

STATES OF JERSEY



Jersey

DRAFT TRADE MARKS (JERSEY) LAW 202-

Lodged au Greffe on 14th October 2025
by the Minister for External Relations
Earliest date for debate: 25th November 2025

STATES GREFFE



DRAFT TRADE MARKS (JERSEY) LAW 202-

European Convention on Human Rights

In accordance with the provisions of Article 16 of the Human Rights (Jersey) Law 2000, the Assistant Minister for External Relations has made the following statement –

In the view of the Assistant Minister for External Relations, the provisions of the Draft Trade Marks (Jersey) Law 202- are compatible with the Convention Rights.

Signed: **Deputy M.R. Scott of St. Brelade**
Assistant Minister for External Relations

Dated: 13th October 2025

REPORT

Introduction

The draft Trade Marks (Jersey) Law 202- (the **draft Law**) is the first and larger of two items of draft legislation which the States Assembly will be asked to adopt concerning the recording of intellectual property (**IP**) rights in Jersey.

Firstly, this draft Law would provide for the introduction of a new system of primary registration of trade marks in Jersey, in place of the current re-registration system of United Kingdom (**UK**) registered marks. Secondly, a separate piece of legislation will make provision for the establishment of a new register of IP rights to be operated by the Jersey Financial Services Commission. This will be brought to the Assembly for Members' consideration imminently.

Overview

IP rights protect and incentivise the development and distribution of new products and the provision of new services based on the creation and exploitation of trade marks, designs, patents, creative content or other intangible assets. IP rights are therefore a key business asset for companies of all sizes, but are particularly important for small businesses and start-ups to establish brand recognition and differentiation in increasingly competitive markets and provide them with powerful tools to compete with larger and established companies.

Ensuring that Jersey's IP laws are modern and consistent with international standards is important for economic growth and is, therefore, an important policy objective for the Government of Jersey to encourage businesses of many types to locate and invest in the Island. Additionally, the Island's IP legislation must meet recognised international standards for Jersey to be included in, and derive benefit from, the main international IP treaties, in turn enhancing the Island's international reputation.

Jersey's legislation already recognises and protects various types of IP which enable right holders to be recognised and derive financial benefit from their inventions or creations. As its title suggests, the draft Law specifically deals with trade marks.

If adopted, the draft Law will introduce a new, modern and familiar system of primary trade mark registration in Jersey and will repeal and replace the [Trade Marks \(Jersey\) Law 2000](#) (the **2000 Law**). Furthermore, it will ensure compliance of Jersey law with the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the **Madrid Protocol**). This is a key international trade mark agreement that streamlines the process of international trade mark registration in a large number of jurisdictions worldwide.

The draft Law largely is modelled on the framework set out in the UK Trade Marks Act 1994, which is highly regarded and widely understood internationally. The draft Law also fully aligns with work undertaken in the Future Economy Programme to ensure that the right conditions are set for sustainable economic growth for the whole economy and to add to its vibrancy. This, in turn makes the Island a more attractive place to live and work.

Background

A trade mark is a sign that is capable of distinguishing the goods and services of one business from those of other businesses. Signs like logos, names, colours, and shapes can all be protected by a trade mark, giving the owner exclusive rights as to how their brand is represented and protection against unauthorised use. The essential function of a trade mark therefore is "to guarantee the identity of the origin of the trade-marked product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products

which have another origin”.¹ As such, they are amongst the most valuable assets a business can own to help it:

- establish brand recognition and differentiation, enabling consumers to identify the business;
- build consumer trust and a positive reputation;
- protect its rights and prevent unauthorised use of its brand by others;
- stand out from the competition to expand into new markets and attract more consumers;
- add overall value to the business, for example by licensing the brand or attracting buyers.

In view of the importance of trade marks to businesses, it is essential that Jersey keeps its IP legislation fit for purpose and addresses any concerns in this area. Tera Allas emphasised this specific point in her 2015 *Jersey Innovation Review*.² Amongst other things, she recommended that the Government should “engage with industry to identify any constraints to innovation resulting from the existing system of intellectual property protection and take measures to address any outstanding issues”.

Current legislative framework

If adopted, the draft Law will repeal the 2000 Law and replace it with new provisions putting trade mark registration in Jersey on a new and more modern basis.

Under the 2000 Law, the person who is the proprietor of the right in the UK is the person who can apply for re-registration in Jersey. There is no examination of the UK right, but in each case the secondary registration in Jersey can only remain in force so long as the right remains in force in the UK. A registration of a trade mark under the 2000 Law essentially gives that person the same rights and equivalent remedies as exist in the UK. In addition, so-called ‘international trade marks’, that have effect in the UK, automatically apply in Jersey as a result of the 2000 Law. In these cases, there is no need for re-registration in order to obtain protection locally.

In responses to the consultation on the *Proposal for a Primary Trade Mark Registry*,³ stakeholders, across the board, expressed views that the current system of secondary trade mark registration in Jersey is not fit for purpose and needs to be overhauled in order to achieve international recognition as a jurisdiction that takes IP rights seriously. There was widespread support for the proposal to introduce a new system of primary trade mark registration, which was described as a much-needed step forward to modernise trade mark legislation in Jersey and promote the Island as an international business and finance centre.

International treaties

An important driver behind the draft Law relates to Jersey’s longstanding dedication to the implementation of international standards, which is a cornerstone of the Island’s reputation in the international community.

In the IP area, Members will recall the adoption by the Assembly of the Patents Law and Registered Designs Law (Jersey) Amendment Regulations 2024⁴ in September 2024 as part of Jersey’s programme of IP modernisation. These Regulations ensured compliance of Jersey law with both the Patent Cooperation Treaty (the **PCT**) and the Geneva Act (1999) of the Hague Agreement Concerning the International Registration of Industrial Designs (the **Hague**

¹ See Case 102/77 Hoffmann-La Roche & Co. AG v Centrafarm (1978) ECR 1139.

² [Jersey Innovation Review](#).

³ [Intellectual Property: proposal for a Primary Trade Mark Registry](#).

⁴ [P.48/2024](#).

Agreement). Whilst the subject matter of both international treaties is quite different, their purpose is very similar. Namely, to create international systems allowing users to seek IP protection in a large number of countries by filing a single ‘international’ application.

With regard to trade marks, it must be noted that the current system of re-registration is not considered fully compatible with the application of a number of key international treaties in this area. In particular, the existing framework does not enable Jersey to seek inclusion in, and benefit from, the Madrid Protocol.

The Madrid Protocol is an international agreement designed to simplify the registration process of trade marks worldwide. As such, the nature of the Madrid Protocol is similar to the PCT and Hague Agreement. By filing a single international trade mark application and by paying one set of fees, trade mark protection can be applied for in up to 131 countries.⁵ The Madrid Protocol therefore offers a convenient and cost-effective ‘one-stop-shop’ solution for registering and managing trade marks globally. Inclusion in the Madrid Protocol will make Jersey more attractive for foreign investment. It would also assist any local businesses wishing to obtain trade mark protection in other jurisdictions.

Together with the secondary legislation needed for the smooth and efficient operation of the new framework (see below), adoption of the draft Law will also enable Jersey to be part of the trade mark classification system under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (the **Nice Agreement**). This agreement creates a system for classifying goods and services for trade mark registration. This classification is used by trade mark offices worldwide to organise trade marks based on the types of goods and services they cover.

If Members decide to adopt the draft Law, this will enable the Island to be included in and benefit from the main international trade mark agreements mentioned above, instil confidence in right holders and enhance Jersey’s international reputation and attractiveness as a jurisdiction for doing business.

New Registry

The introduction of a system of primary trade mark registration will involve considerable extra work for the Registrar of trade marks and necessitate the establishment of a new Jersey IP Register.

The draft Registrar of Intellectual Property (Jersey) Law 202- (the **draft Registrar Law**), will be brought to the Assembly for Members’ consideration imminently, making provision in this regard. It establishes a new IP Register in Jersey (the **new Register**) and the Office of the Registrar of IP rights. The new Register is to operate under the umbrella of the Jersey Financial Services Commission in place of the existing registry operated by the Judicial Greffier. The draft Registrar Law will set out the basic structures within which the Office of the Registrar of IP rights must work.

Members may be aware that the Judicial Greffier currently also acts as the Registrar to whom an application for sub-registration must be made under the [Registered Designs \(Jersey\) Law 1957](#) and the [Patents \(Jersey\) Law 1957](#), which respectively provide for re-registration of registered designs and patents first registered in the UK. There will be no change to the nature of the registration system for these two laws regarding the link to, and re-registration of, UK rights. However, if the draft Registrar Law is adopted, the new Registry will also take over the Judicial Greffier’s responsibilities for re-registration of patents and designs in Jersey.

⁵ [Madrid System Members](#).

Process leading to proposals in this draft Law

Consultation has been important in informing these proposals. The process commenced in December 2023, when the Government published a consultation seeking feedback on the proposal to introduce a system of primary trade mark registration in Jersey. As part of the consultation process, Government officials engaged with various (local) stakeholders and the majority of the proposals received widespread support.

A paper summarising the feedback received, and setting out the Government's response to the consultation, was published in April 2023.⁶ In July of that year, the Assistant Minister for External Relations, with delegated responsibility for IP, approved law drafting instructions to prepare the draft Law.⁷

Given the very technical nature of this draft Law, and the essential nature of a number of provisions for Jersey to have a law compliant with the Madrid Protocol, a very well-developed draft Law was produced ahead of a further round of stakeholder engagement. This version was made publicly available in June 2025 and shared for comment with the stakeholders who had responded to the first consultation, along with Jersey Business and the Consumer Council.

The feedback received was, once again, generally positive and did not require any major changes to the proposals set out in the consultation paper. In light of the feedback received, a number of adjustments has however been made to improve the draft Law. Further detail is set out in the Government's Response Paper published in August 2025.⁸

Main features of this Law

This draft Law is highly complex and contains over 150 provisions and four schedules. It completely overhauls the existing approach to the registration and protection of trade marks in the Island under the 2000 Law. The draft Law is split out in various parts and its main features are described in more detail below. For the exact and full legal detail, Members are referred to the draft Law itself.

➤ Part 1

This Part defines the important and main terms and expressions used in the draft Law, including the fundamental definition of "trade mark".

➤ Part 2

This Part concerns the registration of trade marks in Jersey and is divided into multiple divisions. Its scope is set out in Division 1.

Division 2 deals with the registering of trade marks, charges the Registrar to maintain the register and prescribes some of the information that must be included in the register. It also deals with classification of goods for the purposes of the register. Division 3 defines what the term "date of filing" means – an important matter in establishing priority of trade marks – and rights of priority in respect of so-called "Convention applications" and other overseas applications.

Division 4 deals with the manner of applying for registration and the examination of the application by the Registrar. Division 5 deals with opposition to applications for registration of a trade mark. Any person may give written notice of opposition to a published application, stating the grounds for opposition.

⁶ [Intellectual Property: proposal for a Primary Trade Mark Registry](#).

⁷ [MD-ER-2024-479](#).

⁸ [Trade Marks Law](#).

Division 6 sets out the grounds on which the Registrar must refuse an application. These are in two categories: absolute grounds, including that the mark is not within the definition of a trade mark or that it lacks distinctive character; and relative grounds for refusal, such as being identical to an earlier trade mark in respect of identical goods or services or the likelihood of confusion with an earlier mark. Registration will also be refused if the trade mark sought contains or relates to certain protected emblems, such as the Royal arms, the Royal flags, the Royal crown or a representation of the members of the Royal family.

Division 7 goes on to require the Registrar to register a trade mark if the application is accepted and no opposition notice is received or opposition proceedings have been decided in favour of the applicant. Registration will last for 10 years and is renewable for further periods of 10 years.

The renewal process is dealt with in Division 8 of this Part, along with restoration and surrender of registration. Division 9 makes provision for revocation of registrations: these include 5 years non-use or suspension of use, without justification, etc. Division 10 gives a right to apply to the Registrar or the Royal Court for a declaration that a registration of a trade mark is invalid. Division 11 deals with legal proceedings relating to registrations.

➤ **Part 3**

Part 3 relates to international registrations and contains 6 divisions. These are provisions intended to implement the Madrid System in Jersey and would enable Jersey to request the extension of the UK's ratification of the Madrid Protocol.

Division 1 defines the main terms and expressions used in this Part of the draft Law. Division 2 applies to an application for international registration filed with the Registrar as the Office of origin and sets out the requirements for filing and processing this type of application.

Division 3 relates to international registrations that are the subject of a request for territorial extension to Jersey (thus where the Jersey Registrar does not act as the Office of origin) and requires the Registrar to undertake a variety of actions, including examining a request for territorial extension of an international registration to Jersey as if it were a domestic application. It sets out the circumstances in which the Registrar must send a notice of provisional or total refusal to the International Bureau and makes provision in relation to publication and opposition. If all the procedures before the Registrar have been completed, the Registrar must send to the International Bureau a statement that the international trade mark is granted protection in Jersey. Division 3 also deals with 'replacement' and with the renewal of an international registration that extends to Jersey.

Division 4 makes provision in the event the International Bureau cancels an international registration that extends to Jersey. Division 5 contains various provisions that deal with changes in the International Register, whilst Division 6 sets out various general provisions, for example in relation to communications between the Registrar and the International Bureau.

➤ **Part 4**

This Part provides that certain rights will be conferred on a trade mark owner by virtue of making an application. This Part also makes provision for cases where the application is made by more than one person jointly and in respect of the grant of licences (exclusive or non-exclusive) to use the trade mark before the application is processed.

➤ **Part 5**

Part 5 makes provision in relation to the rights conferred by registration. It also makes provision relating to co-ownership, the rights of the registered owner to limit or disclaim their exclusive use of the mark, how trade marks may be transferred and the licensing of the use of a registered mark.

Another important provision gives the registered proprietor the right, in certain circumstances, to prevent articles that may infringe the trade mark from entering Jersey.

➤ **Part 6**

This Part is split in several divisions. Division 1 deals with infringement of a registered trade mark and describes the circumstances in which an infringement takes place and uses that do not constitute infringement. Division 2 deals with infringement proceedings and, amongst other things, sets out the rights of the registered proprietor to bring proceedings before the Royal Court to prevent the infringement.

Division 3 deals with defences and remedies, while Division 4 gives the owner of a so-called “well-known trade mark” the power to apply to the Royal Court for an injunction to restrain the use of an identical or similar trade mark. Division 5 concerns prohibited goods and gives the owner of a registered trade mark, who expects goods which infringe the trade mark to be imported, to request the Agent of the Impôts to treat the goods as prohibited imports which are therefore liable to forfeiture.

➤ **Part 7**

This Part contains protections against groundless threats to take proceedings for infringement. Such threats have the potential to cause serious damage to businesses. A person aggrieved by the threat may apply to the Royal Court for a declaration that the threat was not justified, an injunction to prevent further such threats and, if loss has been suffered, for damages.

➤ **Part 8**

Part 8 confers a power on the Minister to require the Registrar to keep and maintain a register of trade mark agents. Once and if the register is established, persons or businesses would have to be on the register in order to practice or carry on a business under a name or description including the words “registered trade mark agent”.

➤ **Part 9**

This Part creates various criminal offences in connection with the unauthorised use of a trade mark, falsification of the register of trade marks, false representation in respect of a trade mark and unauthorised use of Royal arms etc. It also confers enforcement powers on officers of Trading Standards and provides for the criminal liability of company directors and officers etc. There also is provision for forfeiture of counterfeit goods on application to the Royal Court.

➤ **Part 10**

This Part contains powers to make Regulations and Orders to give further effect to the draft Law, provides for rights of appeal to the Royal Court from decisions of the Registrar, various evidential provisions and savings for vested rights.

➤ **Schedule 1**

This Schedule applies to the registration of collective marks. A collective trade mark is a type of trade mark owned by an association or organisation, rather than an individual or company, and used by its members to indicate their affiliation with that group. It essentially distinguishes the goods or services of the members of the collective from those of non-members. The schedule

makes provision that the draft Law would apply to such marks with the modifications set out in the Schedule.

➤ **Schedule 2**

A certification mark is a type of trade mark that indicates a product or service meets specific standards or qualifications set by a certifying body. It provides a means for an independent organisation to assure consumers that a product or service has been assessed and verified against defined criteria. Unlike regular trade marks that identify the source of goods or services, certification marks show that a product or service possesses certain characteristics or meets certain specified standards. This Schedule would apply the draft Law to certification marks, subject to the modifications set out in the Schedule.

➤ **Schedule 3**

This Schedule sets out how the draft Law coming into force would affect existing registered trade marks.

Paragraph 1 deals with the existing registrations under the 2000 Law (i.e. those marks in the UK register which have been re-registered in Jersey). It makes clear that all existing marks will be transferred onto the new Register of trade marks. If, on the renewal date, the right holder wants to continue their protection in Jersey, they must separately renew their trade mark in Jersey, directly with the Office of the Registrar of IP rights. The Registrar must inform owners of their rights to renew.

Paragraphs 2 and 3 deal with the renewal of registrations due in the first 6 months after the draft Law enters into force and the renewal of certain lapsed registrations. Paragraph 4 makes provision in relation to applications for re-registration in Jersey that are pending on the commencement date of the draft Law.

