

# THIRD SUPPLEMENT TO THE GIBRALTAR GAZETTE

No. 4787 GIBRALTAR Monday 30th November 2020

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B. 29/20

## BILL

FOR

AN ACT to amend the Trade Marks Act and Patents Act.

ENACTED by the Legislature of Gibraltar.

### Short title.

1. This Act may be cited as the Trade Marks and Patents (Miscellaneous Amendments) Act 2020.

### Commencement.

2. The provisions of this Act come into operation on the 1<sup>st</sup> January 2021.

### Amendment of the Trade Marks Act.

3.(1) The Trade Marks Act is amended in accordance with the provisions of this section.

(2) In the long title, after the words “UNITED KINGDOM TRADEMARKS” insert-

“OR TO GIVE EFFECT TO SUCH TRADE MARKS; TO IMPLEMENT, IN PART, THE MADRID PROTOCOL ADOPTED AT MADRID ON 27<sup>TH</sup> JUNE 1989, AS AMENDED, SUPPLEMENTED OR REVISED FROM TIME TO TIME, AND FOR CONNECTED PURPOSES.”.

(3) Before the heading to section 1 insert –

“PART 1

INTRODUCTORY”

(4) In section 2-

(a) after the definition of “goods” insert-

““international trade mark (UK)” means a trade mark entitled to protection in the United Kingdom which results from an international application made on

or after 1 January 2021 for registration under the Madrid Protocol and designates the United Kingdom;

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

(b) after the definition of “trade mark” insert-

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

(5) Before the heading to section 2A insert-

## **“PART 2**

### **REGISTRATION OF TRADE MARKS”**

(6) In section 3 –

(a) for “Any person” substitute “Subject to Part 3, any person”;

(b) for “, 1938” substitute “1994”; and

(c) delete “, or any Act amended or substituted for that Act,”.

(7) In section 16 –

(a) delete “and generally” ; and

(b) after “to be prescribed” insert “, and generally for giving effect to the provisions of this Act.”.

(8) After section 16 insert-

## **“PART 3**

### **INTERNATIONAL TRADE MARKS”**

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

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

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

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

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

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

**Regulations.**

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

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

**Amendment of the Patents Act.**

4.(1) The Patents Act is amended in accordance with the provisions of this section.

(2) In the long title, after the words “IN THE UNITED KINGDOM” insert-

“, AND TO IMPLEMENT, IN PART, THE PATENT COOPERATION TREATY SIGNED AT WASHINGTON ON 19<sup>TH</sup> JUNE 1970, AS REPLACED, AMENDED OR SUPPLEMENTED FROM TIME TO TIME; AND FOR CONNECTED PURPOSES.”.

(3) In section 2 for “Any person” substitute “Subject to section 13, any person”.

(4) After section 12 insert-

**“International Patent (UK).**

13.(1) The registered proprietor of an international patent (UK) shall enjoy in Gibraltar the like privileges and rights as though the grant of the international patent (UK) had been extended to Gibraltar.

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

(3) For the purposes of this section-

“the Patent Cooperation Treaty” means the treaty of that name signed at Washington on 19<sup>th</sup> June 1970, or any other international convention or agreement replacing it; or as amended or supplemented by any convention or international agreement;

“international patent (UK)” refers to a patent (as may be amended from time to time) registered in the United Kingdom under the United Kingdom’s Patents Act 1977, or any Act amending or substituted for that Act, which results from an international application filed on or after 1 January 2021 for a patent under the Patent Cooperation Treaty that designates the United Kingdom.

### **Regulations.**

14. The Minister responsible for trade may make regulations for the purpose of implementing or further implementing in Gibraltar an international agreement or convention or any other international obligation concerned with patents.”

### **EXPLANATORY MEMORANDUM**

This Bill amends the Trade Marks Act in order to implement, in part, the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27<sup>th</sup> June 1989. It also makes provision for EUTMs and international trade marks with an EU designation following Gibraltar's exit from the EU.

This Bill also amends the Patents Act in order to implement, in part, the Patent Cooperation signed at Washington on 19<sup>th</sup> June 1970.

