

DRAFT TRADE MARKS (JERSEY) LAW 199

**Lodged au Greffe on 27th July 1999
by the Finance and Economics Committee**



STATES OF JERSEY

STATES GREFFE

REPORT

History of the draft Trade Marks (Jersey) Law 199

Responsibility for intellectual property matters historically rested with the Judicial Greffe. In practical terms, however, for many years the Financial Services Department (formerly Commercial Relations Department) undertook the housing and maintenance of the Registry of Patents, Trade Marks and Designs. With the establishment of the Financial Services Commission as an independent statutory body in July 1998, the Judicial Greffe resumed full responsibility for the management of the Registry and in doing so inherited an obligation to revise and upgrade Jersey's intellectual property legislation. Jersey's Trade Marks, Registered Designs and Patents legislation (three statutes) has fallen out of date making it difficult to provide a satisfactory service to those wishing to claim protection of intellectual property rights in the Island. Review was therefore a priority and the attached draft Law is the first, and most pressing, element of this triple undertaking. It replaces with amendments the Trade Marks (Jersey) Law 1958, which was itself based on the United Kingdom Trade Marks Act 1938.

Benchmarks

The legislation has been revised to take account of changes in the United Kingdom, which introduced a new Trade Marks Act in 1994, and to make provision for developments in European Union and other international intellectual property registration.

United Kingdom Trade Marks Act 1994

The coming into force of the Trade Marks Act 1994 substantially changed trade mark law in the United Kingdom. The new Act incorporated a number of practical and procedural amendments but was primarily designed to enable the United Kingdom's ratification of the "Madrid Protocol" on the International Registration of Marks and to put EU Directive 89/104 into force. Since Jersey's Trade Marks Registry is a *Dependent Registry* in which the only trade marks registered are those which are registered in the United Kingdom, there is an obvious need for consistency in legislation.

Consideration was given to the utility of maintaining the *Dependent Registry* linked with the United Kingdom, the alternative being to develop a fully independent system of registration for Jersey. It was agreed that, owing to the pressing need for Law reform and having regard to the resource implications of re-designating the Registry, the most sensible policy was to maintain the current dependent status.

European Union/International trade marks

As indicated above, in recent years, the focus of trade mark law has shifted from the national to the international arena. Indeed, the Policy and Resources Department specifically requested that, in order for Jersey to maintain its international competitiveness, any revisions to intellectual property legislation should take into account international and European Union considerations. Accordingly, this draft enables recognition of (European) Community trade marks and trade marks afforded international protection by virtue of the above Protocol (relating to the Madrid Agreement concerning the International Registration of Marks). In both cases recognition has been achieved by incorporating parts of the European Union and international regulations into the Jersey Law.

Community trade marks

The creation of a Europe-wide trade mark and the harmonization of national trade mark laws is consistent with the European Union's overall aim of advancing an unimpeded single market. National differences have been overcome by the implementation within the European Union of Directive 89/104 (which provides for harmonization of legislation), and Regulation 40/94 (which creates a Community trade mark).

The effect of incorporating recognition of Community trade marks into Jersey's legislation is two-fold. As well as allowing for the maintenance of Jersey's international competitiveness, it also has the potential for removing those obstacles that at present prevent Jersey companies and individuals from benefiting from the European aspects of trade marks law. It is envisaged that, on presentation of this amended legislation to the European Commission, Jersey will be included in the European trade mark system by virtue of being a territory which accords reciprocal trade mark protection of nationals of all European Union Member States.

International trade marks

As implied, the Madrid system incorporates The Madrid Agreement of 1891 and the related Protocol of 1989, both of which provide for the international registration of trade marks. The United Kingdom ratified the Protocol in 1995 but it was not ratified on behalf of Jersey. Separate provisions have been made in this legislation to deal with international trade marks, essentially offering protection to those international marks which are protected in the United Kingdom.

T.R.I.P.S.

Further provisions have been added to enable compliance with the International Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

Rules to be made in virtue of the Law

The need for co-extensively operable Rules is acknowledged and these will be drafted to facilitate their coming into force at the same time as the new Law.

Explanatory Note

This Law replaces with amendments the Trade Marks (Jersey) Law 1958. The main changes are to ensure consistency with the equivalent legislation in the United Kingdom, which introduced a new Trade Marks Act in 1994. This is necessary because registration of a trade mark in Jersey is dependent on that trade mark having already been registered in the UK. It is also necessary to enable recognition of Community trade marks and trade marks afforded international protection by virtue of the Protocol relating to the Madrid Agreement concerning the International Registration of Marks (“the Madrid Protocol”) which the UK has adopted. Further provisions have been added to enable compliance with the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

Article 1 of the draft Law contains the interpretation provisions. *Article 2* provides for the Judicial Greffier to be the registrar of trade marks, for his seal and for his functions to be exercised by officers of his staff. *Article 3* establishes a register of trade marks to be maintained at the Judicial Greffe and *Article 4* provides for proprietors of UK registered trade marks to be registered locally subject to certain conditions. *Article 5* provides for the renewal of registrations where a UK registration has been renewed and for trade marks that have not been renewed to be removed from the register. *Article 6* enables persons granted licences to use a trade mark in the UK to apply to become registered licensees in Jersey.

Article 7 empowers the registrar to cancel a registration or change the registered name or address of registered proprietor on his request, or, on the request of the registered licensee, to register any change in his name or address. *Article 8* stipulates that neither the applicant nor his representative need be present in the Island to make an application under Articles 4-7 provided the applicant has notified the registrar of an address in the Island where any notice or summons may be sent.

Article 9 provides for the registered proprietor or licensee to have the same rights and remedies in the Island in relation to the trade mark as they possess in the UK, so long as the UK registration remains in force. *Article 10* provides for the Royal Court to revoke a registration in certain circumstances and *Article 11* enables the charging of fees by the registrar.

Article 12 provides for those provisions of the Council Regulation (EC) No 40/94 of 20th December 1993 on the Community trade mark which are set out in the *Schedule* to have full force and effect in the Island. *Article 13* enables the proprietor or licensee of an international trade mark registered in the register maintained for the purposes of the Madrid Protocol and which is afforded protection in the UK to have the same rights and remedies as if he were a registered proprietor or licensee under this Law.

Article 14 enables rectification of the register by order of the court and *Article 15* enables the registrar to correct clerical errors in the register. *Article 16* empowers the registrar to amend or substitute any entry in the register so as to enable its conformity with the UK registration. *Article 17* requires the registered proprietor to furnish the registrar with a copy of amended filed regulations relating to any registered collective mark or certification mark which the Comptroller-General of Patents, Designs and Trade Marks in the UK has accepted.

Article 18 precludes the award of damages for infringement of a trade mark against a defendant who proves that he was unaware and had no reasonable ground for supposing that it was registered. *Article 19* provides for relief where a person is unjustifiably threatened with proceedings for infringement of a trade mark, Community trade mark or protected international trade mark.

Article 20 extends the privilege for communications between advocate or solicitor and his client to UK registered trade mark agents and persons on the list of professional representatives maintained under the Community Trade Mark Regulation.

Article 21 deems the application in the Island of a trade mark to goods or services to be exported to be a material use of the trade mark. *Article 22* enables infringing goods, material or articles to be treated as prohibited goods for customs purposes and the Committee may, under *Article 23*, make Orders in respect of such goods, material or articles. The Agent of the Impôts is empowered to disclose information relating to infringing goods, material or articles in connection with a prosecution (*Article 24*).

Article 25 creates offences in relation to the unauthorized use of a registered trade mark, Community trade mark or protected international trade mark. Under *Article 26* it is an offence to falsify an entry in the

register of trade marks and *Article 27* creates an offence of making false representations in relation to registered trade marks, Community trade marks or protected international trade marks. *Article 28* gives the court power to order forfeiture of the goods, material or articles where certain offences have been committed.

Article 29 covers offences by partnerships and bodies corporate and *Article 30* provides for liability of secondary parties to an offence. *Article 31* is a general Order-making power which enables provision to be made for certain procedural matters and *Article 32* provides a supplementary power to make Rules of Court. *Articles 33 and 34* preserve vested rights and rights of action for passing off. *Article 35* consequentially amends the Merchandise Marks (Jersey) Law 1958. *Article 36* repeals the Trade Marks (Jersey) Law 1958 and amendments to it and makes saving provisions in relation to things done under the old Law. *Article 37* contains the short title and commencement provision.