Paragraph 5 makes important provision in relation to protected international marks (UK) that are currently automatically protected in Jersey under the 2000 Law. It provides that, on the commencement date of the draft Law, any protected international trade mark (UK) will continue to be protected in Jersey as a protected international trade mark (Jersey). These will be in force until their date of renewal, at which time they may be renewed for Jersey against payment of the applicable renewal fee. Paragraph 6 goes on to make provision for international marks (UK) that are pending on the commencement date of the draft Law.

➤ **Schedule 4**

Schedule 4 makes a number of consequential amendments of existing Jersey legislation.

Secondary legislation

Members will note that the draft Law includes various provisions requiring the Minister to make an Order providing further detail on certain aspects of the Law. Amongst other things, the draft Law requires the Minister to make an Order to govern certain matters in relation to the classification of goods and services for the purposes of registration, the particulars of registrable transactions and the giving of notice of opposition. Subject to the adoption by the States Assembly of the draft Law, the necessary secondary legislation will be prepared ahead of the commencement date of the draft Law.

Extension of International Treaty Texts

If Members adopt this legislation, it will enable Jersey to seek extension through the UK of two international treaties related to trade mark protection:

- [Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks](#); and
- [Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks](#).

Financial and resource implications

There would be no additional resource implications as a result of the adoption of the draft Law beyond the funding agreed by the States Assembly for the modernisation of Jersey's IP legislation and registry infrastructure in the Government Plan 2024-2027.

Children's Rights Impact Assessment

A Children's Rights Impact Assessment has been prepared in relation to this proposition and is available to read on the States Assembly website.

Human Rights

The notes on the human rights aspects of the draft Law in the **Appendix** have been prepared by the Law Officers' Department and are included for the information of States Members. They are not, and should not be taken as, legal advice.

APPENDIX TO REPORT**Human Rights Notes on the Draft Trade Marks (Jersey) Law 202-**

These Notes have been prepared in respect of the draft Trade Marks (Jersey) Law 202- (“the **draft Law**”) by the Law Officers’ Department. They summarise the principal human rights issues arising from the contents of the draft Law and explain why, in the Law Officers’ opinion, the draft Law is compatible with the European Convention on Human Rights (“**ECHR**”).

These notes are included for the information of States Members. They are not, and should not be taken as, legal advice.

The interaction between intellectual property rights, such as trade marks, and the ECHR rights, is well recognised. In relation to trade marks, as with other types of intellectual property, that interaction mainly relates to the right to freedom of expression and to property rights, though in the case of the draft Law, the so called “fair trial” rights would also be engaged.

The draft Trade Marks (Jersey) Law would establish a new scheme for the primary registration in Jersey of trade marks in place of the scheme for re-registration of UK registered trade marks under the Trade Marks (Jersey) Law 2000. It would also introduce new provisions enabling the extension to Jersey of the Madrid system for registration of international trade marks. Trade marks legislation can engage several of the rights guaranteed under the ECHR. In this instance, three of ECHR rights are potentially engaged.

They are the protection of property rights (Article 1 of the 1st Protocol); fair trial rights (Article 6) and the right to freedom of expression (Article 10).

ARTICLE 1 PROTOCOL 1 Rights (“A1P1”) – rights in property

Article 1 of the First Protocol to the ECHR reads –

- “1. *Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law.*
2. *The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties.”.*

The jurisprudence of the European Court of Human Rights has established that States have a wide margin of appreciation, or discretion to decide what limitations on the use of property are in the public interest. The Court has said that the second paragraph sets the Contracting States up as sole judges of the “necessity” for such a law in “the general interest”.

A1P1 rights may be engaged by the enforcement and forfeiture provisions in Article 148 and 150 of the draft Law. Article 148 requires “authorised officers” (i.e. trading standards officers) to enforce the provisions of Part 9 of the draft Law using the powers given by the Consumer Protection (Unfair Practices) (Jersey) Law 2018 these are to inspect, test, seize and detain goods

which are suspected of being infringing goods. Article 150 gives power to the Royal Court to order forfeiture of goods etc. which the Court is satisfied are connected with which an offence under Article 144 of the draft Law or under various other offences listed in the article. They may also be engaged by the exercise of powers in Articles 122 and 124 relating to orders for the delivery-up and disposal of infringing articles. These are provisions would not themselves be incompatible with A1P1 rights.

Clearly, such powers will enable, in cases concerning infringement of trade marks, deprivation of property and interference with the rights of persons having ownership or other interests in the goods. The deprivation or interference will be in accordance with the law, and in the general interests of protection of the rights of the public and the trade mark owners and these provisions are therefore compatible within paragraph (2) of A1P1.

ARTICLE 6 rights –

1. **Determination of civil rights:** Article 6(1) of the ECHR provides that –

“In the determination of his civil rights and obligations or of any criminal charge against him, everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law. Judgment shall be pronounced publicly but the press and public may be excluded from all or part of the trial in the interest of morals, public order or national security in a democratic society, where the interests of juveniles or the protection of the private life of the parties so require, or the extent strictly necessary in the opinion of the court in special circumstances where publicity would prejudice the interests of justice.”.

Article 6 of the ECHR applies if the civil rights and obligations of the applicant are in issue, there is a dispute as to those civil rights and obligations, and the proceedings are determinative of those civil rights and obligations. This could arise in cases where an application for registration of a trade mark is refused, cancelled or revoked. The initial decision on such matters under the draft Law will be taken by the Registrar of Intellectual Property, who (at least arguably) will fulfil the requirements of Article 6 because, under another draft Law, due to be presented to the States at the same time or shortly after this Draft Law, and which would establish the new office of registrar of intellectual property, the Registrar, will be an officer of the Financial Services Commission, which is a body independent of the States executive.

A key requirement of Article 6 of the ECHR is the need for access to a fair and public hearing within a reasonable time “by an independent and impartial tribunal”. The independence in question here is independence from the executive, the parties and the legislature. Access to an independent and impartial tribunal may be granted in two ways: either the decision-making body itself complies with the requirement of Article 6(1) of the ECHR, which is arguable already the case, as explained above, or the initial decision-making body is subject to control by a body which complies with the requirements of Article 6(1) and which has full jurisdiction.

Article 153 of the draft Law provides for a right to appeal from decisions of the Registrar to the Royal Court. This procedure will satisfy the requirements of Article 6 of the ECHR. In addition, there may in some circumstances be a further appeal to the Court of Appeal.

Accordingly, the process for making decisions under the draft Law is compatible with Article 6.1 of the ECHR.

2. Criminal proceedings.

Further engagement of Article 6 rights arises because of one of the provisions of the draft Law relating to criminal offences and the requirements of Article 6(2) ECHR which provides –

“Everyone charged with a criminal offence shall be presumed innocent until proved guilty according to law.”

Article 144(5) of the draft Law includes a provision which has been the subject of judicial consideration in the UK on grounds of compatibility with Article 6(2). The provision reads –

“(5) A person has a defence to an offence under this Article if they show 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.”

This provision could potentially be incompatible with Article 6(2) because it places a burden of proof in criminal proceedings on the defendant, which might be incompatible with the “presumption of innocence”. However, in the case of *R-v-Johnstone* (2003) UKHL 28 a similarly worded provision in the Trade Marks Act 1994 was considered by the Judicial Committee of the House of Lords to be compatible with Article 6(2) of the ECHR. Although the provision placed a legal or probative burden of proof (on a balance of probabilities) on the defence, it was justified and therefore not incompatible with Article 6(2) because it was not unreasonable for Parliament to require a person trading commercially to have to prove their belief in what they were doing.

Therefore, it is likely that if the question of the compatibility of Article 144(5) with Article 6(2) ECHR came before the Jersey Courts, the matter would be decided the same way, though the Jersey Courts are not bound to follow UK judicial decisions, of course.

Accordingly, the provisions of the draft Law are not incompatible with the Article 6 ECHR rights.

Article 10 – Freedom of expression

Article 10 provides –

*“Article 10
Freedom of expression*

- 1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.*
- 2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.”*

Potential conflicts involving trade marks and freedom of expression can arise in two main areas; first where a person seeks to register a mark or sign which is refused as being contrary to public policy or morality; and second where a third party uses a mark in the course of a parody, criticism, art, or comparative advertising.

The rights under this Article are potentially engaged by Article 32(5) (and similar provisions in the Schedules on collective and certification marks) of the draft Law, which would give power to the Registrar to refuse to register a trade mark on grounds of being contrary to public policy or morality. These provisions are not in themselves incompatible with the Article 10 rights but since they might involve limiting the right to free expression, they must be applied by the Registrar (and the Court on an appeal) in a way which is compatible with the Article 10 right, by applying Article 4 and Article 7 of the Human Rights Law, which require legislation to be applied as far as possible in a way which is compatible with the Convention rights and require a public authority to act in a way that is not incompatible with those rights.

Potentially, as to the second area mentioned above, the parts of the draft Law dealing with proceedings for infringement of trade marks (Part 6) and unjustified threats of infringement proceedings (Part 7) could engage the Article 10 rights; but the provision of the draft Law themselves are not incompatible with the rights under the Article. The Courts when dealing with claims for infringement, by virtue of the duty placed on them by Article 7 of the Human Rights Law, will of course have to consider and act in accordance with the Article 10 rights. The Court would have to balance the proprietor's exclusive right to use the mark against the public interest in freedom of expression; and in the case of any doubt, resolve the matter in favour of the Article 10 right.

For the above reasons, the draft Law would be compatible with the Convention rights.

EXPLANATORY NOTE

The Trade Marks (Jersey) Law 202-, if passed, will make provision for a system of primary registration of trade marks in Jersey, repealing and replacing the Trade Marks (Jersey) Law 2000 which provided a system of re-registration, and will 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. The Madrid Protocol is an international agreement which makes it possible to seek trade mark protection in a large number of countries by filing a single international application.

Part 1 (Articles 1 to 9) provides for general interpretation.

Article 1 defines terms used throughout the Law. A domestic registration is defined as the registration of a trade mark granted under Part 2 of this Law. A domestic application is defined as an application for registration of a trade mark under Part 2 of this Law. *Article 1* defines the requirements for registration. The Registrar is defined as the person appointed as the Registrar of Intellectual Property under the Registrar of Intellectual Property (Jersey) Law 202- (“the Registrar’s Law”). The Registrar’s website is defined as the website maintained by the Registrar under the Registrar’s Law. The register of trade marks is defined as that part of the Jersey Intellectual Property Register established under the Registrar’s Law that is maintained under Part 2 of this Law. *Article 1* defines an existing registered trade mark.

Article 2 defines a trade mark.

Article 3 defines a collective mark, and *Article 4* defines a certification mark, each of which is a kind of trade mark.

Article 5 defines an earlier trade mark.

Article 6 defines a registered proprietor.

Article 7 defines “use” in relation to a trade mark.

Article 8 provides that the burden of proving use of a trade mark is on the registered proprietor.

Article 9 provides that goods and services appearing in the same or a different class under a classification system does not affect whether the goods and services are similar or dissimilar.

Part 2 (Articles 10 to 63) provides for the registration of trade marks in Jersey.

Division 1 (Article 10) provides that, unless expressly stated otherwise, Part 2 applies to an international registration that extends to Jersey or a request for territorial extension of an international registration to Jersey, in the same way as it applies to domestic registrations or domestic applications.

Division 2 (Articles 11 to 18) provides for the register of trade marks.

Article 11 requires the Registrar to maintain the register of trade marks and specifies what must be entered in the register.

Article 12 provides a power for the Minister for External Relations (“the Minister”) to make an Order specifying a classification system for the purpose of domestic registrations.

Article 13 provides a power for the Minister to make an Order providing for the Registrar to implement an amended or substituted classification of goods or services for the purposes of domestic registrations.

Article 14 defines “registrable transaction” and provides a power for the Minister to make an Order specifying the particulars of a registrable transaction that must be registered.

Article 15 defines “registered particulars” and provides a power for the Minister to make an Order providing for the Registrar to amend or remove registered particulars.

Article 16 provides for the rectification of errors or omissions in the register of trade marks, and for the removal of any matter appearing to the Registrar to have ceased to have effect.

Article 17 provides for the limited circumstances in which the Registrar may alter a registered trade mark in the register of trade marks.

Article 18 provides that the Registrar is not affected by a notice of trusts and must not enter a notice of trusts in the register of trade marks.

Division 3 (Articles 19 to 21) defines the date of filing of a domestic application and provides for the determination of a date of priority.

Article 19 defines the date of filing of a domestic application.

Article 20 provides for the determination of the date of priority for an application for registration if the applicant has previously filed a Convention application (as defined in Article 1).

Article 21 provides a power for the States to make Regulations providing for a right of priority on the basis of an overseas application (as defined in Article 21).

Division 4 (Articles 22 to 29) provides for an application for the registration of a trade mark under Part 2.

Article 22 provides for the content of an application for the registration.

Article 23 provides that an application for registration is subject to the payment of an application fee set by the Jersey Financial Services Commission under the Registrar’s Law.

Article 24 provides that the Registrar must examine whether an application for registration meets the requirements for registration and must accept an application that meets those requirements.

Article 25 provides that the Registrar must publish an application for registration on the Registrar’s website.

Article 26 provides for the withdrawal or amendment of an application for registration by the applicant, and for the publication of a withdrawal or amendment. It provides for the Registrar to amend an application for registration in limited circumstances.

Article 27 provides for the Registrar to provide a person with information about a published application for registration and a trade mark registered as a result of the published application.

Article 28 restricts the provision of information before an application for registration is published.

Article 29 requires a person who claims an interest in an applicant’s property rights as a result of a transaction listed in the Article to notify the Registrar of the transaction.

Division 5 (Articles 30 and 31) provides for opposition proceedings (as defined in Article 1) following publication of an application for registration.

Article 30 provides for the giving of a notice of opposition.

Article 31 defines “use conditions” and provides for relative grounds for refusal during opposition proceedings only if the use conditions are met.

Division 6 (Articles 32 to 41) provides grounds for refusing registration.

Article 32 provides for absolute grounds for refusal, for example if a sign does not fall within the definition of a trade mark.

Article 33 provides for absolute grounds for refusal if the use or registration of the trade mark is prohibited in the cases mentioned in that Article.

Article 34 provides for refusal on the grounds that the trade mark is identical or similar to an earlier trade mark (as defined in Article 1), if the proprietor of the earlier trade mark raises an objection on that ground in opposition proceedings.

Article 35 provides for refusal on the grounds that the use in Jersey of the trade mark is liable to be prevented by an earlier right (as defined in Article 1), if the proprietor of the earlier right raises an objection on that ground in opposition proceedings.

Article 36 provides for refusal on the grounds that the application for registration is made by an agent or representative of the proprietor in their own name, without the proprietor's consent and without justification, if the proprietor of the trade mark raises an objection on that ground in opposition proceedings.

Article 37 provides for refusal in relation to only some goods or services if grounds for refusal exist only in relation to those goods or services.

Article 38 provides for refusal of registration of a trade mark that consists of or contains specially protected emblems mentioned in that Article.

Article 39 provides for refusal of registration of a trade mark that consists of or contains national emblems of a Convention country (as defined in Article 1).

Article 40 provides for refusal of registration of a trade mark that consists of an emblem of an international organisation.

Article 41, for the purpose of Articles 39 and 40, provides for when certain emblems of a Convention country or an international organisation are taken to be protected under the Paris Convention.

Division 7 (Articles 42 to 46) provides for the registration of a trade mark.

Article 42 provides that Division 7 does not apply to an international registration that extends to Jersey or a request for territorial extension of an international registration to Jersey.

Article 43 provides for the circumstances in which the Registrar must, or must not, register a trade mark.

Article 44 provides for a 10-year period of registration and renewal for further periods of 10 years.

Article 45 provides for publication of a registration on the Registrar's website and the issue of a certificate of registration.

Article 46 provides power for the Minister to make an Order providing for division or merger of applications and registrations. The Article also provides for the registration of a series of trade marks.

Division 8 (Articles 47 to 50) provides for the renewal, restoration and surrender of a registration.

Article 47 provides that Division 8 does not apply to an international registration that extends to Jersey.

Article 48 provides for the renewal of a registration.

Article 49 provides Order-making powers for the Minister relating to renewal and restoration.

Article 50 provides for the surrender of a registered trade mark in relation to some or all goods or services.

Division 9 (Articles 51 and 52) provides for the revocation of a registration.

Article 51 provides for an application for the revocation of the registration of a trade mark.

Article 52 provides grounds for revoking a registration, including non-use. This Article also provides that 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.

Division 10 (Articles 53 to 57) provides for a declaration of invalidity of a registration.

Article 53 provides that a person may apply to the Registrar or the Royal Court for a declaration that the registration of a trade mark is invalid.

Article 54 provides for the effect of a declaration of invalidity.

Article 55 provides for the grounds on which registration of a trade mark may be declared invalid.

Article 56 provides that a declaration of invalidity must not be made on the ground of an earlier trade mark unless certain circumstances apply.

Article 57 provides for the effect of acquiescence on the right of the proprietor of an earlier trade mark or earlier right to apply for a declaration of invalidity in relation to, or oppose the use of, a later trade mark.

