



# Trade Marks Act 1994

## 1994 CHAPTER 26

### PART III

#### ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

##### *The registrar*

#### **62 The registrar**

In this Act “the registrar” means the Comptroller-General of Patents, Designs and Trade Marks.

##### *The register*

#### **63 The register**

(1) The registrar shall maintain a register of trade marks.

References in this Act to “the register” are to that register; and references to registration (in particular, in the expression “registered trade mark”) are, unless the context otherwise requires, to registration in that register.

(2) There shall be entered in the register in accordance with this Act—

- (a) registered trade marks,
- (b) such particulars as may be prescribed of registrable transactions affecting a registered trade mark, and
- (c) such other matters relating to registered trade marks as may be prescribed.

(3) The register shall be kept in such manner as may be prescribed, and provision shall in particular be made for—

- (a) public inspection of the register, and
- (b) the supply of certified or uncertified copies, or extracts, of entries in the register.

#### **64 Rectification or correction of the register**

- (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

- (2) An application for rectification may be made either to the registrar or to the court, except that—
- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
  - (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.
- (3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.
- (4) The registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.
- (5) The registrar may remove from the register matter appearing to him to have ceased to have effect.

#### **65 Adaptation of entries to new classification**

- (1) Provision may be made by rules empowering the registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.
- (2) Provision may in particular be made for the amendment of existing entries on the register so as to accord with the new classification.
- (3) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.
- (4) The rules may empower the registrar—
- (a) to require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the register, and
  - (b) to cancel or refuse to renew the registration of the trade mark in the event of his failing to do so.
- (5) Any such proposal shall be advertised, and may be opposed, in such manner as may be prescribed.

### *Powers and duties of the registrar*

#### **66 Power to require use of forms**

- (1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.
- (2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner.

#### **67 Information about applications and registered trade marks**

- (1) After publication of an application for registration of a trade mark, the registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject, however, to any prescribed restrictions.  
  
Any request must be made in the prescribed manner and be accompanied by the appropriate fee (if any).
- (2) Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application shall not be published by the registrar or communicated by him to any person except—
  - (a) in such cases and to such extent as may be prescribed, or
  - (b) with the consent of the applicant;but subject as follows.
- (3) Where a person has been notified that an application for registration of a trade mark has been made, and that the applicant will if the application is granted bring proceedings against him in respect of acts done after publication of the application, he may make a request under subsection (1) notwithstanding that the application has not been published and that subsection shall apply accordingly.

#### **68 Costs and security for costs**

- (1) Provision may be made by rules empowering the registrar, in any proceedings before him under this Act—
  - (a) to award any party such costs as he may consider reasonable, and
  - (b) to direct how and by what parties they are to be paid.
- (2) Any such order of the registrar may be enforced—
  - (a) in England and Wales or Northern Ireland, in the same way as an order of the High Court;
  - (b) in Scotland, in the same way as a decree for expenses granted by the Court of Session.
- (3) Provision may be made by rules empowering the registrar, in such cases as may be prescribed, to require a party to proceedings before him to give security for costs, in relation to those proceedings or to proceedings on appeal, and as to the consequences if security is not given.

## **69 Evidence before registrar**

Provision may be made by rules—

- (a) as to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration;
- (b) conferring on the registrar the powers of an official referee of the Supreme Court as regards the examination of witnesses on oath and the discovery and production of documents; and
- (c) applying in relation to the attendance of witnesses in proceedings before the registrar the rules applicable to the attendance of witnesses before such a referee.

## **70 Exclusion of liability in respect of official acts**

- (1) The registrar shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention, arrangement or engagement to which the United Kingdom is a party.
- (2) The registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.
- (3) No proceedings lie against an officer of the registrar in respect of any matter for which, by virtue of this section, the registrar is not liable.

## **71 Registrar's annual report**

- (1) The Comptroller-General of Patents, Designs and Trade Marks shall in his annual report under section 121 of the Patents Act 1977, include a report on the execution of this Act, including the discharge of his functions under the Madrid Protocol.
- (2) The report shall include an account of all money received and paid by him under or by virtue of this Act.

