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STATUTORY INSTRUMENTS

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**2013 No. 2601**

**TRADE MARKS**

**The Trade Marks (Isle of Man) Order 2013**

*Made - - - - 9th October 2013*

*Coming into force - - 11th November 2013*

At the Court at Buckingham Palace, the 9th day of October 2013

Present,

The Queen's Most Excellent Majesty in Council

Her Majesty, in exercise of the powers conferred on Her by 108(2) of the Trade Marks Act 1994<sup>(1)</sup>, is pleased, by and with the advice of Her Privy Council, to make the following Order:

**Citation and commencement**

1. This Order may be cited as the Trade Marks (Isle of Man) Order 2013 and shall come into force on 11th November 2013.

**Exceptions to and modifications of the Trade Marks Act 1994 in its application to the Isle of Man**

2. The Trade Marks Act 1994 shall, in its application to the Isle of Man, have effect subject to the exceptions and modifications specified in the Schedule to this Order.

**Revocation**

3. The following instruments are revoked—

- (a) the Trade Marks Act 1994 (Isle of Man) Order 1996<sup>(2)</sup>;
- (b) the Trade Marks Act 1994 (Isle of Man) (Amendment) Order 2002<sup>(3)</sup>;
- (c) the Trade Marks Act 1994 (Isle of Man) (Amendment) Order 2004<sup>(4)</sup>.

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(1) 1994 c.26.  
(2) S.I. 1996/729.  
(3) S.I. 2002/3148.  
(4) S.I. 2004/1497.

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*Richard Tilbrook*  
Clerk of the Privy Council

## SCHEDULE

## Article 2

Exceptions to and modifications of the Trade Marks Act 1994 in its application to the Isle of Man

1.—(1) Any reference to an Act of Parliament (including the Trade Marks Act 1994) or to a provision of such an Act shall be construed as a reference to that Act or provision as it has effect in the Isle of Man.

(2) Any reference to an Act of Tynwald shall be construed as a reference to it as amended or replaced by or under any other such enactment.

2. In section 3(4) (absolute grounds for refusal), for “Community law” substitute “EU law”.

3. In section 5(3) (relative grounds for refusal)—

(a) omit paragraph (b) and the word “and” immediately before it;

(b) for “, in the European Community” substitute “or international trade mark (EC), in the European Union”.

4. In section 6(1) (meaning of “earlier trade mark”)—

(a) in paragraph (a), for “or Community trade mark” substitute “, Community trade mark or international trade mark (EC)”;

(b) for paragraph (b) substitute—

“(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),

(ba) a registered trade mark or international trade mark (UK) which—

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or”;

(c) in paragraph (c), after “Paris Convention” insert “or the WTO agreement”.

5. After section 6 insert—

### **“Raising of relative grounds in opposition proceedings in case of non-use**

6A.—(1) This section applies where—

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if—

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
  - (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
  - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—
  - (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
  - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”.
- 6. In section 10(3) (infringement of registered trade mark)—
  - (a) after “course of trade” insert “, in relation to goods or services,”;
  - (b) omit paragraph (b) and the word “and” immediately before it.
- 7. After section 14(2) (action for infringement) insert—
  - “(2A) Where in an action for infringement of a registered trade mark it is shown that the defendant knew, or had reason to believe, that he was committing an infringement, the damages awarded to the claimant shall be appropriate to the actual prejudice he suffered as a result of the infringement.
  - (2B) The court—
    - (a) in awarding such damages shall take into account all appropriate aspects, including in particular—
      - (i) the negative economic consequences, including any lost profits, which the claimant has suffered;
      - (ii) any unfair profits made by the defendant; and
      - (iii) elements other than economic factors, including the moral prejudice caused to the claimant by the infringement; or
    - (b) may where appropriate award such damages on the basis of the royalties or fees which would have been due had the defendant obtained a licence.”.
- 8. In section 17(3), for “Community” substitute “EU”.
- 9. In section 18(3) (period after which remedy of delivery up not available), at the end insert—
  - “(d) in the Isle of Man, has the same meaning as in the Limitation Act 1984 (an Act of Tynwald)(5).”.

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(5) 1984 c.18 (Isle of Man).

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**10.** In section 19(6) (order as to disposal of infringing goods etc.), for the words from “this section or” onwards substitute—

- “(a) this section (including that section as applied to Community trade marks by any statutory provision having effect in the Isle of Man);
- (b) section 24D of the Registered Designs Act 1949<sup>(6)</sup>;
- (c) section 113 of the Copyright Act 1991 (an Act of Tynwald)<sup>(7)</sup>;
- (d) section 19 of the Design Right Act 1991 (an Act of Tynwald)<sup>(8)</sup>;
- (e) section 26 of the Performers’ Protection Act 1996 (an Act of Tynwald)<sup>(9)</sup>; or
- (f) any corresponding statutory provision relating to Community designs and having effect in the Isle of Man.”.