Division 11 (Articles 58 to 63) provides for legal proceedings relating to registration.

Article 58 provides that the Minister may make an Order providing for costs and security for costs in proceedings before the Registrar.

Article 59 provides that the Minister may make an Order providing for the giving of evidence in proceedings before the Registrar.

Article 60 provides that 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 the original registration and a change of ownership.

Article 61 provides for a certificate of valid registration to be given by the Royal Court in proceedings contesting the validity of a registration.

Article 62 provides that the Registrar is entitled to appear and be heard in Court proceedings relating to an application for revocation, a declaration of invalidity or rectification of the register of trade marks, and that the Registrar must appear if directed by the Court to do so.

Article 63 provides power for the Royal Court to release the Registrar from proceedings that relate to the determination of a question between a proprietor and another person.

Part 3 (Articles 64 to 94) provides for international registration.

Division 1 (Article 64) provides for the interpretation of Part 3. In particular, it defines a protected international trade mark (Jersey).

Division 2 (Articles 65 to 69) provides for applications for international registration made on the basis of a domestic application (“basic application”) or domestic registration (“basic registration”).

Article 65 provides for the application and interpretation of Division 2.

Article 66 provides requirements for the filing and processing of international applications under Division 2.

Article 67 provides for the classification of goods and services for the purposes of an international application under Division 2.

Article 68 provides for the cancellation of an international registration if a basic application or basic registration is cancelled.

Article 69 requires the Registrar to notify the International Bureau of the division or merger of domestic applications or domestic registrations.

Division 3 (Articles 70 to 84) provides for the extension of international registrations to Jersey.

Article 70 provides that Division 3 applies to an international registration that extends to Jersey or that is the subject of a request for territorial extension to Jersey.

Article 71 provides that the Registrar is not bound by the classification of goods or services indicated in the international registration when determining the scope of protection to be granted to a protected international trade mark (Jersey).

Articles 72 to 79 provide for the procedure for examination of a request for territorial extension of an international registration to Jersey and the granting of protection of the international trade mark in Jersey as a protected international trade mark (Jersey).

Article 80 provides for the registration of a protected international trade mark (Jersey).

Article 81 provides for the circumstances in which the international registration is taken to replace the domestic registration in the register of trade marks.

Article 82 provides for the notation of the replacement in the register.

Article 83 provides for an international registration to continue to have effect in Jersey if it is renewed in accordance with the Madrid Protocol.

Article 84 requires the Registrar to notify the International Bureau if a declaration of invalidity or revocation is made under Part 2 in relation to the protected international trade mark (Jersey).

Division 4 (Article 85) provides for transformation applications. It provides for the holder of an international registration to apply for registration under this Law if the international registration is cancelled.

Division 5 (Articles 86 to 92) provides for the effect of changes recorded in the international register, declarations that certain changes in the international register have no effect in Jersey, a declaration that protection cannot be granted to an international trade mark as a result of a correction of the international register, and requests to the Registrar for division or merger of international registrations that extend to Jersey or are the subject of a request for territorial extension to Jersey.

Division 6 (Articles 93 and 94) makes general provision for the purposes of Part 3.

Article 93 makes provision relating to communications between the Registrar and the International Bureau.

Article 94 provides power for the Minister to make an Order amending this Law for the purpose of implementing changes to the Madrid Protocol that are extended to Jersey.

Part 4 (Articles 95 to 101) provides for rights conferred by an application for registration.

Article 95 provides that Part 4 applies to a request for territorial extension of an international registration to Jersey in the same way as it applies to a domestic application.

Article 96 provides that an application for registration is movable property, and provides for when rights in that movable property are conferred on the applicant. It provides that infringement proceedings may not be brought before the date on which the Registrar enters the trade mark in the register of trade marks.

Article 97 provides for co-applicants' property rights.

Article 98 provides for disclaimers and limitations.

Article 99 provides for the transmission of an applicants' property rights.

Articles 100 and 101 provide for licences granted by an applicant for registration.

Part 5 (Articles 102 to 112) provides for rights conferred by registration.

Article 102 provides that Part 5 applies to an international registration that extends to Jersey in the same way as it applies to a domestic registration.

Article 103 provides that a registered trade mark is movable property, and provides for when rights in that movable property are conferred on the registered proprietor. It provides that no offence is committed under Article 144 (unauthorised use of trade mark in relation to goods) by anything done before the registration of the trade mark is published under Article 45.

Article 104 provides that the registered proprietor has exclusive rights in the registered trade mark and refers to use which infringes those rights.

Article 105 provides that co-owners of a registered trade mark have an equal undivided share in the registered trade mark.

Article 106 provides for disclaimers and limitations.

Article 107 provides for the transmission of a registered trade mark in the same way as other movable property.

Articles 108 and 109 provide for licences granted by a registered proprietor.

Article 110 provides that the proprietor of a trade mark may prevent the use of the trade mark if an agent or representative of the proprietor registers the trade mark in their own name.

Article 111 provides for the circumstances in which the proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into Jersey in the course of trade without being released for free circulation.

Article 112 provides for a registered proprietor to require a publisher of a reproduction of a registered trade mark in a dictionary, encyclopaedia or similar reference work to ensure that the reproduction of the registered trade mark is accompanied by an indication that the trade mark is a registered trade mark.

Part 6 (Articles 113 to 130) provides for infringement of a registered trade mark.

Division 1 (Articles 113 to 115) provides for use that constitutes, or does not constitute, infringement of a registered trade mark.

Division 2 (Articles 116 to 120) provides for the circumstances in which a registered proprietor (including a co-proprietor), or a licensee may bring Court proceedings for the infringement of a registered trade mark (“infringement proceedings”).

Division 3 (Articles 121 to 126) provides for defences and remedies in infringement proceedings.

Article 121 provides for the defence of non-use.

Articles 122 and 123 provide for a registered proprietor to apply to the Royal Court for an order for delivery up to them of infringing goods that a person has in their possession, custody or control in the course of a business.

Article 124 provides for an order for disposal of infringing goods that have been delivered up under an order of the Royal Court made under Article 122.

Articles 125 provides for remedies that the Royal Court may grant in infringement proceedings.

Article 126 provides for orders for erasure etc that may be made by the Royal Court if a person is found to have infringed a registered trade mark.

Division 4 (Article 127) provides for protection of well-known trade marks. It provides the circumstances in which 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.

Division 5 (Articles 128 to 130) makes provision in relation to prohibited goods.

Article 128 provides for a registered proprietor or a licensee of a registered trade mark to give the Agent of the Impôts a notice of importation of prohibited goods.

Article 129 provides power for the Minister to make an Order in relation to the giving of a notice of importation.

Article 130 provides for the Agent of the Impôts to disclose information about infringing goods for the purpose of the investigation or prosecution of certain offences.

Part 7 (Articles 131 to 136) make provision for an action to be brought by an aggrieved person in relation to an unjustified threat of infringement proceedings made by another person.

Article 131 provides for the interpretation of Part 7.

Article 132 defines a threat of infringement proceedings.

Article 133 sets out the circumstances in which a threat of infringement proceedings is actionable.

Article 134 defines a “permitted communication” for the purposes of Article 133.

Article 135 provides the remedies available in an action brought by an aggrieved person, and provides the defences available for the person who made the unjustified threat of infringement proceedings.

Article 136 provides for the circumstances in which proceedings in respect of an actionable threat may not be brought against a professional adviser.

Part 8 (Articles 137 to 143) makes provision for trade mark agents.

Article 137 provides for the interpretation of Part 8.

Article 138 provides that a person may authorise an agent to act on the person's behalf in relation to the registration of a trade mark.

Article 139 provides power for the Minister to make an Order authorising the Registrar to refuse to deal with an agent who has been convicted of an offence under Article 141 or whose name has been removed, on the ground of misconduct, from the register of trade mark agents kept under Article 140.

Article 140 provides power for the Minister to make an Order requiring the Registrar or other person specified in the Order to keep and maintain a register of trade mark agents.

Articles 141 and 142 make provision for unregistered trade mark agents.

Article 143 provides that 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.

Part 9 (Articles 144 to 151) provides for offences and forfeiture.

Article 144 provides for offences relating to unauthorised use of a trade mark in relation to goods. A person who commits an offence under Article 144 is liable to imprisonment for a term of 10 years and to a fine.

Article 145 provides for offences relating to falsification of the register of trade marks. A person who commits an offence under Article 145 is liable to imprisonment for a term of 2 years and to a fine.

Article 146 provides for offences relating to false representation in respect of trade marks. A person who commits an offence under Article 146 is liable to a fine.

Article 147(1) provides for an offence relating to the unauthorised use of Royal arms. A person who commits an offence under paragraph (1) is liable to a fine of level 2 on the standard scale.

Article 148 provides for an authorised officer under the Consumer Protection (Unfair Practices) (Jersey) Law 2018 to enforce the provisions of Part 9.

Article 149 provides for the criminal liability of directors, managers and others for offences committed by entities.

Article 150 makes provision for an order for the forfeiture of infringing goods to be made by the Royal Court.

Article 151 makes provision for the Royal Court to grant an injunction or other order in relation to a contravention of a provision of this Law, on the application of the Attorney General.

Part 10 (Articles 152 to 161) makes miscellaneous and general provision for the purpose of this Law.

Article 152 provides power for the States to make Regulations that amend this Law or another enactment to ensure consistency with or give effect to an international treaty or agreement that applies to, is ratified by or on behalf of, or is extended to, Jersey.

Article 153 provides for appeals to the Royal Court against decisions of the Registrar under this Law. This Article also provides power for the Minister to make an Order specifying the kinds of decisions in respect of which there is no right to an appeal.

Article 154 provides general Order-making powers for the Minister in relation to practice and procedure under this Law.

Article 155 provides power for Rules of Court to be made in relation to practice and procedure in Court proceedings under this Law.

Article 156 provides that a Jersey court must take judicial notice of the Madrid Protocol and the Madrid Regulations, copies of entries in the International Register issued by the International Bureau, and copies of the periodical gazette published by the International Bureau.

Article 157 provides that the Royal Court and the Registrar must have regard to certain recommendations relating to trade marks published by the World Intellectual Property Organisation.

Article 158 continues the saving of certain vested rights previously provided for in the Trade Marks (Jersey) Law 2000.

Article 159 provides that Schedule 3 makes transitional provision that has effect on the commencement date. This Article also provides power for the Minister to make transitional provision in an Order.

Article 160 provides that Schedule 4 makes provision for consequential amendments and repeals.

Article 161 provides for citation and commencement by Order of the Minister.

Schedule 1 makes further provision for collective marks.

Schedule 2 makes further provision for certification marks.

Schedule 3 makes transitional provision –

- for the registration and renewal of registration, under this Law, of existing registered trade marks;
- for the renewal, under this Law, of lapsed registrations;
- in respect of applications for registration of a trade mark under the Trade Marks (Jersey) Law 2000 that were not finally determined before the commencement date, for the application to be determined under that Law as if that Law had not been repealed, and for the trade mark to be registered under this Law;
- for the continued protection of an international trade mark that was, immediately before the commencement date, a protected international trade mark (UK); and
- for the granting of protection to an international trade mark that, immediately before the commencement date, was the subject of a request for territorial extension to the United Kingdom, with protection to take effect from when it is granted protection in the United Kingdom as a result of that request.

Schedule 4 makes consequential amendments and repeals, replacing references to the Trade Marks (Jersey) Law 2000 with references to this Law, and repealing the Trade Marks (Jersey) Law 2000.



Jersey

DRAFT TRADE MARKS (JERSEY) LAW 202-

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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.

<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

GENERAL INTERPRETATION

1 General 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’s property rights” means the rights in movable property conferred on an applicant for domestic registration under Article 96 (applicant’s property rights);

“application for trade mark registration fee” means the application for trade mark registration fee set by the Commission under Article 9 of the Registrar’s Law;

“application for registration” means an application for the registration of a trade mark under Part 2;

“application for revocation” means an application to revoke a domestic registration;

“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;

“certified”, in relation to goods or services in connection with which a certification mark is used, 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, means a classification system specified by the Minister in an Order under Article 12 (classification of goods and services for domestic registrations);
- (b) in relation to an international registration, means a system for determining under Article 67 (classification of goods and services) the class of goods and services to which an international application relates;

“collective mark” has the meaning given in Article 3;

“commencement date” means the date on which this Law comes into force;

“Commission” means the Jersey Financial Services Commission established under Article 2 of the [Financial Services Commission \(Jersey\) Law 1998](#);

“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 of the application;

“date of filing”, for an application for registration, has the meaning given in Article 19 (date of filing (domestic application));

“date of priority”, for an application for registration or a request for territorial extension of an international registration to Jersey, means the date from which a right of priority is claimed –

- (a) under Article 20 on the basis of a Convention application; or
- (b) under Article 21 on the basis of an overseas application;

“date of registration”, for an application for registration, means –

- (a) the date of filing; or
- (b) any date of priority;

“date of request for territorial extension” has the meaning given in Article 64 (interpretation of Part 3);

“declaration of invalidity” means a declaration under Part 2, Division 10 that a registration is invalid;

“director”, in relation to a body corporate whose affairs are managed by its members, means any member of the body;

“domestic application” means an application for registration;

“domestic registration” means the registration of a trade mark granted under Part 2;

“earlier right”, in relation to a trade mark, means a right that would prevent the use of the trade mark under Article 35 (relative grounds for refusal – earlier rights);

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

“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;

“exclusive licence” means a licence mentioned in Article 101(1) or 109(1);

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

“final decision” means a decision from which no appeal may be brought;

“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 in the registered trade mark in accordance with Article 104 (exclusive rights);

“infringement proceedings” means Court proceedings brought under Part 6 –

- (a) for the infringement of a registered trade mark; or
- (b) for an order under Article 122 (order for delivery up of infringing goods etc);

“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 application” has the meaning given in Article 65(2) (application and interpretation of Division 2);

“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”, in relation to a trade mark, means the registration of the trade mark in the International Register for the purposes of the Madrid Protocol;

“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 6 of the Registrar’s Law;

“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;

“Madrid Regulations” means the Regulations under the Protocol relating to the Madrid Agreement concerning the International Registration of Marks (as in force on 1 November 2021);

“Minister” means the Minister for External Relations;

“notice of importation” means a notice of importation of prohibited goods under Article 128;

“notice of opposition” means a notice of opposition under Article 30 (notice of opposition and observations);

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

“opposition period” means the time for giving a notice of opposition specified by the Minister in an Order under Article 30(3);

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

“overseas application” has the meaning given in Article 21 (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 128 (notice of importation of prohibited goods);

“protected international trade mark (Jersey)” has the meaning given in Article 64;

“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 2;

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

“registered trade mark” means a trade mark –

- (a) that is granted registration under Part 2 or is granted protection in Jersey under Part 3 or Schedule 3, paragraph 5 or 6 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 14 (registration of transactions affecting registered trade mark);
- “Registrar” means the person appointed as the Registrar of Intellectual Property under Article 2 of the Registrar’s Law;
- “Registrar’s Law” means the Registrar of Intellectual Property (Jersey) Law 202-;
- “Registrar’s website” means the website maintained by the Registrar under the Registrar’s Law;
- “request for territorial extension” has the meaning given in Article 64 (interpretation of Part 3);
- “requirements for registration” means –
 - (a) the requirements relating to an application for registration set out in Article 22 (application for registration); and
 - (b) any requirements relating to an application for registration contained in an Order by the Minister under this Law;
- “subsequent request for territorial extension” has the meaning given in Article 64 (interpretation of Part 3);
- “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” includes any business or profession;
- “trade mark” has the meaning given in Article 2;
- “transformation application” means an application for registration made under Article 85 as a result of the cancellation of an international registration;
- “UK extended legislation” has the meaning given in Article 1 of the [Legislation \(Jersey\) Law 2021](#);
- “well-known trade mark” has the meaning given in Article 127 (protection of well-known trade marks);
- “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 this Law, the proprietor of an earlier right in relation to a trade mark means a person who is entitled under Article 35 (relative grounds for refusal – earlier rights) to prevent the use of the trade mark.
- (4) References in this Law to the proprietor of a well-known trade mark are construed in accordance with Article 127(6) (protection of well-known trade marks).
- (5) In this Law, a reference to an international registration that extends to Jersey is a reference to an international trade mark granted protection in Jersey under –
 - (a) Part 3; or
 - (b) Schedule 3, paragraph 5 or 6.

- (6) 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.
- (7) Nothing in this Law affects rights of action against a person for passing off, or any remedies for passing off.

2 Meaning of trade mark

- (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 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.
- (4) 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 from goods or services that are not.

3 Meaning of collective mark

- (1) In this Law, "collective mark" means a trade mark that –
 - (a) is described as a collective mark in the application for registration of that trade mark; and
 - (b) if the applicant for registration is an association, is capable of distinguishing goods or services of members of the association from goods or services of other undertakings.
- (2) Schedule 1 makes further provision for collective marks.