TRADE MARKS (JERSEY) LAW 199

ARRANGEMENT OF ARTICLES

PART I

PRELIMINARY

1. Interpretation

PART II

REGISTERED TRADE MARKS

2. Registrar and other officers
3. Register of trade marks
4. Registration of title to trade marks
5. Renewal of registration
6. Registered licensees
7. Cancellation of registration and registration of change of name or address
8. Presence in Island unnecessary for the purpose of making applications
9. Effect of registration
10. Power of court to revoke registration
11. Fees

*PART III*COMMUNITY TRADE MARKS AND PROTECTED
INTERNATIONAL TRADE MARKS

12. Community trade marks
13. Protected international trade marks

PART IV

ADMINISTRATION AND OTHER SUPPLEMENTARY PROVISIONS

14. Rectification of the register
15. Power to correct clerical errors
16. Adaptation of entries to UK registration
17. Amendment of filed regulations to be furnished to registrar
18. Restrictions on recovery of damages for infringement
19. Remedy for groundless threats of infringement proceedings
20. Privilege for communications with trade mark agents or professional representatives
21. Use of trade mark for export trade
22. Infringing goods, material or articles may be treated as prohibited goods
23. Orders concerning the importation of infringing goods, material or articles
24. Power of Agent of the Impôts to disclose information
25. Unauthorized use of trade mark in relation to goods

26. Falsification of register of trade marks
27. False representations in respect of trade marks
28. Forfeiture

PART V

MISCELLANEOUS

29. Offences by partnerships and bodies corporate
30. Accessories and abettors
31. Orders
32. Rules of Court
33. Saving of vested rights
34. Saving of rights of action for passing off
35. Amendment of Merchandise Marks (Jersey) Law 1958
36. Repeals and savings in relation to repealed legislation
37. Short title and commencement

SCHEDULE - PROVISIONS OF COMMUNITY TRADE MARK
LEGISLATION APPLIED TO THE ISLAND

TEXT OF THE PROVISIONS OF COUNCIL REGULATION (EC) No
40/94 OF 20 DECEMBER 1993 ON THE COMMUNITY TRADE
MARK AS APPLICABLE IN THE ISLAND (for information only - not
part of this Law)

TRADE MARKS (JERSEY) LAW 199

A LAW to make new provision for the registration in the Island of trade marks, to allow for the recognition of Community trade marks and to afford protection to certain international trade marks and for connected purposes, sanctioned by Order of Her Majesty in Council of the

(Registered on the day of 199)

STATES OF JERSEY

The day of 199

THE STATES, subject to the sanction of Her Most Excellent Majesty in Council, have adopted the following Law -

PART I

PRELIMINARY

ARTICLE 1

Interpretation

(1) In this Law, unless the context otherwise requires -

“business” includes a trade or profession;

“certification mark” means a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of

Draft Trade Marks (Jersey) Law 199

manufacture of goods or performance of services, quality, accuracy or other characteristics;

“collective mark” means a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings;

“the Committee” means the Finance and Economics Committee;

“Community trade mark” has the same meaning as in the Community Trade Mark Regulation;

“the Community Trade Mark Regulation” means Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community trade mark (O.J. No. L11 14.1.94, p.1);

“the Comptroller-General” means the Comptroller-General of Patents, Designs and Trade Marks in the United Kingdom;

“the court” means the Royal Court;

“infringing articles”, in relation to a registered trade mark, means articles -

- (a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark; and
- (b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or infringing material;

“infringing goods”, in relation to a registered trade mark, means goods which bear, or the packaging of which bears, a sign identical or similar to that mark and -

- (a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark;

Draft Trade Marks (Jersey) Law 199

- (b) the goods are proposed to be imported into the Island and the application of the sign in the Island to them 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 such a way as to infringe the registered trade mark;

“infringing material”, in relation to a registered trade mark, means material which bears a sign identical or similar to that mark and either -

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark, or
- (b) it is intended to be so used and such use would infringe the registered trade mark.

“the International Bureau” has the meaning giving by Article 2(1) of the Madrid Protocol;

“international trade mark” means a trade mark registered in the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol;

“the Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989;

“prescribed” means prescribed by Order made by the Committee;

“protected international trade mark” means an international trade mark protected in the United Kingdom by virtue of Regulations made under section 54 of the Trade Marks Act;

“register” means enter in the register of trade marks;

Draft Trade Marks (Jersey) Law 199

“the register of trade marks” means the register of trade marks maintained pursuant to Article 3;

“registered licensee” means any person who is for the time being registered as such under Article 6;

“registered proprietor” means, in relation to a trade mark, any person for the time being entered in the register of trade marks as a proprietor of the trade mark;

“registered trade mark” means a trade mark that is currently entered in the register of trade marks;

“registrar” means the registrar of trade marks appointed pursuant to Article 2 and “his seal” in relation to the registrar means a seal prepared under that Article;

“the relevant filed regulations” means -

- (a) in relation to a collective mark, the regulations governing the use of that mark which have been filed with the Comptroller-General in accordance with paragraph 5 of Schedule 1 to the Trade Marks Act; and
- (b) in relation to a certification mark, the regulations governing the use of that mark which have been filed with the Comptroller-General in accordance with paragraph 6 of Schedule 2 to the Trade Marks Act;

“trade mark” means -

- (a) any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings;
- (b) a collective mark; or
- (c) a certification mark,

Draft Trade Marks (Jersey) Law 199

and may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging;

“the Trade Marks Act” means the Trade Marks Act 1994 of the United Kingdom;

“the United Kingdom register of trade marks” means the register of trade marks maintained pursuant to section 63 of the Trade Marks Act.

(2) References in this Law to use (or to any particular description of use) of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, include use (or that description of use) otherwise than by means of a graphic representation.

(3) A reference in this Law to an Article by number only, and without further identification, is a reference to the Article of that number contained in this Law.

(4) A reference in an Article or other division of this Law to a paragraph or sub-paragraph by number or letter only, and without further identification, is a reference to the paragraph or sub-paragraph of that number or letter contained in the Article or other division of this Law in which the reference occurs.

(5) A reference in this Law to an enactment (including any enactment of the United Kingdom) is a reference to that enactment as amended, and includes a reference to that enactment as extended or applied by or under any other enactment, including any other provision of this Law.

Draft Trade Marks (Jersey) Law 199

PART II

REGISTERED TRADE MARKS

ARTICLE 2

Registrar and other officers

(1) The Judicial Greffier shall be the registrar of trade marks.

(2) The Committee may direct a seal or seals to be prepared for the authentication of documents required for or in connection with the registration of trade marks.

(3) Any functions of the registrar under this Law may, to the extent authorized by him, be exercised by any officer on his staff.

(4) In paragraph (3), “officer” has the same meaning as in the Civil Service Administration (Jersey) Law 1953.¹

ARTICLE 3

Register of Trade Marks

(1) There shall be maintained at the Judicial Greffe a register of trade marks in which there shall be entered -

- (a) all trade marks together with the names and addresses of their proprietors;
- (b) particulars of assignments and transmissions of registered trade marks;
- (c) the names and addresses of all registered licensees; and
- (d) such other matters relating to trade marks as may be prescribed or as the registrar may think fit.

¹ Tome VIII, page 319, and R & Os 9198 and 9421.

Draft Trade Marks (Jersey) Law 199

(2) Save as may otherwise be prescribed, the register of trade marks shall, at all convenient times, be open to inspection by the public and certified copies of any entry in the register shall be given to any person requiring them on payment of the appropriate fee.

(3) The register of trade marks shall be *prima facie* evidence of any matters required or authorized by or under this Law to be entered therein.

(4) No notice of any trust, whether express, implied or constructive, shall be entered in the register of trade marks and the registrar shall not be affected by any such notice.

(5) No title or interest in respect of any trade mark shall be entered in the rolls of the Royal Court or registered in the register of trade marks otherwise than in accordance with the provisions of this Law.

ARTICLE 4

Registration of title to trade marks

(1) Any person for the time being entered in the United Kingdom register of trade marks as the proprietor of a trade mark may apply to the registrar for the registration of that trade mark in respect of the goods or services comprised in the United Kingdom registration.

(2) A person who -

(a) has become entitled by assignment, transmission or other operation of law, to the privileges and rights conferred on a registered proprietor under this Law; and

(b) has obtained registration in the United Kingdom of such title in accordance with the law for the time being in force in the United Kingdom,

may apply to the registrar for the registration of such title.

