

STATES OF JERSEY



Jersey

DRAFT TRADE MARKS, REGISTERED DESIGNS AND PATENTS (APPLICATION FORMS) (JERSEY) REGULATIONS 202-

**Lodged au Greffe on 18th January 2022
by the Minister for External Relations and Financial Services
Earliest date for debate: 1st March 2022**

STATES GREFFE

REPORT

Background

Ensuring that the laws making provision about intellectual property in Jersey are modern (and consistent with international standards) is an important policy objective for the Government of Jersey so as to encourage businesses of many types to locate and invest in the Island.

At the moment there are three laws in Jersey making provision about intellectual property rights that arise as a result of registration, namely laws relating to trade marks, patents and registered designs. The below three laws essentially provide for re-registration of intellectual property first registered in the United Kingdom (the “UK”).

- [Trade Marks \(Jersey\) Law 2000](#) (the “Trade Marks Law”)
- [Registered Designs \(Jersey\) Law 1957](#) (the “Registered Designs Law”)
- [Patents \(Jersey\) Law 1957](#) (the “Patents Law”).

Registration in Jersey

Each law permits registration in Jersey of the relevant intellectual property right (i.e. trade mark, registered design or patent) that is valid in the UK.¹ The person who is the proprietor of the right in the UK, is the person who can apply for registration in Jersey. The Judicial Greffier is the registrar to whom an application for registration must be made, with a Register of Rights maintained at the Judicial Greffe. There is no examination of the UK right for compliance with the various requirements in UK law that apply before there can be a registration in Jersey, but in each case the secondary registration in Jersey can only remain in force so long as the right remains in force in the UK.

Other types of registration

In addition to provisions dealing with applications for registration in Jersey of a trade mark, registered design or patent first registered in the UK, each of the three laws also makes provision for applications for other (related) types of registration in Jersey.

1. Trade marks

If the registration of a trade mark in the UK has been renewed, the Trade Marks Law enables the registered proprietor to apply to the registrar for the registration of the renewal in Jersey.² Furthermore, the Trade Marks Law also makes provision for applications for the registration of assignments and other transfers of and interests in, as well as licences of, registered trade marks.³

2. Registered designs

If the period for which a right in a registered design subsists has been extended in the UK or where a lapsed right in a design has been restored in the UK, the Registered Designs Law allows the registered proprietor to apply to the Judicial Greffier for the registration of the extension or restoration of the right in Jersey.⁴ Additionally, similar to the Trade Marks Law, the Registered Designs Law also contains a provision

¹ Article 4 of each of the three laws.

² Article 5 of the Trade Marks Law.

³ Article 6 of the Trade Marks Law

⁴ Article 5 of the Registered Designs Law.

regarding applications for the registration of assignments, licences and other titles in a registered design.⁵

3. *Patents*

Where a patent has been registered and the competent authority in the UK has either:

- made an order extending the term of the patent;
- granted a patent of addition for the improvement or modification of the patent so registered;
- where the patent has lapsed, made an order restoring the patent; or
- issued a decision or made an order allowing the amendment of the specification or drawings of the patent,

the Patents Law enables the person in whose name the patent is registered to apply to the Judicial Greffier for the registration of such order, grant or decision.⁶

Furthermore, the Patents Law deals with applications for the registration of an amendment or restoration of a registered “European patent (U.K.)”, when the amendment or restoration is made in accordance with the European Patent Convention and is treated under UK legislation as if it had been made under that legislation.⁷ Finally, the Regulations also amend the Patents Law with respect to the registration of assignments and other titles in a registered patent to be consistent with similar provisions in the Trade Marks Law and Registered Designs Law.⁸

Manner of application

1. *Trade Marks*

The Trade Marks Law provides that for each type of application for registration in Jersey, as outlined, the application must be made in “such manner as may be prescribed”. Article 1 of the Trade Marks Law stipulates that “prescribed” means prescribed by Order made by the Minister for External Relations and Financial Services (the “Minister”). In accordance with the applicable provisions, the manner of application for registration in Jersey is currently prescribed in the [Trade Marks \(Jersey\) Order 2000](#) (the “Order”), which contains application forms for each type of registration as set out in the Law.