4 Meaning of certification mark

- (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 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

- (1) In this Law, “earlier trade mark”, in relation to a trade mark (trade mark A), means –
 - (a) a trade mark entered in the register of trade marks under a paragraph in Schedule 3 (transitional provisions) with a date of registration under that paragraph that is earlier than the date of registration of trade mark A (taking account of any date of priority for either application);
 - (b) a registered trade mark with a date of registration earlier than the date of registration of trade mark A (taking account of any date of priority for either application); or
 - (c) a trade mark that, at the date of registration of trade mark A, 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), subject to its being registered.

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 governed by public law.
- (3) In Part 6 (infringement of registered trade mark), “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.
- (2) In Article 52 (grounds for revoking registration) and for the purpose of the “use conditions” in Articles 31(3) (relative grounds for refusal in opposition proceedings – non-use) and 56(3) (refusal of application for declaration of invalidity – earlier trade mark) –
 - (a) “use”, in relation to a trade mark, includes use in a variant form (whether or not the trade mark in its 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 or to the packaging of goods in Jersey, solely for export purposes.
- (3) A variant form of a trade mark is a form differing in elements that do not alter the distinctive character of the trade mark in the form in which the trade mark was registered.

8 Burden of proving use of trade mark

In 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.

9 Similarity of goods and services under classification system

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 classification system specified by the Minister in an Order under Article 12 (classification of goods and services for domestic registrations);
- (b) are not to be regarded as dissimilar from each other on the ground that they appear in different classes under that classification system.

PART 2

REGISTRATION OF TRADE MARKS IN JERSEY

DIVISION 1 – APPLICATION OF PART 2

10 Application of Part 2

- (1) Unless expressly stated otherwise, this Part applies to –
 - (a) a transformation application in the same way as it applies to a domestic application;
 - (b) a request for territorial extension of an international registration to Jersey in the same way as it applies to a domestic application; and
 - (c) an international registration that extends to Jersey in the same way as it applies to a domestic registration.
- (2) In this Part, unless expressly stated otherwise –
 - (a) “application for registration” includes a request for territorial extension;
 - (b) “date of application for registration” includes the date of request for territorial extension;
 - (c) “applicant for registration” includes the holder of an international registration that is the subject of a request for territorial extension to Jersey;
 - (d) “registered proprietor” includes the holder of an international registration that extends to Jersey;
 - (e) “date of application for registration” includes the date of request for territorial extension;
 - (f) a reference to registering a trade mark includes a reference to granting protection in Jersey to an international trade mark under Part 3 or Schedule 3, paragraph 5 or 6;

- (g) a reference to the goods or services for which a trade mark is registered includes a reference to the goods or services for which a protected international trade mark (Jersey) confers protection;
 - (h) a reference to the publication of an application for registration includes a reference to the publication of an international registration or subsequent request for territorial extension under Article 3~~ter~~(1) or (2) of the Madrid Protocol.
- (3) In this Part, as applied by paragraph (1), “date of filing” of a request for territorial extension means the date of request for territorial extension of the international registration to Jersey (but see Article 82(7)).

DIVISION 2 – REGISTER OF TRADE MARKS

11 Register of trade marks

- (1) The Registrar must maintain a register of trade marks.
- (2) The Registrar must enter in the register –
 - (a) a trade mark that is granted registration under this Part;
 - (b) a protected international trade mark (Jersey);
 - (c) the name and address of the proprietor of the trade mark;
 - (d) the date of registration of the trade mark;
 - (e) the date on which the trade mark is entered in the register;
 - (f) any date of priority;
 - (g) the number of the registration;
 - (h) the goods or services for which the trade mark is registered;
 - (i) particulars of registrable transactions that are required to be registered under Article 14 (registration of transactions affecting registered trade mark);
 - (j) any disclaimer or limitation required to be registered under Article 106 (rights subject to disclaimer or limitation);
 - (k) any disclaimer or limitation entered in the International Register in relation to a protected international trade mark (Jersey);
 - (l) the date of any renewal;
 - (m) other matters specified by the Minister in an Order under paragraph (3).
- (3) The Minister may by Order specify other matters that must be entered in the Register in relation to registered trade marks.

12 Classification of goods and services for domestic registrations

- (1) The Minister must by Order specify a system for classifying goods and services (“classification system”) for the purpose of domestic registrations.
- (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.

- (4) This Article does not apply to an international registration that extends to Jersey or that is the subject of a request for territorial extension to Jersey.

13 Adapting domestic registrations to new classification

- (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 domestic registrations.
- (2) The Order may in particular provide for the Registrar to amend domestic registrations so that the registrations accord with the new classification.
- (3) The Registrar must not exercise the power of amendment under paragraph (2) to extend the rights conferred by a registration unless it appears to the Registrar that –
- (a) compliance with the requirement of this paragraph 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 required by the Registrar.
- (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 required by the Registrar.
- (7) This Article does not apply to an international registration that extends to Jersey or that is the subject of a request for territorial extension to Jersey.

14 Registration of transactions affecting registered trade mark

- (1) The following are registrable transactions –
- (a) the assignment or other transmission of a registered trade mark or a right in it;
 - (b) a change in the ownership of an international registration that extends to Jersey, that is recorded in the International Register by the International Bureau under Article 9 of the Madrid Protocol and is notified to the Registrar under Article 86 of this Law (effect of changes recorded in International Register);
 - (c) the grant of a licence under a registered trade mark;
 - (d) the grant of a licence under an international registration that extends to Jersey, that is recorded in the International Register by the International Bureau under Rule 20*bis* of the Madrid Regulations and is notified to the Registrar under Article 86 of this Law;
 - (e) any other change in relation to an international registration that extends to Jersey, that is recorded in the International Register by the International

Bureau under Article 9*bis* of the Madrid Protocol and is notified to the Registrar under Article 86 of this Law.

- (2) The Minister must by Order specify the particulars of a registrable transaction that must be registered.
- (3) The Registrar must register those 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.
- (4) For an international registration that extends to Jersey –
 - (a) the particulars of a registrable transaction that must be registered are those matters notified to the Registrar under Article 86; and
 - (b) the Registrar must register those particulars on receipt of the notice under that Article.
- (5) Until an application has been made to the Registrar under paragraph (3) or a request has been made to the International Bureau to record the change in the International Register –
 - (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 118 (right of licensee to bring infringement proceedings) and 119 (right of exclusive licensee to bring infringement proceedings in own name).
- (6) Paragraph (7) 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 required particulars of the registrable transaction are registered.
- (7) In infringement proceedings brought by the registered proprietor or a licensee, the Court must not award costs to the proprietor or licensee unless –
 - (a) before the end of the 6-month period beginning with the date of the registrable transaction –
 - (i) an application to the Registrar under paragraph (3) is made; or
 - (ii) a request to the International Bureau to record the change in the International Register is made; or
 - (b) the Court is satisfied that –
 - (i) it was not practicable for the application or request to be made before the end of that period; and
 - (ii) the application or request was made as soon as practicable after the end of that period.

15 Amendment of registered particulars

- (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 at the end of a period specified in the Order after notifying the parties of the intention to remove the registered particulars from the register.
- (2) If the Minister does not make an Order under paragraph (1), the Registrar may amend the registered particulars as the Registrar thinks fit.
- (3) In this Article, “registered particulars” means particulars of a registrable transaction entered in the register.

16 Rectification of register of trade marks

- (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 must not relate to 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 proceedings before the Registrar.
- (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 remove from the register any matter appearing to the Registrar to have ceased to have effect.
- (7) 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 specified by the Minister in an Order under Article 154 (Orders generally).
- (8) Paragraph (7) does not apply to an international registration that extends to Jersey.

17 Alteration of registered trade mark

- (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) If the Registrar proposes to allow an alteration under paragraph (2), the Registrar must publish the registered trade mark, as altered, on the Registrar’s website.

- (4) The Minister must by Order provide for the making of objections by a person claiming to be affected by a proposed alteration.
- (5) This Article does not apply to an international registration that extends to Jersey.

18 Notice of trusts

The Registrar –

- (a) is not affected by a notice of trust (express, implied or constructive); and
- (b) must not enter a notice of trust in the register of trade marks.

DIVISION 3 – DATE OF FILING AND DATE OF PRIORITY

19 Date of filing (domestic application)

- (1) The date of filing of a domestic application is the date on which the applicant provides to the Registrar documents containing everything required by Article 22(2) (application for registration).
- (2) If documents required to be provided to the Registrar under Article 22(2) are provided on different days, the date of filing is the last of those days.
- (3) This Article does not apply to a request for territorial extension of an international registration to Jersey.

20 Right of priority on basis of Convention application

- (1) This Article applies if –
 - (a) an applicant for registration of a trade mark has previously filed a Convention application (or is the successor in title to the rights in that 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 equivalent to a regular national filing.
- (2) The applicant has a right of priority (for the purposes of registering the same trade mark under this Act for some or all of the same goods or services) on the basis of the Convention application for the 6-month period beginning with the day after 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 application for registration of the trade mark is made within the priority period –
 - (a) the date of priority for the application for registration (for the purposes of establishing which rights take precedence) is the date of filing of the Convention application; and
 - (b) the registrability of the trade mark is not affected by any use in Jersey of the trade mark 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 for a domestic application on the basis of a Convention application.
- (6) For a request for territorial extension of an international registration to Jersey, the manner of claiming priority must be determined in accordance with the Madrid Protocol and the Madrid Regulations.
- (7) 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”).
- (8) 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 at the time of the subsequent application –
 - (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) a right of priority has not been claimed on the basis of the previous Convention application.
- (9) If paragraph (8) applies, the previous Convention application cannot subsequently serve as a basis for claiming a right of priority under this Article.
- (10) This Article applies in relation to a Convention application filed before, on or after the commencement date.
- (11) In this Article, “regular national filing” means a filing that was adequate to establish the date of filing of the application in the Convention country, regardless of the outcome of the application.

21 Right of priority on basis of other overseas application

- (1) This Article applies if an applicant for registration of a trade mark –
 - (a) has previously filed an overseas application in relation to the same trade mark and some or all of the same goods or services; or
 - (b) is the successor in title to the rights in that overseas application.
- (2) The States may by Regulations provide for conferring on the applicant for registration of the trade mark a right of priority, for a specified period, on the basis of the overseas application.
- (3) The Regulations may –
 - (a) make provision corresponding to that made by Article 20 (right of priority on basis of Convention application) in relation to Convention applications; and
 - (b) make other provision that the States consider appropriate.
- (4) If Regulations are made under this Article, the Minister may by Order provide for how the applicant may claim the right of priority.
- (5) In this Article –
 - “overseas application” means an application for protection of a trade mark where that application is filed before, on 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 has 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 4 – APPLICATION FOR REGISTRATION

22 Application for registration

- (1) An application for registration of a trade mark must be made to the Registrar in the form and manner required by the Registrar.
- (2) An application for registration must contain –
 - (a) a request to register a trade mark;
 - (b) the name and address of the applicant;
 - (c) a statement of the goods or services to which the application for registration relates;
 - (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) An 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 to which the application for registration relates; or
 - (b) that the applicant has a *bona fide* intention that it will be used in that way.
- (4) Paragraphs (1) and (2) do not apply to a request for territorial extension of an international registration to Jersey.

23 Application for trade mark registration fee

- (1) An application for registration is subject to the payment of an application for trade mark registration fee.
- (2) The Minister must by Order specify the period within which an application for trade mark registration fee must be paid.
- (3) The applicant is taken to have withdrawn an application for registration if the application for trade mark registration fee is not paid within that period.
- (4) This Article does not apply to a request for territorial extension of an international registration to Jersey.

24 Examination and acceptance of application for registration

- (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)(b).
- (4) The Registrar must accept the application if it appears to the Registrar that the application meets the requirements for registration.
- (5) This Article does not apply to a request for territorial extension of an international registration to Jersey.

25 Publication of application for registration

- (1) If the Registrar accepts an application for registration under Article 24 (examination and acceptance of application for registration), the Registrar must publish the application on the Registrar's website.
- (2) When publishing an application, the Registrar must –
 - (a) inform the public of the right to give a notice of opposition and make observations under Article 30 (notice of opposition and observations); and
 - (b) specify the number allocated to the application for registration.

26 Withdrawal or amendment of application for registration

- (1) An applicant for registration of a trade mark may at any time –
 - (a) withdraw the application for registration; or
 - (b) amend the application to restrict the goods or services to which the application for registration relates.
- (2) If the application for registration has been published on the Registrar's website under Article 25, the Registrar must publish a withdrawal or amendment under paragraph (1) in the same manner.
- (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 of 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 to which the application for registration relates.
- (5) Paragraph (3) does not apply to a request for territorial extension of an international registration to Jersey.
- (6) 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 to which the application for registration relates; and
- (b) the making of objections by a person claiming to be affected by the amendment.

27 Provision of information about published applications and registered trade marks

- (1) This Article applies if an application for registration has been published under Article 25.
- (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 the Registrar think fit;
 - (b) be accompanied by any fee set by the Commission under Article 9 of the Registrar's Law for the inspection or provision of documents under this Law; 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.

28 Provision of information before application is published

- (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 25.
- (2) Paragraph (1) does not apply if –
 - (a) the applicant for registration of the trade mark has consented to the publication or communication of the information or documents;
 - (b) paragraph (3) applies, and the person makes a request under Article 27 (provision of information about published applications); or
 - (c) any circumstance specified in an Order under paragraph (4) applies.
- (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 25.
- (4) The Minister may by Order specify circumstances in which paragraph (1) does not apply.
- (5) In paragraph (1), "information" includes any information recorded in the International Register in relation to an international registration.

29 Requirement to notify transactions affecting applicant's property rights

- (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) a change in the ownership of an international registration that is the subject of a request for territorial extension to Jersey, that is recorded in the International Register by the International Bureau under Article 9 of the Madrid Protocol and is notified to the Registrar under Article 86 of this Law (effect of changes recorded in International Register);
 - (c) the grant of a licence to use the trade mark to which an application for registration relates;
 - (d) the grant of a licence under an international registration that is the subject of a request for territorial extension to Jersey, that is recorded in the International Register by the International Bureau under Rule 20*bis* of the Madrid Regulations and is notified to the Registrar under Article 86 of this Law;
 - (e) any other matter in relation to an international registration that is the subject of a request for territorial extension to Jersey, that is recorded in the International Register by the International Bureau under Article 9*bis* of the Madrid Protocol and is notified to the Registrar under Article 86 of this Law.
- (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 5 – OPPOSITION PROCEEDINGS**30 Notice of opposition and observations**

- (1) This Article applies if an application for registration of a trade mark has been published under Article 25.
- (2) Any 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 containing the matters specified in the Order; and
 - (b) be given within the time and in the manner specified in the Order.
- (5) A notice of opposition filed on the basis of 1 or more earlier trade marks or earlier rights may be filed on the basis of some or all of the goods or services for which the earlier trade mark or earlier right is protected or applied for.

- (6) If a notice of opposition is filed on the basis of more than 1 earlier trade mark or earlier right, all the rights must belong to the same proprietor.
- (7) A notice of opposition may be directed against some or all of the goods or services for which the contested trade mark is applied for.
- (8) A person may, at any time before the registration of the trade mark, make written observations to the Registrar as to whether the trade mark should be registered.
- (9) The Registrar must inform the applicant for registration of the trade mark of any observations made under paragraph (8).
- (10) A person does not become a party to opposition proceedings by making observations under paragraph (8).

31 Relative grounds for refusal in opposition proceedings – non-use

- (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 of a kind falling within Article 5(1)(a) to (c) –
 - (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 34 (relative grounds for refusal of registration – identical or similar to earlier trade mark) 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 the registered proprietor or with the registered proprietor’s consent) in relation to the goods or services for which the earlier trade mark is registered; or
 - (b) the earlier trade mark has not been used in accordance with sub-paragraph (a), but there are proper reasons for the 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 32 (absolute grounds for refusal – general), Article 33 (absolute grounds for refusal - prohibitions) or Article 35 (relative grounds for refusal – earlier rights); or
 - (b) the making of an application for a declaration of invalidity on the grounds in Article 55(3) (grounds for invalidity of registration).

DIVISION 6 – GROUNDS FOR REFUSING REGISTRATION

32 Absolute grounds for refusal – general

- (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 exclusively 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 exclusively 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 (registration of 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 exclusively 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) is of such a nature as to deceive the public (for instance, as 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.

33 Absolute grounds for refusal – prohibitions

- (1) The Registrar must refuse registration of a trade mark if or to the extent that the use in Jersey of that trade mark is prohibited under any enactment, UK extended legislation or customary law that does not relate to trade marks.
- (2) The Registrar must refuse registration of a trade mark if the registration of that trade mark is prohibited under –
 - (a) any enactment, UK extended legislation or customary law that provides for the protection of designations of origin or geographical indications; or
 - (b) any international agreement that extends to Jersey and provides for the protection of designations of origin or geographical indications.
- (3) The Registrar must refuse registration of a trade mark if the registration of that trade mark is prohibited under –

- (a) any enactment, UK extended legislation or customary law that provides for the protection of traditional terms for wine or traditional specialities guaranteed; or
- (b) any international agreement that extends to Jersey and provides for the protection of traditional terms for wine or traditional specialities guaranteed.

