedule 2, para 6/]**

- (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the certification mark.
- (2) The Minister must by Order specify –
  - (a) the period within which the applicant must file the regulations; and
  - (b) the fee to accompany the filing of the regulations (“filing fee”).
- (3) The regulations must specify –
  - (a) the persons authorised to use the certification mark;
  - (b) the characteristics in relation to which goods or services are to be certified;
  - (c) how the registered proprietor is to test those characteristics and to supervise the use of the certification mark;
  - (d) the fees, if any, to be paid in connection with the operation of the certification mark; and
  - (e) the procedures for resolving disputes.
- (4) The Minister may by Order impose further requirements in relation to the regulations.
- (5) If the Minister does not make an Order under sub-paragraph (4), the Registrar may publish further requirements on a website maintained by the Registrar.
- (6) If the applicant does not file the regulations and pay the filing fee before the end of the period specified under sub-paragraph (2), the applicant is taken to have withdrawn the application.

## **7 Grounds for refusal of application for registration of certification mark [TMA Schedule 2 para 7/]**

The Registrar must refuse registration of a certification mark unless –

- (a) regulations governing the use of the certification mark –
  - (i) comply with paragraph 6(3) (filing of regulations governing use of certification mark) and any further requirements under paragraph 6(4) or (5); and
  - (ii) are not contrary to public policy or to accepted principles of morality; and
- (b) the applicant for registration is competent to certify the goods or services for which the application for registration is made.

## **8 Consideration of application for registration [TMA Schedule 2 para 8/]**

- (1) The Registrar must decide whether regulations governing the use of a certification mark meet the requirements in paragraph 7.
- (2) If the Registrar decides that the regulations do not meet the requirements in paragraph 7, the Registrar must –
  - (a) inform the applicant for registration; and
  - (b) give the applicant an opportunity, within a period specified by the Registrar, to make representations or to file amended regulations.

- (3) The Registrar must refuse to accept an application for registration if –
  - (a) the applicant fails to satisfy the Registrar that the regulations meet the requirements in paragraph 7;
  - (b) the applicant fails to file amended regulations that meet those requirements; or
  - (c) the applicant fails to make representations or to file amended regulations before the end of the period specified under sub-paragraph (2).
- (4) The Registrar must accept the application for registration if the requirements in paragraph 7 and the other requirements for registration are met.

## **9 Publication of regulations, notice of opposition and observations [TMA Schedule 2 para 9/]**

- (1) The Registrar must publish regulations governing the use of a certification mark (and any amended regulations filed under paragraph 8) in the same manner as the application for registration is published.
- (2) A person may give a notice of opposition and make observations in relation to the matters in paragraph 7.
- (3) The provision in sub-paragraph (2) is in addition to any other grounds on which an application for registration may be opposed or observations made under this Law.
- (4) The procedure in Article 78 [TMA s38] (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

## **10 Inspection of regulations [TMA Schedule 2 para 10/]**

The duty on the Registrar under [Article [xx] (inspection of register) of the Registrar of Intellectual Property (Jersey) Law 202-] to make the register of trade marks available for public inspection applies in the same way to regulations governing the use of a certification mark that is a registered trade mark.

## **11 Amendment of regulations after registration [TMA Schedule 2 para 11/]**

- (1) Any amendment of regulations governing the use of a certification mark after the certification mark is registered is not effective unless –
  - (a) the registered proprietor files the amended regulations with the Registrar; and
  - (b) the Registrar accepts the amended regulations.
- (2) Before accepting the amended regulations, the Registrar may, if it appears expedient to do so, publish the amended regulations in the same manner as the application for registration was published.
- (3) If the Registrar publishes the amended regulations, a person may give a notice of opposition and make observations in relation to the matters in paragraph 7.
- (4) The procedure in Article 78 [TMA s38] (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

**12 Consent to assignment [TMA Schedule 2 para 12/]**

The assignment or other transmission of a certification mark that is a registered trade mark is not effective without the consent of the Registrar.

