

**TRADE MARKS ACT****Principal Act**

<b>Act. No. 1948-31</b>	<i>Commencement</i>	1.1.1949
	<i>Assent</i>	24.8.1948

Amending enactment	Relevant current provisions	Commencement date
Act. 1965-15	s. 2A	
1980-04	s. 2A	
1987-12	s. 2	2.4.1987
2007-17	ss. 2A(1), (2), 16	14.6.2007
2020-13	Long title, ss. 2-3, 16-19	1.1.2021

## English source

Trade Mark Act 1938 (1 &amp; 2 Geo..6 c.22)

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AN ACT TO MAKE PROVISION FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS OR TO GIVE EFFECT TO SUCH TRADE MARKS; TO IMPLEMENT, IN PART, THE MADRID PROTOCOL ADOPTED AT MADRID ON 27<sup>TH</sup> JUNE 1989, AS AMENDED, SUPPLEMENTED OR REVISED FROM TIME TO TIME, AND FOR CONNECTED PURPOSES.

**PART 1**

**INTRODUCTORY**

**Short title.**

1. This Act may be cited as the Trade Marks Act.

**Interpretation.**

2. In this Act, unless the context otherwise requires,—

“goods” includes “services”;

“international trade mark (UK)” means a trade mark entitled to protection in the United Kingdom which results from an international application made on or after 1 January 2021 for registration under the Madrid Protocol and designates the United Kingdom;

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27th June 1989, as amended, supplemented or revised from time to time;

“register” means the Register of Trade Marks required to be kept under this Act.

“service mark” means a mark (including a device, name, signature, word, letter, numeral or any combination thereof) used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person;

“trade mark” includes service mark.

“Trade Marks Act 1994” means the United Kingdom’s Trade Marks Act 1994 as amended or substituted from time to time.

**PART 2****REGISTRATION OF TRADE MARKS****Appointment of Registrar.**

2A.(1) The Minister responsible for trade shall appoint a fit and proper person to the Registrar of Trade Marks (hereinafter referred to as the Registrar) for the purposes of this Act.

(2) The Minister responsible for trade may appoint one or more assistant registrars of trade marks, and any assistant registrar so appointed may, subject to any directions given to him by the Registrar, exercise all the powers and perform all the duties of the Registrar.

**Application for registration.**

3. Subject to Part 3, any person being the registered proprietor of a trade mark in the United Kingdom by virtue of an entry in the register of trade marks kept under the Trade Marks Act 1994 or any person deriving title from such registered proprietor by assignment or other mode of transfer, may apply at any time during the existence of the registration in the United Kingdom to have such trade mark registered in Gibraltar in respect of some or all of the goods comprised in the United Kingdom registration.

**Procedure on application.**

4. An application for registration of a trade mark under this Act shall be made to the Registrar\* and accompanied by a certified representation of the trade mark and a certificate of the Comptroller General of the United Kingdom Patent Office (under his title of Registrar of Trade Marks) giving full particulars of the registration of the trade mark in the United Kingdom and such other documents as may from time to time be prescribed.

**Issue of certificate.**

5. Upon such application being lodged, together with the documents mentioned in section 4, the Registrar shall enter the prescribed particulars in the register and shall issue a certificate of registration to the applicant who shall then be the registered proprietor in Gibraltar of the trade mark in respect of the goods entered in the register.

**Privileges of proprietor.**

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\* LN 1993/056 Trade Marks Registry (Location of Office) Notice, 1993.

6. Subject to the provisions of this Act, a registered proprietor shall have in Gibraltar such privileges and rights in the use of the trade mark in respect of the goods entered in the register as mutatis mutandis would be conferred on him by the law for the time being in force in the United Kingdom.

**Duration of privileges.**

7. The privileges and rights conferred by section 6 shall date from the date of registration in the United Kingdom and shall continue in force, subject to the provisions of section 14, for so long as the registration in the United Kingdom remains in force in respect of the goods for which the trade mark is registered in Gibraltar:

Provided that no action for infringement of the trade mark shall be entertained in respect of any use of the trade mark prior to the date of issue of the certificate of registration in Gibraltar.

**Right of action for passing off.**

8. Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as those of another person or any remedy in respect thereof.

**Powers of Supreme Court.**

9. The Supreme Court shall have power, upon the application of any person who alleges that his interests have been prejudicially affected by the issue of a certificate of registration, to declare on any of the grounds mutatis mutandis on which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom that the exclusive privileges and rights have not been acquired.