34 Relative grounds for refusal – identical or similar to earlier trade mark

- (1) The Registrar must refuse registration of a trade mark on any ground in paragraphs (2) to (4), but only if the proprietor of the earlier trade mark raises an objection in opposition proceedings on that ground.
- (2) The ground is –
 - (a) the trade mark is identical to the earlier trade mark; and
 - (b) the goods or services to which the application for registration relates are identical to the goods or services for which the earlier trade mark is protected.
- (3) The ground is 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 to the earlier trade mark; and
 - (b) the goods or services to which the application for registration relates are similar to those for which the earlier trade mark is protected.
- (4) The ground is there is a likelihood of confusion on the part of the public if the trade mark is registered because –
 - (a) the trade mark is similar to the earlier trade mark; and
 - (b) the goods or services to which the application for registration relates are identical or similar to those for which the earlier trade mark is protected.
- (5) The Registrar must refuse registration of a trade mark if or to the extent that paragraph (6) applies.
- (6) This paragraph applies if –
 - (a) the proprietor of an earlier trade mark raises an objection in opposition proceedings on the ground that the trade mark is identical or similar to the earlier trade mark;
 - (b) the earlier trade mark has a reputation in Jersey; and
 - (c) 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.
- (7) Paragraph (6) applies whether or not the goods or services to which the application for registration relates are identical, similar or not similar to those for which the earlier trade mark is protected.
- (8) This Article does not prevent the registration of a trade mark if the proprietor of the earlier trade mark consents to the registration.
- (9) In this Article, “likelihood of confusion” includes the likelihood of association with the earlier trade mark.

35 Relative grounds for refusal – earlier rights

- (1) The Registrar must refuse registration of a trade mark if or to the extent that any ground in paragraphs (2) to (4) applies, but only if the proprietor of the earlier right raises an objection in opposition proceedings on that ground.
- (2) The ground is –
 - (a) the use in Jersey of the trade mark is liable 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 the date of application for registration of the trade mark (or any date of priority for that application).
- (3) The ground is –
 - (a) the use in Jersey of the trade mark is liable to be prevented by any enactment, UK extended legislation or customary law providing for protection of designations of origin or geographical indications;
 - (b) an application for a designation of origin or geographical indication was made before the date of application for registration of the trade mark (or any date of priority for that application); and
 - (c) as a result of the earlier application, the designation of origin or geographical indication is registered.
- (4) The ground is that the use in Jersey of the trade mark is liable to be prevented by any other right in relation to the trade mark, in particular a right arising from the law of copyright or the law relating to industrial property rights.
- (5) This Article does not prevent the registration of a trade mark if the proprietor of the earlier right consents to the registration.

36 Relative grounds for refusal – application without proprietor's consent

- (1) The Registrar must refuse registration of a trade mark on the ground in paragraph (2), but only if the proprietor of the trade mark raises an objection in opposition proceedings on that ground.
- (2) The ground is that –
 - (a) an agent or representative of the proprietor of the trade mark applies for the registration of the trade mark in their own name, without the proprietor's consent; and
 - (b) the agent or representative does not justify their action.

37 Grounds for refusal relating to only some goods or services

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

38 Specially protected emblems

- (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 the relevant 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 any 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 of the trade mark 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 to which paragraph (4)(b) applies.
- (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 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 to which paragraph (6)(a) applies.
- (8) Paragraph (6) does not apply if it appears to the Registrar that the person entitled to the arms 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 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 that 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 sub-paragraph (a).

39 National emblems of Convention countries

- (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 the 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.

40 Emblems of international organisations

- (1) This Article applies to a trade mark that consists of the emblem, abbreviation or name of an international organisation if the emblem, abbreviation or name is protected under the Paris Convention or the WTO Agreement.
- (2) The Registrar must refuse registration of the trade mark unless –
 - (a) the international organisation has authorised the registration; or
 - (b) it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed –
 - (i) is not such as to 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 as to the existence of a connection between the user and the international organisation.
- (3) An international organisation whose authorisation is or would be required under paragraph (2) is entitled to restrain by injunction the use in Jersey of the trade mark without its authorisation.
- (4) This Article does not affect the rights of a person whose *bona fide* 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.
- (5) In this Article –
 - (a) “international organisation” means an international intergovernmental organisation of which 1 or more Convention countries are members;
 - (b) “emblem, abbreviation or name” of an international organisation means –
 - (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) a provision about the emblem of an international organisation applies equally to anything that from a heraldic point of view imitates the emblem.

41 Notification under Article 6~~ter~~ of the Paris Convention

- (1) For the purposes of Article 39 (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 under Article 6~~ter~~(3) of the Paris Convention that it wishes to protect that emblem, sign or hallmark;
 - (b) the notification remains in force; and
 - (c) Jersey has not objected to it under Article 6~~ter~~(4) of the Paris Convention, or if an objection was made, it has been withdrawn.
- (2) For the purposes of Article 40 (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 under Article 6~~ter~~(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 under Article 6~~ter~~(4), or if an objection was made, it has been withdrawn.
- (3) Notification under Article 6~~ter~~(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 that have protection under the Paris Convention because of a notification under Article 6~~ter~~(3).

- (5) In this Article, references to Article 6^{ter} of the Paris Convention include a reference to that Article as applied by the WTO agreement.

DIVISION 7 – REGISTRATION OF TRADE MARK

42 Application of Division 7

This Division does not apply to –

- (a) a request for territorial extension of an international registration to Jersey; or
- (b) an international registration that extends to Jersey.

43 Registration of trade mark

- (1) The Registrar must register a trade mark if the Registrar has accepted an application for registration of the trade mark under Article 24 (examination and acceptance of application for registration) and –
 - (a) no notice of opposition is given within the time mentioned in Article 30(3) (notice of opposition and observations); or
 - (b) all opposition proceedings are withdrawn or decided in favour of the applicant for registration.
- (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 Registrar must not register a trade mark unless the application for trade mark registration fee is paid within the period specified by the Minister in an Order under Article 23 (application for trade mark registration fee).

44 Period of registration

- (1) The Registrar must register a trade mark for a 10-year period beginning with the date of registration.
- (2) The Registrar may renew the registration of a trade mark under Article 48 (renewal of registration) for further periods of 10 years.

45 Publication and certificate of registration

- (1) On the registration of a trade mark, the Registrar must –
 - (a) publish the registration on the Registrar's website; and
 - (b) issue a certificate of registration to the registered proprietor.
- (2) When publishing a registration, the Registrar must specify the date on which the trade mark was entered in the register of trade marks.

46 Registration: supplementary provisions

- (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 8 – RENEWAL, RESTORATION AND SURRENDER OF REGISTRATION**47 Application of Division 8**

This Division does not apply to an international registration that extends to Jersey.

48 Renewal of registration

- (1) The Registrar must renew the registration of a trade mark –
 - (a) at the request of the registered proprietor;
 - (b) on payment of the renewal of trade mark registration fee; and
 - (c) if the Minister has made an Order under Article 49(2) (Orders relating to renewal and restoration), on payment of any additional 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 Article 49(2)); and
 - (b) is accompanied by the renewal of trade mark registration fee (and any additional renewal fee).
- (3) If a request for renewal is made, or the renewal of trade mark registration fee (and any additional 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) Renewal takes effect from the end of the previous period of registration.
- (5) The Registrar must publish a renewal on the Registrar’s website.

- (6) When publishing a renewal, the Registrar must specify the date on which the renewal was entered in the register of trade marks.
- (7) 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 of trade marks.
- (8) In this Article –
 - “additional renewal fee” means any additional renewal fee set by the Commission under Article 9 of the Registrar’s Law; and
 - “renewal of trade mark registration fee” means the renewal of trade mark registration fee set by the Commission under Article 9 of the Registrar’s Law.

49 Orders relating to renewal and restoration

- (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;
 - (b) the manner in which the registration may be renewed.
- (2) The Minister may by Order extend the period for requesting a renewal of registration by at least 6 months.
- (3) The Minister may by Order –
 - (a) provide for the restoration of a registration that has been removed from the register;
 - (b) provide for the publication of a restoration; and
 - (c) specify conditions that must be met before a registration can be restored.

50 Surrender of registered trade mark

- (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 9 – REVOCATION OF REGISTRATION

51 Application for revocation

- (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 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 proceedings before the Registrar.

52 Grounds for revoking registration

- (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 day after the day on which 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 the 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) in relation to the goods or services for which the trade mark is registered, the registered trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- (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 cease to have effect 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 10 – DECLARATION OF INVALIDITY OF REGISTRATION

53 Application for declaration of invalidity

- (1) Unless paragraph (2) applies, any person may apply for a declaration that the registration of a trade mark is invalid.

- (2) Only the proprietor (or licensee or authorised user) of an earlier trade mark or the proprietor of an earlier right may apply for a declaration of invalidity on the grounds in Article 55(3) (grounds for invalidity of registration).
- (3) 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.
- (4) 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 proceedings before the Registrar.
- (5) The Registrar may apply to the Court for a declaration that the registration of a trade mark is invalid if the application for registration of the trade mark was made in bad faith.
- (6) An application for a declaration of invalidity may be filed on the basis of 1 or more earlier trade marks or earlier rights.
- (7) If an application for a declaration of invalidity is filed on the basis of more than 1 earlier trade mark or earlier right, all the rights must belong to the same proprietor.

54 Declaration of invalidity

- (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.

55 Grounds for invalidity of registration

- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of –
 - (a) Article 32 (absolute grounds for refusal – general), 33 (absolute grounds for refusal – prohibitions), 38 (specially protected emblems), 39 (national emblems of Convention countries) or 40 (emblems of international organisations); or
 - (b) any provision mentioned in those Articles.
- (2) If the trade mark was registered in breach of Article 32(1)(b), (c) or (d) (absolute grounds for refusal – general), the registration must not be declared invalid if, as a result of the use that 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 56 (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 34 applies (relative grounds for refusal – identical or similar to earlier trade mark); or
 - (b) there is an earlier right in relation to the registered trade mark.

- (4) But paragraph (3) does not apply if the proprietor of the earlier trade mark or 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 36 (relative grounds for refusal – application without proprietor’s consent).

56 Refusal of application for declaration of invalidity – earlier trade mark

- (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(1)(d) (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 the registered proprietor or with the registered proprietor’s consent) in relation to the goods or services for which the earlier trade mark 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 52(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 the 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, it is taken for the purposes of this Article to be registered only in relation to those goods or services.
- (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 that –
 - (a) on that date, the earlier trade mark was liable to be declared invalid on the basis of Article 32(1)(b), (c) or (d) (absolute grounds for refusal – general), and it had not yet acquired a distinctive character as a result of the use made of it;
 - (b) the application for a declaration of invalidity is based on Article 34(3) or (4) (relative grounds for refusal – identical or similar to earlier trade mark) and on that date the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of that Article;

- (c) the application for a declaration of invalidity is based on Article 34(6) (relative grounds for refusal – identical or similar to earlier trade mark) and on that date the earlier trade mark had not yet acquired a reputation in Jersey.

57 Effect of acquiescence

- (1) This Article applies if the proprietor of an earlier trade mark or 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 earlier right ceases to be entitled, on the basis of the earlier trade mark or 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 for which it has been used.
- (3) The proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or the exploitation of the earlier right, even though the earlier trade mark or earlier right may no longer be invoked against the later trade mark.
- (4) Paragraph (2) does not apply if the application for registration of the later trade mark was made in bad faith.

DIVISION 11 – LEGAL PROCEEDINGS RELATING TO REGISTRATION

58 Costs and security for costs in proceedings before Registrar

- (1) This Article applies to the award of costs in 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 in 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.
- (3) The award of costs may be enforced in the same way as an order of the Court.

59 Evidence in proceedings before Registrar

- (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.

60 Registration of proprietor *prima facie* evidence of valid registration

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;
- (b) any assignment or other transmission of the registered trade mark; and
- (c) for an international registration that extends to Jersey, a change in the ownership of the international registration.

61 Certificate of valid registration

- (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.
- (4) In this Article, “indemnity basis” has the same meaning as in Part 12 of the [Royal Court Rules 2004](#).

62 Registrar’s appearance in Court proceedings

- (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 51;
 - (b) a declaration of invalidity under Article 53;
 - (c) the rectification of the register of trade marks under Article 16.
- (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 Commission authorised under Article 2 of the Registrar's Law (appointment of Registrar of Intellectual Property) to act on behalf of the Registrar in that regard.

63 Power to release Registrar from Court proceedings

- (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 51;
 - (b) a declaration of invalidity under Article 53;
 - (c) the rectification of the register of trade marks under Article 16;
 - (d) an appeal under Article 153 (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 of a trade mark; 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 3

INTERNATIONAL REGISTRATION

DIVISION 1 – INTERPRETATION OF PART 3

64 Interpretation of Part 3

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”, in relation to an international registration, means –

- (a) the date of international registration; or

(b) if later, the date on which a subsequent request for territorial extension of the international registration is recorded by the International Bureau;

“notice of provisional refusal”, in relation to a request for territorial extension of an international registration to Jersey, means a notice under –

(a) Article 73 (notice of provisional refusal); or

(b) Article 74 (notice of provisional refusal based on opposition);

“opponent” means a person who opposes a request for territorial extension of an international registration to Jersey;

“protected international trade mark (Jersey)” means an international trade mark granted protection in Jersey under this Part or under Schedule 3, paragraph 5 or 6;

“protection” means protection granted to an international trade mark in Jersey under this Part or under Schedule 3, paragraph 5 or 6;

“refusal period”, in relation to a request for territorial extension of an international registration to Jersey, means 1 year beginning with the date of request for territorial extension, or any longer period specified by the Minister in an Order under Article 154 (Orders generally);

“request for territorial extension”, in relation to an international registration, means a request under Article 3^{ter}(1) or (2) of the Madrid Protocol to extend the protection resulting from the international registration;

“subsequent request for territorial extension”, in relation to an international registration, means a request under Article 3^{ter}(2) of the Madrid Protocol to extend the protection resulting from the international registration.

DIVISION 2 – APPLICATIONS FOR INTERNATIONAL REGISTRATION ORIGINATING FROM JERSEY

65 Application and interpretation of Division 2

(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.

(2) In this Division –

“basic application” means a domestic application on which an international application is based;

“basic registration” means a domestic registration on which an international application is based;

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

“international application” means an application for international registration mentioned in paragraph (1).

66 Requirements for filing and processing international application

(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 proprietor of a trade mark granted registration under Part 2 or they have filed a domestic application with the Registrar.
- (2) An international application must be filed with the Registrar in the form and manner required by the Registrar and must –
- (a) include the information required by Rule 9 of the Madrid Regulations;
 - (b) include or be accompanied by any other document or information –
 - (i) that the Registrar may require; or
 - (ii) that is specified by the Minister in an Order under Article 154 (Orders generally); and
 - (c) be accompanied by any handling fee set by the Commission under Article 9 of the Registrar's Law.
- (3) The Registrar must give the international application a date of receipt.
- (4) If any required handling fee is not paid within a period specified by the Registrar –
- (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.
- (5) The Registrar must send the international application to the International Bureau if the Registrar is satisfied that –
- (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 domestic registration.
- (6) At the time of sending the international application under paragraph (5), 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.
- (7) If, under Rule 11, 12 or 13 of the Madrid 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 in the Madrid 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).
- (8) In this Article, “British citizen”, “British overseas territories citizen”, “British overseas citizen”, “British subject” and “British protected person” have the meanings given in the British Nationality Act 1981 of the United Kingdom.

67 Classification of goods and services

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

68 Cancellation of international registration

- (1) This Article applies if a basic application or a basic registration ceases to have effect (wholly or partially) –
 - (a) before the end of the 5-year period beginning with the day after 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) If this Article applies, the Registrar must –
 - (a) notify the International Bureau under Rule 22 of the Madrid Regulations; and
 - (b) request that the international registration is cancelled to the extent applicable.
- (3) A basic application ceases to have effect –
 - (a) if the application is not accepted or is withdrawn; or
 - (b) if or to the extent that –
 - (i) registration is refused; or
 - (ii) the application is amended to restrict the goods or services to which the application relates.
- (4) A basic registration ceases to have effect –
 - (a) if the registration expires and is not renewed; or
 - (b) if or to the extent that the registration is surrendered, revoked or declared invalid.
- (5) If a basic application or basic registration ceases to have effect in relation to only some of the goods or services to which the basic application or basic registration relates, the request to cancel the international registration must relate to those goods or services only.

69 Division or merger of domestic application or domestic registration

- (1) This Article applies if, before the end of the 5-year period beginning with the day after the date of international registration –
 - (a) the basic application is divided into 2 or more basic applications;
 - (b) 2 or more basic applications are merged into a single basic application;
 - (c) the basic registration is divided into 2 or more basic registrations; or

- (d) the basic registration is merged with another basic registration into a single basic registration.
- (2) The Registrar must notify the International Bureau of the following –
 - (a) the number of the international registration or, if the international registration has not yet been effected, the number of the basic 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) basic application or basic registration resulting from the division; or
 - (ii) basic application or basic registration resulting from the merger.

DIVISION 3 – EXTENSION OF INTERNATIONAL REGISTRATIONS TO JERSEY

70 Application of Division 3

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

71 Classification of goods and services for purposes of protected international trade mark (Jersey)

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 in Jersey to a protected international trade mark (Jersey).