### *Legal proceedings and appeals*

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

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

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

- (1) If in proceedings before the court the validity of the registration of a trade mark is contested and it is found by the court that the trade mark is validly registered, the court may give a certificate to that effect.
- (2) If the court gives such a certificate and in subsequent proceedings—
  - (a) the validity of the registration is again questioned, and

(b) the proprietor obtains a final order or judgment in his favour, he is entitled to his costs as between solicitor and client unless the court directs otherwise.

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

#### **74 Registrar’s appearance in proceedings involving the register**

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

#### **75 The court**

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

- (a) in England and Wales and Northern Ireland, the High Court, and
- (b) in Scotland, the Court of Session.

#### **76 Appeals from the registrar**

- (1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules.
- For this purpose “decision” includes any act of the registrar in exercise of a discretion vested in him by or under this Act.
- (2) Any such appeal may be brought either to an appointed person or to the court.
- (3) Where an appeal is made to an appointed person, he may refer the appeal to the court if—
- (a) it appears to him that a point of general legal importance is involved,
  - (b) the registrar requests that it be so referred, or
  - (c) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.

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

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

## **77 Persons appointed to hear and determine appeals**

- (1) For the purposes of section 76 an “appointed person” means a person appointed by the Lord Chancellor to hear and decide appeals under this Act.
- (2) A person is not eligible for such appointment unless—
  - (a) he has a 7 year general qualification, within the meaning of section 71 of the Courts and Legal Services Act 1990;
  - (b) he is an advocate or solicitor in Scotland of at least 7 years' standing;
  - (c) he is a member of the Bar of Northern Ireland or solicitor of the Supreme Court of Northern Ireland of at least 7 years' standing; or
  - (d) he has held judicial office.
- (3) An appointed person shall hold and vacate office in accordance with his terms of appointment, subject to the following provisions—
  - (a) there shall be paid to him such remuneration (whether by way of salary or fees), and such allowances, as the Secretary of State with the approval of the Treasury may determine;
  - (b) he may resign his office by notice in writing to the Lord Chancellor;
  - (c) the Lord Chancellor may by notice in writing remove him from office if—
    - (i) he has become bankrupt or made an arrangement with his creditors or, in Scotland, his estate has been sequestrated or he has executed a trust deed for his creditors or entered into a composition contract, or
    - (ii) he is incapacitated by physical or mental illness,
 or if he is in the opinion of the Lord Chancellor otherwise unable or unfit to perform his duties as an appointed person.
- (4) The Lord Chancellor shall consult the Lord Advocate before exercising his powers under this section.

*Rules, fees, hours of business, &c.*

## **78 Power of Secretary of State to make rules**

- (1) The Secretary of State may make rules—
  - (a) for the purposes of any provision of this Act authorising the making of rules with respect to any matter, and
  - (b) for prescribing anything authorised or required by any provision of this Act to be prescribed,
 and generally for regulating practice and procedure under this Act.

- (2) Provision may, in particular, be made—
- (a) as to the manner of filing of applications and other documents;
  - (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
  - (c) as to the service of documents;
  - (d) authorising the rectification of irregularities of procedure;
  - (e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;
  - (f) providing for the extension of any time limit so prescribed, or specified by the registrar, whether or not it has already expired.
- (3) Rules under this Act shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

## **79 Fees**

- (1) There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed.
- (2) Provision may be made by rules as to—
- (a) the payment of a single fee in respect of two or more matters, and
  - (b) the circumstances (if any) in which a fee may be repaid or remitted.

## **80 Hours of business and business days**

- (1) The registrar may give directions specifying the hours of business of the Patent Office for the purpose of the transaction by the public of business under this Act, and the days which are business days for that purpose.
- (2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.
- (3) Directions under this section may make different provision for different classes of business and shall be published in the prescribed manner.

## **81 The trade marks journal**

Provision shall be made by rules for the publication by the registrar of a journal containing particulars of any application for the registration of a trade mark (including a representation of the mark) and such other information relating to trade marks as the registrar thinks fit.

### *Trade mark agents*

## **82 Recognition of agents**

Except as otherwise provided by rules, any act required or authorised by this Act to be done by or to a person in connection with the registration of a trade mark, or any

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procedure relating to a registered trade mark, may be done by or to an agent authorised by that person orally or in writing.