**Assignment of privileges.**

10. Subject to the provisions of this Act, where a person becomes entitled by assignment or other mode of transfer to the privileges and rights conferred by a certificate of registration issued under this Act, the Registrar shall, on application being made in the prescribed manner, and on proof of title to his satisfaction, cause such person to be entered on the register as subsequent registered proprietor of the trade mark.

**Application by registered user.**

11. Any person entered in the United Kingdom Register of Trade Marks under section 28 of the Trade Marks Act, 1938, as a registered user in respect of any goods of a trade mark in respect of which a certificate of registration under this Act is in force, may apply to be registered in Gibraltar

as a registered user of the mark in respect of some or all of such goods, subject to any conditions or restrictions entered in the United Kingdom Register.

**Entry in register.**

12. Upon such application being lodged together with a certificate of the United Kingdom Registrar of Trade Marks giving full particulars of the entry in the United Kingdom Register under section 28, the Registrar shall cause the applicant to be entered in the register of Gibraltar as a registered user of the trade mark, and on such entry the registered user shall be entitled in Gibraltar, subject to the aforesaid conditions and restrictions, to such privileges and rights in respect of the goods for which he is entered as *mutatis mutandis* would be conferred on him by the law for the time being in force in the United Kingdom.

**Keeping and inspection of register.**

13. (1) There shall be kept in the Registrar's office a register in which shall be entered in the prescribed form all matters which are by this Act required to be registered.

(2) Such register shall be open to inspection at all hours during which the Registrar's office is open.

**Renewal of registration.**

14.(1) If the registration in the United Kingdom of a trade mark registered under this Act, is renewed, the registered proprietor may, within three months after the date of renewal in the United Kingdom or such further period as may be prescribed, notify the Registrar who shall then, on sufficient evidence thereof and on payment of the prescribed fee, renew the registration in the register in the prescribed manner.

(2) If the registration in the register is not so renewed it shall be cancelled by the Registrar.

**Powers of Registrar.**

15. The Registrar may, on request in writing made by the registered proprietor, and on payment of the prescribed fee—

- (a) cancel the registration of a trade mark or of a registered user thereunder either wholly or as regards any particular goods in respect of which the trade mark or the registered user is registered;

- (b) correct any clerical error in or in connection with any application under this Act or in any matter which is entered in the register;
- (c) enter in the register any change in the name, description or address of the person who is registered as proprietor or user of a trade mark.

#### **Powers of the Minister responsible for trade.**

16. The Minister responsible for trade may make such rules and do such things as he may deem expedient, subject to the provisions of this Act, for regulating procedure under this Act, and prescribing the fees to be paid in respect of proceedings under this Act, for prescribing anything which by this Act is to be prescribed, and generally for giving effect to the provisions of this Act..

### **PART 3**

#### **INTERNATIONAL TRADE MARKS**

##### **International Mark (UK).**

17.(1) The registered proprietor of an international trade mark (UK) shall enjoy in Gibraltar the like privileges and rights as though the certificate of registration of the international trade mark (UK) had been issued with an extension to Gibraltar.

(2) The privileges and rights conferred by subsection (1) shall continue in force only for so long as the registration in the United Kingdom remains in force.

##### **Comparable Trade Mark (EU) and (UK).**

18.(1) The registered proprietor of a trade mark registered in the United Kingdom as a comparable trade mark (EU) or a comparable trade mark (IR) under the Trade Marks Act 1994 shall enjoy in Gibraltar the like privileges and rights as though the registration in the United Kingdom had been extended to Gibraltar, until the date of expiry of the registration of such trade mark.

(2) The privileges and rights conferred by subsection (1) shall continue in force only for so long as the registration of the comparable trade mark (EU) or the comparable trade mark (IR), as the case may be, in the United Kingdom remains in force.

(3) This section shall not affect any trade mark registered in the register prior to the coming into force of this section.

**Regulations.**

19.(1) The Minister responsible for trade may by regulations-

- (a) make provision for the purpose of implementing, or further implementing, in Gibraltar an international agreement or convention or any other international obligation concerned with trade marks;
- (b) make such provision as the Minister considers necessary or expedient in relation to any trade mark which has been registered prior to 1 January 2021;
- (c) make such transitional, transitory or saving provision as the Minister considers appropriate in connection with the coming into force of any provision of this Act.