As a result of the current legal framework, any time an amendment is needed to one, or more, of the application forms included in the Order, however minor, there is an administrative procedure of making Order changes that needs to be completed, which is considered disproportionately onerous in this context. Furthermore, it should be noted that it follows from Article 2(3) of the current Order that the application forms may be modified as directed by the registrar in any event, which is considered appropriate as the registrar is responsible for administering the Jersey Register of Trade Marks.

The purpose of the draft Trade Marks, Registered Designs and Patents (Application Forms) (Jersey) Regulations 202- (the “Regulations”) is therefore to amend the legal provisions in the Trade Marks Law that deal with the “manner” of application for registration in Jersey. More specifically, if approved by the States, these Regulations will ensure that in each of the applicable provisions for “such manner as may be prescribed” there is substituted “such manner as the registrar may from time to time

⁵ Article 6 of the Registered Designs Law.

⁶ Article 5(1) of the Patents Law.

⁷ Articles 5(3) and (4) of the Patents Law.

⁸ Article 6 of the Patents Law.

specify by publishing a notice, or providing an online form, on a website maintained by the registrar or the States of Jersey”.⁹

If passed, these Regulations will thus enhance flexibility under the relevant legal provisions by allowing the registrar to publish application forms on a website, including allowing interactive online forms to be used on the website. This would replace the current requirements for static paper-based forms to be prescribed by a Ministerial Order.

2. Registered Designs and Patents

The Registered Designs Law and the Patents Law both establish that for each type of application for registration in Jersey, as outlined above, the application must be made in “such manner as may be prescribed by rules of court”.

Article 13 of the [Royal Court \(Jersey\) Law 1948](#) (the “1948 Law”) establishes that Rules of Court may be made by the Superior Number of the Royal Court, with the advice and assistance of the Rules Committee. In the area of registered designs and patents, the [Registered Designs Rules 1958](#) and the [Patents Rules 1982](#) currently prescribe the manner in which an application for registration in Jersey must be made and set out the application forms that should be used.

As a result of the current practice, should any of the application forms included in either set of Rules of Court need to be updated, the procedure set out in the 1948 Law must be followed, which is considered a disproportionately cumbersome procedure for making such (often minor and non-substantive) administrative changes. Additionally, both the Registered Designs Rules 1958 and the Patents Rules 1982 currently also stipulate that the forms set out in these Rules may, in any event, be modified as directed by the Judicial Greffier who is responsible for maintaining the Register of Patents and the Register of Designs. In this respect, both sets of Rules of Court are similar to the [Trade Marks \(Jersey\) Order 2000](#).

In order to enhance flexibility under the relevant legal provisions and ensure consistency across all three laws, these Regulations are intended to make similar changes, as outlined above in respect of trade marks, to the Registered Designs Law and Patents Law (i.e. to make the language and manner of application consistent with equivalent provisions in the Trade Marks Law). As such, if passed, these Regulations will ensure that specifying the manner of application for registration of intellectual property under the Registered Designs Law and the Patents Law becomes the responsibility of the Judicial Greffier to decide on and publish (instead of the Superior Number of the Royal Court).

More specifically, the Regulations, if approved by the States, will ensure that in the applicable provisions in both the Registered Designs Law and the Patents Law for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey”.¹⁰

Modernisation of forms

If the Regulations are approved by the States, the process to amend the Trade Marks (Jersey) Order 2000, Patents Rules 1982 and Registered Designs Rules 1958 will

⁹ The provisions that would be amended if the Regulations are approved are Articles 4(3)(a), 5(1) and 6(2) of the Trade Marks Law.

¹⁰ The provisions that would be amended if the Regulations are approved are Articles 4(3), 5(1) and 6(2) of the Registered Designs Law and Articles 4(3), 5(1), (3) and (4) and 6(2) of the Patents Law.

subsequently be set in train by the responsible office, in particular, with a view to removing the current out-of-date forms in the Order and both sets of Rules of Court which do not reflect modern society as these currently require a married woman to give her maiden surname and the full name of her husband, stating whether “wife”, “widow” or “divorced” when making an application.

Once this process is finalised, any subsequent changes with regard to the manner of application will be for the Judicial Greffier to decide on and publish without the need to bring any further legislative changes to the Trade Marks (Jersey) Order 2000, Patents Rules 1982 or Registered Designs Rules 1958.

Financial and manpower implications

There would be no additional resource implications as a result of the adoption of these draft Regulations.