**13 Infringement – rights of authorised users [TMA Schedule 2 para 13/]**

The following provisions apply in relation to an authorised user of a certification mark that is a registered trade mark as they apply in relation to a licensee –

- (a) Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles);
- (b) Article 41 [TMA s89] (notice of importation of prohibited goods).

**14 Consideration of loss of authorised users in infringement proceedings [TMA Schedule 2 para 14/]**

- (1) In infringement proceedings brought by the registered proprietor of a certification mark, the Court must take into consideration any loss suffered or likely to be suffered by an authorised user.
- (2) The Court may give any directions it thinks fit about the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of an authorised user.

**15 Grounds for revocation of registration [TMA Schedule 2 para 15/]**

In addition to the grounds for revocation in Article 90 [TMA s46] (grounds for revoking registration), the registration of a certification mark may be revoked on any of the following grounds –

- (a) that the registered proprietor has begun to carry on a business mentioned in paragraph 4;
- (b) that the manner in which the certification mark has been used by the registered proprietor has caused the certification mark to become liable to mislead the public in the manner mentioned in paragraph 5(1) (certification mark not to be misleading);
- (c) that the registered proprietor has failed to observe, or failed to secure the observance of, regulations governing the use of the certification mark;
- (d) that an amendment of the regulations has been made so that the regulations –
  - (i) no longer comply with paragraph 6(2) (regulations governing use of certification mark) and any further requirements under paragraph 6(4) or (5); or
  - (ii) are contrary to public policy or to accepted principles of morality;
- (e) that the registered proprietor is no longer competent to certify the goods or services for which the certification mark is registered.

**16 Grounds for invalidity of registration [TMA Schedule 2 para 16/]**

- (1) In addition to the grounds for invalidity in Article 93 [TMA s47(1), (2) and (2ZA)] (grounds for invalidity of registration), the registration of a certification mark must

be declared invalid on the grounds that the certification mark was registered in breach of –

- (a) paragraph 4 (nature of business of the proprietor);
  - (b) paragraph 5(1) (certification mark not to be misleading); or
  - (c) paragraph 7 (grounds for refusal).
- (2) But a declaration of invalidity must not be made if –
- (a) sub-paragraph (1)(c) applies; and
  - (b) the registered proprietor amends the regulations under paragraph 10 so that the regulations comply with the requirements of paragraph 7.

Consultation draft

## SCHEDULE 3

(Articles 5 and 159)

### TRANSITIONAL PROVISIONS

#### 1 Registration of existing registered trade marks

- (1) On the commencement date, the Registrar must enter all existing registered trade marks in the register of trade marks.
- (2) A trade mark registered under this Law in accordance with sub-paragraph (1) has a date of registration that is the same date as the date of application for registration of that trade mark under the TMA.
- (3) The registration of a trade mark under this Law in accordance with sub-paragraph (1) ceases to have effect on the date on which the registration of that trade mark under the TMA would have expired, unless the registration of the trade mark under this Law is renewed under Part 6 in accordance with this Schedule.
- (4) The renewal of registration of the trade mark under Part 6 has effect from the date on which the registration of that trade mark under the TMA would have expired.
- (5) The Registrar must publish a notice informing registered proprietors of their rights of renewal under this paragraph.

#### 2 Renewal of registration due in first 6 months

- (1) This paragraph applies in relation to a trade mark registered under this Law in accordance with paragraph 1(1) if the registration of that trade mark under the TMA would have expired within the 6-month period beginning with the commencement date.
- (2) The registered proprietor may, at any time before the end of that 6-month period, make a request under Part 6 to renew the registration of the trade mark under this Law.
- (3) The registration of the trade mark under this Law ceases to have effect at the end of that 6-month period unless the registered proprietor has made a request for renewal of the registration of the trade mark under Part 6.
- (4) The renewal of registration of the trade mark under Part 6 has effect from the date on which the registration of that trade mark under the TMA would have expired.
- (5) The Registrar must publish a notice informing registered proprietors of their rights of renewal under this paragraph.