**11.** In section 25(4) (registration of transactions), for the words from “then unless” onwards substitute—

“and the mark is infringed before the prescribed particulars of the transaction are registered, in proceedings for such an infringement, the court shall not award him costs unless—

- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date, or
- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter.”.

**12.** In section 40 (registration), in subsection (1), for the words from “since he accepted” onwards substitute “since the application was accepted that the registration requirements (other than those mentioned in section 5(1), (2) or (3)) were not met at that time.”.

**13.** In section 47 (grounds for invalidity of registration), after subsection (2) insert—

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

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

(2B) The use conditions are met if—

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

(2C) For these purposes—

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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(6) 1949 c.88. Section 24D is inserted in the Registered Designs Act 1949, as that Act has effect in the Isle of Man, by the Registered Designs (Isle of Man) Order 2013 (S.I. 2013/1234) Schedule 1 paragraph 28.

(7) 1991 c.8 (Isle of Man).

(8) 1991 c.9 (Isle of Man).

(9) 1996 c.12 (Isle of Man).

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(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).”.

**14.** Omit section 52 (power to make provision in connection with Community Trade Mark Regulation).

**15.** In section 53 (the Madrid Protocol), at the appropriate place insert—

““international trade mark (EC)” means a trade mark which is entitled to protection in the European Union under that Protocol;”.

**16.** In section 55(1) (the Paris Convention)—

(a) in paragraph (a), at the end omit “and”;

(b) after paragraph (a) insert—

“(aa) “the WTO agreement” means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994, and”;

(c) in paragraph (b), at the end insert “or to that Agreement”.

(2) In section 55(2), after “Paris Convention” insert “or the WTO agreement”.

**17.** In sections 56(1) and (2) (protection of well-known trade marks), 57(2) and (3) (national emblems etc. of Convention countries) and 58(2) (emblems etc. of certain international organisations), after “Paris Convention” insert “or the WTO agreement”.

**18.** In section 59 (notification under Article 6ter of the Convention), at the end insert—

“(5) Any reference in this section to Article 6ter of the Paris Convention shall be construed as including a reference to that Article as applied by the WTO agreement.”.

**19.** Omit section 61 (stamp duty).

**20.** In section 68(2) (costs and security for costs), at the end insert—

“(c) in the Isle of Man, in the same way as an order of the court.”.

**21.** In section 75 (the court)—

(a) in paragraph (a), at the end omit “and”;

(b) after paragraph (b) insert—

“and

(c) in the Isle of Man, the High Court of Justice of the Isle of Man.”.

**22.** In section 77(2) (persons appointed to hear appeals), after paragraph (b) insert—

“(ba) he is an advocate in the Isle of Man of at least 5 years’ standing;”.

**23.** In section 83A(7)(10) (regulation of trade mark attorneys), in paragraph (a) of the definition of “trade mark agency work”, after “United Kingdom” insert “or elsewhere”.

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(10) Section 83A was inserted by section 184(1) and (3) of the Legal Services Act 2007(c.29) and amended by article 2 of S.I. 2009/3339.

**24.** In section 86(2) (use of the term “trade mark attorney”), after “1980” insert “, section 1 of the Legal Practitioners Registration Act 1986 (an Act of Tynwald)(**11**)”.

**25.** In section 87(2)(**12**) (privilege for communications), for “solicitor” substitute “advocate”.

**26.—**(1) In section 89(1) (infringing goods etc. may be treated as prohibited goods)—

- (a) for “Commissioners of Customs and Excise” substitute “Treasury”;
- (b) in paragraph (b), for “United Kingdom” substitute “Isle of Man”;
- (c) in paragraph (c), for “Commissioners” substitute “Treasury”.

(2) For section 89(3) substitute—

“(3) This section does not apply to goods placed in, or expected to be placed in, one of the situations referred to in Article 1(1), in respect of which an application may be made under Article 5(1), of Council Regulation (EC) No.1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights(**13**).

(4) In this section and sections 90 and 91, “the Treasury” means the Department of that name established under the Government Departments Act 1987 (an Act of Tynwald)(**14**).”.

**27.—**(1) In the side note to section 90 (powers of Commissioners to make regulations) and in section 90(1), (2) and (3), for “Commissioners of Customs and Excise” and “Commissioners” (in each place) substitute “Treasury”.

(2) For section 90(4) substitute—

“(4) Regulations under this section shall not have effect unless they are approved by Tynwald.”.

**28.** In section 91(**15**) (power of Commissioners to disclose information)—

- (a) in the side note, for “Commissioners for Revenue and Customs” substitute “Treasury”;
- (b) for “Commissioners for Her Majesty’s Revenue and Customs” substitute “Treasury”;
- (c) for “functions of Her Majesty’s Revenue and Customs” substitute “its functions”;
- (d) for “Commissioners may authorise” substitute “Treasury may authorise”;
- (e) for “Trade Descriptions Act 1968” substitute “Consumer Protection (Trade Descriptions) Act 1970 (an Act of Tynwald)(**16**)”.

