
STATUTORY INSTRUMENTS

1994 No. 2803

TRADE MARKS

The Trade Marks (Claims to Priority
from Relevant Countries) Order 1994

Made - - - - *2nd November 1994*
Laid before Parliament *14th November 1994*
Coming into force - - *5th December 1994*

At the Court at Buckingham Palace, the 2nd day of November 1994

Present,

The Queen's Most Excellent Majesty in Council

Her Majesty, in exercise of the powers conferred upon Her by section 36(1) and (2) of the Trade Marks Act 1994⁽¹⁾, is pleased, by and with the advice of Her Privy Council, to order, and it is hereby ordered, as follows:—

1. This Order may be cited as the Trade Marks (Claims to Priority from Relevant Countries) Order 1994 and shall come into force on 5th December 1994.

2. In this Order—

“the Act” means the Trade Marks Act 1994;

“duly filed” means a filing which is adequate to establish the date on which the application was filed in the relevant country in question, whatever may be the subsequent fate of the application; and

“relevant country” means any country or territory specified in the Schedule to this Order.

3. A person who has duly filed an application for the protection of a trade mark in a relevant country shall have a right to priority, for the purpose of registering the same trade mark under the Act for some or all of the same goods or services, for a period of six months from the date of filing of the application in that country.

4. Where the application for registration under the Act is made within the aforesaid period of six months—

(a) the relevant date for the purpose of establishing which rights take precedence shall be the date of the filing of the application in the relevant country, and

- (b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under the Act.

5. A subsequent application concerning the same subject as the first application, duly filed in the same relevant country, shall be considered the first application to be filed in that country (of which the filing date shall be the starting date of the period of priority) if at the time of the subsequent application—

- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and
- (b) it has not yet served as a basis for claiming a right of priority.

6. A previous application may not serve as a basis for claiming a right of priority where a subsequent application is considered, in accordance with article 5 above, as the first application to be duly filed.

7. A right to priority conferred by this Order—

- (a) shall (unless otherwise stated in the application) vest in the person filing the application or his successor in title; and
- (b) may be assigned or otherwise transmitted, either with the application or independently.

8.—(1) Where a right to priority is claimed by reason of an application to which this Order relates, particulars of that claim shall be included in the application for registration filed under the Act and, unless a certificate as is referred to in paragraph (2) below is filed with the application, such particulars shall include the relevant country and the date of filing.

(2) There shall be filed within three months of the filing of the application for registration under the Act a certificate by the registering or other competent authority of the relevant country certifying, or verifying to the satisfaction of the registrar—

- (a) the date of the filing of the application,
- (b) the relevant country or registering or competent authority,
- (c) the representation of the mark, and
- (d) the goods or services covered by the application.

N. H. Nicholls
Clerk of the Privy Council

SCHEDULE

Article 2

RELEVANT COUNTRIES

Ecuador

Hong Kong

EXPLANATORY NOTE

(This note is not part of the Order)

This Order specifies, pursuant to section 36 of the Trade Marks Act 1994 (“the Act”), the countries or territories listed in the Schedule as relevant countries (being countries which are not Convention countries) in which an application for registration of a trade mark will confer priority in respect of an application for the registration of the trade mark in the United Kingdom. The period within which the claim to priority must be made is six months from the date of filing of the application in the relevant country.

Articles 4 to 7 of the Order make provisions corresponding to subsections (2), (4), (5) and (6) of section 35 of the Act, which confers the right to priority in respect of applications filed in Convention countries, that is to say, countries which are parties to the Paris Convention for the Protection of Industrial Property of 20th March 1883, as amended.

Countries, whether Convention countries or not, in which an application for registration of a trade or service mark conferred a right to priority in respect of an application for registration made in the United Kingdom were required to be specified by Order in Council under section 39A of the Trade Marks Act 1938 (c. 22). The Trade Marks and Service Marks (Relevant Countries) Order 1986 (S.I.1986/1303, as amended by S.I. 1986/1890 and 2236, 1987/170, 1988/1856, 1990/2593, 1992/2672 and 1993/1258), which specified such countries, ceased to have effect in relation to Convention countries upon the coming into force of section 35 of the Act.