#### 3 Renewal of lapsed registration

- (1) The proprietor of a trade mark may apply under Part 6 to renew the registration of the trade mark in Jersey if –
  - (a) the trade mark was registered under Article 4 of the TMJL 2000 on the basis of its registration under the TMA;
  - (b) the registration of the trade mark under the TMA was due for renewal in the 6-month period before the commencement date;
  - (c) the registration of the trade mark under the TMA has been renewed; and

- (d) the renewal under the TMA was not registered under Article 5(1) of the TMJL 2000 before the commencement date.
- (2) A request under Part 6 for renewal of the registration of the trade mark in Jersey must be made before the end of the 12-month period beginning with the date the registration of the trade mark under the TMA was due for renewal.
- (3) The date of registration of a trade mark whose registration is renewed under this paragraph is the same date as the date of application for registration of that trade mark under the TMA.
- (4) The Registrar must publish a notice informing proprietors of their rights of renewal under this paragraph.

#### **4 Protected international trade marks (UK) [Art 13 TMJL/]**

- (1) This paragraph applies in relation to an international trade mark that was, immediately before the commencement date, a protected international trade mark (UK).
- (2) For the period beginning with the commencement date and ending with the date its registration would have expired under the TMA, the international trade mark –
  - (a) continues to be protected in Jersey; and
  - (b) is taken to be a registered trade mark under this Law.
- (3) The international trade mark ceases to be protected in Jersey at the end of the period in paragraph (2) unless –
  - (a) the holder of the international registration has applied under Part 6 for registration of the trade mark under this Law; or
  - (b) the international trade mark is the subject of a request for territorial extension to Jersey made on or after the commencement date.

### **SCHEDULE 4**

(Article 160)

#### **PART 1**

#### **CONSEQUENTIAL AMENDMENTS**

##### **1 [Criminal Procedure \(Jersey\) Law 2018](#) amended**

In the [Criminal Procedure \(Jersey\) Law 2018](#), in Article 112(3)(r), for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”.

##### **2 [Intellectual Property \(Plant Varieties\) \(Jersey\) Law 2016](#) amended**

In the [Intellectual Property \(Plant Varieties\) \(Jersey\) Law 2016](#), in Article 36(3), for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”.

##### **3 [Intellectual Property \(Unregistered Rights\) \(Jersey\) Law 2011](#) amended**

In the [Intellectual Property \(Unregistered Rights\) \(Jersey\) Law 2011](#) –

- (a) in the long title, for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”;
- (b) for Article 143(7)(d) there is substituted –
  - (d) Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles) of the Trade Marks (Jersey) Law 202-;
- (c) for Article 321(6)(d) there is substituted –
  - (d) Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles) of the Trade Marks (Jersey) Law 202-;
- (d) for Article 377(7)(d) there is substituted –
  - (d) Article 37 [TMA s19] (order for disposal of infringing goods, infringing material or infringing articles) of the Trade Marks (Jersey) Law 202-;
- (e) in Article 406(2), for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”.

#### **4 [Merchandise Marks \(Jersey\) Law 1958](#) amended**

In the [Merchandise Marks \(Jersey\) Law 1958](#) –

- (a) in Article 1(2), for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”;
- (b) in Article 14, for “Article 4 of the Trade Marks (Jersey) Law 2000” there is substituted “Article 82 [TMA 40] (registration of trade mark) of the Trade Marks (Jersey) Law 202-”.

#### **5 [Motor Vehicles \(Construction and Use\) \(Jersey\) Order 1998](#)**

In the [Motor Vehicles \(Construction and Use\) \(Jersey\) Order 1998](#), in Article 63(15), for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”.

#### **6 [Royal Court Rules 2004](#)**

In the [Royal Court Rules 2004](#), in Rule 17/3(1)(h), for “Article 14 of the [Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Article 55 [TMA 64] of the Trade Marks (Jersey) Law 202- (rectification of the register of trade marks)”.

## **PART 2**

### **REPEALS**

#### **7 Repeals**

The following enactments are repealed –

- (a) the [Trade Marks \(Jersey\) Law 2000](#);
- (b) the [Trade Marks \(Jersey\) Order 2000](#);
- (c) the Trade Marks (Jersey) Rules 2000.