(3) Every application under this Article shall -

Draft Trade Marks (Jersey) Law 199

- (a) be made in such manner as may be prescribed;
- (b) be supported by a certificate of the Comptroller-General setting forth the title of the applicant to the trade mark; and
- (c) in the case of an application under paragraph (1), be accompanied by a certified representation of the mark.

(4) Where an application under this Article is for the registration of a certification mark or a collective mark, the application shall be accompanied by a copy of the relevant filed regulations amended where necessary to enable an authorized user of such mark to use the mark in the Island.

(5) The registration of a trade mark may be refused on the ground that it contains or consists of -

- (a) a geographical name, or a surname, connected with the Island; or
- (b) the Jersey flag or the official Jersey crest comprising the three heraldic leopards unless it appears to the registrar that consent has been given by or on behalf of the Bailiff.

(6) Subject to paragraphs (7) to (9), on the receipt of an application under this Article together with the documents required to accompany that application, the registrar shall register the title and issue a certificate of registration.

(7) Where it appears doubtful to the registrar whether the application should be granted, or where any question arises in relation to the application, he shall present a statement of the matter in question to the Bailiff for the directions of the court, and the court may order such persons to be convened, such evidence to be taken and such enquiries to be made as it considers necessary.

(8) Subject to Rules of Court, the court shall determine whether any application referred to it should be granted, and if granted,

Draft Trade Marks (Jersey) Law 199

the registrar shall register the title and issue a certificate of registration accordingly.

(9) Where the application relates to a trade mark which is associated with another trade mark registered in the name of a proprietor other than the applicant, the registrar shall not register the title unless the applicant applies at the same time to register the other trade mark.

ARTICLE 5

Renewal of registration

(1) Where a trade mark has been registered and its registration in the United Kingdom has been renewed, the registered proprietor may apply to the registrar for registration of the renewal in such manner as may be prescribed, and the registrar shall, on production of sufficient evidence of the renewal in the United Kingdom, register the renewal.

(2) Where the registration of a trade mark has not been renewed and not less than 12 months have elapsed since the expiry of the period for which it was registered under section 42 of the Trade Marks Act, the registrar shall, having notified the registered proprietor, remove that trade mark from the register of trade marks.

ARTICLE 6

Registered licensees

(1) Where a trade mark has been registered, any person for the time being granted a licence to use that trade mark in the United Kingdom may apply to the registrar for registration as a registered licensee of that trade mark in respect of the goods or services comprised in the United Kingdom registration, being goods or services in respect of which the trade mark is registered under this Law.

(2) Every application shall be made in such manner as may be prescribed and shall be supported by a certificate of the Comptroller-General relating to the United Kingdom registration.

Draft Trade Marks (Jersey) Law 199

(3) Subject to paragraphs (4) and (5), on the receipt of an application under this Article, the registrar shall register the applicant as a registered licensee of the trade mark in respect of the goods or services for which the application is made and issue a certificate of registration.

(4) Where it appears doubtful to the registrar whether the application should be granted, or where any question arises in relation to the application, he shall present a statement of the matter in question to the Bailiff for the directions of the court, and the court may order such persons to be convened, such evidence to be taken and such enquiries to be made as it considers necessary.

(5) Subject to Rules of Court, the court shall determine whether any application referred to it should be granted, and if granted, the registrar shall register the applicant and issue a certificate of registration accordingly.

ARTICLE 7

Cancellation of registration and registration of change of name or address

(1) The registrar may, on request in writing made by the registered proprietor -

- (a) cancel the registration of a trade mark, either wholly or as regards any particular goods or services in respect of which the trade mark is registered; or
- (b) enter in the register of trade marks any change of the name or address of the registered proprietor.

(2) The registrar may, on request in writing made by a registered licensee of a trade mark, enter in the register of trade marks any change in his name or address.

Draft Trade Marks (Jersey) Law 199

ARTICLE 8

Presence in Island unnecessary for the purpose of making applications

(1) An application under Article 4, 5, 6 or 7 may be made notwithstanding the fact that neither the applicant nor any representative of his is present in the Island provided that the applicant has notified the registrar of an address in the Island to which any notice or summons in connection with any matter relating to the trade mark may be sent.

(2) Any notice or summons sent to the address notified to the registrar in accordance with paragraph (1) shall be deemed to be sufficiently served.

ARTICLE 9

Effect of registration

(1) Subject to the provisions of this Law, the registered proprietor or registered licensee of a registered trade mark shall have the same rights and remedies in the Island regarding the use of that trade mark, in relation to the goods and services in respect of which it is registered, as such proprietor or licensee, as the case may be, possesses for the time being in the United Kingdom by virtue of the trade mark or the title or interest in it being registered in the United Kingdom register of trade marks, but, save as aforesaid, no person shall be entitled to any rights or remedies in respect of any trade mark.

(2) Subject to paragraph (3), the rights and remedies so conferred shall date from the date of registration in the United Kingdom and shall continue in force for so long only as the registration in the United Kingdom remains in force in respect of the goods or services for which the trade mark is registered under this Law.

(3) No action for infringement of a trade mark shall be entertained and no offence under Article 25 shall be committed -

Draft Trade Marks (Jersey) Law 199

- (a) in respect of any use of the trade mark prior to its registration under this Law; or
- (b) where the registration of the trade mark in the United Kingdom has been renewed, unless such renewal has been registered.

ARTICLE 10

Power of court to revoke registration

(1) A petition for the revocation of the registration of a trade mark may be presented to the court by -

- (a) the Attorney General or by any person who alleges that his interests have been prejudicially affected by such registration on the ground -
 - (i) that the trade mark was registered on the application of a person not entitled under the provisions of this Law to make the application; or
 - (ii) which is set out in paragraph (5) of Article 4; or
- (b) the Attorney General or any person having a sufficient interest on the ground of any contravention of, or failure to observe, a condition registered in relation to that trade mark.

(2) On the presentation of any petition under this Article, the court may, after considering the representations of any party to the proceedings, revoke the registration or dismiss the petition and the registrar shall forthwith take such action as the order of the court may require.

(3) In proceedings under this Article, the court may determine any question which it may consider necessary or expedient to determine in connection with the revocation of the registration.

Draft Trade Marks (Jersey) Law 199

ARTICLE 11

Fees

(1) The Committee may require the payment to the registrar of such fees as may be prescribed in respect of -

- (a) the performance by the registrar of such functions under this Law as may be prescribed, including the receipt by him of any document under this Law which is required to be delivered to him; and
- (b) the inspection of copying of documents or other material held by him under this Law.

(2) The registrar may charge a fee for any services provided by him otherwise than in pursuance of any obligation imposed on him by this Law.

(3) Where a fee is provided for or charged under this Article for performance of an act or duty by the registrar, no action need be taken by him until the fee is paid, and where the fee is payable on the receipt by him of a document required to be delivered to him he shall be deemed not to have received it until the fee is paid.

(4) Fees paid to the registrar shall form part of the annual income of the States.

PART III

COMMUNITY TRADE MARKS AND PROTECTED
INTERNATIONAL TRADE MARKS

ARTICLE 12

Community trade marks

(1) The provisions of the Community Trade Mark Regulation specified in the Schedule to this Law shall have full force and effect in the

Draft Trade Marks (Jersey) Law 199

Island subject to the exceptions, adaptations and modifications specified in paragraphs (2) to (4).

(2) Unless the context otherwise requires, references to the Community Trade Mark Regulation or to any provision thereof shall be construed as references to the Regulation or provision as it has effect in the Island.

(3) In relation to the Island, references to a Community trade mark court shall be construed as references to the Royal Court and references to the Community trade mark court of second instance shall be construed as references to the Court of Appeal.

(4) The Community Trade Mark Regulation shall be construed as if the Island were a Member State.

(5) The States may by Regulations make any provision they consider appropriate (including amending this Law) to give further effect to the Community Trade Mark Regulation and any amendments made thereto.

ARTICLE 13

Protected international trade marks

(1) Subject to the provisions of this Law, the proprietor or licensee of a protected international trade mark shall have the same rights and remedies under this Law regarding use of that trade mark, in relation to the goods and services in respect of which it confers protection, as if he was a registered proprietor or registered licensee, as the case may be, but, save as aforesaid, no person shall be entitled to any rights or remedies in respect of any protected international trade mark.

(2) References in this Law to goods or services in respect of which a trade mark is registered shall be construed as references to goods or services in respect of which a protected international trade mark confers protection.