### **83 The register of trade mark agents**

- (1) The Secretary of State may make rules requiring the keeping of a register of persons who act as agent for others for the purpose of applying for or obtaining the registration of trade marks; and in this Act a “registered trade mark agent” means a person whose name is entered in the register kept under this section.
- (2) The rules may contain such provision as the Secretary of State thinks fit regulating the registration of persons, and may in particular—
  - (a) require the payment of such fees as may be prescribed, and
  - (b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person’s registration.
- (3) The rules may delegate the keeping of the register to another person, and may confer on that person—
  - (a) power to make regulations—
    - (i) with respect to the payment of fees, in the cases and subject to the limits prescribed by the rules, and
    - (ii) with respect to any other matter which could be regulated by the rules, and
  - (b) such other functions, including disciplinary functions, as may be prescribed by the rules.

### **84 Unregistered persons not to be described as registered trade mark agents**

- (1) An individual who is not a registered trade mark agent shall not—
  - (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent”; or
  - (b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent.
- (2) A partnership shall not—
  - (a) carry on a business under any name or other description which 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,unless all the partners are registered trade mark agents or the partnership satisfies such conditions as may be prescribed for the purposes of this section.
- (3) A body corporate shall not—
  - (a) carry on a business (otherwise than in partnership) under any name or other description which 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,unless all the directors of the body corporate are registered trade mark agents or the body satisfies such conditions as may be prescribed for the purposes of this section.



- (4) A person who contravenes this section commits an offence and is liable on summary conviction to a fine not exceeding level 5 on the standard scale; and proceedings for such an offence may be begun at any time within a year from the date of the offence.

## **85 Power to prescribe conditions, &c. for mixed partnerships and bodies corporate**

- (1) The Secretary of State may make rules prescribing the conditions to be satisfied for the purposes of section 84 (persons entitled to be described as registered trade mark agents)—
- (a) in relation to a partnership where not all the partners are qualified persons, or
  - (b) in relation to a body corporate where not all the directors are qualified persons,
- and imposing requirements to be complied with by such partnerships or bodies corporate.
- (2) The rules may, in particular—
- (a) prescribe conditions as to the number or proportion of partners or directors who must be qualified persons;
  - (b) impose requirements as to—
    - (i) the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to its business, and
    - (ii) the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a sufficient degree of control over the activities of unqualified persons.
- (3) Contravention of a requirement imposed by the rules is an offence for which a person is liable on summary conviction to a fine not exceeding level 5 on the standard scale.
- (4) In this section “qualified person” means a registered trade mark agent.

## **86 Use of the term “trade mark attorney”**

- (1) No offence is committed under the enactments restricting the use of certain expressions in reference to persons not qualified to act as solicitors by the use of the term “trade mark attorney” in reference to a registered trade mark agent.
- (2) The enactments referred to in subsection (1) are section 21 of the Solicitors Act 1974, section 31 of the Solicitors (Scotland) Act 1980 and Article 22 of the Solicitors (Northern Ireland) Order 1976.

## **87 Privilege for communications with registered trade mark agents**

- (1) This section applies to communications as to any matter relating to the protection of any design or trade mark, or as to any matter involving passing off.
- (2) Any such communication—
- (a) between a person and his trade mark agent, or
  - (b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his trade mark agent,
- is privileged from, or in Scotland protected against, disclosure in legal proceedings in the same way as a communication between a person and his solicitor or, as the case

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may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his solicitor.

- (3) In subsection (2) “trade mark agent” means—
- (a) a registered trade mark agent, or
  - (b) a partnership 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.

## **88 Power of registrar to refuse to deal with certain agents**

- (1) The Secretary of State may make rules authorising the registrar to refuse to recognise as agent in respect of any business under this Act—
- (a) a person who has been convicted of an offence under section 84 (unregistered persons describing themselves as registered trade mark agents);
  - (b) an individual whose name has been erased from 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 Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of trade mark agents, render him liable to have his name erased from the register on the ground of misconduct;
  - (d) a partnership or body corporate of which one of the partners or directors is a person whom the registrar could refuse to recognise under paragraph (a), (b) or (c) above.
- (2) The rules may contain such incidental and supplementary provisions as appear to the Secretary of State to be appropriate and may, in particular, prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct.