72 Examination, publication and opposition

- (1) The Registrar must examine a request for territorial extension of an international registration to Jersey to determine if –
 - (a) it should be accepted; or
 - (b) it should be refused on any of the grounds under Part 2, Division 6.
- (2) In examining a request for territorial extension, 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, the Registrar must publish the request as if it were a domestic application.
- (4) An opponent may file a notice of opposition with the Registrar within 60 days beginning with the date of publication of the request for territorial extension.
- (5) Part 2, Division 5 (opposition proceedings) applies to a request for territorial extension in the same way that it applies to a domestic application.

73 Notice of provisional refusal

- (1) This Article applies if –

- (a) after examining a request for territorial extension of an international registration to Jersey, the Registrar finds that –
 - (i) a ground for refusing registration under Part 2, Division 6 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 72 (examination, publication and opposition) is not included in the request for territorial extension; or
 - (b) for a collective mark or certification mark that is the subject of the request for territorial extension, regulations governing the use of the collective mark or certification mark have not been filed with the Registrar in accordance with Schedule 1 (registration of collective marks) or Schedule 2 (registration of certification marks).
- (2) If this Article applies, the Registrar must, before the end of the refusal period, send a notice of provisional refusal to the International Bureau.
 - (3) 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 Madrid Regulations.
 - (4) The same remedies available to an applicant for registration of a trade mark under Part 2 are available to the holder of the international registration.
 - (5) The holder of the international registration may, no later than 2 months after being notified by the International Bureau of the provisional refusal, file with the Registrar a written request for a review of the 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 –
 - (a) be filed with the Registrar through a duly appointed agent domiciled in Jersey; and
 - (b) be 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.

74 Notice of provisional refusal based on opposition

- (1) If a notice of opposition is filed with the Registrar within the time specified in Article 72(4) (examination, 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 Madrid Regulations.
- (3) The holder of the international registration may, no later than 2 months after being notified by the International Bureau of the provisional refusal, file with the Registrar a written counter-statement.
- (4) The Registrar may extend the period for filing a counter-statement on the request of the holder made before the end of the time limit in paragraph (3).
- (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.
- (7) After giving the holder and the opponent the opportunity to present their argument (including the opportunity to provide evidence), 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.

75 Statement of grant of protection if no grounds for refusal or opposition

- (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 73 (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 72 (examination, publication and opposition) and there is no obligation for the Registrar under Article 74 (notice of provisional refusal based on 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 18~~ter~~(1) of the Madrid Regulations.

76 Statement of grant of protection following notification of provisional refusal

- (1) If the conditions in paragraph (2) are met, the Registrar must send to the International Bureau –
 - (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 73 (notice of provisional refusal) or 74 (notice of provisional refusal based on opposition); and
 - (b) the Registrar or the Court makes a final decision to grant protection to the international trade mark in Jersey, either totally or partially.
- (3) A statement under paragraph (1) must be sent in accordance with Rule 18~~ter~~(2) of the Madrid Regulations.

77 Statement confirming total refusal

- (1) If the conditions in paragraph (2) are met, the Registrar must send to the International Bureau 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 73 (notice of provisional refusal) or 74 (notice of provisional refusal based on opposition);
 - (b) all procedures before the Registrar have been completed; and
 - (c) the Registrar or the Court makes a final decision to confirm the total refusal of protection of the international trade mark in Jersey, for all goods or services.
- (3) A statement under paragraph (1) must be sent in accordance with Rule 18~~ter~~(3) of the Madrid Regulations.

78 Statement of further decision affecting scope of protection

- (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 75 (statement of grant of protection if 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 76 (statement of grant of protection following notification of provisional refusal); or
 - (d) the Registrar has sent a statement confirming total refusal under Article 77 (statement confirming total refusal).
- (2) If a further decision is taken by the Court or the Registrar that reduces or extends the scope of that protection (if the Registrar is aware of the further decision by the Court), the Registrar must send a further statement to the International Bureau indicating the goods or services for which protection is granted.
- (3) In paragraph (2), “further decision” includes a decision taken by the Court following an appeal under Article 153 against a decision of the Registrar under this Division.
- (4) This Article does not limit the application of Rule 19 of the Madrid Regulations (invalidations in designated contracting parties) or Article 84 of this Law (notification of invalidation).

79 Automatic grant of protection

- (1) An international registration that is the subject of a request for territorial extension to Jersey is automatically extended to Jersey if the Registrar does not send a notice of provisional refusal to the International Bureau before the end of the refusal period.
- (2) If paragraph (1) applies, the international trade mark is taken to be granted protection under this Part as a protected international trade mark (Jersey).

80 Registration of protected international trade mark (Jersey)

The Registrar must enter in the register of trade marks an international trade mark granted protection in Jersey under this Part as a protected international trade mark (Jersey).

81 Domestic registration taken to be replaced by international registration

- (1) A trade mark granted registration under Part 2 is taken to be replaced in the register of trade marks by a protected international trade mark (Jersey) if –
 - (a) the trade mark granted registration under Part 2 and the protected international trade mark (Jersey) are the same trade mark;
 - (b) the registered proprietor is also the holder of the international registration;
 - (c) the international registration lists, in respect of Jersey, some or all of the goods or services to which the domestic registration relates; and
 - (d) the date of request for territorial extension of the international registration to Jersey falls after the date of filing of the domestic application.
- (2) The replacement is taken to have effect from the date of request for territorial extension of the international registration to Jersey.
- (3) The replacement –
 - (a) occurs automatically; and
 - (b) is not dependent on the actions of the holder of the international registration or the Registrar.
- (4) A domestic registration continues to have effect despite –
 - (a) the automatic replacement under paragraph (1); or
 - (b) the Registrar making a note of the replacement in the register.
- (5) The scope of the replacement is limited to the goods or services –
 - (a) that are listed in the international registration in respect of Jersey; and
 - (b) to which the domestic registration also relates.
- (6) This Article continues to apply if the domestic registration –
 - (a) expires and is not renewed; or
 - (b) is surrendered.
- (7) This Article ceases to apply if or to the extent that the domestic registration is revoked or declared invalid.

82 Request to note replacement in register

- (1) This Article applies if a replacement has occurred under Article 81 (domestic registration taken to be replaced by international registration).
- (2) The holder of the international registration may file with the Registrar a written request to make a note of the replacement in the register of trade marks.
- (3) A request under paragraph (2) must be accompanied by the notation fee set by the Commission under Article 9 of the Registrar's Law.
- (4) The Registrar must examine a request under paragraph (2) for compliance with the requirements of Article 81(1) and paragraph (3).
- (5) If the Registrar accepts the request and makes a note of the replacement in the register of trade marks, the Registrar must notify the International Bureau.
- (6) A notification to the International Bureau must include the following particulars –
 - (a) the number of the international registration;
 - (b) if the replacement is in respect of only some of the goods or services listed in the international registration, those goods or services;

- (c) the date of filing of the domestic application;
 - (d) the number of the domestic application;
 - (e) the date on which the domestic registration was granted;
 - (f) the number of the registered trade mark;
 - (g) any date of priority for the domestic application;
 - (h) information relating to any other rights acquired because of the domestic registration.
- (7) If the Registrar makes a note of a replacement under this Article, the international registration, to the extent that it replaces the domestic registration, is taken to have had continued protection in Jersey since the date of filing of the domestic application.

83 Effect of renewal of international registration

An international registration that extends to Jersey, or that is the subject of a request for territorial extension to Jersey, continues to have effect in Jersey if it is renewed in accordance with Article 7 of the Madrid Protocol.

84 Notification of invalidation

The Registrar must notify the International Bureau in accordance with the Madrid Protocol and Madrid Regulations if, in relation to a protected international trade mark (Jersey) –

- (a) the Registrar makes a declaration of invalidity or becomes aware that the Court has made a declaration of invalidity; or
- (b) the Registrar or the Court makes a final decision under Part 2 that revokes the registration of the protected international trade mark (Jersey).

DIVISION 4 – TRANSFORMATION APPLICATIONS

85 Transformation application

- (1) This Article applies if the International Bureau, under Article 6(4) of the Madrid Protocol, cancels an international registration that extends to Jersey or is the subject of a request for territorial extension to Jersey.
- (2) Within the 3-month period beginning with the day after the date on which the international registration was cancelled, the person who was the holder of the international registration immediately before it was cancelled may apply for registration of the trade mark in Jersey (“transformation application”) for some or all of the goods or services that were listed in the international registration.
- (3) The date of registration of a transformation application is –
 - (a) the same date as the date of request for territorial extension of the international registration to Jersey; or
 - (b) any date of priority for that request.
- (4) The date of filing of a transformation application is the date of request for territorial extension of the international registration to Jersey.
- (5) In addition to the requirements in Article 22 (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 of the transformation application;
 - (iii) the date on which the cancellation of the international registration was recorded in the International Register;
 - (iv) any date of priority claimed in the international application and recorded in the International Register; and
 - (d) be accompanied by the transformation application fee set by the Commission under Article 9 of the Registrar's Law.
- (6) The Registrar must accept the transformation application and grant registration of the trade mark under Part 2 if –
- (a) all the requirements under Part 2 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) 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 the request for territorial extension as having been completed for the purpose of the transformation application.

DIVISION 5 – CHANGES IN INTERNATIONAL REGISTER

86 Effect of changes recorded in International Register

- (1) A change recorded in the International Register in relation to an international registration that extends to Jersey, or is the subject of a request for territorial extension to 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) Paragraph (2) does not apply if –
 - (a) the Registrar considers that the change recorded in the International Register has no effect in Jersey as a matter of Jersey law; and
 - (b) the Registrar sends a declaration stating that fact to the International Bureau under –
 - (i) Article 87 (declaration that change in ownership has no effect in Jersey);
 - (ii) Article 88 (declaration that limitation of goods or services has no effect in Jersey); or
 - (iii) Article 89 (declaration that recording of licence has no effect in Jersey).

87 Declaration that change in ownership has no effect in Jersey

- (1) If the Registrar is notified by the International Bureau under Article 86(2) (effect of changes recorded in International Register) of a change in ownership of an international registration that extends to Jersey, or is the subject of a request for 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 Madrid 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 Madrid 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).

88 Declaration that limitation of goods or services has no effect in Jersey

- (1) If the Registrar is notified by the International Bureau under Article 86(2) (effect of changes recorded in International Register) of a limitation of the list of goods or services in an international registration that extends to Jersey, or is the subject of a request for territorial extension to Jersey, the Registrar may declare that the limitation has no effect in Jersey.
- (2) A declaration under paragraph (1) must indicate –
 - (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 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 27(5)(c) of the Madrid 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 Madrid 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).

89 Declaration that recording of licence has no effect in Jersey

- (1) If the Registrar is notified by the International Bureau under Article 86(2) (effect of changes recorded in International Register) of a recording of a licence in respect of an international registration that extends to Jersey, or is the subject of a request for 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 Madrid Regulations.
- (4) The holder of the international registration may file with the Registrar a written request for a review of a declaration made under paragraph (1).
- (5) 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 Madrid Regulations.
- (6) 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.
- (7) The Registrar must notify the International Bureau of a final decision on a request for review made under paragraph (6).

90 Correction of International Register

- (1) This Article applies if the Registrar is notified by the International Bureau of a correction to an international registration that extends to Jersey or is the subject of a request for territorial extension to Jersey.

- (2) On receiving the notification, the Registrar may declare in a notice of provisional refusal to the International Bureau that the Registrar considers that the international trade mark, so far as it is corrected, cannot, or can no longer, be granted protection in Jersey.
- (3) A notice of provisional refusal must be sent –
 - (a) in accordance with the requirements of Article 5 of the Madrid Protocol and Rule 17 of the Madrid Regulations; and
 - (b) within the 12-month period beginning with the date on which the International Bureau notified the Registrar of the correction.

91 Request for division of international registration

- (1) The holder of an international registration that extends to Jersey, or is the subject of a request for territorial extension to Jersey, may file with the Registrar a written request that the International Bureau divide the international registration.
- (2) A request under paragraph (1) must –
 - (a) contain the information specified in Rule 27*bis* of the Madrid Regulations; and
 - (b) be accompanied by the division of international registration fee set by the Commission under Article 9 of the Registrar's Law.
- (3) If the request does not comply with the requirements in paragraph (2), the Registrar must give the holder the opportunity to provide the required information or pay the required fee within a period specified by the Registrar.
- (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 in relation to the request for division within the time limit set by the International Bureau and, if necessary, the Registrar must consult with the holder.
- (7) The Registrar, on receipt of a notification of a division and creation of a divisional international registration sent by the International Bureau under Rule 27*bis*(4)(a) of the Madrid Regulations, 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 and the request for dividing the international registration.
- (9) The Registrar must notify to the International Bureau the relevant decisions concerning the scope of protection for the international registration and of the divisional international registration.

92 Request for merger of previously divided international registrations

- (1) The holder of an international registration that extends to Jersey, or is the subject of a request for territorial extension to Jersey, may file with the Registrar a written

request that the International Bureau merge an international registration previously divided under Article 91.

- (2) A request under paragraph (1) must –
 - (a) contain the information specified in Rule 27*ter* of the Madrid Regulations; and
 - (b) be accompanied by the request for merger fee set by the Commission under Article 9 of the Registrar's Law.
- (3) If the request does not comply with the requirements in paragraph (2), the Registrar must give the holder the opportunity to provide the required information or pay the required fee within a period specified by the Registrar.
- (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 in relation to the request for merger within the time limit set by the International Bureau and, if necessary, the Registrar must consult with the holder.
- (7) The Registrar, on receipt of a notification of the record of a merger in relation to an international registration sent by the International Bureau under Rule 27*ter*(2)(a) of the Madrid Regulations, must update the register of trade marks with the new international registration number for the merged international registrations.

DIVISION 6 – GENERAL

93 Communications between Registrar and International Bureau

- (1) Any communication, including an international application, that is filed with the Registrar for sending to the International Bureau must be in English.
- (2) Any communication from the Registrar in relation to an international application or international registration that is addressed to the International Bureau must be in English.
- (3) Despite any other enactment, UK extended legislation or customary law, the Registrar may communicate to the International Bureau any information that Jersey is required to communicate under –
 - (a) this Part;
 - (b) the Madrid Protocol; or
 - (c) the Madrid Regulations.

94 Order to amend this Law

The Minister may by Order amend this Law as the Minister thinks fit for the purpose of implementing changes to the Madrid Protocol that are extended to Jersey.

PART 4

RIGHTS CONFERRED BY APPLICATION FOR REGISTRATION

95 Application of Part 4

- (1) Unless expressly stated otherwise, this Part applies to a request for territorial extension of an international registration to Jersey in the same way as it applies to a domestic application.
- (2) In this Part, unless expressly stated otherwise –
 - (a) “application for registration” includes a request for territorial extension;
 - (b) “date of application for registration” includes the date of request for territorial extension; and
 - (c) “applicant for registration” includes the holder of the international registration.

96 Applicant’s property rights

- (1) An application for registration that contains everything required by Article 22(2) (application for registration) is movable property.
- (2) Rights in that movable property –
 - (a) are conferred on the applicant on the date of application for registration; and
 - (b) are enforceable in the same way as rights in other movable property are enforceable.
- (3) But infringement proceedings may not be brought before the date on which the Registrar enters the trade mark in the register of trade marks.

97 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) Paragraphs (3) and 4 apply if 2 or more persons are co-applicants, whether under paragraph (1) or otherwise.
- (3) A co-applicant (A) cannot, without the consent of each other co-applicant –
 - (a) grant a licence to use the trade mark to which the application for registration relates; or
 - (b) assign A’s share in the applicant’s property rights.
- (4) Subject to any agreement to the contrary, each co-applicant 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-applicant, any act mentioned in Article 113 (infringement of registered trade mark) that would amount to an infringement of the trade mark if the trade mark were a 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.

98 Application for registration subject to disclaimer or limitation

- (1) An applicant for registration of a trade mark may by written notice to the Registrar –
 - (a) disclaim a 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) If an applicant has disclaimed a right or agreed to a limitation under paragraph (1), the rights conferred by Article 96 (applicant's property rights) are restricted accordingly.
- (3) The Registrar must publish the disclaimer or limitation on the Registrar's website.

99 Transmission of applicant's property rights

- (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 in relation to –
 - (a) some but not all of the goods or services to which the application for registration relates; or
 - (b) the use of the trade mark to which the application for registration relates in a particular manner.
- (4) An 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.
- (5) If the person assigning the applicant's property rights is a body corporate, the requirement in paragraph (4) may be satisfied if the assignment –
 - (a) is sealed with the body corporate's seal; or
 - (b) is signed in a manner authorised by the body corporate's memorandum of association, articles of association or equivalent constitutional documents.
- (6) Paragraphs (1) to (5) apply to assignment by way of security in the same way as they apply to any other assignment.
- (7) Paragraph (3)(b) does not apply to a request for territorial extension of an international registration to Jersey.
- (8) Nothing in this Law affects the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

100 Licence granted by applicant for registration

- (1) An applicant for registration of a trade mark may grant a licence to use the trade mark.
- (2) A licence granted under paragraph (1) 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 to which the application for registration relates; or
 - (b) the use of the 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 –
 - (a) is sealed with the body corporate's seal; or
 - (b) is signed in a manner authorised by the body corporate's memorandum of association, articles of association or equivalent constitutional documents.
- (6) Unless a licence provides otherwise, the licence is binding on a successor in title to the grantor's interest.
- (7) If a licence so provides, the licensee may grant a sub-licence.
- (8) The applicant for registration of the trade mark 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 licence is granted;
 - (d) the territory in which the trade mark may be affixed;
 - (e) the quality of the goods manufactured by the licensee; or
 - (f) the quality of the services provided by the licensee.
- (9) In paragraph (8), "applicant for registration of the trade mark" includes a licensee or sub-licensee if a licence or sub-licence so provides.