Draft Trade Marks (Jersey) Law 199

(3) Where a protected international trade mark is subject to a disclaimer or limitation which has been notified to the Comptroller-General, the rights and remedies afforded by this Law shall have effect subject to such disclaimer or limitation.

(4) The States may by Regulations make such provision as they think fit (including amending this Law) for giving further effect in the Island to the provisions of the Madrid Protocol.

PART IV

ADMINISTRATION AND OTHER SUPPLEMENTARY PROVISIONS

ARTICLE 14

Rectification of register

(1) The court may, on the application of the Attorney General or of any person having a sufficient interest, order the register of trade marks to be rectified by the making of any entry therein or the variation or deletion of any such entry and the registrar shall forthwith take such action as the order may require.

(2) In proceedings under this Article the court may determine any question which it may be necessary or expedient to determine in connection with the rectification of the register of trade marks.

ARTICLE 15

Power to correct clerical errors

(1) Subject to the following provisions of this Article, the registrar may, either at the written request of a person having a sufficient interest or of his own motion, correct any clerical error in the register of trade marks.

(2) Where the registrar proposes to make a correction under paragraph (1) of his own motion, he shall give notice of the proposal to

Draft Trade Marks (Jersey) Law 199

the registered proprietor or the registered licensee, as the case may require, and to any other person who appears to him to have a sufficient interest, and shall give them an opportunity to be heard before making the correction.

(3) Where the registrar receives a written request to make a correction under paragraph (1) and he considers that the correction would materially affect the privileges and rights conferred by the registration, he shall require the person making the request to apply to the court for the rectification of the register of trade marks in accordance with Article 14.

ARTICLE 16

Adaptation of entries to UK registration

The registrar may, either at the written request of a person having sufficient interest or of his own motion, make such amendment to or substitution of any entry in the register as is necessary to bring it into conformity with the entry for the time being in respect of that trade mark in the United Kingdom register of trade marks.

ARTICLE 17

Amendment of filed regulations to be furnished to registrar

Where the Comptroller-General has accepted the amendment of the filed regulations to which any registered collective mark or certification mark relates, the registered proprietor shall, within six weeks of such acceptance, furnish to the registrar a copy of the amended regulations duly certified by the Comptroller-General, and, if he fails to do so, he shall be liable to a fine for each day during which the default continues.

Draft Trade Marks (Jersey) Law 199

ARTICLE 18

Restrictions on recovery of damages for infringement of registered trade marks

(1) Damages shall not be awarded in proceedings for the infringement of a registered trade mark against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the trade mark was registered.

(2) A person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the trade mark was registered by reason only of the application of the word “Registered” or any other word or words referring expressly or impliedly to registration unless the words “in Jersey” followed the word “Registered” or the words “Registered in Jersey” accompanied that other word or those other words.

(3) Nothing in this Article shall affect the power of the court to grant an injunction in any proceedings for infringement of a registered trade mark.

ARTICLE 19

Remedy for groundless threats of infringement proceedings

(1) Where a person threatens another with proceedings for infringement of a registered trade mark, Community trade mark or protected international trade mark other than -

- (a) the application of that mark to goods or their packaging;
- (b) the importation of goods to which, or to the packaging of which, the mark has been applied; or
- (c) the supply of services under the mark,

any person aggrieved may bring proceedings in the court for relief under this Article.

Draft Trade Marks (Jersey) Law 199

- (2) The relief available under this Article is -
 - (a) a declaration that the threats are unjustifiable;
 - (b) an injunction against the continuance of the threats; and
 - (c) damages in respect of any loss sustained by the threats.
- (3) The plaintiff is entitled to relief unless-
 - (a) the defendant shows that the acts in respect of which proceedings were threatened constitute, or, if done, would constitute, an infringement of the mark concerned; and
 - (b) the plaintiff is unable to show that the registration (or, in the case of a protected international trade mark, the protection) of the mark is invalid or liable to be revoked in a relevant respect.
- (4) The mere notification -
 - (a) that a trade mark is registered, or that an application for registration has been made; or
 - (b) in the case of a protected international trade mark, that it is protected or is the subject of a request for protection in the United Kingdom,

does not constitute a threat of proceedings for the purposes of this Article.

ARTICLE 20

Privilege for communications with trade mark agents or professional representatives

- (1) Any communication between a person and a person he has instructed -

Draft Trade Marks (Jersey) Law 199

- (a) whose name is entered in the register of trade mark agents kept under section 83 of the Trade Marks Act; or
- (b) who is on the list of professional representatives maintained in pursuance of Article 89 of the Community Trade Mark Regulation,

in relation to the protection of any trade mark or any matter involving passing off, is privileged from disclosure in the same way as a communication between a person and his advocate or solicitor.

(2) Any communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a person described in sub-paragraph (a) or (b) of paragraph (1) in relation to the protection of any trade mark or any matter involving passing off, is privileged from disclosure in the same way as a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his advocate or solicitor.

ARTICLE 21

Use of trade mark for export trade

The application in the Island of a trade mark to goods or services to be exported from the Island, and any other act done in the Island in relation to goods or services to be so exported which, if done in relation to goods or services to be sold or otherwise traded in within the Island, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods or services for any purpose for which such use is material under this Law or under the customary law.

Draft Trade Marks (Jersey) Law 199

ARTICLE 22

Infringing goods, material or articles may be treated as prohibited goods

(1) The proprietor or licensee of a registered trade mark, Community trade mark or protected international trade mark may give notice in writing to the Agent of the Impôts -

- (a) that he is the proprietor or, as the case may be, a licensee of that mark;
- (b) that, at a time and place specified in the notice, goods which are, in relation to the mark, infringing goods, material or articles are expected to arrive in the Island -
 - (i) from outside the European Economic Area; or
 - (ii) from within that Area but not having been entered for free circulation; and
- (c) that he requests the Agent of the Impôts to treat them as prohibited goods.

(2) Where a notice is in force under this Article, any goods to which the notice relates which are imported otherwise than by a person for his private and domestic use shall be liable to forfeiture (but a person shall not, by reason of the goods being treated as prohibited, be liable to any other penalty in respect of them).

(3) This Article does not apply to goods entered, or expected to be entered for free circulation, export, re-export or for a suspensive procedure in respect of which an application may be made under Article 3(1) of Council Regulation (EC) No. 3295/94 (O.J. No. L341. 30.12.94, p.8) laying down measures to prohibit the release for free circulation, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods.

Draft Trade Marks (Jersey) Law 199

ARTICLE 23

Orders concerning the importation of infringing goods, material or articles

(1) The Committee may make Orders prescribing the form in which notice is to be given under Article 22 and requiring a person giving notice -

- (a) to furnish the Agent of the Impôts with such evidence as may be specified in the Order, either on giving notice or when the goods are imported, or at both these times; and
- (b) to comply with such other conditions as may be specified in the Order.

(2) An Order may, in particular, require a person giving notice -

- (a) to pay such fees in respect of the notice as may be specified by the Order;
- (b) to give such security as may be so specified in respect of any liability or expense which the Agent of the Impôts may incur in consequence of the notice by reason of the detention of any goods or anything done to goods detained; and
- (c) to indemnify the Agent of the Impôts against any such liability or expense, whether security has been given or not.

(3) Article 8 of the Customs and Excise (Jersey) Law 1999² applies to fees paid in pursuance of an Order made under this Article as it applies to receipts under the enactments relating to customs and excise.

² At the time of printing, this Law was awaiting Privy Council sanction.

Draft Trade Marks (Jersey) Law 199

ARTICLE 24

Power of Agent of the Impôts to disclose information

Where information relating to infringing goods, material or articles has been obtained by the Agent of the Impôts for the purposes of, or in connection with, the exercise of his functions in relation to imported goods, he may authorize the disclosure of that information for the purpose of facilitating the exercise by any person of any function in connection with the investigation or prosecution of an offence under Article 25 or any enactment relating to trade descriptions.

ARTICLE 25

Unauthorized use of trade mark in relation to goods

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

- (a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trade mark, Community trade mark or protected international trade mark;
- (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign; or
- (c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under sub-paragraph (b).

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

Draft Trade Marks (Jersey) Law 199

- (a) applies a sign identical to, or likely to be mistaken for, a registered trade mark, Community trade mark or protected international trade mark to material intended to be used -
 - (i) for labelling or packaging goods;
 - (ii) as a business paper in relation to goods; or
 - (iii) for advertising goods;
- (b) uses in the course of a business material bearing such a sign for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or
- (c) has in his possession, custody or control in the course of a business any such material with a view to the going of anything, by himself or another, which would be an offence under sub-paragraph (b).