### *Importation of infringing goods, material or articles*

## **89 Infringing goods, material or articles may be treated as prohibited goods**

- (1) The proprietor of a registered trade mark, or a licensee, may give notice in writing to the Commissioners of Customs and Excise—
- (a) that he is the proprietor or, as the case may be, a licensee of the registered trade mark,
  - (b) that, at a time and place specified in the notice, goods which are, in relation to that registered trade mark, infringing goods, material or articles are expected to arrive in the United Kingdom—
    - (i) from outside the European Economic Area, or
    - (ii) from within that Area but not having been entered for free circulation, and
  - (c) that he requests the Commissioners to treat them as prohibited goods.
- (2) When a notice is in force under this section the importation of the goods to which the notice relates, otherwise than by a person for his private and domestic use, is prohibited; but a person is not by reason of the prohibition liable to any penalty other than forfeiture of the goods.

- (3) This section does not apply to goods entered, or expected to be entered, for free circulation in respect of which the proprietor of the registered trade mark, or a licensee, is entitled to lodge an application under Article 3(1) of Council Regulation (EEC) No. 3842/86 laying down measures to prohibit the release for free circulation of counterfeit goods.

## **90 Power of Commissioners of Customs and Excise to make regulations**

- (1) The Commissioners of Customs and Excise may make regulations prescribing the form in which notice is to be given under section 89 and requiring a person giving notice—
- (a) to furnish the Commissioners with such evidence as may be specified in the regulations, either on giving notice or when the goods are imported, or at both those times, and
  - (b) to comply with such other conditions as may be specified in the regulations.
- (2) The regulations may, in particular, require a person giving such a notice—
- (a) to pay such fees in respect of the notice as may be specified by the regulations;
  - (b) to give such security as may be so specified in respect of any liability or expense which the Commissioners may incur in consequence of the notice by reason of the detention of any goods or anything done to goods detained;
  - (c) to indemnify the Commissioners against any such liability or expense, whether security has been given or not.
- (3) The regulations may make different provision as respects different classes of case to which they apply and may include such incidental and supplementary provisions as the Commissioners consider expedient.
- (4) Regulations under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.
- (5) Section 17 of the Customs and Excise Management Act 1979 (general provisions as to Commissioners' receipts) applies to fees paid in pursuance of regulations under this section as to receipts under the enactments relating to customs and excise.

## **91 Power of Commissioners of Customs and Excise to disclose information**

Where information relating to infringing goods, material or articles has been obtained by the Commissioners of Customs and Excise for the purposes of, or in connection with, the exercise of their functions in relation to imported goods, the Commissioners may authorise the disclosure of that information for the purpose of facilitating the exercise by any person of any function in connection with the investigation or prosecution of an offence under section 92 below (unauthorised use of trade mark, &c. in relation to goods) or under the Trade Descriptions Act 1968.

### *Offences*

## **92 Unauthorised use of trade mark, &c. in relation to goods**

- (1) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

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- (a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trade mark, or
  - (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign, or
  - (c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- (2) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—
- (a) applies a sign identical to, or likely to be mistaken for, a registered trade mark to material intended to be used—
    - (i) for labelling or packaging goods,
    - (ii) as a business paper in relation to goods, or
    - (iii) for advertising goods, or
  - (b) uses in the course of a business material bearing such a sign for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, or
  - (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- (3) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—
- (a) 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
  - (b) has such an article in his possession, custody or control in the course of a business,
- knowing or having reason to believe that it 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 section unless—
- (a) the goods are goods in respect of which the trade mark is registered, or
  - (b) the trade mark has a reputation in the United Kingdom 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 repute of the trade mark.
- (5) It is a defence for a person charged with an offence under this section to show that he 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 guilty of an offence under this section is liable—
- (a) on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both;
  - (b) on conviction on indictment to a fine or imprisonment for a term not exceeding ten years, or both.

### **93 Enforcement function of local weights and measures authority**

- (1) It is the duty of every local weights and measures authority to enforce within their area the provisions of section 92 (unauthorised use of trade mark, &c. in relation to goods).