101 Exclusive licence granted by applicant for registration

- (1) A licence granted under Article 100 (licence granted by applicant for registration) by an applicant for registration of a trade mark may authorise the licensee to use the 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 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 5

RIGHTS CONFERRED BY REGISTRATION

102 Application of Part 5

- (1) This Part applies to an international registration that extends to Jersey in the same way as it applies to a domestic registration.
- (2) In this Part –
 - (a) “registered proprietor” includes the holder of the international registration;
 - (b) “application for registration” includes a request for territorial extension;
 - (c) “date of application for registration” includes the date of request for territorial extension;
 - (d) “applicant for registration” includes the holder of the international registration;
 - (e) a reference to registering a trade mark includes a reference to granting protection to an international trade mark under Part 3 (international registration) or Schedule 3, paragraph 5 or 6;
 - (f) a reference to the goods or services for which a trade mark is registered includes a reference to the goods or services in respect of which a protected international trade mark (Jersey) confers protection;
 - (g) a reference to the publication of an application for registration includes a reference to the publication of an international registration or subsequent request for territorial extension under Article 3^{ter}(1) or (2) of the Madrid Protocol.

103 Property rights

- (1) A registered trade mark is movable property.
- (2) Rights in that movable property –
 - (a) are conferred on the registered proprietor when the trade mark is registered; and
 - (b) are enforceable in the same way as rights in other movable property are enforceable.
- (3) But no offence is committed under Article 144 (unauthorised use of trade mark in relation to goods) by anything done before the registration of the trade mark is published under Article 45 (publication and certificate of registration).

104 Exclusive rights

- (1) The proprietor of a registered trade mark has exclusive rights in the registered trade mark that are infringed if the registered trade mark is used in Jersey in the circumstances set out in Article 113 (infringement of registered trade mark) without the registered proprietor’s consent.
- (2) Exclusive rights in the registered trade mark have effect from the date of registration.

- (3) This Article does not affect any right acquired in the trade mark before the date of application for registration of the trade mark (or any date of priority for that application for registration).
- (4) In this Article –
 - “registered proprietor’s consent” includes the consent of a licensee or an authorised user;
 - “any right”, in relation to the registered trade mark, means a right in an earlier trade mark or an earlier right.

105 Co-ownership of registered trade mark

- (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) A co-proprietor (A) cannot, without the consent of each other co-proprietor –
 - (a) grant a licence to use the registered trade mark; or
 - (b) assign A’s share 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.

106 Rights subject to disclaimer or limitation

- (1) The proprietor of a registered trade mark may by written notice to the Registrar –
 - (a) disclaim any right to the exclusive use of a specified element of the trade mark; or
 - (b) agree that the rights in the registered trade mark conferred by Article 104 (exclusive rights) 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 104 are restricted accordingly.
- (3) The Registrar must –
 - (a) enter the disclaimer or limitation in the register; and
 - (b) publish the disclaimer or limitation on the Registrar’s website.

107 Transmission of registered trade mark

- (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.
- (5) If the person assigning the registered trade mark is a body corporate, the requirement in paragraph (4) may be satisfied if the assignment –
 - (a) is sealed with the body corporate's seal; or
 - (b) is signed in a manner authorised by the body corporate's memorandum of association, articles of association or equivalent constitutional documents.
- (6) Paragraphs (1) to (5) apply to assignment by way of security in the same way as they apply to any other assignment.
- (7) Paragraph (3)(b) does not apply to a protected international trade mark (Jersey).

108 Licence to use registered trade mark

- (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; or
 - (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 –
 - (a) is sealed with the body corporate's seal; or
 - (b) is signed in a manner authorised by the body corporate's memorandum of association, articles of association or equivalent constitutional documents.
- (6) Unless a licence provides otherwise, the licence is binding on a successor in title to the grantor's interest.
- (7) If a licence so provides, the licensee may grant a sub-licence.
- (8) The registered proprietor 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 and may be used;

- (c) the scope of the goods or services for which the licence is granted;
 - (d) the territory in which the trade mark may be affixed;
 - (e) the quality of the goods manufactured; or
 - (f) the quality of the services provided by the licensee.
- (9) In paragraph (8), “registered proprietor” includes a licensee or sub-licensee if a licence or sub-licence so provides.

109 Exclusive licence granted by registered proprietor

- (1) A licence granted under Article 108 (licence to use registered trade mark) by a registered proprietor may authorise the licensee to use the 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.

110 Prohibition on use of trade mark registered in name of agent or representative

- (1) This Article applies if –
 - (a) an agent or representative of the proprietor of a trade mark registers the trade mark in their own name, without the proprietor’s consent; and
 - (b) the agent or representative does not justify their action.
- (2) The proprietor may –
 - (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); and
 - (b) apply under Article 16 to rectify the register of trade marks to name the proprietor as the registered proprietor.

111 Right to prevent goods entering Jersey without being released for free circulation

- (1) The proprietor of a registered trade mark is entitled to prevent third parties from bringing goods into Jersey in the course of trade without being released for free circulation if paragraph (2) applies.
- (2) This paragraph applies if –
 - (a) the goods are goods for which the trade mark is registered;
 - (b) the goods come from outside Jersey, the United Kingdom or the European Economic Area; and
 - (c) the goods bear, without the registered proprietor’s consent, a sign that –
 - (i) is identical to the registered trade mark; or

- (ii) cannot be distinguished in its essential aspects from the registered trade mark.
- (3) In paragraph (2)(a), 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.
- (4) This Article does not affect any right in relation to the registered trade mark acquired before the date of application for registration of the trade mark (or any date of priority for that application for registration).
- (5) In paragraph (4), “any right”, in relation to the registered trade mark, means a right in an earlier trade mark or an earlier right.
- (6) The entitlement of the registered proprietor under paragraph (1) lapses if –
 - (a) proceedings are initiated under 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.
- (7) In paragraph (6)(b), “declarant” and “holder of the goods” have the meanings given in the European Customs Enforcement Regulation.

112 Reproduction of trade marks in dictionaries, encyclopaedias etc

- (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 6

INFRINGEMENT OF REGISTERED TRADE MARK

DIVISION 1 – INFRINGEMENT OF REGISTERED TRADE MARK

113 Infringement of registered trade mark

- (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 and is used in relation to similar goods or services; or
 - (ii) the sign is similar to the registered trade mark and is used 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, similar or not 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, label, tag, security or authenticity feature or device or other means to which a trade mark may be affixed; and
 - (b) the conditions in paragraph (6) are met.
- (6) The conditions are –
 - (a) there is a risk the packaging, label, tag, security or authenticity feature or device or other means to which a trade mark may be affixed could be used in relation to goods or services; 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, label, tag, security or authenticity feature or device or other means to which a trade mark may be affixed 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, label, tag, security or authenticity feature or device or other means to which a trade mark may be affixed could be used in relation to goods or services; 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;
 - “identical, similar or not similar goods or services” means goods or services that are identical, similar or not similar to those for which the trade mark is registered;
 - “similar goods or services” means goods or services that are similar to those for which the trade mark is registered.

114 Use that does not constitute infringement of registered trade mark

- (1) A registered trade mark (“trade mark A”) is not infringed by the use of a later registered trade mark (“trade mark B”) in relation to the goods or services for which trade mark B is registered if the registration of trade mark B would not be declared invalid under Article 55 (grounds for invalidity of registration) because Article 56(1) (refusal of application for declaration of invalidity – earlier trade mark) or Article 57(1) (effect of acquiescence) applies.
- (2) If paragraph (1) applies, trade mark B is not infringed by the use of trade mark A even though trade mark A may no longer be invoked against trade mark B.
- (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.

115 Exhaustion of rights conferred by registration

- (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, the United Kingdom or the European Economic Area 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

116 Right of registered proprietor to bring infringement proceedings

A registered proprietor may bring Court proceedings for the infringement of a registered trade mark.

117 Infringement proceedings brought by co-proprietor

- (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) must not be made 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.

118 Right of licensee to bring infringement proceedings

- (1) Unless a licence granted by a registered proprietor under Article 108 (licence to use registered trade mark) 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) If the registered proprietor has granted an exclusive licence, the exclusive licensee may request the registered proprietor to take infringement proceedings in relation to any matter that affects the exclusive 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 requested to do so.
- (4) 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 119 (right of exclusive licensee to bring infringement proceedings in own name).
- (5) 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.
- (6) Paragraph (5) does not affect the granting of interlocutory relief on an application by a licensee alone.
- (7) A registered proprietor who is added as a defendant under paragraph (5) must not be made liable for any costs in the infringement proceedings unless they take part in those proceedings.
- (8) 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 any 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.
- (9) 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.
- (10) A licensee who brings infringement proceedings has the same rights and remedies under this Part as the registered proprietor.

119 Right of exclusive licensee to bring infringement proceedings in own name

- (1) This Article applies to the extent that an exclusive licence mentioned in Article 109(1) (exclusive licence granted by registered proprietor) provides 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) Subject to the provisions of the licence, 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 that would have been 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.

120 Concurrent rights of action

- (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 either the registered proprietor or exclusive licensee 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) must not be made liable for any costs in the infringement proceedings unless they take part in those proceedings.
- (5) In infringement proceedings brought by either the registered proprietor or exclusive licensee –
 - (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 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 registered proprietor and exclusive 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) This Article has effect subject to any agreement to the contrary between the registered proprietor and exclusive licensee.

DIVISION 3 – DEFENCES AND REMEDIES IN INFRINGEMENT PROCEEDINGS**121 Defence of non-use of trade mark**

- (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 52(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 (by the registered proprietor or 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 the non-use.
- (4) Nothing in paragraphs (2) and (3) overrides any provision of Article 52, 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.

122 Order for delivery up of infringing goods etc

- (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) Infringement proceedings may not be brought under this Article after the end of the 6-year period mentioned in Article 123(1) (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 124 (order for disposal of infringing goods etc).
- (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 124 has not been made, retain the goods, material or articles until the Court –
 - (a) makes an order under that Article; or
 - (b) decides not to 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 120 (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 registered proprietor and exclusive licensee.

123 Period after which remedy of delivery up not available

- (1) For the purpose of Article 122(2) (order for delivery up of infringing goods etc), the 6-year period is –
 - (a) for infringing goods, 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, the 6-year period beginning with the date on which the trade mark was affixed to the material;
 - (c) for infringing articles, the 6-year period beginning with the date on which the articles were made;
 - (d) if paragraph (2) applies, the 6-year period beginning with the date on which the registered proprietor –
 - (i) ceased to be under a disability; or
 - (ii) could have discovered, with reasonable diligence, the facts entitling them to apply for an order under Article 122(1).
- (2) This paragraph applies if, during the whole or part of the 6-year period mentioned in paragraph (1)(a) to (c), 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 122(1).
- (3) 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](#).

124 Order for disposal of infringing goods etc

- (1) If infringing goods, infringing material or infringing articles have been delivered up under an order under Article 122(1) (order for delivery up of infringing goods etc), 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 –
 - (a) compensate the registered proprietor and any licensee; and
 - (b) 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) Articles 143, 321 and 377 of the [Intellectual Property \(Unregistered Rights\) \(Jersey\) Law 2011](#); or
 - (c) the [Community Provisions \(Goods Suspected of Infringing Intellectual Property Rights\) \(Jersey\) Regulations 2014](#).

125 Remedies for infringement of property right

- (1) 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.
- (2) In paragraph (1), “relief” includes damages, injunctions or accounts.

126 Order for erasure etc of sign that infringes registered trade mark

- (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, remove or obliterate 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, removed or obliterated, 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 –
 - (a) erasure, removal or obliteration of the sign; or
 - (b) destruction of the sign.

DIVISION 4 – WELL-KNOWN TRADE MARKS

127 Protection of well-known trade marks

- (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 –
 - (i) is 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 57 (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, similar or not similar goods or services.
- (4) Nothing in this Article affects the continuation of any *bona fide* use of a trade mark begun before the coming into force of this Article.
- (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, similar or not similar goods or services” means goods or services that are identical, similar or not 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 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.

DIVISION 5 – PROHIBITED GOODS

128 Notice of importation of prohibited goods

- (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 Jersey, the United Kingdom or the European Economic Area; or
 - (ii) from within Jersey, the United Kingdom or the European Economic 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 of importation is in force under paragraph (1) –
 - (a) the importation of the infringing goods, infringing material or infringing articles to which the notice relates, other than by a person for their private and domestic use, is prohibited; and
 - (b) the infringing goods, infringing material or infringing articles 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 infringing goods, infringing material or infringing articles placed in, or expected to be placed in, any of the situations mentioned in Article 1(1) of the European Customs Enforcement Regulation.

129 Specified requirements for notice of importation of prohibited goods

- (1) The Minister may by Order specify –
 - (a) the form in which a notice of importation is to be given;
 - (b) any evidence required to support a notice of importation;
 - (c) any fees payable in respect of a notice of importation; 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 a person giving a notice of importation –
 - (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) The Order may, in particular, require a person giving a notice of importation –
 - (a) to pay any specified fees in respect of the notice;
 - (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.

130 Disclosure of information

- (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 (unauthorised use of trade mark in relation to goods);
 - (b) the [Consumer Safety \(Jersey\) Law 2006](#);
 - (c) Regulations made under Article 94 of 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 that contain similar provision.

PART 7

UNJUSTIFIED THREAT OF INFRINGEMENT PROCEEDINGS

131 Interpretation of Part 7

- (1) In this Part –
- “actionable threat” means a threat of infringement proceedings that is actionable under Article 133;
 - “aggrieved person” means a person aggrieved by a threat of infringement proceedings;
 - “permitted communication” has the meaning given in Article 134;
 - “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 132.
- (2) In this Part, a reference to a registered trade mark includes a reference to –
- (a) a trade mark in respect of which an application for registration has been published under Article 25; or
 - (b) a trade mark registered as a result of an application for registration that has been so published.

132 Threat of infringement proceedings

- (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; and
 - (b) a person intends to bring Court proceedings 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 124 (order for disposal of infringing goods etc).

133 Actionable threats

- (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.

134 Permitted communications

- (1) For the purposes of Article 133(6) (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;
 - (b) discovering whether, or by whom, there has been an infringement of the registered trade mark by an act mentioned in Article 133(2)(a), (b) or (c);
 - (c) giving notice that a person has a right in or under a registered trade mark, 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;
 - (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) 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.

135 Proceedings for actionable threats

- (1) An aggrieved person may bring proceedings against a person who makes an actionable threat for any of the following remedies –
 - (a) a declaration that the threat is unjustified;
 - (b) an injunction against the continuance of the threat;
 - (c) 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 –
 - (a) the registered trade mark; or
 - (b) if the threat of infringement proceedings is made after an application for registration has been published under Article 25, the trade mark registered as a result of an application for registration that has been so published.
- (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 133(2) (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.

136 Professional advisers

- (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 is 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 is acting.
- (3) This Article does not affect any liability of the person on whose instructions the adviser is 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 is made –
 - (a) is acting in a professional capacity in providing legal services or the services of a registered trade mark agent; and
 - (b) is 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 8**TRADE MARK AGENTS****137 Interpretation of Part 8**

- (1) In this Part –

“register of trade mark agents” means the register kept in accordance with an Order by the Minister under Article 140;

“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.
- (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

- (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

- (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 (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 sub-paragraph (a), (b) or (c).
- (2) The Minister may by Order specify the circumstances that constitute a ground of misconduct.

140 Register of trade mark agents

- (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.
- (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 fees set by the Commission under Article 9 of the Registrar's Law in respect of the register;
 - (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;
 - (f) the circumstances in which the registration of a trade mark agent may be suspended;
 - (g) provision for the carrying on of trade mark agency work by registered trade mark agents.

- (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 for any matter that the Minister could provide for in the Order.

141 Unregistered trade mark agents

- (1) This Article applies if the Minister has made an Order under Article 140 (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 by the Minister in an Order under Article 142 (power to specify conditions for mixed partnerships and bodies (corporate or unincorporate)).
- (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 by the Minister in an Order under Article 142.
- (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 or unincorporate)

- (1) The Minister may by Order specify conditions that must be met under Article 141 (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

- (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 –
 - “communication” includes any document, material or information;
 - “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

- (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) It is a defence for a person charged with an offence under this Article to show 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 Falsification of register of trade marks

- (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, in evidence 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 imprisonment for a term of 2 years and to a fine.