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

- (a) makes an article specifically designed or adapted for making copies of a sign identical to, or likely to be mistaken for, a registered trade mark, Community trade mark or protected international trade mark; or
- (b) has such an article in his possession, custody or control in the course of a business,

knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods.

(4) A person does not commit an offence under this Article unless -

Draft Trade Marks (Jersey) Law 199

- (a) the goods are goods in respect of which the trade mark is registered; or
- (b) the trade mark has a reputation in the Island and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark.

(5) It is a defence for a person charged with an offence under this Article to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the trade mark.

(6) A person guilty of an offence under this Article shall be liable to a fine or to imprisonment for a term not exceeding 10 years, or to both.

ARTICLE 26

Falsification of register of trade marks

A person who -

- (a) makes or causes to be made -
 - (i) a false entry in the register of trade marks; or
 - (ii) anything falsely purporting to be a copy of an entry in that register; or
- (b) produces or tenders or causes to be produced or tendered in evidence any such thing,

knowing or having reason to believe the entry or thing to be false shall be liable to imprisonment for a term not exceeding two years or to a fine, or to both.

Draft Trade Marks (Jersey) Law 199

ARTICLE 27

False representations in respect of trade marks

- (1) A person who -
 - (a) falsely represents that a mark is a registered trade mark, a Community trade mark or a protected international trade mark; or
 - (b) makes a false representation as to the goods or services for which such a mark is registered,

knowing or having reason to believe the representation to be false shall be liable to a fine not exceeding level 3 on the standard scale.³

(2) For the purposes of this Article, the use in the Island in relation to a trade mark of the words “Registered in Jersey”, or of any other word or symbol referring, whether expressly or impliedly, to registration, shall be deemed to import a reference to registration in the register of trade marks.

ARTICLE 28

Forfeiture

- (1) Where, in connection with the investigation or prosecution of a relevant offence -
 - (a) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trade mark, Community trade mark or protected international trade mark;
 - (b) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or

³ Volume 1992-1993, page 437.

Draft Trade Marks (Jersey) Law 199

- (c) articles specifically designed or adapted for making copies of such a sign,

have come into the possession of any person, he may apply to the court for an order for the forfeiture of the goods, material or articles, and where the court is satisfied that such an offence has been committed, it shall make such an order.

(2) For the purposes of this Article the court may infer that a relevant offence has been committed in relation any to goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are representative of them, whether by reason of being of the same design or part of the same consignment or batch, or otherwise.

(3) Where any goods, material or articles are forfeited under this Article the court shall -

- (a) direct that they be destroyed in accordance with such directions as it may give; or
- (b) if it considers it appropriate to do so, direct that they shall be released to such person it may specify, on condition that that person -
 - (i) causes the offending sign to be erased, removed or obliterated; and
 - (ii) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

(4) In this Article “relevant offence” means -

- (a) an offence under Article 25;
- (b) an offence under any enactment relating to trades descriptions; or
- (c) any offence involving dishonesty or deception.

*Draft Trade Marks (Jersey) Law 199**PART V*

MISCELLANEOUS

ARTICLE 29

Offences by partnerships and bodies corporate

(1) Proceedings for an offence under this Law alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not that of the partners, but without prejudice to any liability of the partners under paragraph (3).

(2) A fine imposed on a partnership on its conviction in proceedings for an offence under this Law shall be paid out of the partnership assets.

(3) Where a partnership is guilty of an offence under this Law, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is guilty of the offence and liable to be proceeded against and punished accordingly.

(4) Where an offence under this Law committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body corporate, or any person purporting to act in any such capacity, he (as well as the body corporate) shall be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

ARTICLE 30

Accessories and abettors

A person who aids, abets, counsels or procures the commission of an offence under this Law shall be liable to be dealt with, tried and punished as a principal offender.

Draft Trade Marks (Jersey) Law 199

ARTICLE 31

Orders

(1) The Committee may by Order make provision for the purpose of carrying this Law into effect and in particular, but without prejudice to the generality of the foregoing, for prescribing any matter which may be prescribed under this Law.

(2) Provision may, in particular, be made -

- (a) as to the manner of filing of applications and other documents;
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (c) as to the service of documents;
- (d) authorizing the rectification of irregularities of procedure;
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Law; and
- (f) providing for the extension of any time limit so prescribed, or specified by the registrar, whether or not it has already expired.

(3) An Order made under this Law may -

- (a) make different provision in relation to different cases or circumstances; and
- (b) contain such incidental, supplementary or transitional provisions as the Committee may consider necessary or expedient.

Draft Trade Marks (Jersey) Law 199

(4) The Subordinate Legislation (Jersey) Law 1960⁴ shall apply to Orders made under this Law.

ARTICLE 32

Rules of Court

(1) Rules of Court made under the Royal Court (Jersey) Law 1948⁵ for the purposes of this Law and proceedings thereunder may make provision -

- (a) for the appointment of advisers to assist the court in proceedings for infringement of trade marks and proceedings under this Law, and for regulation the functions of such advisers;
- (b) for enabling persons to take proceedings under this Law *in forma pauperis*;
- (c) for the hearing by the court in vacation of all such matters under this Law as may require to be immediately or promptly heard.

(2) The remuneration of any adviser appointed under Rules made in pursuance of this Article shall be defrayed out of the annual income of the States.

ARTICLE 33

Saving of vested rights

(1) Nothing in this Law shall be deemed to derogate from such rights as may be possessed by any person by virtue of the registration in the rolls of the Royal Court before the coming into force of the Trade Marks (Jersey) Law 1958⁶ of any document relating to a trade mark.

⁴ Tome VIII, page 849.

⁵ Tome VII, page 502, Volume 1979-1981, page 195, Volume 1984-1985, pages 175 and 178, Volume 1990-1991, page 113, Volume 1992-1993, page 461, and Volume 1996-1997, pages 147, 148 and 665.

⁶ Tome VIII, page 741, and Volume 1986-1987, pages 175 and 379.

Draft Trade Marks (Jersey) Law 199

(2) Nothing in this Law shall entitle the registered proprietor or a registered licensee of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or similar to it in relation to goods or services for which that person or a predecessor in title of his has continuously used that trade mark from a date prior to the registration in the United Kingdom of the first-mentioned trade mark in respect of those goods in the name of the registered proprietor or a predecessor in title of his.

ARTICLE 34

Saving of rights of action for passing off

Nothing in this Law shall affect rights of action against any person for passing off or the remedies in respect thereof.

ARTICLE 35

Amendment of Merchandise Marks (Jersey) Law 1958⁷

The Merchandise Marks (Jersey) Law 1958 is amended as follows -

- (a) in Article 1⁸ -
- (i) for the definition of “trade mark” in paragraph (1) there shall be substituted the following definition-
- “ ‘trade mark’ means -
- (a) a registered trade mark, Community trade mark or protected international trade mark; or
- (b) a trade mark registered under the Trade Marks Act;” and

⁷ Tome VIII, page 753, Volume 1988-1989, page 511, and Volume 1994-1995, page 251.

⁸ Tome VIII, page 755.

Draft Trade Marks (Jersey) Law 199

- (ii) after paragraph (1) there shall be inserted the following paragraph -

“(1A) Words and phrases used in this Law shall, unless the context otherwise requires, have the same respective meanings as in the Trade Marks (Jersey) Law 199 ”; and

- (b) in Article 14⁹ -

- (i) for the words “a certification trade mark registered under Article 4 of the Trade Marks (Jersey) Law, 1958, or a certification trade mark registered or deemed to be registered under section 37 of the Trade Marks Act, 1938” there shall be substituted the words “a certification mark registered under Article 4 of the Trade Marks (Jersey) Law 199 or a certification mark registered or deemed to be registered under the Trade Marks Act”; and

- (ii) in the proviso for the words “certification trade mark” there shall be substituted the words “certification mark”.

ARTICLE 36

Repeals and savings in relation to repealed legislation

- (1) The following Laws are repealed -
- (a) the Trade Marks (Jersey) Law 1958;¹⁰
- (b) the Trade Marks (Amendment) (Jersey) Law 1969;¹⁰

⁹ Tome VIII, page 766.

¹⁰ Tome VIII, page 741.