EXPLANATORY NOTE

These Regulations, if passed, would amend three Laws relating to intellectual property to allow the Judicial Greffier to publish application forms on a website, including allowing interactive online forms to be used on the website. That would replace the current requirements for static paper-based forms to be prescribed by a Ministerial Order or by rules of court.

The Laws are –

- (a) the Trade Marks (Jersey) Law 2000;
- (b) the Registered Designs (Jersey) Law 1957; and
- (c) the Patents (Jersey) Law 1957.

The applications for which the forms can be published are applications under those Laws for registration of –

- (a) a trade mark, when it relates to goods or services comprised in a United Kingdom trade mark registration (this also covers applications for renewal of registration);
- (b) a title or interest in a trade mark, when the applicant has become entitled to the trade mark (or to a share or interest in it) and has registered the title or interest in the United Kingdom;
- (c) a design, when the applicant is entered in the United Kingdom register of designs as the proprietor of that design;
- (d) an extension or restoration of a right in a design, when the applicant is the registered proprietor of the design and the right has been extended or restored in the United Kingdom;
- (e) a title to or interest in a registered design, when the applicant has become entitled to the registered design (or to a share or interest in it) and has registered the title or interest in the United Kingdom;
- (f) a patent, when the applicant is the grantee of the United Kingdom patent, or has a right to the United Kingdom patent under an assignment or transmission or by operation of law;
- (g) an order, grant or decision of the proper authority in the United Kingdom, extending or restoring a registered patent or allowing for its improvement, modification or amendment;
- (h) an amendment or restoration of a registered “European patent (U.K.)”, when the amendment or restoration is made in accordance with the European Patent Convention and is treated under United Kingdom legislation as if it had been made under that legislation;
- (i) a title to or interest in a registered patent, when the applicant has become entitled to the registered patent (or to a share or interest in it) under an assignment or transmission or by operation of law and has registered the title or interest in the United Kingdom.



Jersey

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Contents

Regulation

1	Trade Marks (Jersey) Law 2000 amended.....	11
2	Registered Designs (Jersey) Law 1957 amended	11
3	Patents (Jersey) Law 1957 amended.....	12
4	Citation and commencement.....	12



Jersey

DRAFT TRADE MARKS, REGISTERED DESIGNS AND PATENTS (APPLICATION FORMS) (JERSEY) REGULATIONS 202-

Made [date to be inserted]
Coming into force [date to be inserted]

THE STATES make these Regulations under Article 31A of the [Trade Marks \(Jersey\) Law 2000](#), Article 20A of the [Registered Designs \(Jersey\) Law 1957](#) and Article 24A of the [Patents \(Jersey\) Law 1957](#) –

1 [Trade Marks \(Jersey\) Law 2000](#) amended

In the [Trade Marks \(Jersey\) Law 2000](#) –

- (a) in Article 4(3)(a) for “such manner as may be prescribed” there is substituted “such manner as the registrar may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the registrar or the States of Jersey”;
- (b) in Article 5(1) for “such manner as may be prescribed” there is substituted “such manner as the registrar may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the registrar or the States of Jersey”;
- (c) in Article 6(2) for “such manner as may be prescribed” there is substituted “such manner as the registrar may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the registrar or the States of Jersey,”.

2 [Registered Designs \(Jersey\) Law 1957](#) amended

In the [Registered Designs \(Jersey\) Law 1957](#) –

- (a) in Article 4(3) for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey,”;
- (b) in Article 5(1) for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an

online form, on a website maintained by the Judicial Greffier or the States of Jersey,”;

- (c) in Article 6(2) for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey,”.

3 [Patents \(Jersey\) Law 1957](#) amended

In the [Patents \(Jersey\) Law 1957](#) –

- (a) in Article 4(3) for “such manner and be accompanied by such documents as may be prescribed by rules of court” there is substituted “such manner, and be accompanied by such documents, as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey”;
- (b) in Article 5(1) for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey,”;
- (c) in Article 5(3) for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey,”;
- (d) in Article 5(4) for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey,”;
- (e) in Article 6(2) for “such manner as may be prescribed by rules of court” there is substituted “such manner as the Judicial Greffier may from time to time specify by publishing a notice, or providing an online form, on a website maintained by the Judicial Greffier or the States of Jersey,”.

4 Citation and commencement

These Regulations may be cited as the Trade Marks, Registered Designs and Patents (Application Forms) (Jersey) Regulations 202- and come into force 7 days after they are made.