



**Tuvalu**

**REGISTRATION OF UNITED KINGDOM  
TRADE MARKS ACT**

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**CAP. 40.52**





Tuvalu

## REGISTRATION OF UNITED KINGDOM TRADE MARKS ACT

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Tuvalu

# REGISTRATION OF UNITED KINGDOM TRADE MARKS ACT

## AN ACT TO PROVIDE FOR THE REGISTRATION OF TRADE MARKS REGISTERED IN THE UNITED KINGDOM<sup>1</sup>

Commencement [22nd August 1939]

### 1 Short title

This Act may be cited as the Registration of United Kingdom Trade Marks Act.

### 2 Interpretation<sup>2</sup>

In this Act —

“**goods**” includes services;

“**the Register**” means the Register of Trade Marks kept under this Act;

“**the Registrar**” means the public officer who shall be appointed by the Minister to perform the duties of the Registrar or any matters incidental thereto under the Act;

“**the United Kingdom**” includes the Isle of Man; and

“**user**” includes a licensee of a trade mark.

### 3 Application to register trade mark registered in United Kingdom<sup>3</sup>

Any person being the registered proprietor of a trade mark in the United Kingdom by virtue of an entry in the register of trade marks kept under any law in force in the United Kingdom, or any person deriving title from such registered proprietor by assignment or other mode of transfer, may apply at any time during the existence of

the registration in the United Kingdom to have such trade mark registered in Tuvalu in respect of some or all of the goods comprised in the United Kingdom registration.

#### **4 Documents required on application for registration<sup>4</sup>**

An application for registration of a trade mark under this Act shall be made to the Registrar and accompanied by a certified representation of the trade mark and a certificate of the Comptroller-General of Patents, Designs and Trade Marks (under his title of Registrar of Trade Marks) giving full particulars of the registration of the trade mark in the United Kingdom.

#### **5 Issue of certificate of registration**

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

#### **6 Effect of certificate**

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

#### **7 Period for which effective**

The privileges and rights conferred by section 6 shall date from the date of registration in the United Kingdom and shall continue in force, subject to section 15, for so long as the registration in the United Kingdom remains in force in respect of the goods for which the trade mark is registered in Tuvalu:

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

#### **8 Saving of “Passing off” action**

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

## **9 Jurisdiction of the High Court<sup>5</sup>**

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

## **10 Entry in Register of Assignments**

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

## **11 Registered users<sup>6</sup>**

Any person entered in the United Kingdom Register of Trade Marks under any law in force in the United Kingdom as a registered user in respect of any goods of a trade mark in respect of which a certificate of registration under this Act is in force, may apply to be registered in Tuvalu as a registered user of the mark in respect of some or all such goods, subject to any conditions or restrictions entered in the United Kingdom register.

## **12 Rights of registered users**

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

## **13 Power to make regulations and prescribe fees**

The Minister may make such regulations and do such things as he may think expedient, subject to the provisions of this Act, for regulating procedure under this Act and prescribing the fees to be paid in respect of proceedings under this Act, other than procedure in relation to applications to the High Court and fees payable in respect thereof; and generally for prescribing anything which by this Act is to be prescribed.

**14 A Register of Trade Marks to be kept and to be open to inspection**

The Registrar shall keep in his office a book, to be called the Register of Trade Marks, in which he shall register the particulars to be kept and of any documents filed showing the number, nature and date thereof and the name of the registered proprietor or parties thereto; and such Register and all documents relating to entries therein which may have been duly filed, shall be open to the inspection of any person during office hours on payment of the prescribed fee.

**15 Entry in Register of renewals of United Kingdom registration**

If the registration in the United Kingdom of a trade mark registered under this Act is renewed, the registered proprietor may, within such time after the date of renewal in the United Kingdom as may be prescribed, notify the Registrar, who shall then, on sufficient evidence thereof and on payment of the prescribed fee, renew the registration in the Register in the prescribed manner; and if the registration in the Register is not so renewed, it shall be cancelled by the Registrar.

**16 Alteration of Register**

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

- (1) cancel the registration of a trade mark or of a registered user thereunder either wholly or as regards any particular goods in respect of which the trade mark or registered user is registered;
- (2) correct any clerical error in, or in connection with, any application under this Act or in any matter which is entered in the Register;
- (3) enter in the Register any change in the name, description or address of the person who is registered as proprietor or user of a trade mark.

**17 Entry in Register or certified copy to be admissible in evidence**

Any entry in the Register or any certified copy thereof or of any document duly filed signed by the Registrar shall be admitted in evidence in all courts of Tuvalu and in all proceedings without further proof.



**ENDNOTES**

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<sup>1</sup> 1990 Revised Edition, Cap. 63 – Acts 3 of 1939, 10 of 1967, 8 of 1971, 13 of 1972, LN 26/1976, LN 9/1981

Amended by Act 3 of 1997 commencement 11 April, 1997,

Amended by Act 8 of 2002 commencement 26 March 2003

<sup>2</sup> Amended by Acts 3 of 1997, 8 of 2002

<sup>3</sup> Amended by Act 3 of 1997

Act 3 of 1997 contained the following transitional provision —

“3. Upon the commencement of this Act, and subject to the provisions of the Registration of United Kingdom Trade Marks Act -

(a) trade marks entered in the Register by virtue of their registration in the United Kingdom under the Trade Marks Act 1938 shall continue on the Register as if registered under the law in force in the United Kingdom at the commencement of this Act; and

(b) entries in the Register in respect of registered users made pursuant to section 28 of the Trade Marks Act 1938 shall continue to have effect as if made pursuant to any law in force in the United Kingdom at the commencement of this Act as regards licensees of trade marks.”

<sup>4</sup> Amended by Act 3 of 1997

<sup>5</sup> Amended by Act 3 of 1997

<sup>6</sup> Amended by Act 3 of 1997