Draft Trade Marks (Jersey) Law 199

- (c) the Trade Marks (Amendment No. 2) (Jersey) Law 1986;¹¹ and
 - (d) the Trade Marks (Amendment No. 3) (Jersey) Law 1987.¹²
- (2) On the commencement of this Law -
- (a) any registered trade mark registered or purported to be registered in accordance with the 1958 Law (whether before or after the commencement of the Trade Marks Act) shall have effect as if registered under this Law;
 - (b) an application for the registration of a trade mark made under Article 4 of the 1958 Law or an application for registration as a registered user under Article 6 of that Law and not yet determined shall be treated as an application under Article 4 or Article 6 of this Law as the case may be;
 - (c) any note indicating that a trade mark registered under the 1958 Law is associated with any other mark shall cease to have effect;
 - (d) a condition entered in the register of trade marks kept under Article 3 of the 1958 Law shall cease to have effect;
 - (e) a disclaimer or limitation or an assignment or transmission entered in the register of trade marks kept under Article 3 of the 1958 Law shall have effect as if entered in the register maintained under Article 3 of this Law; and
 - (f) any proceedings begun under Article 10 or Article 11 of the 1958 Law but not yet determined shall have effect as if begun under Article 10 or Article 14 of this Law as the case may be.

¹¹ Volume 1986-1987, page 175.

¹² Volume 1986-1987, page 379.

Draft Trade Marks (Jersey) Law 199

(3) In paragraph (2) “the 1958 Law” means the Trade Marks (Jersey) Law 1958.¹³

ARTICLE 37

Short title and commencement

This Law may be cited as the Trade Marks (Jersey) Law 199 and shall come into force on such day as the States may by Act appoint.

¹³ Tome VIII, page 741, and Volume 1986-1987, pages 175 and 379.

Draft Trade Marks (Jersey) Law 199

SCHEDULE

(Article 12)

PROVISIONS OF COMMUNITY TRADE MARK REGULATION
APPLIED TO THE ISLAND

TITLE I: GENERAL PROVISIONS

Article 1 (Community trade mark)

Article 3 (Capacity to act)

TITLE II: THE LAW RELATING TO TRADE MARKS

Article 9 (Rights conferred by a Community trade mark)

Article 10 (Reproduction of Community trade marks in dictionaries)

Article 11 (Prohibition on the use of a Community trade mark registered in the name of an agent or representative)

Article 12 (Limitation of the effects of a Community trade mark)

Article 13 (Exhaustion of the rights conferred by a Community trade mark)

Article 14 (Complementary application of national law relating to infringement)

Article 15 (Use of Community trade marks)

Article 16 (Dealing with Community trade marks as national trade marks)

Article 19 (rights in rem), except paragraph 2

Article 22 (Licensing) except -

Draft Trade Marks (Jersey) Law 199

in paragraph 1, the words “and for the whole of part of the Community”;

paragraph 5

Article 23 (Effects vis-à-vis third parties), except -

in paragraph 1 the words “17” and “in all the Member States”;

paragraphs 3 and 4

TITLE VI: SURRENDER, REVOCATION AND INVALIDITY

Article 53 (Limitation in consequence of acquiescence)

Article 54 (Consequences of revocation and invalidity)

TITLE VIII: COMMUNITY COLLECTIVE MARKS

Article 64 (Community collective marks), except paragraphs 2 and 3

Article 70 (Persons who are entitled to bring an action for infringement)

TITLE IX: PROCEDURE

Article 86 (Administrative cooperation), except -

in the first sentence the words “the Office and”

the second sentence

*TITLE X: JURISDICTION AND PROCEDURE IN LEGAL ACTIONS
RELATING TO COMMUNITY TRADE MARKS*

Article 92 (Jurisdiction over infringement and validity), except paragraph (d)

Draft Trade Marks (Jersey) Law 199

- Article 95 (Presumption of validity - Defence as to the merits),
except -

in paragraph 1, the words from “unless to the end of the
paragraph;

paragraph 3
- Article 97 (Applicable law)
- Article 98 (Sanctions)
- Article 99 (Provisional and protective measures), except -

in paragraph 1 the words “or Community trade mark
application”

paragraph 2
- Article 100 (Specific rules on related actions), except paragraph 2
- Article 101 (Jurisdiction of Community trade mark courts of second
instance - Further appeal)
- Article 103 (Obligation of the national court)

TITLE XI: EFFECTS ON THE LAWS OF MEMBER STATES

- Article 105 (Simultaneous and successive civil actions on the basis of
Community trade marks and national trade marks)
- Article 106 (Prohibition of use of Community trade marks), except
paragraph 1
- Article 107 (Prior rights applicable to particular localities)

TITLE XIII: FINAL PROVISIONS

- Article 142 (Compatibility with other Community legal provisions)

*Draft Trade Marks (Jersey) Law 199*TEXT OF THE PROVISIONS OF COUNCIL REGULATION (EC) No
40/94 OF 20 DECEMBER 1993 ON THE COMMUNITY TRADE
MARK AS APPLICABLE IN THE ISLAND**(For information only - not part of this Law)**

THE COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community, and in particular Article 235 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Parliament,

Having regard to the opinion of the Economic and Social Committee,

Whereas it is desirable to promote throughout the Community a harmonious development of economic activities and a continuous and balanced expansion by completing an internal market which functions properly and offers conditions which are similar to those obtaining in a national market; whereas in order to create a market of this kind and make it increasingly a single market, not only must be barriers to free movement of goods and services be removed and arrangements be instituted which ensure that competition is not distorted, but, in addition, legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community, whether in manufacturing and distributing goods or in providing services; whereas for those purposes, trade marks enabling the products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers, should feature amongst the legal instruments which undertakings have at their disposal;

Whereas action by the Community would appear to be necessary for the purpose of attaining the Community's said objectives; whereas such action involves the creation of Community arrangements for trade marks whereby undertakings can by means of one procedural system obtain Community trade marks to which uniform protection is given and which

Draft Trade Marks (Jersey) Law 199

produce their effects throughout the entire area of the Community; whereas the principle of the unitary character of the Community trade mark thus stated will apply unless otherwise provided for in this Regulation;

Whereas the barrier of territoriality of the rights conferred on proprietors of trade marks by the laws of the Member States cannot be removed by approximation of laws; whereas in order to open up unrestricted economic activity in the whole of the common market for the benefit of undertakings, trade marks need to be created which are governed by a uniform Community law directly applicable in all Member States;

Whereas since the Treaty has not provided the specific powers to establish such a legal instrument, Article 235 of the Treaty should be applied;

Whereas the Community law relating to trade marks nevertheless does not replace the laws of the Member States on trade marks; whereas it would not in fact appear to be justified to require undertakings to apply for registration of their trade marks as Community trade marks; whereas national trade marks continue to be necessary for those undertakings which do not want protection of their trade marks at Community level;

Whereas the rights in a Community trade mark may not be obtained otherwise than by registration, and registration is to be refused in particular if the trade mark is not distinctive, if it is unlawful or if it conflicts with earlier rights;

Whereas the protection afforded by a Community trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and the goods or services; whereas the protection applies also in cases of similarity between the mark and the sign and the goods or services; whereas an interpretation should be given of the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the

Draft Trade Marks (Jersey) Law 199

goods or services identified, constitutes the specific condition for such protection;

Whereas it follows from the principle of free flow of goods that the proprietor of a Community trade mark must not be entitled to prohibit its use by a third party in relation to goods which have been put into circulation in the Community, under the trade mark, by him or with his consent, save where there exist legitimate reasons for the proprietor to oppose further commercialization of the goods;

Whereas there is not justification for protecting Community trade marks or, as against them, any trade mark which has been registered before them, except where the trade marks are actually used;

Whereas a Community trade mark is to be regarded as an object of property which exists separately from the undertakings whose goods or services are designated by it; whereas accordingly, it must be capable of being transferred, subject to the overriding need to prevent the public being misled as a result of the transfer. It must also be capable of being charged as security in favour of a third party and of being the subject matter of licences;

Whereas administrative measures are necessary at Community level for implementing in relation to every trade mark the trade mark law created by this Regulation; whereas it is therefore essential, while retaining the Community's existing institutional structure and balance of powers, to establish an Office for Harmonization in the Internal Market (trade marks and designs) which is independent in relation to technical matters and has legal, administrative and financial autonomy; whereas to this end it is necessary and appropriate that it should be a body of the Community having legal personality and exercising the implementing powers which are conferred on it by this Regulation, and that it should operate within the framework of Community law without detracting from the competencies exercised by the Community institutions;