- (2) The following provisions of the Trade Descriptions Act 1968 apply in relation to the enforcement of that section as in relation to the enforcement of that Act—
- section 27 (power to make test purchases),
  - section 28 (power to enter premises and inspect and seize goods and documents),
  - section 29 (obstruction of authorised officers), and
  - section 33 (compensation for loss, &c. of goods seized).

- (3) Subsection (1) above does not apply in relation to the enforcement of section 92 in Northern Ireland, but it is the duty of the Department of Economic Development to enforce that section in Northern Ireland.

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

- (4) Any enactment which authorises the disclosure of information for the purpose of facilitating the enforcement of the Trade Descriptions Act 1968 shall apply as if section 92 above were contained in that Act and as if the functions of any person in relation to the enforcement of that section were functions under that Act.
- (5) Nothing in this section shall be construed as authorising a local weights and measures authority to bring proceedings in Scotland for an offence.

#### **94 Falsification of register, &c**

- (1) It is an offence for a person to 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) It is an offence for a person—
- (a) to make or cause to be made anything falsely purporting to be a copy of an entry in the register, or
  - (b) to produce or tender or cause to be produced or tendered in evidence any such thing,
- knowing or having reason to believe that it is false.
- (3) A person guilty of an offence under this section is liable—
- (a) on conviction on indictment, to imprisonment for a term not exceeding two years or a fine, or both;
  - (b) on summary conviction, to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or both.

#### **95 Falsely representing trade mark as registered**

- (1) It is an offence for a person—
- (a) falsely to represent that a mark is a registered trade mark, or
  - (b) to make a false representation as to the goods or services for which a trade mark is registered
- knowing or having reason to believe that the representation is false.
- (2) For the purposes of this section, the use in the United Kingdom in relation to a trade mark—

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- (a) of the word “registered”, or
- (b) of any other word or symbol importing a reference (express or implied) to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the United Kingdom and that the trade mark is in fact so registered for the goods or services in question.

- (3) A person guilty of an offence under this section is liable on summary conviction to a fine not exceeding level 3 on the standard scale.

## **96 Supplementary provisions as to summary proceedings in Scotland**

- (1) Notwithstanding anything in section 331 of the Criminal Procedure (Scotland) Act 1975, summary proceedings in Scotland for an offence under this Act may be begun at any time within six months after the date on which evidence sufficient in the Lord Advocate’s opinion to justify the proceedings came to his knowledge.

For this purpose a certificate of the Lord Advocate as to the date on which such evidence came to his knowledge is conclusive evidence.

- (2) For the purposes of subsection (1) and of any other provision of this Act as to the time within which summary proceedings for an offence may be brought, proceedings in Scotland shall be deemed to be begun on the date on which a warrant to apprehend or to cite the accused is granted, if such warrant is executed without undue delay.

*Forfeiture of counterfeit goods, &c.*

## **97 Forfeiture: England and Wales or Northern Ireland**

- (1) In England and Wales or Northern Ireland where there has come into the possession of any person in connection with the investigation or prosecution of a relevant offence—
  - (a) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trade mark,
  - (b) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, or
  - (c) articles specifically designed or adapted for making copies of such a sign,
 that person may apply under this section for an order for the forfeiture of the goods, material or articles.
- (2) An application under this section may be made—
  - (a) where proceedings have been brought in any court for a relevant offence relating to some or all of the goods, material or articles, to that court;
  - (b) where no application for the forfeiture of the goods, material or articles has been made under paragraph (a), by way of complaint to a magistrates' court.
- (3) On an application under this section the court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that a relevant offence has been committed in relation to the goods, material or articles.
- (4) A court may infer for the purposes of this section that such an offence has been committed in relation to any goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are

representative of them (whether by reason of being of the same design or part of the same consignment or batch or otherwise).