**29.** In section 92(6) (unauthorised use of trade mark, &c in relation to goods)—

- (a) for “imprisonment” (in each place) substitute “custody”;
- (b) in paragraph (a), for “the statutory maximum” substitute “the prescribed sum within the meaning of section 32 of the Magistrates’ Courts Act 1980(**17**)”;
- (c) in paragraph (b), for “indictment” substitute “information”.

**30.—**(1) After section 92A(2)(**18**) insert—

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(11) 1986 c.15 (Isle of Man).

(12) Section 87(2) was inserted by section 208(1) of and paragraphs 109 and 113 to Schedule 21 to the Legal Services Act 2007 (c.29).

(13) O.J. No. L195, 2.6.2003, p.7.

(14) 1987 c.13 (Isle of Man).

(15) Section 91 was amended by section 50(6) of and paragraph 58 of Schedule 4 to the Commissioners for Revenue and Customs Act 2005 (c.11).

(16) 1970 c.2 (Isle of Man).

(17) 1980 c.43.

(18) Section 92A was inserted by section 6 of the Copyright, etc. and Trade Marks (Offences and Enforcement) Act 2002 (c.25).

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“(2A) The power conferred by subsection (1) does not, in the Isle of Man, extend to authorising a search for material of the kinds mentioned in section 10(2) of the Police Powers and Procedures Act 1988 (an Act of Tynwald)(19) (certain classes of personal or confidential material).”.

(2) In section 92A(3)(b), for “28 days” substitute “3 months”.

**31.** Omit section 93 (enforcement function of local weights and measures authority).

**32.** In section 94(3) (falsification of register)—

- (a) for “imprisonment” (in each place) substitute “custody”;
- (b) in paragraph (a), for “indictment” substitute “information”;
- (c) in paragraph (b), for “the statutory maximum” substitute “the prescribed sum within the meaning of section 32 of the Magistrates’ Courts Act 1980”.

**33.—**(1) In section 97 (forfeiture: England and Wales or Northern Ireland), in the side note and subsection (1), for “or Northern Ireland” substitute “, Northern Ireland or the Isle of Man”.

(2) In section 97(2)(b), after “magistrates’ court” insert “or, in the Isle of Man, a court of summary jurisdiction”.

(3) In section 97(5)—

- (a) after “magistrates’ court” insert “or, in the Isle of Man, a court of summary jurisdiction,”;
- (b) after paragraph (b) insert—
  - “(c) in the Isle of Man, to the court.”;
- (c) after “1981” insert “or section 109 of the Summary Jurisdiction Act 1989 (an Act of Tynwald)(20)”.

(4) In section 97(8), for “Trade Descriptions Act 1968” substitute “Consumer Protection (Trade Descriptions) Act 1970 (an Act of Tynwald)”.

**34.** In section 101(2)(b) (offences committed by partnerships and bodies corporate)—

- (a) for “or Northern Ireland” substitute “, Northern Ireland or the Isle of Man”;
- (b) after “1981” insert “or section 32 of the Summary Jurisdiction Act 1989 (an Act of Tynwald)”.

**35.** In section 103(3) (minor definitions) for “a Community instrument” substitute “an EU instrument”.

**36.** In the table in section 104 (index of defined expressions), at the appropriate places insert—

“international trade mark (EC)	section 53”;
“the Treasury	section 89(4)”.

**37.—**(1) Omit section 106 (consequential amendments and repeals) and Schedules 4 and 5.

(2) Sub-paragraph (1), and the revocation (by article 3) of the Trade Marks Act 1994 (Isle of Man) Order 1996, do not affect any amendment or repeal effected by section 106 and Schedules 4 and 5 before the coming into operation of this Order.

(19) 1998 c.9 (Isle of Man).  
 (20) 1989 c.15 (Isle of Man).



**38.** In Schedule 1, in paragraph 11(c) for “Commissioners of Customs and Excise” substitute “the Treasury”.

**39.** In Schedule 2, in paragraph 13(c) for “Commissioners of Customs and Excise” substitute “the Treasury”.

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### EXPLANATORY NOTE

*(This note is not part of the Order)*

This Order modifies the Trade Marks Act 1994 in its application to the Isle of Man. It replaces the Trade Marks Act 1994 (Isle of Man) Order 1996 ([S.I. 1996/729](#)) as amended, and makes additional modifications to correspond to the amendments made to the Act (as it has effect in the United Kingdom) by the Trade Marks (International Registrations Designating the European Community, etc.) Regulations 2004 ([S.I. 2004/2332](#)), the Serious and Organised Crime and Police Act 2005 ([c.15](#)), the Intellectual Property (Enforcement, etc.) Regulations 2006 ([S.I. 2006/1028](#)), the Trade Marks (Earlier Trade Marks) Regulations 2008 ([S.I. 2008/1067](#)) and the Legal Services Act 2007 (Functions of an Approved Regulator) Order 2009 ([S.I. 2009/3339](#)).