Whereas it is necessary to ensure that parties who are affected by decisions made by the Office are protected by the law in a manner which is suited to the special character of trade mark law; whereas to that end provision is made for an appeal to lie from decisions of the examiners and

Draft Trade Marks (Jersey) Law 199

of the various divisions of the Office; whereas if the department whose decision is contested does not rectify its decision it is to remit the appeal to a Board of Appeal of the Office, which is to decide on it; whereas decisions of the Boards of Appeal are, in turn, amenable to actions before the Courts of Justice of the European Communities, which has jurisdiction to annul or to alter the contested decision;

Whereas under Council Decision 88/591/ECSC, EEC, Euratom of 24 October 1988 establishing a Court of First Instance of the European Communities, as amended by Decision 93/350/Euratom, ECSC, EEC of 8 June 1993, that Court shall exercise at the first instance the jurisdiction conferred on the Court of Justice by the Treaties establishing the Communities - with particular regard to appeals lodged under the second subparagraph of Article 173 of the EC Treaty - and by the acts adopted in implementation thereof, save as otherwise provided in an act setting up a body governed by Community law; whereas the jurisdiction which this Regulation confers on the Court of Justice to cancel and reform decisions of the appeal courts shall accordingly be exercised at the first instance by the Court in accordance with the above Decision;

Whereas in order to strengthen the protection of Community trade marks the Members States should designate, having regard to their own national system, as limited a number as possible of national courts of first and second instance having jurisdiction in matters of infringement of validity of Community trade marks;

Whereas decisions regarding the validity and infringement of Community trade marks must have effect and cover the entire area of the Community, as this is the only way of preventing inconsistent decisions on the part of the courts and the Office and of ensuring that the unitary character of Community trade marks is not undermined; whereas the rules contained in the Brussels Convention of Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters will apply to all actions at law relating to Community trade marks, save where this Regulation derogates from those rules;

Whereas contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of a Community trade mark and parallel national trade marks;

Draft Trade Marks (Jersey) Law 199

whereas for this purpose, when the actions are brought in the same Member State, the way in which this is to be achieved is a matter for national procedural rules, which are not prejudiced by this Regulation, whilst when the actions are brought in different Member States, provisions modelled on the rules on *lis pendens* and related actions of the abovementioned Brussels Convention appear appropriate;

Whereas in order to guarantee the full autonomy and independence of the Office, it is considered necessary to grant it an autonomous budget whose revenue comes principally from fees paid by the users of the system; whereas however, the Community budgetary procedure remains applicable as far as any subsidies chargeable to general budget of the European Communities are concerned; whereas moreover, the auditing of accounts should be undertaken by the Court of Auditors;

Whereas implementing measures are required for the Regulation's application, particularly as regards the adoption and amendment of fees regulations and an Implementing Regulation; whereas such measures should be adopted by the Commission, assisted by a Committee composed of representatives of the Member States, in accordance with the procedural rules laid down in Article 2, procedure III(b), of Council Decisions 87/373/EEC of 13 July 1987 laying down the procedures for the exercise of implementing powers conferred on the Commission (6),

HAS ADOPTED THIS REGULATION:

*TITLE I: GENERAL PROVISIONS**Article 1*

Community trade mark

1. A trade mark for goods or services which is registered in accordance with the conditions contained in this Regulation and in the manner herein provided is hereinafter referred to as a 'Community trade mark'.
2. A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community; it shall not be

Draft Trade Marks (Jersey) Law 199

registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle shall apply unless otherwise provided in this Regulation.

Article 2

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Article 3

Capacity to act

For the purpose of implementing this Regulation, companies or firms and other legal bodies shall be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued.

TITLE II: THE LAW RELATING TO TRADE MARKS

Article 4

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Article 5

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Article 6

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Article 7

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*Draft Trade Marks (Jersey) Law 199**Article 8*

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Article 9

Rights conferred by a Community trade mark

1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:
 - (a) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;
 - (b) any sign where, because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
 - (c) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.
2. The following, inter alia, may be prohibited under paragraph 1:
 - (a) affixing the sign to the goods or to the packaging thereof;
 - (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
 - (c) importing or exporting the goods under that sign;

Draft Trade Marks (Jersey) Law 199

- (d) using the sign on business papers and in advertising.
3. The rights conferred by a Community trade mark shall prevail against third parties from the date of publication of registration of the trade mark. Reasonable compensation may, however, be claimed in respect of matters arising after the date of publication of a Community trade mark application, which matters would, after publication of the registration of the trade mark, be prohibited by virtue of that publication. The court seized of the case may not decide upon the merits of the case until the registration has been published.

Article 10

Reproduction of Community trade marks in dictionaries

If the reproduction of a Community trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the Community trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark.

Article 11

Prohibition on the sue of a Community trade mark registered in the name of an agent or representative

Where a Community trade mark is registered in the name of the agent or representative of a person who is the proprietor of that trade mark, without the proprietor's authorization, the latter shall be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use, unless the agent or representative justifies his action.

Article 12

Limitation of the effects of a Community trade mark

Draft Trade Marks (Jersey) Law 199

A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) his own name or address;
- (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
- (c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided he uses them in accordance with honest practises in industrial or commercial matters.

Article 13

Exhaustion of the rights conferred by a Community trade mark

1. A Community trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that trade mark by the proprietor or with his consent.
2. Paragraph 1 shall not apply where there exists legitimate reasons for the proprietor to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

Article 14

Complementary application of national law relating to infringement

1. The effects of Community trade marks shall be governed solely by the provisions of this Regulation. In other respects, infringement of a Community trade mark shall be governed by the national law

Draft Trade Marks (Jersey) Law 199

relating to infringement of a national trade mark in accordance with the provisions of Title X.

2. This Regulation shall not prevent actions concerning a Community trade mark being brought under the law of Member States relating in particular to civil liability and unfair competition.
3. The rules of procedure to be applied shall be determined in accordance with the provisions of Title X.

Article 15

Use of Community trade marks

1. If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.
2. The following shall also constitute use within the meaning of paragraph 1:
 - (a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;
 - (b) affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for the export purposes.
3. Use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

*Draft Trade Marks (Jersey) Law 199**Article 16*

Dealing with Community trade marks as national trade marks

1. Unless Articles 17 to 24 provide otherwise, a Community trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national trade mark registered in the Member State in which, according to the Register of Community trade marks,
 - (a) the proprietor has his seat or his domicile on the relevant date; or
 - (b) where subparagraph (a) does not apply, the proprietor has an establishment on the relevant date.
2. In cases which are not provided for by paragraph 1, the Member State referred to in that paragraph shall be the Member State in which the seat of the Office is situated.
3. If two or more persons are mentioned in the Register of Community trade marks as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply.

Article 17

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Article 18

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*Draft Trade Marks (Jersey) Law 199**Article 19*

Rights in rem

1. A Community trade mark may, independently of the undertaking, be given as security or be the subject of rights in rem.
2. * * * * *

Article 20

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Article 21

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Article 22

Licensing

1. A Community trade mark may be licensed for some or all to the goods or services for which it is registered * * *. A licence may be exclusive or non-exclusive.
2. The proprietor of a Community trade mark may invoke the rights conferred by the trade mark against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form covered by the registration in which the trade mark may be used, the scope of the goods or services for which the licence is granted, the territory in which the trade mark may be affixed, or the quality of the goods manufactured or of the services provided by the licensee.
3. Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a Community trade mark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the

Draft Trade Marks (Jersey) Law 199

proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

- 4. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor of the Community trade mark.
- 5. * * * * *

Article 23

Effects vis-à-vis third parties

- 1. Legal acts referred to in Article * * *, 19 and 22 concerning a Community trade mark shall only have effects vis-à-vis third parties * * * after entry in the Register. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired.
- 2. Paragraph 1 shall not apply in the case of a person who acquires the Community trade mark or a right concerning the Community trade mark by way of transfer of the whole of the undertaking or by any other universal succession.