146 False representation in respect of trade marks

- (1) A person commits an offence if they falsely represent that a mark is a registered trade mark, knowing or having reason to believe that the representation is false.
- (2) A person commits an offence if they 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.
- (3) A person who commits an offence under this Article is liable to a fine.
- (4) For the purpose of this Article, the following words used in Jersey in relation to a trade mark are taken to refer to registration under this Law –
 - (a) the word “registered”;
 - (b) any other word referring expressly or impliedly to registration.
- (5) This Article does not apply to a protected international trade mark (Jersey).

147 Unauthorised use of Royal arms

- (1) A person commits an offence if, without the authority of the Lieutenant-Governor, 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 must not, without the authority of the Lieutenant-Governor or a member of the Royal family, use in connection with a business any device, emblem or title in a manner that is calculated to lead to the belief that the person is employed by, or supplies 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; or
 - (b) a person authorised by the Lieutenant-Governor 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 the trade mark.

148 Enforcement function of authorised officer

- (1) An authorised officer must enforce the provisions of this Part.
- (2) Articles 10 to 14 of the 2018 Law (which relate to the exercise of enforcement powers by authorised officers under that Law) apply to the enforcement of this Part as they apply to enforcement of the 2018 Law.
- (3) An authorised officer may inspect or test any goods seized or detained under the powers applied under paragraph (2), whether or not an offence under this Part has been committed.
- (4) An authorised officer seizing any goods or documents in the exercise of the powers applied by paragraph (2) must inform the person from whom they were seized.
- (5) If an authorised officer exercises any power to seize or detain goods under Article 11 or 12 of the 2018 Law, as applied by paragraph (2), the Minister for Sustainable Economic Development is liable to pay compensation to any person having an interest in the goods in respect of any loss or damage caused to that person by reason of the seizure and detention if –
- (a) the loss or damage is not attributable to any neglect or default by the person having an interest in the goods; and
- (b) paragraph (6) applies.
- (6) This paragraph applies if –
- (a) there has been no contravention, in relation to the goods, of any provision of this Law; or
- (b) the exercise of the power is otherwise unreasonable in the circumstances or is carried out in bad faith.
- (7) 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 –
- (a) the parties; or
- (b) failing agreement between the parties, the Registrar.
- (8) 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.
- (9) A person who commits an offence under this Article is liable to imprisonment for a term of 2 years and to a fine.
- (10) An enactment that authorises the disclosure of information for the purpose of enforcing the 2018 Law applies as if –
- (a) an offence under this Law were contained in the 2018 Law; and
- (b) the functions of a person in relation to the enforcement of the offence under this Law were functions under the 2018 Law.
- (11) In this Article –
- “2018 Law” means the [Consumer Protection \(Unfair Practices\) \(Jersey\) Law 2018](#); and
- “authorised officer” has the meaning given to the term “authorized officer” in Article 1(1) of the 2018 Law.

149 Criminal liability of directors, managers and others for offences committed by entities

- (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 an offence that may be 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 in an Order under Article 154 (Orders generally) 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).

150 Forfeiture of infringing goods etc

- (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 forfeiture of the goods, material or articles; and
 - (b) the Court must make an order for forfeiture of any 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 it is 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) causes the offending sign to be erased, removed or obliterated; 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 (unauthorised use of trade mark in relation to goods);
 - (b) an offence under the [Consumer Safety \(Jersey\) Law 2006](#);
 - (c) an offence under Regulations made under Article 94 of the [Supply of Goods and Services \(Jersey\) Law 2009](#);
 - (d) an offence under the [Consumer Protection \(Unfair Practices\) \(Jersey\) Law 2018](#); or
 - (e) an offence involving dishonesty or deception.

151 Orders to enforce this Law

- (1) The Attorney General may apply to the Court for an injunction (including an interim injunction) or other order against any person who appears to the Attorney General to be responsible for a contravention of a provision of this Law.
- (2) The Court, on an application under this Article, may grant an injunction or other order, on the terms it thinks fit, to secure compliance with a provision of this Law.

PART 10**MISCELLANEOUS AND GENERAL PROVISIONS****152 Regulations**

- (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 sub-paragraph (b);
 - (d) to enable the ratification by or on behalf of Jersey, or the 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;
 - (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 appropriate.

153 Appeals to Court against decision of Registrar

- (1) A person may appeal to the Court against any decision of the Registrar under this Law, unless an Order under paragraph (3) specifically provides that there is no right to an appeal in respect of a decision of that kind.
- (2) An appeal under this Article must be made –
 - (a) before the end of 28 days beginning with the date of the Registrar's decision;
or
 - (b) within any longer period, with the leave of the Court.

- (3) The Minister may by Order specify the kinds of decisions in respect of which there is no right to an appeal.
- (4) In this Article, “decision” includes any act of the Registrar in exercise of a discretion vested in the Registrar under this Law.

154 Orders generally

- (1) The Minister may make an Order generally for regulating practice and procedure under this Law.
- (2) An Order under paragraph (1) may include provision 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.
- (3) If the Minister does not make an Order under paragraph (1), the Registrar may adopt the practice and procedure that the Registrar thinks fit for the matters in respect of which an Order under paragraph (1) may be made.

155 Rules of Court

- (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)(a) must be paid out of the Consolidated Fund.
- (4) In this Article, “Consolidated Fund” means the fund continued under Article 3 of the [Public Finances \(Jersey\) Law 2019](#).

156 Judicial notice

- (1) A Jersey court must take judicial notice of the following –
 - (a) the Madrid Protocol and the Madrid 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 Madrid 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

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

- (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) of a registered trade mark to interfere with or restrain the use by a person of an identical or similar trade mark if paragraph (3) applies.
- (3) This paragraph applies if the person (or a predecessor in title of the person) has continuously used the identical or similar trade mark in relation to goods or services from a date before the first-mentioned trade mark was registered in the United Kingdom in the name of the registered proprietor (or their predecessor in title) in relation to the same goods or services.
- (4) In paragraph (2), “identical or similar trade mark” means a trade mark that is identical or similar to the registered trade mark.

159 Transitional provisions

- (1) 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.
- (2) The Minister may by Order make any transitional provision the Minister considers necessary or appropriate.

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

(Articles 1(1), 3(2), 32(3) and 73(1)(b))

REGISTRATION OF COLLECTIVE MARKS

1 Interpretation of Schedule 1

In this Schedule –

“amended regulations”, in relation to a collective mark, means amended regulations governing the use of the collective mark;

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

“the regulations”, in relation to a collective mark, means the regulations governing the use of the collective mark.

2 Application of this Law to collective marks

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

3 Indication of geographical origin

- (1) Despite Article 32 (absolute grounds for refusal – general), 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

- (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 to which an application for registration of a collective mark relates includes an indication that the trade mark is a collective mark.
- (3) Despite Article 26(3) (withdrawal or amendment of application for registration), the applicant 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

- (1) An applicant for registration of a collective mark must, within the period specified by the Registrar under sub-paragraph (2) –

- (a) file with the Registrar the regulations governing the use of the collective mark; and
 - (b) pay the filing fee set by the Commission under Article 9 of the Registrar's Law.
- (2) For the purpose of sub-paragraph (1), the Registrar must specify a period of at least 3 months beginning with the date of filing of the application for registration.
- (3) The regulations must specify –
 - (a) the persons authorised to use the collective mark;
 - (b) if an association is the proprietor of the collective mark, the conditions of membership of the association; and
 - (c) the conditions of use of the collective mark and sanctions for misuse.
- (4) The 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 the Registrar's website.
- (7) If an applicant for registration of a collective mark does not, before the end of the period specified by the Registrar under sub-paragraph (2), file the regulations and pay the filing fee, the applicant is taken to have withdrawn the application for registration.

6 Grounds for refusal of application for registration of collective mark

The Registrar must refuse registration of a collective mark unless the regulations –

- (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.

7 Consideration of application for registration

- (1) The Registrar must decide whether the requirements of paragraph 6 are met.
- (2) If the Registrar decides that the requirements of paragraph 6 are not met, the Registrar must –
 - (a) inform the applicant for registration of the collective mark; 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 requirements of paragraph 6 are met;
 - (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 by the Registrar under sub-paragraph (2).
- (4) The Registrar must accept the application for registration if the requirements of paragraph 6 and the other requirements for registration are met.

8 Publication of regulations, notice of opposition and observations

- (1) The Registrar must publish the regulations (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 30 (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

9 Inspection of regulations

The duty on the Registrar under Article 7 of the Registrar's Law to make the register of trade marks available for public inspection applies in the same way to the regulations governing the use of a collective mark that is a registered trade mark.

10 Amendment of regulations after registration

- (1) Any amendment of the regulations 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 30 (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

11 Infringement – rights of authorised users

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 124(2) (order for disposal of infringing goods etc);
- (b) Article 128 (notice of importation of prohibited goods).

12 Infringement proceedings brought by authorised user

- (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) must not be made 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 any 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

In addition to the grounds for revocation in Article 52 (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

- (1) In addition to the grounds of invalidity in Article 55 (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) (meaning of registered proprietor);
 - (b) paragraph 4(1) (collective mark not to be misleading about character or significance); or
 - (c) paragraph 6(1) (grounds for refusal of 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).

SCHEDULE 2

(Articles 1(1), 4(3) and 73(1)(b))

REGISTRATION OF CERTIFICATION MARKS

1 Interpretation of Schedule 2

In this Schedule –

“amended regulations”, in relation to a certification mark, means amended regulations governing the use of the certification mark;

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

“the regulations”, in relation to a certification mark, means the regulations governing the use of the certification mark.

2 Application of this Law to certification marks

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

3 Indication of geographical origin

- (1) Despite Article 32 (absolute grounds for refusal – general), 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

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

- (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 to which an application for registration of a certification mark relates includes an indication that the trade mark is a certification mark.
- (3) Despite Article 26(3) (withdrawal or amendment of application for registration), the applicant for registration of the certification mark may amend the representation of the trade mark to comply with a requirement of the Registrar under subparagraph (2).

6 Filing of regulations governing use of certification mark

- (1) An applicant for registration of a certification mark must, within the period specified by the Registrar under sub-paragraph (2) –
 - (a) file with the Registrar the regulations governing the use of the certification mark; and
 - (b) pay the filing fee set by the Commission under Article 9 of the Registrar's Law.
- (2) For the purpose of sub-paragraph (1), the Registrar must specify a period of at least 3 months beginning with the date of filing of the application for registration.
- (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 proprietor is to test those characteristics and to supervise the use of the certification mark;
 - (d) the fees, if any, to be paid to the proprietor 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 the Registrar's website.
- (6) If the applicant does not, before the end of the period specified by the Registrar under sub-paragraph (2), file the regulations and pay the filing fee, the applicant is taken to have withdrawn the application for registration.

7 Grounds for refusal of application for registration of certification mark

The Registrar must refuse registration of a certification mark unless –

- (a) the regulations –
 - (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 of the certification mark is competent to certify the goods or services to which the application for registration relates.

8 Consideration of application for registration

- (1) The Registrar must decide whether the requirements of paragraph 7 are met.
- (2) If the Registrar decides that the requirements of paragraph 7 are not met, the Registrar must –
 - (a) inform the applicant for registration of the certification mark; 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 requirements of paragraph 7 are met;
 - (b) the applicant fails to file amended regulations that meet the requirements of paragraph 7(a); or
 - (c) the applicant fails to make representations or to file amended regulations before the end of the period specified by the Registrar under sub-paragraph (2).
- (4) The Registrar must accept the application for registration if the requirements of paragraph 7 and the other requirements for registration are met.

9 Publication of regulations, notice of opposition and observations

- (1) The Registrar must publish the regulations (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 30 (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

10 Inspection of regulations

The duty on the Registrar under Article 7 of the Registrar's Law to make the register of trade marks available for public inspection applies in the same way to the regulations governing the use of a certification mark that is a registered trade mark.

11 Amendment of regulations after registration

- (1) Any amendment of the regulations 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 30 (notice of opposition and observations) applies to giving a notice of opposition and making observations under this paragraph.

12 Consent to assignment

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

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 124(2) (order for disposal of infringing goods etc);
- (b) Article 128 (notice of importation of prohibited goods).

14 Consideration of loss of authorised users in infringement proceedings

- (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

In addition to the grounds for revocation in Article 52 (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, the regulations;
- (d) that an amendment of the regulations has been made so that the regulations –
 - (i) no longer comply with paragraph 6(3) (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

In addition to the grounds for invalidity in Article 55 (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 proprietor's business);
- (b) paragraph 5(1) (certification mark not to be misleading about character of significance); or
- (c) paragraph 7 (grounds for refusal of application for registration of certification mark).

SCHEDULE 3

(Articles 1(1) and (5), 5(1)(a), 5(1)(b), 10(2)(f), 64, 102(2)(d) 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) The date of registration of a trade mark registered under this Law in accordance with sub-paragraph (1) is –
 - (a) the same date as the date of application for registration of that trade mark under the TMA; or
 - (b) any date of priority for that application.
- (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 2 in accordance with this Schedule.
- (4) The renewal of registration of the trade mark under Part 2 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 on the Registrar's website 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 2 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 under Part 2 for renewal of the registration of the trade mark.
- (4) The renewal of registration of the trade mark under Part 2 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 on the Registrar's website informing registered proprietors of their rights of renewal under this paragraph.

3 Renewal of lapsed registration

- (1) The proprietor of a trade mark may make a request under Part 2 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 2 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 –
 - (a) the same date as the date of application for registration of that trade mark under the TMA; or
 - (b) any date of priority for that application.
- (4) The Registrar must publish a notice on the Registrar's website informing proprietors of their rights of renewal under this paragraph.

4 Pending applications for re-registration in Jersey

- (1) This paragraph applies if, before the commencement date –
 - (a) an application was made under Article 4 of the TMJL 2000; and
 - (b) the application was not finally determined.
- (2) The TMJL 2000 continues to apply to the determination of that application as if that Law had not been repealed.
- (3) If the Registrar or the Court determines that the application should be granted –
 - (a) the Registrar must enter the trade mark in the register of trade marks under this Law; and
 - (b) the trade mark is taken to be registered under Part 2 of this Law.
- (4) The date of registration of the trade mark is –
 - (a) the same date as the date of application for registration of the trade mark under the TMA; or
 - (b) any date of priority for that application.

5 Protected international trade marks (UK)

- (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) On the commencement date, the international trade mark –
 - (a) is granted protection in Jersey as a protected international trade mark (Jersey); and
 - (b) must be entered in the register of trade marks as a protected international trade mark (Jersey).
- (3) The date of registration of a protected international trade mark (Jersey) registered under this Law in accordance with sub-paragraph (2) is –

- (a) the same date as the date of request for territorial extension of the international registration to the United Kingdom; or
 - (b) any date of priority for that request.
- (4) In this paragraph and paragraph 6 –
 - (a) “protected international trade mark (UK)” has the meaning given in the Trade Marks (International Registration) Order 2008 of the United Kingdom (S.I. 2008/2206); and
 - (b) “date of request for territorial extension” and “request for territorial extension” have the meanings given in Article 64 (interpretation of Part 3).

6 Requests for territorial extension to the UK made before commencement date

- (1) This paragraph applies in relation to an international trade mark that –
 - (a) immediately before the commencement date, was the subject of a request for territorial extension to the United Kingdom; and
 - (b) on or after the commencement date, is granted protection in the United Kingdom (as a result of that request) as a protected international trade mark (UK).
- (2) On the day on which it becomes a protected international trade mark (UK), the international trade mark –
 - (a) is granted protection in Jersey as a protected international trade mark (Jersey); and
 - (b) must be entered in the register of trade marks as a protected international trade mark (Jersey).
- (3) The date of registration of a protected international trade mark (Jersey) registered under this Law in accordance with sub-paragraph (2) is –
 - (a) the same date as the date of request for territorial extension of the international registration to the United Kingdom; or
 - (b) any date of priority for that request.

SCHEDULE 4

(Article 160)

PART 1

CONSEQUENTIAL AMENDMENTS

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

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

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

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

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

- (1) This paragraph amends the [Intellectual Property \(Unregistered Rights\) \(Jersey\) Law 2011](#).
- (2) In the long title, for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”.
- (3) For Article 143(7)(d) there is substituted –
 - (d) Article 124 (order for disposal of infringing goods etc) of the Trade Marks (Jersey) Law 202-.
- (4) For Article 321(6)(d) there is substituted –
 - (d) Article 124 (order for disposal of infringing goods etc) of the Trade Marks (Jersey) Law 202-.
- (5) For Article 377(7)(d) there is substituted –
 - (d) Article 124 (order for disposal of infringing goods etc) of the Trade Marks (Jersey) Law 202-.
- (6) 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

- (1) This paragraph amends the [Merchandise Marks \(Jersey\) Law 1958](#).
- (2) In Article 1(2), for “[Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Trade Marks (Jersey) Law 202-”.
- (3) In Article 14, for “Article 4 of the [Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Article 43 (registration of trade mark) of the Trade Marks (Jersey) Law 202-”.

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

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

6 [Royal Court Rules 2004](#)

In Rule 17/3(1)(h) of the [Royal Court Rules 2004](#), for “Article 14 of the [Trade Marks \(Jersey\) Law 2000](#)” there is substituted “Article 16 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 Rules 2000](#).