- (5) Any person aggrieved by an order made under this section by a magistrates' court, or by a decision of such a court not to make such an order, may appeal against that order or decision—
- (a) in England and Wales, to the Crown Court;
  - (b) in Northern Ireland, to the county court;
- and an order so made may contain such provision as appears to the court to be appropriate for delaying the coming into force of the order pending the making and determination of any appeal (including any application under section 111 of the Magistrates' Courts Act 1980 or Article 146 of the Magistrates' Courts (Northern Ireland) Order 1981 (statement of case)).
- (6) Subject to subsection (7), where any goods, material or articles are forfeited under this section they shall be destroyed in accordance with such directions as the court may give.
- (7) On making an order under this section the court may, if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall (instead of being destroyed) be released, to such person as the court may specify, on condition that that person—
- (a) causes the offending sign to be erased, removed or obliterated, and
  - (b) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.
- (8) For the purposes of this section a “relevant offence” means an offence under section 92 above (unauthorised use of trade mark, &c. in relation to goods) or under the Trade Descriptions Act 1968 or any offence involving dishonesty or deception.

## **98 Forfeiture: Scotland**

- (1) In Scotland the court may make an order for the forfeiture of any—
- (a) goods which bear, or the packaging of which bears, a sign identical to or likely to be mistaken for a registered trade mark,
  - (b) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, or
  - (c) articles specifically designed or adapted for making copies of such a sign.
- (2) An order under this section may be made—
- (a) on an application by the procurator-fiscal made in the manner specified in section 310 of the Criminal Procedure (Scotland) Act 1975, or
  - (b) where a person is convicted of a relevant offence, in addition to any other penalty which the court may impose.
- (3) On an application under subsection (2)(a), the court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that a relevant offence has been committed in relation to the goods, material or articles.
- (4) The court may infer for the purposes of this section that such an offence has been committed in relation to any goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are

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

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- representative of them (whether by reason of being of the same design or part of the same consignment or batch or otherwise).
- (5) The procurator-fiscal making the application under subsection (2)(a) shall serve on any person appearing to him to be the owner of, or otherwise to have an interest in, the goods, material or articles to which the application relates a copy of the application, together with a notice giving him the opportunity to appear at the hearing of the application to show cause why the goods, material or articles should not be forfeited.
- (6) Service under subsection (5) shall be carried out, and such service may be proved, in the manner specified for citation of an accused in summary proceedings under the Criminal Procedure (Scotland) Act 1975.
- (7) Any person upon whom notice is served under subsection (5) and any other person claiming to be the owner of, or otherwise to have an interest in, goods, material or articles to which an application under this section relates shall be entitled to appear at the hearing of the application to show cause why the goods, material or articles should not be forfeited.
- (8) The court shall not make an order following an application under subsection (2)(a)—
- (a) if any person on whom notice is served under subsection (5) does not appear, unless service of the notice on that person is proved; or
  - (b) if no notice under subsection (5) has been served, unless the court is satisfied that in the circumstances it was reasonable not to serve such notice.
- (9) Where an order for the forfeiture of any goods, material or articles is made following an application under subsection (2)(a), any person who appeared, or was entitled to appear, to show cause why goods, material or articles should not be forfeited may, within 21 days of the making of the order, appeal to the High Court by Bill of Suspension; and section 452(4)(a) to (e) of the Criminal Procedure (Scotland) Act 1975 shall apply to an appeal under this subsection as it applies to a stated case under Part II of that Act.
- (10) An order following an application under subsection (2)(a) shall not take effect—
- (a) until the end of the period of 21 days beginning with the day after the day on which the order is made; or
  - (b) if an appeal is made under subsection (9) above within that period, until the appeal is determined or abandoned.
- (11) An order under subsection (2)(b) shall not take effect—
- (a) until the end of the period within which an appeal against the order could be brought under the Criminal Procedure (Scotland) Act 1975; or
  - (b) if an appeal is made within that period, until the appeal is determined or abandoned.
- (12) Subject to subsection (13), goods, material or articles forfeited under this section shall be destroyed in accordance with such directions as the court may give.
- (13) On making an order under this section the court may if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall (instead of being destroyed) be released, to such person as the court may specify, on condition that that person causes the offending sign to be erased, removed or obliterated.
- (14) For the purposes of this section—



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“relevant offence” means an offence under section 92 (unauthorised use of trade mark, &c. in relation to goods) or under the Trade Descriptions Act 1968 or any offence involving dishonesty or deception,

“the court” means—

- (a) in relation to an order made on an application under subsection (2)(a), the sheriff, and
- (b) in relation to an order made under subsection (2)(b), the court which imposed the penalty.