- 3. * * * * *
- 4. * * * * *

Article 24

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TITLE III: APPLICATION FOR COMMUNITY TRADE MARKS

Article 25

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Draft Trade Marks (Jersey) Law 199

Article 26

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Article 27

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Draft Trade Marks (Jersey) Law 199

TITLE IV: REGISTRATION PROCEDURE

Article 36

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Article 37

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Article 38

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Article 41

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Draft Trade Marks (Jersey) Law 199

Article 45

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*TITLE V: DURATION, RENEWAL AND ALTERATION OF
COMMUNITY TRADE MARKS*

Article 46

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Article 47

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Article 48

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TITLE VI: SURRENDER, REVOCATION AND INVALIDITY

Article 49

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Article 50

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Article 51

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Article 52

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*Draft Trade Marks (Jersey) Law 199**Article 53*

Limitation in consequence of acquiescence

1. Where the proprietor of a Community trade mark has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Community while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.
2. Where the proprietor of an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced, for a period of five successive years, in the use of a later Community trade mark in the Member State in which the earlier trade mark or other earlier sign is protected while being aware of such use, he shall no longer be entitled on the basis of the earlier trade mark or of the other earlier sign either to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in respect of the goods or services for which the later trade mark has been used, unless registration of the later Community trade mark was applied for in bad faith.
3. In the case referred to in paragraphs 1 and 2, the proprietor of a later Community trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later Community trade mark.

Article 54

Consequences of revocation and invalidity

1. The Community trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date,

Draft Trade Marks (Jersey) Law 199

on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.

2. The Community trade mark shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that that trade mark has been declared invalid.
3. Subject to the national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the proprietor of the trade mark, or to unjust enrichment, the retroactive effect of revocation or invalidity of the trade mark shall not affect:
 - (a) any decision on infringement which has acquired the authority of a final decision and been enforced prior to the revocation or invalidity decision;
 - (b) any contract concluded prior to the revocation or invalidity decision, in so far as it has been performed before that decision; however, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract, may be claimed on grounds of equity.

Article 55

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Article 56

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*TITLE VII: APPEALS**Article 57*

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Article 58

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Draft Trade Marks (Jersey) Law 199

Article 59

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Article 61

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Article 62

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Article 63

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TITLE VIII: COMMUNITY COLLECTIVE MARKS

Article 64

Community collective marks

1. A Community collective mark shall be a Community trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for Community collective marks.
2. * * * * *

Draft Trade Marks (Jersey) Law 199

3. * * * * *

Article 65

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Article 66

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Article 67

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Article 68

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Article 69

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Article 70

Persons who are entitled to bring an action for infringement

1. The provisions of Article 22(3) and (4) concerning the rights of licensees shall apply to every person who has authority to use a Community collective mark.
2. The proprietor of a Community collective mark shall be entitled to claim compensation of behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorized use of the mark.

Article 71

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Draft Trade Marks (Jersey) Law 199

Article 72

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TITLE IX: PROCEDURE

Article 73

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Article 74

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Article 75

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Article 76

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Draft Trade Marks (Jersey) Law 199

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Article 83

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Article 84

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Article 85

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Article 86

Administrative cooperation

Unless otherwise provided in this Regulation or in national laws,
* * * the courts or authorities of the Member States shall on request
give assistance to each other by communicating information or opening
files for inspection. * * *.

Article 87

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Article 88

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Draft Trade Marks (Jersey) Law 199

Article 89

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*TITLE X: JURISDICTION AND PROCEDURE IN LEGAL ACTIONS
RELATING TO COMMUNITY TRADE MARKS*

Article 90

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Article 91

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Article 92

Jurisdiction over infringement and validity

The Community trade mark courts shall have exclusive jurisdiction:

- (a) for all infringement actions and - if they are permitted under national law - actions in respect of threatened infringement relating to Community trade marks;
- (b) for actions for declaration of non-infringement, if they are permitted under national law;
- (c) for all actions brought as a result of acts referred to in Article 9(3), second sentence;
- (d) * * * * *

Article 93

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Draft Trade Marks (Jersey) Law 199

Article 94

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Article 95

Presumption of validity - Defence as to the merits

1. The Community trade mark courts shall treat Community trade mark as valid * * *.
2. The validity of a Community trade mark may not be put in issue in an action for a declaration of non-infringement.
3. * * * * *

Article 96

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Article 97

Applicable law

1. The Community trade mark courts shall apply the provisions of this Regulation.
2. On all matters not covered by this Regulation a Community trade mark court shall apply its national law, including its private international law.
3. Unless otherwise provided in this Regulation, a Community trade mark court shall apply the rules of procedure governing the same type of action relating to a national trade mark in the Member State where it has its seat.

*Draft Trade Marks (Jersey) Law 199**Article 98*

Sanctions

1. Where a Community trade mark court finds that the defendant has infringed or threatened to infringe a Community trade mark, it shall, unless there are no special reasons for not doing so, issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark. It shall also take such measures in accordance with its national law as are aimed at ensuring that this prohibition is complied with.
2. In all other respects the Community trade mark court shall apply the law of the Member State to which the acts of infringement or threatened infringement were committed, including the private international law.

Article 99

Provisional and protective measures

1. Application may be made to the courts of Member State, including Community trade mark courts, for such provisional, including protective, measures in respect of a Community trade mark * * * as may be available under the law of that State in respect of a national trade mark, even if, under this Regulation, a Community trade mark court of another Member State has jurisdiction as to the substance of the matter.
2. * * * * *

Article 100

Specific rules on related actions

1. A Community trade mark court hearing an action referred to in Article 92, other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the

Draft Trade Marks (Jersey) Law 199

request of one of the parties and after hearing the parties, stay the proceedings where the validity of the Community trade mark is already in issue before another Community trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has been already been filed at the Office.

2. * * * * *
3. Where the Community trade mark court stays the proceedings it may order provisional and protective measures for the duration of the stay.

Article 101

Jurisdiction of Community trade mark courts of second instance - Further appeal

1. An appeal to the Community trade mark courts of second instance shall lie from judgments of the Community trade mark courts of first instance in respect of proceedings arising from the actions and claims referred to in Article 92.
2. The conditions under which an appeal may be lodged with a Community trade mark court of second instance shall be determined by the national law of the Member State in which that court is located.
3. The national rules concerning further appeal shall be applicable in respect of judgments of Community trade mark courts of second instance.

Article 102

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*Draft Trade Marks (Jersey) Law 199**Article 103*

Obligation of the national court

A national court which is dealing with an action relating to a Community trade mark, other than the action referred to in Article 92, shall treat the trade mark as valid.

Article 104

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*TITLE XI: EFFECTS ON THE LAWS OF MEMBER STATES**Article 105*

Simultaneous and successive civil actions on the basis of Community trade marks and national trade marks

1. Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different Member States, one seized on the basis of a Community trade mark and the other seized on the basis of a national trade mark:
 - (a) the court other than the court first seized shall of its own motion decline jurisdiction in favour of that court where the trade marks concerned are identical and valid for identical goods or services. The court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested;
 - (b) the court other than the court first seized may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services and where the trade marks concerned are similar and valid for identical or similar goods or services.
2. The court hearing an action for infringement on the basis of a Community trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between

Draft Trade Marks (Jersey) Law 199

the same parties on the basis of an identical national trade mark valid for identical goods or services.

3. The court hearing an action for infringement on the basis of a national trade mark shall reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical Community trade mark valid for identical goods or services.
4. Paragraphs 1, 2 and 3 shall not apply in respect of provisional, including protective, measures.

Article 106

Prohibition of use of Community trade marks

1. * * * * *
2. This Regulation shall, unless otherwise provided for, not affect the right to bring proceedings under the civil, administrative or criminal law of a Member State or under provisions of Community law for the purpose of prohibiting the use of a Community trade mark to the extent that the use of a national trade mark may be prohibited under the law of that Member State or under Community law.

Article 107

Prior rights applicable to particular localities

1. The proprietor of an earlier right which only applies to a particular locality may oppose the use of the Community trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.
2. Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the Community trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the Community trade mark was applied for in bad faith.

Draft Trade Marks (Jersey) Law 199

3. The proprietor of the Community trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though that right may no longer be invoked against the Community trade mark.

Article 108

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Article 109

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Article 110

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TITLE XII: THE OFFICE

Article 111

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Article 112

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Article 113

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Article 114

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Article 115

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Draft Trade Marks (Jersey) Law 199

Article 116

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Draft Trade Marks (Jersey) Law 199

Article 126

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*Draft Trade Marks (Jersey) Law 199**Article 135*

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*TITLE XIII: FINAL PROVISIONS**Article 140*

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Article 141

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Article 142

Compatibility with other Community legal provisions

This Regulation shall not affect Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs of 14 July 1992, and in particular Article 14 thereof.

Draft Trade Marks (Jersey) Law 199

Article 143

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This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 20 December 1993.

For the Council
The President

A. BOURGEOIS